

1-1-2021

## Trademark Law—Looking Out for the Big Guys: Outdated Precedent Reveals the Need for New Legal Test in Fortnite Likeness Case—Pellegrino v. Epic Games, Inc., 451 F. Supp. 3d 373 (E.D. Pa. 2020)

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### Recommended Citation

26 Suffolk J. Trial & App. Advoc. 309 (2020-2021)

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**TRADEMARK LAW—LOOKING OUT FOR THE  
BIG GUYS: OUTDATED PRECEDENT REVEALS  
THE NEED FOR NEW LEGAL TEST IN *FORTNITE*  
LIKENESS CASE—*PELLEGRINO V. EPIC GAMES,  
INC.*, 451 F. SUPP. 3D 373 (E.D. PA. 2020).**

States have an interest in both protecting an individual’s right of publicity and safeguarding the proprietary interest in their acts and likeness.<sup>1</sup> In a world of viral videos and overnight fame, issues have arisen regarding the extent to which public figures have ownership over their image and signature moves, and whether third parties, like video game developers, can profit off them.<sup>2</sup> In *Pellegrino v. Epic Games, Inc.*,<sup>3</sup> the United States District Court for the Eastern District of Pennsylvania considered whether Epic Games, Inc. (“Epic”) misappropriated Leo Pellegrino’s (“Pellegrino”) likeness and signature move when creating the “Phone It In” emote for its game *Fortnite Battle Royale* (“Fortnite”).<sup>4</sup> The court ultimately dismissed Pellegrino’s right of publicity claims and found that Epic’s use of Pellegrino’s likeness in creating the “Phone It In” emote satisfied the Transformative Use Test (“Test”), granting the emote First Amendment protection.<sup>5</sup>

Pellegrino is a professional baritone saxophone player and member of the “brass house” group Too Many Zooz.<sup>6</sup> At concerts and festivals, Pellegrino performs his signature move: a series of movements that “express his own unique dancing style.”<sup>7</sup> Pellegrino performs his signature move so frequently and in front of so many people that “it has become inextricably linked to his identity.”<sup>8</sup> Epic is a video game developer that cre-

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<sup>1</sup> See *Zacchini v. Scripps-Howards Broad. Co.*, 433 U.S. 562, 573 (1977) (highlighting right of publicity is “right of the individual to reap reward of his endeavors”).

<sup>2</sup> See Katie Thomas, *Image Rights vs. Free Speech in Video Game Suit*, N.Y. TIMES (Nov. 15, 2010), <https://www.nytimes.com/2010/11/16/sports/16videogame.html> (discussing importance of balancing First Amendment free speech rights against right of publicity).

<sup>3</sup> 451 F. Supp. 3d 373 (E.D. Pa. 2020).

<sup>4</sup> See *id.* at 378 (describing legal issue).

<sup>5</sup> See *id.* at 381 (concluding Epic’s use of Pellegrino’s likeness is sufficiently transformative); see also *infra* notes 25-26 (describing Transformative Use Test).

<sup>6</sup> See *Pellegrino*, 451 F. Supp. 3d at 378 (describing Pellegrino’s profession).

<sup>7</sup> See *id.* (explaining Pellegrino’s unique ability and anatomy to perform signature move). “Using his unique anatomy—specifically his externally rotatable feet—Pellegrino was able to create the Signature Move. . . .” *Id.*

<sup>8</sup> See *id.* at 378 (explaining how Pellegrino’s signature move has become synonymous with him).

ated Fortnite, one of the most popular video games ever.<sup>9</sup> It is described as “a battle royale video game that blends survival, exploration, and scavenging elements with last-man-standing gameplay.”<sup>10</sup> Within its free-to-play game, Epic generates revenue through in-game purchases, such as customizable outfits and content for player avatars; this content includes their popular “emotes,” which allow players to cause their Fortnite avatar to perform certain dances, movements, or acts.<sup>11</sup> By copying moves from popular ce-

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<sup>9</sup> See Nick Statt, *Fortnite is Now One of the Biggest Games Ever with 350 Million Players*, THE VERGE (May 6, 2020, 1:54 PM), <https://www.theverge.com/2020/5/6/21249497/fortnite-350-million-registered-players-hours-played-april> (stating Fortnite has over 350 million registered players with billions of logged playtime hours); Kevin Webb, *'Fortnite' Was the Most Important Video Game of This Decade, and It Will Be For the Next One Too*, BUSINESS INSIDER (Dec. 29, 2019, 10:05 AM), <https://www.businessinsider.com/fortnite-most-influential-video-game-decade-2019-12> (stating Fortnite generated \$2.4 billion in 2018).

