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Dryer v. NFL: Can the "Voice of God" Save NFL Films?

***Conflict Preemption Under Copyright Law
May Be the Best Defense***

BY LARRY A. SILVERMAN

NFL Films has become a ubiquitous presence on the sports landscape. Using its vast stockpiles of archival footage and its distinctive production style, it has produced countless television programs, feature films, documentaries, and promotional spots that have helped to ingrain the National Football League ("NFL") into America's consciousness. However, a recent court decision in a class action suit brought by retired players raises serious questions about the NFL's right to market and sell these films without compensating the thousands of players whose images and likenesses play

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PROFILE Andrew Brandt

***From the Gridirons
of Barcelona and
Green Bay to the
Blogosphere***

BY EMMANUEL ROHAN

The National Football Post ("NFP") burst online at nationalfootballpost.com in Au-

starring roles in these productions.

This article will examine that decision (*Dryer v. National Football League*) and its potential impact on the ability of all professional sports leagues and teams to exploit its copyrighted archival video footage. It also will suggest that the inconsistent interpretations by the courts of the express preemption doctrine under copyright law limits that doctrine’s usefulness as a defense to these types of right of publicity claims. Finally, the article will argue that the conflict preemption analysis in a 2008 opinion from the Court of Appeals for the Third Circuit that, ironically, involved a successful right of publicity claim brought by the so-called Voice of God against NFL Films, may provide the clearest path toward avoiding the collision course between right of publicity claims and copyright law that is epitomized by the *Dryer* decision.

THE DRYER CASE

On January 26, 2010, the U.S. District Court for the District of Minnesota denied the NFL’s Motion for Judgment on the Pleadings in a class action suit brought by several retired NFL players on behalf of retired players from all 50 states.¹ The retired players, including Fred Dryer, a defensive end who played 13 years in the NFL (1969–81) and who later starred as Detective Hunter in the television show *Hunter*, alleged that for years the NFL had earned substantial revenue and had enhanced the NFL’s brand awareness by producing and selling hundreds of promotional films and videos that featured the images and likenesses of the retired class member players.² The retired players argued that while the NFL “reaps record breaking revenues,” the players featured in these films and videos have not been compensated for the use of their likenesses and images.³ The retired players claimed that this commercial exploitation of their identities and likenesses through the marketing and sale of these films and videos violated their rights of publicity afforded by state statutes or the common law of all 50 states.⁴

The NFL’s motion asked the court to dismiss the right of publicity claims on First Amendment grounds and/or that the claims were barred by express preemption under the Copyright Act.⁵

The district court in Minnesota denied the NFL’s motion. The bulk of the opinion analyzed the First Amendment issue.⁶ This article, however, will focus on the copyright preemption issue. On that issue, the court, while recognizing “there is no dispute that the NFL has a valid copyright in the video clips used in the films,” nevertheless rejected the NFL’s claim that the retired players’ right of publicity claims were expressly preempted by § 301 of the Copyright Act.⁷

At the outset of its decision, the court recognized that the Copyright Act “provides the exclusive source of protection for all legal rights that are equivalent to any of the exclusive rights under the general scope of the copyright.”⁸ It then referenced the two-part

test for express preemption under § 301(a), which provides that a state law claim is preempted if (1) the work at issue is “within the subject matter of copyright,” and (2) the state law right is “equivalent to any of the exclusive rights” within the general scope of the copyright.⁹

The court concluded that the NFL had failed to establish either prong of this two-part test. First, the court held that the “work” at issue was not the films themselves; rather, it was the retired players’ own identities. Accordingly, “the work at issue” (the players’ persona) was not within the subject matter of the NFL’s copyright.¹⁰ Second, the court held that state law rights of publicity are not “equivalent” to the exclusive rights afforded the NFL under its copyright. The court reasoned that rights of publicity protect “the right of an individual to reap the rewards of his or her endeavors,”¹¹ while copyright law “protects the author’s exclusive right to reproduce, distribute, perform or display expressive works.”¹² Because rights of publicity “protect very different rights” than the copyright laws, those claims were not “equivalent” to the exclusive rights afforded by the Act.¹³

Importantly, in its memorandum in support of its motion, the NFL, in a one-sentence footnote, referenced the additional copyright preemption defense afforded by the doctrine of conflict preemption, but stated, “the court need not reach this alternative basis to grant this motion.”¹⁴ As a result, the conflict preemption defense to the right of publicity claims asserted by the retired class member players was never addressed in the *Dryer* opinion.

