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ETW Corp. v. Jireb Publishing, Inc.: Turning an Athlete's Publicity Over to the Public

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I. INTRODUCTION

Heroes have always fascinated American society. Whether inspiring the masses to achieve their personal bests or giving them the hope to overcome adversity, many regard their heroes as the ultimate symbol of triumph and victory. Today, it is common to find heroes not on the pages of popular comic books or novels, but rather, on the field, the court, or the rink, accompanied by the cheers and aspirations of their fans. Indeed, the professional athlete is the modern-day hero of many Americans. "[W]e live vicariously through them, feeling both the thrill of victory and the agony of defeat . . . ."

While nearly every mainstream American sport has enjoyed its collection of heroes, it was not until Tiger Woods stunned the golfing world that the “links” could boast a modern-day super-athlete who had become a household name. “The story of Tiger Woods’ rise to fame is by now a familiar one.” After becoming the youngest player ever to win the U.S. Junior Amateur Championship, Eldrick “Tiger” Woods went on to become one of the most prominent and respected golfers alive today. With staggering power off of the tee and surgeon-like precision in his short game, Woods’ dominance on the course has made his name synonymous with golfing excellence. Indeed, it is quite difficult to engage in a conversation about golf without some reference to the amazing “Tiger.” His peers have characterized him as “something supernatural” without “a flaw in his golf or his makeup.” Since becoming a professional golfer in the late summer of 1996, Tiger has won an unprecedented fifty-one

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4 Statements made by Tom Watson and Jack Nicklaus. *Id.*
tournaments, thirty-eight of which were on the PGA tour. He is currently the career victories leader among active players and the career money list leader.

In 1997, Woods became the youngest player ever to win the Masters Tournament at Augusta; his victory catapulted his face and name into the international spotlight. Among the thousands of fans present that day to cheer on Tiger as he approached the final hole was Alabama resident Rick Rush, a painter who specializes in depicting sports subjects. Woods' performance inspired Rush to create "The Masters of Augusta"—a painting that depicted images of Tiger Woods. After completion of the painting, Rush's publisher, Jireh Publishing, Inc., made over 5,000 copies of the work and began selling them to the public. The painting soon became the subject of a bitter and costly lawsuit.

ETW Corporation ("ETW") is the exclusive licensing agent of Tiger Woods and holds numerous registrations for the trademark "TIGER WOODS." Once ETW became aware of the painting, it promptly filed suit against Jireh for its involvement in the sale of "Masters of Augusta." By that time, Jireh had sold approximately 879 of the prints. ETW's complaint alleged that Jireh had violated several of ETW's intellectual property rights, ranging from trademark infringement under the Lanham Act to a violation of Tiger Woods' right of publicity under Ohio common law. Both parties moved for summary judgment, and the United States District Court for the Northern District of Ohio granted the defendant's motion. ETW then appealed the decision of the district court, and in June 2003, the Sixth Circuit affirmed the granting of the defendant's

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5 Id.
6 Id.
9 Id.
10 250 limited edition serigraphs were selling for $700 each and 5,000 smaller lithographs were selling for $15 each. Marcia Chambers, Lawsuit Pits Artists' Rights vs. Athletes', N.Y. TIMES, Feb. 16, 1999, at D1, D4.
11 ETW Corp., 99 F. Supp. 2d at 830. ETW holds registrations for the mark "TIGER WOODS" "for: art prints, calendars, mounted photographs, notebooks, pencils, pens, posters, trading cards, and unmounted photographs, in Class 16." Id. (quoting Plaintiff's Amended Complaint, ¶ 6, 16, Ex. 1).
12 Reggie Rivers, Selling of Woods' Likeness by Artist Goes Out of Bounds, DENV. ROCKY MTN. NEWS, Feb. 28, 1999 at 4C.
14 Id. at 836.
motion for summary judgment.\textsuperscript{15} The Sixth Circuit's reasoning, at least with respect to the right of publicity claim, however, was deficient.

Success in professional athletics offers more than just a paycheck to today's sports superstars. Through endorsements, licensing, sponsorships, and television spots, advertisers offer a seemingly unlimited source of income for today's most popular athletes. In fact, "the money [professional athletes] can make from endorsements now rivals or exceeds the money they are paid for competing in their sport."\textsuperscript{16} Thus, it is no wonder that athletes want to protect these sources of income and "have demanded control of their names and images."\textsuperscript{17} Athletes argue that "in an age of rampant commercialism they must hold onto the hottest property they know: themselves."\textsuperscript{18} In Tiger Woods' case, the value of his endorsements was so great that ETW Corporation was established solely to control the marketing of his image. The primary legal vehicle for establishing this type of control is the right of publicity. Simply stated, the right of publicity endows one with the ability to control the commercial use of his or her identity.\textsuperscript{19}

This Note focuses exclusively on ETW's claim that Jireh violated Tiger Woods' common law right of publicity.\textsuperscript{20} This Note explains how, in erroneously applying First Amendment protection to the painting of Rush, the courts have placed an unnecessary handicap on the ability of Woods and others to protect the property rights of their personas. To this end, Part II sets forth a general history of the right of publicity, concentrating on its relationship with the right of privacy. Parts III and IV then trace the more recent developments in the right's evolution. Part V provides background information on an issue of prominence in the ETW opinion—First Amendment restraints on the right of publicity. Finally, Part VI argues that the ETW court misapplied the First Amendment restraints on the right by failing to apply properly the so-called "transformative" test articulated in Comedy III Productions, Inc. v. Gary Saderup, Inc.\textsuperscript{21}

II. THE RIGHT OF PUBLICITY—A NOT-SO-BRIEF HISTORY

One might view the right of publicity as the baby brother in the family of inherent human property rights. Indeed, one commentator has described the

\begin{itemize}
\item \textsuperscript{15} ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 938, 67 U.S.P.Q.2d (BNA) 1065 (6th Cir. 2003).
\item \textsuperscript{16} Stapleton & McMurphy, supra note 1, at 23.
\item \textsuperscript{17} Chambers, supra note 10, at D1, D4.
\item \textsuperscript{18} Id.
\item \textsuperscript{19} JTHOMAS McCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY, § 1.3, at 1-2.1 (2d ed. 2002).
\item \textsuperscript{20} ETW Corp. v. Jireh Publ'g, Inc., 99 F. Supp. 2d 829, 830-31 (N.D. Ohio 2000).
\item \textsuperscript{21} 21 P.3d 797, 58 U.S.P.Q.2d (BNA) 1823 (Cal. 2001).
\end{itemize}
right as "Privacy's Stepchild and Property's Adopted Son."\textsuperscript{22} The contemporary notion of the right finds its genesis in an article by Samuel D. Warren and Louis D. Brandeis appearing in one of the earliest volumes of the Harvard Law Review.\textsuperscript{23} The article, entitled "The Right to Privacy," argues 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."\textsuperscript{24} Some have lauded the article as "one of the most famous and influential law review articles ever published."\textsuperscript{25} By articulating a concept of individual privacy rights, Warren and Brandeis single-handedly created a new arena of law in western society.\textsuperscript{26} Referring to property rights in things "such as literature, art, good will, trade secrets and trademarks,"\textsuperscript{27} the article boasts an insight into intellectual property rights that was years ahead of its time. As one would expect, the article sparked a legal debate that has lasted well over one hundred years.\textsuperscript{28}

