

TRANSFORMATION: THE BRIGHT LINE BETWEEN COMMERCIAL PUBLICITY RIGHTS AND THE FIRST AMENDMENT

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I. INTRODUCTION

The Right of Publicity provides to each and every person the right to use his or her *persona* for his or her benefit and provides a cause of action to stop the unauthorized use of that *persona* for commercial purposes.

This right is one of the many provided by the laws of unfair competition. Infringement of this right has become a frequently pleaded count made by attorneys who are trying to protect their clients from the unauthorized use of the client's *persona* for commercial purposes. While the genesis of the right has been commonly thought to be a splintering from the Right to Privacy, which in turn owes its birth to an article in a Harvard Law Journal in 1890,¹ it may be more accurate to say that it has long been a common law right and has a common origin in trademark law as a commercial fraud.

Originally, the Right of Publicity was thought to protect only the unauthorized use of a person's name, likeness and image.² Now, however, it is generally understood to encompass any *personal* attribute that identifies a particular person. For ease of discussion, that identity is referred to as the individual's *persona*. The identifying attribute may be

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1. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:3 (4th ed. 2003).

2. See *Haelen Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953).

the individual's name, likeness, image, voice,³ unique property identified with a person,⁴ or recognizable attire and "look," unique to a person and by which he or she is known.⁵

The use of the Right of Publicity as a separate count in a complaint has become sufficiently common that it can now be said that it has come of age. Of course, there are still those who refuse to accept that the right grew in an appropriate fashion, and consider it to be like Topsy, arriving without any identifiable parentage. Whatever its origin, the reality is that it is here and that, in the last ten years, it has been separately pled and discussed in at least seventy-five different reported federal court cases.⁶

It is clearly the majority view that the unauthorized use of a *persona* gives rise to a cause of action that may be pleaded in addition to the usual unfair competition causes of action of trademark infringement, unfair competition, copyright infringement, and false advertising. The Right of Publicity has a family resemblance to all of those causes of action, but it is, in fact, independent of them, and provides a separate means of recovery in addition to those more commonly utilized counts.

The modern use of the Right of Publicity cause of action can be traced to the Supreme Court decision in *Zacchini v. Scripps-Howard Broadcasting Co.*,⁷ a case that arose out of the state of Ohio. Ohio and the Sixth Circuit have provided some of the more interesting cases dealing with the Right of Publicity; yet one does not automatically think of the middle of America as being a hot bed of celebrities where publicity rights would be frequently litigated. While Detroit, in the northernmost state in the circuit, has Motown music, and Nashville, in the southernmost state, provides country music and both have numerous celebrities, the cases considered by the Sixth Circuit have not involved the music celebrities of either of those cities. Rather, Elvis from Memphis,⁸ portable toilets from Michigan,⁹ toys from Kentucky,¹⁰ sports

3. See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (unique singing voice and style); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

4. *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (racing car).

5. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993) (involving the well-recognized dress and appearance of Vanna White, the letter-turner on the television game show *Wheel of Fortune*). Also consider the bowler hat, floppy shoes and cane of Charlie Chaplin's character "The Tramp."

6. This number is based on a review of cases through Westlaw using the description "Right of Publicity."

7. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

8. *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir. 1980).

9. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

10. *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619 (6th Cir. 2000).

management in Cleveland,¹¹ Rosa Parks in Michigan,¹² and of course the Zacchini cannonball act provide interesting points of development of the right.

II. RIGHT OF PUBLICITY: RECOGNIZED BUT NOT UNIFORM

Unfortunately, the Right of Publicity has not attained uniform national recognition. Application of the law depends on each state's interpretation of the right: some agree that it is a common law right that has always existed; others cling to the view that it is a branch of the privacy right and is only a creature of statute; and still others have yet to opine on it at all.¹³ Moreover, the right seems to cause visceral reactions from judges who decide the issue. A few years ago, the International Trademark Association (INTA) unsuccessfully attempted to create a model definition for the Right of Publicity. The plan never fully developed because of differing views among INTA members. Today, we remain without any uniform law or federal legislation.

Early efforts to get states in which the rich and famous reside, and whose *personas* are most attractive to marketers, to recognize the right were two pronged. Cases were filed in state courts urging the recognition of a common law right, and legislative efforts were undertaken to have the right codified. The result was mixed. Some states recognize the right as an advertising right; some have a term limit for the right while others do not; some recognize that the right is descendible; others hold that it is a personal right that terminates upon the person's death.¹⁴ The result of these differences is that the very corporations that prefer that there not be a uniform act or federal law are left to deal with the vagaries of each state.

III. TODAY'S HOT ISSUES FOR THE RIGHT OF PUBLICITY

Although there are perhaps a number of issues which could be considered "hot" in the field of the Right of Publicity, the discussion here is limited to two issues which seem to raise the most angst. First is the descendability of the right: once the celebrity dies, are the

11. *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000), *aff'd*, 332 F.3d 915 (6th Cir. 2003).

12. *Parks v. LaFace Records*, 76 F. Supp. 2d 775 (E.D. Mich. 1999), *rev'd*, 329 F.3d 437 (6th Cir. 2003).