<sup>10</sup> See Pellegrino, 451 F. Supp. 3d at 378 (noting Epic’s significant growth in valuation because of Fortnite); see also Yousef Saifi, *Fortnite NFL Skins: New Fortnite Football Skins Leaked Gridiron Gang Outfits*, FORTNITE INSIDER (Nov. 23, 2020), <https://fortniteinsider.com/fortnite-nfl-skins-new-fortnite-football-skins-leaked/> (explaining Fortnite’s two-time collaboration with NFL, once in 2018 and again in 2020). The game is so popular that even the National Football League (“NFL”) collaborated for a cut of the profit. Saifi, *supra* note 10. Fortnite allowed players to buy skins for their avatars representing any of the thirty-two NFL teams with a customizable player number to place on the back of the skin’s jersey. Saifi, *supra* note 10; Isaiah Alonzo, *'Fortnite' x Houseparty: How to Use Live Video Chat While Playing and Get Rainbow Fog Wrap!*, TECH TIMES (Nov. 20, 2020, 1:44 AM), <https://www.techtimes.com/articles/254334/20201120/fortnite-x-houseparty-use-live-video-chat-playing-rainbow-fog.htm> (outlining Epic’s goal to bring live video chat into game without employing third-party device). Epic has also partnered with Houseparty, a video chatting app, in hopes of integrating live video chat on the screen while playing the game. Alonzo, *supra* note 10; Tom Gerken, *Fortnite: 'Millions Attend' Virtual Marshmello Concert*, BBC (Feb. 4, 2019), <https://www.bbc.com/news/blogs-trending-47116429> (describing phenomenon of Fortnite’s first live concert); Marc Hogan, *Where Can Virtual Concerts Go After Travis Scott's Fortnite Extravaganza?*, PITCHFORK (May 5, 2020), <https://pitchfork.com/thepitch/virtual-concerts-travis-scotts-fortnite-100-gecs-minecraft/> (showing how Fortnite’s success in virtual concerts has inspired others); Andrew Webster, *Fortnite is Launching a Concert Series it Hopes Will Become a 'Tour Stop' for Artists*, THE VERGE (Sept. 8, 2020, 10:00 AM), <https://www.theverge.com/2020/9/8/21423004/fortnite-party-royale-concert-series-dominic-fike> (describing musical performances held in Fortnite’s virtual platform by artists like Diplo and Steve Aoki). With the Fortnite and Houseparty collaboration, Epic has taken yet another step to transform Fortnite from a basic video game to a virtual reality where people can listen to concerts, video chat with friends, and play a battle royale shooter simultaneously. Gerken, *supra* note 10; Digital Staff, *Fortnite Isn't Just a Game, It's a Social Platform – and It's Eclipsing Facebook*, 7NEWS (June 11, 2019, 12:22 PM), <https://7news.com.au/the-morning-show/fortnite-isnt-just-a-game-its-a-social-platform-and-its-eclipsing-facebook-c-162425> (referencing studies that show Fortnite players spend more time playing than using social media). With Fortnite’s success, some people say that Fortnite is no longer just a video game, but rather a social platform that has grown bigger than anyone could have imagined. Digital Staff, *supra* note 10; Bijan Stephen, *Fortnite was 2018's Most Important Social Network*, THE VERGE (Dec. 21, 2018, 2:37 PM), <https://www.theverge.com/2018/12/21/18152012/fortnite-was-2018s-most-important-social-network> (describing Fortnite as cultural phenomenon accessible by almost every device).

<sup>11</sup> See Pellegrino, 451 F. Supp. 3d at 378 (explaining Epic creates emotes by copying dances and movements from pop culture, sometimes without consent); see also *Best Fortnite Dances in*

lebrities and viral videos, Epic promotes the purchase of these emotes because it allows players to mimic their favorite idols in-game.<sup>12</sup>

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*Real Life!*, BEANO, <https://www.beano.com/posts/7-best-fortnite-dances-in-real-life> (last visited Oct. 19, 2020) (showing use of *Scrubs* dance move as default battle royale dance). The free default dance available to every player is based on the dance moves of a character named Turk from the comedy television show *Scrubs*. *Best Fortnite Dances in Real Life!*, *supra* note 11. Other examples of emotes taken from pop culture are the “Best Mates” emote based on Marlon Webb’s dancing and the “Fresh Dance” emote based on the dancing of Alfonso Ribeiro’s character, Carlton Banks, from *The Fresh Prince of Bel-Air*. *Best Fortnite Dances in Real Life!*, *supra* note 11; Kiril Stoilov, *Top 7 Celebrity Fortnite Skins That Look Most Like the Original*, EARLY GAME (Sep. 4, 2020), <https://www.earlygame.com/top-7-celebrity-fortnite-skins-that-look-most-like-the-original/> (providing pictures of notable collaboration skins). While Epic has created many emotes based on pop culture and individuals’ identities without permission, Epic has contracted to collaborate with famous figures such as streamer and professional gamer, Tyler “Ninja” Blevins, iconic streamer, Kathleen “Loserfruit” Belsten, DJ Marshmello, and rapper, Travis Scott. Stoilov, *supra* note 11; Dipanjan Dey, *More Accurate than Ninja Skin- New Fortnite Skin for Iconic Streamer*, ESSENTIALLY SPORTS (June 22, 2020, 12:07 PM), <https://www.essentiallysports.com/more-accurate-than-ninja-skin-new-fortnite-skin-for-iconic-streamer-esports-epic-games-loserfruit-news/> (showcasing Loserfruit’s collaboration skin).

