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Keller v. Electronic Arts: How Copyright Law Precludes Electronic Arts' First Amendment Defense

STEVEN HOWARD ROTH

As of 2010, it was estimated that 67 percent of Americans played video or computer games and that the same percentage of homes owned a video game console and/or a computer used to play video game software. Over the past several years, advancements in graphic cards have enabled game creators to replicate athletic environments with unprecedented precision, making sports video games increasingly more popular. The exceptional authenticity, however, has created a unique problem for video games featuring collegiate athletics due to the use of student-athlete likenesses and the relationship between commercial products and the amateur status of student-athletes. This contentious debate finally came to a boiling point on May 5th, 2009, when Sam Keller, a former quarterback for the University of Nebraska, filed a class action lawsuit on behalf of all college football and basketball players against Electronic Arts, Inc. ("EA"), the National Collegiate Athletic Association ("NCAA"), and the Collegiate Licensing Company (the "CLC").

Keller's complaint alleged that EA blatantly and unlawfully uses NCAA student-athlete likenesses in its collegiate sports video games to increase profits, in spite of clear bars on the use of student names and likenesses in NCAA bylaws and licensing agreements. Among other things, Keller also alleged that EA purposefully evaded the prohibition on the use of student-athletes' names in commercial ventures by enabling gamers to directly download entire rosters of collegiate teams into games. Exploring the relationship between intellectual property law and the First Amendment in video games, this Note examines Keller v. Electronic Arts, and dissects the validity of EA's First Amendment defense.

Despite EA's contention that the First Amendment protects its collegiate sports video games as expressive works, the argument does not comport with basic legal principles. Applying tenets of copyright law to the issues involved in Keller, this Note argues that the First Amendment affirmative defense employed by EA is invalid. More specifically, this Note demonstrates how the idea-expression dichotomy, scènes à faire doctrine, merger doctrine, and substantial similarity test necessarily preclude the athlete-avatars within EA's NCAA Football series video games, inter alia, from being considered expressive under the transformative use test.

Part I provides a brief history of NCAA sports video games and discusses the intricacies of EA's NCAA Football games, including the licensing procedure, the feel of the games, and the individual athlete-avatars. Part II scrutinizes Keller by giving an overview of the parties and issues involved as well as exploring the arguments for and against infringement. Part III examines and discusses intellectual property law, the First Amendment, and their application to video games by exploring the right of publicity, the First Amendment defense, and copyright protection in video games. Finally, Part IV argues that EA's use of the First Amendment as an affirmative defense is void for two separate reasons: (1) EA cannot own a copyright in certain aspects of the NCAA Football series video games; and (2), even absent the former issue, many components of the games do not meet the minimal level of creativity required to qualify for copyright protection.

I. INTRODUCTION

Since the creation of the Cathode Ray Tube Amusement Device, the world's first legitimate electronic game, by Thomas T. Goldsmith Jr. and Estle Ray Mann in 1947,¹ the video game industry has grown exponentially. As of 2010, it is estimated that sixty-seven percent of Americans play video or computer games and that the same percentage of homes own a video game console and/or a computer used to play video game software.² Industry data directly reflects the popularity of electronic games, as the computer and video game industry has increased its sales by an average of \$730,769,230 each year since 1996, and grossed a total of \$10.5 billion in 2009.³

Technological advancement has been one of the primary forces making video games more attractive to consumers. New technology has enabled video game producers to create games that continuously blur the lines between reality and fiction, allowing players to experience games in a completely new way. Although the advancements in technology have certainly had a wide-ranging effect on video games as a whole, sports video games, which constituted the top-selling game genre in 2009,⁴ have arguably been affected the most. Advancements in graphics cards have enabled sports video games to replicate athletic environments with unprecedented precision. Consequently, sports video games have become so realistic that, at first glance, characters and games are sometimes indistinguishable from reality. Even though the increasing authenticity of sports video games has helped skyrocket their popularity, it has simultaneously created a unique problem for games featuring collegiate athletics. Specifically, the rising accuracy of sports video games has incited a vigorous debate about the use of student-athlete likenesses in such games as well as the relationship between commercial products and the amateur status of student-athletes.

On May 5th, 2009, Sam Keller, a former quarterback for the University of Nebraska, filed a class action lawsuit on behalf of all college football and basketball players against Electronic Arts, Inc. ("EA"), the National Collegiate Athletic Association ("NCAA"), and the Collegiate Licensing Company (the "CLC").⁵ Keller's complaint alleged that EA blatantly and unlawfully used NCAA student-athlete likenesses in its collegiate sports video games to increase profits, in spite of clear bars on the use of student names and likenesses in NCAA bylaws and licensing agreements.⁶ Furthermore, Keller alleged that EA purposefully evaded the prohibition on the use of student-athletes' names in commercial ventures by enabling gamers to directly download entire rosters of collegiate teams into games.⁷ The complaint also claimed that both the NCAA and its licensing arm, the CLC, condoned the violations committed by EA, because the infringement increased the

1. D.S. Cohen, *Cathode-Ray Tube Amusement Device - The First Electronic Game*, ABOUT.COM CLASSIC VIDEO GAMES, <http://classicgames.about.com/od/classicvideogames101/p/CathodeDevice.htm> (last visited Oct. 5, 2011).

2. *Essential Facts About the Computer and Video Game Industry: 2010 Sales, Demographics and Usage Data*, ENT. SOFTWARE ASS'N 2 (2010), http://www.theesa.com/facts/pdfs/ESA_Essential_Facts_2010.PDF.

3. *Id.* at 11.

4. *Id.* at 7.

5. *Keller v. Elec. Arts, Inc.*, No. 09-1967, 2010 U.S. Dist. LEXIS 10719 1, 1 (N.D. Cal. Feb. 8, 2010).

6. *Id.* at 7.

7. *Id.* at 8.

popularity of the respective games, which in return provided them a higher yield of royalties.⁸

This Note examines and dissects *Keller v. Electronic Arts* by exploring the relationship between intellectual property law and the First Amendment in video games. Despite EA's contention that the First Amendment protects its collegiate sports video games as expressive works, the argument does not comport with basic legal principles. Applying tenets of copyright law to the issues involved in *Keller*, this Note argues that the First Amendment affirmative defense employed by EA is invalid. More specifically, this Note demonstrates how the idea-expression dichotomy, *scènes à faire* doctrine, merger doctrine, and substantial similarity test necessarily preclude the athlete-avatars within EA's NCAA Football series video games, *inter alia*, from being considered expressive under the transformative use test. Part I begins by providing a brief history of NCAA sports video games and discusses the intricacies of EA's NCAA Football games, including the licensing procedure, the feel of the games, and the individual athlete-avatars. Part II scrutinizes *Keller* by giving an overview of the Parties and issues involved as well as exploring the arguments for and against infringement. Part III examines and discusses intellectual property law, the First Amendment, and their application to video games by exploring the right of publicity, the First Amendment defense, and copyright protection in video games (through the idea/expression dichotomy, *scènes à faire* doctrine, merger doctrine, and substantial similarity test). Part IV argues that EA's use of the First Amendment as an affirmative defense is void for two separate reasons: (1) EA cannot own a copyright in certain aspects of the NCAA Football series video games; and (2), even absent the former issue, many components of the games do not meet the minimal level of creativity required to qualify for copyright protection.

II. THE NCAA, EA, AND SPORTS VIDEO GAMES

A. HISTORY AND BACKGROUND OF NCAA FOOTBALL VIDEO GAMES

The first "NCAA" football video game made its debut in 1993 when EA Sports, a division of EA, introduced *Bill Walsh College Football* into the market.⁹ The *Bill Walsh* franchise was designed for the Sega Genesis gaming console and was based on EA's successful *John Madden Football* (NFL) series.¹⁰ Aside from the title, there was little about *Bill Walsh College Football* that produced a collegiate feel; the game's 48 teams, which consisted of 24 of the all-time best "college" teams since 1978 and 24 "college" teams from 1992, only loosely mirrored their real life counterparts because EA did not hold a license from the NCAA or any of the colleges or universities.¹¹ As a result, the game did not incorporate any official NCAA, college, or university logos, and the "colleges" contained in the game were identified by the state or city schools were located within rather than the actual institutions' names.¹² Louisiana State University, for example, was represented in the

8. *Id.*

9. *Top Five NCAA Football Video Games of All Time*, BLEACHER REPORT (June 25, 2008), <http://bleacherreport.com/articles/32620-top-five-ncaa-football-video-games-of-all-time>.

10. Brett Alan Weiss, *Bill Walsh College Football*, ALLGAME, <http://www.allgame.com/game.php?id=12704> (last visited Oct. 5, 2011).

11. *Id.*

12. *Id.*

game by the team named Baton Rouge, while the team called Florida embodied the University of Florida.¹³ Teams in the game wore the same colors as their real-life counterparts, but rather than using names to identify the individual athlete-avatars, the players were identified by numbers.¹⁴ Game play modes were also extremely limited. Game players were able to choose from two options: (1) “exhibition” single game matchups; and (2) two separate playoff/tournament modes, neither of which even remotely resembled college football’s Bowl Championship Series (“BCS”) playoff structure.¹⁵ While game players were given a playbook containing sixty-eight different plays, including “the triple option, student body, and wishbone,” a vast array of classic collegiate formations and plays were left out.¹⁶ The game also provided game players with a choice of three different quarter lengths, which were 20, 40, and 60 minutes, as well as four different weather conditions: (1) fair; (2) windy; (3) rainy; and (4) snowy.¹⁷ Additionally, each team had its own “card,” which contained the statistics and ratings of thirty-five players on its roster across several different categories.¹⁸

The second installment of *Bill Walsh College Football*, released in 1994,¹⁹ had a markedly different feel than its predecessor. The primary impetus behind this change was that EA had obtained a license²⁰ from the NCAA, which made the game an official NCAA product, and opened up a whole new world of developmental possibilities. The second version of the game differed from the first in a number of ways, including the replacement of the game’s original twenty-four “college” teams with thirty-six Division I-A programs.²¹ In addition, unlike the first version, the new game contained a customizable season game mode option with a complete statistical tracking system; game players were given the choice of playing a season that lasted anywhere from one to sixteen weeks.²² When played in season mode, the game also provided game players with weekly national and divisional rankings.²³ Post-season game mode options were changed as well; game players had the choice of either a playoff or bowl game system.²⁴ Although the names of the bowl games, which included the Palm Bowl, Pecan Bowl, and Redwood Bowl, were fictional, the addition of the bowl game system gave *Bill Walsh College Football ‘95* a more realistic feel.²⁵ Making the experience more authentic, EA expanded the game’s playbook by incorporating “36 new plays and formations into it, including the . . . veer . . . and 4-4 D.”²⁶

13. See Alex Burr, *Bill Walsh College Football*, SEGA 16 (Oct. 20, 2008), <http://www.sega-16.com/2008/10/bill-walsh-college-football/> (showing a screenshot of tournament matchups).

14. *Id.*

15. Weiss, *supra* note 9.

16. *Id.*

17. *Id.*

18. *Id.*

19. See Alex Burr, *Bill Walsh College Football 95*, SEGA 16 (Jan. 20, 2010), <http://www.sega-16.com/2010/01/bill-walsh-college-football-95/>.

20. *Id.*

21. See Scott Alan Marriott, *Bill Walsh College Football 95*, ALL GAME, <http://www.allgame.com/game.php?id=14044> (last visited Feb. 16, 2011).

22. *Id.*

23. *Id.*

24. *Id.*

25. *Id.*

26. Scott Alan Marriott, *Bill Walsh College Football 95*, ALL GAME, <http://www.allgame.com/game.php?id=14044> (last visited Feb. 16, 2011).

In 1996, EA discontinued its affiliation with Bill Walsh and changed the name of the series to College Football USA.²⁷ Although the game used the same basic platform as the Bill Walsh series, it touted several important upgrades from its predecessor. Without a doubt, one of the most notable modifications EA made was its incorporation of every current Division I-A team into the game, something that had never been done prior to that point.²⁸ In addition, College Football USA '96 was the first college football video game to feature real BCS bowl games, such as the Orange Bowl, Sugar Bowl, Fiesta Bowl, and Rose Bowl.²⁹ While the season mode remained the same, allowing users to choose anywhere from a one to eleven game season, the roster size for each team received a boost to 45 players.³⁰ EA also designed a new passing feature that allowed game players to select one of five receivers to throw to on each passing play, and included a total of 400 plays in the game's playbook.³¹ Other significant improvements included a new "four-player mode[.] . . . substitutions, injuries, audibles, fake snaps, spins, hurdles, dives, blocked kicks . . . and laterals."³²

In the late part of 1996,³³ EA released "College Football USA '97: The Road to New Orleans." Continuing their trend of making its college football video games more authentic each year, EA incorporated several innovations into the new version. In particular, the game included every new Division I-A team, and incorporated the location of the 1997 BCS Championship game into the title to make it more authentic.³⁴ EA also expanded the game's playbook by incorporating even more authentic collegiate plays, and provided game players with eight different NCAA conferences, including the ACC, Big 12, Big East, and SEC.³⁵ Furthermore, in order to make the game even more realistic, EA made it so that the teams in each conference reflected the real conference's actual style of play.³⁶ The game also provided game players with a simulated USA Today/CNN College Football Coaches Poll, and was designed so that the winner of the BCS National Championship Game was provided with the American Football Coaches Association National Championship Trophy.³⁷ In fact, because Sears sponsored the trophy in 1997, EA called it the Sears National Championship Trophy.³⁸

27. See Brett Alan Weiss, *College Football USA '96*, ALL GAME, <http://www.allgame.com/game.php?id=11900> (last visited Feb. 16, 2011) [hereinafter *Football USA*]; Brett Alan Weiss, *College Football USA '96*, IGN, <http://cheats.ign.com/objects/492/492345.html> (last visited Feb. 16, 2011).

28. Weiss, *Football USA*, *supra* note 27.

29. *Id.*

30. *Id.*

31. *Id.*

32. *Id.*

33. See Scott Alan Marriott, *College Football USA '97: The Road to New Orleans*, ALL GAME, <http://www.allgame.com/game.php?id=7530> (last visited Feb. 16, 2011) [hereinafter *Marriott Football USA*]; *College Football USA '97: The Road to New Orleans*, IGN, <http://cheats.ign.com/objects/684/684603.html> (last visited Feb. 16, 2011) [hereinafter *IGN Football USA '97*].

34. *IGN Football USA '97*, *supra* note 33.

35. *Id.*

36. *Id.*

37. *Marriott Football USA*, *supra* note 33.

38. *Id.*

Although the College Football USA series encountered great success, EA once again decided to change its title.³⁹ Thus, in 1998, EA capitalized on its license with the NCAA, and transformed College Football USA into the NCAA Football series. Despite the change in title, however, EA's strategy remained consistent, and NCAA Football '98 contained numerous new features aimed at making the video game more accurate. For example, the game not only included over 30 authentic college and university fight songs, but provided game players with a choice of a total of 122 real stadiums to play games in as well.⁴⁰

Over the years, EA has continued to make improvements in each new release of the game to improve the series's authenticity. As technology has progressed, the ability to make improvements and additions has become easier, and allowed EA to incorporate more aspects of NCAA college football into the game. As a result, each new release of the NCAA Football series blurs the line between fiction and reality even more, and NCAA Football '11 is certainly no exception.

B. EA SPORTS' NCAA FOOTBALL '11

1. LICENSING

Colleges and universities can handle their licensing needs in a variety of different ways. One of the primary and best known organizations used by colleges and universities is the CLC. Established in 1981 by Bill Battle, former Head Football Coach for the University of Tennessee from 1970 to 1976, the CLC provides a wide range of licensing services to colleges, universities, athletic conferences, bowl games, and the NCAA, including brand protection, brand management, and brand development.⁴¹ More specifically, the CLC provides colleges and universities with a "consolidated approach to licensing [that] . . . increas[es] exposure, . . . reduce[s] administration expenses, [and] . . . allow[s] for independent decision-making by each and every client."⁴² Although a large number of colleges and universities choose the CLC to handle their respective licensing needs, collegiate entities are not required to use the CLC, and have a variety of other options at their disposal.⁴³ Many colleges and universities, for example, handle licensing issues internally or employ other licensing companies, such as the Licensing Resource Group.⁴⁴ Accordingly, any manufacturing company or organization that wants to obtain a license from a college or university that is not a member of the CLC must obtain the desired

39. See Scott Alan Marriott, *NCAA Football '98*, ALL GAME, <http://www.allgame.com/game.php?id=6616> (last visited Feb. 18, 2011).

40. *Id.*

41. CLC History, THE COLLEGIATE LICENSING COMPANY, <http://www.clc.com/clcweb/publishing.nsf/Content/history.html> (last visited Feb. 13, 2011); Bill Battle, SPORTS REFERENCE/COLLEGE FOOTBALL, <http://www.sports-reference.com/cfb/coaches/bill-battle-1.html>; CLC Services, THE COLLEGIATE LICENSING COMPANY, <http://www.clc.com/clcweb/publishing.nsf/Content/services.html> (last visited Feb. 13, 2011); NACMA Selects Battle, Valdiserri for 2010 Hall of Fame Class, NAT'L ASS'N OF COLLEGIATE MARKETING ADMINS. (May 12, 2010), <http://www.nacda.com/sports/nacma/spec-rel/051210aaa.html>.

42. *CLC History*, *supra* note 36 (alterations in original).

43. Telephone Interview with Dave Kirkpatrick, Vice President, Non-Apparel Mktg., The Collegiate Licensing Co. (Dec. 2, 2010); Telephone Interview with Michael S. Low, Dir. Of Licensing, Univ. of Notre Dame (Nov. 29, 2010).

44. Telephone Interview with Dave Kirkpatrick, *supra* note 43; Telephone Interview with Michael S. Low, *supra* note 43.

license(s) by contacting the institution's designated representative. Despite this general rule, however, all licensing deals concerning trading cards and/or video games, including EA's NCAA Football series, are handled by the CLC.⁴⁵

In order to make the licensing process easier, the CLC negotiates with every school and athletic conference over each version of the NCAA Football video game series, regardless of whether or not it is a member of the CLC.⁴⁶ As a result, EA obtains almost all the required licenses through one licensing agreement with the CLC on behalf of all the participating colleges and universities; each school included in the contract is listed in an exhibit/addendum.⁴⁷ Through the agreement, schools license an extensive amount of protected material, including the following: logos; school/team colors; designs and names of school owned stadiums; mascots; uniforms, including jerseys, helmets, cleats, etc.; fight songs; and school specific pre-game and in-game rituals and traditions.⁴⁸ Not every collegiate football stadium is covered under the CLC's licensing agreement, however, because some schools do not own the stadiums where their football team plays its home games. Nevertheless, EA acquires licenses for such stadiums by negotiating with each of the appropriate rights holders individually.⁴⁹ EA's agreement with the CLC also provides them with a license to utilize the NCAA's logos and trademarks as well as those of the BCS games, a large number of other postseason bowl games, and the Heisman Trophy Trust.⁵⁰ Finally, EA also obtained a separate license from the Entertainment and Sports Programming Network ("ESPN"), in order to integrate realistic news reporting and commentary into the game.

2. GAME PRESENTATION

When NCAA Football '11 is inserted into a gaming console, one of the very first things game players hear and see plastered across the screen is EA Sports slogan: "EA Sports, it's in the game."⁵¹ As the slogan implies, if it is in collegiate football in real life, EA Sports wants it in the video game. Technological advancements have not only helped EA make significant progress towards that goal, but have enabled them to do it with extraordinary accuracy. As a result, the feel of the game is exceedingly realistic. Featuring over 120 collegiate teams, NCAA Football '11 blurs the line between fiction and reality more than ever before.⁵² Every segment of the video game, in terms of both core game play and overall presentation, is designed to mirror real aspects of college football.⁵³

45. Telephone Interview with Dave Kirkpatrick, *supra* note 43.

46. *Id.*

47. *Id.*

48. *Id.*

49. For example, The Rose Bowl Stadium in California, which is one of the BCS Bowl game locations, is owned by the city of Pasadena, and not by a team. EA, as a result, obtains a separate license from Pasadena to utilize the stadium in the video game. See generally ROSE BOWL STADIUM, http://www.rosebowlstadium.com/RoseBowl_history.php (last visited Oct. 5, 2011).

50. Telephone Interview with Dave Kirkpatrick, *supra* note 38.

51. NCAA Football 11: Launch Trailer, EA SPORTS (July 13, 2010), <http://www.ea.com/videos/a8d358edb9dc9210VgnVCM2000001165140aRCRD>.

52. See *id.* ("We made it look just like it does on Saturday. . . . It's about tradition. It's your legacy, your pride, and your glory. . . . For 15 Saturdays and one trophy; every detail from your playbook to your passion, NCAA Football '11 is here.")

53. According to Michael S. Low, who is the Dir. of Licensing at the Univ. of Notre Dame, "[f]ans love the effort

In terms of the game presentation, EA does everything within its power to make the video game have a genuine collegiate feel. Through the “TruSchool” system, EA “delivers gameplay[,] traditions[,] and general aesthetics] authentic to each college team.”⁵⁴ One of the primary ways EA achieves such authenticity is by replicating each team’s uniforms from head to toe. More specifically, in the video game, teams’ jerseys (home, away, and alternates), helmets, cleats, and in-game and sideline accessories (wristbands, gloves, hats, etc.) are the exact same colors and designs as their real life equivalents. The designs of each team’s logos as well as the placement of sponsorship marks on all apparel are also replicated precisely. In the video game, for example, each player on the University of Louisville football team has an Adidas logo on his jersey in the exact same place it is located on the team’s jerseys in real life.⁵⁵ Similarly, the University of Oklahoma football Team, who is sponsored by Nike, has a Nike logo in the upper left hand corner on the front of its jerseys, and the school’s jerseys in the video game have the logo in the exact same place.⁵⁶

Another way EA makes the video game authentic is by infusing it with “pageantry and tradition”; the game features teams’ “true-to-life” pre-game stadium entrances and rituals.⁵⁷ In particular, some of the rituals and traditions EA recreated include Clemson players touching Howard’s Rock; Ohio State players locking arms together as they walk onto the field; Notre Dame players slapping the “PLAY LIKE A CHAMPION TODAY” sign as they exit the locker room; University of Miami players running under a giant inflatable helmet and being led onto the field by the school’s mascot; and Tennessee players hitting the “I will give my all for Tennessee today!” sign prior to the start of a game.⁵⁸ The pre-game entrances and traditions are specifically designed to recreate the unrivaled passion and emotion that players and fans experience each game. During the pre-game entrances, as teams walk through the stadium tunnels, game players hear and see cleats clacking on the concrete floors, experience the echoes of screaming fans bouncing off the walls, and observe players jabbering at each other trying to get pumped up for the game.⁵⁹ Game players, in addition, experience each team’s cheerleaders and mascots hyping up the crowd to the point where it feels like everyone is cheering. Finally, upon charging out onto the

[EA Sports] put[s] into making the stadium[s], the traditions, the mascots and the whole game environment so realistic.” Business Wire, CLC Grants EA Exclusive College Football Videogame License, ALLBUSINESS, (Apr. 11, 2005), <http://www.allbusiness.com/legal/contracts-law/licensing-agreements/5074835-1.html> (alteration in original).

54. *NCAA Football 11 Hits Shelves Today*, EA Sports (July 13, 2010, 9:00 AM), <http://www.ea.com/news/eas-ncaa-football-11-hits-shelves-today>.

55. NYYankees42, Comment to *The Photographic Side of NCAA Football 11*, OPERATION SPORTS (Jan. 11, 2011, 5:04 PM), <http://www.operationsports.com/forums/ncaa-football/427007-photographic-side-ncaa-football-11-a199.html>.

56. Double C, Comment to *The Photographic Side of NCAA Football 11*, OPERATION SPORTS (Jan. 12, 2011, 5:18 AM), <http://www.operationsports.com/forums/ncaa-football/427007-photographic-side-ncaa-football-11-a199.html>.

57. *Team Entrances in NCAA Football '11*, The Gaming Tailgate (May 4, 2010, 5:36 pm), <http://www.thegamingtailgate.com/forums/content.php?123-Team-Entrances-in-NCAA-Football-11> (quoting Greg Heddleston, EA Game Designer).

58. *Id.* (noting other teams with pre-game rituals include Texas, Florida, Georgia, Iowa, Nebraska, Virginia Tech, and Florida State).

59. *Id.*

field, game players encounter the sound of the home team's fight song suddenly exploding from the school's band.⁶⁰

EA also makes the video game more authentic by using the license it acquired from ESPN to recreate ESPN College Gameday and the company's general broadcast presentation of NCAA college football games. Game players not only have the ability to play in the ESPN Game of the Week, but experience ESPN's full broadcast graphics package and authentic replay system as well.⁶¹ Increasing the video game's authenticity even more, game players hear in-game commentary from ESPN commentators Brad Nessler and Kirk Herbstreit, and receive side-line reports, including insights and injury updates, throughout the game from Erin Andrews.⁶²

Another way EA makes the video game authentic is by replicating each team's stadium. More specifically, the game reproduces the designs of over 150 college football stadiums.⁶³ EA accomplished this task by sending individuals to photograph every nook and cranny of each stadium included in the video game.⁶⁴ From the number of seats to the landmarks and scenery outside of stadiums, EA left nothing out.⁶⁵ The details of each bowl game are also replicated in the video game with the same level of precision.⁶⁶ For example, after the BCS National Championship Game, the winning team holds up a newspaper in which the entire front page highlights the victory, as often happens in real life.⁶⁷

3. CORE GAME PLAY

In terms of the core game play, EA attempts to make game players feel as if they are inside the huddle. Game players are not only given extensive playbooks that contain authentic college formations, but are provided with playbook styles as well.⁶⁸ The playbook styles allow game players to play the game using the exact same strategies and plays as each team's real life counterpart.⁶⁹ As in real life, teams with the same playbook styles do not

60. *Id.* (“[W]e, EA Sports, really wanted to strengthen our authenticity and presentation in NCAA 11. . . . [and] we knew pregame entrances were a major component of building a great foundation.”).

61. Greg Heddlesten, *ESPN Integration*, EA SPORTS (Apr. 15, 2010, 5:55 PM), <http://ncaafootball.easports.com/blog.action%3FblogId%3Despn?author=Greg>.

62. *NCAA Football 11*, EA SPORTS, <http://www.ea.com/games/ncaa-football-11> (last visited Feb. 10, 2011).

63. Solidice, *NCAA Football 11 Blog: Screenshots and Videos*, OPERATION SPORTS (July 8, 2010, 1:11 pm), <http://www.operationsports.com/news/424313/ncaa-football-11-blog-new-stadiums-screenshots-and-videos/> (quoting EA Sports).

64. Telephone Interview with Dave Kirkpatrick, *supra* note 43.

65. Solidice, *supra* note 63.

66. See Dewiel, *NCAA Football 11 Official BCS National Championship Sim*, EA SPORTS, <http://www.easports.com/media/play/feature-video/NCAA-Football-11-Official-BCS-National-Championship-Sim> (last visited Feb. 10, 2011).

67. *Id.*

68. *NCAA Football 11 Guide*, IGN, http://guides.ign.com/guides/56574/page_5.html (last visited Feb. 11, 2011). (noting game players can choose from eight different authentic playbook styles: (1) Air Raid; (2) Multiple; (3) One Back; (4) Option; (5) Pistol; (6) Pro; (7) Run and Shoot; and (8) Spread).

69. Peter Moore, *It's in the Game: Are You Ready For Some Football?*, IT'S IN THE GAME (July 13, 2010), <http://www.easports.com/blogs/itsinthegame/post/slug/are-you-ready-for-some-football> (“[O]ur Tiburon development team has done a fantastic job of researching each individual offense and implementing it into the game. All 120 teams will run their own unique offense, whether it be the Spread No-Huddle, Air Raid, Pistol or any other, they will run it in NCAA Football 11.”).

have the same plays or even in-game strategy. Oregon and Marshall, for example, both utilize the spread playbook style, but Oregon frequently employs a no huddle offense, and Marshall's style is more conventional.⁷⁰ Running plays are extremely authentic due to a new technology called Real Assignment AI, which greatly improves the way offensive linemen select their blocking assignments.⁷¹ In addition, EA's locomotion system technology makes the movement of the individual athlete-avatars in the video game extremely fluid.⁷² Game players are not only able to experience the explosive power of an athlete's first step, but also have the ability to stop that momentum and regain an athlete's balance instantaneously. Moreover, the locomotion system helps highlight and differentiate the styles of players at each position (i.e. linemen, cornerbacks, receivers, running backs, etc.).⁷³

NCAA Football '11 provides several different playing formats, including a single game "exhibition" mode, a season mode, a "Road to Glory" mode, a dynasty mode, and a team builder mode. In the "Road to Glory" mode, a game player is put in the cleats of a specific football player as he navigates his collegiate career. Rather than starting at the beginning of the player's collegiate career, however, the game player's experience commences when the athlete is a senior in high school competing for the state football championship. While playing in a four-round tournament, the game player must impress the college scouts, who are watching in the stands and rating their talents. After the tournament concludes, the athlete receives offers from various schools. Once the game player accepts one of the proposals, the athlete embarks on his collegiate career.⁷⁴ The dynasty mode puts game players in the head coaching position and is extremely realistic. In dynasty mode, game players are not only in charge of recruiting, but of setting their schools' goals and priorities as well; EA gives game players complete control over every single decision. Furthermore, for game players who desire to micromanage every aspect of their teams, there are several add-ons available for purchase that provide weekly reports about high school prospects to help identify talent that may otherwise be overlooked. Making the game even more realistic, the video game also allows game players to change jobs after a season ends if another school offers them a more attractive position.⁷⁵

4. ATHLETES' IDENTITIES

Similar to earlier versions of the video game, each player in NCAA Football '11 is only identified by his playing position and jersey number (e.g. QB #11). At the same time,

70. *NCAA Football 11 Guide*, *supra* note 68.

71. *Real Assignment AI in NCAA Football 11*, THE GAMING TAILGATE, (Apr. 30, 2010, 4:04 PM), <http://www.thegamingtailgate.com/forums/content.php?124-Real-Assignment-AI-in-NCAA-Football-11> (quoting Mike Scantlebury, Associate Designer) (explaining that Real Assignment AI was specifically created to improve the effectiveness of run plays because "[i]n college football shotgun running is a huge part of many teams' high powered offense. You have to be able to mix it up, whether that means throwing in a Read Option, HB Sweep, Jet Sweep, HB Draw, Wild Cat, etc.").

72. Larry Richart, *Locomotion*, GAMING NEXUS (Apr. 5, 2010, 5:05 PM), <http://www.gamingnexus.com/FullNews/NCAA-Football-10-doing-thelocomotion/Item17074.aspx> ("The goal of this new locomotion technology is to create more realistic movements, while also maintaining responsiveness for the user.").

73. *Id.*

74. *NCAA Football 11 Game Modes: Road to Glory*, IGN, http://guides.ign.com/guides/56574/page_17.html (last visited Feb. 11, 2011).

75. *NCAA Football 11 Game Modes: Dynasty Overview*, IGN, http://guides.ign.com/guides/56574/page_4.html (last visited Feb. 11, 2011).

however, game players are able to share manually created rosters over an online server hosted by EA through a feature in the video game called EA Locker.⁷⁶ Using this feature, game players can download and save complete and accurate rosters for each team, allowing them to play the video game as their favorite college players.⁷⁷ In past versions of the series, when a game player downloaded accurate team rosters or manually entered the names of each team's players, the video game's commentators would automatically recognize and say the names during the game. For example, if a game player downloaded the 2009 University of Southern California football team roster into NCAA Football '09, Mark Sanchez would be listed as the team's quarterback, and Kirk Herbstreit or Brad Nessler would automatically say "Sanchez to throw" or "Sanchez in the gun" prior to and during the game. Even for players with difficult to pronounce or unique last names, the announcers would say them correctly; names, however, had to be spelled the exact same way the real football players spelled them in order to be recognized. As confirmed by Brad Nessler, the reason the video game recognized the players' names was that they were pre-recorded: "[w]e add players' names, although I know [EA is not] supposed to."⁷⁸ In spite of the feature being removed in NCAA Football '11, Sean O'Brien, the producer of EA's NCAA Basketball series, has openly admitted EA wants the names in its collegiate games: "[t]he NCAA knows we want it and they're investigating it for us."⁷⁹

III. DISENTANGLING KELLER V. ELECTRONIC ARTS

A. GENERAL BACKGROUND

Keller filed his complaint on May 5, 2009, against EA, the NCAA, and the CLC in the United States District Court for the Northern District of California.⁸⁰ The complaint set forth multiple claims, including allegations of civil conspiracy against EA, the NCAA, and the CLC, violation of the Unfair Competition Act/California Business & Professions Code Section 17200 against EA, breach of contract by the NCAA, and unjust enrichment as against EA and the CLC.⁸¹ By October 15, 2009, two other former collegiate athletes, Ed O'Bannon and Bryan Bishop, who also filed class action lawsuits against EA, the NCAA, and the CLC, had moved to consolidate their respective cases together with Keller's.⁸² Shortly after the court granted the consolidation motions, EA, the NCAA, and the CLC each filed a motion to dismiss in response to Keller's complaint.⁸³ Additionally, in accordance with California Civil Procedure Code 425.16, which pertains to strategic lawsuits against public participation, or "anti-SLAPP" motions, EA moved separately to strike Keller's allegations. The court denied both EA's and CLC's motions to dismiss, granted in part and

76. Anastacios Kaburakis, David A. Pierce, Olivia M. Fleming, Galen E. Clavio, Heather J. Lawrence, & Dawn A. Dziuba, *NCAA Student Athletes' Rights of Publicity, EA Sports, and the Video Game Industry*, 27 ENT. & SPORTS LAW. 1, Summer 2009, at 15.

77. *Id.*

78. Beth A. Cianfrone & Thomas A. Baker III, *The Use of Student-Athlete Likeness in Sport Video Games: An Application of the Right of Publicity*, 20 J. LEGAL ASPECTS SPORT at 44 (2010).

79. *Id.* at 37.

80. *In re NCAA Student-Athlete Name & Likeness Litig.*, No. C 09-1967CW, 2010 U.S. Dist. LEXIS 139724, at *8, (N.D. Cal. Dec. 17, 2010).

81. *Keller v. Elec. Arts, Inc.*, 2010 U.S. Dist. LEXIS 10719, at *7 (N.D. Cal. Feb. 8, 2010).

82. *In re NCAA Student-Athlete Name & Likeness Litig.*, No. C 09-1967CW at *10, (N.D. Cal. Dec. 17, 2010).

83. *Id.* at *9.

denied in part NCAA's motion to dismiss,⁸⁴ and denied EA's anti-SLAPP motion to strike.⁸⁵ Ten days after the court issued its opinion, EA appealed the denial of its anti-SLAPP motion, and moved to stay all discovery and proceedings.⁸⁶ As a result, the NCAA and CLC filed motions to stay both the proceedings and the discovery against them.⁸⁷ In analyzing an anti-SLAPP motion to strike, California courts apply a two-step process: (1) "the court decides whether the defendant has made a threshold showing that the challenged cause of action is one arising from protected activity"; and (2) "the court determines whether the plaintiff has demonstrated a probability of prevailing on the claim."⁸⁸ Accordingly, EA's appeal will require the Ninth Circuit to examine the scope of protection afforded by the First Amendment and balance it against an individual's right of publicity. Moreover, even if the district court's denial of EA's anti-SLAPP motion is affirmed on appeal, the ruling will not preclude EA from using the First Amendment as a defense. The remainder of this Note discusses and analyzes the relevant arguments and defenses with respect to Keller's right of publicity claims against EA.

B. KELLER'S ALLEGATIONS

1. STATUTORY LAW CLAIMS AGAINST EA

In his complaint, Keller's second cause of action alleges that EA deprived him of his statutory right of publicity by violating California Civil Code § 3344.⁸⁹ Keller specifically claims that EA knowingly and intentionally utilized and continues to utilize his name and likeness as well as the names and likenesses of all class members in its video games without proper consent.⁹⁰ In addition, Keller alleges that the conduct not only "occurred in and emanated" from EA's headquarters located in California, but that EA also used and continues to use the names and likenesses of all class members, including himself, to advertise, sell, and solicit its NCAA Football, NCAA Basketball and NCAA March Madness video games.⁹¹ Based on EA's actions, Keller alleges that EA has misappropriated both his and the class members' publicity rights and caused them to sustain serious injuries.⁹² The statutory publicity right was designed to complement the common law right of publicity rather than supplant it.⁹³

2. COMMON LAW CLAIMS AGAINST EA

84. Keller's claim against the NCAA for both breach of contract and violation of his right of publicity were dismissed with leave to amend the complaint; Keller could amend by alleging or attaching an enforceable contract and alleging that the NCAA violated his publicity right under Indiana law by actually using his likeness or conspiring with others, respectively. *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW at *35 (N.D. Cal. Feb. 8, 2010).

85. *Id.* at *35.

86. *In re NCAA Student-Athlete Name & Likeness Litig.*, 2010 U.S. Dist. LEXIS 139724, at *9.

87. *Id.*

88. *Keller v. Elec. Arts, Inc.*, 2010 U.S. Dist. LEXIS, at *33,34 (N.D. Cal. Feb. 8, 2010).

89. *See id.* at *8,11.

90. *Id.* at *28.

91. *Id.* at *16,17.

92. *Id.*

93. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001).

Keller's third cause of action in his complaint alleges that EA deprived him of his California common law right of publicity.⁹⁴ Despite the similarity between the common law and statutory rights of publicity, there are important distinctions between the two. The common law right of publicity, for example, possesses an advantage requirement, but the statutory right does not.⁹⁵ Conversely, while the statutory right of publicity requires that the defendant use the plaintiff's name and/or likeness knowingly, no such condition exists under the common law right.⁹⁶ Similar to his allegations in the second cause of action, Keller claims that, without proper consent, EA utilized and continues to utilize his name and likeness as well as the names and likenesses of all class members in the NCAA video games, "pursuant to their unlawful conspiracy."⁹⁷ Keller also alleges that EA commits such acts purely for its own commercial advantage, and that, once again, he and the class members have endured substantial injuries due to EA's misappropriation of their rights of publicity.⁹⁸

C. EA'S ARGUMENTS

1. DEFENSE TO KELLER'S COMMON LAW CLAIMS

In response to Keller's claim that it has violated his and the class members' common law right of publicity, EA asserts that both California law and the First Amendment disallow his claims. EA argues that its First Amendment affirmative defense bars Keller's right of publicity claims under two different theories. First, EA claims that since its NCAA Football series and other NCAA video games contain a significant number of transformative elements, the games qualify as expressive works, and thus are entitled to protection under the First Amendment.⁹⁹ EA specifically contends that its NCAA video games are protected by the First Amendment as expressive and transformative works because "[they] . . . are extraordinarily complex feats of computer engineering[, and] . . . artistic expression, comprised of originally designed virtual locations, players, coaches, fans and other game elements."¹⁰⁰ Second, EA argues that since the First Amendment protects works that are important to the public, such as ones that provide informative data, its NCAA video games automatically deserve protection, because they garner a high amount of public interest and include important information about sports and athletes.¹⁰¹ In its motion to dismiss, EA states that its NCAA video games have multiple expressive and creative elements not present in other works that received First Amendment protection from right of publicity claims.¹⁰² As a result, EA claims that "[i]f a poster of Joe Montana, a program from a baseball game, and a 'fantasy sports' game that includes nothing more than players'

94. *Keller* 2010 U.S. Dist. LEXIS, at *8.

