

# **Is Tiger Woods's Swing Really a Work of Art? Defining the Line**

## **Between the Right of Publicity and the First Amendment**

By: Michael Suppappola

*The aim of art is to represent not the outward appearance of things, but their inward significance. – Aristotle*

*Those who do not want to imitate anything, produce nothing. – Salvadore Dali*

### **I. Introduction**

The age of the celebrity athlete is upon us. For better or worse, no longer does your local hero merely hit game-winning home runs or sink buzzer-beating fall away jumpers. He now sells you t-shirts and educates you on a virtually endless number of topics, from which sneaker will help you jump the highest to which fast-food establishment will best satisfy your appetite.

A quick walk through your local supermarket will confirm that it is impossible to escape the reach of celebrity athletes in today's culture. Michael Jordan looms down at you from cereal boxes; Donovan McNabb stares at you from soup cans; Sammy Sosa invites you to try a can of soda; Markus Naslund smirks at you from the cover of a video game; Barry Bonds scowls at you from a magazine rack. Indeed, it is becoming increasingly difficult to imagine a world without celebrity athletes.

Athletic success often translates into an economic windfall from sources outside the athletic domain: "[t]hrough endorsements, licensing, sponsorships, and television spots, advertisers offer a seemingly unlimited source of income for today's most popular

athletes.”<sup>1</sup> Due to the increasing economic value of popular athletes’ identities, athletes have become determined to “hold onto the hottest property they know: themselves.”<sup>2</sup> The right of publicity affords professional athletes the right to control the commercial use of his or her identity.<sup>3</sup>

The majority of states now recognize the right of publicity, either at common law or by statute.<sup>4</sup> As with other forms of intellectual property, however, allowing athletes to retain a right of publicity is not free, but is “imposed at the expense of future creators and of the public at large . . .”<sup>5</sup> Specifically, the right of publicity often collides with a core concern of the First Amendment, described by Justice Brandeis as the right to “self-expression in all forms.”<sup>6</sup>

In Cardtoons, L.C. v. Major League Baseball Players Association,<sup>7</sup> Judge Tacha noted that “[t]hrough their pervasive presence in the media, sports and entertainment celebrities come to symbolize certain ideas and values . . . [they] are an important element of the shared communicative resources of our cultural domain.” Thus, the public’s First Amendment right to use an athlete’s image for purposes of expression often conflicts with the athlete’s right of publicity. Courts have struggled to establish the boundaries between the right of publicity and the First Amendment.

This Note attempts to explore the various justifications for affording professional athletes a right of publicity and how to best balance publicity rights with First

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<sup>1</sup> Michael J. Breslin, *ETW Corp. v. Jireh Publishing, Inc.: Turning an Athlete’s Publicity Over to the Public*, 11 J. Intell. Prop. L. 369, 371 (2004).

<sup>2</sup> Id.

<sup>3</sup> Raymond T. Nimmer, *The Law of Computer Technology*, § 16:22. The Right of Publicity (2004).

<sup>4</sup> 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 28:1, at 6-5 (4th ed. 2000).

<sup>5</sup> ETW, Corp. v. Jireh Publishing, Inc., 332 F.3d 915, 932 (6<sup>th</sup> Cir. 2003).

<sup>6</sup> J. Thomas McCarthy, 2 *The Rights of Publicity and Privacy* § 8:2 (2d ed. 2000).

<sup>7</sup> 95 F.3d 959, 972 (1996).

Amendment concerns. Part II traces the history of the right of publicity, from its genesis in early Twentieth Century right to privacy cases to its current status as a generally recognized common law and statutory right. Part III focuses on the “commercial/newsworthy” distinction in early right of publicity cases, and how courts attempted to limit the boundaries of the right of publicity in the face of First Amendment concerns. Part IV addresses the renewed battle between the First Amendment and the right of publicity in a series of court cases from the early 1990s through the present. Part V analyzes the Sixth’s Circuit controversial decision in ETW Corp. v. Jireh Publishing, Inc., which held that an artist’s First Amendment right to use the image of Tiger Woods in an expressive work of art trumped Woods’s right of publicity. Part VI critiques the various balancing tests offered by courts in right of publicity cases. Part VII attempts to answer the fundamental question of whether an athlete’s right of publicity should be recognized by the courts at all. Part VIII concludes.

## **II. History of the Right of Publicity**

### **A. The Right to Privacy and the Commercial/Newsworthy Distinction**

Ironically, the right of *publicity* found its origins in the common law right to *privacy*. In 1890, Harvard Law Review published an article authored by Samuel D. Warren and Louis D. Brandeis entitled “The Right to Privacy.”<sup>8</sup> This influential article argued that “the powers of the common law should be used to protect a right to privacy by creating a ‘quiet zone’ in each person’s life, immune from the prying of neighbors, the press and the public.”<sup>9</sup>

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<sup>8</sup> Samuel D. Warren & Louis D. Brandeis, The Right to Privacy, 4 Harv. L. Rev. 193 (1890).

<sup>9</sup> Breslin, *supra* note 1, at 372.

Following publication of the article, courts and legislatures began to recognize several new tort rights under the label “right to privacy.”<sup>10</sup> In his 1960 article, “Privacy,” University of California Law School Dean William Prosser articulated the four general torts as invasion of privacy by: (1) intrusion; (2) disclosure; (3) false-light; and (4) appropriation.<sup>11</sup>

Nevertheless, courts quickly recognized that “a full-blown right in individuals to control the dissemination of personal information would overwhelm the countervailing constitutional interest in free speech.”<sup>12</sup> Courts began to draw a distinction between “newsworthy” speech and “commercial” speech; the former was speech fully protected by the First Amendment, and the latter was not.<sup>13</sup> Newsworthy speech was generally defined as “the public communication of accurate, newsworthy information.”<sup>14</sup>

“Commercial” speech, however, was considered unprotected by the First Amendment and became vulnerable to right to privacy claims. A “large percentage of the early ‘commercial use’ cases involved advertisements or promotions using the names or faces of people who did not desire that form of notoriety.”<sup>15</sup> For example, in Pavesich v. New England Life Insurance Co., the Supreme Court of Georgia held that “the publication of a picture of a person, without his consent, as a part of an advertisement, for

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<sup>10</sup> Diane L. Zimmerman, *Requiem for a Heavyweight: A Farewell to Warren and Brandeis’s Privacy Tort*, 68 CORNELL L. REV. 291, 296 (1983).

<sup>11</sup> *Id.* at 296-97.

<sup>12</sup> Amicus Curiae Brief of Law Professors in Support of Jireh Publishing, Inc. at 6, *ETW Corp. v. Jireh Publishing, Inc.* (2000).

<sup>13</sup> See Sidis v. F-R Publishing Corp., 113 F.2d 806, 808-09 (2d Cir. 1940) (right to privacy limited by newsworthiness privilege); Pavesich v. New England Life Insurance Co., 50 S.E. 68, 74 (Ga. 1905) (same).

<sup>14</sup> *Id.*

<sup>15</sup> Amicus Brief, *supra* note 12, at 7.

the purpose of exploiting the publisher's business, is a violation of the right of privacy of the person whose picture is reproduced . . .”<sup>16</sup>

In addition to commercial advertisement cases, a number of courts held that speech intended to “entertain” also qualified as “commercial speech.”<sup>17</sup> For example, in Binns v. Vitagraph Company of America, the Court of Appeals of New York held that speech used “to amuse those who paid to be entertained by it” constituted “commercial” speech.<sup>18</sup> Thus, so long as speech was not characterized as “newsworthy,” liability “for commercial appropriation could be imposed at will.”<sup>19</sup>

### **B. Problems with the Common Law Invasion of Privacy by Appropriation**

Nevertheless, a conspicuous weakness of the “invasion of privacy” doctrine was revealed when public figure plaintiffs attempted to take advantage of the new cause of action. The “fundamental justification” for a person’s right to privacy is that “every person has a right to be free from *mental distress* and indignity.”<sup>20</sup> Accordingly, a plaintiff could not prevail unless the court found that commercial appropriation of his or her identity resulted in “harm to a plaintiff’s mental well-being as measured by tort-based mental distress.”<sup>21</sup> Thus, for public figure plaintiffs, courts would rarely find “‘indignity’ or ‘mental distress’ when the plaintiff’s identity was already in widespread use in the

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<sup>16</sup> 50 S.E. 68, 81 (Ga. 1905). See Kunz v. Allen, 172 P. 532 (Kan. 1918) (plaintiff’s picture used in advertisement for drygoods store); Munden v. Harris, 134 S.W. 1076 (Mo. 1911) (plaintiff’s photograph used in advertisement for jewelry business).