<sup>12</sup> See *Pellegrino*, 451 F. Supp. 3d at 378 (noting emotes’ popularity such that professional athletes perform Fortnite emotes in on-field celebrations). “Emotes have become popular even outside of Fortnite. For example, professional athletes perform celebrations based on Fortnite emotes and other people post social media videos of themselves executing the emotes.” *Id.*; see also Adi Robertson, *Most of the Fortnite dance lawsuits are on pause*, THE VERGE (Mar. 9, 2019, 12:23 PM), <https://www.theverge.com/2019/3/9/18257385/epic-fortnite-lawsuit-ribeiro-2milly-dance-emote-lawsuits-withdrawn-pause-registration> (providing examples of other people and videos Epic has used for emotes); Nick Statt, *Fortnite Keeps Stealing Dances – And No One Knows If It’s Illegal*, THE VERGE (Dec. 20, 2018, 8:55 AM), <https://www.theverge.com/2018/12/20/18149869/fortnite-dance-emote-lawsuit-milly-rock-floss-carlton> (noting claims of well-known celebrities like 2 Milly and lesser known figures like “Backpack Kid”); *Collaborations*, FANDOM, <https://fortnite.fandom.com/wiki/Collaborations> (last updated Mar. 7, 2021) (listing Fortnite’s collaborations). Fortnite has become so successful that many companies and celebrities want to collaborate with Epic to promote themselves to an audience of millions. Paul Tassi, *‘Fortnite’ Could Follow Its Marvel Season with a DC Season*, FORBES (Aug. 30, 2020, 10:34 AM), <https://www.forbes.com/sites/paultassi/2020/08/30/fortnite-could-follow-its-marvel-season-with-a-dc-season/?sh=21ec04152290> (reporting how Marvel and DC Comics have been competing for collaborations with Fortnite); Webb, *supra* note 9 (describing success of Fortnite and player base); Oscar Gonzalez, *Fortnite X Stranger Things Adds Chief Hopper, Demogorgon Skins for Crossover*, CNET (July 5, 2019, 6:01 AM), <https://www.cnet.com/news/fortnite-x-stranger-things-adds-chief-hopper-demogorgon-skins-for-crossover/> (describing Fortnite’s collaboration with hit TV show “Stranger Things”). Even television shows have joined the long list of collaborators as Fortnite has become a formative tool for promoting new content and attracting new viewers. See Gonzalez, *supra* note 12; Andrew Webster, *The Mandalorian is the Perfect Fortnite Character*, THE VERGE (Dec. 2, 2020, 11:05 AM), <https://www.theverge.com/2020/12/2/22028767/the-mandalorian-fortnite-perfect-character-season-5> (describing Fortnite’s collaboration with hit TV show *The Mandalorian*); Andrew Webster, *The New Trailer for Christopher Nolan’s Tenet Will Air in Fortnite*, THE VERGE (May 21, 2020, 4:24 PM), <https://www.theverge.com/2020/5/21/21266768/fortnite-party-royale-christopher-nolan-tenet-trailer> (explaining how world premiere trailer for *Tenet* aired on Fortnite on hourly basis). Some collaborators who have less faith in Fortnite’s influence, such as Christopher Nolan, will not allow their characters in the game, but still admit that working with Epic would benefit them in the long run due to sheer publicity. *The New Trailer for Christopher No-*

One of the emotes Epic created and currently profits from is the “Phone It In” emote, which is identical to Pellegrino’s signature move.<sup>13</sup> While many Fortnite players recognized the emote as Pellegrino’s signature move, some players were under the false impression that it was Epic’s original creation.<sup>14</sup> As a result, Pellegrino brought suit against Epic and asserted that it used his name or likeness without consent in violation of Pennsylvania statute § 8316.<sup>15</sup> The district court ultimately dismissed Pellegrino’s § 8316 claim because he was unable to prove that the “Phone It In” emote resembled his appearance or biographical information.<sup>16</sup> Moreover, in applying the Transformative Use Test, the court emphasized that Fortnite players can customize their characters with various emotes that mimic celebrities other than Pellegrino.<sup>17</sup> The court further reasoned that emotes are utilized in a battle royale setting—whereas Pellegrino ex-

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*lan’s Tenet Will Air in Fortnite*, *supra* note 12; Patricia Hernandez, *Fortnite Fans are Making Kratos Dance, and it’s Amazing*, POLYGON (Dec. 4, 2020, 2:18 PM), <https://www.polygon.com/fortnite/2020/12/4/22153779/fortnite-god-of-war-kratos-emote-dance-epic-games-sony-sequel-ps5> (explaining Kratos’ character in Fortnite contrasts with Kratos’ more serious character in *God of War*). With all of Epic’s success, other gaming companies, such as Sony Interactive Entertainment, capitalized on Fortnite’s publicity by collaborating with Epic to add characters from their own popular games such as Psycho from *Borderlands 3* and Kratos from *God of War*. Hernandez, *supra* note 12; Andrew Webster, *Fortnite’s New Borderlands 3 Crossover Features Psycho, Claptrap, and a Pandora Zone*, THE VERGE (Aug. 27, 2019, 8:44 AM), <https://www.theverge.com/2019/8/27/20834819/fortnite-borderlands-3-crossover-psycho-claptrap-pandora> (explaining Fortnite’s *Borderlands 3* collaboration).