95. CAL CIV. CODE § 3344 (2009).

96. *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 612–13 (Cal. Ct. App. 2006).

97. Class Action Complaint, *supra* note 89, at *29.

98. Motion to Strike, *Keller v. Elec. Arts, Inc.*, No. 4:09 CV 01967 CW, 2009 U.S. Dist. Ct. Motions 368791, at *1–2 (N.D. Cal. July 29, 2009).

99. *Keller v. Elec. Arts, Inc.*, No. 4:09 CV 01967 CW, 2009 U.S. Dist. Ct. Motions 368791, at *1–2 (N.D. Cal. July 29, 2009).

100. *Id.* at *35.

101. *Id.* at *27–28.

102. *Id.* at *34–35.

names, photos, biographical information and statistics are all protected by the First Amendment against publicity rights claims, then so too must [its NCAA video games].”¹⁰³

2. DEFENSE TO KELLER’S STATUTORY CLAIMS

In response to Keller’s claim that it has violated his and the class members’ statutory right of publicity under California Civil Code Section 3344, EA argues that the statute itself bars his claim. More specifically, EA asserts that, independent of its First Amendment defense, Keller’s claim fails due to the statute’s “public affairs” exception, which states that the “use of a name . . . or likeness in connection with any . . . public affairs, or sports broadcast or account” is explicitly exempt from liability.¹⁰⁴ EA states that the “public affairs” exemption not only provides works a wider shield against statutory misappropriation in comparison to the First Amendment, but also “is designed to avoid First Amendment questions in the area of misappropriation by providing extra breathing space for the use of a person’s name in connection with matters of public interest”.¹⁰⁵ Moreover, EA argues that Keller’s claim that the NCAA Football series includes his likeness satisfies the statute’s definition of the “public affairs” exception, and that courts have applied the exemption to sports related expressive works in less forceful situations.¹⁰⁶ Similar to the logic and reasoning employed in defense to Keller’s common law right of publicity claim, EA argues that since courts have applied the “public affairs” exception to a surfing movie, a poster of quarterback Joe Montana, and a baseball game program, its NCAA video games are entitled to exemption as well.¹⁰⁷

IV. INTELLECTUAL PROPERTY LAW, THE FIRST AMENDMENT, AND APPLICATIONS TO VIDEO GAMES

A. THE RIGHT OF PUBLICITY

1. BACKGROUND

Evolving from William L. Prosser’s four distinct tort-based invasions of privacy,¹⁰⁸ which were later adopted in the Restatement (Second) of Torts, the right of publicity first gained notoriety in the Restatement (Third) of Unfair Competition.¹⁰⁹ Section 46 of the latter Restatement defines a violation of the right of publicity as the “appropriat[ion] [of] the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade.”¹¹⁰ Although the invasion of

103. *Id.* at *43.

104. *Keller v. Elec. Arts, Inc.*, 2009 U.S. Dist. Ct. Motions 368791, at *49 (quoting CAL. CIV. CODE 3344(d)).

105. *Id.* (quoting *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 310 n.10 (9th Cir. 1992)).

106. *Id.* at *49–51.

107. *Id.* at *25–26.

108. According to Prosser, the four distinct invasions of privacy are: (1) “intrusion upon the plaintiff’s seclusion or solitude, or into his private affairs”; (2) “public disclosure of embarrassing private facts about the plaintiff”; (3) “publicity which places the plaintiff in a false light in the public eye”; and (4) “appropriation, for the defendant’s advantage, of the plaintiff’s name or likeness.” William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960).

109. Anastasios Kaburakis, David A. Pierce, Olivia M. Fleming, Galen E. Clavio, Heather J. Lawrence, & Dawn A. Dziuba, *NCAA Student-Athletes’ Rights of Publicity, EA Sports, and the Video Game Industry*, 27 ENT. & SPORTS LAW, Summer 2009, at 21.

110. *Id.* (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995)).

privacy and the right of publicity have common roots, there are several critical differences between the two of them.¹¹¹ One notable distinction is that the right of publicity has a much wider scope.¹¹² More specifically, the phrase “other indicia of identity” enables an individual to claim that the commercial value of his or her identity has been appropriated in violation of the right of publicity, even if his or her name or likeness was not actually used.¹¹³ Keller, as a result, does not even have to show that EA used his name or likeness without his permission in order to prevail on a right of publicity claim.

While plaintiffs can bring a false endorsement claim under the Federal Trademark, or Lanham, Act,¹¹⁴ the right of publicity is typically a product of state common law doctrine,¹¹⁵ concentrating on an individual’s financial interest in his or her identity.¹¹⁶ More specifically, publicity rights are designed to help individuals prevent unauthorized commercial exploitation of their names and likenesses.¹¹⁷ Even though the exact method for determining whether an individual’s right of publicity has been violated may vary from jurisdiction to jurisdiction, four elements appear to remain constant: (1) use of the plaintiff’s identity by the defendant; (2) a gain, commercially or otherwise, to the defendant through his or her misuse of the plaintiff’s name or likeness; (3) lack of consent by the plaintiff; and (4) injury to the plaintiff.¹¹⁸

2. PRECEDENT

While hearing *Haelan Laboratories v. Topps Chewing Gum* in 1953, the Second Circuit became the first to recognize and differentiate the right of publicity from the right of privacy.¹¹⁹ In *Haelan*, the plaintiff, Haelan Laboratories, had entered into contracts with baseball players that granted Haelan the exclusive right to use the players’ photographs on baseball cards, which were sold in packs that also contained the plaintiff’s chewing gum.¹²⁰ Topps Chewing Gum, the defendant, induced the baseball players to grant it a license to use the players’ photographs in the exact same manner as the plaintiff during either the original term or the extended term of the plaintiff’s agreements.¹²¹ Consequently, the plaintiff

111. *Id.*

112. *Id.*

113. *Id.*

114. Kaburakis, at 21.

115. Thomas Glenn Martin, Jr., *Rebirth and Rejuvenation in a Digital Hollywood: The Challenge Computer-Simulated Celebrities Present for California’s Antiquated Right of Publicity*, 4 UCLA ENT. L. REV. 99, 107 (1996).

116. *Id.* at 110.

117. *See id.* at 109.

118. Matthew G. Matzkin, *Gettin’ Played: How the Video Game Industry Violates College Athletes’ Rights of Publicity by Not Paying for Their Likenesses*, 21 LOY. L.A. ENT. L. REV. 227, 229–30 (2001) (citing *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 347 (Ct. App. 1983); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992); *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 413–14 (9th Cir. 1996); *see also* Darren F. Farrington, *Should the First Amendment Protect Against Right of Publicity Infringement Actions Where the Media Is Merchandiser? Say It Ain’t So, Joe*, 7 FORDHAM INTEL. PROP. MEDIA & ENT. L.J. 779, 793 (1997) (clarifying the elements of infringement of California common law right of publicity).

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

120. *Id.* at 867.

121. *Id.*

instituted a lawsuit against the defendant to stop the agreements.¹²² The defendant argued that the plaintiff only had a release of liability against the use of the picture, not an exclusive right to use the players' photographs (i.e., there was no property right granted to the plaintiff).¹²³ According to the defendant, if the plaintiff decided to use the players' pictures in an unauthorized manner, the plaintiff would only be violating the players' right to privacy, which is "a personal and non-assignable right."¹²⁴ The court, however, disagreed, explicitly recognizing the right of publicity as a valid and independent right:

[I]n addition to and independent of [the] right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture Whether it be labeled a 'property' right is immaterial . . . the tag 'property' simply symbolizes the fact that courts enforce a claim which has pecuniary worth. 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.¹²⁵

After the Second Circuit issued its opinion in *Haelan*, other states slowly began to recognize the right of publicity as independent. In spite of the publicity right being widely recognized, however, defining the exact scope and extent of the right has been a source of disagreement, and varies across jurisdictions.

On one end of the spectrum is *White v. Samsung Electronics, Inc.*, which the Ninth Circuit Court of Appeals decided in 1992. In *White*, the plaintiff, Vanna White, who was the hostess of the popular television game show "Wheel of Fortune," claimed that the defendant, Samsung Electronics, violated her right of publicity by knowingly using her likeness in advertisements without obtaining consent.¹²⁶ In particular, the advertisement at issue depicted a robot, which was clothed in a wig, dress, and jewelry (that resembled White's typical appearance), posing in White's signature stance next to a Wheel of Fortune-like game board, while the words "Longest-running game show. 2012 A.D." appeared on the screen.¹²⁷ In discussing the right of publicity, the court proposed the airing of a hypothetical advertisement during professional basketball games.¹²⁸ In the commercial, a bald African American male robot, wearing Air Jordan basketball shoes, baggy shorts, and a number 23 red basketball jersey (with black trim), is shown dunking a basketball one-handed with his arm stiff, legs spread "like open scissors," and tongue hanging out of his

122. *Id.*

123. *Id.*

124. *Id.* at 868.

125. *Id.* (alteration in original).

126. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992).

127. *Id.* at 1937.

128. *Id.* at 1399.

mouth.¹²⁹ According to the court, when “[c]onsidered individually, the robot’s physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.”¹³⁰ Likening the facts in the case at bar to the Michael Jordan hypothetical, the court found that Samsung had violated White’s right of publicity.¹³¹

On the other end of the spectrum, there are a number of courts that have defined the right of publicity’s scope in a wholly different manner.¹³² In *ETW Corporation v. Jireh Publishing, Inc.*, for example, Rick Rush, a well-known sports artist who has painted many famous athletes and sporting events,¹³³ created a painting of professional golfer Tiger Woods entitled *The Masters of Augusta* to honor Woods winning the 1997 Masters Tournament.¹³⁴ The painting contained Woods in three different poses, Woods’s caddy, Augusta National Clubhouse, and the likenesses of several past golf legends watching over Woods in the background behind the clubhouse.¹³⁵ Defendant, Jireh Publishing, published, marketed, and sold a limited number of serigraphs and lithographs of *The Masters of Augusta* for \$700 and \$100, respectively.¹³⁶ Shortly thereafter, plaintiff, ETW Corporation, which is Woods’s licensing agent, filed suit against Jireh Publishing alleging, inter alia, that Jireh had violated Woods’s right of publicity under Ohio common law.¹³⁷ Due to its transformative and artistic elements, the court ruled that the painting warranted First Amendment protection and Woods’s right of publicity had not been violated:

Rush’s work is expression . . . entitled to the full protection of the First Amendment and not the more limited protection afforded to commercial speech Rush has added a significant creative component of his own to Woods’s identity balancing the societal and personal interests embodied in the First Amendment against Woods’s property rights . . . the effect of limiting Woods’s right of publicity in this case is negligible and significantly outweighed by society’s interest in freedom of artistic expression Rush’s work consists of a collage of images in addition to Woods’s image which . . . describe, in artistic form, a historic event in sports history and . . . convey a message about the significance of Woods’s achievement in that event. Because Rush’s work has substantial transformative elements, it is entitled to the full protection of the First Amendment.¹³⁸

129. *Id.*

130. *Id.*

131. *White*, 971 F.2d at 1399.

132. See *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996); *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307 (Ct. App. 2001).

133. Examples include Michael Jordan, Mark McGuire, Coach Paul “Bear” Bryant, the Pebble Beach Golf Tournament. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 918 (6th Cir. 2003).

134. *Id.*

135. *Id.*

136. *Id.* at 919.

137. *Id.*

138. *ETW Corp.*, 332 F.3d at 937–38.

In *Montana v. San Jose Mercury News*, the California District Court of Appeals held that the First Amendment protected posters of professional football player Joe Montana.¹³⁹ According to the court, since Joe Montana was a major player in significant contemporaneous sports events and the posters at issue depicted newsworthy matters of public interest (i.e., triumphant moments from Super Bowls XXIII and XXIV), the posters were entitled to First Amendment protection.¹⁴⁰

Despite the various differences in the scope of the publicity right, and EA's attempt to have Keller's lawsuit dismissed by employing the First Amendment as an affirmative defense, one thing is clear: Keller has stated a prima facie right of publicity claim under California common and statutory law.¹⁴¹

B. THE FIRST AMENDMENT DEFENSE

The freedom of expression, which is safeguarded by the First Amendment, "exists to preserve an uninhibited marketplace of ideas and to further individual rights of self-expression."¹⁴² Moreover, regardless of whether a financial incentive exists, protection is afforded to all expressive forms, including fictional and non-fictional written and spoken works, movies, paintings, and drawings.¹⁴³ Video games, as expressive works, are no exception: they are as "entitled to the protection of free speech as the best of literature."¹⁴⁴ As a result, the First Amendment may be used as an affirmative defense to claims of copyright infringement.

Since there is inherent tension between the right of publicity and the First Amendment, courts must perform a delicate balancing act. Specifically, in determining if a defendant has a valid First Amendment defense, a court must discern whether the allegedly infringing work "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."¹⁴⁵ In order to make this inquiry, courts apply the "transformative use" test. The goal is to ascertain whether a new work "merely 'supersede[s] the objects' of the original creation," or is substantially transformative.¹⁴⁶ Thus, if the "sum and substance" of an allegedly infringing work is the illustration or replication of the celebrity or his or her likeness, it is not protected.¹⁴⁷ If, on the other hand, an allegedly infringing work contains so many transformative elements that it "'has become

139. *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 643 (Ct. App. 1995).

140. *Id.*

141. *See Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 U.S. Dist. LEXIS 10719, at *12 (N.D. Cal. Feb. 8, 2010) ("[EA] asserts . . . that [Keller's] right of publicity claims are barred by the First Amendment and California law. The Court considers and rejects each of these defenses in turn.")

142. *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 614 (Ct. App. 2006) (citing *Winter v. DC Comics*, 69 P.3d 473, 477 (Cal. 2003)).

143. *Id.* (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001); *Winter*, 69 P.3d at 477; *ETW Corp.*, 332 F.3d at 924).

144. *Interactive Digital Software Ass'n v. St. Louis Cnty.*, 329 F.3d 954, 958 (8th Cir. 2003) (citing *Winters v. New York*, 333 U.S. 507, 510 (1948)).

145. *Comedy III*, 21 P.3d at 808.

146. *Id.* (alteration in original) (quoting citation omitted in original).

147. *Kirby*, 50 Cal. Rptr. 3d at 615 (citing *Comedy III*, 21 P.3d at 809).

primarily the defendant's own expression¹⁴⁸ rather than the celebrity's likeness, it is protected."¹⁴⁹

The transformative use argument's range is laid out through two California Supreme Court cases: *Comedy III Productions, Inc. v. Gary Saderup, Inc.* and *Winter v. DC Comics*. In *Comedy III*, the plaintiff, who was the owner of all of the rights to the former "Three Stooges" comedy act, filed suit against the defendant-artist, alleging that the defendant violated its publicity rights by selling lithographs and T-shirts that contained a charcoal drawing he had created of "The Three Stooges."¹⁵⁰ While noting that a work containing significant transformative elements is entitled to First Amendment protection even more since it is less likely to hamper the economic interest safeguarded by the right of publicity, the court also acknowledged that a literal illustration or imitation of a famous person that produces financial gain, without more, does not amount to protectable expression.¹⁵¹ The court also explained that the transformative use analysis involves a process that is, in many respects, less qualitative than quantitative; in other words, the focus is on "whether the literal and imitative or the creative elements predominate in the work."¹⁵² Moreover, the court stated that in close cases, it may be helpful to perform a microanalysis by asking if the economic worth and marketability of the allegedly infringing work largely stems from the fame of the individual represented.¹⁵³ Applying the transformative use test to the defendant's work, the *Comedy III* court found that the overall goal of exploiting the fame of "The Three Stooges" by creating literal depictions of them trumped the artist's creative input, and, as a result, violated the plaintiff's right of publicity.¹⁵⁴

In *Winter*, the defendant, DC Comics, created and sold a five-volume comic series, which featured an "anti-hero" named Jonah Hex, and a wide variety of other characters.¹⁵⁵ After the defendant released the fourth volume of the series, which featured two half-worm, half-human brothers named Johnny and Edgar Autumn, the plaintiff-musicians, Johnny and Edgar Winter, instituted a lawsuit, alleging that DC Comics had misappropriated their names and likenesses by basing the two new characters on them.¹⁵⁶ While the court recognized that the fictional comic book characters summoned thoughts of the plaintiffs, it pointed out that the characters did not literally portray them.¹⁵⁷ Thus, stating that the plaintiffs were only one part of the "raw materials" used to construct the works, the court held that the comic books were entitled to protection under the First Amendment.¹⁵⁸

Approximately five years after *Comedy III* and three years after *Winter*, the California Court of Appeals applied the transformative use analysis to a video game in *Kirby v. Sega of America*. In *Kirby*, the plaintiff-celebrity, Keirin Kirby, who was the lead singer of a musical group called "Deee-Lite" and known for using the catch phrase "ooh la

148. "Expression" means expression of something besides a celebrity's likeness.

149. *Kirby*, 50 Cal. Rptr. 3d at 615 (citing *Comedy III*, 21 P.3d at 809).

150. *Comedy III*, 21 P.3d at 800-01.

151. *Id.* at 808.

152. *Id.* at 809.

153. *Id.* at 810.

154. *Id.* at 811.

155. *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003).

156. *Id.*

157. *Id.* at 479.

158. *Id.* at 477.

la,” sued Sega of America, alleging that her right of publicity was violated by “Ulala,” the main character of the defendant’s video game, “Space Channel 5.”¹⁵⁹ In analyzing the expressive elements of the video game, the court observed that Ulala’s tall and slender physique was not only markedly different from the plaintiff’s, but that the fictional character’s main costume, hairstyle, dance moves, and general environment¹⁶⁰ were also dissimilar.¹⁶¹ As a result, the court concluded that the First Amendment protected Ulala, because the character had enough creativity and expressive elements to qualify as transformative.¹⁶²

C. COPYRIGHT PROTECTION AND VIDEO GAMES

Although issues concerning copyright law have not been explicitly raised or discussed by any of the parties in *Keller*, it is necessary to briefly examine copyright principles and their interaction with video games to provide adequate context for the argument advanced in section IV of this Note.

1. OVERVIEW

In order to qualify for copyright protection, a work must: (1) be an original work of authorship; (2) be fixed in a tangible form; and (3) come within the subject matter of copyright.¹⁶³ The originality requirement is not difficult to meet. A work must have a minimal degree of creativity and be the product of an author’s independent creation.¹⁶⁴ As stated by the United States Supreme Court in *Feist*, “the requisite level of creativity is extremely low; even a slight amount will suffice.”¹⁶⁵ Put differently, as long as a work is not the result of copying, it can meet the originality threshold, even if it is fortuitously similar to other works.¹⁶⁶ Furthermore, only the final product is considered in determining whether a work is sufficiently original to garner copyright protection. Rigorous or “creative” labor in no way assures that a work is copyrightable.¹⁶⁷

In *Meshwerks v. Toyota Motor Sales U.S.A.*, plaintiff, Meshwerks, sued Toyota for copyright infringement, alleging that Toyota used the digital models it had created of Toyota’s cars, pursuant to a contract between them, in a way that was not allowed.¹⁶⁸ Meshwerks had been hired by a subcontractor of Toyota’s advertising agency to create digital models of Toyota’s vehicles for use in the company’s 2004 advertising campaign.¹⁶⁹ In order to create the digital wire frame models, Meshwerks took measurements of each car

159. Kirby v. Sega of Am., Inc., 50 Cal. Rptr. 3d 607, 609–11 (Ct. App. 2006).

160. Kirby was a musical artist, and was depicted as such to the public. In contrast, Ulala was depicted as a “space age” reporter working in the 25th century. *Id.* at 616.

161. *Id.*

162. *Id.* at 617–18.

163. 17 U.S.C. § 102(a) (2006). The statute expresses the “subject matter of copyright,” and the proper third element is a tangible form “from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”

164. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (citing 1 Melville Nimmer & David Nimmer, NIMMER ON COPYRIGHT § 2.01(A), (B) (1990)).

165. *Id.*

166. See *id.*

167. *Id.* at 346, *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1268 (10th Cir. 2008).

168. See *Meshwerks*, 528 F.3d, 1260–62.

169. *Id.* at 1260.

by covering it with a grid of tape and using a mechanical arm to analyze the intersection points.¹⁷⁰ Once all the models had been created, Meshwerks spent 80-100 hours per vehicle fine-tuning or “sculpting” their lines to make them resemble their real-life counterparts as accurately as possible.¹⁷¹ Specifically, the “sculpting” process accounted for about ninety percent of the data points included in each car’s digital model, and involved Meshwerks’ employees recreating each vehicle’s wheels, headlights, door handles, and Toyota symbol by hand, based on photographs.¹⁷² The final models, however, lacked color, texture, lighting, and other details, all of which were applied by the subcontractor that hired them.¹⁷³ While the court noted that it had no doubt that accurately recreating Toyota’s vehicles in digital form required a great deal of skill and labor, it held that such talent and effort did not entitle them to copyright protection because the design and images of the vehicles the digital models depicted were created by Toyota.¹⁷⁴ According to the court, Meshwerks’ intent in making the digital models supplied even more support for its ruling:

“In theory, the originality requirement tests the putative author’s state of mind: Did he have an earlier work in mind when he created his own?” If an artist affirmatively sets out to be unoriginal—to make a copy of someone else’s creation, rather than to create an original work—it is far more likely that the resultant product will, in fact, be unoriginal. “[A] person’s intent to copy . . . should be considered strong evidence that what that person has produced is not copyrightable.” . . . In this case, the undisputed evidence before us leaves no question that Meshwerks set out to copy Toyota’s vehicles, rather than to create, or even to add, any original expression.¹⁷⁵

2. THE IDEA/EXPRESSION OR FACT/EXPRESSION DICHOTOMY

Even if a work is entitled to copyright protection, it does not mean that every facet of it is protectable. Facts, for example, are never copyrightable, because they are not original to the author.¹⁷⁶ Furthermore, since copyright is designed to promote advancements in art and science, ideas also are not copyrightable; “copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.”¹⁷⁷ The concept, called the fact/expression or idea/expression dichotomy, is a well-known staple of copyright law, and has helped many courts determine which video game features are copyrightable as audiovisual works.

The Second Circuit Court of Appeals in *Stern Electronics, Inc. v. Kaufman*, for example, held that a coin operated electronic video game’s visual images and sounds met the fixation and originality requirements.¹⁷⁸ According to the court, since the repetitive

170. *Id.*

171. *Id.* at 1261.

172. *Id.* at 1260–61.

173. *Meshwerks*, 528 F.3d at 1261.

174. *Id.* at 1268.

175. *Id.* at 1268–69 (alteration in original) (citations omitted).

176. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344–45 (1991).

177. *Id.* at 349–50 (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556–57 (U.S. 1985)).

178. *Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 856–57 (2d Cir. 1982).

sequence of visual images and sounds were capable of being seen and heard every time a player performed specific tasks, they were entitled to copyright protection.¹⁷⁹

In *Atari, Inc. v. Amusement World, Inc.*, the plaintiff, who held a copyright in his video game “Asteroids,” filed suit against an electronics firm, which was trying to manufacture and sell a similar game called “Meteors.”¹⁸⁰ Although the court noted that the two games shared a number of design similarities, it found that the defendant did not infringe the plaintiff’s copyright, because the majority of the parallels were necessitated by the idea of a game in which a spaceship fights space rocks.¹⁸¹

3. THE *SCÈNES À FAIRE* DOCTRINE

Scènes à faire are “‘incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.’”¹⁸² Since it is almost impossible in some instances to write about a theme, historical period, or topic without employing certain “stock” or standard literary devices, courts have long held that *scènes à faire* are not copyrightable.¹⁸³

In *Incredible Technologies, Inc. v. Virtual Technologies, Inc.*, the plaintiff, Incredible Technologies, claimed that the defendant, Virtual Technologies, infringed copyrights in its highly successful video game, “Golden Tee.”¹⁸⁴ More specifically, Incredible Technologies alleged that the defendant’s game violated copyrights in the instructional guide provided on Golden Tee’s control panel, as well as the video imagery displayed on its video monitor.¹⁸⁵ While noting that Golden Tee’s menu screens and golf imagery could not be copied identically, the court held that they were standard to video games, and thus constituted *scènes à faire*:

[A] realistic video golf game . . . need[s] golf courses, clubs, a selection menu, a golfer, a wind meter, etc. Sand traps and water hazards are a fact of life for golfers, real and virtual. The menu screens are standard to the video arcade game format, as are prompts showing the distance remaining to the hole. As such, the video display is afforded protection only from virtually identical copying.¹⁸⁶

In *Team Play, Inc. v. Boyer*, plaintiffs, Team Play, et. al, sought a declaratory judgment that their video game, “Police Trainer 2,” did not violate any of Boyer’s copyrights or owe Boyer any more royalty payments.¹⁸⁷ Boyer, in response, counterclaimed not only that Police Trainer 2 violated his copyrighted video games, Police Trainer and Sharpshooter, but also that the plaintiffs breached a contract, which required them to make

179. *Id.* at 856.

180. *Atari, Inc. v. Amusement World, Inc.*, 547 F. Supp. 222, 223-24 (D. Md. 1981).

181. *Id.* at 229.

182. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980) (quoting *Alexander v. Halcy*, 460 F.Supp. 40, 45 (S.D.N.Y. 1978)).

183. *Hoehling*, 618 F.2d at 979.

184. *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007, 1009 (7th Cir. 2005).

185. *Id.* at 1010.

186. *Id.* at 1015.

187. *Team Play, Inc. v. Boyer*, 391 F. Supp. 2d 695, 697 (N.D. Ill. 2005).

royalty payments on any sequel and derivative games.¹⁸⁸ More specifically, Boyer alleged that Police Trainer 2 violated his copyrights in Sharpshooter by misappropriating four of the game's features: (1) a shooting contest where targets come out of a cylindrical hole in the floor; (2) a shooting contest where targets are arranged randomly and game players are required to recall which are which in order to shoot the correct targets; (3) a shooting contest where targets erratically emerge from cylindrical holes; and (4) silver iconic objects, which are used as progress indicators to inform game players that a challenge has been completed.¹⁸⁹ Despite Boyer's contentions, however, the court held that the plaintiffs did not violate his video game's copyrights, because the four features embodied either *scènes à faire*, uncopyrightable ideas, or both; absent identical copying, the elements were not entitled to protection.¹⁹⁰

4. THE MERGER DOCTRINE

Although copyright law generally shelters expression and not ideas, there are still situations in which even the expression of an idea must not be protected. In circumstances where a "given idea is inseparably tied to a particular expression," the merger doctrine precludes protection over the expression, since it "would confer a monopoly over the idea itself, in contravention of the statutory command."¹⁹¹ Put otherwise, when an idea can only be expressed one or a very limited number of ways, the expression is not guarded, because, in such cases, it inextricably merges with the idea. Applying the merger doctrine's threshold inquiry "requires a determination of precisely what the 'idea' and the 'expression' are."¹⁹²

The Ninth Circuit Court of Appeals' decision in *Herbert Rosenthal Jewelry Corporation v. Kalpakian* provides an excellent example of the merger doctrine. In *Rosenthal Jewelry*, the plaintiff, who held a copyright in a bee shaped pin that was made of gold and covered in jewels, alleged that the defendant's product line of jeweled bees violated his copyright.¹⁹³ According to the court, the "jeweled bee pin" was an idea, and the plaintiff's pin was one expression of the idea.¹⁹⁴ Since the plaintiff could not explain how the jewels could be arranged in the shape of a bee on the back of a pin without violating his copyright, the court stated that upholding the copyright "would effectively prevent others from engaging in the business of manufacturing and selling jeweled bees."¹⁹⁵ Consequently, the court held the idea of the jeweled bee pin was inseparable from the expression of it in the plaintiff's pin, and would not enforce the copyright.¹⁹⁶

5. SUBSTANTIAL SIMILARITY

188. *Id.*

189. *Id.* at 702.

190. *Id.*

191. 4 Melville B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT §13.03 (B)(3) (1998).

192. *Thornton v. J Jargon Co.*, 580 F. Supp. 2d 1261, 1273 (M.D. Fla. 2008) (quoting *BUC Int'l Corp. v. Int'l Yacht Council Ltd.*, 489 F.3d 1129, 1143 (11th Cir. 2007)).

193. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 739 (9th Cir. 1971).

194. *Id.* at 742.

195. *Id.* at 740.

196. *Id.* at 742.

In order to bring a successful copyright infringement claim a plaintiff must show that: (1) the defendant copied from his or her copyrighted work; and (2) the copying amounted to an unlawful appropriation (i.e., the alleged infringing work is substantially similar to the original copyrighted work).¹⁹⁷ Absent direct evidence, plaintiffs can indirectly establish copying through the use of circumstantial evidence. One of the ways a plaintiff can support an inference of copying is by demonstrating that the defendant had access to the copyrighted material and that the infringing work is adequately similar to it.¹⁹⁸ Another way a plaintiff can indirectly establish copying is through striking similarity; even without concrete evidence of access, if the similarity between the works is so striking that it is highly unlikely the defendant independently created his or her work, copying may be inferred. If copying is established, a plaintiff must then show the copying amounted to an unlawful taking.¹⁹⁹ Although there have been a number of tests devised to determine substantial similarity, one of the most widely relied upon methods, which was developed by the Ninth Circuit, centers on the “total concept and feel” of one work in comparison to another.²⁰⁰ In applying the “total concept and feel” test, courts must take a two-tier approach,²⁰¹ which consists of extrinsic and intrinsic assessments.²⁰² First, in performing the extrinsic test, the court must determine if the ideas contained in two works are substantially similar.²⁰³ This test focuses on specific criteria that can be listed and analyzed, and often makes use of expert testimony.²⁰⁴ Once the extrinsic prong has been satisfied, a court then focuses on the expression of the ideas.²⁰⁵ Since it is often much more complex to ascertain whether there is substantial similarity between the forms of expression in two works, courts employ an intrinsic test, which focuses on the reaction of the “ordinary observer.”²⁰⁶ More specifically, the test asks “whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protectable expression by taking material of substance and value.”²⁰⁷ However, the test excludes any elements in the allegedly infringed work that are not protectable under the Copyright Act (i.e. ideas, facts, *scènes à faire*, or expressions of ideas that can only be conveyed in an extremely limited number of ways/inextricably merge with an idea).²⁰⁸

In *Williams Electronics, Inc. v. Bally Manufacturing Corporation*, plaintiff, Williams Electronics, created an arcade game called “Hyperball,” which integrated the video game format with several popular features of the traditional pinball game.²⁰⁹ Game players’ primary objective in Hyperball was to prevent lightning bolts from smashing into

197. *Incredible Techs., Inc.*, 400 F.3d at 1011 (quoting *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982); *Warner Bros., Inc. v. Am. Broad. Cos.*, 654 F.2d 204, _____ (2d Cir. 1981)).

198. *Id.*

199. *Id.*

200. *See Interactive Network v. NTN Commc’ns*, 875 F. Supp. 1398, 1404 (N.D. Cal. 1995).

201. *Id.* at 1403 (citing *Data E. USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 208 (9th Cir. 1988)).

202. *Id.*

203. *Id.*

204. *See Interactive Network*, 875 F. Supp. at 1404.

205. *Id.* at 1403, 1405.

206. *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007, 1011 (7th Cir. 2005).

207. *Id.* (quoting *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982)).

208. *See Interactive Network*, 875 F. Supp. at 1403.

209. *Williams Elecs., Inc. v. Bally Mfg. Corp.*, 568 F. Supp. 1274, 1276-77 (N.D. Ill. 1983)

their energy center by shooting balls at them.²¹⁰ After seeing Hyperball at a trade show, Bally Manufacturing designed a similar game called “Rapid Fire,” and, as a result, Williams Electronics filed suit, claiming Bally infringed its copyright in Hyperball.²¹¹ While recognizing that the concept of Hyperball was novel, the court pointed out that a video game in which “a player shoots rolling balls at advancing ‘enemies’ is not only not copyrightable,” but also that the shapes, colors, targets, and lights in its game, other than their specific expressive arrangement, were not protected.²¹² The court found that, after eliminating all of the uncopyrightable elements, the two games were not substantially similar. Therefore, it held that Williams Electronics’ copyright had not been violated and granted summary judgment to Bally.

In *Interactive Network, Inc. v. NTN Communications, Inc.*, plaintiff, Interactive Network, developed a new “play-along” interactive game similar to a game it licensed from the defendant, NTN, and sought a declaratory judgment that its new game did not violate the defendant’s copyright.²¹³ The two games were interactive games that tested players’ aptitude at making predictions about football plays and awarded different point totals according to the accuracy and complexity of each prediction.²¹⁴ Even though NTN Communications recognized that the idea of the game was not copyrightable, it specifically claimed that Interactive Network copied its game’s unique structural features, including the consecutive bonus element, scoring system, three level play prediction format, beginning animation series, and design of the graphical user interface.²¹⁵ While the court recognized that NTN’s format and scoring system were not copyrightable because the nature of football limited the number of possible predictions, it stated that a reasonable jury could find NTN’s original combination of the elements protectable.²¹⁶ As a result, the court held that it was unable to determine whether there was substantial similarity between the two video games, and denied Interactive’s motion.²¹⁷

IV. ARGUMENT AGAINST THE VALIDITY OF EA’S FIRST AMENDMENT DEFENSE

Despite EA’s contention that Keller’s right of publicity claims are barred by the First Amendment, application of basic copyright principles reveals that EA’s argument does not stand. While each version of the NCAA Football video game series as a whole is entitled to copyright protection, the amount of coverage is limited in many ways. As a result, EA’s First Amendment defense is invalid for two reasons. First, EA cannot own a copyright in every aspect of the NCAA Football series video games. Second, putting the former issue aside, many parts of the video games are not sufficiently creative to garner copyright protection. Due to these copyright constraints, EA cannot show its NCAA Football games contain the transformative elements necessary to invoke First Amendment protection.

210. *Id.*

211. *Id.* at 1277.

212. *Id.* at 1278 (citing *Cf. Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 1188-89 (2d Cir. 1975) (rules of game not copyrightable)).

213. *Interactive Network*, 875 F. Supp. at 1401.

214. *Id.* at 1403-04.

215. *Id.* at 1403.

216. *Id.* at 1405.

217. *Id.*

A. EA CANNOT OWN A COPYRIGHT IN EVERY FACET OF THE NCAA FOOTBALL VIDEO GAME SERIES

EA's *modus operandi* is no secret: make each installment in the NCAA Football series as realistic as possible. As mentioned previously, in order to ensure the video games' authenticity, EA acquires exclusive licenses from the NCAA, BCS, ESPN, apparel sponsors (e.g. Nike, Adidas, etc.), and each athletic conference and collegiate program included in the games.²¹⁸ Using the licenses, EA attempts to replicate every aspect of collegiate football exactly as it is in real life. The licenses are crucial; without them, EA would not be able to reproduce each team's logos, colors, jerseys, helmets, cleats, fight song(s), mascot(s), stadium, or pre-game and in-game rituals and traditions. Given the fact that EA not only goes through the trouble to obtain the licenses, but also pays a considerable amount to be the exclusive video game licensee of the NCAA,²¹⁹ it seems more than safe to reason that EA openly acknowledges that, other than the user interface (i.e. menus, option screens, control buttons, etc.) and coding, the design of every aspect of the video game's core game play owes its origins to the individual licensors, and not to EA. While EA does not attempt to physically reproduce the items it licenses, it does seek to recreate the objects in a digital two-dimensional medium. Considering "[t]he fact that a work in one medium [that] has been copied from a work in another medium does not render it any the less a 'copy,'"²²⁰ and that EA does not and would not want to add anything into the game that is not authentic, it logically follows that EA cannot claim that any of the licensed items are original.²²¹ Since the licensed items are not independent and original creations made by EA, the company does not own a copyright in any of the individual elements of the game.²²² Accordingly, EA's argument that the First Amendment protects its NCAA Football video games must fail, because the games cannot pass the transformative use test; EA did not contribute any original, identifiable, or distinctive expressive content.²²³ While EA may spend a considerable amount of labor and skill replicating each of the licensed items in the video games, it does not change the fact that all of those items owe their origins to their respective licensors. In other words, the "blood, sweat, and tears" EA poured into creating NCAA Football '11 or any other release in the series do not count in the originality assessment. As previously mentioned, only the final product is considered in determining a

218. See *supra* text accompanying notes 9–40.

219. See *supra* note 48.

220. *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1267 (10th Cir. 2008) (quoting *Nimmer on Copyright* § 8.01(B)) (citing *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980) (holding that "the mere reproduction of the Disney characters in plastic . . . does not constitute originality as this Court has defined the term"); *Entm't Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1221–24 (9th Cir. 1997) (denying copyright protection to 3-D costumes based on 2-D cartoon characters)).

221. *Id.* at 1270 ("Originality is the sine qua non of copyright. If the basic design reflected in a work of art does not owe its origin to the putative copyright holder, then that person must add something original to that design, and then only the original addition may be copyrighted").

222. See *ATC Distr. Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 712 (6th Cir. 2005) (holding that a series of catalog illustrations depicting auto transmission parts, which were drawn by hand from photographs in a competitors catalog, were not independently copyrightable). "The illustrations were intended to be as accurate as possible in reproducing the parts shown in the photographs on which they were based, a form of slavish copying that is the antithesis of originality."

223. *Meshwerks*, 528 F.3d at 1267–68 (citing *Bridgeman Art Library, Ltd.*, 36 F. Supp. 2d 191, 199 (S.D.N.Y. 1999) (noting that "a copy in a new medium is copyrightable only where, as often but not always is the case, the copier makes some identifiable original contribution")).

work's originality (i.e. the final product of EA's efforts, which is each version/annual release of the NCAA Football series sold to the public).²²⁴ Moreover, since the single motivation of the tremendous amount of hours and effort EA spends on creating each release of NCAA Football is to make each facet of the game as accurate as possible, EA cannot assert that the depiction of the licensed items is not the "sum and substance" of the video game.²²⁵

B. MANY ASPECTS OF THE VIDEO GAMES ARE NOT SUFFICIENTLY CREATIVE TO GARNER COPYRIGHT PROTECTION

Even if the limitations imposed by the licenses EA acquires from the NCAA, BCS, ESPN, apparel sponsors, athletic conferences, and collegiate programs are disregarded, the extent of EA's copyright in its NCAA Football series video games would still be extremely restricted. Examining NCAA Football '11 using the idea/expression dichotomy, *scènes à faire* doctrine, merger doctrine, and substantial similarity test reveals that many parts of the video games are not sufficiently creative to garner copyright protection.