As the several states were wrestling with the concept of a right to privacy, Dean William Prosser published his influential 1960 article, "Privacy,"\textsuperscript{29} in which he articulated the contours of Warren and Brandeis' right to privacy. In his article, Prosser portrayed the right to privacy not as a unified legal right but as a generic term that encompassed four specific and quite distinct torts:

The law of privacy comprises four distinct kinds of invasion of four different interests of the plaintiff, which are tied together by the common name, but otherwise have almost nothing in common except that each represents an interference with the right of the plaintiff . . . "to be let alone."\textsuperscript{30}

\textsuperscript{22} Stapleton & McMurphy, \textit{supra} note 1, at 26.
\textsuperscript{24} 1 MCCARTHY, \textit{supra} note 19, § 1:11, at 1-14.
\textsuperscript{25} Id. § 1:11, at 1-12.
\textsuperscript{26} In a statement made to William Chilton in 1916, Dean Roscoe Pound said that the Warren and Brandeis article did "nothing less than add a chapter to our law." ALPHEUS T. MASON, BRANDEIS: A FREE MAN'S LIFE 70 (Viking Press 1946). \textit{See also} 1 MCCARTHY, \textit{supra} note 19, § 1:25, at 650 n.23 (citing a 1912 Columbia Law Review note that comments how the Warren and Brandeis article "enjoys the unique distinction of having initiated and theoretically outlined a new field of jurisprudence").
\textsuperscript{27} 1 MCCARTHY, \textit{supra} note 19, § 1:11, at 1-14.
\textsuperscript{28} \textit{See} Shulman v. Group W Prods., Inc., 955 P.2d 469, 473, 74 Cal. Rptr. 2d 843, 847 (Cal. 1998) (citing the Warren and Brandeis article in holding that the defendant invaded the plaintiff's privacy by intrusion).
\textsuperscript{30} Id. at 389.
The four torts that Prosser advanced were invasion of privacy by: (1) intrusion; (2) disclosure; (3) false light; and (4) appropriation. Prosser's four-tort analysis had a tremendous impact inasmuch as it has found almost universal acceptance among U.S. jurisdictions. Even after Prosser's article had begun to gain widespread acceptance though, the right of privacy had yet to undergo one final metamorphosis before spawning the right of publicity.

The fundamental justification for protecting a person's right to privacy is that every person has a right to be free from mental distress and indignity. This right has always been grounded in the law of tort. "The 'privacy' label was taken at face value," and the courts only considered harm to a plaintiff's mental well-being as measured by tort-based mental distress damages. More significantly for public figures, including athletes like Tiger Woods, Prosser's fourth tort, invasion of privacy by appropriation, was not viewed as encompassing any property rights. Even though the appropriation tort necessarily involves the "unpermitted commercial use of a person's identity," the courts insisted that plaintiffs "frame their claims in terms of 'mental distress,' when in fact what many such plaintiffs really wanted was to be paid the going rate for the use of their identity to help sell defendant's goods and services." The problematic effect of this tort approach to privacy claims was most readily observed when celebrity plaintiffs, who were public figures, brought claims for misappropriation of their identities. Under the constrained view that cast the right solely within the realm of tort law, courts were unwilling to see "how there could be 'indignity' or 'mental distress' when plaintiff's identity was already in widespread use in the media." As Weiler and Roberts stated:

There were serious doubts about whether this personal protection against the psychological injury (hurt feelings) from having such an intrusion upon their private lives extended to athletes (or

31 Prosser, supra note 29.
32 See RESTATEMENT (SECOND) OF TORTS § 652 (1977) (adopting Prosser's four torts in subsections B-E); 1 MCCARTHY, supra note 19, § 1:24, at 1-35 n.2 (listing court decisions from states that have accepted Prosser's four-tort formulation).
33 1 MCCARTHY, supra note 19, § 1:25, at 1-37.
34 See RESTATEMENT (SECOND) OF TORTS, supra note 32.
35 1 MCCARTHY, supra note 19, § 1:25, at 1-36.
36 Id.
37 Id.
38 Id. § 5:58; see also RESTATEMENT (SECOND) OF TORTS § 652C cmt. b (stating that the appropriation is accomplished by using the plaintiff's name or likeness for advertising or commercial purposes).
39 1 MCCARTHY, supra note 19, § 1:25, at 1-41.
40 Id.
entertainers) who had actively sought to make themselves into celebrated public figures.  

One of the best examples of this claim confusion appears in O'Brien v. Pabst Sales Co. At issue was Pabst's use of a photograph of professional football player David O'Brien in a 1939 Pabst Blue Ribbon advertising calendar without his consent. O'Brien sued Pabst for the appropriation of his identity, claiming that the "use of his photograph as part of [Pabst's] advertising was an invasion of his right of privacy and that he had been damaged thereby." The court held for the defendant, reasoning that O'Brien had suffered no cognizable damage because he was already a public figure, and he had not expressly endorsed Pabst Blue Ribbon beer.  

While the majority's reasoning in O'Brien illustrates the problem that arose from a pure tort conceptualization of "privacy," Justice Holmes' dissenting opinion suggested a more pragmatic approach. Holmes argued that O'Brien was "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]." In what is probably the earliest articulation of a distinction between the right to privacy and the right of publicity, Justice Holmes stated:

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

The O'Brien case thus served as a launching pad for the creation of a true right of publicity. As confusion from the traditional interpretation of "privacy" mounted, the legal landscape became ripe for a break in traditional thinking.

That break came twelve years later in Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc. when Judge Jerome Frank first coined the term "right of publicity" to grant a professional ballplayer the ability to control how his image was used in

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42 124 F.2d 167 (5th Cir. 1941).
43 Id. at 168.
44 Id. at 169.
45 Id. at 170 (Holmes, J., dissenting).
46 Id.
47 202 F.2d 866, 868 (2d Cir. 1953). Although the term "right of publicity" was used before the Haelan case, it was used to describe an entirely different concept. See 1 MCCARTHY, supra note 19, § 1:26, at 1-42 n.1 (listing prior mentions of the "right of publicity").
baseball cards sold with chewing gum. In *Haelan Laboratories*, the plaintiff's case hinged on asserting an exclusive property right in the baseball player's images that appeared on the cards. The defendant argued that the plaintiff's only viable theory of relief was the right to privacy, a personal and non-assignable right not to have one's feelings hurt by the publication of unauthorized images. Therefore, the plaintiff's assertion of privacy rights would not advance his central claim because no allegations were made that the use of the images had hurt the ballplayer's feelings. Surprisingly, the court rejected the defendant's contention and created a new "right of publicity":

We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture... This right might be called a 'right of publicity.' For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways.