<sup>13</sup> See *Pellegrino*, 451 F. Supp. 3d at 378 (noting name of emote refers to Pellegrino’s appearance in 2017 Google Pixel 2 Phone commercial). Epic generates revenue when players purchase emotes, like “Phone It In”, from the “in-game electronic storefront.” *Id.*

<sup>14</sup> See *id.* at 379 (noting players’ high awareness about relationship between “Phone It In” and Pellegrino’s signature move). Pellegrino argued that players who are unaware that the “Phone It In” emote imitates Pellegrino’s signature move “have the false impression that the ‘Phone It In’ emote was Epic’s original creation because Epic does not credit Pellegrino as the Signature Move’s creator and owner.” *Id.*

<sup>15</sup> See 42 PA. CONS. STAT. ANN. § 8316 (allowing individuals to bring actions against unauthorized use of their name or likeness); *Pellegrino*, 451 F. Supp. 3d at 379 (summarizing Pellegrino’s claims against Epic). Pellegrino made a claim for unauthorized use of his name and likeness in violation of § 8316. *Pellegrino*, 451 F. Supp. 3d at 379. He also brought claims under misappropriation of publicity, invasion of privacy by misappropriation of identity, unjust enrichment for using his trademark, unfair competition for using his likeness, and trademark infringement all under Pennsylvania common law. *Pellegrino*, 451 F. Supp. 3d at 379. Pellegrino’s last two claims were for trademark infringement and trademark dilution under the Lanham Act. *Pellegrino*, 451 F. Supp. 3d at 379; see also 15 U.S.C. §§ 1125 (a), (c) (prohibiting trademark infringement and trademark dilution).

<sup>16</sup> See *Pellegrino*, 451 F. Supp. 3d at 381 (noting avatar equipped with “Phone It In” emote did not resemble Pellegrino whatsoever).

<sup>17</sup> See *id.* (explaining Fortnite players can cause their avatars to perform emotes). The court discussed the allegations in the complaint and acknowledged that Fortnite players can customize their avatars with new characters. See *id.* However, the court noted that the photos provided in the complaint did not share any resemblance to Pellegrino. See *id.*

cutes his signature move at musical performances and festivals—thereby making Epic’s “Phone It In” emote sufficiently transformative to be granted First Amendment protections.<sup>18</sup>

The right of publicity grants famous figures the ability to control and profit from certain uses of their identities.<sup>19</sup> In an effort to protect this right, courts have utilized different balancing tests to limit others from copying a famous figure’s signature moves.<sup>20</sup> One such test came from the United States Court of Appeals for the Second Circuit decision *Rogers v. Grimaldi*; here, the court created a two-prong test to determine whether a work is protected under the First Amendment.<sup>21</sup> The first prong examines the title of the work and the second prong states that no protection will be granted if the work clearly misleads consumers as to the source or content of the work.<sup>22</sup> This test has been met with criticism, however, as it is ill-suited for application to video games.<sup>23</sup> Another test is the Predominant Use Test, as applied by the Missouri Supreme Court in *Doe v. TCI Cablevi-*

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<sup>18</sup> See *id.* at 381-82 (concluding Epic’s use of emote constitutional under Transformative Use Test).

<sup>19</sup> See Matthew D. Bunker & Emily Erickson, *Transformative Variations: The Uses and Abuses of the Transformative Use Doctrine in Right of Publicity Law*, 14 WASH. J.L. TECH. & ARTS 138, 139 (2019) (explaining history of right of publicity); see also William K. Ford & Raizel Liebler, *Games Are Not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 6-7 (2012) (discussing how right of privacy led to right of publicity).

<sup>20</sup> See Joseph Gutmann, Note, *It’s in the Game: Redefining the Transformative Use Test for the Video Game Arena*, 31 CARDOZO ARTS & ENT. L.J. 215, 219 (2012) (describing three primary balancing tests courts have used).

<sup>21</sup> See *Rogers v. Grimaldi*, 875 F.2d 994, 997-99 (2d Cir. 1989) (evaluating claim by dancer against movie producer for incorporating characters that mimicked dancer’s identity).

<sup>22</sup> See *id.* at 999 (stating goal of test is to avoid consumer confusion). Under the first prong, courts examine the title of the work and will deem a work unprotected if that title has no artistic relevance to the original work. See *id.* The second prong of the test focuses on misleading titles, and the court in *Rogers* explained that a misleading title with no artistic relevance would violate the Lanham Act. See *id.*; see also *Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir. 2003) (applying test and finding artistic relevance of title to song lyrics highly questionable). For example, a song titled *Rosa Parks* was deemed unprotected because it “ma[de] no explicit statement that the work is about that person in any direct sense” and its title had no artistic relevance to the original work. See *Parks*, 329 F.3d at 459. The court reasoned that, though the song referenced Rosa Parks for marketing reasons, “[t]he composers did not intend [the song] to be about Rosa Parks, and the lyrics are not about Rosa Parks.” See *Parks*, 329 F.3d 437 at 452.

<sup>23</sup> See Gutmann, *supra* note 20, at 220 (arguing deception is not indicative of work being complete imitation). Gutmann further explains that a work can be a complete imitation even if it is not deceptive. See *id.* While imitations have almost no creative value on their own, they would still undeniably pass the *Rogers* test. See *id.* As a result, the *Rogers* test is not appropriate when applied to most forms of media, such as video games, where issues are much more complex. See *id.*

sion<sup>24</sup>; there, the court examined the creative intent behind the work and held that protection will only be granted where there is intent to make a distinct creative work.<sup>25</sup> The Predominant Use Test is not immune from criticism either, as it fails to properly examine works that seek to make an expressive comment while directly imitating a famous figure's likeness.<sup>26</sup>

Finally, courts utilize the Transformative Use Test, which the United States Court of Appeals for the Third Circuit expanded upon in *Hart v. Electronic Arts, Inc.*<sup>27</sup> The Transformative Use Test asks if the imitation is so transformed that it mainly becomes a defendant's own expression rather than the celebrity's likeness.<sup>28</sup> Like the *Rogers* and Predominant Use Tests, the Transformative Use Test has not escaped criticism because it lacks clear, objective guidelines and essentially allows judges to base decisions on external factors.<sup>29</sup> The Transformative Use Test has been used in a myriad of cases and continues to be used even as it is met with changing circumstances, such as the video game industry's continued incorporation of pop culture figures.<sup>30</sup>

A notable invocation of the Transformative Use Test came with *Winter v. DC Comics*, where the Supreme Court of California found that

<sup>24</sup> See *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374-76 (Mo. 2003) (applying Predominant Use Test).