<sup>17</sup> Amicus Brief, *supra* note 12, at 7.

<sup>18</sup> Binns v. Vitagraph Company of America, 103 N.E. 1108, 1119 (N.Y. 1913).

<sup>19</sup> Amicus Brief, *supra* note 12, at 8.

<sup>20</sup> Breslin, *supra* note 1, at 373 (emphasis added).

<sup>21</sup> Id.

media.”<sup>22</sup> Conversely, many athletes and entertainers actively strive to make themselves into household names.

For example, in O’Brien v. Pabst Sales Co., Pabst used the photograph of well-known Philadelphia Eagles quarterback David O’Brien on an advertising calendar without O’Brien’s consent.<sup>23</sup> O’Brien brought suit against Pabst for invasion of his right to privacy, claiming that he was damaged by Pabst’s misappropriation of his identity.<sup>24</sup> The U.S. District Court for the Northern District of Texas held that O’Brien could not prevail: “considered from the standpoint merely of an invasion of plaintiff’s right of privacy, no case was made out, because plaintiff was an outstanding national football figure and had completely publicized his name and his pictures.”<sup>25</sup> The Fifth Circuit agreed on appeal, holding that O’Brien was not a private person and “the publicity he got was only that which he had been constantly seeking and receiving.”<sup>26</sup>

Nevertheless, Judge Holmes’ dissenting opinion in O’Brien foreshadowed the creation of a right of publicity. Judge Holmes argued that a plaintiff should be entitled to recover “the reasonable value of the use in trade and commerce of his picture for advertisement purposes, to the extent that such use was appropriated by [Pabst].”<sup>27</sup> Judge Holmes distinguished the right to privacy from what would later become the right to publicity:

The right to privacy is distinct from the right to use one’s name or picture for purposes of commercial advertisement. The latter is a property right

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<sup>22</sup> Id.

<sup>23</sup> 124 F.2d 167, 168 (5<sup>th</sup> Cir. 1941).

<sup>24</sup> Id.

<sup>25</sup> Id.

<sup>26</sup> Id. at 170.

<sup>27</sup> Id.

that belongs to every one; it may have much or little, or only a nominal value; but it is a personal right, which may not be violated with impunity.<sup>28</sup>

### C. The Birth of the Right of Publicity

The right of publicity was first recognized in Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.<sup>29</sup> In Haelan, two rival baseball card manufacturers argued over the exclusive right to use the image of a professional baseball player to promote their product.<sup>30</sup> The “plaintiff’s case hinged on asserting an exclusive property right in the baseball player’s images that appeared on the cards.”<sup>31</sup> The defendant argued that the plaintiff’s only viable claim for relief was violation of the right to privacy, which would fail because, as in O’Brien, a professional baseball player would be unable to show that he suffered mental distress from the publication of his photograph.<sup>32</sup>

The Second Circuit, however, concluded “a man has a right in the publicity value of his photograph.”<sup>33</sup> The court explained:

This right might be called a ‘right of publicity.’ For it is common knowledge that many prominent persons (especially actors and ballplayers), 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.

Just one year later, the development of the right of publicity was “further cultivated by Melvin Nimmer in his seminal article *The Right of Publicity*.”<sup>34</sup> Nimmer

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<sup>28</sup> Id.

<sup>29</sup> 202 F.2d 866 (2d Cir. 1953).

<sup>30</sup> Id. at 867.

<sup>31</sup> Breslin, *supra* note 1, at 375.

<sup>32</sup> Id.

argued, “traditional privacy law could not adequately protect the commercial interests people held in themselves because its protection was limited to those situations involving embarrassment or humiliation stemming from unauthorized advertising use.”<sup>35</sup>

Moreover, Nimmer argued that both celebrities *and* private persons should be afforded the right of publicity:

It is impractical to attempt to draw a line as to which persons have achieved the status of celebrity and which have not; it should rather be held that every person has the property right of publicity, but that the damages which a person may claim for infringement of the right will turn upon the value of the publicity appropriated which in turn will depend in great measure upon the degree of fame attained by the plaintiff. Thus, the right of publicity accorded to each individual ‘may have much or little, or only a nominal value,’ but the right should be available to everyone.<sup>36</sup>

By the 1990s, the right of publicity had developed into a well established doctrine accepted by most courts, exemplified by its inclusion in the 1995 Restatement of Unfair Competition: “[o]ne who appropriates 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 . . .”<sup>37</sup>

Nevertheless, in the years following the Haelan decision, most courts refused to legitimize the new cause of action, particularly because of its “important economic and social implications.”<sup>38</sup> The First Amendment provided effective ammunition for courts wishing to eradicate publicity rights.

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<sup>33</sup> Haelan, 202 F.2d 866 at 868.

<sup>34</sup> Cardtoons, 95 F.2d at 967.

<sup>35</sup> Breslin, *supra* note 1, at 375-76.

<sup>36</sup> Melvin B. Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203, 204 (1954) (citing *O'Brien v. Pabst Sales Co.*, 124 F.2d at 170).

<sup>37</sup> Restatement (Third) of Unfair Competition § 46 (1995).

<sup>38</sup> Breslin, *supra* note 1, at 377.

### **III. The Battle for Legitimacy: Early Cases Defining the Boundary Between the Right of Publicity and the First Amendment**

#### **A. Early Balancing of the Right of Publicity and the First Amendment**

In right of publicity cases, courts would abide by the same rules that pertained in privacy cases, specifically the distinction between “newsworthy” and “commercial” publications.<sup>39</sup> However, “what got lost in the process was any recognition that, by the 1950s and 1960s, those two categories were no longer synonymous with protected and unprotected speech.”<sup>40</sup> For example, the Binns line of cases (holding that speech meant to entertain should be classified as commercial) was slowly overtaken by Supreme Court cases holding that “fiction, film, art and other forms of speech intended to entertain were as fully entitled to constitutional protections as was classically ‘newsworthy’ speech.”<sup>41</sup> In 1973, the Supreme Court explicitly made clear that “pictures, films, paintings, drawings, and engravings . . . have First Amendment protection.”<sup>42</sup>

Even speech that directly proposed a commercial transaction, which was entirely unprotected prior to 1976, was afforded some measure of First Amendment protection by the Supreme Court in Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.<sup>43</sup> Thus, courts attempting to utilize the “commercial/newsworthy”

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<sup>39</sup> Amicus Brief, *supra* note 12, at 8.

<sup>40</sup> Id.

<sup>41</sup> Id. at 9. See, e.g. Ward v. Rock Against Racism, 491 U.S. 781 (1989) (music independent of its lyrics, is protected speech); Southeastern Promotions, Ltd. v. Conrad, 420 U.S. 546 (1975) (plays); Spence v. Washington, 418 U.S. 405 (1974) (American flag bearing a peace symbol); Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495 (1952) (motion pictures); Winters v. New York, 333 U.S. 507 (1948) (publications intended to entertain).

<sup>42</sup> Kaplan v. California, 413 U.S. 115, 119-20 (1973).

<sup>43</sup> 425 U.S. 748 (1976). See Time, Inc. v. Hill, 385 U.S. 374, 397 (1967) (works published for ‘trade purposes’ do not lose First Amendment protection).

distinction in determining the boundary between publicity rights and the First Amendment were not only left without a map, but also without a compass. Judges who were hostile to the right of publicity used the recent expansion of First Amendment protections to deny plaintiffs' right of publicity claims.