Both amorphous and cutting-edge, this new legal concept began as a product belonging solely to New York common law, but due to its far-ranging implications, the right of publicity would soon receive a great deal more attention. That attention came in an article by Melville B. Nimmer. In 1954, just one year after the *Haelan Laboratories* decision, Nimmer wrote an article that became the foundation of the contemporary right of publicity. In his seminal article, Nimmer "elegantly surveyed the deficiencies of traditional areas of law to adequately protect the commercial interest in a person's identity." Reinforcing the views expressed by the *Haelan Laboratories* decision one year earlier, Nimmer posited that 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

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48 Id. § 1:26, at 1-43.
49 *Haelan Labs.*, 202 F.2d at 868.
50 Id.
51 Id.
53 1 MCCARTHY, *supra* note 19, § 1:27, at 1-46.
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advertising use. Nimmer's article, the first to justify and define the purposes of the new right, "did for the right of publicity what Warren & Brandeis did sixty-four years earlier for the right of privacy." Nimmer's article offered a persuasive policy rationale in support of the right of publicity. Nimmer explained that while celebrity status has been determined to constitute a waiver of certain privacy rights, the same waiver should not hold true for publicity rights. Plainly stated, a celebrity should not be deprived of the commercial value of his identity simply because he is well-known. Additionally, Nimmer's article asserted that every person, celebrity or not, possesses the right to control the commercial value of his or her identity. This view contrasted sharply with the principle adopted by some judges that only celebrities have a right of publicity. According to Nimmer,

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.

Indeed, the article was considered such a groundbreaking and informative piece that "all subsequent case law and commentary has built upon [it]." If Nimmer was the architect of the right of publicity, his article was the official blueprint. It would fall upon the courts and the legislatures to construct and test this controversial new legal right.

54 See Nimmer, supra note 52, at 203-04 (stating that the right of privacy “is not adequate to meet the demands of the second half of the twentieth century, particularly with respect to the advertising, motion picture, television, and radio industries”).

55 Hoffman, Limitations on the Right of Publicity, 28 BULL. COPYRIGHT SOCY 111 (1980).

56 See Nimmer, supra note 52, at 204 (noting that most courts had accepted the limited view of celebrity waiver presented in the Warren and Brandeis article, suggesting celebrities lose privacy protection only “to whatever degree and in whatever connection [the celebrity’s] life has ceased to be private”).

57 Id. at 217 (citing O’Brien v. Pabst Sales Co., 124 F.2d at 170 (Holmes, J., dissenting)).

Following the *Haelan Laboratories* decision and the Nimmer article, most judges balked at the notion of embracing the new legal right of publicity and creating a new cause of action in their courts.\(^59\) One would expect this reaction. It would be highly uncharacteristic of the courts to adopt quickly any new and generally formless legal concept, especially one carrying such important economic and social implications.

As an increasing number of plaintiffs entered the courtrooms armed with the new cause of action designed to protect “celebrities like us,” the courts’ reluctance to accept their claims did not diminish. Rather, the courts simply found more practical ways to skirt the issue. As early as 1968, courts began using the First Amendment as a weapon to derail a plaintiff’s right of publicity claims. In holding that a plaintiff could not enjoin the publishing of an unauthorized biography, Justice Harry Frank observed 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.”\(^60\) Later that same year, Justice Frank again used First Amendment principles to stifle a plaintiff’s attempt to enjoin the unauthorized sale of mock presidential campaign posters depicting the plaintiff, a well-known comedian, as a candidate in the upcoming election. Although the decision was more controversial than the unauthorized biography case,\(^61\) the court held that First Amendment principles clearly trumped the flailing right of publicity when the political arena was involved: “When a well-known entertainer enters the presidential ring, tongue in cheek or otherwise, it is clearly newsworthy and of public interest.”\(^62\)

Not until the 1970s did the right of publicity find a more receptive welcome in the courtrooms. Some have described the seventies as the right of publicity’s “coming of age”; courts stopped shutting their eyes to the right and began to examine what it was and why it should exist.\(^63\) Most courts entertained the...
notion, and one state went so far as to adopt the right of publicity into its common law.\(^{64}\)

In the late 1970s, the courts continued their measured acceptance of the new property right and, in the process, took the first steps in polishing the contours of the right. Although the case law was inconsistent,\(^{65}\) courts resolved several practical issues involving the exercise of the right. One of the first issues that arose was the element of “identifiability” of the plaintiff. In 1974, the Ninth Circuit held that a plaintiff’s right of publicity could be violated without depicting the plaintiff in an unauthorized commercial setting.\(^{66}\) The practical effect of this ruling was that it allowed a plaintiff to enjoin the use of certain symbols, phrases, and other indicia so closely related to his persona that viewers were likely to infer that the plaintiff had endorsed the advertised product.\(^{67}\) However, courts were not unanimous in their conclusions on this issue.\(^{68}\)

Another question presented for the courts in the seventies was whether the “plaintiff’s previous ‘exploitation’ of the right of publicity was a condition precedent to having a right to assert.”\(^{69}\) In Grant v. Esquire, Inc.,\(^{70}\) Justice Knapp unequivocally stated that prior exploitation of the right is not a precondition to exercising the right in court. In that case, actor Cary Grant sought to enjoin the defendant, a magazine publisher, from printing an article discussing the clothing tastes and habits of Grant and five other Hollywood stars. Grant conceded he had never exploited or licensed his right of publicity as a matter of principle, namely because he did not want anyone, including himself, to profit from his fame.\(^{71}\) Justice Knapp likened publicity rights to traditional real property interests: “If the owner of Blackacre decides for reasons of his own not to use his land but

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\(^{64}\) See Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129, 205 U.S.P.Q. (BNA) 920 (Wis. 1979) (holding that the distinction between appropriation torts and traditional torts involving invasion of privacy warranted the acceptance of a right of publicity in Wisconsin common law).

\(^{65}\) See McCARTHY, supra note 19, § 1:32, at 1-54 n.4.

\(^{66}\) See Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 827 (9th Cir. 1974) (holding that although only a racecar similar to plaintiff’s professional racecar was depicted in the commercial, the distinctive decorations on the car were enough to cause viewers to believe the car was “plaintiff’s and to infer that the person driving the car was the plaintiff”).