<sup>25</sup> See *id.* at 374 (stating expressive values are given greater weight when predominant purpose of product comments on celebrity). The court explained that a product sold for the main purpose of exploiting the commercial value of an individual's identity is a clear violation of the right of publicity and not protected by the First Amendment. See *id.* While, under certain circumstances, there may be some "expressive" content in the product that could qualify as "speech," this would not be sufficient to grant the product protections. See *id.* On the other hand, a product whose predominant purpose is to make an expressive comment on or about a celebrity is given greater leeway as the expressive values are greater. See *id.*

<sup>26</sup> See Gutmann, *supra* note 20, at 221 (admitting that creative intent is important, but test is still not enough).

<sup>27</sup> See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 145 (3d Cir. 2013) (utilizing Transformative Use Test).

<sup>28</sup> See *id.* at 160 (explaining that "expression" means something other than likeness of celebrity). In a case of first impression, the Third Circuit determined that the Transformative Use Test was the proper analytical framework to examine the right of publicity and how it interacts with the First Amendment. See *id.* at 165; see also *Comedy III Prods. Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001) (establishing Transformative Use Test). The origin of the Transformative Use Test came from the Supreme Court of California, which stated the inquiry as follows: "whether the product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness." *Comedy III Prods. Inc.*, 21 P.3d at 809.

<sup>29</sup> See David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1, 25-26 (2011) (arguing Test allows judges to base decisions on external factors like fame of artist).

<sup>30</sup> See Gutmann, *supra* note 20, at 222 (demonstrating how courts deciding on same video game came to different conclusions).

using the likeness of two musicians to create two half-worm, half-human comic book characters was sufficiently transformative and therefore protected by the First Amendment.<sup>31</sup> A few years later, the California Court of Appeal addressed a singer's claim against a video game producer in *Kirby v. Sega of America, Inc.*, where the singer claimed a video game character used her persona.<sup>32</sup> The court in *Kirby* held that Sega of America was protected because the character in the game, Ulala, was not a literal depiction of the plaintiff, American musician Kirby, but was instead based on a Japanese "anime" style character with a different storyline and background from Kirby.<sup>33</sup> In contrast, the California court found in favor of the plaintiff in *No Doubt v. Activision Publishing, Inc.*, ruling that there was insufficient transformation where avatars, based on the musicians of a popular rock band, performed in outer space venues in a video game, because the game still involved the plaintiff band members doing what they typically do—singing and performing music.<sup>34</sup> In two important Electronic Arts

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<sup>31</sup> See *Winter v. D.C. Comics*, 69 P.3d 473, 479 (Cal. 2003) (explaining differences in appearance between plaintiffs and comic book characters). In this case, famous musicians Johnny and Edgar Winter, who had distinctive long white hair due to albinism, claimed that their depictions in a comic book miniseries misappropriated their likeness. See *id.* at 476. The comic book characters in question were Johnny and Edgar Autumn, also known as the Autumn brothers, and they are depicted as "villainous half-worm, half-human offspring." See *id.* The plaintiffs argued that the defendant misappropriated both their names, Johnny and Edgar, and their likeness as to the plaintiffs' long white hair. See *id.* However, the court found that the comics depicted the plaintiffs in a way that was so unique and creative that it gave birth to something new and expressive, such that it deserved First Amendment protection. See *id.* at 480. The court reasoned that the plaintiffs were "merely part of the raw materials from which the comic books were synthesized," and their likeness was so distorted in the comic that Winter brothers' fans who wanted to purchase pictures of them would find the drawings of the Autumn brothers unsatisfactory as a substitute for the real Winter brothers. See *id.* at 479.

<sup>32</sup> See *Kirby v. Sega of America, Inc.*, 50 Cal. Rptr. 3d 607, 608-09 (Cal. Ct. App. 2006) (describing Kirby's claims).

<sup>33</sup> See *id.* at 615-17 (explaining differences between Ulala and Kirby that warranted protection). The court noted that Kirby and the character Ulala's backgrounds differed significantly, notably because Ulala was a news reporter living in a fantasy world and not a musician. *Id.*; see also Kevin L. Chin, Note, *The Transformative Use Test Fails to Protect Actor-Celebrities' Rights of Publicity*, 13 NW. J. TECH. & INTELL. PROP. 197, 204 (2015) (explaining significant role of activity and work setting in applying Test).

<sup>34</sup> See *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 401 (Cal. Ct. App. 2011) (holding song played in different venue not transformative enough). This case involved ska-pop rock band No Doubt, who sued Activision Publishing, Inc. ("Activision") for using their likeness in ways outside the scope of the license granted to Activision for the use of their likeness and music in the popular video game *Band Hero*. See *id.* at 400. No Doubt was unaware that there was a feature in the game that allowed players to use No Doubt's likeness to perform songs other than their own. See *id.* at 402. The court found the First Amendment did not protect Activision in this instance, because, while the setting in which the band performed could be changed in-game, the fact that the band still performed rock songs—the very same activity that the band used to achieve its fame—was not enough to transform the game into a new, expressive creation. See *id.* at 411-12.