For example, in Rosemont Enterprises, Inc. v. Random House, Inc.,<sup>44</sup> Justice Frank of the New York Supreme Court refused to enjoin the publishing of an unauthorized biography of Howard Hughes. Frank explained that “[j]ust as a public figure’s ‘right of privacy’ must yield to the public interest so too must the ‘right of publicity’ bow where such conflicts with the free dissemination of thoughts, ideas, newsworthy events, and matters of public interest.”<sup>45</sup> A few months later, Justice Frank again used First Amendment principles to “stifle a plaintiff’s attempt to enjoin the unauthorized sale of mock presidential campaign posters” depicting a comedian, Pat Paulson, as a candidate.<sup>46</sup> Justice Frank noted, “[w]hen a well-known entertainer enters the presidential ring, tongue in cheek or otherwise, it is clearly newsworthy and of public interest.”<sup>47</sup> The Supreme Court would not specifically address the right of publicity until 1977, in the landmark case of Zacchini v. Scripps-Howard Broadcasting, Co.<sup>48</sup>

## **B. Zacchini v. Scripps-Howard Broadcasting, Co.: The Supreme Court Tackles the Right of Publicity**

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<sup>44</sup> 294 N.Y.S.2d 122 (N.Y. Sup. Ct. 1968).

<sup>45</sup> Id. at 129.

<sup>46</sup> Breslin, *supra* note 1, at 5.

<sup>47</sup> Paulson v. Personality Posters, Inc., 299 N.Y.S.2d 501, 507 (N.Y. Sup. Ct. 1968).

<sup>48</sup> 433 U.S. 562 (1977).

Hugo Zacchini was an entertainer who performed a “human cannonball” act in which he was shot from a cannon into a net approximately 200 feet away.<sup>49</sup> Although Zacchini specifically requested that reporters not film his act, a local news station videotaped and aired a film clip of his entire fifteen-second performance.<sup>50</sup> Zacchini brought suit in Ohio for infringement of his common law right of publicity.<sup>51</sup> The Supreme Court of Ohio held that “[a] TV station has a privilege to report in its newscasts matters of legitimate public interest which would otherwise be protected by an individual’s right of publicity.”<sup>52</sup>

The Supreme Court reversed the Ohio court, holding that “the broadcast of a film of petitioner’s entire act poses a substantial threat to the economic value of that performance.”<sup>53</sup> Zacchini, however, was not exactly an overwhelming triumph for the right of publicity over the First Amendment. Conversely, the Court emphasized the unique facts of the case, noting that the case involved “not the appropriation of an entertainer’s reputation to enhance the attractiveness of a commercial product,” but “goes to the heart of petitioner’s ability to earn a living as an entertainer.”<sup>54</sup> Thus, the Supreme Court’s narrow holding in Zacchini is of little relevance to later cases concerning the unauthorized use of celebrity identities to sell a product, such as ETW Corp. v. Jireh Publishing, Inc.

Nevertheless, the importance of Zacchini lies in its analysis of the justifications for the right of publicity. The Supreme Court noted that the right of publicity served

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<sup>49</sup> Id. at 563.

<sup>50</sup> Id. at 564.

<sup>51</sup> Id.

<sup>52</sup> Id. at 565.

<sup>53</sup> Id. at 575.

“three basic functions: (1) it prevented others from being unjustly enriched by the plaintiff’s goodwill, (2) it kept others from interfering with the plaintiff’s right to make a living as an entertainer, and (3) it provided entertainers and celebrities an economic incentive to continue to invest in creating performances that the public could enjoy.”<sup>55</sup> Zacchini is also important for its implicit holding that a state right of publicity claim will not be automatically defeated by a First Amendment defense; instead, the Supreme Court made clear that the right of publicity and the First Amendment interest in free expression must be balanced “according to the relative importance of the interests at stake.”<sup>56</sup>

#### **IV. Freeriding on a Celebrity’s Fame and the Birth of the “Transformative” Elements Test**

In the years following Zacchini, courts have struggled to balance right of publicity claims with the First Amendment. A recent string of cases involving celebrities and professional athletes exemplifies the disagreement and disharmony among courts on this issue.

##### **A. The Second Circuit**

In Rogers v. Grimaldi,<sup>57</sup> Ginger Rogers sued the producers and distributors of a motion picture entitled “Ginger and Fred” for violation of her right of publicity.<sup>58</sup> The film’s title referred to the names of its two protagonists, Ginger and Fred. Moreover, the

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<sup>54</sup> Id. at 576.

<sup>55</sup> Jacy T. Jasmer, ETW Corp. v. Jireh Publishing, Inc.: A Workable Standard, An Unworkable Decision, 5 Minn. Intel. Prop. Rev. 293, 296 (2004). The persuasiveness of each of these justifications with respect to professional athletes will be examined further in Part VI of this Note.

<sup>56</sup> Comedy III Productions, Inc. v. Gary Saderup, Inc., 25 Cal.4<sup>th</sup> 387, 401, 21 P.3d 797, 806, 106 Cal.Rptr.2d 126, 137 (2001)

<sup>57</sup> 875 F.2d 994, 1004 (2d Cir. 1989).

film attempted to contrast the “elegance” of 1940s era American cinema to the “gaudiness and banality of contemporary television, which (the director) satirizes.”<sup>59</sup>

The Second Circuit held that the right of publicity would not bar the use of a celebrity’s name in a movie title “unless the title was ‘wholly unrelated’ to the movie or was ‘simply a disguised commercial advertisement for the sale of goods or services.’”<sup>60</sup> The court held that the title “Ginger and Fred” was “clearly related to the content of the movie and is not a disguised commercial advertisement for the sale of goods or services or a collateral commercial product,” and thus did not violate Rogers’ right of publicity.<sup>61</sup>

The Second Circuit’s “disguised commercial advertisement” test has been widely adopted by other circuits, but limited to cases where the title of an artistic work uses a celebrity’s name. Nevertheless, courts utilizing the Second Circuit test have often arrived at contrary results. In Parks v. LaFace Records,<sup>62</sup> the hip hop group Outkast was sued when they used the name of Rosa Parks in a song title that did not convey factual information about Parks. The Sixth Circuit denied Outkast’s motion for summary judgment, holding that “a reasonable finder of fact . . . could find the title to be a ‘disguised commercial advertisement’ or adopted ‘solely to attract attention’ to the work.”<sup>63</sup> The court found that there was no relationship between the song’s title and its content, despite the chorus refrain of “[e]verybody move to the back of the bus.”<sup>64</sup>

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<sup>58</sup> Id. at 996.

<sup>59</sup> Id. at 1001.

<sup>60</sup> Id. at 1004.

<sup>61</sup> Id. at 1004-05.

<sup>62</sup> 329 F.3d 437 (2003).

<sup>63</sup> Id. at 461.

<sup>64</sup> Id. at 442.

In contrast, the Ninth Circuit found that Aqua’s song entitled “Barbie Girl” was not a “disguised commercial advertisement” because the group claimed that the song used “Barbie’s image” to comment “humorously” on Barbie’s cultural values.<sup>65</sup> Although “Barbie” was not a right of publicity case (the claim was trademark infringement), the decision exemplifies the disparate outcomes of cases using the Second Circuit test. Nevertheless, the test has thus far been limited to cases where a product’s *title* uses a celebrity identity, and thus does not apply to cases such as Jireh where a celebrity “image” has been appropriated.

## **B. The Sixth Circuit**

Prior to its decision in Jireh, the Sixth Circuit decided several cases that involved balancing the right of publicity with the First Amendment. In Carson v. Here’s Johnny Portable Toilets, Inc., talk show host Johnny Carson sued a toilet manufacturer for using Carson’s popular catch phrase.<sup>66</sup> The Sixth Circuit found that the defendant had violated Carson’s right of publicity, holding that “a celebrity has a protected pecuniary interest in the commercial exploitation of his identity.”<sup>67</sup> Judge Kennedy’s dissent noted, “public policy requires that the public’s interest in free enterprise and free expression take precedence over any interest Johnny Carson may have in a phrase associated with his person.”<sup>68</sup>

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<sup>65</sup> Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 907 (9<sup>th</sup> Cir. 2002).