\(^{67}\) See Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 218 U.S.P.Q. (BNA) 1 (6th Cir. 1983) (applying the rule to phrases by holding that use of phrase “here’s Johnny” violated entertainer plaintiff’s right of publicity under Michigan state law).

\(^{68}\) See Booth v. Colgate-Palmolive Co., 362 F. Supp. 343, 179 U.S.P.Q. (BNA) 819 (S.D.N.Y. 1973) (holding that plaintiff actress could not recover for defendant’s imitation of her voice in commercial); cf. Shaw v. Time-Life Records, 341 N.E.2d 817, 379 N.Y.S.2d 390, 190 U.S.P.Q. (BNA) 573 (1975) (liability for recreation of plaintiff’s music only if likely to confuse reasonably discriminating consumers as to whether music was recreation or authentic).

\(^{69}\) See McCARTHY, supra note 19, § 1:32, at 1-55.


\(^{71}\) See McCARTHY, supra note 19, § 1:32, at 1-55.
to keep it in reserve he is not precluded from prosecuting trespassers.\(^{72}\) The court's holding resonates with the idea proffered in the Nimmer article that every person, celebrity or not, has a right of publicity.\(^{73}\) Had Justice Knapp held otherwise, the effect would be to grant the right only to celebrities or, in the extreme, to only those celebrities who had previously made use of the right.

The Grant case made it clear that living celebrities need not have exploited their right of publicity in order to enforce it in court. A heated debate arose, however, regarding the applicability of the Grant holding with respect to post-mortem rights of publicity. The confusion stemmed from a 1977 case involving the post-mortem publicity rights of entertainer Elvis Presley. The court stated, in dicta, that an entertainer's right of publicity survived his death because he had exploited it in his lifetime.\(^{74}\) As a result, subsequent defendants sought to assert, similar to an abandonment defense in trademark infringement, that there was no cause of action in publicity cases when the celebrity in question had not exercised the right during her lifetime.\(^{75}\) The misguided effects of the Presley dictum came to a head in a 1978 decision that erroneously construed the Elvis case as requiring lifetime exploitation for post-mortem rights to exist.\(^{76}\) Calling upon the same ideas expressed by Justice Holmes in his dissent in the O'Brien case,\(^{77}\) most courts that rejected the officious "lifetime exploitation" requirement did so on the grounds that, unlike traditional "personal" rights in privacy, the right of publicity was a property right, and it should pass on to one's heirs.\(^{78}\)

The very existence of the "lifetime exploitation" concept still befuddles many legal commentators. The primary criticism is that no court has bothered "to explain the why or wherefore of having such a requirement."\(^{80}\) McCarthy

\(^{72}\) Grant, 367 F. Supp. at 880.

\(^{73}\) Compare Nimmer, supra note 52, with Grant, 367 F. Supp. 876.


\(^{75}\) See 1 McCarthy, supra note 19, \S 4-5, at 4-7 n.1.

\(^{76}\) Hicks v. Casablanca Records, 464 F. Supp. 426, 204 U.S.P.Q. (BNA) 126 (S.D.N.Y. 1978); contra Martin Luther King Jr. Ctr. v. Am. Heritage Prods., Inc., 296 S.E.2d 697, 216 U.S.P.Q. (BNA) 711 (Ga. 1982) (stating that the comments relating to the lifetime exploitation requirement in the Hicks decision were made in dictum and contrary to related case law).

\(^{77}\) O'Brien v. Pabst Sales Co., 124 F.2d 167, 170 (5th Cir. 1941) (Holmes, J., dissenting) (stressing the distinction between publicity rights as property and traditional privacy rights as purely personal).

\(^{78}\) Courts have disagreed on what exactly constitutes "lifetime exploitation." For a discussion of the various definitions attached to the term, see 1 McCarthy, supra note 19, \S 9:13 (discussing three definitions used by courts).

\(^{79}\) Id. \S 9:13, at 9-25 to 9-26.

\(^{80}\) Id. \S 9:14, at 9-32 (offering a persuasive criticism of the requirement). For a discussion of policy rationales supporting the requirement, compare Peter L. Fletcher & Edward L. Rubin, Privacy, Publicity, and the Portrayal of Real People by the Media, 88 YALE L.J. 1577 (1979) (offering policy rationales for the requirement), with Note, An Assessment of the Commercial Exploitation Requirement as a Limit on the Right of Publicity, 96 HARV. L. REV. 1703 (1983) (advocating complete abolishment of the
described the requirement as a “deus ex machina” that descended from the sky without “explanation or rationale.” Andrew Sims concluded, after conducting an analysis of the pros and cons of the requirement, that “[t]he logic of the lifetime exercise requirement is sufficiently tenuous that fairness requires that any doubts be resolved in favor of the survivability of the celebrity’s publicity rights for the benefit of his heirs.”

To the relief of many intellectual property advocates and legal scholars, the lifetime exploitation requirement fell into significant disrepute during the early 1980s. One of the earliest casualties of the requirement occurred in a 1982 Georgia case where the court was squarely presented with the issue of whether lifetime exploitation was required in order to establish a postmortem right of publicity. The Georgia Supreme Court rejected the requirement by stating that “a person who avoids exploitation during life is entitled to have his image protected against exploitation after death just as much if not more than a person who exploited his image during life.” Subsequent blows to the requirement came from cases rejecting it; in addition, two states went so far as to codify the right of publicity along with an express statutory rejection of the requirement. The radical move toward disfavoring the requirement is underscored by the fact that only one state currently has the lifetime exploitation requirement as part of its law.

IV. MODERN CASES THAT SHAPED THE RIGHT OF PUBLICITY

From its inception, the right of publicity was hard-pressed to obtain the stature and respect of other legal doctrines. Ignored by many legal scholars and

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1 McCARTHY, supra note 19, § 9:14, at 9-32.
4 Id. at 706.
6 See CAL. CIV. CODE § 3344.1(b) (2004); TENN. CODE ANN. § 47-25-1103(b) (2001). While both expressly reject the requirement, Tennessee law requires postmortem exploitation within two years following the initial ten year period following the individual’s death for the publicity right to continue. See TENN. CODE ANN. § 47-25-1104(b)(2).
ATHLETE’S RIGHT OF PUBLICITY

relatively unknown to the legal community, it appeared that the right of publicity would forever be regarded as a second-class citizen in courtrooms across the United States. But in 1977, just twenty-four years after its birth in Haelan Laboratories, the right of publicity finally came of age in the United States Supreme Court.