(“EA”) cases, *Hart v. Electronic Arts, Inc.*, and *Keller v. Electronic Arts, Inc.*, two different federal courts examined video games focused on collegiate sports and held that there was insufficient transformative use of student-athletes to provide First Amendment protection.<sup>35</sup> Most recently, in *Mitchell v. Cartoon Network, Inc.*, a court examined the likeness of a television character to the plaintiff, Billy Mitchell, a figure in the video gaming community well-known for his world record high scores in famous arcade games, and found the defendant’s use of the plaintiff’s likeness was sufficiently transformative under the Test.<sup>36</sup>

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<sup>35</sup> See *Keller v. Elec. Arts, Inc.* (In re NCAA Student-Athlete Name & Likeness Licensing Litig.), 724 F.3d 1268, 1284 (9th Cir. 2013) (holding that video game’s use of player likeness not protected by First Amendment). In *Keller*, the Ninth Circuit found that EA’s use of National Collegiate Athletic Association (“NCAA”) student-athlete likenesses was not sufficiently transformative to warrant First Amendment protection because the video games literally recreated playing college football, the same setting in which the student-athletes had achieved their celebrity status in the first place. See *id.* at 1276. The Ninth Circuit drew many parallels to *No Doubt* in reaching its decision, as both cases involved celebrities represented as avatars in video games doing what made them famous: playing music in *No Doubt* and playing college football in *Keller*, respectively. See *id.* at 1275-76; *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170 (3d Cir. 2013) (finding in favor of college football player against video game company). Although the Third Circuit in *Hart* and the Ninth Circuit in *Keller* ultimately concluded that video game manufacturers must compensate student-athletes for use of their likenesses, the district court in *Hart* found that the *NCAA Football* games were sufficiently transformative. See *Hart*, 717 F.3d at 170. Unlike the Ninth Circuit, the district court in *Hart* found that features within the games that allowed players to alter student-athlete avatars were transformative enough to be granted First Amendment protection. *Hart*, 717 F.3d at 168. The Third Circuit did not share the district court’s view and its decision was reversed. See *Hart*, 717 F.3d at 170.

It is worth noting that, because of the *Keller* ruling, EA canceled the *NCAA Football* game franchise because each member of the class of student-athletes was to be paid \$4,000 for every year their likeness was used in the games. See also Thomas A. Baker III et al., *Simplifying the Transformative Use Doctrine: Analyzing Transformative Expression in EA’s NCAA Football Sport Video Games*, 7 ELON L. REV. 467, 486 (2015) (noting debate on proper application of Transformative Use Test in *Hart* and *Keller*); Tom Risen, *Electronic Arts Cancels NCAA 2014 Video Game After Lawsuit*, U.S. NEWS (Sept. 27, 2013, 5:36 PM), <https://www.usnews.com/news/articles/2013/09/27/electronic-arts-cancels-ncaa-2014-video-game-after-lawsuit> (detailing EA’s cancellation of 2014 edition of *NCAA Football*); Tom Farrey, *Players, Game Makers Settle for \$40M*, ESPN (May 30, 2014), [https://www.espn.com/espn/otl/story/\\_/id/11010455/college-athletes-reach-40-million-settlement-ea-sports-ncaa-licensing-arm](https://www.espn.com/espn/otl/story/_/id/11010455/college-athletes-reach-40-million-settlement-ea-sports-ncaa-licensing-arm) (detailing settlement agreement that delivered thousands of dollars to student-athletes).

<sup>36</sup> See *Mitchell v. Cartoon Network, Inc.*, No. 15-5668, 2015 WL 12839135, at \*16 (D.N.J. Nov. 20, 2015) (stating plaintiff’s likeness sufficiently transformed where defendant added new features). Billy Mitchell, recognizable by his long black hair and black beard, alleged Cartoon Network misappropriated his likeness in creating a character named Garrett Bobby Ferguson (“GBF”) who appeared as “a giant floating head from outer space, with long black hair and a black beard, but no body.” See *id.* at \*1-3. The court held that “while GBF may [have been] a less-than-subtle evocation of plaintiff, GBF [was] not a literal representation of him” because: (1) GBF appeared as a non-human creature; (2) GBF held the universe record to a different game than the game to which Mitchell held a world record; and (3) GBF attempted to keep his universe record deceit while Mitchell questioned his opponent’s equipment and the authenticity of a filmed

In *Pellegrino*, the District Court for the Eastern District of Pennsylvania dismissed Pellegrino’s right of publicity and privacy claims, finding that Epic’s use of Pellegrino’s likeness was sufficiently transformative under the Transformative Use Test.<sup>37</sup> First, the court established that the First Amendment protects Fortnite as an expressive work because it is a video game.<sup>38</sup> Then, following the precedent set by the Third Circuit in *Hart*, the court applied the Transformative Use Test when balancing Epic’s First Amendment protections against Pellegrino’s publicity and privacy rights.<sup>39</sup> The Transformative Use Test provides that an expressive work that overcomes a celebrity plaintiff’s interest in their likeness is granted First Amendment protections as long as “the product containing [the] celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”<sup>40</sup>

When applying the Transformative Use Test, the court found that Fortnite avatars using the “Phone It In” emote did not resemble Pellegrino in appearance or biographical information.<sup>41</sup> Additionally, Fortnite avatars fight in a battle royale environment and can perform emotes like “Phone It In” while wielding weapons and using violence to eliminate other avatars.<sup>42</sup> On the other hand, Pellegrino is a musical performer who performs his sig-

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high score. *See id.* at \*5. The court likened GBF to the Autumn brothers’ characters from *Winter*, as both had recognizable traits of the source material but were ultimately turned into supernatural creatures. *See id.* at \*6; *see also* *Winter v. D.C. Comics*, 69 P.3d 473, 479 (Cal. 2003) (analyzing Autumn brothers’ likeness as reflected in comic book characters).