The entire NCAA Football series, including NCAA Football '11, is built upon one idea: an authentic college football video game that transposes physical reality into a two dimensional space.²²⁶ As is the case with all ideas and facts, the concept of an authentic college football video game is not copyrightable. Although copyright law prohibits someone from copying NCAA Football '11 to the letter and selling the game under a different title, EA cannot prevent other "authentic" college football video games from being created. In other words, if another gaming organization acquired licenses from the appropriate sources (NCAA, BCS, ESPN, apparel sponsors, athletic conferences, collegiate programs, etc.) and created another authentic college football video game, which competed against NCAA Football '11, EA would not be able to do anything about it.²²⁷ The idea/expression dichotomy thus prevents EA from holding copyright in the idea embodied in NCAA Football '11, and, in fact, encourages others to build freely upon its underlying concept.

Although EA may have integrated some creativity into the layout and design of the menu screens and user interface in NCAA Football '11, since their primary objective was to provide game players with an authentic college football game, it consists almost wholly of *scènes à faire*. In any college football video game, let alone one designed to be purely authentic, there are certain standard and indispensable staples that would necessarily be included in the end product. In particular, teams/players, referees, stadiums, fans, cheerleaders, and playbooks are all "stock" items that are inextricably linked with the topic of college football and are not copyrightable as a result.²²⁸ While EA placed more than those basic elements in NCAA Football '11, they did not install anything that is not standard or stock in relation to the game's objective. All the core game play features

224. See *id.* at 1268 (citing Howard B. Abrams, LAW OF COPYRIGHT § 2:8 ("Even if the process is both expensive and intricate, an exact or near-exact duplicate of an original should not qualify for copyright.")).

225. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

226. See discussion *supra* notes 50, 59.

227. Although EA currently has exclusive licenses with the NCAA, BCS, ESPN, apparel sponsors, athletic conferences, and collegiate programs, which essentially prevents another company from creating as authentic a college football video game as EA can, EA cannot stop another company from acquiring the necessary licenses and creating a similar video game once the agreements expire.

228. See *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980).

contained in NCAA Football '11, including the ESPN integration package, the BCS system, each NCAA team and athletic conference, and each teams' logo(s), school colors, uniforms (helmets, jerseys, cleats, wristbands, etc.), ritual(s) and tradition(s), fight song(s), and mascot(s), are all still indispensable to creating an authentic college football video game. The only difference between NCAA Football '11 and any other authentic "college" football video game is that EA's game will have a much higher level of authenticity due to its current exclusivity agreement. Nevertheless, simply because one college football game cannot or does not replicate the college football experience as accurately as another game does not mean that the items contained in the more realistic one are not indispensable. Everything included in NCAA Football '11's game presentation, as a result, qualifies as *scènes à faire*; the individual elements in the game are only copyrightable to the extent their expression is original. However, since EA specifically acquires licenses so they can precisely replicate each aspect of college football, originality is essentially non-existent.

While authenticity is often desirable in many types of works, it does have a profound effect on the scope of a work's expression. Authenticity, by its very nature, is the antagonist of originality; it necessarily requires precise replication of some other expression. The relationship between originality and authenticity is equivalent to a seesaw in many respects. When original elements are infused into a work depicting a specific subject or object, the authenticity of it almost automatically declines, and vice versa. Thus, if the primary goal of a work portraying a particular concept is genuineness, the number of ways a topic or object can be expressed will be limited to one or a very few number of ways, and the merger doctrine will apply.²²⁹

EA prides itself on and openly admits that authenticity is the focal point of its NCAA Football series video games. EA Sports' slogan says it all: "it's in the game." While the authenticity of NCAA Football '11 may make it extremely popular, it completely eradicates EA's ability to instill original and creative expression into the game. The idea of an authentic college football video game is "inseparably tied to a particular expression."²³⁰ College football is inextricably linked with the NCAA and its member institutions. As a result, there is only one way a college football video game can be depicted in a truly authentic manner: the video game must express each facet of college football exactly as it is in reality. This means ESPN's media coverage (pre-game, in-game, and post-game format), the BCS system, non-BCS bowl games, each NCAA team and athletic conference, and the teams' logo(s), school colors, uniforms (helmets, jerseys, cleats, wristbands, etc.), stadiums, pre-game and in-game ritual(s) and tradition(s), fight song(s), and mascot(s) must be replicated in the game precisely. The fact that EA obtained licenses to utilize the copyrighted items in NCAA Football '11 not only serves as direct evidence that there is just one way to accurately express each of the aforementioned components, but that EA acknowledges and accepts that fact as well.

Granting EA copyright over those expressions would confer a monopoly over the idea of an authentic college football video game,²³¹ and prevent others from creating a different authentic college football game if they obtained the necessary licenses. Consequently, the merger doctrine applies, precluding copyright protection in the vast majority of NCAA Football '11, and voiding EA's First Amendment argument. Implicit

229. See *Thornton v. J Jargon Co.*, 580 F. Supp. 2d 1261, 1273 (M.D. Fla. 2008).

230. See 4 Melville B. Nimmer & David Nimmer, *NIMMER ON COPYRIGHT* §13.03(B)(3) (1998).

231. *Id.*

within the merger doctrine is the understanding that anything inside its realm is by association not creative, at least in the sense necessary to obtain copyright protection. Thus, since the merger doctrine prevents the core of NCAA Football '11 from being original and the transformative use argument employed by EA hinges on the theory that the game's athlete-avatars are intensely creative, the First Amendment argument must fail.

Stripping away all the uncopyrightable elements of NCAA Football '11 (i.e. every part of the game covered by a license, such as the ESPN integration package, the BCS system, each NCAA team and athletic conference, and the teams' logo(s), school colors, uniforms (helmets, jerseys, cleats, wristbands, etc.), rituals and traditions, fight songs, and mascot(s)),²³² all that is left is the naked avatars EA created.²³³ The naked athlete-avatars, however, cannot be considered original or creative because their features infringe on the NCAA athletes' rights of publicity. As Keller points out in his complaint, "with rare exception, virtually every real-life Division I football [player] . . . in the NCAA has a corresponding player in Electronic Arts' games with the same jersey number, and virtually identical height, weight build, and home state."²³⁴ For example, Keller highlights the characteristics of player number 6 on the Kent State Golden Flashes in NCAA Football '09. This avatar-player, the Flashes' starting running back, has the exact same traits as the team's actual starting running back from that season, Eugene Jarvis; both are 5'5", 170-pound African American red-shirt juniors from Pennsylvania.²³⁵ Athlete-avatars in NCAA Football '11 also have virtually identical physical attributes, statistics, and even movements as their real life counterparts. One example is Andrew Luck, the starting quarterback for the Stanford Cardinal. Luck wears number 12 and is a 6'4", 235-pound Caucasian junior.²³⁶ In the video game, the starting quarterback for Stanford wears the exact same number and possesses the exact same physical features as Luck, except that the athlete-avatar is one pound lighter.²³⁷ Another example is Derek Dimke, who is the kicker for the Illinois Fighting Illini. Dimke wears number 13 and is a 6'0", 180-pound Caucasian junior.²³⁸ The kicker for Illinois in NCAA Football '11 not only wears the same number as Dimke, but possesses the exact same physical attributes.²³⁹ Furthermore, as previously mentioned, the

232. These are the parts of the game that qualify as ideas, facts, *scènes à faire*, or expressions of ideas that can only be conveyed in an extremely limited number of ways or inextricably merge with an idea.

233. EA's NCAA Football video games contain several different genres of avatars, including, but not limited to, ones for coaches, fans, and athletes.

234. Class Action Complaint at 4, *Keller v. Elec. Arts, Inc.*, No. 09-1967 (N.D. Cal. May 5, 2009). Keller also sheds light on the fact that many of the athlete-avatars in the games have the same skin tone, hair color, and even hairstyle as their real-life counterparts. *Id.*

235. *Id.* at 6. Keller also notes that since Jarvis "is unusually small for a college football player . . . one would expect a randomly generated virtual running back for the Golden Flashes to be somewhat dissimilar to [him]." *Id.*

236. *Andrew Luck Player Profile*, STANFORD CARDINAL ATHLETICS, http://www.gostanford.com/sports/m-footbl/mtt/luck_andrew00.html (last visited Feb. 11, 2011).

237. *NCAA Football 11 (XBox 360) Screenshot No. 153*, OPERATION SPORTS (July 9, 2010), <http://www.operation-sports.com/media/663/ncaa-football-11/?page=28>.

238. *Derek Dimke Player Profile*, ILLINOIS FIGHTING ILLINI ATHLETICS, http://www.fightingillini.com/sports/m-footbl/mtt/dimke_derek00.html (last visited Feb. 11, 2011).

239. *NCAA Football 11 (XBox 360) Screenshot No. 208*, OPERATION SPORTS (July 9, 2010), <http://www.operation-sports.com/media/663/ncaa-football-11/?page=23>. Generally, athlete-avatars, whose real-life counterparts are not well known publicly, have the exact same traits as their real-life counterparts. On the other hand, the characteristics of the athlete-avatars, whose real life counterparts are well known, may be slightly different. For example, Blaine Gabbert, who is the starting quarterback for Missouri, and Jake Locker, who is the starting quarterback for

EA Locker feature embedded within the NCAA Football series provides game players with a way to download the actual rosters for each collegiate team. In several of the annual releases, EA even designed the game so that the announcers would refer to the players by their actual names when the real rosters were downloaded or manually inputted.²⁴⁰ Although EA disabled that feature in NCAA Football '11, the fact that they (1) allowed the commentators to pre-record the names, (2) integrated the recordings into the game, and (3) subsequently removed the feature following Keller's lawsuit being filed, is indicative of EA's true intentions regarding the players' identities and suggests EA knew, at the very least, they were violating the athletes' publicity rights.²⁴¹ After factoring out the uncopyrightable elements, and taking into account the EA Locker system, the name recognition feature, and the messages conveyed in the video game's commercials and by EA's executives and employees, an ordinary observer would easily conclude that the "total concept and feel" of the athlete-avatars is substantially similar to their real-life counterparts.²⁴² As a result, NCAA Football '11, as well as every other release of the NCAA Football series, is not sufficiently original to acquire copyright protection, thus precluding the video game from being transformative, and causing EA's First Amendment argument to fail.

V. CONCLUSION

EA argues that the First Amendment protects their NCAA Football video games from Keller's right of publicity allegations. Scrutinizing the video games under copyright law, however, reveals that their argument must fail. While copyright law prohibits EA's NCAA Football video games from being precisely duplicated, the amount of protection afforded to each version's individual components is extremely limited. Consequently, EA's First Amendment defense must fail.

EA obtains licenses from each athletic conference and collegiate team, the NCAA, ESPN, and even apparel sponsors (Adidas, Nike, Under Armor, etc.) specifically so it can reproduce copyrighted material in the video games. Unless EA substantially alters the form of an item it replicates under a license, effectively transforming the item into something different, the copyright in it belongs solely to the licensor. Since EA's goal is to replicate every aspect of college football as accurately as possible, there is no attempt to transform the licensed items; they simply transfer them to a new medium without any creativity.

Washington, are both projected to be top draft picks in the 2011 NFL Draft. The quarterback-avatars for Missouri and Washington in NCAA Football '11 have the exact same characteristics as Gabbert and Locker, except that the avatars' weights are slightly different; the quarterback-avatar for Missouri weighs five pounds more than Gabbert, while the quarterback-avatar for Washington weighs four pounds less than Locker. *Compare NCAA Football 11 (XBox 360) Screenshot No. 352*, OPERATION SPORTS (July 9, 2010), <http://www.operationsports.com/media/663/ncaa-football-11/?page=8>, and *Jake Locker Player Profile*, WASHINGTON HUSKIES ATHLETICS, http://www.gohuskies.com/sports/m-footbl/mtt/locker_jake01.html (last visited Feb. 11, 2011); *NCAA Football 11 (XBox 360) Screenshot No. 185*, OPERATION SPORTS (July 9, 2010), <http://www.operationsports.com/media/663/ncaa-football-11/?page=25>, and *Blaine Gabbert Player Profile*, MISSOURI TIGERS ATHLETICS, http://www.mutigers.com/sports/m-footbl/mtt/gabbert_blaine00.html (last visited Feb. 11, 2011).

240. See discussion, *supra* Section I(B)(4).

241. The most incriminating part of the commentators saying the players' actual names is that the video game would not recognize/say them if they were not spelled the exact same way the real football players spelled them. At the same time, the video game would recognize and say the names of players that were difficult to pronounce without any issue.

242. See *Interactive Network v. NTN Commc'ns*, 875 F. Supp. 1398, 1404 (N.D. Cal. 1995).

Accordingly, EA does not own a copyright in the individual components of the games, and their First Amendment argument must fail, because the games cannot qualify as transformative works.

Even if the lack of copyright in the licensed items is put aside, the NCAA Football video games are not sufficiently creative to garner copyright protection. Due to the idea/expression dichotomy, the idea of an authentic college football video game is not copyrightable, which means that EA cannot prevent anyone else from creating a competing game. Furthermore, every facet of the NCAA Football video games, including the teams/players, referees, stadiums, fans, cheerleaders, and playbooks, is considered “stock” in terms of college football, and, as a result, is not copyrightable as *scènes à faire*. The merger doctrine also precludes the licensed items in the NCAA Football video games from receiving copyright protection, because there is only one way to express the components of college football authentically. In other words, there is only one way that the stadiums, uniforms, logos, and traditions can be expressed, which is the precise reason EA obtained the licenses in the first place. Filtering out all of the uncopyrightable elements, an ordinary observer would find that the “total concept and feel” of the athlete-avatars in the video games is substantially similar to their real-life counterparts. Therefore, since copyright law principles prevent the individual pieces of the NCAA Football video games from qualifying as original, and a significant part of the transformative use argument rests on the theory that the games are intensely creative, EA’s First Amendment argument must fail.

Termination Rights: An In-Depth Look at Looming Issues Under the Copyright Act of 1976

SEAN STOLPER

It is the hallmark of any sale, assignment, or perpetual license that the grant transfers an indefinite and uninterrupted exercise of certain rights. American copyright law, however, has often been in conflict with this position, limiting an author's ability to convey, and an assignee's right to retain, an interest for the entire term of copyright. As early as 1790, this was codified in statute with the creation of two distinct terms of copyright in a single work. Subsequent acts and numerous judicial decisions maintained the status quo, interpreting each term as a separate estate, thus precluding the disposition of the renewal term prior to its vesting. With the passage of the 1976 Act, Congress abrogated the two-term structure of copyright and replaced it with a fixed unitary term of federal protection. Although this enabled authors to control their works for the maximum duration of copyright and, as a corollary, assign all rights in their works for the entire term of protection, the Act did not guarantee assignees and licensees an unfettered interest in the conveyed rights. Rather, the Act gave authors and their heirs an inalienable right to terminate any grant of a transfer or license during a specified window. In an effort to provide a clearer understanding of this right, this article examines sections 203(b), 304(c), and 304(d) of the Copyright Act of 1976, highlighting their core components, application to various works, and primary limitations.

I. INTRODUCTION

In 1955, Seymour Bricker wrote, “no phase of the copyright law has been of such deep concern to the creators of literary and artistic property, to the users of such property, and to the public at large, as the matter of the duration of protection.”¹ At the time of Bricker’s writing, copyright protection endured for a period of twenty-eight years with a single renewal term of an additional twenty-eight years;² a system intended to permit “the author, originally in a poor bargaining position, to renegotiate the terms of the grant once the value of the work ha[d] been tested.”³

Congress ultimately abrogated the two-term structure in 1976, replacing it with a single term of the author’s life plus fifty years.⁴ Indicating a paradigm shift in American copyright law, the single term benefited authors by eliminating many of the highly technical requirements that had previously existed, while simultaneously providing a certainty of rights to transferees throughout the entire duration of copyright. However, as part of the 1976 Act, Congress also included two provisions that gave authors and their heirs an inalienable right to terminate any grant of a transfer or license.⁵ While advantageous to creators, these provisions are, arguably, disconcerting to assignees and licensees who operate under the false premise that a perpetual grant provides perpetual rights.⁶

Whereas persuasive arguments exist for and against the merits of statutory termination, this article will avoid discussion of the rationale for such rights and will instead examine the application and effect of statutory termination on the various stakeholders. More critically, this article will analyze the extent to which a copyright interest can be eroded through statutory interference. However, before engaging in an examination of the law and its application, the reader should note that the provisions of the U.S. Copyright Act, including duration and termination, apply exclusively to the U.S. interest in a copyrighted work and have no extra-territorial application.⁷

II. COPYRIGHT TERM

Although the 1976 Act, effective as of January 1, 1978,⁸ established a single duration for new works, it also created a complex patchwork of terms for pre-existing works.⁹ Accordingly, an analysis of the duration of protection typically requires an investigation into three key factors, namely: the date a work was created; whether the work was published; and, whether the work was authored by an identifiable individual, an anonymous party, or a corporate entity.¹⁰ Since the pre- and post-1978 distinction and the identity of the author remain critical to termination rights, and because many people erroneously attach the single-term duration to all works, this article will briefly outline the various terms of copyright in an effort to clarify the applicable law.

A. WORKS EXISTING BEFORE JANUARY 1, 1978

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1. Seymour M. Bricker, *Renewal and Extension of Copyright*, 29 S. CAL. L. REV. 23, 23 (1955).
 2. Copyright Act of 1909, § 23 (repealed 1976).
 3. *Stewart v. Abend*, 495 U.S. 207, 218–19 (1990).
 4. 17 U.S.C. § 302(a) (1996), *amended by* Pub. L. No. 105-298, § 102(b)(1) (1998).
 5. 17 U.S.C. §§ 203(a), 304(c) (2006). Section 304(d) was subsequently added to the Act by Pub. L. No. 105-298(d)(1)(D)(1998).
 6. See discussion *infra* Part III.
 7. *Subafilms, Ltd. v. MGM-Pathe Commc'ns Co.*, 24 F.3d 1088, 1094 (9th Cir. 1994).
 8. 17 U.S.C. § 301(a) (2006).
 9. See discussion *infra* Parts II.I, II.II.
 10. See discussion *infra* Parts II.I, II.II.

1. UNPUBLISHED WORKS

Under the 1909 Act, unpublished and unregistered works were protected by common law for a duration commencing upon their creation and enduring for a period determined by the applicable state law (typically in perpetuity) or until published.¹¹ Once published and/or registered,¹² a work lost its common law protection and either received federal copyright protection or fell into the public domain if such publication failed to comply with the statutory requirements¹³ (i.e., the public sale or distribution of the work with an included copyright notice consisting of the word “Copyright”, “Copr.”, or the symbol “©”, accompanied by the name of the holder and the year of publication¹⁴). In 1978, the bifurcated system of common law protection for unpublished works and federal protection for published works was eliminated and Congress introduced a unitary preemptive federal scheme that abolished all state and common law protection of works falling within the scope of the federal copyright law.¹⁵ Under the current scheme, unpublished works created before January 1, 1978, and not in the public domain as of that date, receive protection for: the life of author plus seventy years for individually authored works; the life of the last surviving author plus seventy years for joint works; or 120 years from creation for anonymous, pseudonymous, or corporate works; provided that “in no case shall term expire before December 31, 2002; and, if the work is published on or before December 31, 2002, the term of copyright shall not expire before December 31, 2047.”¹⁶

2. PUBLISHED WORKS

In contrast to unpublished works, which now enjoy a fixed term of federal protection regardless of the date of creation, published works remain subject to various standards of protection based on authorship and the date of publication. Generally, copyright in works published with proper notice before 1978 endures for a period of twenty-eight years, with an option for an additional twenty-eight-year renewal,¹⁷ subject to an extension of up to thirty-nine years. This standard rule, however, cannot be universally applied.

Through a series of amendments to the 1909 Act,¹⁸ cumulating with the passage of the 1976 Act, Congress extended the renewal term from twenty-eight years to forty-seven

11. Copyright Act of 1909, § 2; *Roy Export Co. Establishment of Vaduz v. CBS, Inc.*, 672 F.2d 1095, 1101 (2d Cir. 1982).

12. See Copyright Act of 1909, § 11 (affording statutory copyright protection to certain works “not reproduced for sale” (i.e., unpublished works) via registration and deposit).

13. *ABKCO Music, Inc. v. LaVere*, 217 F.3d 684, 688 (9th Cir. 2000); *Roy Export Co. Establishment of Vaduz*, 672 F.2d at 1101, n. 13 (“Section 12’ registration extinguishes common-law rights . . .”).

14. Copyright Act of 1909, § 18.

15. 17 U.S.C. § 301 (2006). Federal copyright did not protect sound recordings until February 15, 1972. *Id.* at § 301(c). As a result, all sound recordings made prior to February 15, 1972 remain protected by state and common law until federal preemption on February 15, 2067. *Id.*

16. 17 U.S.C. §§ 302(a)–(c), 303(a) (2006).

17. Copyright Act of 1909, § 23 (noting that the renewal window for works first published between 1909 and 1950 is a one-year period beginning on the twenty-seventh year of the original registration); 17 U.S.C. § 305 (1996) (noting that the renewal period for works first published between 1950 and 1978 is a one-year period beginning on December 31 of the twenty-seventh year of the original registration).

18. See Joint Resolution, Extending the Duration of Copyright Protection in Certain Cases, Pub. L. Nos. 87-668, 76 Stat. 555 (1962); 89-142, 79 Stat. 581 (1965); 90-141, 81 Stat. 464 (1967); 90-416, 82 Stat. 397 (1968); 91-147, 83 Stat. 360 (1969); 91-555, 84 Stat. 1441 (1970); 92-170, 85 Stat. 490 (1971); 92-566, 86 Stat. 1181 (1972); 93-573, 88 Stat. 1873 (1974).

years.¹⁹ Later, in 1998, Congress again extended the copyright term in all protected works for an additional twenty years, creating a sixty-seven-year renewal term.²⁰ However, the incorporation of additional terms to a particular work and the ultimate duration of protection depend upon the date of original publication, among other factors.²¹ The complexity and legacy of the 1909 Act, resulting in the disparate treatment afforded to works published before 1978, is best illustrated by the following three scenarios: works published on or before January 1, 1923; works published between 1923 and 1963; and works published between 1964 and December 31, 1977.

First, works published with notice on or before January 1, 1923 received initial protection for twenty-eight years with a single twenty-eight-year renewal term.²² In 1976, Congress expanded the renewal term to forty-seven years for works subsisting in their renewal period between December 31, 1976 and December 31, 1977 and, as a result, automatically increased the total copyright duration from fifty-six years to seventy-five years.²³ Applied to works published in 1922, the twenty-eight-year renewal term subsisted in 1977, thus subjecting such works to the nineteen-year extension and extending the total copyright protection to December 31, 1997. Since the Sonny Bono Copyright Term Extension Act (“CTEA”) took effect on October 27, 1998, works that entered the public domain in 1997 did not benefit from the twenty-year extension provided therein.²⁴ Accordingly, copyright in works published on or before January 1, 1923 irrevocably expired on December 31, 1997.²⁵

Second, works published with notice between January 1, 1923 and December 31, 1963 are eligible for up to ninety-five years of protection.²⁶ As with the pre-1923 copyrights, these works received initial protection for twenty-eight years, with a twenty-eight-year renewal term.²⁷ In addition, they also benefited from both the nineteen-year extension created by the 1976 Act and the twenty-year extension created by the CTEA.²⁸ However, failure to timely renew upon the expiration of the first term irrevocably moved these works into the public domain.²⁹ This important factor was not lost on the publishers

19. Copyright Act of 1976, Pub. L. No. 102-307, 106 Stat. 264 (codified as amended at 17 U.S.C. § 304(a)(1996)).

20. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

21. See Kenneth D. Crews, *Copyright Duration and the Progressive Degeneration of a Constitutional Doctrine*, 55 SYRACUSE L. REV. 189, 220 (2005) (“[D]etermining the term of copyright protection for pre-1978 works depends . . . on isolating facts relating to the date of publication.”).

22. Copyright Act of 1909, § 23.

23. 17 U.S.C. § 304(b) (1996), amended by Pub. L. No. 102-307, § 102(a), (d) (1998) (“The duration of any copyright, the renewal term of which is subsisting at any time between December 31, 1976, and December 31, 1977, inclusive, or for which renewal registration is made between December 31, 1976, and December 31, 1977, inclusive, is extended to endure for a term of seventy-five years from the date copyright was originally secured.”).

24. 17 U.S.C. § 304(b) (2006) (“Any copyright still in its renewal term at the time that the Sonny Bono Copyright Term Extension Act becomes effective shall have a copyright term of 95 years from the date copyright was originally secured.”) (emphasis added).

25. See *id.*

26. See Copyright Act of 1909, § 23; 17 U.S.C. § 304(b) (1996), amended by Pub. L. No. 105-298, 112 Stat. 2827, § 102(b)(1) (1998); 17 U.S.C. § 304(b) (2006).

27. Copyright Act of 1909, § 23.

28. See Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827, § 102(b)(3), (d)(1) (increasing fifty-six-year term to seventy-five years in the case of copyrights subsisting in both their first and their renewal terms and expanding copyrights in their renewal terms to 95 years from the date the copyright was originally secured).

29. 17 U.S.C. § 304(a)(4)(A) (2006).

of “Time Is On My Side.” Although made famous by the Rolling Stones in 1964³⁰, the composition was written by Jerry Ragovoy (p/k/a Norman Meade) and published by Rittenhouse Music & Maygar Music in 1963.³¹ There, copyright in the composition was not timely renewed and, as a result, the U.S. interest in the work fell into the public domain at the end of 1991.³² A similar fate befell the producers of the 1963 John Wayne film, *McLintock!*, the copyright holder, Batjac Productions, Inc., registered the film for federal copyright protection in 1963, but failed to renew.³³ The lapse in renewal forfeited Batjac’s copyright in *McLintock!* and the film entered the public domain at the expiration of the initial term.³⁴ While these cases provide two high-profile examples of copyright forfeiture through non-renewal, this outcome was far from atypical. In the fiscal year 1959, for example, fewer than fifteen percent of copyrights registered in 1931 and 1932 were renewed.³⁵ Similarly, records for 1975 and 1990 show estimated³⁶ renewal rates of approximately thirteen percent³⁷ and twenty-two percent³⁸ for 1948 and 1962 copyrights, respectively.

Finally, works published with notice between January 1, 1964 and December 31, 1977 automatically receive ninety-five years of protection. This is a result of both the Copyright Renewal Act (“CRA”), which amended § 304 of the 1976 Act by eliminating the renewal requirement,³⁹ and the term extension provided by the CTEA.⁴⁰ With an effective date of June 26, 1992, the CRA applied prospectively to works registered on or after January 1, 1964 and on or before December 31, 1977, for which copyright subsisted through the end of 1992.⁴¹ Although this amendment eliminated the registration of renewal requirement as a condition for copyright protection, it did not merge the initial term with the renewal and extension terms.⁴² Accordingly, an effective assignment of the renewal interest made during the initial term required that the author at least survive the filing date of the renewal registration.⁴³

30. See The Rolling Stones—Chart History, BILLBOARD, <http://www.billboard.com/artist/the-rolling-stones/chart-history/5556#/artist/the-rolling-stones/chart-history/5556> (showing that “Time Is On My Side” peaked at number 6 on Oct. 17, 1964).

31. *Before the Rolling Stones, Irma Thomas: “Time Is On My Side,”* ROCKAEOLOGY (Sept. 23, 2011), <http://rockaeology.com/2011/09/22/before-the-rolling-stones-irma-franklin-time-is-on-my-side.aspx>.

32. TOM NICHOLS, THEY NEVER RENEWED: SONGS YOU NEVER DREAMED WERE IN THE PUBLIC DOMAIN (The BZ/Rights Stuff, Inc. 2010).

33. *Batjac Prods., Inc. v. GoodTimes Home Video Corp.*, 160 F.3d 1223, 1225 (9th Cir. 1998).

34. *Id.*

35. BARBARA A. RINGER, STUDY NO. 31: RENEWAL OF COPYRIGHT, at 223 (1960), *reprinted in* STUDIES PREPARED FOR THE SUBCOMM. ON PATENTS, TRADEMARKS, AND COPYRIGHTS OF THE COMM. ON THE JUDICIARY, 86TH CONG., at 123 (1961).

36. The referenced reports run through the fiscal year, not calendar year, and as a result do not reflect registrations and renewals crossing into the next year. As such, the percentages are merely an estimation based on renewals during the applicable window.

37. See LIBRARY OF CONG., FIFTY-SECOND ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS, at 7 (1950) (listing 222,305 copyrights as registered in 1948); LIBRARY OF CONG., 80TH ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS, at 32 (1978) (listing 28,202 copyright renewals in 1975).

38. See LIBRARY OF CONG., SIXTY-SIXTH ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS, at 16 (1964) (listing 235,502 copyrights as registered in 1962); LIBRARY OF CONG., 93RD ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS, at 38 (1991) (listing 51,834 copyright renewals in 1990).

39. Copyright Amendments Act of 1992, Pub. L. No. 102-307, 106 Stat. 264, § 102.

40. 17 U.S.C. § 304(b) (2006).

41. Copyright Amendments Act of 1992, Pub. L. No. 102-307, 106 Stat. 264, § 102(g)(2).

42. *Id.* § 102.

43. See *Dimensional Music Publ’g, L.L.C. v. Kersey*, 435 F. Supp. 2d 452, 459 (E.D. Pa. 2006); see also *Roger Miller Music v. Sony*, 2012 U.S. App. LEXIS 3472 (6th Cir.); but see *Venegas-Hernandez v. Peer*, 283 F. Supp. 2d 491, 499 (D.P.R. 2002) (holding that an “author may assign his

As illustrated above, the key dates and copyright durations for works created before 1978 are as follows: (a) unpublished works created before 1978 are protected for the life of the author plus seventy years for natural persons or 120 years from creation for anonymous, pseudonymous, or corporate works; (b) works published before 1923 were protected for a maximum of seventy-five years and are now in the public domain; (c) works published between 1924 and 1963 are protected for an initial term of twenty-eight years with a renewal term of sixty-seven years (total of ninety-five years); and (d) works published between 1964 and 1977 are automatically protected for ninety-five years.

B. WORKS CREATED AFTER JANUARY 1, 1978

Abolishing the two-term system of notice and publication enshrined in the 1909 Act, the 1976 Act established a term of protection commencing upon the creation and fixation of a work to a tangible medium.⁴⁴ As the law exists today, works created by natural persons enjoy protection for the life of the author plus seventy years, while anonymous, pseudonymous, and corporate works receive protection for a duration consisting of the earlier of ninety-five years from publication or 120 years from creation.⁴⁵

On the surface, in addition to simplifying the copyright process, the current law seemingly provides for a longer term of protection than was afforded to works published under the 1909 Act. However, in practice, many pre-1978 copyrights endure for a period exceeding seventy years p.m.a.⁴⁶ For example, a work published in 1975 remains protected until December 31, 2070 (i.e., ninety-five years following publication),⁴⁷ but copyright in a work created by the same author in 1980, who later died in 1985, will expire on December 31, 2055. As such, any analysis of a work's copyright status must consider all facts as opposed to relying solely on the normative "life plus seventy" calculation.

Tantamount in importance to the unitary term and the substitution of creation for publication as the *sine qua non* for protection, the 1976 Act, as amended in 1988, also removed the formalities associated with proper notice.⁴⁸ This shift in long-standing policy resulted from the U.S. ascension to the Berne Convention in 1988 and the treaty's subsequent implemation into law on March 1, 1989, which amended § 401 by making notice optional rather than mandatory.⁴⁹ Thus, with the exception of works created between January 1, 1978 and March 1, 1989, all otherwise copyrightable material created after 1978 is protected for the duration set forth in § 302 of the 1976 Act.⁵⁰ Works created between January 1, 1978 and March 1, 1989, however, remain subject to the requirements of the original version of § 401, which reads:

"GENERAL REQUIREMENT.—Whenever a work protected under this title is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section *shall be* placed on

interest in the copyright renewal term during its original term, but the assignment is valid only if the author is alive at the start of the renewal term") (citing *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373, 374–75).

44. 17 U.S.C. § 102(a) (2006).

45. 17 U.S.C. § 302(a)–(c) (2006).

46. *Post mortem auctoris* (after author's death).

47. 17 U.S.C. § 304(b) (2006).

48. See Berne Convention Implementation Act of 1988 § 7, Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended at 17 U.S.C. §§ 401–406, 504 (2006)).

49. *Id.* § 7(a)(2)–(3) ("[B]y striking out 'shall be placed on all' and inserting in lieu thereof 'may be placed on'; 'by striking out 'The notice appearing on the copies' and inserting in lieu thereof 'If notice appears on the copies, it . . .'"").

50. *Id.*

all publicly distributed copies from which the work can be visually perceived, either directly or with the aid of a machine or device.”⁵¹

Despite the strict rule set forth in the original iteration of § 401(a), a party may cure any failure to include notice via registration of the work within five years of publication.⁵² As such, while compliance with the provision presents an administrative burden, noncompliance is not necessarily fatal to the continued protection of a work.

Overall, the landscape of copyright in the wake of the 1976 Act and subsequent amendments revealed a system dissimilar to any prior federal scheme. Most notably, authors need no longer comply with the formalities of publication, notice, and renewal that carried over from the first federal copyright act in 1790.⁵³ Instead, authors now receive the protections of copyright upon the creation and fixation of an original work, which endures for a single, contiguous term.⁵⁴ Although limited formalities remain, such as the notice requirement for certain works⁵⁵ and the requirement of registration as a pre-condition for infringement claims,⁵⁶ these formalities do not serve to restrict or otherwise limit the duration or scope of copyright.

Absent any genuine limitation on protection, such as renewal or notice, authors and their heirs may confidently exploit their works indefinitely and, as a corollary, assignees and licensees of such works are rewarded with the opportunity to negotiate once for the perpetual rights therein. It is the latter issue that guided Congress to include a right of termination, a right “intended to relieve authors of the consequences of ill-advised and unremunerative grants that had been made before the author had a fair opportunity to appreciate the true value of his work product.”⁵⁷ The following section examines this right, providing a digestible overview of the statutory framework and prevailing case law.

III. TERMINATION RIGHT

It is the hallmark of any sale, assignment, or perpetual license that the grant transfers an indefinite and uninterrupted exercise of certain rights. In the context of copyright, this was firmly established in *Fred Fisher Music Co. v. M. Witmark & Sons*, where the Supreme Court held that a grant of both the initial term and the renewal term under the 1909 Act conveyed rights for the entire duration of copyright.⁵⁸ Although in direct conflict with a rational interpretation of the 1909 Act, the two-term scheme, and the concept of a renewal as a “new estate,”⁵⁹ this case acknowledged the inherent flaws in

51. Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541, § 401(a) (codified as amended at 17 U.S.C. § 401(a) (1996)) (emphasis added).

52. 17 U.S.C. § 405(a)(2) (2006).

53. See *Eldred v. Ashcroft*, 537 U.S. 186, 195 (2003) (discussing congressional alteration of the method used to compute federal copyright terms).

54. See Copyright Renewal Act of 1992, Pub. L. No. 102-307, 106 Stat. 264 (codified as amended at 17 U.S.C. §§ 101, 304, 408–409, 708 (2006)).

55. Act of Oct. 19, 1976 § 401.

56. 17 U.S.C. § 411(a) (2006).

57. *Mills Music, Inc. v. Snyder*, 469 U.S. 153, 172–73 (1985); see also H.R. Rep. No. 94-1476, at 79 (1976).

58. *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643, 657–58 (1943). There, the author granted certain rights in both the initial term and renewal term of his work. The grant was made during the initial term and the author survived into the renewal term. In contrast, if the author dies prior to the expiry of the initial term, the beneficiaries are entitled to the renewal rights and any agreement made by the author to a third party granting such rights in the renewal term is unenforceable against the beneficiaries. *Stewart v. Abend*, 495 U.S. 207, 251 (1990); *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373, 375 (1960).

59. *Fox Film Corp. v. Knowles*, 261 U.S. 326, 329 (1923).

limiting an author's ability to convey an entire interest in copyright during the author's lifetime.⁶⁰ Despite this conflict, however, *Fred Fisher Music* controlled until the passage of the 1976 Act and the codification of an inalienable termination right.⁶¹

Pursuant to the 1976 Act, any grant, transfer, or license by an author is now terminable thirty-five years following the execution of such grant⁶² or fifty-six years from the date copyright was originally secured.⁶³ As a consequence, the efficacy of an author's attempt to convey an entire interest is nullified. Logically, this presents an issue of genuine concern to anyone relying on the terms of an assignment or perpetual license to actually transfer the expected rights. For example, as of 2015, a novelist may terminate the U.S. interest in rights assigned to a publisher in 1980. Likewise, as of 2016, a playwright may terminate the U.S. portion of a perpetual license to perform a play first published in 1960. These are but two of countless scenarios that will likely arise under the current scheme. In an effort to further illustrate the impact of the law on the various stakeholders, the following section outlines the application of the relevant statutory provisions and the primary exceptions to the right of termination.

B. SECTION 203—GRANTS EXECUTED AFTER JANUARY 1, 1978

Maintaining a distinction between pre and post-1978 copyrights, the 1976 Act provides two primary mechanisms for termination: § 203, which applies to grants executed after 1978; and §§ 304(c)(d), applicable to copyrights secured and grants executed prior to 1978. Looking to the language § 203(a), which reads, “[i]n the case of any work other than a work made for hire, the exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, executed by the author on or after January 1, 1978, otherwise than by will, is subject to termination under the following conditions,” the provision has five main elements.

Firstly, it applies solely to grants executed on or after January 1, 1978.⁶⁴ Although unsettled, this presumably includes works created after 1978, but made pursuant to agreements executed prior to 1978.⁶⁵ Secondly, the section provides for the termination of any exclusive or nonexclusive transfer or license or of any right under a copyright.⁶⁶ This includes licenses, assignments, conveyances, and other transfers as defined in § 101,⁶⁷ whether made impliedly or expressly and otherwise valid under § 204.⁶⁸ Thirdly, § 203(a) is confined to grants executed by the author. Accordingly, grants made by devisees or assignees are not subject to termination under this scheme. Fourthly, this provision specifically excludes transfers made by will.⁶⁹ As a result, only *inter vivos* transfers are terminable.⁷⁰ Finally, § 203(a) and its companion provisions do not apply to works made

60. *Fred Fisher Music*, 318 U.S. at 659 (“If an author cannot make an effective assignment of his renewal, it may be worthless to him when he is most in need.”).

61. 17 U.S.C. §§ 203, 304(c)–(d) (2006).

62. *Id.* § 203(a)(3).

63. *Id.* § 304(c)(3).

64. *Id.* § 203(a).

65. Email from Jane C. Ginsburg, Morton L. Janklow Professor of Literary and Artistic Property Law, Columbia Law School, to Maria Pallente, Assoc. Register, U.S. Copyright Office (Apr. 27, 2010), <http://www.copyright.gov/docs/termination/comments/2010/ginsburg-jane.pdf>.

66. 17 U.S.C. § 203(a) (2006).

67. 17 U.S.C. § 101 (2006).

68. *Korman v. HBC Florida, Inc.*, 182 F.3d 1291, 1294 (11th Cir. 1999).

69. 17 U.S.C. § 203(a) (2006).