POTENTIAL IMPACT OF DRYER

Founded in 1962 by Ed Sabol, NFL Films is currently run by Ed's son, Steve Sabol, and is owned by the NFL. With its now familiar style of slow-motion shots, sideline audio, and narrators with deep, booming voices like Harry Kalas and John Facenda, NFL Films generates over \$50 million per year in revenue for the league. Its real value, however, lies in its impact on the NFL brand. In fact, many people believe that NFL Films is one of the key reasons for the NFL's success.¹⁵

The films at issue in *Dryer* included *The Fabulous Fifties* and *Sensational 60s*, both from the NFL Films' *History* series. NFL Films also produces, among other things, the *Greatest Moments* series that details classic games from the 1960s, 1970s, 1980s, and 1990s; the *Lost Treasures* series, which utilizes old NFL Films' footage to give an inside, uncut look at the league's players, coaches, and referees; and a five-part mini-series entitled *Full Color Football: The History of the American Football League*, which aired in 2009.¹⁶

If upheld and followed by other courts, the *Dryer* decision would have a substantial impact on the ability of the NFL to produce, market, and sell these films, because the "stars" of these films are the thousands of names, images, likenesses, and voices of the players and coaches who appear on screen. Moreover, like the decision of the Court of Appeals for the Eighth Circuit in *C.B.C.*, in which it was held that the use of names and statistics in fantasy baseball games without a license was protected from right of publicity claims by the First Amendment,¹⁷ the decision also could have a ripple effect on similar uses of copyrighted films marketed and sold by other pro sports leagues and teams, all of whom make liberal use of archival footage to promote their brand. How much of the revenue pie generated by these copyrighted materials would need to be paid over to the tens of thousands of retired players whose images and likenesses appear in these films if these right of publicity claims are successful is, of course, unknown, but the potential impact of the decision cannot and should not be underestimated by the NFL and the other pro sports leagues and teams.¹⁸

THE LIMITS OF EXPRESS PREEMPTION

Whether one agrees with the court's holding in *Dryer* or not, the decision highlights the limited usefulness of § 301's

express preemption provision as a vehicle for the disposition of right of publicity claims. Section 301(a) of the Copyright Act provides that

[o]n or after January 1, 1978 all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by Section 102 and 103 . . . are governed exclusively by this title.¹⁹

In determining whether a right of publicity claim under state law is preempted by § 301(a), the courts have asked two questions. First, is the right the state law claim seeks to protect "equivalent" to a copyright holder's exclusive rights? Second, does the "work" (the image, likeness, or voice in a right of publicity case) fall within the copyright's subject matter?²⁰

THE USE OF RETIRED PLAYERS' IMAGES AND LIKENESSES BY NFL FILMS IS A LEGITIMATE EXPLOITATION OF THE NFL'S COPYRIGHTED MATERIALS.

When deciding whether the state law claim is "equivalent" to the copyright holder's exclusive rights, most courts have utilized the "additional" or "extra" element test. If the state law claim requires that the plaintiff prove an "additional element" beyond what is needed to prove copyright infringement, the state law claim will not be deemed equivalent to the copyright holder's exclusive rights. In answering the second question, courts have examined whether the "work" that is the subject of the right of publicity claim comes within the subject matter of the copyright.²¹

The application of this two-part express preemption test has led to wildly inconsistent results. As Professor David Nimmer has noted, "the interplay between copyright preemption and the right of publicity has seen more volatility than just about any other doctrine canvassed throughout this treatise. Tremendous disarray punctuates the cases."²² Judge Kozinski, in a stinging dissent from the Ninth Circuit's denial of a request for rehearing en banc in a right of publicity case brought by two of the stars of the TV show *Cheers*, expressed the growing frustration with the express preemption case law when he opined that the court's application of the right of publicity "put state law on a collision course with the federal rights of the copyright holder."²³

In its memorandum in *Dryer*, the NFL relied almost exclusively on the 1986 decision from the Seventh Circuit in *Baltimore Orioles v. Major League Baseball Players Ass'n* ("MLBPA").²⁴ In *Baltimore Orioles*, the MLBPA, on behalf of its membership, argued that the use of their images and likenesses in baseball telecasts violated their rights of publicity. Reasoning that Major League Baseball owned a valid copyright over these telecasts, the court held that the players' claims were expressly preempted by federal copyright law.²⁵

Although the result in the *Baltimore Orioles* case was clearly correct, the rationale employed by the Seventh Circuit has often been questioned. The Fifth Circuit called the decision "controversial" and noted it had been "heavily criticized."²⁶ In 2004, the Seventh Circuit itself took the unusual step of specifically commenting on the criticism from "our sister circuits and several commentators" that the *Baltimore Orioles* rationale had received.²⁷ The court then proceeded to "clarify" its holding in that case, stating that the *Baltimore Orioles* decision did not stand for the proposition that the right of publicity was preempted by § 301 "in all instances." Rather, the Seventh Circuit emphasized that

even the *Baltimore Orioles* court had noted (albeit in a footnote) that “[a] player’s right of publicity in his name or likeness would not be preempted if a company, without the consent of the player, used the player’s name to advertise its product.”²⁸