<sup>37</sup> *See Pellegrino v. Epic Games, Inc.*, 451 F. Supp. 3d 373, 381-82 (E.D. Pa. 2020) (stating holding).

<sup>38</sup> *See id.* at 380 (discussing Epic’s motion to dismiss claim on First Amendment grounds); *see also Hart*, 717 F.3d at 148 (citing *Brown v. Entm’t Merch. Ass’n*, 564 U.S. 786, 790-91 (2011)) (“[V]ideo games are protected as expressive speech under the First Amendment.”). In determining whether an expressive work violates a plaintiff’s right of publicity and privacy, a court must determine whether the First Amendment protections afforded to the expressive work outweigh the plaintiff’s publicity and privacy rights. *See Hart*, 717 F.3d at 148-49.

<sup>39</sup> *See Pellegrino*, 451 F. Supp. 3d at 380-81 (noting Third Circuit’s use of Transformative Use Test in *Hart*); *see also Hart*, 717 F.3d at 165 (ruling “the Transformative Use Test is the proper analytical framework to apply” when balancing First Amendment protections and publicity rights).

<sup>40</sup> *See Hart*, 717 F.3d at 160 (emphasis omitted) (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001)) (describing origin of Transformative Use Test); *see also Pellegrino*, 451 F. Supp. 3d at 380-81 (explaining Transformative Use Test).

<sup>41</sup> *See Pellegrino*, 451 F. Supp. 3d at 381 (ruling that “the avatars in Fortnite do not share Pellegrino’s identity nor do what Pellegrino does in real life.”) The court referenced a picture of a Fortnite avatar equipped with the “Phone It In” emote and observed that the avatar did not bear any resemblance to Pellegrino. *See id.* *But see* Complaint at 9-12, *Pellegrino v. Epic Games, Inc.*, 451 F. Supp. 3d 373 (E.D. Pa. 2020) (No. 2:19-cv-01806-JP) (detailing how Fortnite’s emote copied Pellegrino’s signature move).

<sup>42</sup> *See Pellegrino*, 451 F. Supp. 3d at 381 (describing Fortnite universe and environment).

nature move at concerts and festivals.<sup>43</sup> The court found that, because Fortnite avatars did not share Pellegrino's identity or his profession, Epic's use of Pellegrino's likeness was sufficiently transformative under the Transformative Use Test.<sup>44</sup> Accordingly, the court dismissed Pellegrino's claim of right to publicity and privacy because Epic's use of Pellegrino's likeness was provided First Amendment protections under the Transformative Use Test that are not outweighed by Pellegrino's interests in his likeness.<sup>45</sup>

While the *Pellegrino* court correctly followed precedent in utilizing the Transformative Use Test, the Test itself is not immune to criticism.<sup>46</sup> A frequently raised issue is that the Test is difficult to apply and predict, forcing judges to make subjective and inconsistent analyses of artworks.<sup>47</sup> Critics also suggest that the Transformative Use Test should be changed in order to properly address the ever-changing world of video games.<sup>48</sup> Even if the Transformative Use Test is crafted well enough to apply to video games, the court's adherence to precedent using this test will leave small, lesser-known figures with no avenue for relief; as a result, Epic may continue to add their signature moves and likeness into Fortnite without permission.<sup>49</sup>

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<sup>43</sup> See *id.* (describing Pellegrino's profession and context of signature move).

<sup>44</sup> See *id.* (outlining reasoning). But see Gerken, *supra* note 10 (recounting Fortnite's first virtual concert); Statt, *supra* note 12 (describing various claims against Epic for Fortnite emotes); Webster, *supra* note 10 (explaining Epic wants Fortnite to become tour stop for artists). Fortnite's head of global partnerships, Nate Nanzer, stated that virtual concerts have been extremely successful, and that Epic is focused on finding ways to host more virtual concerts and performances. See Webster, *supra* note 10.

<sup>45</sup> See *Pellegrino*, 451 F. Supp. 3d at 381 (outlining court's holding).

<sup>46</sup> See Chin, *supra* note 33, at 212 (noting distinctive features of Test are dubious and difficult to apply) The Missouri Supreme Court criticized and rejected the Transformative Use Test, reasoning that, under the Test, a commercial work whose sole purpose was commercial could still receive First Amendment protections as long as there is a slight hint of personal expression. See Chin, *supra* note 33, at 201-02; see also Ford & Liebler, *supra* note 19, at 77 (arguing courts have failed to apply Transformative Use Test properly in video game cases); Gutmann, *supra* note 20, at 222 (discussing inconsistent application of Test to video games).

<sup>47</sup> See Chin, *supra* note 33, at 212 (asserting Transformative Use Test forces judges to decide on artistic value and expressions of artwork).