<sup>66</sup> 698 F.2d 831 (6<sup>th</sup> Cir. 1983).

<sup>67</sup> Id. at 835.

<sup>68</sup> Id. at 841.

In Memphis Development Foundation v. Factors, Inc.,<sup>69</sup> Elvis Presley’s heirs sued the defendant for making a large bronze statue and numerous small pewter copies to honor the deceased singer. Although the case “was decided on other grounds,” Judge Meritt “referred to the existence of significant First Amendment questions” and “to the importance of allowing important information and symbols to enter the public domain where all are free to use them.”<sup>70</sup>

### C. The Tenth Circuit

Seven years before Jireh, the Tenth Circuit decided a case focusing on the right of publicity with respect to professional athletes. In Cardtoons, L.C., v. Major League Baseball Players Assoc.,<sup>71</sup> the Tenth Circuit held that baseball card parodies of several professional baseball players did not violate the athletes’ rights of publicity. The court “did not base its decision on some special First Amendment status enjoyed by parody . . . [r]ather, the court’s discussion took into consideration ordinary trading cards as well, terming all of them ‘an important medium for disseminating information.’”<sup>72</sup> The court found that the cards should receive full First Amendment protection:

Cardtoons’ parody trading cards receive full protection under the First Amendment. The cards provide social commentary on public figures, major league baseball players, who are involved in a significant commercial enterprise, major league baseball. While not core political speech . . . this type of commentary on an important social institution constitutes protected expression.<sup>73</sup>

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<sup>69</sup> 616 F.2d 956 (6<sup>th</sup> Cir. 1980).

<sup>70</sup> Amicus Brief, *supra* note 12, at 13.

<sup>71</sup> 95 F.3d 959, 972 (1996).

<sup>72</sup> Amicus Brief, *supra* note 12, at 11.

<sup>73</sup> Cardtoons, 95 F.3d at 969.

The Cardtoons court also commented on the potential danger publicity rights pose to the public domain. The court noted that celebrities are a “common point of reference for millions of individuals who may never interact,” and that “through their pervasive presence in the media, sports and entertainment celebrities come to symbolize certain ideas and values . . . [they] are an important element of the shared communicative resources of our cultural domain.”<sup>74</sup> Thus, overprotection of publicity rights would inevitably deprive the public of a valuable component of our modern marketplace of ideas.

The Tenth Circuit called into question the viability of publicity rights for professional athletes. With respect to the first Zacchini justification of incentive, the court bluntly stated, “[t]he extra income generated by licensing one’s identity does not provide a necessary inducement to enter and achieve in the realm of sports and entertainment.”<sup>75</sup> With respect to the second Zacchini justification of depriving entertainers of the right to make a living, the Tenth Circuit noted that professional athletes receive a more than adequate “rate of return” from their primary profession, and furthermore “even in the absence of publicity rights, celebrities would still be able to reap financial reward from authorized appearances and endorsements.”<sup>76</sup> With respect to the third Zacchini justification of unjust enrichment, the court observed, “Cardtoons added a significant creative component of its own to the celebrity identity and created an entirely new product.”<sup>77</sup> In addition, the court noted that “[c]elebrities . . . are often not fully

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<sup>74</sup> Id. at 972.

<sup>75</sup> Id. at 974.

<sup>76</sup> Id.

<sup>77</sup> Id. at 976.

responsible for their fame . . . fame may largely be the creation of the media or the audience.”<sup>78</sup>

Finally, the Tenth Circuit inferred that the right of publicity may best serve the public if confined to cases that affect an entertainer’s incentive to perform, such as in Zacchini: “[t]he distinction between the value of a person’s identity and the value of his performance explains why Zacchini . . . is a red herring . . . the Court’s incentive rationale is obviously more compelling in a right of performance case than in a more typical right of publicity case involving the appropriation of a celebrity’s identity.”<sup>79</sup> The Tenth Circuit’s logical dismantling of professional athletes’ publicity rights would play a pivotal role in influencing the Sixth Circuit’s decision in the Jireh case seven years later.

#### **D. The Ninth Circuit**

The Supreme Court of California and the Ninth Circuit developed the “transformative elements” test through a line of cases beginning with White v. Samsung Electronics America, Inc.<sup>80</sup> and ending with Comedy III Productions, Inc. v. Gary Saderup, Inc.<sup>81</sup>

In White, television celebrity Vanna White brought suit, alleging that the defendant’s use of a robot wearing a long gown and blonde wig who turned letters on a game show set designed to look like “Wheel of Fortune” constituted a violation of her publicity rights. The Ninth Circuit reversed a grant of summary judgment for the

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<sup>78</sup> Id. at 975.

<sup>79</sup> Id. at 973.

<sup>80</sup> 989 F.2d 1512 (9<sup>th</sup> Cir. 1993).

<sup>81</sup> 25 Cal.4<sup>th</sup> 387, 401, 21 P.3d 797, 806, 106 Cal.Rptr.2d 126, 137 (2001)

defendant, and a suggestion for rehearing *en banc* failed.<sup>82</sup> In a blistering dissent, Judge Kozinski explained that overprotection of such intellectual property rights would cause harm to the public domain:

Something very dangerous is going on here . . . Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain . . . Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large . . . This is why intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us[.]<sup>83</sup>

The Ninth Circuit's next right of publicity decision came in Hoffman v. Capital Cities/ABC, Inc.<sup>84</sup> In Hoffman, actor Dustin Hoffman alleged that a magazine used an unauthorized still photograph from the movie *Tootsie* which used computer generated images to falsely depict him wearing recent spring fashions. The magazine article contained sixteen familiar scenes of famous actors used to show what they'd look like in contemporary designer clothing. The Ninth Circuit found that the article used "a combination of fashion photography, humor, and visual and verbal editorial comment" on classic films, and any commercial aspects were "inextricably intertwined with expressive elements."<sup>85</sup> The Hoffman "expressive elements" test would serve as the basis of the California Supreme Court's "transformative" test set forth in Comedy.

Finally, in Comedy, the owner of all rights to the Three Stooges comedy team brought suit against an artist selling lithographic prints of the Stooges on t-shirts. The court first found that the drawings contained "expressive elements," and therefore were

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<sup>82</sup> White, 989 F.2d at 1512.

<sup>83</sup> Id. at 1516.

<sup>84</sup> 255 F.3d 1180, 29 Media L. Rep. (BNA) 1993, 59 U.S.P.Q.2d (BNA) 1363 (9<sup>th</sup> Cir. 2001).

entitled to First Amendment protection because they were not merely an “advertisement or endorsement of a product.”<sup>86</sup> The court rejected the plaintiff’s argument that the t-shirts lost First Amendment protection because they were sold via multiple reproductions: “[A] reproduction of a celebrity image that . . . contains significant creative elements is entitled to as much First Amendment protection as an original work of art.”<sup>87</sup>

In finding that the plaintiff’s publicity rights had been violated, the court set forth the “transformative elements” test for determining the proper balance between the right of publicity and the First Amendment:

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, [the right of publicity trumps the First Amendment]. On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.<sup>88</sup>

The court added that another way to view the test is “whether the celebrity likeness is one of raw materials from which the original work was synthesized,” or whether the celebrity image is the “very sum and substance of the work.”<sup>89</sup> The court then added yet another “useful subsidiary inquiry” to be used in close cases: “does the

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<sup>85</sup> *Id.* at 1185.

<sup>86</sup> *Comedy*, 25 Cal.4<sup>th</sup> at 396.

<sup>87</sup> *Id.* at 408.

<sup>88</sup> *Id.* at 405.