Zacchini v. Scripps-Howard Broadcasting Co. is the most significant case in the development of the right of publicity since its birth in Haelan Laboratories. Zacchini was the first Supreme Court case to deal with the issue, pitting the feeble right of publicity head to head with the First Amendment. In Zacchini, the Supreme Court faced the question of whether an entertainer’s right of publicity allows the unauthorized broadcast of First Amendment-protected “newsworthy” material.

Hugo Zacchini made his living as a “human cannonball.” Despite Zacchini’s requests not to videotape his act, a local news station aired a clip of his entire fifteen second performance. Zacchini brought suit in Ohio for damages from the reproduction of his performance without his permission. The Ohio court held that although Zacchini had a valid claim for infringement of his right of publicity, the performance was privileged newsworthy material because it was “a matter of legitimate public interest.”

The Supreme Court reversed the Ohio Supreme Court in a 5-4 decision. At first glance, the holding seemed to be a colossal victory for the right of publicity, trumping the mighty First Amendment in the Supreme Court. The Court made clear, however, that its holding was confined to the very narrow facts of the case and left the door open to future First Amendment victories by cleverly pointing out three characteristics of Zacchini that distinguished it from the customary right of publicity cases. First, Zacchini’s claim arose not from the classic type of infringing use of identity in commercial advertising, but from the unauthorized reproduction of a performance. Second, the case involved the reproduction of an entire act, not merely highlights or segments. The Court emphasized the importance of this distinction: “we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer’s entire act without his consent.” Finally, Zacchini requested only money damages for the unauthorized reproduction. Had Zacchini sought the more extreme remedy of enjoining the broadcast, the Court would likely have balked.

89 Id. at 564.
91 1 McCARTHY, supra note 19, § 1:33, at 1-58.
92 Zacchini, 433 U.S. at 574.
at his request, given the ability of an injunction to stifle speech and expression completely.

What is important about Zacchini is not that the right of publicity narrowly triumphed over the First Amendment. Rather, the significance of the opinion is that the Supreme Court openly recognized infringement of the right of publicity as a separate and distinct tort from invasion of privacy and defamation claims. Many that had previously dismissed the concept were shocked to find the Supreme Court routinely referring to a "right of publicity." Thus, by moving the right of publicity out of the shadows of legal apathy and placing it in the limelight of Supreme Court recognition, Zacchini represented a coming of age for this young legal concept.

In the years following Hazel Laboratories, courtrooms provided the primary arena for the development of the right of publicity. By the 1980s, the right had undeniably developed into a separate and distinct property right widely accepted by the courts. In 1995, the right achieved its pinnacle when it was included in the 1995 Restatement of Unfair Competition. Today, the right continues to be the source of continued legal debate. While its contours and limits are still being defined in the courtrooms, one thing is certain: it is an undeniable legal truth that every person possesses the inherent right to control the commercial exploitation of her name, image, or likeness.

V. FIRST AMENDMENT RESTRAINTS ON THE RIGHT OF PUBLICITY

While the right of publicity can provide a powerful weapon for protecting people's commercial value in themselves, it does not go unchecked. The assertion of First Amendment protection has been described as "the most difficult defense to deal with" in right of publicity cases. Because of the deference given to First Amendment principles, defendants asserting a right to "free speech" often seem to enjoy the benefits of a heavy armor that provides impenetrable insulation from liability. However, the First Amendment is not absolute. When determining whether the First Amendment insulates a defendant from liability for unauthorized uses of another's persona, courts decide the issue on a case-by-case

93 Id. at 573.
94 1 McCARTHY, supra note 19, § 1:33, at 1-58.1.
95 Id. § 1:37, at 1-66.
96 RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46-49 (1995) (supporting the right as an independent, viable cause of action and distinguishing infringement of the right from other types of unfair competition). For further discussion of the Restatement's formulation, see Oliver R. Goodenough, Go Fish: Evaluating The Restatement's Formulation of The Law of Publicity, 47 S.C. L. REV. 709 (1996); 1 McCARTHY, supra note 19, § 1:35, at 1-64.
97 1 McCARTHY, supra note 19, § 3:6, at 3-7.
basis by balancing the rights at issue. Particularly, the courts categorize the speech at issue and balance the degree of protection afforded that category with the countervailing rights of persons and property. 98

The spectrum of "speech" typically at-issue in right of publicity cases consists of three primary classifications. "News," defined as information about the real world, receives the highest level of protection. 99 "Stories," which convey fictionalized information primarily designed to entertain, receive the next highest level of protection. 100 Finally, "advertising," defined as uses that clearly have the message "buy me," receives the lowest level of protection. 101

The three categories are not separate and distinct; rather, their confines and practical definitions are amorphous, at best; one category may often bleed into another. 102 For example, television "docudramas" often straddle the line between "news" and "story." 103 Moreover, the inclusion of subclasses, each of which receives a distinct level of protection, within each of the three categories adds to the difficulty of classifying particular speech. For instance, news about the political process enjoys the highest level of protection while its entertainment news counterparts receive a slightly lesser degree of protection. 104 Interestingly, the three-class hierarchy of First Amendment protection may not be very useful in determining the outcome of right of publicity cases since those cases generally depend on whether the speech at issue is classified as "newsworthy" or "commercial." 105 In spite of the significant implications of labeling speech as commercial rather than some other form, 106 the Supreme Court has only begun to touch upon this distinction. 107

98 Id. § 8:22, at 8-32.1.
99 Erika T. Olander, Stop The Presses! First Amendment Limitations of Professional Athlete's Publicity Rights, 12 MARQ. SPORTS L.J. 885 (2002) (citing Peter L. Felcher & Edward L. Rubin, Privacy, Publicity and the Portrayal of Real People by the Media, 88 YALE L.J. 1577, 1597 (1979)).
100 Id.
101 Id.
102 See 1 MCCARTHY, supra note 19, § 8:12, at 8-17 (noting that a given media type may fall into more than one of the categories).
103 Id. § 8:14, at 8-19.
104 Id.
105 See Pallas v. Crowley, Milner & Co., 33 N.W.2d 911, 914 (Mich. 1948) ("We recognize a fundamental difference between the use of a person's photographic likeness in connection with or as a part of a legitimate news item in a newspaper, and its commercial use in an advertisement for the pecuniary gain of the user. In the latter case there is no involvement of freedom of speech or freedom of the press.").
106 See 1 MCCARTHY, supra note 19, § 8:18, at 8-24 to 8-25 n.9 (listing cases illustrative of the lesser degree of protection afforded to speech labeled as "commercial").
As already stated, the main message of commercial speech is “buy me.” It is clear that commercial speech is granted a lower level of First Amendment protection than political or social speech. As a practical matter though, commercial speech may incorporate elements of “news” and “story” speech and still only be entitled to commercial speech protection. The real difficulty lies in determining exactly where the line is drawn.