70. *Id.* § 203(a).

for hire.⁷¹ Due to the importance of this last item, it is discussed in further detail in Part IV.II, below.

Where the conditions for termination under § 203(a) are satisfied (i.e., a grant for the transfer or license of a work, not created as a work for hire, and executed by the author after January 1, 1978), an author or statutory heir⁷² may terminate the grant any time during either a five-year period commencing thirty-five years from date of execution or a five-year period beginning on the earlier of thirty-five years from the date the work is published under the grant or forty years from the date of execution, if the grant covers the right of publication.⁷³ The former method of computation covers pre-existing and contemporaneously created works, while the latter, as an exception, covers circumstances such as “where years elapse between the signing of a publication contract and the eventual publication of the work.”⁷⁴

Applying the above calculations, and barring any changes to the law, parties can begin exercising their statutory termination right in 2013. To do so, however, requires compliance with the formal requirements set forth in § 203(a)(4). Pursuant to this provision, the terminating party or parties⁷⁵ must serve the grantee with written notice, between two and ten years before the nominated termination date, of the intent to terminate.⁷⁶ Such notice must be sent via first-class mail or personal service and include the following: a statement identifying under which provision termination is being made; the name and address of the grantee; the date of execution of the original grant or the date of publication of the work under the grant; the title of the work and the name(s) of the author(s); the original copyright registration number (if practicable); a brief statement identifying the grant to be terminated; the effective date of termination; a handwritten signature of the grantor or authorized representative; and the full name and address of that person, typewritten or printed legibly.⁷⁷ Lastly, a copy of the notice must be recorded at the Copyright Office prior to the effective termination date.⁷⁸

While the statute mandates compliance with the foregoing, certain missteps and oversights have nonetheless been deemed “harmless so as not to affect the validity of [a] termination notice.”⁷⁹ Under the circumstances of *Siegel v. Warner*, for example, the court held that a failure of the terminating party to “provide the ‘title,’ the ‘name of one author,’ ‘date copyright was originally secured,’ or the ‘original copyright registration number’” for certain works subject to termination was not fatal to the validity of the termination notice.⁸⁰

There, the terminating party, Siegel, served the grantee, Warner Bros., with notice of his intent to terminate previously granted rights in *Superman*.⁸¹ The termination notice, which spanned “546 pages and concern[ed] literally tens of thousands of *Superman* works published from 1938 to 1997,” omitted two weeks’ worth of comic strips published in 1939,

71. *Id.*

72. *Id.* § 203(a)(2).

73. *Id.* § 203(a)(3).

74. H.R. Rep. No. 94-1476, at 126 (1976).

75. See 17 U.S.C. § 203(a)(1) (2006) (“In the case of a grant executed by two or more authors of a joint work, termination of the grant may be effected by a majority of the authors who executed it; if any of such authors is dead, the termination interest of any such author may be exercised as a unit by the person or persons who . . . own and are entitled to exercise a total of more than one-half of that author’s interest.”) (emphasis added).

76. *Id.* § 203(a)(4)(A).

77. 37 C.F.R. § 201.10(b)(2) (2011).

78. *Id.* § 201.10(f)(6).

79. *Siegel v. Warner Bros. Ent. Inc.*, 690 F. Supp. 2d 1048, 1051 (C.D. Cal. 2009).

80. *Id.* at 1050, 1073.

81. *Id.* at 1051.

in which certain characters and elements were introduced.⁸² However, the notice included the following so-called “catch-all” phrase:

“[I]n addition to all the other works that were so identified by title, registration number, etc. . . . it also applied to: each and every work (in any medium whatsoever, whenever created) that includes or embodies any character, story element, or indicia reasonably associated with SUPERMAN or the SUPERMAN stories, such as, without limitation, Superman, Clark Kent, Lois Lane, Perry White, Jimmy Olsen, Superboy, Supergirl, Lana Lang, Lex Luthor, Mr. MXYZTPLK . . . Ma and Pa Kent, Steel, the planet Krypton, Kryptonite, Metropolis, Smallville, or the Daily Planet. Every reasonable effort has been made to find and list herein every such SUPERMAN-related work ever created. Nonetheless, if any such work has been omitted, such omission is unintentional and involuntary, and this Notice also applies to each and every such omitted work.”⁸³

In examining the intent of the termination and notice provisions, the court determined that Siegel’s failure to comply with the strict formalities of the regulation did not prevent Warner from having a “reasonable opportunity to identify the affected work[s].”⁸⁴ Consequently, the omissions were deemed “harmless errors” and insufficient to nullify the termination in grants to those works.⁸⁵ In contrast, *Burroughs v. Metro-Goldwyn-Mayer* held that the omission of five titles from a list of thirty-five works in a termination notice left the grantee’s interest in those five works intact, but did not repudiate the effectiveness of notice with respect to the properly listed titles.⁸⁶ Unlike *Siegel*, where the grantee had a reasonable opportunity to identify the unlisted works, the grantee in *Burroughs* had no such opportunity.⁸⁷

1. SECTION 203(A) CONTEXTUALIZED

As noted, the first available termination date under § 203(a) arises on January 1, 2013.⁸⁸ Accordingly, courts have not yet had an opportunity to opine on the exercise of an author’s, or heirs’, rights during the five-year period following thirty-five years from the executed grant or the date of publication. While several circuits have rendered decisions on this section, such decisions are limited in scope and have dealt primarily with the question of whether § 203 imposes a thirty-five-year minimum grant on licenses of an undefined term.⁸⁹ Absent existing case law, the following hypothetical illustrates the application of § 203(a) to a post-1978 grant.

82. *Id.* at 1050.

83. *Id.* at 1051.

84. *Siegel*, 690 F. Supp. 2d at 1069–70.

85. *Id.* at 1073.

86. *Burroughs v. Metro-Goldwyn-Mayer Inc.*, 491 F. Supp. 1320, 1326 (S.D.N.Y. 1980).

87. *Id.*

88. *See* 17 U.S.C. § 203(a) (2006) (“[T]he exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, executed by the author on or after January 1, 1978 . . . is subject to termination under the following conditions.”); *Id.* § 203(a)(3) (“Termination of the grant may be effected at any time during a period of five years beginning at the end of thirty-five years from the date of execution of the grant.”).

89. *See, e.g.*, *Korman v. HBC Florida, Inc.*, 182 F.3d 1291, 1294 (11th Cir. 1991) (holding that § 203 does not create a minimum term of thirty-five years to licenses of indefinite duration); *Walsh v. Rusk*, 172 F.3d 481, 484–85 (7th Cir. 1999) (holding that § 203 does not create a minimum term of 35

In this scenario, Joe “Big County” Smith composed and published his seminal hit *I’m The Next Big Thing* on February 15, 1980 and executed an assignment of all rights in and to the composition to Mid-West Publishing (“MWP”) for \$15,000.00 on March 15, 1981. The assignment specifically granted to MWP all rights in and to the composition, throughout the universe, in perpetuity. Exercising its rights under the assignment, MWP registered copyright in the work in its name and granted mechanical licenses to several record labels and synchronization licenses to multiple film and television production companies.

Here, despite the perpetual assignment, Big Country may terminate the grant to MWP anytime between March 15, 2016 and March 15, 2021, representing the five-year termination window commencing thirty-five years from the date of execution. If, for example, Big Country elects to terminate on March 15, 2020, he must serve and file notice between March 15, 2010 and March 15, 2018, representing a period no greater than ten years and no less than two years before the effective termination date. However, failure to serve notice by March 15, 2019 (i.e., two years before the last day to terminate) will result in the permanent forfeiture of Big Country’s statutory right to terminate the grant to MWP.

Assuming Big Country timely serves proper notice, he may terminate the grants specifically set forth in such notice with respect to the U.S. interest in the composition. Since the original assignment granted MWP universe-wide rights in and to the work, MWP retains its interest throughout the rest of the universe for the duration of copyright therein. Upon termination, the U.S. interests in the composition revert to Big Country and he may then assign, license, or otherwise transfer those rights. Notwithstanding the termination, authorized derivative works prepared under the terms of assignment (e.g., records embodying the composition pursuant to a mechanical license) remain unaffected and any post-termination income generated from such exploitation will be allocated pursuant to the terms of the assignment.⁹⁰

B. SECTION 304(C)—WORKS PUBLISHED OR REGISTERED BEFORE JANUARY 1, 1978

As distinguished from § 203(a), § 304(c) applies to grants executed before January 1, 1978 that transfer or convey rights to copyrights subsisting in their first or renewal term as of that date.⁹¹ As discussed above in II.I, copyright subsistence typically mandates compliance with the publication requirement set forth in the 1909 Act, which necessarily omits unpublished works from the scope of this provision.⁹² Further distinguishing § 304(c) from § 203(a), the former applies to grants made both by the author and any statutorily defined heirs,⁹³ while the latter applies exclusively to grants executed by the author. However, § 203(a) and § 304(c) share significant commonality: both provisions preserve the right of termination “notwithstanding any agreement to the contrary;”⁹⁴ both preclude the termination of grants made pursuant to a will; both require strict adherence to the notice of termination requirement clarified in 37 C.F.R. 201.10; and, both specifically carve out works made for hire from the purview of the termination right. Additionally, as discussed

years to licenses of indefinite duration); *Rano v. Sipa Press, Inc.*, 987 F.2d 580, 585–86 (9th Cir. 1993) (interpreting § 203 to create a minimum term of thirty-five years to licenses of indefinite duration).

90. See *infra* Part IV.III for a discussion of derivative works.

91. 17 U.S.C. § 304(c) (1976).

92. See 17 U.S.C. § 2 (1976), citing 1909 Act (explaining that unpublished and unregistered works were protected under common law).

93. *Id.* § 304(a).

94. *Id.* §§ 203(a)(5), 304(c)(5).

below in IV.III, neither section affects the grantee's right to continue exploiting certain derivative works.⁹⁵

As with § 203(a), the terminating party or parties⁹⁶ must serve notice to the grantee not less than two or more than ten years before the effective termination date.⁹⁷ However, here, the termination window is the later of: January 1, 1978; or, any time during a five-year period beginning at the end of fifty-six years from the date copyright was originally secured.⁹⁸ This effectively provides grantees with rights as would be provided by a perpetual grant under the 1909 Act (i.e., fifty-six years from the date of copyright). Since the extended terms created by the 1976 Act⁹⁹ represent a new estate,¹⁰⁰ § 304(c) gives authors an opportunity to recapture their interests and renegotiate for the rights in the new estate,¹⁰¹ effectively restoring the law to its pre-*Fred Fisher* status with respect to such extensions.

1. SECTION 304(C) APPLIED

Unlike termination under § 203(a), which has received limited judicial attention, § 304(c) has been the subject of several decisions over the past thirty years.¹⁰² Although the seminal cases addressing this provision examine highly nuanced issues, such as the phrases “utilized under the terms of the grant”¹⁰³ or “notwithstanding any agreement to the contrary,”¹⁰⁴ the cases serve to illustrate the section's application and complexity as a matter of background. For example, *Classic Media v. Mewborn* addressed the issue of whether a post-1978 grant extinguishes the § 304(c) termination right.¹⁰⁵ In answering that question, which is briefly discussed in Section IV, below, the court also provided a detailed examination of the provision's applicability to the termination of a grant in a literary work.¹⁰⁶

Classic Media v. Mewborn concerned the works of Eric Knight, who published *Lassie Come Home* as a short story in December 17, 1938, and later as a novel in 1940, licensing the television, film, and radio rights to LTI prior to his death in 1943.¹⁰⁷ As authorized heirs, Knight's widow and three daughters timely renewed the copyright in the story and the novel in 1965 and 1967, respectively.¹⁰⁸ On July 14, 1976, Knight's daughter, Mewborn, assigned her twenty-five percent interest in the short story and novel to LTI, granting all film, television, and radio rights to the works “throughout the world for the full period of the renewal copyrights in the work[s] and any further renewals or extensions

95. *Id.* §§ 203(b)(1), 304(c)(6)(A).

96. See 17 U.S.C. 304(c)(1) (stating that “In the case of a grant executed by one or more of the authors of the work, termination of the grant may be effected, to the extent of a particular author's share in the ownership of the renewal copyright, by the author who executed it or, if such author is dead, by the person or persons who . . . own and are entitled to exercise a total of more than one-half of that author's termination interest) (emphasis added).

97. 17 U.S.C. § 304(c)(4)(A) (1976).

98. *Id.* § 304(c)(3).

99. See *id.* § 304(b) (extending the duration of copyright to a term of seventy-five years from the date copyright was originally secured).

100. *Larry Spier, Inc. v. Bourne Co.*, 953 F.2d 774, 779 (2d Cir. 1992).

101. H.R. Rep. No. 94-1476, at 140, (1976).

102. 17 U.S.C. § 304(b) (1976).

103. *Mills Music, Inc. v. Snyder*, 469 U.S. 153 (1985).

104. *Classic Media v. Mewborn*, 532 F.3d 978, 983 (9th Cir. 2008).

105. *Id.* at 986.

106. *Id.* at 985-86.

107. *Id.* at 980.

108. *Id.*

thereof.”¹⁰⁹ LTI and Mewborn subsequently executed a new agreement on March 16, 1978, which granted identical rights with the addition of “ancillary rights such as merchandising, dramatic recording, and certain publishing rights.”¹¹⁰

Seeking to recapture her film, television, and radio rights effective as of May 1, 1998, Mewborn served notice of termination on LTI’s successor-in-interest, Classic Media, on April 12, 1996.¹¹¹ This complied with § 304(c), as the five-year window for termination of the short story and novel commenced in 1994 and 1996, respectively.¹¹² And, based on those dates, notice was effective if properly served anytime between 1984 and 1997 for the short story and between 1986 and 1999 for the novel (i.e., a period no earlier than ten years and no later than two years before the effective termination date).¹¹³

In an effort to prevent the termination, Classic Media argued that the March 16, 1978 grant superseded the July 14, 1976 assignment and thus extinguished Mewborn’s right of termination.¹¹⁴ Taking a contrary view, however, the court concluded that “Mewborn did not relinquish her termination right via the 1978 Assignment”¹¹⁵ and thus “validly terminated the rights she granted to LTI in the 1976 Assignment.”¹¹⁶ There, compliance with the formalities of § 304(c) enabled Mewborn to successfully recapture the U.S. interest in her twenty-five percent share of the rights granted via the 1976 Assignment despite the subsequent agreement.¹¹⁷

C. SECTION 304(D)—WORKS SUBSISTING IN THEIR RENEWAL TERM ON OCTOBER 27, 1998

Drafted in response to the CTEA, §304(d) accommodates works copyrighted before October 26, 1939¹¹⁸ and whose § 304(c) termination right expired without being exercised before the effective date of the CTEA, October 27, 1998.¹¹⁹ Like § 304(c), subsection (d) gives authors and their statutorily defined heirs the inalienable right to terminate pre-1978 grants of transfers or licenses of copyright. By its terms, § 304(d) is subject to 304(c)(1), (2), (4), (5), and (6).¹²⁰ As a result, grants made by will, works made for hire, and derivative works are excluded from the purview of termination under this section.¹²¹ Noticeably absent from the list of incorporated sub-sections, however, is (c)(3), which provides for a five-year window following fifty-six years from copyright to terminate a grant.¹²² In its place, § 304(d)(2) specifies that termination under subsection (d) may be effected at any time during a five-year period beginning at the end of seventy-five years

109. *Mewborn*, 532 F.3d at 980.

110. *Id.* at 980–81.

111. *Id.* at 981.

112. 17 U.S.C. § 304(c) (1976).

113. *Id.*

114. *Classic Media*, 532 F.3d 978.

115. *Id.* at 990.

116. *Id.* at 987.

117. *Classic Media*, 532 F.3d 978.

118. Notice of Termination, 67 Fed. Reg. 69,134-01 (proposed Nov. 15, 2002) (to be codified at 37 C.F.R. pt. 201). *See supra* Part III.II.

119. 17 U.S.C. § 304(d) (1976) (“In the case of any copyright other than a work made for hire, subsisting in its renewal term on the *effective date of the Sonny Bono Copyright Term Extension Act* for which the termination right provided in subsection (c) has *expired by such date*, where the author or owner of the termination right has not previously exercised such termination right”) (emphasis added). The Sonny Bono Copyright Term Extension Act (“CTEA”) is effective October 27, 1998. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

120. 17 U.S.C. § 304(d)(1) (1976).

121. 17 U.S.C. § 304(c) (1976).

122. *See* 17 U.S.C. § 304(d)(1) (1976) (excluding § 304(c)(3)); 17 U.S.C. § 304(c)(3) (1976).

from the date copyright was originally secured.¹²³ § 304(c)(4)(A) sets forth the notice window for works copyrighted between January 1, 1923 and October 26, 1939. Authors (and heirs) who properly renew the copyrights on their works may serve notice on grantees anytime between sixty-five and seventy-eight years from the date of copyright and recapture anytime between seventy-five and eighty years from the date of copyright.¹²⁴

1. HOW TERMINATION UNDER § 304(D) WORKS IN PRACTICE

Notwithstanding any changes to the law, copyright in works published or registered between January 1, 1923 and October 26, 1939 and properly renewed, will expire on December 31, 2018 and December 31, 2034, respectively.¹²⁵ This represents an initial term of twenty-eight years, a renewal term of twenty-eight years, the nineteen-year extension provided by § 304(a), and the twenty-year extension provided by the CTEA.¹²⁶ As noted, § 304(c)(3) enables authors and heirs to terminate pre-1978 grants fifty-six to sixty-one years following the copyright date.¹²⁷ Accordingly, grants executed before 1978, transferring rights in works first copyrighted on June 15, 1930, for example, were terminable anytime between June 15, 1986 and June 15, 1991.¹²⁸ If notice was not served by June 15, 1989 (i.e., two years before the end of the five-year window), the § 304(c) termination right expired and the authors and heirs lost the opportunity to “reap the benefits of the extended term” provided by the CTEA.¹²⁹ However, relying on § 304(d)(2), the authors and heirs in this example had a second opportunity to terminate anytime between June 15, 2005 and June 15, 2010, provided they served valid notice on the grantee between June 15, 1995 and June 15, 2008.¹³⁰

IV. EXCEPTIONS TO THE RIGHT OF TERMINATION

Despite the seemingly unfettered right of reversion, several limitations exist to prevent the effectuation of termination. These include judicially imposed restraints, implied limitations, and express legislative restrictions. Consistent with all other aspects of copyright law, however, the application of such limitations hinges on many factors and a nuanced reading of the controlling statute.

Evincing the judicially imposed restraints, *Milne v. Slesinger* held that a post-1978 agreement superseding a pre-1978 grant extinguishes the right to terminate the original grant.¹³¹ There, a statutory heir sought to recapture previously granted rights in the Winnie The Pooh stories first published between 1924 and 1928.¹³² The record showed that the author, A.A. Milne, granted limited perpetual rights¹³³ to a television producer and entrepreneur, Slesinger, in 1930.¹³⁴ Following the death of Milne, Slesinger transferred his rights to The Walt Disney Co. (“Disney”) in 1961, which simultaneously obtained

123. 17 U.S.C. § 304(d)(2) (1976).

124. 17 U.S.C. § 304(c)(4)(a) (1976).

125. 17 U.S.C. § 304(a) (1976).

126. *Id.*

127. 17 U.S.C. § 304(c)(3) (1976).

128. *Id.*

129. S. Rep. No. 104-315, at 22 (1996).

130. 17 U.S.C. § 304(d)(2) (1976).

131. *Milne v. Stephen Slesinger, Inc.*, 430 F.3d 1036 (9th Cir. 2005).

132. *Id.* at 1039 (“U.S. copyrights in the Pooh works were registered between 1924 and 1928, and renewed between 1952 and 1956”).

133. Having survived the renewal period, Milne’s grant effectively transferred rights for the entire duration of copyright.

134. *Milne*, 430 F.3d at 1039.

additional rights from Milne's heirs.¹³⁵ Upon the vesting of the heirs' § 304(c) termination rights,¹³⁶ Disney and the heirs renegotiated a new agreement in 1983, expressly acknowledging and superseding the 1930 and 1961 grants.¹³⁷ Nearly two decades later, Milne's granddaughter sought to recapture the rights under § 304(d), relying on a strict reading of the Act.¹³⁸ Despite § 304(c)(5) providing that a termination of a grant may be effected "notwithstanding any agreement to the contrary," the court held that the 1983 grant extinguished any future right of reversion.¹³⁹ This outcome hinged on three primary factors: first, the ambiguity plaguing the statutory language regarding "agreements to the contrary;"¹⁴⁰ second, the court's belief that the underlying policy considerations for statutory termination were met by the heirs' ability to negotiate more advantageous terms based on the value of the work;¹⁴¹ and, third, that the 1983 agreement terminated the previous grants, thus leaving no pre-1978 grant to terminate under § 304(d).¹⁴²

Adopting a consistent reading of §§ 304(c) and (d), *Penguin v. Steinbeck* held that a 1994 agreement, which superseded a 1938 agreement granting Viking Press publishing rights to John Steinbeck's notable works, extinguished the heir's statutory right to terminate the 1938 grant.¹⁴³ There, the parties executed the subsequent agreement under the specter of "threat of termination."¹⁴⁴ By electing to renegotiate rather than terminate, the heir exhausted the single opportunity provided by statute. According to the Second Circuit, the heir had already engaged in the very type of renegotiation intended by Congress.¹⁴⁵

By contrast, *Classic Media v. Mewborn* demonstrates that not all post-1978 agreements transferring rights to pre-1978 works relinquish or extinguish the termination right.¹⁴⁶ As distinguished from *Milne*, where the subsequent agreement was executed at a time when the heir could have exercised her termination right, Mewborn executed the later agreement several years before her termination right vested.¹⁴⁷ As a result, Mewborn, unlike Milne, was not presented with an immediate opportunity to either terminate or renegotiate.¹⁴⁸ Further, Mewborn, unlike Steinbeck,¹⁴⁹ did not intend for the subsequent agreement to revoke or replace (or even modify) the prior grant.¹⁵⁰ These factors distinguish *Mewborn* from both *Milne* and *Steinbeck* and evidence the highly nuanced nature of this judicially imposed limitation on the right of termination.¹⁵¹

Turning to the implied limitations, a claim of co-authorship by a grantee may serve to frustrate termination. Because § 203(a)(1) mandates consent from the majority of the authors who executed the initial grant, a music publisher, video producer, or record label

135. *Id.* at 1040.

136. 17 U.S.C. § 304(c)(3) (1976) (stating that the termination window for the 1924 copyrights opened in 1980 and closed in 1985, while the window for the 1928 copyrights opened in 1984 and closed in 1989).

137. *Milne*, 430 F.3d at 1040, 1044.

138. *Id.* at 1041.

139. 17 U.S.C. § 304(c)(5) (2006).

140. *Milne*, 430 F.3d at 1045.

141. *Id.* at 1046.

142. *Id.* at 1042–1043.

143. *Penguin Group USA v. Steinbeck*, 537 F.3d 193 (2d Cir. 2008).

144. *Id.* at 202.

145. *Id.*

146. *Classic Media v. Mewborn*, 532 F.3d 978 (9th Cir. 2008).

147. *Compare Milne*, 430 F.3d 1036, with *Classic Media*, 532 F.3d 978.

148. *Classic Media*, 532 F.3d at 988–89.

149. *Penguin Group*, 537 F.3d 193 (2d Cir. 2008).

150. *Classic Media*, 532 F.3d at 89.

151. *Classic Media*, 532 F.3d 978.

asserting joint-authorship could prevent termination.¹⁵² Likewise, § 304(c)(1), while not requiring majority consent of all authors, limits termination to the portion controlled by the terminating party.¹⁵³ In light of established precedent, which permits any co-owner to make a non-exclusive transfer of rights without the other owners' consent,¹⁵⁴ termination by one party would have limited impact on the overall rights in and to a work, thereby effectively neutering the terminating party's control of that work.¹⁵⁵

Reliance on this method, however, requires that all parties be regarded as joint-authors, not merely co-owners of the subject work.¹⁵⁶ All parties must contribute independently copyrightable elements¹⁵⁷ and "entertain in their minds the concept of joint authorship" such that they intend to be joint authors.¹⁵⁸ In the context of sound recordings, for example, courts have indicated that the contributions of an engineer¹⁵⁹ or a producer¹⁶⁰ may satisfy this requirement. To succeed in a claim of joint authorship, however, the contributor must provide more than mere direction, advice, or consultation—which will not "rise to the level necessary for a joint work."¹⁶¹ Accordingly, it is unlikely that a record label, through its employees (e.g., an A&R representative or executive producer), and absent a genuine and independently copyrightable contribution to the creation of a sound recording, would rise to the necessary level of a joint author. This corresponds with the policy that denies joint-authorship status to persons "who merely describe[] to an author what the commissioned work should do or look like."¹⁶²

While these examples illustrate judicial and implied limitations placed on the right of termination, the Copyright Act itself imposes two primary restrictions on an author's or heir's right to terminate: works made for hire and derivative works.

A. WORKS MADE FOR HIRE

Generally, authorship vests in the natural person who creates a work.¹⁶³ However, U.S. law recognizes the legal fiction known as "works made for hire," whereby an employer assumes both ownership and authorship in works created by certain employees.¹⁶⁴ Because §§ 203(a), 304(c), and 304(d) expressly exclude works made for hire from the right of statutory termination, the designation of a work as "made for hire" is paramount to any determination of rights in works created by employees and independent contractors.¹⁶⁵ Consistent with the analysis of copyright duration and termination, the pre- and post-1978 distinction remains intact with respect to the classification of works as "made for hire."¹⁶⁶

152. 17 U.S.C. § 203(a)(1) (1976).

153. *Id.* § 304(c)(1).

154. *Oddo v. Ries*, 743 F.2d 630, 632 (9th Cir. 1984).

155. *Id.*

156. 17 U.S.C. § 201(a) (1976) (noting that all joint authors are co-owners, but not all co-owners are joint-authors); *Davis v. Blige*, 505 F.3d 90, 98 (2d Cir. 2007); *Oddo*, 743 F.2d 630 (providing an example of co-ownership created by means other than joint authorship).

157. *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231 (9th Cir. 2000).

158. *Price v. Fox Ent. Group Inc.*, 473 F. Supp. 2d 446, 454 (S.D.N.Y. 2007) (quoting *Childress v. Taylor*, 945 F. 2d 500, 508 (2d Cir. 1991)).

159. *Diamond v. Gillis*, 357 F. Supp. 2d 1003, 1007 (E.D. Mich. 2005).

160. *Sebastian Music Group, Inc. v. Ayala-Rodriguez*, 594 F. Supp. 2d 176 (D.P.R. 2008); *JCW Invs., Inc. v. Novelty Inc.*, 289 F. Supp. 2d 1023 (N.D. Ill. 2003).

161. *Gaylord v. United States*, 595 F.3d 1364, 1372 (Fed.Cir. 2010) (quoting *S.O.S. Inc. v. Payday, Inc.*, 886 F.2d 1081, 1086 (9th Cir. 1989)).

162. *Id.*

163. *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

164. *Id.* § 201(b).

165. *See id.* §§ 203(a), 304(c), 304(d).

166. *See* 17 U.S.C. § 3 (1909); *See* 17 U.S.C. § 201 (1976).

The 1909 Act governs works created prior to January 1, 1978¹⁶⁷, while the 1976 Act controls post-1978 works.¹⁶⁸

1. THE 1909 ACT

The characterization of works created before January 1, 1978, as “made for hire” is determined in accordance with § 26 of the 1909 Copyright Act.¹⁶⁹ Although the act itself proffers no definition of the term, it provides that “the word author shall include an employer in the case of works made for hire.”¹⁷⁰ This ambiguity leads to the question of who or what qualifies as an “employer” for the purposes of the Act.

In the context of a traditional employer-employee relationship, the employer is deemed the author of the employee’s work, absent an agreement to the contrary, when the employee creates the work within the scope of his or her employment.¹⁷¹ Interpreting the 1909 Act, *Tobani v. Carl Fischer* considered a music publisher to be the statutory author of works created by a salaried composer employed to furnish certain compositions.¹⁷² There, Tobani prepared the works “pursuant to and in furtherance of” his employment, resulting in the employer obtaining authorship by virtue of the Act.¹⁷³ In contrast, *Shapiro v. Vogel* held a publisher not to be the author of a work created by an employee lyricist when the employee composed the work “as a special job assignment, outside the line of [his] regular duties.”¹⁷⁴ Similarly, in *Dolman v. Agee*, the court rejected a publisher’s claim of authorship in works created by an employee.¹⁷⁵ The employee, Shields, was hired as Head of A&R for Victor Talking Machine.¹⁷⁶ In addition to his primary duties, he composed music for Victor’s productions, including many Laurel and Hardy films.¹⁷⁷ Recognizing the distinction between A&R duties and composing services, the court considered the latter to be outside the “scope of Shield’s employment with Victor.”¹⁷⁸ Accordingly, Shields, rather than Victor, was deemed the author of the works despite Shields having created such works while employed by Victor.¹⁷⁹

167. 17 U.S.C. § 3 (1909). Here, the controlling factor is creation rather than publication. As the author, an employer has the right to publish works or withhold their publication; publish them with claim of copyright and obtain federal protection; or publish them without claim of copyright and dedicate them to the unrestricted use of the public. 17 U.S.C. § 1-2, 26 (1909) (revised to January 1, 1973); *Tobani v. Carl Fischer, Inc.*, 98 F.2d 57, 59–60 (2d Cir. 1938) (applying “the word ‘author’ shall include an employer in the case of works made for hire” from § 62 to entire Copyright Act of 1909).

168. *Martha Graham Sch. & Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance, Inc.*, 380 F.3d 624, 632–33 (2d Cir. 2004); *Magnuson v. Video Yesteryear*, 85 F.3d 1424, 1427 (9th Cir. 1996).

169. 17 U.S.C. § 26 (1909).

170. *Id.* (Note that from July 1, 1909 to July 29, 1947 this language was found in § 62 of the 1909 Act).

171. *Scherr v. Universal Match Corp.*, 417 F.2d 497, 500 (2d Cir. 1969) (citing *Sawyer v. Crowell Pub. Co.*, 46 F. Supp. 471, 472 (S.D.N.Y. 1942) *aff’d*, 142 F.2d 497 (2d Cir. 1944)).

172. *Tobani*, 98 F.2d at 58–59.

173. *Id.*

174. *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 221 F.2d 569, 570 (2d Cir. 1955).

175. *Dolman v. Agee*, 157 F.3d 708, 711–12 (9th Cir. 1998).

176. *Id.*

177. *Id.*

178. *Id.* at 713

179. *Id.*

With respect to commissioned works, the 1909 Act has been interpreted as establishing a presumption that title to copyright resides in the commissioning party.¹⁸⁰ Although first articulated in the 1910's,¹⁸¹ the principle was not fully developed until the mid-1960's.¹⁸² Prior to then, the presumption applied to limited circumstances such as photographer-patron¹⁸³ and artist-client¹⁸⁴ relationships. Extending the breadth of the work for hire doctrine, *Lin-Brook v. Gerlter* declared that:

[w]hen one person engages another, whether as employee or as an independent contractor, to produce a work of an artistic nature, that in the absence of an express contractual reservation of the copyright in the artist, the presumption arises that the mutual intent of the parties is that the title to the copyright shall be in the person at whose instance and expense the work is done.¹⁸⁵

In that case, Lin-Brook Hardware hired H.L. Baxter to illustrate art for a catalog.¹⁸⁶ Evidence showed that Lin-Brook assigned work to Baxter, but made no mention of a formal contract for services.¹⁸⁷ Absent any language indicating that Baxter would retain copyright, the court presumed that the parties intended for Lin-Brook to be regarded as the author.¹⁸⁸

Adopting the court's reasoning in *Lin-Brook*,¹⁸⁹ the Second Circuit held that the work for hire doctrine applies "whenever an employee's work is produced at the instance and expense of his employer," regardless of the relationship being characterized as that of employer or independent contractor.¹⁹⁰ Analogizing the photographer-patron relationship, in which ownership in a commissioned photograph is presumed to reside in the patron, the court reasoned, similarly, that copyright belongs to merchants who commission a newspaper to design advertisements.¹⁹¹ There, the merchants paid the newspaper a fee for both publishing ads and preparing the copy and illustrations therein.¹⁹² Unable to present documentation of the parties' intent to have the newspaper own the copyright in the ads, the strong presumption in favor of the merchants was not rebutted and the ads were held to have been made at the instance and expense of the merchants.¹⁹³ Accordingly, the merchants, rather than the newspaper, were regarded as the authors of the ads.¹⁹⁴

180. Julie Katzman, *Joint Authorship of Commissioned Works*, 89 Colum. L. Rev. 867, 867 (1989).

181. *Altman v. New Haven Union Co.*, 254 F. 113, 118 (D. Conn. 1918) ("Where the photographer takes the portrait for the sitter under employment by the latter, it is the implied agreement that the property in the portrait is in the sitter, and neither the photographer nor a stranger has a right to print or make copies without permission from the sitter" (citing *Moore v. Rugg*, 46 N.W. 141 (Minn. 1890); "[w]here, however, the photograph is taken at the expense of the photographer and for his benefit, the sitter loses control of the disposition of the pictures, and the property right is in the photographer" (citing *Press Pub. Co. v. Falk*, 59 Fed. 324 (S.D.N.Y. 1894))).

182. Katzman, *supra* note 179, at 871.

183. *Lumiere v. Robertson-Cole Dist. Corp.*, 280 F. 550, 553 (2d Cir. 1922).

184. *Yardley v. Houghton Mifflin Co.*, 309 U.S. 686 (1940).

185. *Lin-Brook Builders Hardware v. Gertler*, 352 F.2d 298, 300 (9th Cir. 1965).

186. *Id.*

187. *Id.*

188. *Id.*

189. *See Lin-Brook*, 352 F.2d 298.

190. *Brattleboro Publ'g Co. v. Winmill Publ'g Corp.*, 369 F.2d 565, 567 (2d Cir. 1966).

191. *Id.* at 568.

192. *Id.*

193. *Id.*

194. *Id.*

As illustrated above, the instance and expense test effectively nullified the importance of characterizing the relationship between the parties.¹⁹⁵ In its place, issues of control and motivation became paramount to the determination of a work's "made for hire" status.¹⁹⁶ *Picture Music v. Bourne*, for example, dealt with the question of whether a songwriter or publisher authored a composition for the purposes of § 26.¹⁹⁷ There, the publisher, Berlin, commissioned Ronell to adapt music and existing lyrics from a cartoon into a new song.¹⁹⁸ As compensation for Ronell's services, Berlin agreed to pay her a royalty.¹⁹⁹ However, the issue of ownership was not addressed until Ronell registered a renewal application, asserting one-half ownership as a co-author.²⁰⁰ In finding that Ronell's contribution "was work done for hire," the court stated that "[t]he purpose of the statute is not to be frustrated by conceptualistic formulations of the employment relationship."²⁰¹ Rather, the court was guided by the fact that Berlin: took the initiative to engage Ronell; had the right to "direct and supervise" her work; and retained the authority "to accept, reject, or modify her work," all hallmarks of an employer-employee relationship for the purposes of the Act.²⁰²

Recently, the U.S. District Court for the Southern District of New York had an opportunity to opine on the scope of § 26 in the context of Bob Marley recordings made under a recording agreement with Island Records.²⁰³ There, Universal Music, successor-in-interest to Island Records, argued that the recordings were made for hire on the basis that it had "contracted with Bob Marley to author the works, paid him to do so, bore the expenses for the [s]ound [r]ecordings, and had control over the final albums that were produced."²⁰⁴ Applying the "instance and expense" test, the court referred to the language of the relevant agreements, which required Marley to "attend at such places and times as [Island] shall reasonably require [and] render to the best of his skill and ability[,] and to the satisfaction of [Island][,] such performance as [Island] shall elect."²⁰⁵ According to the court, this language evidenced Island's authority to "accept, reject, modify, and otherwise control the creation" of the works.²⁰⁶ Although it was argued that Marley may have recorded despite the agreements, such self-motivation did not, as a matter of law, negate his obligation to record and deliver satisfactory work to Island.²⁰⁷ On that basis, the recordings were deemed to have been made at the instance of Island.²⁰⁸ As to the "expense" prong of the test, the court noted that Island advanced the recording costs and paid Marley a royalty on sales.²⁰⁹ Relying on Second Circuit authority, including *Picture Music*, the court acknowledged that while payment in the form of royalties "weighs against finding a work for hire relationship," the "absence of a fixed salary is never conclusive."²¹⁰ Consequently, the

195. Katzman, *supra* note 179, at 896 n.9.

196. *Id.*

197. *Picture Music, Inc. v. Bourne, Inc.*, 457 F.2d 1213 (2d Cir. 1972).

198. *Id.* at 1214.

199. *Id.*

200. *Id.*

201. *Id.* at 1216.

202. *Id.* at 1216-17.

203. *Fifty-Six Hope Rd. Music Ltd. v. UMG Recording, Inc.*, No. 08 Civ. 6143, 2010 U.S. Dist. LEXIS 94500 (S.D.N.Y. Sept. 10, 2010).

204. *Id.* at *21.

205. *Id.* at *4.

206. *Id.* at *29.

207. *Id.*

208. *Id.* at *29-30.

209. *Id.* at *30-31.

210. *Id.* at *31.

combination of a royalty and the payment of recording cost satisfied the expense test for the purposes of characterizing the recordings as made for hire.²¹¹

2. THE 1976 ACT

Absent clear legislative intent or a statutory definition, courts were left with the onerous task of marking the scope and parameters of the “work made for hire” doctrine under the 1909 Act. Although early legislative efforts were tabled to clarify the doctrine,²¹² Congress ultimately prevailed with the passage of the 1976 Act.²¹³ The resultant statute proffered a two-pronged assessment under which works made for hire now included those prepared by an employee within the scope of his or her employment, or works specially ordered or commissioned in certain specified circumstances.²¹⁴ This, per the Fifth Circuit, created “a simple dichotomy in fact between employees and independent contractors.”²¹⁵

Addressing the first prong, the Supreme Court in *Community for Creative Non-Violence v. Reid* interpreted the meaning of “a work prepared by an employee within the scope of his or her employment” as applying solely to circumstances where the general common law of agency characterizes the parties as employer and employee.²¹⁶ In so doing, the Court rejected the argument that “employee” subsumes those who merely create at the instance and expense of another.²¹⁷ Rather, in contrast to pre-1978 works, classifying an individual as an “employee” under §§ 101 and 201(b) now relies on several factors consistent with a genuine employment relationship, including: evidence of the hiring party’s right to control the manner and means by which the product is accomplished; the skill required to accomplish the task; the source of instrumentalities and tools; the location of work; the duration of the relationship between the parties; the right of the hiring party to assign additional tasks to the hired party; the method of payment; whether the work is part of the regular business of the hiring party; and the tax treatment of the hired party.²¹⁸ Applying this standard to a commissioned sculpture, the Court acknowledged the substance, rather than the form, of the relationship.²¹⁹ There, Reid was hired to create and deliver a sculpture in accordance with detailed guidelines and criteria provided by CCNV.²²⁰ In addition to providing a budget and deadline, CCNV also exercised control over many facets of the project, including building materials, subject matter, and the specific elements of content.²²¹ While such factors would have likely satisfied the “instance and expense” test under the 1909 Act, this was insufficient under § 101(1) to merit recognition as an employer/employee relationship.²²² Reid was a sculptor by trade, who owned his own tools,

211. *Id.*

212. H.R. 8177, 68th Cong, 1st Sess (1924) <http://www.copyright.gov/reports/annual/archive/ar-1924.pdf>.

213. 17 U.S.C. § 201 (1976).