<sup>89</sup> *Id.* at 406.

marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted?”<sup>90</sup>

Adding further to the confusion of the “transformative” test, the court explained that the First Amendment may protect even literal reproductions of a celebrity, noting that painter Andy Warhol was able to convey the “dehumanization of celebrity itself” through literal depiction.<sup>91</sup>

After sorting through the semantic acrobatics of the Comedy decision, the “transformative test” would appear to consist of the following inquiry. First, did the plaintiff appropriate the defendant’s identity for commercial gain without the plaintiff’s consent? If the answer is yes, then the defendant may assert First Amendment protection as an affirmative defense. The defendant must show that (1) the use was not a purely commercial “advertisement or endorsement of a product,” and thus qualified for First Amendment protection, and (2) the use was not a literal depiction of the celebrity, but contained significant “transformative” elements. Finally, if the court has difficulty deciding the prior inquiry, it should (3) find for the plaintiff if the marketability of the product derives primarily from the celebrity’s fame. To add to the confusion, the Ninth Circuit noted that courts may *completely disregard* the “literal depiction” portion of the “transformative” test in cases featuring “subtle” artists such as Andy Warhol.

Although far from clear, the Comedy “transformative elements” test at least provided some direction for courts in future right of publicity cases. Two years after

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<sup>90</sup> Id. at 407.

<sup>91</sup> Id. at 408-09.

Comedy, the Sixth Circuit would assay the viability of the Ninth Circuit transformative test in ETW Corp. v. Jireh Publishing, Inc.

## **V. ETW Corp. v. Jireh Publishing, Inc: The “Tiger Woods” Case**

Sports artist Rick Rush has painted some of America’s most famous athletes for over twenty-five years. Rush’s vast collection of sports paintings include Michael Jordan, Wayne Gretzky, Cal Ripken, and Mark McGwire.<sup>92</sup> In 1997, Rush painted a picture of Tiger Woods playing golf in the 1997 Master’s Tournament. Entitled “The Masters of Augusts,” the painting depicts “Woods in three different poses, against a backdrop of the Augusta National clubhouse, the leader board, and images of legendary champions, including Sam Snead, Walter Hagan, Bobby Jones, Ben Hogan, Jack Nicklaus, and Arnold Palmer.<sup>93</sup> Rush’s publisher, Jireh, distributed limited edition prints of Rush’s painting.<sup>94</sup>

The Eldrick Tiger Woods Corporation (ETW) brought suit against Jireh, alleging (among several other charges) that Jireh violated Wood’s right of publicity under Ohio common law.<sup>95</sup> Jireh countered that the First Amendment protected the prints because they were “artwork” and not commercial speech.<sup>96</sup>

### **A. The District Court Grants Jireh’s Motion for Summary Judgment**

The Ohio District Court granted Jireh’s motion for summary judgment on the right to publicity claim, holding that Rush’s paintings went beyond merely “proposing a

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<sup>92</sup> Jerold A. Greenfield, *The Art World News*, Jan/Feb2004.

<sup>93</sup> Id.

<sup>94</sup> ETW, 332 F.3d at 918.

<sup>95</sup> Id. at 919.

<sup>96</sup> ETW Corp. v. Jireh Publishing, Inc., 99 F.Supp.2d 829, 834 (N.D. Ohio 2000).

commercial transaction.” and were therefore protected by the First Amendment.<sup>97</sup> The court quoted the Second Circuit’s decision in Bery v. City of New York: “paintings, photographs, prints and sculptures ... always communicate some idea or concept to those who view it, and as such are entitled to full First Amendment protection.”<sup>98</sup> The court held that Rush’s painting was “an artistic creation seeking to express a message. The fact that it is sold is irrelevant to the determination of whether it receives First Amendment protection.”<sup>99</sup> Since the First Amendment protected the painting, the court noted, no balancing test was needed; the First Amendment always trumps a right of publicity claim.

### **B. The Sixth Circuit Upholds the District Court Decision**

On appeal, the Sixth Circuit upheld the District Court decision, albeit with an entirely different analysis. The court first looked to the Restatement of Unfair Competition to determine the “common law” definition of the right of publicity: “The current version of the Restatement (Third) of Unfair Competition defined the right as . . . [o]ne who appropriates 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 . . . .”<sup>100</sup> The court utilized the Restatement Definition and accompanying Comments to articulate a test for finding whether the Woods’s right of publicity had been violated: “Under this rule, the substantiality and market effect of the use of the celebrity’s image is analyzed in light of the informational and creative content of the defendant’s use.”<sup>101</sup>

In concluding that Rush’s painting had “substantial informational and creative content which outweighs any adverse effect on ETW’s market,” the court noted that

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<sup>97</sup> Id. at 835.

<sup>98</sup> 97 F.3d 689, 696 (2<sup>nd</sup> Cir. 1996).

<sup>99</sup> ETW, 99 F.Supp.2d at 836.

<sup>100</sup> ETW, 332 F.3d at 930.

Rush’s painting consisted of much more than the literal likeness of Tiger Woods: “It is a panorama of Woods’s victory at the 1997 Masters Tournament . . . [a] piece of art that portrays a historic sporting event communicates and celebrates the value our culture attaches to such events . . . Rush’s work conveys the message that Woods himself will someday join [the revered group of Masters champions].”<sup>102</sup>

Although the court could have concluded its analysis in finding that Woods’s right of publicity had not been violated, it further found that Rush’s work was “expression which is entitled to the full protection of the First Amendment.”<sup>103</sup> In making its determination, the court quoted Cardtoons: “sports and entertainment celebrities . . . have become a valuable means of expression in our culture.”<sup>104</sup> The court held that Rush’s prints “are not commercial speech. They do not propose a commercial transaction. Accordingly, they are entitled to the full protection of the First Amendment.”<sup>105</sup>

The court then proceeded to use the Comedy “transformative elements” to balance Woods’s publicity rights against the First Amendment. Before beginning its “transformative” analysis, the court noted that Woods’s primary employment was playing golf, not licensing his image:

“Woods, like most sports and entertainment celebrities . . . engages in an activity, professional golf, that in itself generates a significant amount of income which is unrelated to his right of publicity . . . [i]t is not at all clear that the appearance of Woods’s likeness in artwork prints which display one of his major achievements will reduce the commercial value of his likeness.”<sup>106</sup>

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<sup>101</sup> Id. at 937.

<sup>102</sup> Id. at 936.

<sup>103</sup> Id. at 937.

<sup>104</sup> Id. at 937-38.

<sup>105</sup> Id. At 925.

<sup>106</sup> Id. at 938.

In finding that Rush's prints contained transformative elements, the court essentially echoed its findings with respect to the Restatement test:

Unlike the unadorned, nearly photographic reproduction of the faces of The Three Stooges in Comedy III, Rush's work does not capitalize solely on a literal depiction of Woods. Rather, Rush's work consists of a collage of images in addition to Woods's image which are combined to describe, in artistic form, a historic even in sports history and to convey a message about the significance of Woods's achievement in that event. Because Rush's work has substantial transformative elements . . . Woods's right of publicity must yield to the First Amendment.<sup>107</sup>

Although the Jireh majority applied the correct "transformative elements" test to find that the First Amendment trumped Woods's publicity rights, the opinion as a whole featured several problems.

### **C. Problems with the Majority Opinion**

First, although the court found that Woods's right of publicity had not been violated pursuant to the common law Restatement test, the court continued to discuss whether Rush's prints should receive First Amendment protection and *then* applied the "transformative" balancing test. However, the Restatement inquiry provides essentially the same balancing test as the Comedy test. In other words, when the court found that Woods's right of publicity had not been violated pursuant to the Restatement test, it in essence *already* found the following: (1) Rush's work did not merely propose a commercial transaction, and thus offered "substantial informational and creative content" protected under the First Amendment; and (2) the "substantial informational and creative content" of Rush's work outweighed Woods's right of publicity. Thus, by applying both the Restatement test *and* the transformative test, the court balanced Woods's right of publicity with the First Amendment *twice*. Assuming *arguendo* that the court had

reached different conclusions with respect to the two tests, it is unclear which balancing test would trump. More importantly, once the court stated that Woods’s right of publicity had not been violated, the inquiry should have ended.