The difficulty in consistently applying the protection-hierarchy framework can understandably result in unpredictable court decisions. In fact, this Note intends to show that the holding in ETW Corp. v. Jireh Publishing, Inc. resulted from a misapplication of First Amendment protection; the misapplication stemmed from confusion regarding the speech-classification approach and an inadequate analysis of factors relevant to the speech classification inquiry. Viewed in light of the purposes of First Amendment protection and a proper analysis of speech classification, the ETW decision is an unwarranted extension of First Amendment protection that serves to handicap a person’s right to control the commercial use of his or her image.

A. ETW CORP. V. JIREH PUBLISHING, INC.

Trying to persuade a court that the cherished freedoms of the First Amendment should yield to the economic interests of an individual is never a celebrated task. Indeed, attempting to undermine the revered and fundamental First Amendment seems almost unpatriotic, but lest one forget, it is equally essential to the preservation of liberty to retain such rights within their intended confines as it is to prevent their violation. The pendulum of liberty swings in both directions as a reminder that any time one person’s liberties increase, another’s must contemporaneously diminish. The Sixth Circuit’s holding in ETW Corp. v. Jireh Publishing, Inc. is a quintessential example of how an erroneous extension of First Amendment protection can handicap a person’s ability to retain autonomy over the commercial use of her persona and simultaneously legitimize one person’s unjust enrichment from the goodwill and labor of another.

To appreciate fully the implications of the holding, one must necessarily consider the painting at issue. The foreground of the painting portrays three images of Woods in different poses. On each side, Woods is in his well-recognized position of crouching while lining up his putt. In the center, Woods

108 See supra note 101 and accompanying text.
109 1 MCCARTHY, supra note 19, § 8:19, at 8-28.
110 See Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60, 67-68 (1983) (stating that speech may be property classified as “commercial” notwithstanding the fact it relates to important public or political issues).
is posed as having just completed the golf swing—head up, club over the left shoulder, adorned in his usual Nike hat, red shirt, and black pants. The images of Tiger are flanked on the left by his caddy, Mike “Fluff” Cowan, and on the right by the caddy of his final round partner, Constantino Rocca. In the background is the clubhouse at Augusta National. Behind the clubhouse in the blue sky is an overlay of six famous golfers of the past posing in front of the Masters leader board. Among the golfers in the back are Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagan, Bobby Jones, and Jack Nicklaus. The prints were sold in a white envelope with “Tiger Woods” printed on the back under the flap. The print was also accompanied by descriptive literature that included Woods’ name twice.

When ETW brought suit for the mass production and sale of this painting, Jireh Publishing (“Jireh”) asserted First Amendment protection of free speech as a defense to ETW’s claim of infringement under the Ohio common law right of publicity. In Whitney v. California, Justice Brandeis made what is considered to be the authoritative statement on the general purposes of the First Amendment. Explained by Professor McCarthy, those purposes were: (1) enlightenment—the need to disseminate political, social and scientific information; (2) self-fulfillment—the need for human self-expression in all forms; and (3) safety valve—the societal need for free expression as an alternative for or sublimation of social or political violence. The Sixth Circuit’s reasoning in ETW casts Jireh’s First Amendment defense under the rubric of Brandeis’ second purpose—that of self-fulfillment.

VII. ANALYSIS

Foreshadowing its ultimate decision in the case, the Sixth Circuit began its analysis by downplaying the strength of Woods’ right of publicity based simply on the fact that he is a wealthy celebrity with quite a substantial income. The implications of that statement are disturbingly straightforward: the more money you earn, the less right you have to control how people exploit your image. The opinion proceeds forward, belittling the labors of athletic achievements by stating that “the commercial value acquired by a person’s identity is largely fortuitous or

112 For a detailed analysis of the three Brandeis functions, see Smolla & Nimmer on Freedom of Speech §§ 1.02-1.04; John E. Nowak et al., Constitutional Law 863 (2d ed. 1978).
113 1 McCarthy, supra note 19, § 8-2, at 8-6.
115 See id. at 938 (stating that the effect of restricting Woods' right of publicity rights in this case is "negligible").
otherwise unrelated to any investment made by the individual, thus diminishing the weight of the property and unjust enrichment rationales for protection.116 The court seems content to replace the countless hours of hard labor and training required to achieve athletic greatness with the illusion that fortune and fame simply fall incidentally into the athlete’s lap. In contrast, the Supreme Court of California has recognized that “[y]ears of labor may be required before one’s skill, reputation, notoriety or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion.”117 If, as stated in Zacchini, “the rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will,” how can the Sixth Circuit justify as “negligible” misappropriation of goodwill resulting from years of hard labor? The answer is that it cannot, particularly when applying Ohio State law, since it was the Supreme Court of Ohio that decided Zacchini. The problem with the Sixth Circuit’s analysis is that its focus is misplaced. Rather than concentrate on Jireh’s unjust enrichment through the sale of the prints,118 the court considered the relative loss to Woods.

A proper application of the right of publicity would have led the court to prevent Jireh’s unjust enrichment because “[n]o social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.”119 Thus, by focusing on the relative loss of the athlete rather than the unjust enrichment of the artist, the court improperly weakened Woods’ right of publicity.

A. EXPRESSIVE VERSUS COMMERCIAL—IS RUSH’S PAINTING ENTITLED TO PROTECTION?

Since purely commercial speech is given the lowest level of constitutional protection,120 determining whether a particular work is classified as expressive rather than commercial speech is pivotal in analyzing whether that work has violated the publicity rights of another. “In order to determine whether a person’s right of publicity has been appropriated, ‘the context and nature of the

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116 Id. at 930 (emphasis added) (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (1995)).
118 If there is any doubt as to whether Jireh was enriched through Woods’ goodwill, then imagine how well the painting would have sold sans Tiger Words.
120 See 1 MCCARTHY, supra note 19, § 8:16, at 8-22 (stating that “in some cases, [commercial speech’s] level of First Amendment protection seems so attenuated as to be practically nonexistent”).
use is of preeminent concern.'121 Thus, the pertinent issue in ETW is whether the context and nature of Rush's painting is more aptly characterized as a form of communication designed to convey a message or a product designed to capitalize on the fame and goodwill of the celebrity depicted.