214. 17 U.S.C. §101 (1976)

215. *Easter Seal Soc’y for Crippled Children and Adults of La., Inc. v. Playboy Enters.*, 815 F.2d 323, 329 (5th Cir. 1987).

216. *Cnty. For Creative Non-Violence v. Reid*, 490 U.S. 730, 738 (1989).

217. *Id.*

218. *Id.* at 751–752; *see also* *Aymes v. Bonelli*, 980 F.2d 857, 860-61 (2d Cir. 1992) (holding that certain Reid factors should be given more weight in the analysis because they will usually be highly probative of the true nature of the employment relationship. These include (1) the hiring party’s right to control the manner and means of creation; (2) the skill required; (3) the provision of employee benefits; (4) the tax treatment of the hired party; and (5) whether the hiring party has the right to assign additional projects).

219. *Cnty. For Creative Non-Violence*, 490 U.S. at 752.

220. *Id.*

221. *Id.*

222. *Id.* at 753.

worked in his own studio, hired his own assistants, and was paid a lump sum upon the completion of his services.²²³ Comparatively, CCNV was a non-profit organization dedicated to advancing the interests of America's homeless population, not in the business of creating sculptures, or, as the Court aptly stated, "not a business at all."²²⁴

With respect to independent contractors, the second prong of the definition is satisfied upon a finding of three factors, as defined below.²²⁵ First, the work must fall within one of the nine enumerated categories set forth in § 101(2). These include: (i) a contribution to a collective work;²²⁶ (ii) part of a motion picture or other audiovisual work;²²⁷ (iii) a translation; (iv) a supplementary work;²²⁸ (v) a compilation;²²⁹ (vi) an instructional text;²³⁰ (vii) a test, (viii) an answer material for a test; and, (ix) an atlas.²³¹ Notably absent from the list are novels, musical compositions, paintings, choreography, software programs, and sound recordings.²³²

Second, the work must be "specially ordered or commissioned" for use in one of the nine aforementioned categories.²³³ Absent a statutory definition, the phrase has been interpreted as incorporating much of the "instance and expense" test applied to works governed by the 1909 Act.²³⁴ Accordingly, to qualify as specially ordered or commissioned, the hiring party need not "possess or exercise artistic control over the product," but merely serve as the "motivating factor" in the creation of the work.²³⁵ Further, although axiomatic, it is important to note that this excludes pre-existing works, which by their very nature cannot be ordered or commissioned.²³⁶

Third, the parties must "expressly agree in a written instrument signed by them that the work shall be considered a work made for hire."²³⁷ Neither a formal agreement nor specific language is required to satisfy this element.²³⁸ Accordingly, the Second Circuit held that a series of checks containing legends with the phrase, "payee acknowledges payment in full for services rendered on a work-made-for-hire basis" as sufficient to meet this standard.²³⁹ However, the court also noted that legends solely containing the phrase "payee acknowledges payment in full for the assignment to Playboy Enterprises, Inc. of all right, title and interest in and to the following items" are insufficient.²⁴⁰ While this implies

223. *Id.*

224. *Id.*

225. *Playboy Enters., Inc. v. Dumas*, 53 F.3d 549, 562-63 (2d Cir. 1995).

226. 17 U.S.C. § 101(2). This includes illustrations to be included in magazines. *Playboy*, 53 F.3d at 556.

227. 17 U.S.C. § 101(2) (2010). Purely audio works do not satisfy this requirement. The work must contain a series of images that are capable of being shown by a machine or device. *Lulirama Ltd., Inc. v. Axxess Broad. Servs., Inc.*, 128 F.3d 872, 878 (5th Cir. 1997).

228. 17 U.S.C. § 101(2) (2010).

229. *Id.* Computer programs are considered a compilation "insofar as the concepts of selection, arrangement and organization, central to the compilation doctrine, are included in the analysis of a computer program's structure." *Logicom Inclusive, Inc. v. WP Stewart & Co.*, 2004 WL 1781009 (S.D.N.Y., August 10, 2004) at *9.

230. 17 U.S.C. 101(2) (2010).

231. *Id.*

232. *Id.*

233. *Id.*

234. *Playboy*, 53 F.3d at 561-63 (2d Cir. 1995).

235. *Id.* at 562-63.

236. *Gladwell Gov't Servs., Inc. v. Cnty. of Marin*, 2008 WL 268268 (9th Cir. Jan. 28, 2008).

237. 17 U.S.C. §101(2) (1976).

238. *Playboy*, 53 F.3d at 560.

239. *Id.*

240. *Id.*

that the writing requirement set forth in § 101(2) mandates the use of the words “work for hire,” neither the statute nor prevailing case law necessitates the use of any so-called “talismanic words.”²⁴¹ Rather, any plain language indicating the parties’ intent regarding the commissioning party as the author at law satisfies this requirement.²⁴² What remains unsettled, however, is the timing of such a writing. Evincing a split in authority, the Seventh Circuit requires that the writing “precede the creation of the property”²⁴³ while the Second and Fifth Circuits suggest that the writing may follow the creation of the property if the parties agree, prior to creation, that it will be made for hire.²⁴⁴

3. WORKS MADE FOR HIRE IN THE ENTERTAINMENT COMMUNITY

Having outlined the key elements of the work for hire doctrine as interpreted by both the 1909 Act and the 1976 Act, the following section examines three topics of particular interest to the entertainment community as a subset of the work for hire doctrine. These include music created for use in audiovisual productions, sound recordings, and works created for loan out entities. The characterization of such works as “made for hire” proves essential to the determination of authorship, ultimately affecting termination rights under §§ 203(a) and 304(c)(d).

i. ORIGINAL MUSIC CREATED FOR AUDIOVISUAL PRODUCTIONS

Original music created for use in audiovisual productions encompasses two primary categories: scores and songs.²⁴⁵ Under the 1909 Act, both fall within the ambit of works made for hire if created at the instance and expense of the hiring party and there is no agreement to the contrary.²⁴⁶ This holds true regardless of whether the natural author’s relationship with the hiring party resembles that of an employee or independent contractor.

Similarly, the 1976 Act embraces such works “made for hire” where either (1) a genuine employee/employer relationship exists, the work is created within the scope of the employee’s duties, and no agreement to the contrary exists; or (2) in the alternative, the work is specially ordered or commissioned for inclusion in a motion picture or audiovisual work and the parties execute a signed writing (before commencing work if the contract is governed by Seventh Circuit) indicating their intent to have the hiring party own the work

241. *Warren v. Fox Family Worldwide, Inc.*, 328 F.3d 1136, 1141 (9th Cir. 2003); *see also* *Logicom Inclusive, Inc. v. WP Stewart & Co.*, 2004 WL 1781009 at *11 (“To hold that § 101(2) demands the presence of the phrase ‘works for hire’ in all would-be work for hire agreements would... certainly be a ‘parsimonious reading’ of the statute.”); *Armento v. Laser Image, Inc.*, 950 F. Supp. 719, 732 (W.D.N.C. 1996) (“Indeed, ignoring the import of the commissioning contracts because they fail to include the phrase ‘work for hire’ would undermine ‘Congress’s paramount goal . . . of enhancing predictability and certainty of copyright ownership.’”).

242. *See Warren*, 328 F.3d at 1140–41; *See also Armento*, 950 F. Supp. at 728–30 (holding that for the purposes of qualifying the work under the for-hire doctrine, that omission of the phrase “work for hire” is not fatal); *See also Playboy*, 53 F.3d at 559 (holding that check legends were sufficient to satisfy writing requirement, where legend acknowledged payment in full for services rendered on work-for-hire basis).

243. *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F. 3d 586, 591 (7th Cir. 2003) (quoting *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 413 (7th Cir. 1992)).

244. *See Playboy*, 53 F.3d at 559; *See also Compaq Computer Corp. v. Ergonome, Inc.*, 210 F. Supp. 2d 839, 843–45 (S.D. Tex. 2001) (holding that written work-for-hire agreement may validly be executed after copyrighted work is created).

245. *See* 17 U.S.C. § 101 (1976).

246. *Nat’l Ctr. for Jewish Film v. Goldman*, 943 F. Supp. 113, 117–18 (D. Mass. 1996).

as the statutory author.²⁴⁷ Looking to the second prong of the work for hire definition (i.e., commissioned works), sound recordings²⁴⁸ and musical compositions²⁴⁹ specially ordered or commissioned for a motion picture or “audiovisual work[s] such as a television series”²⁵⁰ both fit within the nine enumerated categories. However, music created for anticipated or potential inclusion in a motion picture or audiovisual work, but not specially ordered or commissioned for such use, falls outside the scope of these categories.²⁵¹ This was established in *Lulirama v. Axxcess*, where the parties entered into a written agreement containing work for hire language, under which the composer provided Axxcess with advertising jingles for use in television and radio ads.²⁵² There, the agreement failed to identify which jingles, if any, were specially ordered or commissioned for use in television ads.²⁵³ Accordingly, each could have been created for inclusion in a radio ad, a television ad, or both. Due to the uncertainty of the intended use, the jingles could not conclusively be deemed “specially ordered or commissioned” for inclusion in an audiovisual work.²⁵⁴

Although the court in *Lulirama* did not reach a conclusion on the status of the various jingles, the decision evinces the necessary link between the audio and visual elements of a work for the purposes of characterization as “made for hire.”²⁵⁵ Thus, absent the latter, the former functions merely as a musical composition or a sound recording—neither of which is identified as an enumerated category in § 101(2).

ii. SOUND RECORDINGS

As distinguished from motion pictures and audiovisual works, sound recordings are audio-only renderings of “musical, spoken, or other sounds.”²⁵⁶ Prior to February 15, 1972, these were protected exclusively by state law—typically in the form of civil and criminal statutes or common law.²⁵⁷ Accordingly, the proper state law governs matters concerning pre-1972 recordings, the 1909 Act governs recordings created between February 15, 1972 and December 31, 1977, and the 1976 Act governs recordings created on or after January 1, 1978. Although pre-1972 sound recordings may be characterized as “made for hire” under common law,²⁵⁸ such characterization has no relevance to the issue of statutory termination under the 1976 Act. As noted, the termination provisions apply “only if the work in question was the subject of statutory copyright prior to the effective date of the current [1976] Act.”²⁵⁹ However, §§ 203(a) and 304(c) do apply to post-1972 sound recordings. Therefore, proper designation as “made for hire” proves essential to ownership and exploitation rights in these works.

247. 17 U.S.C. § 201 (1976).

248. *Greenwich Film Prods., SA v. DRG Records, Inc.*, 1992 WL 279357 at *2 (S.D.N.Y. Sep. 25, 1992).

249. *Warren v. Fox Family Worldwide, Inc.*, 171 F. Supp. 2d 1057, 1067–68 (C.D. Cal. 2001).

250. *Id.*

251. *Lulirama, Ltd. v. Axxcess Broad. Servs., Inc.*, 128 F.3d 872, 879 (5th Cir. 1997).

252. *Id.* at 874.

253. *Id.* at 879.

254. *Id.*

255. *Id.* at 877.

256. 17 U.S.C. § 101 (1976).

257. *Goldstein v. California*, 412 U.S. 546, 571 (1973).

258. 17 U.S.C. § 2 (1909); *Zahler v. Columbia Pictures Corp.*, 180 Cal. App. 2d 582, 589 (1960) (“Where an employee creates something as part of his duties under his employment, the thing created is the property of his employer unless, of course, by appropriate agreement, the employee retains some right in or with respect to the product.”).

259. *Siegel v. Warner Bros. Ent. Inc.*, 658 F. Supp. 2d 1036, 1062 (C.D. Cal. 2009).

Applying the instance and expense test, the law accords “work for hire” status to sound recordings governed by the 1909 Act where evidence supports such a finding. *Fifty-Six Hope Road* recently confirmed this assertion, holding that UMG was the statutory author of Bob Marley recordings created between 1972 and 1978 at the behest of the hiring party.²⁶⁰ There, the court focused on the relationship of the parties, the circumstances surrounding the creation of the particular works, and the language of the controlling agreements.²⁶¹ Recognizing that the particular sound recordings were protected by the 1909 Act, that the hiring party paid the recording costs, and that the agreements indicated an intent to have authorship vest in the hiring party, the court concluded that, despite the lack of a traditional employee relationship, the works were “made for hire.”²⁶²

Such a conclusion, however, could not be reached under the 1976 Act. Since the Act limits corporate authorship to two distinct circumstances (i.e., traditional employment or commissioned works within specified categories), UMG would need to either evidence an employment relationship or squeeze sound recordings into one of the nine enumerated categories.²⁶³ Unfortunately for those seeking to classify post-1978 recordings as commissioned works, the courts have rejected all attempts to fit them into any of the enumerated categories.²⁶⁴ While it might be tenuously argued that the terms “contribution to a collective work” or “compilation” embrace sound recordings, such arguments prove unavailing in light of current case law.²⁶⁵ Therefore, until such the courts or Congress expand the scope of the commissioned works categories, sound recordings will remain excluded from the second prong of the made for hire doctrine.

iii. LOAN OUT COMPANIES AND PERSONAL SERVICE CORPORATIONS

Where other avenues of ascribing corporate authorship fail, grantees may nonetheless preclude authors from invoking the statutory termination right if the subject work was created for, and delivered by, a loan out company. As concisely articulated by the Tax Court, “a ‘loan out’ is an arrangement whereby an employee of one company is loaned to another company to perform services for the latter. The terms of employment are agreed upon between the two companies, and compensation for the services is paid to the lending company rather than to the employee.”²⁶⁶ The lending company, in turn, pays the individual, often withholding applicable income taxes and filing W-2s and other necessary tax forms.²⁶⁷ Although the individual may exist as the sole shareholder, director, and employee of the loan out company, the law typically regards each as distinct identities engaged in a genuine employee-employer relationship.²⁶⁸ As a corollary, works created by

260. *Fifty-Six Hope Rd. Music, Ltd. v. UMG Recordings, Inc.*, No. 08 Civ. 6143, 2010 WL 3564258 (S.D.N.Y. Sept. 10, 2010).

261. *Id.*

262. *Id.* at 8.

263. 17 U.S.C. § 201 (1976).

264. *In re Napster, Inc. Copyright Lit.*, 191 F. Supp. 2d 1087, 1098 (N.D. Cal. 2002); *Lulirama v. Access Broad. Servs., Inc.*, 128 F.3d 872, 877–78 (5th Cir. 1997); *Staggers v. Real Authentic Sound*, 77 F. Supp. 2d 57, 64 (D.D.C. 1999); *Ballas v. Tedesco*, 41 F. Supp. 2d 531, 541 (D.N.J. 1999).

265. *See Napster*, 191 F. Supp. 2d at 1098, *Lulirama*, 128 F.3d 872; *Staggers*, 77 F. Supp. 2d at 64; *Ballas*, 41 F. Supp. 2d at 541.

266. *Bennett v. Comm’r of Internal Revenue*, 23 T.C. 1073, 1074 (1955); *See also Main Line Pictures, Inc. v. Basinger*, 1994 WL 814244, at *7 n.1 (Cal.App.1994) (“A ‘loan-out’ corporation is a personal service corporation which lends the services of an artist to a production company.”).

267. *See Sargent v. Comm’r*, 929 F. 2d 1252, 1255 (8th Cir. 1991) (holding that pension plan where lending company withheld income taxes was a qualified pension plan).

268. *See Main Line Pictures*, 1994 WL 814244 at *6 (recognizing the separate nature of the

the natural person pursuant the agreement with the loan out may, in theory, fit within the first prong of § 101. Consequently, statutory termination would not apply to such works.

Although the loan out argument provides a viable mechanism for nullifying an author's right of termination, the theory remains untested. To date, the employer-employee analysis has been limited to issues concerning taxation and breach of contract, where state courts and the tax court, not the federal circuit, have offered the preponderance of opinions.²⁶⁹ Although persuasive, these decisions bind neither the federal district courts²⁷⁰ nor the courts of appeal.²⁷¹ Accordingly, any reasoning adopted by the tax court, for example, would have limited impact on issues beyond its jurisdictional scope.²⁷² Moreover, where the courts of appeal have opined on tax court rulings, they have ruled on the limited issues presented. As a result, the employee/independent contractor distinction, in the context of loan out companies and personal services corporations, has not undergone the *CCNV v. Reid* (or *Aymes v. Bonelli*) scrutiny applied to copyright and works "made for hire."

C. DERIVATIVE WORKS

Like works made for hire, owners of certain derivative works enjoy limited immunity from the statutory right of termination. At law, the author of a copyrighted work possesses a bundle of exclusive rights that may be transferred individually or conveyed collectively.²⁷³ Often, a grantor transfers limited rights of distribution or publication in and to a completed work. This typically occurs when an author licenses publication rights in a finished novel to a publisher or when a musician licenses distribution rights in a series of recordings to a label or distributor. Conversely, many grantors convey a collection of rights, including the right to prepare and exploit derivative works based on the original creation. Recognizing the substantial investment made by grantees in developing and exploiting derivative works, the law affords moderate respite from the full impact of statutory termination via §§ 203(b)(1) and 304(c)(6)(A), the codification of the so-called "derivative works exception."²⁷⁴

Pursuant to these sections, "[a] derivative work prepared under authority of the grant before its termination may continue to be utilized under the terms of the grant after its termination."²⁷⁵ However, the "privilege does not extend to the preparation after the termination of other derivative works based upon the copyrighted work covered by the terminated grant."²⁷⁶ As applied by the courts, the grantee must demonstrate that it had authority to prepare a derivative work under the original grant; and that the continued exploitation of that work conforms to the terms thereof.²⁷⁷ This necessarily requires an

entities).

269. See *id.*; *Pflug v. Comm'r*, 58 T.C.M. 685, 688 (1989) (holding that an actress was employee for self-employment income tax purposes).

270. See *Klein v. United States*, 94 F. Supp. 2d 838, 845 (E.D. Mich. 2000) (holding that tax court decisions do not bind U.S. District Courts).

271. 26 U.S.C. § 7482 (a)(1); see also *Exacto Spring Corp. v. Comm'r*, 196 F. 3d 833, 838 (7th Cir. 1999) ("We owe no deference to the Tax Court's statutory interpretations, its relation to us being that of a district court to a court of appeals, not that of an administrative agency to a court of appeals.").

272. *Id.*

273. *New York Times v. Tasini*, 533 U.S. 483, 495-96 (2001)

274. See 17 U.S.C. §§ 203(b)(1), 304(c)(6)(A) (1976).

275. *Id.*, See also 17 U.S.C. §304(d)(1)

276. *Id.*

277. See *Mills Music, Inc. v. Snyder*, 469 U.S.,166-178; *Woods v. Bourne Co.*, 60 F.3d 978, 981, 989, (2d Cir. 1995); *Fred Ahlert Music Corp. v. Warner/Chappell*, 155 F.3d 17, 23 (2d Cir. 1998).

examination of four discrete elements: (i) the definition of a “derivative work;” (ii) the scope of the word “prepared;” (iii) the protected rights under the pre-termination grant; and, (iv) the limitations on post-termination alterations to the derivative work.

1. DEFINITION OF A DERIVATIVE WORK

The 1976 Act defines a derivative work as “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.”²⁷⁸ Although the statute establishes a low threshold, the subsequent work must be more than merely “based upon” the preexisting work.²⁷⁹ Rather, the derivative must incorporate copyrighted elements that would, in the absence of consent by the owner of such elements, render it an infringing work.²⁸⁰ This includes the transformation of a musical composition into a sound recording,²⁸¹ the recasting of images from a book onto mounted ceramic tiles,²⁸² the adaptation of a motion picture from a theatrical aspect ratio with a monaural soundtrack to standard television ratio with a stereoized soundtrack,²⁸³ and the novelization of a screenplay.²⁸⁴

However, due to the requirement of “at least some substantial variation” to the preexisting work,²⁸⁵ nominal adaptations such as piano-vocal versions of a lead sheet or arranged bass lines will not suffice.²⁸⁶ Further, with respect to sound recordings, the 1976 Act demands an increased level of variation from the original work. There, “the actual sounds fixed in the sound recording [must be] rearranged, remixed, or otherwise altered in sequence or quality.”²⁸⁷ As a result, neither a ringtone that simply utilizes a licensed sound recording nor the re-packaging of a sound recording in the form of a single or new album meets the requisite level of adaptation.²⁸⁸

2. SCOPE OF THE TERM “PREPARED”

The decision to create a derivative work prior to the termination of an underlying grant requires consideration of whether the term “prepared” includes both completed and unfinished works.²⁸⁹ Presently, the scope and limit of the term “prepared” remain

278. 17 U.S.C. § 101 (1976).

279. See *Well-Made Toy Mfg. v. Goffa Intern. Corp.*, 354 F.3d 112, 117 (2d Cir. 2003); *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984), *Architettura, Inc. v. DBSI Cumberland at Granbury*, 652 F. Supp. 2d 775, 780 (N.D. Tex. 2009).

280. See *Well-Made Toy Mfg.*, 354 F.3d at 117; *Litchfield*, 736 F.2d at 1357; *Architettura, Inc.*, 652 F.Supp. 2d at 780.

281. *Mills*, 469 U.S. at 155.

282. *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1344 (9th Cir. 1988).

283. *Maljack Prods., Inc. v. UAV Corp.*, 964 F. Supp. 1416 (C.D. Cal. 1997).

284. *Twin Peaks Prods. v. Publ'ns. Int'l, Ltd.*, 996 F.2d 1366, 1373 (2d Cir.1993).

285. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976).

286. *Woods v. Bourne Co.*, 60 F.3d 978, 992–93 (2d Cir.1995).

287. 17 U.S.C. § 114(b) (1976).

288. See *Mechanical and Digital Phonorecord Delivery Rate Adjustment Proceeding*, 71 Fed. Reg. 64,303, 64,307 (Copyright Office Nov. 1, 2006), available at <http://www.gpo.gov/fdsys/pkg/FR-2006-11-01/pdf/E6-18426.pdf>; *Harry Fox Agency, Inc. v. Mills Music, Inc.*, 543 F.Supp. 844, 867–68 (S.D.N.Y. 1982).

289. See *Architettura, Inc. v. DBSI Cumberland at Granbury*, 652 F. Supp. 2d 775, 784-785 (N.D. Tex. 2009).

undefined. As such, any party wishing to create a derivative work in the shadow of a pending termination should proceed cautiously.

3. THE PROTECTED RIGHTS OF THE GRANTEE UNDER THE PRE-TERMINATION GRANT

A grantee may rely on §§ 203(b)(1) and 304(c)(6)(A) if the pre-termination derivative work was authorized under the terminated grant and the post-termination uses do not exceed the rights of that grant.²⁹⁰ Where these elements exist, continued post-termination exploitation of the derivative work as well as the distribution of income therefrom, under the terms of the original grant, remain exempt from the termination.²⁹¹ Addressing these matters, *Mills v. Snyder* held that a music publisher was entitled to collect its share of royalties derived from the post-termination exploitation of phonorecords.²⁹² There, a songwriter, Snyder, assigned both the initial and, subsequently, the renewal term of his share in a composition to Mills.²⁹³ Among other terms, the grant provided that Mills would retain 50% of all mechanical income from the sale of phonorecords and disburse the remaining 50% to the writers.²⁹⁴ As customary in the music publishing industry, Mills employed the Harry Fox Agency (“Fox”) to administer the mechanical licenses.²⁹⁵ As part of its duties, Fox issued mechanical licenses to record companies on slightly different terms than as provided for under the compulsory licensing scheme²⁹⁶ and collected the royalties from those licenses on Mills’s behalf.²⁹⁷ Snyder’s heir argued that the original grant did not include the subsequent licenses made by Fox to the various record labels (i.e., “the recordings were not prepared ‘under authority of the grant’ from Synder to Mills”) and, as such, Mills had no further right to retain income from the licenses issued by Fox.²⁹⁸ Rejecting this proposition, the Supreme Court held that “because Mills, or Fox as its agent, authorized the preparation of each of the 400-odd sound recordings while Mills was the owner of the copyright, each of those derivative works was unquestionably prepared ‘under authority of the grant.’”²⁹⁹ Since the recordings were authorized derivative works under the grant, the terms of the grant encompassed both the original agreement, which entitled Mills to fifty percent of mechanical income, and the individual mechanical licenses executed pursuant thereto.³⁰⁰

A similar result was reached in *Woods v. Bourne*, where the court held that post-termination performance income resulting from the exhibition of pre-termination audiovisual works belonged to the pre-termination grantee.³⁰¹ Under the court’s reading of *Mills*, a grant by a songwriter to a publisher includes the publisher’s transfer of performance rights to a PRO (i.e., ASCAP, BMI, SESAC) and the PRO’s license of such rights to broadcast entities.³⁰² Because the performance of a composition in a film or television program requires a synchronization license from the publisher to the producer, a performance license from a PRO to the broadcaster, and a license from the publisher to a

290. 17 U.S.C. §§ 203(b)(a), 304(c)(6)(A) (1976).

291. *Id.* § 304(c)(6)(A).

292. *Mills*, 469 U.S. at 178.

293. *Id.*

294. *Id.* at 166.

295. *Id.*

296. *See* 17 U.S.C. § 115 (1976)

297. *Mills*, 469 U.S. at 158.

298. *Harry Fox Agency, Inc. v. Mills Music, Inc.*, 720 F.2d 733, 737 (2d Cir. 1983).

299. *Mills*, 469 U.S. at 165.

300. *Id.* at 167.

301. *Woods v. Bourne Co.*, 60 F.3d 981 (2d Cir. 1995).

302. *Id.*

PRO, the terms of the grant from the songwriter impliedly include the various grants necessary to enable the broadcast.³⁰³ Accordingly, the grantee is entitled to performance income from post-termination broadcasts of pre-termination audiovisual works.

However, the right to authorize new uses of a pre-termination derivative work terminates with the grant.³⁰⁴ This was affirmed in *Alhert v. Warner/Chappell*, where songwriters assigned their rights in the composition “Bye Bye Blackbird” to Warner/Chappell, who in turn granted a mechanical license to A&M Records for the release of a Joe Cocker recording identified as “Record No. SP 4182.”³⁰⁵ Following the termination of the original grant to Warner/Chappell, Alhert, the new copyright owner, issued a synchronization license and mechanical license for use of the composition embodied in the Cocker recording in the soundtrack and soundtrack album of the film “Sleepless In Seattle.”³⁰⁶ Both Alhert and Warner/Chappell claimed rights to royalties from the sale of the album.³⁰⁷ Looking to the original license between Warner/Chappell and A&M, which “cover[ed] only the particular recording mentioned [t]herein,” the court determined that the disputed exploitation was not an authorized utilization under the original grant.³⁰⁸ As a result, Alhert, not Warner/Chappell, was entitled to royalties from the sale of the soundtrack album. This conclusion relied on a strict reading of *Mills*, which held that the “entire set of documents that created and defined each licensee’s right to prepare and distribute [the] derivative work[.]” must be enforced.³⁰⁹ Since the entire set of documents only authorized the reproduction of the composition on Record No. SP 4182, the reproduction of the composition on a different album fell outside the scope of the grant.³¹⁰ Although untested, it is likely that a contrary outcome would have resulted if the original grant to A&M included the right to reproduce the composition on unspecified phonorecords.

The above cases illustrate the congressional intent to “preserve during the post-termination period the panoply of contractual obligations that governed pre-termination uses of derivative works by derivative work owners or their licensees.”³¹¹ Accordingly, reliance on §§ 203(b)(1) and 304(c)(6)(A) mandates careful consideration of the specific rights and limitation contained in the subject grant.³¹² This applies equally to all stakeholders, including assignees and licensees, as well as their assigns or sub-licensees. It is, per the Supreme Court, “a matter of indifference—as far as the reason for giving protection to derivative works is concerned—whether the authority to prepare the work had been received in a direct license from an author, or in a series of licenses and sublicenses.”³¹³ Thus, for instance, a Broadway producer who obtains the stage rights to a novel from a publisher cannot, following termination of the grant by the author to the publisher, create additional stage works based on the novel. Conversely, the author cannot upon reversion, enjoin the Broadway producer from exploiting the pre-termination derivative works or demand a renegotiation of fees or income participation for the exhibition thereof.

4. POST-TERMINATION ALTERATIONS TO THE DERIVATIVE WORK

303. *Id.* at 988

304. *Fred Ahlert Music Corp. v. Warner/Chappell*, 155 F.3d 17, 25 (2d Cir. 1998).

305. *Id.* at 19

306. *Id.*

307. *Id.*

308. *See id.* at 20.

309. *See id.* at 24.

310. *Fred Ahlert Music Corp.*, 155 F.3d at 24.

311. *Woods*, 60 F.3d at 987.

312. 17 U.S.C. §§ 203(b)(1), 304(c)(6)(A) (1976).

313. *Mills Music, Inc. v. Snyder*, 469 U.S. 153, 173–74 (1985).

Although the derivative works exception precludes the right to create new derivatives or exploit authorized derivative works in unanticipated media, certain post-termination changes to the pre-termination work may be permissible.³¹⁴ This issue was analyzed by the U.S. District Court for the Northern District of Texas in the context of a terminated license for the use of architectural plans.³¹⁵ There, an architectural firm, Architettura, Inc., submitted plans to DMSI for consideration in the construction of an apartment building, granting DMSI an implied revocable license to use and distribute the plans.³¹⁶ DMSI ultimately employed a competing firm, Wilke, to construct the project and provided Wilke with a copy of Architettura's site plans. Prior to termination, elements of Architettura's plans were incorporated into Wilke's plans, resulting in creation of an authorized derivative work that DMSI and Wilke continued to utilize.³¹⁷

Although the case does not address statutory termination, the court acknowledged that the "plain language of § 203 covers all nonexclusive grants of a license executed after January 1, 1978, including implied, oral licenses that are revocable at will."³¹⁸ Against this backdrop, DMSI was authorized under the original grant to continue utilizing the derivative work under § 203(b)(1).³¹⁹ This right, per the court, also entitled DMSI to make certain post-termination alterations to the pre-termination derivative work, provided the "post-termination changes made to the derivative work [did] not incorporate the copyrighted work."³²⁰ This was the case with respect to post-termination comments to the plans from the project's developer, civil engineers, contractors, and city officials.³²¹ Such alterations merely revised the existing work, enabling DMSI to complete the blueprints necessary to begin construction.³²² To interpret § 203(b)(1) as precluding such revisions would force DMSI to destroy the plans just short of completion, a result the court asserted as "contrary to the purposes of Derivative Works Exception."³²³

Providing an analogous argument in support of its position, the court cites a Nimmer hypothetical which posits that the producer of a motion picture based on a novel may freely add a musical score to the picture after the author terminates the rights to use the novel.³²⁴ There, the score itself is neither based on the novel nor incorporates copyrighted elements of the novel.³²⁵ Accordingly, the producer does not infringe upon the rights of the author when adding or incorporating such additional elements.

V. CONCLUSION

With the passage of the 1976 Act, Congress fundamentally altered several core aspects of American copyright law. Deviating from a renewal term system, which had governed since the 18th century, Congress introduced a unitary period of duration based on the author's life plus fixed term thereafter. At the same time, Congress replaced publication with creation as the basis for protection. These changes marked a slow shift toward global harmonization, while simultaneously removing many of the rigors associated with obtaining

314. 17 U.S.C. § 304(c) (1976).

315. *Architettura, Inc. v. DBSI Cumberland at Granbury*, 652 F. Supp. 2d 775, 780 (N.D. Tex. 2009).

316. *Id.* at 779.

317. *Id.* at 781.

318. *Id.* at 782–83.

319. *Id.*

320. *Id.* at 784.

321. *Architettura, Inc.*, 652 F. Supp. 2d at 784.

322. *Id.*

323. *Id.*

324. *Id.*

325. *Id.* at 784–85.

and maintaining copyright protection. As part of the grand bargain among the various stakeholders in developing a new copyright system, the 1976 Act included the inalienable right of termination for authors and their heirs. As illustrated above, the termination provisions, namely, §§ 203, 304(c), and 304(d), have played a significant role in modern United States copyright law since their introduction. Understanding the application of these provisions, and their exceptions, proves critical to any party seeking to counsel authors, assignees, and licensees on matters pertaining to the transfer of copyright interests. While certainly not exhaustive, the above text attempts to provide an overview of the law, proffering several examples relevant to the myriad of common copyright transactions. Whereas copyright law, and American jurisprudence in general, is highly dynamic, the examples contained herein may prove inapplicable to current and future situations. As such, every fact pattern must be assessed independently in light of contemporary, and jurisdictionally relevant, authority.

The Regulation of Dual Representation in the NFL

ANTHONY L. SALVADOR

The corruption in the sport agent industry is not a new phenomenon. Renowned sports agent Tom Reich put it best when he remarked that “[t]he impropriety and corruption is, absolutely, as I look back, at an all time high. It’s like Al Capone’s Chicago and it’s despicable.”¹ Reich made this observation in the early 2000s.² A large component of the “impropriety and corruption” stems from the dual representation of coaches and players in the NFL.

The conflicts associated with the dual representation of coaches and players have always been around; however, regulation of the conflicts remains nonexistent. The arguments for and against dual representation are abundant, but the practice has proliferated in the NFL. The recent state of the NFL demonstrates labor and management are directly in opposition, with agents in the middle often favoring some clients over others. The conflicts associated with the dual representation of coaches and players has become insupportable and greatly in need of change.

Section II will address the increase of dual representation and categorize the conflicts associated with dual representation. Section III will outline the arguments on both sides of the practice and offer some analysis on why the NFL remains without effective regulation in this area. Section IV will address the recent state of the NFL and show why conflicts of dual representation can no longer remain unregulated. Finally, Sections V and VI will offer a solution to the practice of dual representation of coaches and players.

1. Liz Mullen, *Sleaze Factor Off the Charts, Agents Allege*, SPORTS BUSINESS DAILY (June 24, 2002), <http://www.sportsbusinessdaily.com/Journal/Issues/2002/06/20020624/Special-Report/Sleaze-Factor-Off-The-Charts-Agents-Allege.aspx>.

2. *Id.*

I. INTRODUCTION

The corruption in the sport agent industry is not a new phenomenon. Renowned sports agent Tom Reich put it best when he remarked that “[t]he impropriety and corruption is, absolutely, as I look back, at an all time high. It’s like Al Capone’s Chicago and it’s despicable.”³ Reich made this observation in the early 2000s.⁴ A large component of the “impropriety and corruption” stems from the dual representation of coaches and players in the NFL.

The conflicts associated with the dual representation of coaches and players have always been around; however, regulation of the conflicts remains nonexistent. The arguments for and against dual representation are abundant, but the practice has proliferated in the NFL. The recent state of the NFL demonstrates labor and management are directly in opposition, with agents in the middle often favoring some clients over others. The conflicts associated with the dual representation of coaches and players has become insupportable and greatly in need of change.

Section II will address the increase of dual representation and categorize the conflicts associated with dual representation. Section III will outline the arguments on both sides of the practice and offer some analysis on why the NFL remains without effective regulation in this area. Section IV will address the recent state of the NFL and show why conflicts of dual representation can no longer remain unregulated. Finally, Sections V and VI will offer a solution to the practice of dual representation of coaches and players.

II. DUAL REPRESENTATION IN THE NFL

A. INCREASE IN COACHES AS CLIENTS

There has been a significant increase in the number of NFL coaches who are now represented by agents.⁵ The rise in agent representation of NFL coaches is a reflection of the monetary gain to be had by such practice.⁶ Donald Yee, a Los Angeles-based agent who represents NFL coaches and players commented, “The money’s gotten to the point where everybody involved in the process is going to protect themselves.”⁷ Professor Shropshire, an expert in sports law from the University of Pennsylvania, also identified money as the reason for the increase in agent representation for coaches: “That is certainly one area that has grown by big money. . . . The dollars being paid coaches has made this a different arena.”⁸ In fact, a number of NFL coaches make over \$5 million a season.⁹ Moreover, it is

3. Liz Mullen, *Sleaze Factor Off the Charts, Agents Allege*, SPORTS BUSINESS DAILY (June 24, 2002), <http://www.sportsbusinessdaily.com/Journal/Issues/2002/06/20020624/Special-Report/Sleaze-Factor-Off-The-Charts-Agents-Allege.aspx>.

4. *Id.*

5. See Liz Mullen, *Octagon Signs a Three-Pack of High-Profile NFL Coaches*, SPORTS BUSINESS DAILY (Jan. 14, 2008), <http://www.sportsbusinessdaily.com/Journal/Issues/2008/01/20080114/Labor-Agents/Octagon-Signs-A-Three-Pack-Of-High-Profile-NFL-Coaches.aspx> (discussing the increase of sports agents’ “coach practices”).

6. See *id.* (citing representation of coaches as a “growth business” because coaches’ salaries “are not subject to any salary cap” and they are “viewed as attractive corporate spokespeople”).

7. Paul Domowitch, *Agents Walk Fine Line When Representing Both Coaches and Athletes*, PHILA. DAILY NEWS, Oct. 12, 2001.

8. Pete Prisco, *Proliferation of Dual-Purpose Agents Raises Ethics Questions*, CBSSPORTS.COM (Feb. 20, 2003), <http://www.cbssports.com/nfl/story/6200941>.

9. See Tom Van Riper, *The Highest-Paid NFL Coaches*, FORBES.COM (Jan. 4, 2011),

no surprise that it is an NFL coach at the top of the charts as the highest paid coach of the four major North American sports.¹⁰ The New England Patriots head coach Bill Belichick makes an estimated \$7.5 million a year.¹¹ While Bill Belichick is at the top of the list, there is not much of a drop off for the next two highest paid coaches in the NFL: the Washington Redskins head coach, Mike Shanahan, and the Seattle Seahawks head coach and executive vice president, Pete Carroll, both pull in \$7 million annually.¹² Additionally, Chicago Bears head coach Lovie Smith makes \$6 million a year, Arizona Cardinals head coach Ken Whisenhunt earns \$5.75 million annually; this equals what former Tennessee Titan head coach Jeff Fisher made, and Philadelphia Eagles head coach Andy Reid earns \$5.5 million.¹³ With a large number of coaches making large salaries, agents are eager for a percentage of these contracts in addition to the players' contracts they are already negotiating.¹⁴

B. TWO DUAL REPRESENTATION SCENARIOS

With the big money to be made in coaching contracts, it is no surprise agents are flocking to get a piece of the action. The problem arises when many agents are taking coaches on as clients while still maintaining their player clients.¹⁵ Many would argue the representation of both coaches and players create a clear conflict of interest.¹⁶ There are two scenarios present when agents represent both players and coaches: (1) an agent that represents a coach and player that are members of the same NFL Club and (2) an agent representing NFL coaches as well as NFL players, but coach and player are members of separate NFL clubs. Of course, these two scenarios are not mutually exclusive and any single agent can be an example of both scenarios through different representations. Additionally, scenario two can quickly switch to scenario one (or vice versa) with the competitiveness of the industry and the act of players and coaches switching agents or changing teams.