THE VOICE OF GOD TO THE RESCUE

For decades, John Facenda was the narrator of many of NFL Films’ most-watched documentaries. His deep, baritone voice was described as “distinctive,” “recognizable,” and “legendary.” In fact, to many football fans, he was known as “the Voice of God.”²⁹

Shortly before his death in 1984, Facenda signed a release giving NFL Films the right to use any audio sequences he had recorded for NFL Films in any manner whatsoever, “provided, however, such use does not constitute an endorsement of any product or service.”³⁰ After NFL Films used 13 seconds of Facenda’s voice in a 22-minute infomercial shown on the NFL Network to promote the Madden 2006 video game, Facenda’s estate filed suit on a number of grounds, including a claim under Pennsylvania’s right of publicity statute.³¹ The district court granted summary judgment; however, the Third Circuit reversed, holding that the estate’s claims were not preempted by federal copyright law.³²

The significance of the *Facenda* decision on *Dryer* and future cases like *Dryer* lies in the Third Circuit’s conflict preemption discussion.³³ In that discussion, the court provided a path for what should lead to the eventual dismissal of the right of publicity claims asserted by the retired class member players in *Dryer*. More importantly, if the *Facenda* court’s conflict preemption analysis is followed by other courts, the decision should provide a coherent, consistent rationale for the resolution of future state law right of publicity claims predicated on the use of the images and likenesses of pro athletes by leagues and teams in copyrighted telecasts and derivative works.

FACENDA’S CONFLICT PREEMPTION APPROACH

After concluding that the estate’s right of publicity claim under Pennsylvania’s statute was not expressly preempted by § 301(a) of the Copyright Act,³⁴ the court proceeded to address whether that claim was barred by the doctrine of conflict preemption. As the court explained, even where the copyright law “does not expressly preempt the right of publicity because an individual’s identity or persona is outside the subject matter of copyright,” in some situations such claims may still be barred because the right of publicity “clashes with the exploitation of a defendant’s copyright.”³⁵ *Facenda* stated the conflict preemption issue in right of publicity cases in simple and direct terms: “When does the right of individuals to avoid commercial exploitation of their identities interfere with the rights of copyright owners to exhibit their works?”³⁶

To resolve this issue, *Facenda* adopted the framework proposed by *Nimmer* “for

handling cases at the intersection of copyright, the right of publicity, and contract.”³⁷ First, the court should examine “how the copyrighted work featuring the plaintiff’s identity is used.” When used “for the purposes of trade,” such as “in an advertisement,” the claims should not be preempted. However, when the defendant’s uses are “expressive works,” right of publicity claims should be preempted.³⁸ Some of the examples from the *Nimmer* treatise that were cited by *Facenda* as commercial or advertising uses and therefore not preempted included a voice imitation in an advertisement; a robot game show hostess’s likeness used in an advertisement; and use of a model’s likeness on product packaging.³⁹ Some of the examples from *Nimmer* cited by *Facenda* as uses that constitute “expressive works” that would be preempted included distributing a movie in which the plaintiff acted, using public domain footage of an actor in a new video, and using images of individuals in a video game.⁴⁰

In summarizing this first part of the *Nimmer* framework, *Facenda* concluded, “[t]he rationale is that state law has a role in regulating practices of trade, including advertising. But limiting the way material can be used in expressive works extends beyond the purview of state law and into the domain of copyright law.”⁴¹

Finding that the NFL’s use of Facenda’s voice in a television production promoting Madden NFL 06 was “a 22-minute promotional piece akin to advertising,” the court held that this use of Facenda’s

voice “does not count as an expressive work,” and therefore application of conflict preemption was not appropriate to the estate’s right of publicity claim.⁴²

Under the second part of the *Nimmer* framework as adopted by *Facenda*, even if a plaintiff’s image, likeness, or voice is used for advertising purposes, the claim will still be preempted if the plaintiff “collaborated in the creation of a copyrighted advertising product.”⁴³ Absent such collaboration in the creation of “advertising content,” the plaintiff has a strong argument for asserting “continuing control over the use of his image.”⁴⁴ Reasoning that *Facenda* had not consented to “an advertisement for a football video game,” the court held that “*Facenda* successfully bore [his] burden . . . and preserved his state-law right-to-publicity claim.”⁴⁵

Importantly, the court made it very clear that it was allowing the state law right of publicity claim to proceed only because *Facenda*’s voice was “used in a commercial advertisement.” Because Pennsylvania’s statute focused “solely on the commercial–advertising context” and was “targeted at endorsements, not the full universe of creative works,” allowing the case to proceed did not, in the court’s view, “upset copyright law’s balance.”⁴⁶