Second, the court may not have correctly applied the Comedy transformative test. Comedy makes clear that the “transformative elements” test should be utilized as an affirmative defense.<sup>108</sup> The Sixth Circuit, however, failed to make clear which party had the burden of proving whether Rush’s work contained transformative elements. In fact, the Jireh court seemed to apply all three tests (i.e. the Restatement test, the First Amendment test, and the transformative test) as threshold inquiries in determining whether Woods’s right of publicity had been violated. Moreover, assuming the court *did* apply the transformative test as an affirmative defense, the test would have been moot because the court had already found that Woods’s right of publicity had not been violated.

Finally, the court considered the “literal depiction” prong of the Comedy test, but failed to inquire into the subsidiary “marketability” prong. Although the Comedy court merely offered the second prong as a “subsidiary inquiry” which courts “may find useful . . . in close cases,” it would be difficult to argue that Jireh was not a “close” case.<sup>109</sup>

#### **D. Judge Clay’s Dissent**

The Jireh majority opinion clearly left itself vulnerable to criticism, which was plentifully supplied by Judge Clay’s blistering dissent. Judge Clay first pointed out the obvious: “[t]he majority makes a somewhat disjointed holding regarding Plaintiff’s right

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<sup>107</sup> Id.

<sup>108</sup> Comedy, 25 Cal.4<sup>th</sup> at 407 (holding that “[i]n sum, when an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements . . .”).

of publicity claim . . . it appears that the majority engages in three separate analyses, and arrives at three separate holdings, although all of which reach the same result.”<sup>110</sup>

According to Judge Clay, the Comedy transformative elements test was “the approach best suited” for determining whether Rush’s prints deserved First Amendment protection.<sup>111</sup> Applying the test, Clay observed that it was difficult to “discern any appreciable transformative or creative contribution in Defendant’s prints . . .”<sup>112</sup> Clay argued that Rush’s “overall goal” was to create “literal, conventional depictions of [Tiger Woods] so as to exploit his . . . fame [such that Rush’s] right of free expression is outweighed by [Woods’] right of publicity.”<sup>113</sup>

Nevertheless, Judge Clay’s “transformative” analysis cut away from the Comedy “literal depiction” inquiry and instead focused on whether the “focus” of the work was the celebrity: “the clear focus of the work is Woods in full body image . . . the focus of the print is not the Masters Tournament or the other golfers . . . but that of Woods holding his famous golf swing while at that tournament.”<sup>114</sup> To exemplify his point, Judge Clay noted that the narrative accompanying the prints expressly discussed Woods, reading in part, “the center of [other golfers’] gaze is 1997 winner Tiger Woods . . .”<sup>115</sup> Therefore, Judge Clay concluded, “it is clear that the prints gain their commercial value by exploiting the fame and celebrity status that Woods has worked to achieve.”<sup>116</sup>

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<sup>109</sup> Id.

<sup>110</sup> ETW, 332 F.3d at 951.

<sup>111</sup> Id. at 952.

<sup>112</sup> Id. at 959.

<sup>113</sup> Id.

<sup>114</sup> Id.

<sup>115</sup> Id.

<sup>116</sup> Id. at 960.

However, apart from one sentence mentioning that Rush’s overall goal was to create “literal, conventional” depictions of Woods, Judge Clay failed to explain *why* he viewed Rush’s painting as a literal depiction of Woods. Instead, Judge Clay concentrated on the Comedy subsidiary “marketability” inquiry, arguing that the *focus* of Rush’s painting is Tiger Woods, and therefore the prints gain their commercial value by exploiting Woods’s celebrity.

In sum, although Judge Clay ostensibly found that Rush’s picture was a literal depiction of Woods, his analysis gave only lip-service to the Comedy literal depiction inquiry. Thus, both the majority and dissent applications of the “transformative elements” test were suspect.

## **VI. Beyond Transformative: The Future of the Right of Publicity**

The Sixth Circuit decision in Jireh has given courts little guidance in how to properly balance the right of publicity with the First Amendment. Following the controversial decision, many commentators have weighed in on how effective balancing should be conducted in the future. Nevertheless, the proposed “solutions” are often more fraught with problems than the test applied in Jireh.

### **A. The “Marketability” Test**

The majority of commentators have argued that the Jireh majority did not give enough deference to the “marketability” prong of the Comedy test. Michael Breslin believes that a “proper analysis” of the transformative test “would not have ignored the lack of transformative elements in the images of Woods himself nor would it have

ignored the subsidiary inquiry as to the true source of the painting's marketability."<sup>117</sup> To further his point, Breslin posits the question, "[h]ow marketable would the painting be if a generic golfer, rather than Tiger Woods, was the centerpiece of the work?"<sup>118</sup> Breslin argues that the "marketability" analysis would prevent "trivial elements" and "a few supplementary elements in the backdrop" of a work from diverting judges' attentions away from where the true economic value of a painting lies.<sup>119</sup>

Jacy Jasmer believes that the "transformative" test should apply as an affirmative defense, where the defendant not only has the burden of showing that the artwork "contains significant transformative elements," but also that the "marketability and economic value of the challenged work does not derive from the fame of the celebrity depicted."<sup>120</sup> Thus, Jasmer believes that the Comedy test should be modified in that the "subsidiary inquiry" should be promoted to a mandatory inquiry that must be proven before a defendant is afforded First Amendment protection.

Nevertheless, heavy reliance on the "marketability" inquiry would cause vast overprotection of publicity rights at the expense of the public domain. For example, few would argue that a biography of Michael Jordan does not contain "expressive elements" such that it should be afforded First Amendment protection, regardless of the fact that it is sold commercially. It is equally difficult, however, to argue that the primary marketability of such a biography would not stem primarily from the fame of Michael

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<sup>117</sup> Breslin, *supra* note 1, at 393.

<sup>118</sup> *Id.* at 392.

<sup>119</sup> *Id.* at 391.

<sup>120</sup> Jasmer, *supra* note 55, at 335.

Jordan.<sup>121</sup> Thus, under Breslin’s “marketability” test, Michael Jordan would be able to sue biographers at will. Moreover, even under Jasmer’s more liberal “transformative” test, a biographer might satisfy the “expressive elements” prong, but would always fail to meet his burden of proving that the marketability of the biography *does not* stem primarily from the celebrity of Michael Jordan.

The dangers of relying on a work’s “marketability” are not unique to biographies. Many expressive works utilizing celebrity personas derive their primary marketability from the celebrity depicted, including t-shirts, magazines, posters, and television programs. For example, parody, a form of speech that has been historically protected by courts under the First Amendment, would be in danger. Could the estate of James Dean sue artist Gottfried Helnwein for his parody *Boulevard of Broken Dreams*, which features Dean and other tragic celebrity figures? As Breslin would argue, if Dean, Marilyn Monroe, Elvis Presley, and Humphrey Bogart were replaced with four “generic” figures, the painting would be virtually worthless. Similarly, baseball trading cards would also be subject to right of publicity claims, and the Tenth Circuit’s holding in Cardtoons would be turned on its head.

Thus, the Comedy subsidiary inquiry should not be utilized because it sets forth a virtually insurmountable hurdle for the First Amendment. Even the most artistic use of a celebrity image will often derive most of its marketability from the celebrity’s fame; if a “generic” person were used, biographies and paintings would be deprived of their substance. In sum, regardless of the “expressive” content of the work, defendants would

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<sup>121</sup> In rare cases, it could be argued that the author would be of such fame that loyal readers would read a biography regardless of the subject. Nevertheless, this would obviously be the exception, and not the general rule.

be at a loss to prove that consumers are attracted to a work because of its expressive elements and not the celebrity depicted. As the Tenth Circuit noted in Cardtoons, social comment and marketable celebrity personas are often inextricably intertwined.

### **B. The “Transformative Elements” Test**

Although less problematic than the pure “marketability” test, the basic Comedy transformative test still suffers from an array of problems. The Jireh decision highlights many of the test’s inefficiencies.