I. SCENARIO ONE

There are numerous examples of scenario one in which an agent is engaged in representing both players and coaches from the same team. In early 2000, powerhouse agency Octagon represented Atlanta Falcons head coach Dan Reeves as well as the star quarterback for the Falcons, Michael Vic.¹⁷ At one time, agent Marvin Demoff represented head coach for the Cleveland Browns, Butch Davis as well as the Browns top defensive player, Courtney Brown.¹⁸ In the late 1980s, agent Robert Fraley represented head coach of

<http://www.forbes.com/2011/01/04/patriots-redskins-seahawks-business-sports-nfl-highest-paid-coaches.html> (naming several coaches who make greater than \$5 million per season).

10. Tom Van Riper, *The Highest-Paid Coaches in Sports*, FORBES.COM (May 18, 2011), <http://www.forbes.com/2011/05/18/highest-paid-sports-coaches.html>.

11. *Id.*

12. *Id.*

13. *Id.* (citing salaries for Lovie Smith and Jeff Fisher); *Highest-Paid NFL Coaches*, *supra* note 7 (citing salaries for Ken Whisenhunt and Andy Reid).

14. See Mullen, *supra* note 3 (describing the growth business of representing coaches).

15. See Domowitch, *supra* note 5; see also Prisco, *supra* note 6 (both articles describe the conflict of interest that arises when agents represent coaches while still representing players).

16. Domowitch, *supra* note 5; Prisco, *supra* note 6.

17. It is understood Octagon is an agency and not a single agent, but for reasons discussed in Section VI a conflict for one agent in an agency should be considered a conflict for all agents within that agency. Domowitch, *supra* note 5.

18. *Id.*

the Philadelphia Eagles Buddy Ryan and the Eagle's No. 1 draft pick, Jerome Brown.¹⁹ Additionally, Neil Cornrich, agent for Bill Belichick, represented five other New England Patriot players, including defensive end Anthony Pleasant and linebacker Mike Vrabel.²⁰

2. SCENARIO TWO

Agent Neil Cornrich provides a prime example of an agent that falls in both scenarios one and two. While representing head coach Bill Belichick, Cornrich served as agent for current Patriot players.²¹ At the time he also served as agent for more than twenty-five other NFL players on different NFL clubs.²² In 2001, Agent Don Yee represented former San Francisco 49ers head coach Steve Mariucci as well as head coach for the Chicago Bears, Dick Jauron, along with forty other NFL players.²³ While the represented coaches and players are on different NFL clubs, disclosure and consent should still be required to protect the interests of the clients (as will be discussed in Section VI).

C. COACHES ARE MANAGEMENT

An additional scenario, which may seem separate from scenarios one and two, is when an agent is engaged in representing both players and management. For example, Jimmy Sexton of Athletic Resource Management represents the Executive Vice President of Football Operations for the Miami Dolphins.²⁴ The representation of a management figure is synonymous with the representation of a coach because coaches are management. Under the National Labor Relations Act an employer is "any person acting as an agent of an employer, directly or indirectly."²⁵ Head coaches, and arguable assistant coaches, are the face of NFL clubs and agents of the organization. Sexton's example of representing Bill Parcells and Miami Dolphins player Phillip Merling falls under scenario one.²⁶ However, Sexton also represents over forty other NFL players for different NFL clubs and thus serves as an example of scenario two as well.²⁷

Arguably, all coaches, including those from special teams and offensive and defensive coordinators, are management.²⁸ The National Labor Relations Act defines supervisor as "any individual having authority, in the interest of the employer, to hire, transfer, suspend, lay off, recall, promote, discharge, assign, reward, or discipline other

19. Craig Neff, *Den of Vipers*, SPORTS ILLUSTRATED, Oct. 19, 1987, at 76, available at <http://sportsillustrated.cnn.com/vault/article/magazine/MAG1066585/index.htm>.

20. Domowitch, *supra* note 5.

21. *Id.*

22. *Id.*

23. *Id.*

24. Tim Graham, *Tebow 2.0 to be Revealed at Gators' Pro Day*, ESPN.COM (Mar. 16, 2010), http://espn.go.com/blog/afceast/tag/_/name/jimmy-sexton.

25. National Labor Relations Act, 29 U.S.C. § 152(2) 1978 (2006) [hereinafter NLRA].

26. See Graham, *supra* note 22 (stating Sexton represents Miami Dolphins football operations boss Bill Parcells); see also Aaron Wilson, *Phillip Merling's Contract an Issue For Dolphins*, NAT'L FOOTBALL POST (July 30, 2010), <http://www.nationalfootballpost.com/Phillip-Merlings-contract-an-issue-for-Dolphins.html> (stating that Sexton represents both Merling and Parcells).

27. See Our Clients: Football, ATHLETIC RESOURCE MANAGEMENT, http://www.sextonsports.com/ssp/our_clients?id=18 (last visited Oct. 6, 2011) (profiles of professional football players represented by Athletic Resource Management, Jimmy Sexton's agency).

28. See Mike Ditka, *NFL Coaches on Management: Perspectives and Platitudes*, CHI. TRIB., July 15, 1996, available at http://articles.chicagotribune.com/1996-07-15/business/9607150040_1_coaches-offer-redskins-coach-joe-gibbs-george-siefert (describing the similarities between NFL coaches and company managers).

employees, or responsibly to direct them, or to adjust their grievances, or effectively to recommend such action, if in connection with the foregoing the exercise of such authority is not of a merely routine or clerical nature, but requires the use of independent judgment.”²⁹ Although club specific, many assistant coaches meet this definition and are deemed management under the National Labor Relations Act.³⁰

III. TWO SIDES TO THE ARGUMENT

It should come as no surprise that when big money is involved there is a clear split in positions of whether dual representation of players and coaches is ethical. Those in favor of dual representation obviously include the agents engaged in the practice, as well as the National Football League Players Association (NFLPA). Agents engaged solely in player representation or agents engaged solely in the representation of coaches are voicing their opposition. The NFL has also chimed in on the matter, voicing their concerns over dual representation.

A. THOSE IN FAVOR OF DUAL REPRESENTATION

1. AGENTS

Agents in favor of dual representation can be categorized in two areas. The first category of agents argues the ethicality of dual representation based on a business approach. A second category of agents defending dual representation believes a conflict is avoided based on the power of the coaching client.

Agent Neil Cornrich is engaged in dual representation and believes the situation should be treated as a business opportunity: “If it gives you a competitive advantage over other agents, who cares In any field, if Intel has a better [computer] chip and they have a better chip because they have better engineers, what does another chipmaker do about it? Those are the breaks.”³¹ Cornrich is mistaken in his role as an agent. Common law imposes a fiduciary relationship between client and agent.³² An agent with adverse interests to the client, such as an agent representing both a coach and a player, may act as an agent if the individual has revealed “the existence and extent of such adverse interests” to the client.³³ Additionally, unless there has been an agreement between agent and client, an agent cannot act for “persons whose interests conflict with those of the principal in matters in which the agent is employed.”³⁴

The problem stems from the NFLPA agent regulations. An agent engaged in the representation of both a player and a coach exposes themselves to potential conflicts in two forms: (1) contract negotiations and (2) player personnel decisions. NFLPA agent regulations merely require an addendum to be attached to the representation agreement stating other coaches or management represented.³⁵ An attached addendum does not constitute an agreement between principal and agent that reveals “the existence and extent”

29. NLRA, 29 U.S.C. § 152(11).

30. Robert H. Lattinville & Robert A. Boland, *Coaching in the National Football League: A Market Survey and Legal Review*, 17 MARQ. SPORTS L. REV. 109, 111 (2006).

31. Domowitch, *supra* note 5.

32. RESTATEMENT (SECOND) OF AGENCY § 1.1 (1958).

33. *Id.* at § 23.

34. *Id.* at § 394.

35. NAT'L FOOTBALL LEAGUE PLAYERS ASS'N REGULATIONS GOVERNING CONTRACT ADVISORS, § 3(A)(16) (2007) [hereinafter NFLPA REGULATIONS].

of adverse interests as required by law.³⁶ While Cornrich may be right in dual representation giving agents a competitive advantage, he is wrong in ignoring the ethical conflict. In addition, there are more practical reasons that support banning the dual representation of a coach and player on the same team. These reasons will be explored in Section VI.

Other agents recognize the conflicts of interest present in dual representation, but believe it is up to the agent to self-regulate such conflicts.³⁷ Agent Donald Yee is a proponent of this approach, stating that “it could be a conflict . . . It’s a matter of self-policing.”³⁸ Yee’s self-policing approach includes two key aspects. First, the agent must be a good advocate. Second, appropriate disclosures must be made.³⁹ Yee argues, “We’re in a very competitive, tough business. You’re hired, whether by the coach or player, to be an advocate for them. If you’re being a good advocate for them, I don’t think there’s anything wrong with [dual representation] as long as the appropriate disclosures are made.”⁴⁰ Yee’s definition of “appropriate disclosures” may be correct if it includes revealing the existence and extent of any adverse interests as required by agency law, and not just the addendum required by NFLPA agent regulations.⁴¹ Additionally, appropriate disclosures must also consider the frequency of the disclosures. The longtime Executive Director of the NFLPA has made it clear that players only need to be aware if their agent is representing coaches at the time of signing.⁴² This is not adequate because there may be no conflict at the time of signing. However, later in the representation an agent may gain a new client, or an existing client may change teams, which creates a conflict.

Yee defends his dual representation practice because the coaches he represents lack “GM type [sic] power.”⁴³ Dual representation agent Jimmy Sexton takes a similar view as Yee:

I don’t know how it could be a conflict of interest, I just don’t see it. . . . Do you really think Bill Parcells was going to listen to me about what players to sign? And few coaches, even the guys who are football operations directors, have anything to do with contract negotiations or what a team spends on a player. . . . Do you really think Andy Reid tells Joe Banner (Eagles President) what he should or shouldn’t pay a player? Aside from when Parcells was coaching, I don’t know any coach who has *final* say in money matters. Do you think that Dan Reeves (former Atlanta Falcons head coach) went to Harold Richardson (former GM of the Atlanta Falcons) and told him to give Michael Vick more money because both of them are represented by the same company? That’s preposterous.⁴⁴

Sexton’s argument that no conflict exists in dual representation is based on the power coaches have in the organization, specifically the role coaches play in contract negotiations.⁴⁵ However, Sexton takes an absolutist approach in arguing coaches in the NFL

36. See *id.* (requiring only the names and positions of any management personnel or coaches whom agent represents or has represented).

37. Domowitch, *supra* note 5.

38. *Id.*

39. *Id.*

40. *Id.*

41. Compare RESTATEMENT (SECOND) OF AGENCY § 23 with NFLPA REGULATIONS § 3(A)(16).

42. NFLPA REGULATIONS § 3(A)(16).

43. Domowitch, *supra* note 5.

44. *Id.*

45. See *id.* (Sexton explaining that coaches are not involved in contract negotiations).

do not have a “final” say in what a player gets paid.⁴⁶ While this may be true, coaches may have a large continuum of influence. It does not take a coach having “final” say to create a conflict of interest; any adverse interest creates a conflict, but the materialness of such conflict will determine if the conflict can be managed.⁴⁷

Additionally, conflicts other than contract negotiations exist. A coach with influence over player personnel decisions creates a conflict as well. A number of NFL coaching contracts contain provisions listing the duties of the coach, including evaluating and soliciting players.⁴⁸ A number of college coaches’ contracts contain provisions similar to those found in NFL coaching contracts. For example, Mack Brown’s contract with The University of Texas at Austin listed his duties and responsibilities as head football coach to include evaluating, recruiting, training, and coaching.⁴⁹

A large part of NFL coaches’ duties are to evaluate and solicit players. Coaches are present at the NFL Combine evaluating players.⁵⁰ NFL coaches are in the “war room”⁵¹ during the draft and are an integral part of making the decisions on which players the club will draft.⁵² Even the most streamlined war room during the draft includes the head coach, while many include numerous people, even the scouts.⁵³ Further, during training camp coaches are constantly in meeting rooms with team owners giving input on which players should make the cut.⁵⁴ An agent may find himself conflicted when a player client is not performing well and under the risk of being cut or traded by a team in which the agent represents a coach. If an agent tries to influence a coach he represents to sign or keep a player and he does not disclose the “existence and extent” of the adverse interest, then the agent risks breaching his fiduciary duty to the coach.⁵⁵

2. NFLPA MEMBERS

46. *Id.*

47. See generally MODEL RULES OF PROF'L CONDUCT R. 1.7 cmt. (2007) (describing conflicts of interest that can be managed as those that are waviable by the client).

48. See Robert H. Lattinville et al., *Labor Pains: The Effect of a Work Stoppage in the NFL on Its Coaches*, 20 MARQ. SPORTS L. REV. 335, 356 (2010) (providing a detailed description of coaches’ scouting and evaluation duties).

49. See Mack Brown Contract, Compensation for Div. 1-A College Football Coaches, USA TODAY (Nov. 16, 2007), available at http://www.usatoday.com/sports/graphics/coaches_contracts07/pdfs2007/texas_fb.pdf (“As head football coach, Brown shall have the responsibility for the planning, supervision, and coordination of all aspects of the Program, including but not limited to . . . planning, supervising, and coordinating the recruitment and training of student athletes for the Program.”).

50. Kevin Bosner, *How the NFL Draft Works*, HOW STUFF WORKS, <http://entertainment.howstuffworks.com/nfl-draft3.htm>.

51. The term “war room” is used to describe the place where team leaders huddle together to make their player selections. See Kirsten Kendrick & Art Thiel, *No Room for War Room in NFL draft*, KLPu NEWS (Apr. 28, 2011), <http://kplu.org/post/no-room-war-room-nfl-draft>.

52. See Donny Hobrock, *Detroit Lions: Inside the War Room*, XLOG (Apr. 22, 2011), <http://thexlog.com/201104221622/xtra-point-football/nfl/detroit-lions-inside-the-war-room/> (“[W]hen owners, coaches, general managers, and the rest of the front office lock themselves in [the war] room . . .”).

53. Tre Wells, *Secrets of an NFL Draft War Room*, BLEACHERREPORT.COM (April 21, 2009), <http://bleacherreport.com/articles/159858-secrets-you-may-not-know-about-an-nfl-draft-war-room>.

54. See, e.g., John Powers, *Brash Band Ryan Grates on Home, But Jets Swear By Him*, BOSTON GLOBE, (Sept. 19, 2010), available at http://articles.boston.com/2010-09-19/sports/29324870_1_rex-ryan-drill-sergeant-ravens-defensive-coordinator/2 (reporting a discussion by the New York Jetscoach and owner about new player contracts during training camp).

55. RESTATEMENT (SECOND) OF AGENCY §§ 1(1), 23.

The NFLPA, the organization responsible for regulating agents,⁵⁶ has also refused to acknowledge the conflicts of interest present in dual representations.⁵⁷ Gene Upshaw, the former Executive Director of the NFLPA, believes dual representation is not a conflict at all. In fact, dual representation works in the favor of the players. "As long as a player *knows when he signs up* with an agent that he's representing coaches, too, that shouldn't be a problem In fact, from the player's standpoint, I think it's a pretty good thing. If an agent represents two, three coaches in the league and he's got a player he's trying to get placed, it *might* help the player get a job, not hurt him."⁵⁸ The flaw in Upshaw's argument stems from when and how the player "knows" of the conflict. Upshaw argues the player only needs to know of conflicts at the time of signing, with no requirements for re-disclosure as clients change teams or agents.⁵⁹ Upshaw may be right in that dual representation can have a positive influence in getting a player client signed.⁶⁰ However, Upshaw fails to acknowledge how a player may be hurt if the agent does an inadequate job representing him because the agent has decided to do a favor for his coaching client.⁶¹

B. THOSE IN OPPOSITION OF DUAL REPRESENTATION

1. NFL MEMBERS

The NFL has been in opposition to dual representation since the late 1980s.⁶² In a letter to all NFL clubs, former NFL Commissioner Pete Rozelle voiced his concerns over dual representation.⁶³ Rozelle believed dual representation of coaches and players "can cause significant problems and should be avoided."⁶⁴ Rozelle has not been the only Commissioner opposed to the conflict; Roger Goodell's predecessor Paul Tagliabue also did not agree with the practice of dual representation.⁶⁵ Former NFL Executive Vice President for Labor Relations and Former Chairman of the NFL Management Council Harold Henderson took a practical approach to the conflict.⁶⁶ Henderson states:

It's unseemly It's not a good thing. It holds the potential for serious conflicts of interest. . . . Say you're looking at a couple of [free-agent] defensive linemen. . . . One is represented by the agent who represents you and the other is not. Which one are you going to choose and why? . . . I'd like to think that we run something of a meritocracy here where every player has an equal chance to earn a position on the team and not just those whose agent has inside influence with the coach or general manager.

56. NAT'L FOOTBALL LEAGUE COLLECTIVE BARGAINING AGREEMENT, art. VI, § 1 (2006).

57. See NFLPA REGULATIONS § 3(A)(16) (allowing dual representation as long as agents disclose the names and current positions of any NFL management personnel or coaches whom they represent or have represented in matters pertaining to their employment by or association with any NFL club).

58. Domowitch, *supra* note 5.

59. *Id.*

60. *Id.*

61. *Id.*

62. Robert E. Fraley & F. Russell Harwell, *The Sports Lawyer's Duty to Avoid Differing Interests: A Practical Guide to Responsible Representation*, 11 HASTINGS COMM. & ENT. L. J. 165, 216 (1989).

63. *Id.*

64. *Id.*

65. Domowitch, *supra* note 5.

66. See *id.* (Henderson discussing why dual representation presents a conflict of interest).

That's exactly the kind of problem that the union ought to be worried about.⁶⁷

Specific NFL clubs have also verbalized their concerns.⁶⁸ Former Kansas City Chiefs President and General Manager Carl Peterson stated, "A lot of people in the league are starting to realize that this is a difficult and awkward situation that we don't want to continue It presents a tremendous conflict of interest when you have an agent representing both players and coaches. I'm adamantly opposed to it."⁶⁹

The NFL has a legitimate reason to be concerned about the conflicts presented by dual representation. The NFLPA is responsible for the regulation of player agents, not agents representing coaches.⁷⁰ The National Football League Coaches Association (NFLCA) is a non-union voluntary organization with no authority to regulate agents.⁷¹ Neil Cornrich, again, provides as an example of the gap of regulatory authority with regards to agents engaged in dual representation of coaches and players. Cornrich was disciplined with a one-year suspension for violating the NFLPA conflict of interest policy when he served as an expert witness for General Motors in a lawsuit against General Motors brought by the estate of the late Kansas City Chiefs linebacker Derrick Thomas.⁷² However, the suspension did not apply to Cornrich's coaching practice.⁷³

2. AGENTS

Agents opposed to dual representation find there is potential for conflicts of interest and have decided to remove themselves from the situation.⁷⁴ One of the most well-known agents representing coaches, Bob Lamonte, used to represent both coaches and players.⁷⁵ However, Lamonte recognized the conflict and has limited his NFL clients to coaches and management.⁷⁶ Over time, Lamonte weaned himself from dual representation stating "I've turned down players over the last ten years at an enormous rate because I knew I had to police myself. . . . The potential for conflict is clear. It's stupid. It's dumb. It's and obvious conflict of interest."⁷⁷ The discrepancy between Lamonte's exclusion of representing NFL players as self-policing and Yee's case by case self-policing based on a coach's power shows the discrepancy in the understanding of regulations governing agents.

67. *Id.*

68. *See id.* (reporting a discussion among representatives from different NFL clubs about how dual representation may present a conflict of interest).

69. *Id.*

70. *See* NFLPA REGULATIONS § 1 (describing the scope of regulation relating to agents' representation of players).

71. Brief of the Nat'l Football League Coaches Ass'n Amicus Curiae in Support of the Plaintiffs-Appellees at 1, *Brady v. NFL*, 644 F.3d 661 (8th Cir. 2011) (No. 11-1898) [hereinafter Brief of NFLCA].

72. Liz Mullen, *NFL Player Agent Neil Cornrich Begins One-Year Suspension*, SPORTS BUSINESS DAILY (Aug. 5, 2005), <http://www.sportsbusinessdaily.com/Daily/Issues/2005/08/Issue-220/Sports-Industrialists/NFL-Player-Agent-Neil-Cornrich-Begins-One-Year-Suspension.aspx>.

73. *Id.*

74. Domowitch, *supra* note 5.

75. *Id.*

76. *Id.* LaMonte still represents one NFL player, placekicker Joe Nedney, formerly of the San Francisco 49ers. Our Clientele, PROFESSIONAL SPORTS REPRESENTATION, INC., <http://psr-inc.net/clientele.html> (last visited Oct. 5, 2011). LaMonte states the only reason he represents Nedney is because he taught him in high school. Prisco, *supra* note 6.

77. Domowitch, *supra* note 5.

NFL player agent Brad Blank has limited his representation to players only because of the recognized conflict in representing both coaches and players.⁷⁸ Blank commented:

It could go either way. . . . One [possibility] is you don't get as much money [for the player] because you're doing your [coaching] client a favor. You don't want to have a knockdown, dragout [sic] war over money with a [coach] who's your client and you end up doing a disservice to the player. The flip side is the agent who tells a player I can get you more money because I represent this [coach] It should be an arm's-length [sic] relationship where you don't owe anybody anything and they don't owe you anything. Frankly, I don't see examples in any other business where you represent both labor and management. You can't do it. If you're a union guy you're a union guy. Your goal should be to represent one side vigorously and have only that one interest to protect.⁷⁹

Agents in other leagues have also identified dual representation as a problem.⁸⁰ MLB player agent Scott Boras, who represents high profile athletes such as Alex Rodriguez, stated:

I don't think it's a good idea. If one of my clients suddenly had an opportunity to be a manager, I would probably cut the contract so long as he understood that my representation would end once that contract is negotiated. Managers are making money and agents are going to look at it as a revenue stream. I like having that relationship with a manager where you know what side of the fence you're on.⁸¹

Scott Boras has recognized the potential for conflict, as has the MLBPA. While not an outright ban on dual representation, MLBPA Agent Regulations state a player agent *may* be subject to revocation or suspension of their certification or other disciplinary action for representing management.⁸²

III. DUAL REPRESENTATION IN NATIONAL SPORTING LEAGUES

A. NBA AND NHL HAVE BANNED DUAL REPRESENTATION

While the MLBPA has only reserved the right to discipline agents engaged in dual representation, the two other major North American leagues have implemented an outright ban on such practices. The NBPA agent regulations prohibit a player agent from representing any coach of an NBA team.⁸³ Additionally, the NHLPA agent regulations have prohibited player agents from "representing or providing services, either directly or

78. *Id.*

79. *Id.*

80. See Pete Williams, *Flying Solo . . . and Feeling Free*, SPORTS BUSINESS DAILY (July 23, 2001), <http://www.sportsbusinessdaily.com/Journal/Issues/2001/07/20010723/This-Weeks-Issue/Flying-Solo-And-Feeling-Free.aspx> (discussing dual representation conflicts in Major League Baseball).

81. *Id.*

82. MAJOR LEAGUE BASEBALL PLAYERS ASSOCIATION REGULATIONS GOVERNING PLAYER AGENTS § 3(B)(5) (1997) [hereinafter MLBPA REGULATIONS].

83. NATIONAL BASKETBALL PLAYERS ASSOCIATION REGULATIONS GOVERNING PLAYER AGENTS § 3(B)(f) (1991) [hereinafter NBPA REGULATIONS].

indirectly” to any officer or employee, including coaches of an NHL Club.⁸⁴ Of the four major North American leagues—the NFL, the MLB, the NBA, and the NHL—only the NFLPA has refrained from including a specific provision imposing disciplinary power in regards to dual representation of players and coaches. The NFLPA Regulations Governing Contract Advisors only require that NFL player agents disclose “the names and current positions of any NFL management personnel or coaches whom Contract Advisors represents or has represented” in an addendum attached to the Standard Representation Agreement.⁸⁵ NFL agents who engage in the representation of players and coaches are under no risk of discipline as long as a disclosure addendum is attached to the representation agreement. It is curious that the three other leagues have, at a minimum, reserved the right to impose disciplinary action if not an outright ban on dual representation, but the NFLPA has decided to remain powerless in governing this conflict.

B. WHY NO DUAL REPRESENTATION REGULATION IN THE NFL?

With strong opposition from some agents and a continued concern over dual representation by the NFL, it is amazing NFL agents have been able to remain free from discipline with regards to this heated conflict. Former NFL Executive Vice President for Labor Relations Harold Henderson has expressed the NFL’s hands are tied in solving the problem: “We don’t have the authority to dictate to any of our employees—either players or the coaches—who represents them.”⁸⁶

The NFLPA is not ignorant of the potential conflicts involved with dual representation.⁸⁷ General Counsel for the NFLPA Richard Berthelsen admitted the agent regulations he drafted in 1983 originally included a rule prohibiting dual representation, but that the rule did not make the final draft of the regulations.⁸⁸ 1983 was not the first time prohibition of dual representation was considered.⁸⁹ After 1983, a rule prohibiting dual representation was presented to the board of player representatives but was not implemented.⁹⁰ Berthelsen stated, “It is something we’ve looked at before But it’s up to our player rep board to decide it.”⁹¹

However, there does seem to be some suspicious activity within the NFLPA that may account for why dual representation was never banned or at least regulated. Gene Upshaw was elected Executive Director of the NFLPA in 1983 and served in that role until 2008.⁹² Additionally, Tom Condon served as NFLPA president from 1984 to 1986.⁹³ Tom Condon, who was the personal agent for Gene Upshaw, was recognized as one of the most powerful agents in sports and engaged in the practice of dual representation.⁹⁴ Condon

84. NATIONAL HOCKEY LEAGUE PLAYERS ASSOCIATION REGULATIONS GOVERNING AGENT CERTIFICATION § 3(B)(9) (2002) [hereinafter NHLPA REGULATIONS].

85. NFLPA REGULATIONS § 3(A)(16).

86. Domowitch, *supra* note 5.

87. See Prisco, *supra* note 6 (stating that the NFLPA has considered prohibiting dual representation).

88. *Id.*

89. *Id.*

90. *Id.*

91. *Id.*

92. Associated Press, *Hall of Famer, NFLPA Executive Director Gene Upshaw Died at 63*, NFL.COM (2008), <http://www.nfl.com/news/story?confirm=true&id=09000d5d80a28802&template=with-video>.

93. *History: 1980’s - Era of Change*, NFL PLAYERS ASSOCIATION, <https://www.nflplayers.com/About-us/History/> (last visited Oct. 30, 2011).

94. Jeff Nixon, *Are NFL Player Agents Influencing the Union?*, FOURTH & GOAL UNITES (Feb. 28, 2011), <http://fourthandgoalunites.com/2011/02/28/are-nfl-player-agents-influencing-the-union/>.

made the decision around 2003 to stop representing coaches while at IMG.⁹⁵ Condon decided it would be a good idea to create a new division for coaches at IMG headed by Gary O'Hagan.⁹⁶ Lamonte commented on IMG's hot pursuit of coaches at the time, saying "They went out and tried to carpet-bomb the entire industry, signing up everybody they can get."⁹⁷ Condon acknowledged the representation of coaches as a growing concern, "it is a business that has grown. . . . That's why I wanted to create the coaches division."⁹⁸ Not surprisingly, not all are convinced that creating a separate division removed super-agent Tom Condon from the picture of representing coaches. Daniel More, an agent for NFL coaches, commented on the new coaching division at IMG, "It's the same deal. . . . You can't tell me that Condon didn't have a hand in the Mariucci deal. He is represented by O'Hagan, but you can bet Condon was in on that."⁹⁹ Additionally, in 2003 when the IMG coaching division was new, Gary O'Hagan was introduced at a NFLCA function during the Senior Bowl.¹⁰⁰ Larry Kennan, Executive Director for the NFLCA and an IMG client, stated the introduction of O'Hagan was not an endorsement.¹⁰¹ Kennan attempted to downplay the incident, stating that "he was there, so I introduced him."¹⁰² Additionally, it was IMG who helped the NFLCA get office space in the same building as the NFLPA.¹⁰³ So when a rule that would prohibit dual representation was presented to the player representative board of the NFLPA, is there any surprise that it was not adopted? Tom Condon, who is regarded as the most powerful agent in sports,¹⁰⁴ represented the Executive Director of the NFLPA. Condon, who himself once represented coaches and arguably never left the business of representing coaches despite moving to the new division at IMG, admitted the lucrative nature of representing coaches.¹⁰⁵

Although Larry Kennan seemed to add to the corruption with his introduction of O'Hagan at an NFLCA event, he did acknowledge a need for change: "It's probably better to try and do something about it before it does become a problem. . . . [Otherwise] it will be too late."¹⁰⁶ Kennan was possibly too late when he made that comment in the early 2000s because coaches' salaries were already on the rise and a number of agents were engaged in representations involving coaches and players on the same team.¹⁰⁷ Regardless, he is definitely too late now, as evidenced by the recent lockout state of the NFL and agents filing declarations siding for their player clients.¹⁰⁸

While the less than transparent activity discussed above is merely academic speculation, there are two clear facts. First, other major North American leagues have

95. Prisco, *supra* note 6.

96. *Id.*

97. *Id.*

98. *Id.*

99. *Id.*

100. *Id.*

101. *Id.*

102. *Id.*

103. *Id.*

104. *Sports Agent Profile: Tom Condon*, SPORTS AGENT DIRECTORY, <http://www.sports-agent/directory.com/sports-agents/tomcondon.asp> (last visited Oct. 5, 2011).

105. See Prisco, *supra* note 6.

106. *Id.*

107. *Id.*

108. See, e.g., Declaration of Donald Yee, *Brady v. NFL*, No. 0:11-CV-00639-RHK-JJG (D. Minn. Mar. 11, 2011), available at <http://docs.justia.com/cases/federal/district-courts/minnesota/mndce/0:2011cv00639/119126/13/0.pdf>.

banned dual representation.¹⁰⁹ Secondly, the NFLPA has decided against implementing legislation to effectively handle the conflict.¹¹⁰

IV. WHOSE SIDE ARE AGENTS ON?

A. NFLCA BRIEF AND AGENTS SIDING WITH PLAYERS

During the recent lockout, the NFLPA restructured itself as a professional association rather than a union and ceased the regulation of player agents.¹¹¹ The NFLCA is a non-union voluntary organization with no authority to regulate agents.¹¹² The NFLCA filed an amicus brief siding with the players' position in the recent NFL labor dispute.¹¹³ On its face, the filing of an amicus brief by the NFLCA siding with the players seems shocking because the coaches are on the management side of the dispute.¹¹⁴ The brief becomes even more questionable in light of the fact the NFLPA and the NFLCA share office space.¹¹⁵ Additionally, the two organizations share legal services: Tom Depaso, who serves as associate general counsel for the NFLPA, provides legal services for the NFLCA,¹¹⁶ and Tim English, the senior staff counsel for the NFLPA, also advises the NFLCA on labor law issues and filing grievances.¹¹⁷ Thus, the NFL was not taken off guard by the amicus brief as evidenced by NFL spokesman Greg Aiello's response: "The Coaches Association offices with the Players Association in Washington. So this comes as no surprise."¹¹⁸

Prior to the filing of the amicus brief by the NFLCA, a number of agents filed declarations with the court in support of the players' motion for a preliminary injunction to the lockout. A number of these agents also have coaches as clients. One such agent, Joby Branion, is an attorney and the Executive Director of Athletes First, which represents both the head coach of the Dallas Cowboys Jason Garrett and Cowboys player Miles Austin.¹¹⁹

109. See, e.g., MLBPA REGULATIONS § 3(B)(5); NHLPA REGULATIONS § 3(B)(9); NBPA REGULATIONS § 3(B)(f).

110. Prisco, *supra* note 6.

111. Declaration of Richard A. Berthelsen in Opposition for Defendants' Motion for a Stay, *Brady v. NFL*, No. 0:11-CV-00639-RHK-JJG (D. Minn. Apr. 27, 2011), available at http://a.espn.com/media/pdf/110427/Berthelsen_declaration.pdf.

112. Brief of NFLCA, *supra* note 69.

113. *Id.*

114. See *Coaches are Management*, *supra* Part II.B.3.

115. Associated Press, *Coaches Side with NFL Players in Lockout Fight*, SPORTING NEWS, <http://aol.sportingnews.com/nfl/feed/2010-09/nfl-labor-talks/story/nfl-coaches-side-with-players-in-lockout-fight> (last visited Oct. 30, 2011).

116. *Biography of Tom DePaso*, GEORGETOWN UNIVERSITY, <http://scs.georgetown.edu/departments/14/master-of-professional-studies-in-sports-industry-management/faculty-bio.cfm?a=a&fld=129832> (last visited Oct. 5, 2011).

117. *Biography of Tim English*, GEORGETOWN UNIVERSITY, <http://scs.georgetown.edu/departments/14/master-of-professional-studies-in-sports-industry-management/faculty-bio.cfm?a=a&fld=1162> (last visited Oct. 14, 2011).

118. Albert Breer, *Citing Job Security, Coaches Side With Players in Labor Dispute*, NFL.COM (May 25, 2011), <http://www.nfl.com/news/story/09000d5d82002f63/article/citing-job-security-coaches-side-with-players-in-labor-dispute>.

119. See *Biography of Joby Branion*, ATHLETES FIRST, <http://www.athletesfirst.net/about/> (last visited Oct. 30, 2011); *Our Clients: Athletes*, ATHLETES FIRST, <http://www.athletesfirst.net/clients/athletes/> (last visited Oct. 30, 2011) (listing Miles Austin as a client); *Our Clients: Coaches & Personnel*, ATHLETES FIRST, <http://www.athletesfirst.net/clients/coaches-and-personnel/> (last visited Oct. 30, 2011) (listing Jason Garrett as a client).

Joby Branion sided with the players in his declaration.¹²⁰ In response to the NFLCA amicus brief, the Dallas Cowboys coaches have made it clear they do not agree with the players' side:

The Dallas Cowboys' coaching staff did not approve of the brief filed with the 8th Circuit Court of Appeals by the National Football League Coaches Association. We did not provide Larry Kennan with the authority to file such brief on our behalf and do not agree with the brief's position.¹²¹

Athletes First also represents the offensive coordinator of the Minnesota Vikings, Bill Musgrave, and Vikings players Toby Gerhart (running back) and John Sullivan (center).¹²² The Minnesota Vikings coaching staff has come out and expressed their opposition to the NFLCA brief, and sided with the players' position.¹²³ Vikings coach Leslie Frazier stated that his coaching staff was never contacted by the association and will "always be supportive of our management. . . . It really doesn't in a lot of ways pertain to us because we had no say in it as a staff. . . . I just know for us being supportive of . . . the Minnesota Vikings organization is where our staff really feels is important to us."¹²⁴ Joby Branion also took the opposing side to his client, General Manager of the St. Louis Rams Billy Devaney.¹²⁵ Branion represents Rams players A.J. Feeley and Laurent Robinson.¹²⁶ Devaney stated the Ram's coaches were unaware of the NFLCA amicus brief and that the coaches "assured me that they weren't informed or consulted about it."¹²⁷ In all three examples, Branion sided with his player clients, a position in direct opposition of his coach/management clients.

Agent Donald Yee, a proponent of "self-policing," serves as agent for New Orleans Saints head coach Sean Payton. He also serves as the agent for multiple NFL players, including Tom Brady, for whom he also acted as personal attorney.¹²⁸ Donald Yee is another agent caught in the dual representation debate and "under penalty of perjury" has sided with the players.¹²⁹ Like Branion, Yee has found himself publicly advocating for the player side of the dispute while his coaching client has publicly come out in opposition of such view. New Orleans Saints linebacker coach Joe Vitt commented in response to the NFLCA brief on behalf of the Saints coaching staff: "We're supporting the owners. . . . I've

120. See Declaration of Joby Branion, *Brady v. NFL*, No. 0:11-CV-00639-RHK-JJG, (D. Minn. Mar. 11, 2011), available at <http://docs.justia.com/cases/federal/district-courts/minnesota/mndce/0:2011cv00639/119126/8/0.pdf>.

121. Rainer Sabin, *Cowboys Coaches Disapprove of NFL Coaches Association Brief Filed in Support of Players*, DALLASNEWS.COM (June 1, 2011), <http://cowboysblog.dallasnews.com/archives/2011/06/cowboys-coaches-disapprove-of.html>.

122. *Our Clients: Athletes*, ATHLETES FIRST, *supra* note 117.

123. ESPN News Services, *More Coaches Disagree with Brief*, ESPN.COM (June 3, 2011), <http://sports.espn.go.com/nfl/news/story?id=6619264>.

124. *Id.*

125. See *Our Clients: Coaches & Personnel*, ATHLETES FIRST, *supra* note 117 (listing Billy Devaney as a client); see also *More Coaches Disagree with Brief*, *supra* note 121 (St. Louis Rams coaches and Billy Devaney not aware of briefs' filing).

126. *Our Clients: Athletes*, ATHLETES FIRST, *supra* note 117 (listing A.J. Feeley as a client; at the time of publication Laurent Robinson was no longer a client).

127. *More Coaches Disagree with Brief*, *supra* note 121.

128. Declaration of Donald Yee, *supra* note 106.

129. *Id.*

said this a million times, our organization has been built on trust. [Owner Tom] Benson has been great to us. Unequivocally, we support our ownership."¹³⁰

Finally, the infamous Neil Cornrich is yet another agent who has filed a declaration on behalf of the players.¹³¹ Cornrich has "represented approximately 125 NFL players" and is the agent for New England Patriots head coach Bill Belichick.¹³² Cornrich has been caught in the crossfire of these recent declarations. A common argument made by agents is that coaches they represent lack General Manager type power, thus there is no conflict of interest with the dual representation.¹³³ In his declaration supporting the players, player agent Frank Bauer stated that "Bill Belichick . . . has substantial influence over all player personnel decisions."¹³⁴ Of course, Cornrich does not take the position that dual representation is not a conflict because of lack of power, but rather takes the business model approach in thinking that any competitive advantage is acceptable.¹³⁵ Yet these recent declarations do not support the notion that dual representation is free of conflicts of interest. First, agents are siding with some clients in direct opposition to other clients. Secondly, agents are generally not able to self-regulate themselves as claimed, especially when they are engaged in dual representations involving coaching clients who wield "GM-type power."¹³⁶

V. A CALL FOR CHANGE

Action must be taken considering the ineffective regulation of agents by the NFLPA exemplified by agents taking positions directly adverse to clients. Of course, non-attorney and attorney agents are still subject to the common law of agency.¹³⁷ Additionally, while non-attorney agents perform the same job as attorney agents, attorney agents are bound by the ethical rules of their respective state when acting as a sports agent.¹³⁸ As NFL sports agents, this is an NFL problem and should be regulated and disciplined within the league. It is those closest to the NFL that have the knowledge and resources necessary to identify and monitor conflicts in dual representation. Individual states may be able to legislate to solve the problem of dual representation. As noted by Professor Rosner of the University of Pennsylvania, professional athletes are to a large extent ignored by state legislation.¹³⁹ Further, it makes sense to have one body governing all sports agents versus

130. *Jags Coaches Question NFLCA's Brief*, ESPN.COM (June 1, 2011), <http://sports.espn.go.com/nfl/news/story?id=6615256>.