In attempting to apply Ohio law to that exact question, the court stated that it "believe[d] the courts of Ohio would follow the principles of the RESTATEMENT [of Unfair Competition] in defining the limits of the right of publicity."122 In particular, the Court relied on a Restatement provision which states, "[t]he use of a person's identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity."123 Hence, even though an artistic rendering of a recognizable person may not be deemed "newsworthy," it may still find protection under the First Amendment as "expressive art."124 Simply because a piece of art may be said to be "newsworthy" or "expressive," however, does not make its use automatically privileged.125 As one court held: "in certain situations, even when the publication at issue is clearly 'news' and not for commercial purposes, . . . the publisher can be required to compensate the individual whose likeness was used. The right to compensation would seem even more compelling where the use is solely commercial."126 If we endeavor to interpret properly the rights granted by the First Amendment, we must construe them in light of their purpose. Thus, in creating "The Masters of Augusta," has Rick Rush truly communicated some newsworthy information or expressed an idea? In holding that Rush's painting "consists of much more than a mere literal likeness of Woods,"127 the court determined that the painting did, in fact, express an idea. It surmised that the work "conveys the message that Woods himself will someday join [the group of famous golfers in the background]."128 But if potentially侵权 artwork can be saved with the suggestion of any inherent, deeper

122 332 F.3d at 931.
124 1 MCCARTHY, supra note 19, § 8:72, at 8-107.
125 See Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407, 416 (9th Cir. 1996) (noting that speech that is "newsworthy" is not automatically protected).
126 Tellado v. Time-Life Books, Inc., 643 F. Supp. 904, 914 (D.N.J. 1986). See also 1 MCCARTHY, supra note 19, § 8:27, at 8-38 to 8-38.1 (stating that "[o]ne obvious lesson of Zabrini is that if unpermitted use of identity or performance even in the context of pure 'news' can trigger right of publicity infringement without offending First Amendment policies, then similar use in the 'commercial' context of advertising can even more clearly trigger liability").
127 ETW Corp., 332 F.3d at 936.
128 Id.
meaning within the artwork, then the right of publicity becomes useless outside of paintings that depict only lifelike recreations of celebrities on blank canvases. By adopting the Sixth Circuit’s approach, a court can simply engage in a guessing game wherein it gathers any number of potentially valid “ideas” conveyed from the artwork, regardless of whether the artist himself ever intended to convey that message. This approach does not fit with the “levels of protection” framework of the First Amendment because it offers blanket protection to any form of speech no matter how nominally expressive. Furthermore, it fails to take into account any of the celebrity’s interests in controlling the commercial exploitation of his identity while giving full consideration to the artist’s interests in expressing his idea.

As previously stated, the goal of the courts should be to balance the protections of the First Amendment with the interests served by the right of publicity. One useful inquiry in situations where the First Amendment is at odds with the right of publicity is whether the communication at issue has crossed the line from expressive work to commercial speech so that, while elements of expressionism may still remain, the dominating aspect of the work is commercial in nature. This analysis properly places the focus on “whether it is the art, or the celebrity, that is being sold or displayed.” Especially in the context of expressive art, this is a difficult line to draw. Furthermore, the amount of Supreme Court guidance on where to draw this line between expressionism and commercialism is extremely limited. Realizing that one must look beyond Zaccarin inasmuch as it has been criticized as being “narrowly drawn” and distinguishable from ordinary right of publicity cases, “guidance [on the issue] is provided by the California Supreme Court because it has addressed the specific issue in a case nearly on all fours with that presented [in ETW v. Jireh].”

In Comedy III Productions, Inc. v. Gary Saderup, Inc. the California Supreme Court squarely addressed the issue presented in the ETW case and in doing so, created a test for determining whether artistic creations that depict an unauthorized celebrity’s image are entitled to First Amendment protection. The Comedy III plaintiff was the registered owner of all rights to the former comedy act

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129 Hoepker v. Kruger, 200 F. Supp. 2d 340, 349, 63 U.S.P.Q.2d (BNA) 1168, 1175 (S.D.N.Y. 2002). See also 1 McCarthy, supra note 19, § 8:27, at 8-38 (noting that the majority in Zaccarin felt unbound by the label the defendant placed on his work, but looked primarily to the relationship between the defendant’s work and the plaintiff’s publicity value).

130 1 McCarthy, supra note 19, § 8:27, at 8-38 (recognizing that “while the Zaccarin majority and dissenting opinions have been picked apart word by word by the commentators, no clear message emerges and no general rule is discernible by which to predict the result of conflicts between the right of publicity and the First Amendment”).

131 ETW Corp., 332 F.3d at 956 (Clay, J., dissenting).

known as The Three Stooges. The defendants, artist Gary Saderup and his corporation, Gary Saderup, Inc., were sued by the plaintiff for violation of California’s right of publicity statute in connection with the sale of t-shirts and lithographs bearing the image of The Three Stooges produced from a charcoal drawing done by Saderup.133

As in ETW, the defendant claimed that his drawing was protected by the First Amendment. Realizing that the right of publicity protects a form of intellectual property that society deems to have some social utility, the California Supreme Court set out to develop a test that would balance the interests underlying the right of publicity with the interests protected by the First Amendment. In choosing to follow Zacchini, the court concluded that the appropriate test should reflect the proposition “that depictions of celebrities amounting to little more than the appropriation of the celebrity’s economic value are not protected expression under the First Amendment.”134 The court cautioned, however, that simply because the artwork appeared on “a less conventional avenue of communication[]”35 (t-shirts) or was for the purpose of entertaining rather than informing, it did not receive a reduced level of First Amendment protection. Rather, the extent to which the work is transformative determines the level of First Amendment protection.136 In other words, one should ask whether the artwork “containing a celebrity likeness . . . [has] been sufficiently transformed from the original creation that the defendant’s creative elements predominate in the work and give it a new meaning and form.”137

The dominant thrust behind this type of inquiry was drawn from copyright law’s fair use defense.138 Since a partial importation of that doctrine into publicity law carried “the advantage of employing an established doctrine developed from a related area of the law,”139 the court was open to exploring how the factors employed in a copyright fair use defense could be helpful in reconciling the rights of free expression and publicity. In the court’s opinion, the first fair use factor, “the purpose and character of the use,”140 was particularly pertinent to the issue and provided the basis for the transformative test. In a sense, the transformative test applied by the California Supreme Court adapts the “purpose and character

133 Id. at 800-01.
134 Id. at 805.
135 Id. at 804.
136 Id. at 808.
of use" factor into an inquiry of whether the purpose and nature of the artwork is primarily intended to capitalize on the fame and marketability of the depicted celebrity, or whether the dominant purpose of the artwork is expressive, as evidenced by the presence of transformative elements sufficient to elevate the piece above a mere commercial exploitation of the celebrity.

This type of inquiry squares with the Supreme Court's finding in Zacchini:

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 state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.141

In addition, the transformative test squares with the goals of the First Amendment and the right of publicity since "works of parody or other distortions of the celebrity figure are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect."143 It is clear that of all attempts at balancing the First Amendment with the right of publicity, the transformative test is the first to approach the issue properly by analyzing the nature of the work itself rather than the medium of expression or the type of speech employed.