EFFECT OF FACENDA ON DRYER’S RIGHT OF PUBLICITY CLAIMS

The *Facenda/Nimmer* conflict preemption framework, if followed, would appear to provide a path that should ultimately lead to the dismissal of the right of publicity and derivative unjust enrichment claims brought by the retired football players in *Dryer*. The images and likenesses of the retired players in the films created by NFL Films were not used to “endorse” or “advertise” another product, such as Madden NFL 06. Rather, the images and likenesses of the retired players were used only as part of the “expressive works” created by the NFL as holder of the copyright.⁴⁷ Using this framework, the right of publicity claims brought by these retired players should be preempted because allowing these state law claims to proceed would “obstruct the accomplishment of the full purposes and objectives of Congress in enacting the Copyright Act.”⁴⁸

The retired players will argue, of course, that NFL Films is using their images and likenesses for commercial purposes not only because the films generate direct revenues

for the league, but also because the films increase the overall value of the NFL brand. While it is certainly accurate that these films have commercial value to the NFL, under the *Facenda/Nimmer* conflict preemption framework, the distinction between claims that are preempted and those that are not focus on “defendant’s exploitation, drawing a line between entertainment works used for their own sake and commercial works used for advertising purposes.”⁴⁹

The critical determination in applying the *Facenda/Nimmer* framework to the facts in *Dryer* is assessing how these images and likenesses of the retired players are being utilized. As *Nimmer* explains:

The distinction . . . is not between categories, but between utilizations. A song can be on the right side if used to express Jennifer Lopez’ artistic vision, but on the wrong side if it hawks Cheetos and Cherokees. . . . A film is protected if it has two hours of entertainment, teaches how to dance, or recaptures the saga of 1960’s radicalism, but on the wrong side if it just glorifies a computer game that the NFL wants to sell. . . . “The basis of a right of publicity claim concerns the message—whether the Plaintiff endorses, or appears to endorse the product in question.”⁵⁰

Clearly, while the stars of the various NFL Films’ productions are the images and likenesses of these tens of thousands of retired players, it is equally clear that these players are not endorsing a product when they appear in these films. Rather, the use of their images and likenesses by NFL Films is a legitimate exploitation of the NFL’s copyrighted materials. For that reason, it seems clear that under the principles of conflict preemption set forth in *Facenda*, the NFL should be able to steer the *Dryer* lawsuit toward a path that saves its films and like films of all professional sports leagues and teams from right of publicity claims brought by the athletes that star in these films.

CONCLUSION

The decision of the Minnesota district court in *Dryer* raises troubling questions about the rights of the NFL and other professional sports leagues and teams to legitimately exploit their exclusive rights as copyright holders of the vast archival footage of the athletes that played in the

games that are captured on these films and videos. The answer to these troubling questions may lie with the little-used conflict preemption framework employed by the Third Circuit in the right of publicity suit brought by the estate of John *Facenda*, the so-called Voice of God, against the NFL. If followed, that reasoning should ultimately lead to the dismissal of the right of publicity claims brought by the retired players in *Dryer* and, even more importantly, should lead to more uniform results in future cases brought by professional athletes who attempt to use right of publicity laws to prevent a professional league or team from the legitimate exploitation of its copyrighted films and videos. It would be ironic indeed if the decision in the “Voice of God” case that went against the NFL serves as the basis for the dismissal of right of publicity claims brought by the tens of thousands of retired athletes who demand compensation from the NFL or other leagues and teams for the use of their images and likenesses in these films and videos. ❖

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ENDNOTES

1. *Dryer v. Nat’l Football League*, 2010 WL 724112 (D. Minn. Jan. 28, 2010).
2. Amended Class Action Complaint at ¶¶ 2, 4, *Dryer v. Nat’l Football League*, 2010 WL 724112 (D. Minn. 2009) (No. 09-cv-2182).
3. *Id.* at ¶ 2.
4. *Id.* at ¶ 5. Whether by statute or common law, all 50 states recognize some form of the cause of action known as the right of publicity. This cause of action is designed to ensure that individuals whose name, image, likeness, and/or voice have commercial value are compensated if their persona is used for commercial purposes without their consent. Some of the earlier decisions recognizing this cause of action included *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir. 1953), and *Palmer v. Schonhorn Enters, Inc.* 232 A.2d 458 (N.J. Super. 1967).
5. See NFL’s Motion for Judgment on Pleadings, *Dryer v. Nat’l Football League*, 2010 WL 724112 (D. Minn. 2009) (No. 09-cv-2182). The motion also argued that plaintiffs had failed to state a claim for relief under the Lanham Act and that the unjust enrichment claims were derivative of the right of publicity claims and therefore should be dismissed on the same grounds as those claims.
6. *Dryer*, 2010 WL 724112, at 3–13. The NFL relied principally on *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400, 114 Cal. Rptr. 2d 307 (Cal. Dist. Ct. App. 2001); C.B.C. *Distrib.*