131. Declaration of Neil Cornrich, *Brady v. NFL*, No. 0:11-CV-00639-RHK-JJG (D. Minn. Mar. 9, 2011), available at <http://docs.justia.com/cases/federal/district-courts/minnesota/mndce/0:2011cv00639/119126/10/0.pdf>.

132. *Id.*; Domowitch, *supra* note 5.

133. Domowitch, *supra* note 5.

134. Declaration of Frank Bauer, *Brady v. NFL*, No. 0:11-CV-00639-RHK-JJG (D. Minn. Mar. 2, 2011), available at <http://docs.justia.com/cases/federal/district-courts/minnesota/mndce/0:2011cv00639/119126/5/0.pdf>

135. Domowitch, *supra* note 5.

136. *Id.*

137. See RESTATEMENT (SECOND) OF AGENCY § 1. Remember that restatements are treatises on the common law, and not regulations for legal professionals.

138. The Supreme Court of Arizona stated, "As long as a lawyer is engaged in the practice of law, he is bound by ethical requirements of that profession, and he may not defend his actions by contending that he was engaged in some other kind of professional activity. For only in this way can full protection be afforded to the public." *In re Dwight*, 573 P.2d 481, 484 (Ariz. 1977).

139. Scott J. Rosner, *Conflicts of Interest and the Shifting Paradigm of Athlete Representation*, 11 UCLA ENT. L. REV. 193, 239 (2004) (pointing out most state legislation in regards to agents is aimed at protecting college athletes).

the state bar regulating only those sports agents whom are attorneys and leaving the non-attorney agents bound by a less restrictive set of rules.

With the consolidation of the sports agent industry and the majority of sports agents as lawyers, a system of regulation should be implemented that raises the bar in monitoring conflicts of interest.¹⁴⁰ In 2002, 800 of over 1,000 NFL certified agents had zero clients playing in the league and only fifty agents represented fifty percent of NFL players.¹⁴¹ Branion's Athletes First represents over 100 NFL players and ten coaches or management-level employees.¹⁴² Jimmy Sexton's Athletic Resource Management represents roughly forty-five NFL players and over ten NFL coaches or management level employees.¹⁴³ Yee and Dubin Sports represent a number of coaches and over forty NFL players.¹⁴⁴ Lastly, Neil Cornrich represents coaches such as Bill Belichick and roughly twenty-five NFL players.¹⁴⁵

The NFLPA agent regulations do not explicitly prohibit dual representation and seem to permit it subject to a disclosure addendum. However, in examining other provisions of the NFLPA agent regulations, dual representation could be deemed a violation of many provisions in the agent regulations. The regulations require agents to uphold their fiduciary duties to their clients, avoid situations creating an actual or apparent conflict of interest, and abide by all state and federal laws.¹⁴⁶ As discussed above, the dual representation could be a potential breach of fiduciary duty, if not deemed an actual conflict of interest, and runs afoul of common law agency principles. The lack of regulation over the agent/coach relationship and the ineffectiveness of the NFLPA in governing player agents necessitate a new system.

A. CREATION OF AN INDEPENDENT GOVERNING BODY

Given the inability of the NFLPA to regulate agents effectively in the past and the incestuous behavior between the NFLPA and the NFLCA, the NFLPA and NFL should create an independent governing body solely for the regulation of agents as an amendment to the new Collective Bargaining Agreement. Additionally, the fact the NFLPA can decertify and cease the regulation of agents supports the idea of creating an independent governing body that can continue to regulate agents as agent issues continue regardless of the status of the union.¹⁴⁷

The independent governing body would regulate NFL agents—those representing coaches, players, or management—and any front office employee. With its sole function as

140. Over 50% of agents representing players in the NFL, NBA, or MLB are lawyers. Charles B. Lipscomb & Peter Titlebaum, *Selecting a Sports Agent: The Inside for Athletes & Parents*, 3 VAND. J. ENT. L. & PRAC., 95, 99 (2001).

141. Mike Freeman, *Players Union Taking Steps to Exert More Control Over Agents*, N.Y. TIMES, Mar. 10, 2002, <http://www.nytimes.com/2002/03/10/sports/pro-football-inside-nfl-players-union-taking-steps-exert-more-control-over.html>.

142. See *Our Clients: Athletes*, ATHLETES FIRST, *supra* note 117 (listing of player clientele); *Our Clients: Coaches & Personnel*, ATHLETES FIRST, *supra* note 117 (listing of coach and personnel clientele).

143. See *Our Clients: Football*, ATHLETIC RESOURCE MANAGEMENT, *supra* note 25; *Our Clients - Coaches*, ATHLETIC RESOURCE MANAGEMENT, http://www.sextonsports.com/ssp/our_clients?id=20 (last visited Oct. 30, 2011).

144. Domowitch, *supra* note 5.

145. *Id.*

146. See NFLPA REGULATING §§ 2(B)(c), 3, 3(A)(14) (citing breach of fiduciary duty as a ground for denial of certification, stating contract advisors are "to avoid any conflict of interest which could potentially compromise the best interests of NFL players," and stating contract advisors are to "fully comply with state and federal laws," respectively).

147. See Prisco, *supra* note 6 (mentioning the NFLPA's power to decertify agents).

regulating agents, this independent body will be in a better position to avoid the appearance of undue influence we have seen within the NFLPA and the NFLCA. Furthermore, this regulatory group would not be intended to look out for the best interest of the players or coaches, but rather to act as a governing body for ethical behavior for agents. Without allegiance to players or management it is more likely this body can be more effective in regulating agent conduct.

A complete ban on dual representation modeled after the NBA or NHL would offer the most assurance in dealing with the problems associated with dual representation. Short of that, a more moderate approach may be able to effectively regulate the issue while keeping in mind the priorities and concerns of all interested parties. It is acknowledged that all conflicts of interest cannot be eliminated but implementing a regulatory scheme that governs the conflicts in a manageable, ethical way is the desired goal. Conflicts must be managed when they involve “a substantial risk that the [agent’s] representation of the client would be materially and adversely affected by the [agent’s] own interests or by the [agent’s] duties to another current client.”¹⁴⁸

B. THE MODEL RULES AS A GUIDE

The American Bar Association (ABA) Model Rules of Professional Conduct offers a good example of rules to implement for a regulatory body aimed at governing ethical conduct.¹⁴⁹ The ABA is an organization that has made promoting “competence, ethical conduct, and professionalism” as a goal to improving the profession of lawyers.¹⁵⁰ The sports agent industry needs to promote and encourage ethical conduct within the profession by foregoing the current system, which is one centered on personal gain. Additionally, with over fifty percent of professional sports agents also licensed as attorneys, the majority of the NFL agents should be familiar with the ethical rules offered by the ABA. Rather than lower the bar for non-attorney agents, all sports agents should be willing and eager, or at least be forced, to adopt a more ethical and professional approach to the business, in order to do away with the corruption that has been allowed in the sports agent world. Regrettably, agent Jimmy Sexton may have been correct when he stated, “I can see where someone in academic law might see it as a problem, but they don’t work in the business, so they don’t know the rules of the business. . . . We know the rules I don’t think it’s a problem.”¹⁵¹ We can no longer accept biased opinions such as this. Sports agency is a profession and should be bound by professional rules, not the rules agents feel best suit their needs.

Although there are many provisions in the ABA rules that could be used as guidance, this discussion will focus on Model Rule 1.7 to address current conflicts presented by dual representation and Model Rule 1.10 for handling conflicts within large sports agencies such as CAA or Octagon.¹⁵²

VI. PROPOSED REGULATIONS

A. REGULATION BASED ON MODEL RULE 1.7

148. RESTATEMENT (THIRD) OF THE LAW GOVERNING LAWYERS § 121 (2000).

149. MODEL RULES, *supra* note 45.

150. Association Goals, AMERICAN BAR ASS’N, http://www.americanbar.org/utility/about_the_aba/association_goals.html (last visited Oct. 30, 2011).

151. Prisco, *supra* note 6.

152. MODEL RULES, *supra* note 45, at R. 1.7, 1.10.

The author recognizes there are other conflicts of interest within the sports agent business, the most egregious of which occurs when an agent represents two players of the same position on the same team. Unfortunately, the analysis of conflicts other than dual representation of players and coaches are outside the scope of this paper and will not be discussed. The discussion will be divided among scenario one and two, and with respect to the power to negotiate contracts and the power over player personnel decisions.

1. SCENARIO ONE—AGENT REPRESENTS PLAYER AND COACH ON SAME TEAM

An agent representing a player and coach/management on the same team falls under scenario one, described *supra*.¹⁵³ The input any given coach has on player personnel decisions varies by team and by coaching position. For example, the head coach is responsible for the supervision of the entire team and has input over player personnel decision for all positions.¹⁵⁴ The representation of a head coach and any player on the same team should be banned for two reasons: potential conflict of interest and practicality.

As discussed previously, the representation of both a head coach and player presents a potential conflict of interest. As long as the player is performing well and the coach is satisfied with the player's performance no conflict arises. However, if the player begins to underperform and talks of a trade or cut are initiated, the agents' two clients are now adverse parties. Additionally, as former NFL Executive Vice President for Labor Relations Harold Henderson pointed out, there are practical reasons to banning the dual representation of a head coach and player on the same team.¹⁵⁵ It is not in the best interest of the league to have agents who represent coaches gaining an advantage in signing over player-representative agents.¹⁵⁶ An example of a representation that should be banned under the new CBA would include Jimmy Sexton's representation of the former Executive Vice President of Football Operations for the Miami Dolphins Bill Parcells and Dolphins player Phillip Merling, who until Parcells' recent departure were employed by Miami at the same time.¹⁵⁷ Sexton should be limited to representing one or the other.

The regulation of dual representation involving coaches other than the head coach or other high level management should be governed by the position the coach holds with the team and the position of the player. All offensive coordinators have influence in personnel decisions involving offensive players, and likewise defensive coordinators for defensive players. For the same reasons as discussed in banning dual representation of a head coach and any player on the same team, dual representation involving an offensive coordinator and an offensive player should be banned. For example, Joby Branion's representation of Minnesota Vikings offensive coordinator Bill Musgrave and Vikings players Toby Gerhart (running back) and John Sullivan (center) should be banned.¹⁵⁸ Implementation of new agent regulations should force Branion to choose to represent either the players or the offensive coordinator.

The regulations must pay special attention to the representation of special teams coaches and players. Many fringe players, regardless of position, make a team based on their special teams performance. Therefore, the representation of any special teams coach

153. See *supra* Part II.B.1.

154. See, e.g., Mack Brown Contract, *supra* note 47.

155. Domowitch, *supra* note 5.

156. *Id.*

157. Wilson, *supra* note 24.

158. See *Our Clients: Athletes*, ATHLETES FIRST, *supra* note 117 (listing Toby Gerhart and John Sullivan as clients; at the time of publication Bill Musgrave is no longer represented by Sexton).

should be disclosed to the governing body along with all other players represented. If the governing body finds an agent is representing a special teams coach and a fringe special teams player for the same team, the agent should withdraw from one or both representations.

In contract negotiations, it is understood the level of activity coaches play vary by team. NFL agent Brian Mackler commented on the discrepancy, “if you are dealing—let’s take the New York Jets. I don’t have a problem with the agent for Herm Edwards representing a player, because Herm Edwards does not negotiate the contract with me; Terry Bradway and Mike Tannenbaum do.”¹⁵⁹ With regards to head coaches, this is largely irrelevant under the proposed regulations as the dual representation of players and head coaches would be banned for player personnel reasons, regardless of the coaches activity in contract negotiations.

The role an assistant coach plays in contract negotiations may also ban dual representation if such representation has not already been banned for player personnel reasons. For example, an agent represents an offensive coordinator and a free agent defensive player. This representation is not banned for reasons of player personnel decision power and should be permitted under the proposed rules. However, if the offensive coordinator takes an active role in contract negotiations, the coach and player are now directly adverse. The player’s interest is to sign a contract for as much money as possible. The coach is interested in a contract with the least amount of money, especially in the NFL with a salary cap, to free up money to acquire other talent in order to build a winning team. Professor Robert P. Lawry of Case Western University describes the conflict perfectly:

If you’ve got players on the same team as the coach or general manager you represent, you have an irreconcilable conflict. . . You’ve got to get out of it. I don’t know how the hell you can do that. You’re judgment has got to be impaired. Sometimes, conflicts can be managed by disclosure. But in a case when you’re representing both players and coaches on the same team, even disclosure is not going to do it. You’re not going to know if a person held back in doing the kind of negotiation he or she might have done with a level playing field. It just shouldn’t be done.¹⁶⁰

This scenario is analogous to the representation of a buyer and seller in the same transaction.¹⁶¹ Some conflicts can be consented to and the representation may continue. However, some conflicts are deemed non-waivable. A dual representation would be deemed prohibited if the agent cannot “reasonably conclude” he can “provide competent and diligent representation.”¹⁶² Here, a reasonable agent cannot conclude he can provide competent and diligent representation due to impaired judgment. The agent cannot maintain loyalty and independent judgment with regard to each client and therefore cannot ask for a client’s consent to the conflict.¹⁶³

2. SCENARIO TWO—AGENT REPRESENTS PLAYER AND COACH ON DIFFERENT TEAMS

159. *The Seventh Annual Symposium on Legal Issues in Professional Sports*, 14 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 747, 775 (2004).

160. Domowitch, *supra* note 5.

161. MODEL RULES, *supra* note 45, at R. 1.7 cmt. 7.

162. *Id.* at cmt. 15.

163. *Id.* at cmts. 1, 14.

Scenario two only presents potential conflicts. However, this potential conflict can quickly turn into a direct scenario one conflict with a trade or new free agent. For these reasons disclosure is required to explain the possibility that the agent might be required to withdraw in the event a coach or player changes teams creating a scenario one same team conflict. Following full disclosure, the client must then consent to the potential conflict.

3. DISCLOSURE AND CONSENT

The terms disclosure and consent must be defined. The NFLPA regulation requiring an attached addendum is not sufficient to meet the disclosure and consent requirement under the Model Rules of Professional Conduct, and should not be sufficient in a new regulatory system for agents.

Consent from a client shall be deemed ineffective unless the agent “has communicated adequate information and explanation about the material risks of and reasonably available alternatives to the proposed” representation.¹⁶⁴ This means an agent must inform a player of all coaches/management he represents and, alternatively, a coach/management client of all players he represents. Additionally, informed consent requires the client be aware of the relevant circumstances and of the material and reasonably foreseeable ways that the potential conflict could have adverse effects on the interests of that client.¹⁶⁵ The agent must explain that if any client changes teams resulting in a coach/management on the same team as a player the agent must withdraw from one or both of the representations. The agent must inform the client of the possibility of this occurring and tell the client this may be avoided by choosing another agent that does not engage in dual representation of coaches and players. The agent must also give the client “a reasonable opportunity to consider the risks and alternatives and to raise questions and concerns.”¹⁶⁶

The disclosure and consent must be confirmed in writing. The writing “does not supplant the need” for the agent to have a verbal discussion with the client explaining the representation.¹⁶⁷ If the agent takes on new clients presenting a potential conflict the agent must receive informed consent confirmed in writing, even if the potential conflict has arisen after the representation has initiated.

An agent will also be required to disclose their entire client list to the independent body so that the governing body may continue to monitor and regulate conflicts. A failure to keep an updated client list on file with the independent body will make disciplinary action for a violation more likely.

B. REGULATION BASED ON MODEL RULE 1.10—IMPUTED CONFLICTS

In upholding the “principle of loyalty to the client . . . a firm of [agents] is essentially one [agent] for the purposes of the rules governing loyalty to the client.”¹⁶⁸ Therefore, an agency cannot represent both a head coach and a player of the same team (or be involved in any other prohibited representation) even if two separate agents are involved (one agent is representing the player and a separate agent is representing the head coach). This conflict may be avoided with screening, which in the agent business would entail separate coaching and player divisions. In order for separate divisions to be effectively

164. *Id.* at R. 1.0(e).

165. *Id.* at R. 1.7 cmt. 18.

166. *Id.* at cmt. 20.

167. *Id.*

168. *Id.* at R. 1.10 cmt. 2.

screened neither division can have “any participation” in the representation of the player if they are representing the head coach, or vice versa.¹⁶⁹ Further, any fees gained from the representation cannot be shared among divisions.¹⁷⁰

An example of the imputed conflict would be IMG’s separate coaching and player divisions. Shropshire provides a practical test that can be applied to see if the imputed conflict rule should apply, “At the end of the day, you’d have to see where the money is going. . . . [I]f it all goes to the same top from different areas, it’s still under the same umbrella.”¹⁷¹ If it is under the same umbrella, the conflicts are imputed. Without regard to where the money goes, if an agent of the player division is participating in the representation of a coach, the divisions are not separate and the imputed conflict rule applies. So if Condon really had a hand in the Mariucci deal as claimed by Daniel More,¹⁷² under the new regulations this conduct would be subject to discipline. Moreover, the disclosure and consent requirements must include the risks and alternatives of the representation taking into account the potential imputed conflicts of the agency.

VII. CONCLUSION

With the increase of the dual representation of players and coaches, an unruly system of conflicts has emerged. The previous system of regulation has been ineffective in dealing with conflicts of interests with regard to NFL agents. Without action these conflicts will continue to hurt players, coaches and NFL clubs. Now is an appropriate time to begin turning the sports agent business back into a professional system. It is in the best interest of all parties involved, labor and management, to consider regulations to deal with the issues of dual representation. This note has attempted to offer a solution to the problems stemming from the dual representation of players and coaches and created a platform to begin dealing with the other conflicts rampant in the sport agent business.

169. *Id.* at R. 1.10(a)(2)(i).

170. *Id.*

171. Prisco, *supra* note 6.

172. *Id.*

Toddlers, Tiaras, and Pedophilia? The “Borderline Child Pornography” Embraced by the American Public

CHRISTINE TAMER

I. INTRODUCTION

Wearing tiny, tight hot shorts and a cut-off top bearing her midriff, Candi (short for Candace) is coached to “shake that bootie” and “work it.” Everything naturally beautiful about Candi is gone. She has fake hair, a fake tan, fake eyelashes, fake nails, and fake teeth. Scantly clad and covered in makeup, she walks out on stage. They tell her she is doing this for the money, so one day she can go to college and have a better life. Candi plasters on a fake smile and waits for the curtains to rise. She has already done the sexy policewoman, cowgirl, and nurse. This time the theme is “schoolgirl.” The music starts. Wink, booty pop, raised leg, and a shimmy. The million-dollar question: is Candi a 25-year-old stripper in Vegas or a six-year-old child in Nashville, Tennessee? Tuning in to hit television shows like The Learning Channel’s *Toddlers & Tiaras* or Women’s Entertainment’s *Little Miss Perfect* provides the disturbing answer: Candi is a six-year-old beauty pageant princess.

Child beauty pageants started to become the target of increased controversy and media scrutiny after the murder of beauty queen JonBenet Ramsey.¹ As night after night news networks aired videotapes of JonBenet Ramsey “[p]laying the role of an alluring sex kitten,” CBS anchorman Dan Rather criticized the networks, claiming the tapes amounted to “nothing more than kiddy porn.”² Essentially, the JonBenet case “[brought] to the surface both our horror at how effectively a child can be constructed as a sexual being and our guilt at the pleasure we take in such a sight.”³

In 2010, child beauty pageants that convert young girls into “sex puppets adorned with lipstick, mascara, false eyelashes, bleached hair, [and] high heels”⁴ are hardly a thing of the past. The \$5 billion industry draws thousands of participants a year.⁵ The first part of this Note will explore “glitz” child beauty pageants for children under age 13, similar to those featured on TLC and WE TV, and describe the harms such pageants cause to children.⁶ I will argue that these pageants lead to the “sexualization” of children, which is

1. See, e.g., Karen De Witt, *Never Too Young to Be Perfect*, N.Y. TIMES, Jan. 12, 1997 available at <http://www.nytimes.com/1997/01/12/weekinreview/never-too-young-to-be-perfect.html?scp=1&sq=never%20too%20young%20to%20be%20perfect&st=cse>; Frank Rich, *Let Me Entertain You*, N.Y. TIMES, Jan. 18, 1997, available at <http://www.nytimes.com/1997/01/18/opinion/let-me-entertain-you.html>.

2. Henry A. Giroux, *Nymphet Fantasies: Child Beauty Pageants and the Politics of Innocence*, 57 Social Text 31, 37-38 (1998) [hereinafter Giroux I].

3. HENRY A. GIROUX, STEALING INNOCENCE: YOUTH, CORPORATE POWER, AND THE POLITICS OF CULTURE 50 (2001).

4. Mark Davidson, *Is the Media to blame for child sex victims?*, USA TODAY, Sept. 1997, available at http://findarticles.com/p/articles/mi_m1272/is_n2628_v126/ai_19782197/.

5. Henry A. Giroux, *Child Beauty Pageants: A Scene From the “Other America,”* TRUTHOUT, May 11, 2009, available at <http://www.archive.truthout.org/051109A>.

6. While there are many other types of pageants that children participate in, the focus of this paper will be specifically on the “glitz” pageants, rather than “natural pageants,” for children under the age of 13. For a full

not only psychologically harmful to the individual participants but also to society at large. The second and third parts of this Note will provide an overview of the history of child pornography laws and describe why current laws are inadequate and unfit to protect against the harms caused by child “glitz” pageants and the images they conjure in the minds of the American public. Finally, I will present a solution and argue that television stations should at least cease airing these pageants on national television.

II. TODDLERS, TIARAS, & PEDOPHILIA?

Little Miss Perfect and *Toddlers & Tiaras* give audiences a backstage view of child beauty pageants throughout the country.⁷ Each episode follows families as they prepare their children to compete in “glitz” beauty pageants.⁸ Stage moms are seen choreographing dance routines, purchasing \$1,000 dresses, insisting that their children be spray tanned, and adorning the beauty queens with fake nails, hair, and eyelashes. While there is vast public support for legislation against child pornography, Americans support media activities that actually “promote the seduction of children and the incitement of pedophiles.”⁹ Successful shows like *Toddlers & Tiaras*, currently in its third season, and *Little Miss Perfect*, in its second season, bring in millions of viewers in their primetime television spots.¹⁰ For instance, in its second season, *Toddlers & Tiaras* achieved an average of 1.3 million viewers each week.¹¹

It appears Americans are split on the desirability of such pageants. On the one hand, Facebook groups and petitions have been created to ban such television shows for dangerously exploiting and sexualizing children.¹² On the other hand, some parents argue that pageants allow their children to build positive qualities such as poise, individuality, and confidence.¹³ In a prepared response to the petitions against pageants, Eileen O’Neill, president and general manager of TLC, said *Toddlers & Tiaras* chronicles a variety of types of beauty pageants, in which more than 100,000 young children participate annually. “Their motivation for participating is as wide and varied as the pageants themselves,” the statement reads. “TLC is merely chronicling the prep work that goes into these events and tracing the competition of three families participating in each episode. These stories are told from an objective and unfiltered perspective . . .”¹⁴ WE TV’s website actually has a

summary of what “glitz pageants” entail, see Susan Anderson, HIGH GLITZ: THE EXTRAVAGANT WORLD OF CHILD BEAUTY PAGEANTS 8–14 (2009). As described by Anderson, “glitz” is a subgenre of child beauty pageants characterized by couture costumes and a broad array of cosmetic preparations including, among other tricks of the trade: glamour makeup, elaborate hairstyles, and “flippers” (false front teeth veneers).

7. See *Toddlers and Tiaras*, TLC, <http://tlc.discovery.com/tv/toddlers-tiaras/about-toddlers-and-tiaras.html>; *Little Miss Perfect*, WE TV <http://www.wetv.com/little-miss-perfect/>.

8. See *Little Miss Perfect*, WE TV, <http://www.wetv.com/little-miss-perfect/>.

9. Davidson, *supra* note 4, at 1.

10. Peter Sheridan, *Truth About the Beauty Queen Kids*, EXPRESS YOURSELF, May 19, 2011, available at <http://www.express.co.uk/posts/view/247535>.

11. Hollie McKay, *Parents of Children on TLC’s ‘Toddlers in Tiaras’ Hurting Their Kids, Critics Say*, FOX NEWS, June 03, 2010, <http://www.foxnews.com/entertainment/2010/06/03/tlcs-toddlers-tiaras-returns-critics-say-parents-exploitive/>.

12. Mike Zettel, *Teens Want Pageant Show off TV*, NIAGARA THIS WEEK, Feb. 11, 2009, available at 2009 WLNR 2746541; see also Carmela Fragomeni, *Students Petition to Ban TV Shows Beauty Pageant for kids, ‘Creepy’*, HAMILTON SPECTATOR, Feb. 4, 2009, at A5.

13. Jolanda Charles, *Exploring Child Beauty Pageants: Empowerment or Sexualization?*, THE TRINIDAD GUARDIAN, May 28, 2009, available at <http://test.guardian.co.tt/index.php?q=features/life/2009/05/28/exploring-child-beauty-pageants>.

14. Zettel, *supra* note 12, at 2.

disclaimer that *Little Miss Perfect* “in no way represents or implies a position by the network on any of the content.”¹⁵

On an international level, most other countries do not have the same history of “glitz” child beauty pageants as the United States, and many fear the introduction of such “American-style” pageants. For instance, a government official in Thailand recently ordered the removal of the swimsuit category from a child beauty pageant because such a “contest could stir sexual fantasies in some audience members while others might be tempted to have sex with a child prostitute.”¹⁶ Moreover, as recently as five years ago, there were no child beauty pageants in the United Kingdom.¹⁷ A short time ago, in Ireland, psychologists and parents were outraged over an “American-style beauty contest” with plans to come to South Wales.¹⁸ Additionally, early childhood experts in Australia recently sought to ban a “US-style pageant.”¹⁹ In sum, “glitz” child beauty pageants are rooted in the United States and their potential expansion is a concern among other countries in the world.

Once upon a time, child “glitz” pageantry was largely considered a product of Southern subculture, but recently the industry has enjoyed widespread popularity and, as such, it deserves to be critically analyzed.

A. IT IS ALL FUN AND GAMES UNTIL SOMEONE GETS HURT

Child beauty pageants have detrimental effects on their young participants. Several child therapists believe that beauty pageants are harmful to child development and make children especially prone to psychological disorders.²⁰ William Pinsof, a clinical psychologist and president of the Family Institute at Northwestern University, warns that transforming a child into “a little Barbie doll . . . can unleash a whole complex of destructive self-experiences that can lead to eating disorders and all kinds of body distortions in terms of body image.”²¹ The American Psychological Association Task Force on the Sexualization of Girls (“APA Task Force”) confirms that there is a dangerous connection between young girls who are exposed to sexuality early in life and the onset of eating disorders, low self-esteem, and depression.²² Moreover, the APA Task Force has found that sexualizing young girls undermines the confidence of girls, leading to negative emotional consequences of shame, anxiety, and self-disgust and has been directly linked to harmful consequences in regard to a girl’s ability to be sexually healthy and assertive.²³

15. Posting of Stacy Dittrich to <http://womenincrimeink.blogspot.com/2010/02/child-pageant-tv-shows-pedophiles-haven.html>, (Feb. 15, 2010, 02:30 EST).

16. *Kids Swimsuit Pageant Barred*, THE NATION, May 27, 2003, available at 2003 WLNR 90979078.

17. *Three delves into the growing world of the UK beauty pageant industry*, PRESSWIRE, (May 4, 2010), http://goliath.ecnext.com/coms2/gi_0199-12674435/BBC-Three-delves-into-the.html.

18. See Clare Hutchinson, *Experts’ fears over US-style child beauty pageant plan*, SOUTH WALES ECHO, Mar. 8, 2010, available at 2010 WLNR 4845785.

19. Cheryl Critchley, *No ban...but blast for tots with tiaras*, HERALD SUN, Apr. 8, 2010, available at 2010 WLNR 7186822.

20. See, e.g., Charleton Kenrick, *Are Child Beauty Pageants Bad for Children?*, Family Education, <http://life.familyeducation.com/emotional-development/girls-self-esteem/41305.html>.

21. See Julia Prodis, *Child Pageants’ World A Blur of Crowns, Gowns: Experience Can be Healthy, Parents Say*, DAILY NEWS LOS ANGELES, Jan. 19, 1997, available at <http://www.thefreelibrary.com/CHILD+PAGEANTS'+WORLD+A+BLUR+OF+CROWNS,+GOWNS+%3A+EXPERIENCE+CAN+BE...-a083852386>.

22. EILEEN L. ZURBRIGGEN ET AL., REPORT OF THE APA TASK FORCE ON THE SEXUALIZATION OF GIRLS, (American Psychological Association ed., 2010), available at <http://www.apa.org/pi/women/programs/girls/report-full.pdf> [hereinafter APA Report].

23. *Id.* at 22, 32 (finding that sexualization may also cause adverse effects on a young girls educational success and achievement and that studies show the sexualization of girls contributes to sexual harassment and coercion).

According to the APA Task Force, sexualization occurs when “sexuality is inappropriately imposed upon a person,” when a person is “made into a thing of others’ sexual use,” when a person is “held to a standard that equates physical attractiveness with being sexy,” or when a person’s value comes from her sexual appeal or behavior to the exclusion of other characteristics.²⁴ Unfortunately, young beauty pageant participants are being sexualized, and such sexualization causes serious harm to the children, their relationships, and society in general.²⁵ As described by columnist Henry A. Giroux, “Watching a two-year old parade around the stage in a velcro rip-away outfit in stripper-like fashion induces more than repulsion; it also raises questions about the limits of subjecting kids to such pornographic practices and the distorted values these pageants provide for them.”²⁶

In summary, while the sexualization of young girls has been widely associated with body dissatisfaction, eating disorders, and depression, the pageant industry nevertheless encourages young girls to parade around in provocative clothing and strive to achieve a “Barbie-like” sexuality.

B. THE SEXUAL EXPLOITATION OF MINORS

It is more than simply “developmentally inappropriate to teach a six year old to pose like a twenty one year old model,” it also has dangerous effects on society to embrace these sexualized images of young children.²⁷ Psychologist Anthony Graziano, co-director of the Research Center for Children and Youth at the State University of New York at Buffalo, notes the “fake beauty” and vulnerability of the images of child beauty queens “get the pedophile” and are “very appealing to a child molester.”²⁸ While psychologists believe more research is needed on the effects of adults viewing sexualized images of children, many agree that such images provide justification and a market for child pornography.²⁹

A study using “barely legal” pornography (images that did not rise to the level of child pornography as defined by federal law) found that viewing such images resulted in a stronger mental association between neutral (nonsexual) images of children and words related to sex.³⁰ The findings suggest that viewing sexualized images of children lead viewers to inappropriately associate children with sex. Dr. Nancy Irwin, a Los Angeles-based psychotherapist, urges parents to recognize the harm they are causing their children by putting them on the show *Toddlers & Tiaras*:

“As a treatment professional of sex offenders as well as victims of sexual abuse, I would like the parents of these little girls to assume responsibility for their choices. They are sexualizing their young children. Do not be surprised if your child is preyed upon as a result of this high degree of visibility. Men can pose as agents/managers and track you/your girl down

24. *Id.* at 1.

25. *See id.* (describing how sexualization contributes to impaired cognitive performance, body dissatisfaction, and a societal tolerance of sexual violence); *see also*, McKay, *supra* note 11.

26. Giroux, *supra* note 5.

27. Rebecca A. Eder, Ann Digirolamo, & Suzanne Thompson, *Is Winning a Pageant Worth a Lost Childhood?*, ST. LOUIS POST-DISPATCH, Feb. 24, 1997, at 7B.

28. Mary Voboril, *Pageants 'R' Us*, NEWSDAY, Jan. 23, 1997, at B6.

29. ZURBRIGGEN ET AL., *supra* note 22, at 33.

30. *Id.* at 34.

through the show. Further, know that they will be pleasuring themselves while looking at your daughter's YouTube clip."³¹

According to the APA, when children are dressed to resemble adult women, "adults may project adult motives as well as an adult level of responsibility and agency on girls."³² These sexualized images can serve to normalize abusive practices such as child abuse, child pornography, and child prostitution.³³ For instance, a 1986 report on child pornography and pedophilia prepared for the United States Senate stated, "[a] pedophile needs to know or to convince himself that his obsession is not 'abnormal' and dirty, but is shared by thousands of other intelligent, sensitive people."³⁴ *Toddlers & Tiaras* and *Little Miss Perfect* may risk showing the pedophile that millions of viewers share his desire to observe children in a sexually mature way, which reinforces a pedophile's belief that "because so many others engage in the same activity, it must not be as 'wrong' as society believes."³⁵ Thus, the images of child beauty queens may serve to foster and validate a pedophile's desires.

An understanding of the minds of pedophiles helps highlight the vast harm of intentionally putting children in a sexual light. In his book, *Unspeakable Acts: Why Men Sexually Abuse Children*, Professor Pryor attempts to understand child sexual abuse by talking to perpetrators.³⁶ Pryor investigated why sexual perpetrators change preferring adults as sexual partners to molesting children.³⁷ Because 97 percent of male offenders classify themselves as "situation-based offenders," Pryor sought to determine what situations caused these men to start abusing children.³⁸ Pryor discovered that, for many of the men he interviewed, one of the first steps toward abuse was becoming aware the child was physically maturing.³⁹ Additionally, many offenders claimed victims suddenly showed an interest in sex, leading them to think that the victims were inviting sexual activity.⁴⁰

Dangerously, child beauty queens are made to look physically mature and sexually inviting through their costumes, make-up, and performances. While, as we will see below,

31. McKay, *supra* note 11; Pedophilia, a psychosexual disorder with a "pathological use of sexual fantasies, behaviors, or objects as a stimulus for sexual excitement" focused on prepubescent children (generally thirteen years or younger in age), manifests itself characteristically in need-driven behavior that is uncontrollable by the pedophile, and is "persistent, compulsive, and fantasy-driven." Dina I. Oddis, *Combating Child Pornography on the Internet: The Council of Europe's Convention on Cyber Crime*, 16 TEMP. INT'L & COMP. L.J. 477, 516 (2002) (citing AMERICAN PSYCHIATRIC ASSOCIATION, AMERICAN PSYCHIATRIC ASSOCIATION: DIAGNOSTIC AND STATISTICAL MANUAL OF MENTAL DISORDERS 568, 571, (4th ed. 2000)); In hearings before the Senate Judiciary Committee on the CPPA, Dr. Victor Cline, a clinical psychologist and psychotherapist specializing in the treatment of sexual compulsions and addictions, stated: "[P]edophiles, in my clinical experience, use child pornography and/or create it to stimulate and whet their sexual appetites which they masturbate to, then later use as a model for their own sexual acting-out with children . . . The man always escalates to more deviant material and the acting-out continues and escalates, despite very painful consequences . . . Some also use it to seduce children into engaging in sexual acts with themselves." *Child Pornography Prevention Act of 1995: Hearing on S. 1237 Before the S. Jud. Comm.*, 104th Cong. 35 (1996) (statement of Dr. Victor Cline, Emeritus Professor in Psychology, University of Utah, clinical psychologist & psychotherapist).

32. ZURBRIGGEN ET AL., *supra* note 22, at 34.

33. *Id.*

34. Permanent Subcomm. On Investigations of the Comm. On Gov't Affairs, Child Pornography and Pedophilia, S.Rep. No. 99-537, at 10 (1986).

35. *Id.*

36. Douglas W. Pryor, *Unspeakable Acts: Why Men Sexually Abuse Children* 91 (1996).

37. Lisa Hewitt, Book Note, *Unspeakable Acts: Why Men Sexually Abuse Children*, 3 J.L. & FAM. STUD. 120 (2001).

38. Pryor, *supra* note 36, at 91.

39. Hewitt, *supra* note 37, at 115, 120.

40. *Id.*

such images of children do not amount to the legal definition of "child pornography," they are similarly problematic on a psychological level. Certainly, sexualized images of children are not a justification or excuse for a pedophile's perverted desires, but many psychologists agree that parents are potentially harming their children by presenting them as sexually mature.⁴¹

III. AN OVERVIEW OF CHILD PORNOGRAPHY LAW

Laws against child pornography have dramatically evolved over the past thirty-five years. While statutes aimed at punishing those who produce or view child pornography have expanded in several ways, in many other ways they are still inadequate to protect children. Part II of this paper will explore the history of child pornography laws and highlight what is considered "sexually explicit conduct" under the current state of the law.

A. THE EVOLUTION OF CHILD PORNOGRAPHY LAW

In 1978, Congress passed the Protection of Children Against Sexual Exploitation Act, making it unlawful to use children engaged in "sexually explicit conduct for the purpose of producing any visual depiction of such conduct."⁴² While representing the first federal protection of children from sexual exploitation, the Act proved problematic in that the definition of "sexually explicit conduct" was linked to the *Miller v. California* obscenity test.⁴³ The three-part *Miller* test asked the following: (1) whether the average person would find the speech "taken as a whole, appeals to prurient interest" in sex; (2) whether it is "patently offensive;" and (3) "whether the work taken as whole, lacks serious literary, artistic, political, or scientific value."⁴⁴ Because the drafters of the 1978 Protection of Children Against Sexual Exploitation Act thought they were limited by the *Miller* obscenity standard, protection under the Act was largely limited to "hardcore" child pornography.⁴⁵

However, in 1982, the Supreme Court in *New York v. Ferber* proclaimed child pornography a new category of speech without constitutional protection and held "non-obscene" sexual depictions of children could be constitutionally restricted.⁴⁶ The Court noted the production of child pornography required an act of abuse on the child, which was sufficient to deny First Amendment protection, and held the social harm caused by child pornography always exceeded its social or artistic value.⁴⁷ The Supreme Court in *Ferber* enumerated five considerations to support its reasoning: (1) the state had a compelling interest in safeguarding, both physically and psychologically, the well-being of children; (2) the distribution of child pornography was directly related to the sexual abuse of children; (3) the promotion and sale of these materials provided a monetary incentive for producing illegal child pornography; (4) such materials had little value; and (5) denying protection to child pornography was consistent with precedent.⁴⁸ Thus, the *Miller* test was no longer relevant when considering child pornography. As Justice O'Connor noted, "[a] 12-year-old

41. Voboril, *supra* note 28.

42. Protection of Children Against Sexual Exploitation Act of 1977, Pub. L. No. 95-225, 92 Stat. 7 (1978) (codified as amended at 18 U.S.C. §§ 2251-2252, 2256 (2006)).

43. See *Miller v. California*, 413 U.S. 15, 36 (1973). (First time cited, Sween always made us put full name. Haven't found that specifically in the bluebook though...)