One weakness of the Comedy III opinion is that while it calls upon the courts to determine whether a work is transformative, it offers no clear guidance on how the court should make this determination.144 The reader is left with only the court's synopsis of the test:

Another way of stating the inquiry is whether the celebrity likeness is one of the "raw materials" from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a 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. And when we use

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141 Comedy III, 21 P.3d at 808 (citing Zacchini, 433 U.S. at 575-76).
142 See id. (stating that the "inquiry into whether a work is 'transformative' appears to us to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment").
143 Id.
144 See id. at 809 (naming factors that courts should not consider rather than factors that they should consider).
the word "expression," we mean expression of something other than the likeness of the celebrity.\textsuperscript{145}

"The Masters of Augusta" does not satisfy the transformative test. The three images of Tiger Woods are the centerpiece and culmination of the painting. They are lifelike recreations of Woods, with painstaking attention to every detail from his familiar facial expressions right down to the Nike "swoosh" on his black hat. The majority relies on the fact that the painting contains a backdrop of the clubhouse at Augusta and depictions of other famous golfers in the sky as "sufficient to bring Rush's work within the protection of the First Amendment."\textsuperscript{146} This analysis gives too much deference, however, to trivial elements of the painting that belie the true nature of the work; at its core, the work is a literal reproduction of Tiger Woods which derives its marketability almost exclusively from Woods' fame. Under the majority's opinion, any painting that is merely a lifelike recreation of a celebrity's image can be made immune from right of publicity infringement by including a few supplementary elements in the backdrop and allowing the court to speculate as to any number of "ideas" that the artist is trying to convey. It would be analogous to painting a faithful likeness of Michael Jordan and then by the inclusion of both a Chicago Bulls and Washington Wizards logo in the backdrop, the artist claims First Amendment protection because the work illustrates Jordan's transition from an established basketball dynasty to a franchise in dire need of a hero. Surely this cannot be the appropriate balance between the right of publicity and the First Amendment; it leaves no protection for the celebrity beyond lifelike recreations on blank canvases.

To remove all doubt in situations like that of "The Masters of Augusta," the \textit{Comedy III} court proposed a subsidiary inquiry to the transformative test that is particularly useful in close cases: "does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted?"\textsuperscript{147} Gillison has accurately articulated the role of this subsidiary question within the larger framework of the transformative test:

\begin{quote}
[I]f the value of the work derives primarily from the celebrity subject, then the trier of fact must determine whether the work is sufficiently transformed, under the [transformative test], to provide it with First Amendment protection. If, however, the value of the
\end{quote}

\textsuperscript{145} \textit{Id.}

\textsuperscript{146} ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 936, 67 U.S.P.Q.2d (BNA) 1065, 1081 (6th Cir. 2003).

\textsuperscript{147} \textit{Comedy III}, 21 P.3d at 810.
work derives primarily from some source other than the fame of the celebrity subject, then the reviewing court can presume that there are sufficient transformative elements present to provide the work with First Amendment protection.\footnote{GILLISON, supra note 137, at 377-78.}

Under this source of value approach, it is clear that the ETW court should not have granted "The Masters of Augusta" First Amendment protection. How marketable would the painting be if a generic golfer, rather than Tiger Woods, was the centerpiece of the work? The painting undeniably gains its commercial value by exploiting the fame and celebrity status that Woods has worked to achieve. To be sure, the Court admits that if Woods’ right of publicity prevented Rush from using Woods' image, Rush would be unable to profit from his painting.\footnote{332 F.3d at 938.} "Under such facts, the right of publicity is not outweighed by the right of free expression."\footnote{ISO Id at 960 (Clay J., dissenting); see Coxedy 11, 21 P.3d at 811 (noting that the marketability and economic value of the defendant's work was derived primarily from the celebrities it depicted and was therefore not protected by the first amendment).}

In addition, none of the elements deemed "transformative" by the majority have any connection to the three separate images of Woods in the painting. When the only elements that could possibly be designated as "transformative" are entirely separate from the celebrity depicted, there should be a strong presumption that the work is not sufficiently transformative to justify First Amendment protection from right of publicity infringement.

As noted by the dissent:

[I]t is difficult to discern any appreciable transformative or creative contribution in Defendant's prints so as to entitle them to First Amendment Protection . . . [a]lthough the faces and partial body images of other famous golfers appear in blue sketch blending in the background of Rush's print, the clear focus of the work is Woods in full body image wearing his red shirt and holding his famous swing in the pose which is nearly identical to that depicted in the Nike poster. Rush's print does not depict Woods in the same vein as the other golfers, such that the focus of the print is not the Masters Tournament or the other golfers who have won the prestigious green jacket award, but that of Woods holding his famous golf swing while at that tournament. Thus, although it is apparent that Rush is an adequately skilled artist, after viewing the
prints in question it is also apparent that Rush’s ability in this regard is "subordinated to the overall goal of creating 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."151

Thus, the Sixth Circuit erred in its application of the Comedy III "transformative test" to Rick Rush’s "The Masters of Augusta." By viewing the presence of background elements in the painting as dispositive on whether the piece was expressive in nature, the court erroneously granted First Amendment protection where it was not justified by the facts of the case. A proper analysis under the transformative test would not have ignored the lack of any 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.

VIII. CONCLUSION

In ETW Corp. v. Jireh Publishing, Inc., the Sixth Circuit improperly granted First Amendment protection to artwork that clearly exploited the economic value and marketability of Tiger Woods. While this exploitation alone is not enough to remove the artwork from the gambit of First Amendment privileges, the lack of any significant transformative elements in the painting places a suspicious gloss on the painting as to its true nature and purpose.

The so-called "enlightenment" purpose of the First Amendment ensures the right to free and unfettered dissemination of social and political information. To this end, the right is construed broadly and includes the freedom to convey those messages that are purely for entertainment purposes.152 But one must be mindful that while construed broadly, the First Amendment privileges, like any other rights, have their limitations. To be sure, it is not beyond the limits of the First Amendment for an artist to utilize legitimately the image of celebrities in her work. Additionally, that same artist may sell her work, perhaps even capitalizing upon the economic value of the celebrity depicted. Finally, that same artist may legitimately mass produce her work, selling thousands of copies to consumers across the country. Where should courts draw the line between expressionism and pure commercialism? If any deference is given to the purposes of the First Amendment, then the inquiry does not concern how much money is at stake or how many copies are sold. The inquiry must be toward the nature of the artwork itself, and while improperly applied in ETW v. Jireh, the Comedy III transformative

151 Id at 959 (Clay, J., dissenting) (citing Comedy III, 21 P.3d at 811).
152 1 McCarthy, supra note 19, § 8:15, at 8-20 to 8-21.
test "does provide a legal and logical paradigm from which to evaluate future cases" that properly places the focus on the inherent nature of the work in question.

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153 GILLISON, supra note 137, at 383.