<sup>48</sup> See Baker *et al.*, *supra* note 35, at 474 (explaining problems applying Test to commercial products with creative components); see also Gutmann, *supra* note 20, at 222 (suggesting line be drawn between "altered reality" games and "imitation of life" games). Gutmann's suggestion would create an important distinction between video games that merely seek to relate to a person, and video games that actually imitate life and intend to replicate a person's life. See Gutmann, *supra* note 20, at 222.

<sup>49</sup> See Robertson, *supra* note 1 (noting smaller figures like "Backpack Kid" are unable to obtain relief); see also *infra* note 52 and accompanying text (explaining criticisms of Transformative Use Test as being ill-suited in application to video games).

The court analyzed Fortnite's universe as one in which players focus only on eliminating the competition.<sup>50</sup> Although this may have been true at the time, the Fortnite universe has since evolved into a venue where performers can hold virtual musical concerts and festivals—events that more closely align with Pellegrino's profession.<sup>51</sup> Because Epic regularly incorporates into Fortnite's universe what musical performers do in real life, Epic's plans for virtual concerts could open the door for celebrities to attack the Transformative Use Test's misguided focus on whether the celebrities' primary claims to fame have been incorporated into the game.<sup>52</sup> As Epic tries to capitalize on Fortnite's success, the result of *Pellegrino* could make Epic overly confident, potentially leading Epic to use the likeness of someone who would not give in but who would make use of the brand new avenue of attack to surprise Epic and succeed on a claim against it.<sup>53</sup> Even if Epic adds people into Fortnite without their permission, Epic would likely rely on this case's precedent and argue that the body and identity of the figures have been sufficiently transformed through the in-game design.<sup>54</sup>

Notwithstanding the addition of regular virtual concerts in Fortnite, the court has opened a door through which Epic can take advantage of lesser known figures by allowing Epic to copy people without their consent and without subsequent repercussions.<sup>55</sup> Lesser-known pop culture figures will find themselves hard-pressed to win a claim against Epic and Epic will have free rein to incorporate pop culture references into their game to attract different audiences with little threat of litigation.<sup>56</sup> In a world where viral videos skyrocket to millions of views within hours, cultural figures

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<sup>50</sup> See *Pellegrino*, 451 F. Supp. 3d at 381 (describing setting where Fortnite avatars interact).

<sup>51</sup> See Webster, *supra* note 10 (detailing Epic's plan for more virtual concerts to extend musical artists' audience); see also *Pellegrino*, 451 F. Supp. 3d at 377 (explaining Pellegrino's profession).

<sup>52</sup> See Webster, *supra* note 10 (outlining Epic's goal to hold additional and longer concerts); see also *supra* text accompanying note 34 (providing example where performing profession in different venue not transformative).

<sup>53</sup> See Webb, *supra* note 10 (noting Epic's ability to adapt to huge audience, providing model for other companies). If a plaintiff can recover on a claim against Epic, it could hurt Epic financially, as demonstrated in *Keller*. See *supra* note 35 and accompanying text. However, even if a plaintiff were to prevail, Epic would likely continue to profit after paying off a settlement. See Webb, *supra* note 10 (reporting Epic's revenue of at least \$2.4 billion in 2018).

<sup>54</sup> See *Kirby v. Sega of America, Inc.*, 50 Cal. Rptr. 3d 607, 615-17 (2006) (explaining how game characters could resemble celebrities and be sufficiently transformed); see also Dey, *supra* note 11 (illustrating how in-game design of characters can differ from celebrities).

<sup>55</sup> See Stoilov, *supra* note 11 (showcasing Epic's collaborations with celebrities too famous to exploit); see also *supra* note 12 and accompanying text (listing Epic's numerous past collaborations).

<sup>56</sup> See Robertson, *supra* note 12 (noting numerous claims against Epic have failed and been dismissed).

want to profit from their internet fame, free from the fear that big corporations and video game developers, like Epic, will profit off their signature moves and images without any repercussions.<sup>57</sup>

In *Pellegrino v. Epic Games, Inc.*, the United States District Court for the Eastern District of Pennsylvania addressed whether Epic's use of Pellegrino's likeness was sufficiently transformative to be granted First Amendment protection under the Transformative Use Test, and whether Pellegrino's interests in his likeness outweighed the protections provided under the Test. Although the court followed Third Circuit precedent in utilizing the Transformative Use Test, the court's application of the Test lays the groundwork for Epic, and similar businesses, to be able to exploit smaller, lesser-known figures. Meanwhile, figures who have more influence and can use their social media following against Epic will always have the benefit of creating legal and legitimate collaborations with Epic, ensuring their share of the profits while building their brand through Fortnite's popular platform.

Epic has molded Fortnite into a platform that creates an amalgamation of characters from all different universes, with collaborations one would never think were possible. Epic's massive influence is extremely enticing to figures who want to gain a larger following by reaching an audience that is normally unavailable to them. As such, more characters and celebrities from different media universes and platforms will do just about anything to reap the benefits of being added into Fortnite. Considering the unprecedented success that one video game can have and the mingling of influencers and characters from a never-ending amount of different universes and platforms, perhaps the court should have stepped away from the Transformative Use Test—or even created a new one altogether—to give smaller, lesser-known figures a chance at presenting a successful claim against the goliath that is Epic Games.

*Nam Le*

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<sup>57</sup> See *id.* (acknowledging lawsuits filed against Epic for utilizing likenesses without permission); see also Statt, *supra* note 11 (explaining “Backpack Kid” and his overnight fame).