44. *Id.* at 24 (seeking to balance freedom of sexual expression with preventing illegal conduct, the Court limited the permissible scope of obscenity regulation to conduct "specifically defined by applicable state law" and materials "which taken as a whole, do not have serious literary, artistic, political, or scientific value.").

45. See *id.*

46. *New York v. Ferber*, 458 U.S. 747, 756 (1982).

47. *Id.* at 759, 762-63.

48. *Id.* at 756-65.

child photographed while masturbating surely suffers the same psychological harm whether the community labels the photograph ‘edifying’ or ‘tasteless.’”⁴⁹ Further, “[t]he audience’s appreciation of the depiction is simply irrelevant to [a state’s] asserted interest in protecting children from psychological, emotional, and mental harm.”⁵⁰

Soon after the decision, Congress passed the Child Protection Act of 1984 (“CPA”).⁵¹ Alluding to *Ferber*, Congress recognized “the use of children as subjects of pornographic materials is harmful to the psychological, emotional, and mental health of the individual child.”⁵² The CPA defined child pornography as “any visual depiction, including any photograph, film, video, [or] picture . . . of sexually explicit conduct.”⁵³ The statute outlined sexually explicit conduct as “actual or simulated—(i) sexual intercourse, including genital-genital, oral-genital, anal-genital, or oral-anal, whether between persons of the same or opposite sex; (ii) bestiality; (iii) masturbation; (iv) sadistic or masochistic abuse; or (v) lascivious exhibition of the genitals or pubic area of any person.”⁵⁴

After the 1984 Act was passed, the world began to rapidly change and become more technologically advanced.⁵⁵ In response to new computer-imaging technology that generated images virtually indistinguishable from images of actual children engaging in sexual conduct, Congress enacted the Child Pornography Prevention Act (“CPPA”) in 1996.⁵⁶ The CPPA amended the definition of child pornography to include any image that “is, or appears to be, of a minor engaging in sexually explicit conduct” and included any material promoted in a manner that “convey[ed] the impression that the material is or contains a visual depiction of a minor engaging in sexually explicit conduct.”⁵⁷ However, in 2002, the Supreme Court held the CPPA’s definition of child pornography to be unconstitutionally overbroad in *Ashcroft v. Free Speech Coalition*.⁵⁸ First, the Court established that the CPPA prohibited conduct that was not obscene under the *Miller* test.⁵⁹ Next, the Court reasoned that the CPPA was invalid under *Ferber* because it failed to disallow the conduct it purported to forbid: sexual abuse of children.⁶⁰ The Court stated that virtual child pornography did not, in its production, require the victimization of children.⁶¹ Additionally, the Court said the Government could not prohibit virtual pornography simply because it “whets the appetite” as such a prohibition would control private thoughts.⁶²

Congress went back to the drawing board and proposed the Prosecutorial Remedies and Other Tools to end the Exploitation of Children Today (“PROTECT”) Act of

49. *Id.*

50. *Id.* at 774–75 (O’Connor, J., concurring).

51. Child Protection Act of 1984, Pub. L. No. 98-292, 98 Stat. 204 (codified as amended at 42 U.S.C. 522, 2251-2255 (2006)).

52. *Id.* at § 2251.

53. *Id.* at § 2256.

54. *Id.* at § 2256(2)(A).

55. See Lydia W. Lee, *Child Pornography Prevention Act of 1996: Confronting the Challenges of Virtual Reality*, 8 S. CAL. INTERDISC. L.J. 639, 660 (1999) (“From the point of view of the child molester, virtual child pornography is arguably an even more efficient tool than real child pornography in accomplishing the ultimate goal of seduction.”).

56. Child Pornography Prevention Act of 1996, Pub. L. No. 104-208, § 121, 110 Stat. 3009 (1996) (codified as amended at 18 U.S.C. §§2251–2252, 2256 (2008)), *invalidated in part by* *Ashcroft v. Free Speech Coalition*, 535 U.S. 234 (2002).

57. *Id.* at § 121.

58. 535 U.S. at 234–35, 243, 257 (2002) (overturning a definition encompassing adult actors who appear to be minors as well as computer-generated images of children).

59. *Id.* at 246.

60. *Id.* at 250.

61. *Id.*

62. *Id.* at 253.

2003.⁶³ The PROTECT Act criminalized “any visual depiction . . . of sexually explicit conduct, where the production . . . involves the use of a minor . . . [that] is a digital image, computer image, or [CGI] that is, or is indistinguishable from . . . a minor . . . or [that] has been created, adapted, or modified to appear that an identifiable minor is engaging in sexually explicit conduct.”⁶⁴

B. DEFINING “SEXUALLY EXPLICIT CONDUCT”

Congress defines “sexually explicit conduct” as including “lascivious exhibition of genitals or pubic area” of a minor.⁶⁵ In *Massachusetts v. Oakes*, the Supreme Court granted certiorari on the issue of overbreadth with regard to a Massachusetts statute prohibiting adults from posing or exhibiting nude minors for purposes of visual representation or reproduction.⁶⁶ On remand, following a change in the Massachusetts law, the trial court upheld the conviction of a stepfather for photographing his aspiring model stepdaughter partially nude.⁶⁷ In *Osborne v. Ohio*, the Supreme Court upheld a statute prohibiting pictures depicting children in “lewd exhibition” of nudity or with a “graphic focus on the genitals.”⁶⁸ In *Osborne*, the Supreme Court distinguished between “innocuous photographs of naked children” and “lewd exhibitions of nudity.”⁶⁹ The Court stated, “depictions of nudity, without more, constitute protected expression.”⁷⁰

The development of the definition of child pornography in lower courts indicates that pictures of clothed children can be considered a “lascivious exhibition of the genitals.” In *United States v. Knox*, the defendant purchased videotapes in which the videographer zoomed in on the genital areas of clothed female children.⁷¹ In the tapes, girls between the ages of ten and seventeen wore bikini bathing suits, leotards, and underwear.⁷² The tapes were set to music and, in some scenes, “the child subjects were dancing or gyrating in a fashion not natural for their age.”⁷³ The court determined that the defendant’s conviction should be upheld, explaining that nudity was not required for there to be a lascivious exhibition of the genitals, and such an exhibition could exist “when a photographer unnaturally focuses on a minor child’s clothed genital area with the obvious intent to produce an image sexually arousing to pedophiles.”⁷⁴

Some states have expanded the definition of child pornography beyond the federal statute to include portions of the breast and buttocks, in addition to the pubic region. For instance, in Utah, illegal child pornography requires “sexually explicit conduct” which includes “the visual depiction of nudity or partial nudity for the purpose of causing sexual

63. Prosecutorial Remedies and Other Tools to end the Exploitation of Children Today Act of 2003, Pub. L. No. 108-21, 117 Stat. 650 (codified as amended at 18 U.S.C. §§ 2252, 2256, 1466A (2008)) (criminalizing “[a]ny person who . . . produces . . . a visual depiction of any kind, including a drawing, cartoon, sculpture, or painting, that depicts a minor engaging in sexually explicit conduct and is obscene, or depicts an image that is, or appears to be, of a minor engaging in [sexually explicit conduct] and lacks serious literary, artistic, political, or scientific value.”).

64. 18 U.S.C. § 2256(8)(A)–(C) (2008) For a definition of “minor” as “any person under the age of eighteen years,” see *id.* at § 2256(1).

65. See *id.* at § 2256(2)(A)(v).

66. *Massachusetts v. Oakes*, 495 U.S. 103 (1990).

67. *Commonwealth v. Oakes*, 551 N.E.2d 910, 911 (Mass. 1990).

68. 495 U.S. 103, 113 (1990) (quoting *State v. Young*, 525 N.E.2d 1363, 1368 (Ohio 1998)).

69. *Id.* at 114.

70. *Id.* at 112 (Cf. *N.Y. v. Ferber*, 458 U.S. 747, 765 n.18).

71. *United States v. Knox*, 32 F.3d 733, 737 (3d Cir. 1994).

72. *Id.* at 733.

73. *Id.*

74. *Id.* at 750, 754.

arousal of any person.”⁷⁵ It defines “nudity or partial nudity” as “any state of dress or undress in which the human genitals, pubic region, buttocks, or the female breast, at a point below the top of the areola, is less than completely and opaquely covered.”⁷⁶

United States v. Dost is widely considered the leading case on the meaning of “lascivious exhibition.”⁷⁷ The *Dost* court set forth a six-part test for analyzing whether a picture constitutes “lascivious exhibition”:

1) [W]hether the focal point of the visual depiction is on the child’s genitalia or pubic area; 2) whether the setting of the visual depiction is sexually suggestive, i.e., in a place or pose generally associated with sexual activity; 3) whether the child is depicted in an unnatural pose, or in inappropriate attire, considering the age of the child; 4) whether the child is fully or partially clothed, or nude; 5) whether the visual depiction suggests sexual coyness or a willingness to engage in sexual activity; 6) whether the visual depiction is intended or designed to elicit a sexual response in the viewer.⁷⁸

Importantly, the court noted, “a visual depiction need not involve all of these factors to be a ‘lascivious exhibition of the genitals or pubic area.’ The determination will have to be made based on the overall content of the visual depiction, taking into account the age of the minor.”⁷⁹ In regard to the age of the child, the court explained: “A child of very tender years, because of his innocence in matters sexual, would presumably be incapable of exuding sexual coyness. Sexual coyness is an expression outside the young child’s range of experience.”⁸⁰

In *Knox*, the defendant argued that “lascivious exhibition of the genitals or pubic area” required “that the genitals or pubic area must be unclad or nude, and fully exposed to the camera, before an exhibition may occur.”⁸¹ Applying the *Dost* factors, the Third Circuit held that “exhibition” did not require nudity or the ability to see the genitalia, or outline of the genitals, through the clothing.⁸² The videotapes at issue in the case met the definition of “lascivious exhibition of the genitals or pubic area” because the camera focused for extended periods of time on the clothed pubic area and “the obvious purpose and inevitable effect of the videotape was to ‘attract notice’ specifically to the genitalia and pubic area.”⁸³

Some courts hold the sixth *Dost* factor requires an examination of the intended effect of the image on an audience of pedophiles. As the *Knox* court explained, “lasciviousness” describes material “presented by the photographer [so] as to arouse or satisfy the sexual cravings of a voyeur.”⁸⁴ Similarly, the Ninth Circuit stated that the focus

75. Utah Code Ann. § 76-5b-103(1)(a) & (10)(f) (2011).

76. *Id.* at § 76-5b-103(8).

77. *United States v. Dost*, 636 F. Supp. 828 (S.D. Cal. 1986), *aff’d sub nom.*, *United States v. Wiegand*, 812 F.2d 1239 (9th Cir. 1987) (adopted by the First Circuit in *United States v. Amirault*, 173 F.3d 28, 31 (1st Cir. 1999), the Third Circuit in *United States v. Knox*, 32 F.3d 733, 747 (3d Cir. 1994), the Fifth Circuit in *United States v. Rubio*, 834 F.2d 442, 448 (5th Cir. 1987), the Eighth Circuit in *United States v. Horn*, 187 F.3d 781, 789 (8th Cir. 1999), and the Tenth Circuit in *United States v. Wolf*, 890 F.2d 241, 244–46 (10th Cir. 1989)).

78. *Dost*, 636 F. Supp. at 832.

79. *Id.*

80. *Id.*

81. *United States v. Knox*, 32 F.3d 733, 744 (3d Cir. 1994).

82. *Id.* (“[The] plain meaning of the term ‘exhibition’ is confirmed by reference to a popular dictionary of the English language, which defines ‘exhibit’ as [t]o display; as: a. [t]o present for consideration; set forth . . . b. [t]o present to view; to show, esp. in order to attract notice to what is interesting or instructive . . .”).

83. *Id.* at 745–46.

84. *Id.* at 747 (quoting *Wiegand*, 812 F.2d at 1244–45).

should be on the photographer's subjective intent to arrange the composition to satisfy his or like-minded pedophiles' sexual appetite.⁸⁵ Under such an approach, "lasciviousness is not a characteristic of the child photographed but of the exhibition" that was "arrayed . . . to suit [the pedophile's] peculiar lust."⁸⁶ The concern then is not with the sexual response of an average viewer, but rather of the pedophile viewer.

Other courts examine the actual photograph rather than the likely response of the viewer of the image. In *United States v. Villard*, the court "look[ed] at the photograph, rather than the viewer."⁸⁷ The court explained, "[w]hen a picture does not constitute child pornography, even though it portrays nudity, it does not become child pornography because it is placed in the hands of a pedophile, or in a forum where pedophiles might enjoy it."⁸⁸ Similarly, the First Circuit announced, "the focus should be on the objective criteria of the photograph's design" because otherwise "a deviant's subjective response could turn innocuous images into pornography."⁸⁹

IV. THE PROBLEM OF APPLYING THE CURRENT LAW TO "LITTLE MISS PERFECT"

Although the images consisting of young girls participating in glitz pageants may have a sexual appeal, it is unlikely the images constitute child pornography under federal law. The first part of this section will attempt to craft an argument largely based in policy that under the current law, images of children dressed as 25-year-old strippers constitutes child pornography. Then, I will show why under current law, unfortunately, it is practically impossible to classify these images as child pornography.

A. DAN RATHER WAS RIGHT; THIS IS "KIDDY PORN"

Images of children made up to look like 25-year-olds in scant clothing should be considered child pornography.⁹⁰ While these children are not "nude," according to the *Knox* case, it is clear that nudity is not a requirement.⁹¹ To determine whether these images are "lewd" or "lascivious," we start by applying the *Dost* factors. First, it is established that not all of the factors need to be present for an image to be a "lascivious exhibition."⁹² Taking into account the average age, around 5 years old, of the typical child showcased on *Toddlers*

85. *Wiegand*, 812 F.2d at 1244.

86. *Id.* at 1244.

87. *United States v. Villard*, 885 F.2d 117, 125 (3d Cir. 1989).

88. *Id.* In her article in the *Columbia Law Review*, Amy Adler argues child pornography law itself has changed our view of children because it requires us to look at the world as a pedophile does. Amy Adler, *The Perverse Law of Child Pornography*, 101 COLUM. L. REV. 209, 265 (2001). As Adler points out, "[t]he law requires us to study pictures of children to uncover their potential sexual meanings, and in doing so, it explicitly exhorts us to take on the perspective of the pedophile." *Id.* In doing so, some argue that it is society's "obsession with child pornography [that] has created an environment where children are commonly regarded as sex objects." Emily D. Goldberg, *How the Overturn of the Child Pornography Prevention Act Under Ashcroft v. Free Speech Coalition Contributes to the Protection of Children*, 10 CARDOZO WOMEN'S L.J. 175, 199 (2003). Because we are urged to look at the world for the perspective of a pedophile, "images that once seemed innocent are now terrifying because they are read as explicitly erotic" and, henceforth, "child pornography law has the unintentional effect of heightening the sexual allure of children." *Id.*

89. *U.S. v. Amirault*, 173 F.3d 28, 34 (1st Cir. 1999) (holding a photo of a naked female child on the beach was not a "lascivious exhibition of the genitals").

90. See the *Toddlers & Tiaras* website for examples of images of child beauty queens that are inappropriate and sexually suggestive. <http://tlc.howstuffworks.com/tv/toddlers-tiaras/toddlers-and-tiaras-pictures.htm>.

91. *U.S. v. Knox*, 32 F.3d 733, 744 (3d Cir. 1994).

92. *U.S. v. Dost*, 636 F. Supp. 828, 832 (S.D. Cal. 1986) (noting that a "visual depiction need not involve all of these factors to be a lascivious exhibition") (internal quotations omitted).

& *Tiaras* or *Little Miss Perfect*, *Dost* factors two, three, five, and six should be met.⁹³ The depiction of a child dancing provocatively in scant clothing will likely be found to be “sexually suggestive” under factor two. Under factor three, the attire (lots of makeup, fake teeth, false eyelashes, spray tan, fake hair, sexy outfits) and pose of the child (generally engaging in hip thrusting dances) are very inappropriate for the age of the child. Under factor five, the child appears to be showing a “sexual coyness” in that the outfits and images as a whole are often as daring as those in Victoria’s Secret catalogues. The dancing and outfits combined, as in *Knox*, show the child engaging in “gyrat[ions] . . . indicative of adult sexual relations.”⁹⁴ Finally, applying the sixth factor, whether viewed from a pedophile’s perspective or as a self-contained universe, the image is likely designed to elicit a sexual response in the viewer. The material in question would likely “appeal to the lascivious interest of an audience of pedophiles.”⁹⁵

While the images are not focusing on the pubic area, there is, nonetheless, documented evidence of psychological harm to a child whose sexuality is exploited by her parents for personal profit.⁹⁶ The Supreme Court, in the context of holding child pornography outside the scope of First Amendment protection, found that “[t]he prevention of sexual exploitation and abuse of children constitutes a government objective of surpassing importance.”⁹⁷ While there is no evidence that every child forced to participate in pageants are physically abused, the Supreme Court is concerned about the psychological well-being of minors who may be scarred emotionally when their sexuality is exploited.⁹⁸ The Court’s reason for classifying child pornography as unprotected speech is that it harms the “‘physiological, emotional, and mental health of children,’ and thus regulation is permissible . . . when targeted at the evils of the production process itself . . .”⁹⁹ Furthermore, the Court holds that child pornography is abusive, in part, because the images “produced are a permanent record of the children’s participation and the harm to the child is exacerbated by their circulation.”¹⁰⁰

With regard to child beauty pageants, all of these concerns are arguably present. The images are a record of the child’s participation in the production of images that exploit the child’s sexuality for commercial gain. Furthermore, images of children in scant clothing and provocative poses are distributed on national television, the Internet, and in the local community of the participants. Thus, the harms that justify laws against child pornography are similarly present (albeit to a lesser degree) in the context of these child beauty pageants. By regulating these images and the pageants that produce them, Congress could target the evils of the production process. Although the children may not be sexually or physically abused in the traditional sense, the children are harmed by being sexually exploited to be attractive to pedophiles. A real child is being harmed and, therefore, the *Ferber* rationale is arguably met. Child pornography is illegal because it sexually exploits children—and,

93. *Id.* (discussing the factors as including “. . . (2) whether the setting of the visual depiction is sexually suggestive, i.e., in a place or pose generally associated with sexual activity; (3) whether the child is depicted in an unnatural pose, or in inappropriate attire, considering the age of the child; . . . (5) whether the visual depiction suggests sexual coyness or a willingness to engage in sexual activity; (6) whether the visual depiction is intended or designed to elicit a sexual response in the viewer”).

94. *Knox*, 32 F.3d at 747.

95. *See id.*

96. *See supra* Part II.A.

97. *New York v. Ferber*, 458 U.S. 747, 757 (1982).

98. *Id.* at 756–57.

99. *United States v. Williams*, 444 F.3d 1286, 1300 (11th Cir. 2006) (quoting *Ashcroft v. Free Speech Coalition* 535 U.S. 234, 253 (2002)), *rev’d*, 553 U.S. 285 (2008).

100. *Ferber*, 458 U.S. at 759.

likewise, child “glitz” beauty pageants should be prohibited because they sexually exploit children.¹⁰¹

B. INAPPROPRIATENESS DOES NOT MAKE THE CUT

As seen above, a strong argument can be made that images, such as those on *Toddlers & Tiaras*, should be classified as child pornography. However, while such child beauty pageants exploit the sexuality of minors for commercial gain, they do not constitute child pornography under federal law for several reasons. First, the images do not portray children engaged in any sexual acts like those prohibited under child pornography laws, such as intercourse or masturbation.¹⁰² Second, none of the children in this case are nude. Although nudity is not required, the statute is clearly violated if a picture shows a child nude or partially nude.¹⁰³ Third, according to case law, in the absence of nudity, in order to fall within the scope of the *Dost* factors, there must be a focus on the child’s genital or pubic area.¹⁰⁴ Although the attire featured on *Toddlers & Tiaras* and in other child beauty pageants is not “age appropriate” and the children in the images exhibit “sexual coyness,” there is not a clear close-up shot of the pubic area in any of the images. In order for these images to be child pornography under federal law, “lascivious exhibition of the genitals or pubic area” is absolutely required.¹⁰⁵ Fourth, while the images clearly appeal to the deviant sexual appetite of a pedophile, according to the Supreme Court in *Ashcroft*, this is not sufficient to transform an image that falls short of the legal definition of child pornography into illegal child pornography.¹⁰⁶

Past cases involving “child modeling” websites illustrate why images of child “glitz” beauty queens do not fall within the realm of illegal child pornography. Particularly troubling is a recent case in which a Colorado jury acquitted James Grady, the operator of a teen “modeling” website called TrueTeenBabies.com (featuring girls ages thirteen to seventeen in “provocative poses, wearing bikinis, short skirts or lingerie”), of 39 counts of child sexual exploitation.¹⁰⁷ Anyone who paid a \$20-per-month subscription fee could log on to TrueTeenBabies.com and see young girls in sheer tops, thongs, and bikinis.¹⁰⁸ However, under Colorado sexual exploitation law, explicit sexual conduct is defined as “sexual intercourse, erotic fondling, erotic nudity, masturbation, sadomasochism, or sexual excitement.”¹⁰⁹ Because the images on TrueTeenBabies.com did not involve sexual intercourse, erotic fondling, masturbation, sadomasochism, or sexual excitement, the

101. *See id.* at 757.

102. *See* U.S.C. § 2251 (2008); U.S.C. § 2256 (2008); *see also* McKay, *supra* note 11 (describing glitz pageants as “sexually objectifying event[s]”).

103. *United States v. Kemmerling*, 285 F.3d 644, 645-646 (8th Cir.), *cert. denied*, 537 U.S. 860 (2002) (“A picture is ‘lascivious’ only if it is sexual in nature. Thus, the statute is violated, for instance, when a picture shows a child nude or partially clothed . . .”).

104. *See id.* at 646 (holding the statute is violated when “the focus of the image is on the child’s genitals”); *see also* *United States v. Knox*, 32 F.3d 733, 750 (3rd Cir. 1994) (explaining that the “harm Congress attempted to eradicate . . . is present when a photographer unnaturally focuses on a minor child’s clothed genital area”).

105. 18 U.S.C. § 2256(2)(A)(v).

106. *Ashcroft v. Free Speech Coalition* 535 U.S. 234, 253 (2002).

107. J. Sebastian Sinisi, *Not-Guilty Verdict in Photos of Teens, Jurors Acquire Centennial Man of 39 Counts of Child Sex Exploitation*, DENV. POST, Mar. 14, 2003, at B-01; Gabrielle Crist, *Suit May Follow Porn Acquittal*, ROCKY MTN. NEWS (Denver), Aug. 14 2003, at 27A.

108. *Id.* “Child modeling” websites, like TeenBabies.com or “Models 13-2-17” with a linking banner presenting the “hottest 13 to 17 year olds in the worlds,” strategically dodge current child pornography laws by not focusing on the genital areas of minors.

109. COLO. REV. STAT. § 18-6-403(2)(e) (2011).

prosecution tried to argue that the photographs were “erotic nudity.”¹¹⁰ The term “erotic nudity” as defined under Colorado law is “the display of the . . . developing genitals . . . or the . . . developing breast area of a human child, for the purpose of real or stimulated overt sexual gratification or stimulation of one or more persons involved.”¹¹¹ According to case law, complete exposure of the breast or pubic area is not necessary to constitute “erotic nudity” because “equal or greater harm to a child can result from the type of poses to which the child is subjected and the process of taking the photos than from the amount of human breast actually depicted in the photos.”¹¹²

However, in the *Grady* case, the jury found the photographs were not taken for the sexual gratification of the children, but rather to start their modeling careers. Apparently, the jury was not persuaded by the prosecution’s argument that the photographs were taken for the sexual gratification of Grady; rather, the jury presumably agreed with the defendant that the photographs were taken for a “legitimate purpose,” modeling, and thus were protected.¹¹³

Today, the *Grady* case could be seen as an important victory for those who run non-nude child modeling websites or those who take sexual pictures of children that do not amount to “child pornography” or “sexually explicit” images. It follows from the *Grady* case that images of child “glitz” beauty queens similarly and artfully dodge the definition of child pornography under current law by not focusing on the pubic region of the children and by arguably having a “legitimate purpose” of competing in pageants.

V. THE SOLUTION?

This section of the paper will deal with the question of what should be done to prevent or restrict parents and the glitz pageant industry from sexually exploiting minors by dressing them up in provocative clothing and encouraging them to engage in routines that are sexually mature and not age appropriate. I will explore federal and state statutory solutions as well as what the American public can do to help stop the prevalence of such glitz pageants.

A. REVIVE THE CHILD MODELING EXPLOITATION PREVENTION ACT

Images like those in *Grady*, ones that are sexually suggestive but fall short of the legal definition of child pornography, were the focus of the proposed Child Modeling Exploitation Prevention Act of 2002 (“CMEPA”).¹¹⁴ The Act would have prohibited employing or displaying a minor under the age of 17 in “exploitive child modeling,” which was defined as “the display of a minor without a direct or indirect purpose of marketing a product or service other than the minor.”¹¹⁵ According to the proposed Act, “[t]he use of children in the production of exploitive child modeling, including on Internet websites, in photographs, films, videos, and other visual depictions, is a form of child abuse that can result in physical and psychological harm to the children involved” because “[t]he purpose of exploitive child modeling is to satisfy the demand of pedophiles.”¹¹⁶ Congress was concerned, according to the proposed bill, that “exploitive child modeling may involve a

110. Clay Calvert, *The Perplexing Problem of Child Modeling Web Sites: Quasi-Child Pornography and Calls for New Legislation*, 40 CAL. W.L. REV. 231, 246 (2004) [hereinafter Calvert I].

111. COLO. REV. STAT. § 18-6-403(2)(d) (2011).

112. *People v. Gagnon*, 997 P.2d 1278, 1282 (Colo. Ct. App. 1999).

113. Calvert I, *supra* note 109, at 247.

114. Child Modeling Exploitation Prevention Act of 2002, H.R. 4667, 107th Cong. (2002), Govtrack.us.

115. *Id.* at § 3(a).

116. *Id.* at § 2(1), 2(3).

direct and personal interaction between the child model and the pedophile” because the “pedophile often knows the child’s name and has a way of communicating with the child.”¹¹⁷ Representative Mark Foley, a co-sponsor of the bill, criticized the loophole in federal law that allowed these sites to “sell child erotica” and “serve . . . young children on a platter of America’s most deprived.”¹¹⁸ The bill was referred to the Committee on Education and the Workforce in 2002, and the Committee on the Judiciary.¹¹⁹ Unfortunately, the bill died in the House at the end of the 107th Congress.¹²⁰

The images that were the focus of CMEPA are similar to those in child beauty pageants and, thus, revival of the bill might serve to protect child beauty queens from being sexually exploited by their parents. However, the main problem with the CMEPA, and similar legislation that strives to prohibit images that fall short of child pornography, is that these bills likely run afoul of the First Amendment. The types of harm Congress tried to prevent through the CMEPA were physical harm from pedophiles whose appetites were whetted by such images or who might come in contact with the children and the psychological harm caused by the production of these images.¹²¹ However, in *Ashcroft*, the Supreme Court made clear that “while there is a compelling interest in protecting the physical and psychological well-being of minors,”¹²² “indirect harms” are not enough to prohibit speech.¹²³ In *Ashcroft*, the government argued that while children were not physically harmed in production of virtual child pornography, the virtual images could lead to physical abuse by encouraging and whetting the appetites of pedophiles.¹²⁴ The Supreme Court rejected such argued harms as a “contingent and indirect” “causal link” that depended “upon some unquantified potential for subsequent criminal acts.”¹²⁵ The Court clearly stated that the government could not prohibit speech merely because it “increases the chance an unlawful act will be committed at some indefinite time.”¹²⁶

However, some critics of current child pornography law suggest that the CMEPA and similar legislations should be justified in the face of First Amendment concerns on privacy grounds.¹²⁷ A privacy argument begins with the notion that privacy encompasses the principle of autonomous decision-making and choice.¹²⁸ Minors that choose to participate in images that are sexually suggestive, such as child modeling websites or child beauty pageants, are too young to value the consequences of their choices.¹²⁹ When parents press their young children to participate in pageants that produce sexually suggestive images, the children, sometimes as young as two or three years old, are not making a knowing choice because children are too young to make decisions regarding their sexuality

117. *Id.* at § 2(4).

118. Press Release, Office of Rep. Mark Foley, Foley Announces Bill To Ban So-Called “Child Modeling” Web sites (May 7, 2002), available at <http://www.wptz.com/download/2006/1004/10000826.pdf>.

119. Child Modeling Exploitation Prevention Act of 2002, H.R. 4667, 107th Cong., GovTrak, <http://www.govtrack.us/congress/bill.xpd?bill=h107-4667> (2002).

120. *Id.*

121. Clay Calvert, *Opening Up an Academic Privilege and Shutting Down Child Modeling Sites: Revising Child Pornography Laws in the United States*, 107 DICK. L. REV. 253, 280 (2002).

122. *Ashcroft v. Free Speech Coalition*, 535 U.S. 234, 250 (2002).

123. *Ashcroft*, 535 U.S. at 250.

124. *Id.* at 253.

125. *Id.* at 250.

126. See, e.g., Calvert I, *supra* note 109, at 259 (arguing privacy concerns should be added to the mix of justification for the CMEPA).

127. See, e.g., Calvert I, *supra* note 109, at 259 (arguing privacy concerns should be added to the mix of justification for the CMEPA).

128. See *Roe v. Wade*, 410 U.S. 113, 154 (1973) (privacy is broad enough to encompass a women’s decision to terminate her pregnancy).

129. See Calvert I, *supra* note 109, at 259.

and sexual conduct. Very young children, who cannot understand their decisions to participate in child glitz beauty pageants, are being exploited by their parents in performing acts that such children will likely find loathsome upon reaching an age of maturity. Parents, who are supposed to be acting in the best interest of their children, are blinded by promises of fame and money. These children need to be protected by laws.

In the end, while there is a clear government interest in protecting children from being sexually exploited through child beauty pageants, it will be an uphill battle to convince the Supreme Court that a child's interest in privacy should overcome First Amendment interests, especially in light of the *Ashcroft* decision.

B. REDEFINE "SEXUALLY EXPLICIT CONDUCT"

Another way to prohibit sexually suggestive images of children is for Congress to extend the definition of "sexually explicit conduct" to capture images that fall short of the current federal definition of child pornography. Congress could do this by dropping the "of genitals or pubic area" requirement of the "lascivious exhibition" definition of sexually explicit conduct in Section 2256(2)(A) of the PROTECT Act. The section would then provide that sexually explicit conduct includes lascivious exhibition of any person, whether or not it displays or focuses on the genital area of a child. Thus, images that meet all the other *Dost* factors but factor one ("whether the focal point of the visual depiction is on the child's genitalia or pubic area"), could qualify as child pornography. The success of such a proposal, while perhaps favorable in some respects, might prove problematic in light of the *Ashcroft* decision and the First Amendment issues discussed in the previous section.¹³⁰

C. REGULATE CHILD BEAUTY PAGEANTS AT THE STATE LEVEL

Another potential way to protect child "glitz" beauty pageant participants is to regulate the pageant industry at the state level. While not directly aimed at regulating what might be approaching "child pornography," North Carolina House of Representatives Member Annie W. Mobley proposed a bill that would establish a committee to assess the need for child pageant regulations.¹³¹ As noted in Part I.A., child pageant participants are prone to suffering from individual physical and psychological harms as a result of participating in child beauty pageants. However, under current law, children participating in pageants, unlike children acting on Broadway or in television commercials, have no recognized rights under state laws that are designed to protect paid child performers. For instance, while California has stringent laws that protect minors desiring to be employed in the entertainment industry from industry norms that may be harmful to a child's emotional and physical well-being, such laws do not include child beauty pageant participants because they are not "working."¹³²

130. *Id.* at 243.

131. H.B. 1348, 2010 Gen. Assem. Reg. Sess. (N.C. 2009), available at <http://www.ncga.state.nc.us/Sessions/2009/Bills/House/PDF/H1348v1.pdf>.

132. CAL. CODE REGS. tit. 8 § 11753(a)-(b) (2010) ("A minor desiring to be employed in the entertainment industry must obtain an Entertainment Work Permit. The application for permit can be obtained at any of the Division's District offices. The minor must provide the information called for on the application, to-wit: his/her name, age, birth date, address, sex, height, weight and color of hair and eyes. In addition, such minor must obtain verification in writing from the appropriate school district of the minor's school record and attendance, and must satisfactorily meet the requirements of that school district with respect to age, school record, attendance and health. Such verification of school record and attendance and proof that the school district's requirements with respect to age, school record, attendance and health have been met must be filed with the Division, concurrently with the filing of the application. Such verification and proof may be in any form as provided by the school district if reasonably demonstrative of the information required to be furnished by this subsection. The Division may require

House Bill 1348, proposed by Mobley on April, 9, 2009, would establish a committee to study the following in regard to child beauty pageants taking place in North Carolina: (1) how youth under 13 years of age are affected by competing in beauty pageants, both positively and negatively; (2) any data regarding regulation of the beauty pageant industry in the state as related to youth under 13 years of age; (3) legislation adopted by other states addressing the regulation of beauty pageants for youth under 13 years of age; (4) the appropriate agency to regulate the beauty pageant industry for youth under 13 years of age in the state; (5) the criteria under which beauty pageants for youth under 13 years of age should be regulated in the state, including minimum age requirements of participants, requirements for parental involvement, and any restrictions as related to the use of excessive makeup and competition focus areas; and (6) any other issues the Committee considers relevant to the study.¹³³

The bill, which has passed first reading and was reported favorable by the Committee of Juvenile Justice, Rules Committee, Operations of the House, and Calendar Committee, has not made any progress since April 29, 2009. Many critics of the pageant industry consider the bill a step in the right direction to finding an agency to oversee child pageants and establishing regulations to best protect child beauty pageant participants' interests.¹³⁴

D. PROTEST NATIONAL TELEVISION NETWORKS AND BEAUTY PAGEANTS THAT ENCOURAGE CHILD EROTICA

Currently, a legal solution to the problem of child beauty pageants and sexually suggestive images through statutory reform or case law is unpredictable at best. Thus, in order to curtail the prevalence of glitz beauty pageants that are both harmful to child participants and society at large, parents should stop entering their children in these pageants and the American public should stop watching national television shows that broadcast sexually suggestive images of children that amount to "child erotica."

"Child erotica" is a term used to describe images and materials that can sexually exploit children, but do not fit within the legal definition of child pornography.¹³⁵ The term, as used in criminal litigation, often describes pictures of children that are sexually exploitive but not illegal.¹³⁶ One study found that 79 percent of child pornography possessors also had "soft core" images of minors, but only 1 percent had such images alone.¹³⁷ It follows then that images not rising to the level of child pornography often accompany pornographic images.

As noted earlier, the Internet contains many child modeling, i.e. "soft child porn," sites that contain images of children photographed in "provocative poses, wearing bikinis,

in appropriate cases a physical examination of the minor to ensure that the minor's physical condition permits the minor to perform the work or activity called for by the Permit to Employ Minor and Entertainment Work Permit.").

133. H.B. 1348, *supra* note 131.

134. See Lindsay Lieberman, *Protecting Pageant Princesses: A Call for Statutory Regulation of Child Beauty Pageants*, 18 J. L. & POL'Y 739, 771 (2010) (calling the North Carolina bill "the country's first legislative effort in safeguarding minors from the exploitive effects of child pageantry"). Lieberman suggests that North Carolina should create a regulatory scheme that provides financial counseling to parents, guidelines for the number of hours a child may practice, and limits the availability of appearance altering techniques and adult costumes. *Id.* Additionally, Lieberman suggests that each child should have to undergo psychological and emotional testing and pageant parents should have to endure education and awareness programs aimed at developing healthy and realistic expectations for their children. *Id.*

135. Mary G. Leary, *Death to Child Erotica: How Mislabeling the Evidence Can Risk Inaccuracy in the Courtroom*, 16 CARDOZO J.L. & GENDER 1, 1 (2009).

136. *Id.*

137. *Id.* at 24.

short skirts, or lingerie” and other revealing attire.¹³⁸ Such “soft child porn” websites have been criticized by national media outlets, have been the target of Congressional bills, and have been largely considered “taboo” and abhorrent by the American public.¹³⁹ Since these websites are problematic and harmful to children, thankfully the vast majority of the public and the mainstream media do not support them.

On the other hand, child glitz pageants, which are similarly harmful and akin to “soft child porn,” though sometimes criticized, sadly cannot be likewise classified as “taboo”—after all, two national television networks air such pageants and an average of 1.3 million people are tuning in every week.¹⁴⁰ Oddly, these television shows and pageants are offering the exact same thing as taboo child modeling websites — namely, children in “provocative poses, wearing bikinis [and] short skirts”¹⁴¹ — but are not similarly considered abhorrent or “child erotica” by the American public.

The question remains: why are parents pushing their children to compete in these pageants and why are Americans supporting this “child erotica”? Perhaps parents and American viewers are unaware that research shows such images can encourage and assist sexual interest in children and that such pageants can be psychologically harmful to children.¹⁴² Often the prospect of money or fame can undermine the presumption that parents will protect the best interests of their children.¹⁴³

Thus, it is important to raise awareness that child beauty glitz pageants are often nothing more than minors being sexually exploited by their parents. Americans need to boycott television shows like *Toddlers & Tiaras* and *Little Miss Perfect* in order to send the message that such child beauty pageants are not socially acceptable. If the vast majority of Americans refuse to watch child beauty pageants, parents and the pageant industry may learn that they are engaging in taboo “child erotica” at best. Hopefully, as a result, such pageants will be transformed from “sex puppets adorned with lipstick, mascara, false eyelashes, bleached hair, [and] high heels”¹⁴⁴ into something that reflects the true, innocent beauty of these young children.

VI. CONCLUSION

Today, the sexual exploitation of young children is a widespread and growing problem in many facets of American culture, including child beauty pageants. Parents putting their children in such pageants risk serious psychological and physical harms to their children. The pageant industry and television shows like *Toddlers & Tiaras* and *Little Miss Perfect* also risk encouraging the sexualization of children and whetting the appetite of pedophiles by providing sexually suggestive images of children. While not rising to the level of child pornography, images of child beauty queens are similarly harmful and, as such, should be regulated. Parents and the pageant industry are neglecting to act in the best interest of the child participants and, therefore, it is necessary for Congress, states, and the American public to intervene and protect these minors from sexual exploitation.

138. Leary, *supra* note 135, at 6.

139. *See id.*

140. McKay, *supra* note 11.

141. Leary, *supra* note 135, at 7 (describing child modeling sites such as “Lil’ Amber” and “True Teen Babes.”).

142. *Id.*

143. Kimberlianne Podlas, *Does Exploiting A Child Amount to Employing a Child? The FLSA’s Child Labor Provisions and Children on Reality Television*, 17 UCLA ENT. L. REV. 39, 45 (2010) (noting that “parents have thrust their children into the spotlight for financial gain or to promote their own celebrity and in doing so, have compromised the well-being of their children”).

144. Davidson, *supra* note 4.