First, the “transformative elements” test is impossible to consistently apply. The Supreme Court of California admitted as much when setting forth the test: “[a]lthough the distinction between protected and unprotected expression will sometimes be subtle, it is no more so than other distinctions triers of fact are called on to make in First Amendment jurisprudence.”<sup>122</sup>

One need look no further than the Jireh decision to demonstrate the inherent unpredictability of the transformative test. The majority found that Rush’s painting consisted of *much* more than a “mere literal likeness of Woods,” and was in fact a “piece of art that portrays a historic event” and “communicates and celebrates the value our culture attaches to such events.”<sup>123</sup> Conversely, Judge Clay found it “difficult to discern *any* appreciable transformative or creative contribution” in Rush’s prints.<sup>124</sup> Thus, the transformative test is far from a bright line rule that can be applied consistently; indeed, judges’ subjective perceptions of what constitutes artistic expression is entirely

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<sup>122</sup> Comedy, 25 Cal.4<sup>th</sup> at 409.

<sup>123</sup> ETW, 332 F.3d at 936.

<sup>124</sup> Id. at 959.

determinative of how a right of publicity case is decided. Nevertheless, an attempt to objectively define what constitutes artistic expression or a “literal depiction” would undoubtedly be even more problematic.

Second, courts seem confused as to whether the transformative test should be applied as an affirmative defense. Although the Comedy court explicitly formulated the test as such, the court in Jireh seemed to place the burden of proof on the plaintiff. Much of the confusion in Jireh is attributable to the fact that the court first applied the Restatement test, which is virtually the same as the “transformative test” except for the Restatement’s burden of proof, which is on the celebrity plaintiff in the first instance.

Nevertheless, so long as there is a right of publicity that needs to be balanced against the First Amendment, the transformative test may well be the proverbial least of many evils. The test is at least feasible in that it (1) gives proper deference to First Amendment concerns; (2) allows courts the flexibility to “make necessary fact specific determinations”<sup>125</sup>; and (3) is far superior to most alternative approaches. In fact, when compared to other proposed solutions, the transformative test looks like a veritable stroke of genius by the Supreme Court of California.

### **C. Other Proposed Solutions**

Legal scholars have proffered several other solutions to the right of publicity dilemma. First, one scholar has proposed to eliminate subjectivity entirely by classifying works into one of two categories: “Popular Art” or “Fine Art.”<sup>126</sup> This “Cultural Niche Theory” asks the finder of fact to “determine whether a work’s purpose is to ‘entertain, to

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<sup>125</sup> Jasmer, *supra* note 55, at 313.

stimulate emotion or project sentimentality’ [evidence suggesting ‘Popular Art’] or to ‘exhibit a personal expression, originality, [or] creativity’ [evidence suggesting ‘Fine Art’].”<sup>127</sup> The First Amendment would protect celebrity personas used in “Fine Art”, whereas the use of celebrity personas in “Popular Art” would not be protected.

The problems with this test are too numerous to mention in entirety, but include the following: (1) the test is not objective at all, and merely passes the subjective judgment of what “category” a work falls into from the judge to the jury; (2) some (if not most) art could fall into either category; and (3) by focusing on the “type” and “quality” of art and not the amount of celebrity fame appropriated, the test completely ignores the critical inquiry in publicity rights cases, specifically whether the defendant is using the celebrity for expressive purposes or merely free-riding off celebrity fame. To quote the Comedy court, the “inquiry is in a sense more quantitative than qualitative . . .”<sup>128</sup>

Second, a number of scholars have proposed incorporating the entire “fair use” defense from copyright law and applying it to right of publicity cases.<sup>129</sup> However, “the factors used in copyright analysis do not readily lend themselves to right of publicity claims.”<sup>130</sup> For instance, as the court in Comedy explained:

We conclude that a wholesale importation of the fair use doctrine into right of publicity law would not be advisable. At least two of the factors employed in the fair use test, ‘the nature of the copyrighted work’ and ‘the amount and substantiality of the portion used’ seem particularly designed to be applied to the partial copying of works . . . fixed in a tangible medium of expression; it is difficult to understand why these factors

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<sup>126</sup> Id. at 320.

<sup>127</sup> Id.

<sup>128</sup> Comedy, 25 Cal.4<sup>th</sup> at 407.

<sup>129</sup> Jasmer, *supra* note 55, at 323.

<sup>130</sup> Id.

would be especially useful for determining whether the depiction of a celebrity likeness is protected by the First Amendment.<sup>131</sup>

Furthermore, the third factor, “the effect of the use upon the potential market for or value of the copyrighted work,” would not only be difficult to ascertain in the right of publicity context, but may tip the balance toward plaintiffs because “it could be argued that if a defendant has capitalized in any way on a celebrity’s image, he or she has found a potential market and therefore could be liable for such work.”<sup>132</sup> Thus, since this factor would almost always cut against the defendant, the defendant would “face what is effectively a presumption of infringement” from the outset.<sup>133</sup>

Moreover, the aims of copyright and the right of publicity are divergent. Copyright law “protects the primary, if not only source of a writer’s income, and thus provides a significant incentive for creativity and achievement.”<sup>134</sup> The right of publicity, however, only protects this incentive in the limited context of “performance” cases such as Zacchini. The commercial value of professional athlete and celebrity identities is “merely a by-product of their performance values.”<sup>135</sup> Copyright is designed to balance artists’ rights and the need for a rich public domain by affording artists’ exclusive rights *for a limited duration*. Conversely, many jurisdictions have held that the right of publicity “exists posthumously and is both inheritable and devisable,” with *no* limited

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<sup>131</sup> Comedy, 25 Cal.4<sup>th</sup> at 807-08.

<sup>132</sup> Id. at n.10.

<sup>133</sup> Jasmer, *supra* note 55, at 323.

<sup>134</sup> Cardtoons, 95 F.3d at 973.

<sup>135</sup> Id.

time duration.<sup>136</sup> Thus, it makes little sense to blindly import copyright doctrine into right of publicity cases.

## **VI. Should Publicity Rights Be Protected? Debunking the Justifications for a Right of Publicity**

As one critic of publicity rights astutely noted, “[f]ame existed long before the right of publicity was invented, and no one apparently needed the law’s protection to become famous before this century.”<sup>137</sup> Inherent in this simple statement is a fundamental question: Do we need a right of publicity for professional athletes and celebrities *at all*?

To answer this question, it is necessary to re-examine the three justification for the right of publicity as given by the Supreme Court in Zacchini: (1) it provides celebrities an economic incentive to invest in creating performances; (2) it keeps others from interfering with the celebrity’s right to make a living; and (3) it prevents unjust enrichment and misappropriation of the celebrity’s goodwill.

### **A. Incentive and the Right to Make a Living**

As previously noted, the first two justifications make little sense when applied to professional athletes and celebrities outside the Zacchini context. To reiterate, the “incentive” rationale is only compelling in “right of performance” cases, where a performer is deprived of the economic incentive to invest in his primary source of his income. As the Tenth Circuit noted, “it is unlikely that little leaguers will stop dreaming

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<sup>136</sup> Jasmer, *supra* note 55, at 323-24.

of the big leagues or major leaguers will start ‘dogging it’ to first base” if the right of publicity did not exist.<sup>138</sup> The second Zacchini justification is also only compelling in “right of performance” cases; allowing Rick Rush to paint an image of Tiger Woods will not interfere with Woods’ ability to make a living as a professional golfer.

Michael Breslin counters that courts such as Jireh ignore the long hours of labor required for an athlete to attain fame and fortune. Specifically, Breslin believes that the implications of downplaying the second Zacchini justification are “disturbingly straightforward”: “the more money you earn, the less right you have to control how people exploit your image.”<sup>139</sup> Breslin’s analysis, however, misses the point.

Courts such as Jireh and Cardtoons are not making distinction based on *amount* of wealth, but rather *source* of wealth. To illustrate this point, even if Zacchini had made millions off of his “human cannonball” act, the Supreme Court would likely have still found a violation of his right of publicity because his *performance* (or his *primary* means of employment) was appropriated and shown for free, which thereby threatened his ability to make a living off that performance. Zacchini’s wealth was entirely irrelevant to the outcome of the case. Similarly, if Rush had painted a picture of a famous ballplayer who had recently declared bankruptcy, the case would have come out the same because the “commercial value of [his] identity” would merely be a “by-product” of his performance value, and thus would not affect the player’s ability to make a living by playing baseball.<sup>140</sup>

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<sup>137</sup> Vincent M. de Grandpre, Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity, 12 Fordham Intell. Prop. Media & Ent. L.J. 73, 103 (2001).

<sup>138</sup> Cardtoons, 95 F.3d at 974.

<sup>139</sup> Breslin, *supra* note 1, 385.

<sup>140</sup> Cardtoons, 95 F.3d at 973.

## B. Unjust Enrichment

“Unjust enrichment” is the sole remaining justification for giving publicity rights to professional athletes. This argument is justified on two grounds: (1) professional athletes and celebrities should be allowed to enjoy the fruits of their labors, and (2) no “social purpose is served” by allowing others to get a “free ride” off of someone else’s goodwill.<sup>141</sup>

Inherent in the first argument is the belief that people have earned the right to control and profit off of their commercial identities. Nevertheless, celebrities “are often not fully responsible for their fame . . . a celebrity’s fame may largely be the creation of the media or the audience.”<sup>142</sup> A celebrity “cannot make herself famous any more than she can make herself loved.”<sup>143</sup> Although professional athletes are admittedly more responsible for their celebrity status than entertainment celebrities, it is also true that “[m]any people make valuable contributions to society without receiving compensation that reflects every cent of that value.”<sup>144</sup> An Amicus Brief in support of Jireh sets forth this argument as follows:

Judges . . . create social value far in excess of their compensation. Law professors, too, have never expected royalties from former students, although arguably the information the professors produce is a factor in producing the high income many earn in practice . . . As long as the rewards are adequate to induce talented people into teaching, onto the bench, or into the business of making desirable products, how excess value should be distributed is a policy question and not one of justice . . . celebrities have no greater claim to the excess value they generate than do any other actors in society.<sup>145</sup>

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<sup>141</sup> Id. at 975-76.

<sup>142</sup> Id. at 975.

<sup>143</sup> Jasmer, *supra* note 55, at 298.

<sup>144</sup> Amicus Brief, *supra* note 6, at 29.

<sup>145</sup> Id.

The “free-rider argument” also has flaws in the context of First Amendment cases such as Cardtoons, Comedy and Jireh. For example, in Jireh, “a substantial part of the value of the Rush print must, in all fairness, be attributed to his own talent and fame as a sports artist.”<sup>146</sup> It is difficult to argue that a celebrity’s fame is the *only* reason anyone would purchase a product; would a three-year-old’s crayon drawing of the Three Stooges or Tiger Woods generally be a marketable product? The answer is likely in the negative.

Similarly, in the advertising context, it could be argued that merely placing a celebrity’s likeness in the background of a commercial would not instantly make that commercial successful. A commercial’s popularity also depends on the skill of the marketing department in generating humor or a memorable sales pitch. For instance, in White, Samsung used the “robot” Vanna White to convey that Samsung would exist many years into the future. As Judge Kozinski noted, Samsung’s ad “didn’t simply copy White’s schtick – like all parody, it created something new.”<sup>147</sup> Furthermore, most advertisement right of publicity cases that fall outside of the “false endorsement” context do not explicitly invoke the “name, likeness, signature or voice” of a celebrity,” but many courts now grant celebrities an “exclusive right to *anything that reminds the viewer of her*.”<sup>148</sup> Judge Kozinski believes that “the right to draw ideas from a rich and varied public domain, and the right to mock, for profit as well as fun, the cultural icons of our time” should limit celebrity “rights” of such broad proportion.<sup>149</sup>

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<sup>146</sup> Id. at 28.

<sup>147</sup> White, 989 F.2d at 1517.

<sup>148</sup> Id.

<sup>149</sup> Id.

It should be noted that if a commercial utilizes a celebrity image to falsely suggest that the celebrity is *endorsing* the product, the unjust enrichment argument is infinitely more persuasive. Nevertheless, the Lanham Act already provides nationwide protection against false or misleading representations in connection with the sale of products.<sup>150</sup> Moreover, a “false endorsement” tort strictly limited to such claims would provide a far more suitable solution than the right of publicity, which is infinitely broader in scope.

### **C. Emotional Injury**

Several other justifications have been offered in support of a right of publicity, most of which are of little merit. One argument is that the right of publicity prevents “emotional injuries.”<sup>151</sup> Publicity right, however, are designed to protect against the “loss of financial gain, not mental anguish.”<sup>152</sup> In addition, tort laws prohibiting the “intentional infliction of emotional distress” are available.<sup>153</sup> Furthermore, defamation law has made clear that those who enjoy the “public limelight” assume the risk of criticism.<sup>154</sup>

### **D. Efficient Allocation of Resources**

Some courts and commentators have argued that the right of publicity promotes the “efficient allocation of resources.”<sup>155</sup> This “tragedy of the commons” line of

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<sup>150</sup> Comedy, 95 F.3d at 975. Whether the Lanham Act offers adequate compensation for celebrities who are falsely suggested to endorse a product is a separate question which requires a note to itself, and therefore is not addressed here. Nevertheless, it would clearly be ill-advised for the courts to maintain a right of publicity solely because the Lanham Act does not offer adequate compensation. Congress could better address the issue.

<sup>151</sup> Cardtoons, 95 F.3d at 976.

<sup>152</sup> Id.

<sup>153</sup> Id.

<sup>154</sup> Id.

<sup>155</sup> Cardtoons, 95 F.3d at 974.

argument posits that “[w]ithout the artificial scarcity created by publicity rights, identities would be commercially exploited until the marginal value of each use is zero.”<sup>156</sup> First, this argument is not persuasive outside the advertising context, as frequent use of a celebrity image may actually *increase* its value precisely because “everybody’s got one.”<sup>157</sup> For instance, a t-shirt featuring Britney Spears may act as an “advertisement” of sorts for her “celebrity” status. The t-shirt would in effect promote Spears, and therefore increase the value of her “celebrity”; the more t-shirts that are created, the more promotion Spears’ “celebrity” receives.

Moreover, in the advertising context, Professor Michael Madow argues that well before the advertising value of a celebrity’s persona decreases to zero due to overexploitation, advertisers will replace her with a “fresh face” from an unlimited alternative supply: “After all, there would be no ‘tragedy’ in the classic parable if the herdsmen, after depleting their common pasture, could simply move on to another one.”<sup>158</sup> If one thing is clear, it is that society is in no danger of running out of celebrities or professional athletes anytime soon.

## **VIII. Conclusion**

Upon analyzing the justifications for the right of publicity, one could conclude that the right of publicity should be strictly limited to “right of performance” cases such as Zacchini, where the plaintiff’s incentive and ability to make a living off his or her performance is endangered. Moreover, courts and legislatures could fashion a limited

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<sup>156</sup> Id.

<sup>157</sup> Id. at 975.

<sup>158</sup> Michael Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights, 81 CAL. L. REV. 127, 224 (1993).

“false endorsement” tort to protect celebrities from advertisers who falsely suggest that a celebrity endorses a product.

Apart from “right of performance” and “false endorsement” cases, the most persuasive argument for a right of publicity can be made in cases in which an advertiser skillfully appropriates an athlete’s image without implying that the celebrity endorses the product being sold. Nevertheless, even where an advertiser uses a celebrity’s image solely for the purpose of proposing a commercial transaction, there are valid arguments that the advertiser is not entirely “unjustly enriched”; not only is the athlete’s fame not completely attributable to the athlete (both the public and the media play a role), but, as in White, the advertiser’s skill and talent also play a part in the commercial’s appeal.

Thus, *at most*, the right of publicity should be confined to “right of performance” cases and traditional commercial advertisements. In cases such as Hoffman where it is unclear whether the commercial use constitutes an “advertisement,” the “transformative elements” test should be used to determine whether the use is protected by the First Amendment.

When an individual’s tentative property right collides with the First Amendment and the public domain, the public domain should always be given great deference. This should hold true even when the “individual” in question is Tiger Woods.