13. 4 MCCARTHY, *supra* note 1, § 28:45, at 28-71.

14. *Id.* at 28-71; *see, e.g.*, the statutes of Virginia, Nevada, Tennessee, California, and New York.

heirs/estate able to exclusively exploit that right? Second is the protection the First Amendment affords as a defense to an allegation of the Right of Publicity. Both issues continue to generate discussion: when, if ever, does the right cease and where does protection of the Right of Publicity end and the First Amendment begin?

A. *Should the Right Descend?*

While the Right of Publicity is a right that we all have, it is clear that most of us will not have reason to exercise the right. The states that we think of as having the most “celebrities” have a fairly well established jurisprudence outlining the applicability of the right to living individuals.¹⁵ There are not a significant number of open questions in those states, notwithstanding that their laws are not uniform.

1. State Decisions and Codifications

However, there is an issue as to when the right terminates. Those states that have codified the right have all legislated a term-limit to the right. In New York, the right dies with the individual.¹⁶ In Indiana and Nevada, the publicity right lasts for 100 years after death. In California, the right lasts for fifty years after death and, in Tennessee, the right terminates only upon its abandonment. The differences have occurred as a result of lobbying by various interest groups. Those lobbying efforts in New York and Tennessee are particularly interesting. It is also important to remember that the law of the state where the deceased is domiciled at the time of his/her death is the law that applies.

a. The Law in New York

In New York, the law is considered a part of the law of privacy of the state. The statute was enacted after the landmark case of *Roberson v. Rochester Folding Box Co.*¹⁷ There, a miller used a young woman’s image to sell his flour.¹⁸ The young woman sued and alleged an invasion of her privacy right.¹⁹ The claim was founded on the privacy theory expounded in the 1890 Samuel D. Warren and Louis D. Brandeis

15. California, New York, Nevada and Tennessee. The selection is not scientific, merely anecdotal as a result of their entertainment centers in Hollywood, New York City, Las Vegas, Nashville and Memphis.

16. 4 MCCARTHY, *supra* note 1, § 28:45, at 28-72.

17. *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442 (N.Y. 1902).

18. *Id.*

19. *Id.*

Harvard Law Journal article, *Right To Privacy*,²⁰ in which they argued that a right of privacy existed at common law and that every one had the right to be let alone. The New York court held that there was no common law right of privacy in New York and denied any recovery to the woman.²¹

The *Roberson* decision caused a public outcry and, the year following the decision, the New York legislature passed a law to correct the injustice done to the young woman. The newly enacted legislation provided a cause of action for using a name or photograph of a living person for advertising purposes without authorization of the person.²²

In the early 1980's, following decisions of the United States District Courts in New York and the Second Circuit Court of Appeals, there were hearings to amend the New York statute. Lobbying on behalf of advertising, publicity, press and entertainment interests successfully prevented any changes to extend protection to the deceased and to broaden the law to cover attributes other than names and photographs. Thus, to date, the law of New York remains as it was when the statute was enacted in 1903.

b. The Law in Tennessee

In Tennessee, the Right of Publicity legislation was enacted as a result of a series of cases primarily involving Elvis Presley.²³ In the first of these cases, *Factors Etc., Inc. v. Pro Arts, Inc.*, the Second Circuit determined that, under New York law, the Right of Publicity could survive a celebrity's death if the right had been exploited during the celebrity's life.²⁴ The court upheld the lower court's grant of a preliminary injunction.²⁵

The Second Circuit had an opportunity to reconsider the descendability of the Right of Publicity two years later in a second

20. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

21. *Roberson*, 64 N.E. at 442.

22. N.Y. CIV. RIGHTS LAW §§ 50-51 (2003).

23. *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978) [hereinafter *Factors I*]; *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278 (2d Cir. 1981) [hereinafter *Factors II*]; *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 956 (6th Cir. 1980).

24. *Factors I*, 579 F.2d at 222, *overruled by* *Stephano v. News Group Publ'ns, Inc.*, 64 N.Y.2d 174 (N.Y. 1984). In *Stephano*, the highest court for the state of New York held that there was no common law Right of Publicity; the Right of Publicity was found in the 1903 statute. *Id.* at 183.

25. *Factors I*, 579 F.2d at 222.

appeal of the same case.²⁶ This time, the court reviewed the lower court's issuance of a permanent injunction.

In its second review of the case, the Second Circuit addressed the choice of law issue: which state's law applied in determining whether or not the Right of Publicity descended, New York or Tennessee?²⁷ When the case first came to the court, neither party raised the conflict of law issue, and the court summarily decided that the law of New York applied as that was where the "wrong" had occurred.²⁸ At this second bite of the apple, the parties raised the choice of law issue as the Sixth Circuit, in a different Elvis Presley case, *Memphis Development Foundation v. Factors, Etc.*,²⁹ had recently considered whether or not Tennessee common law provided for a descendible Right of Publicity.

After considering the choice of law issue, the Second Circuit held that Tennessee law applied as opposed to New York law.³⁰ Moreover, because Tennessee had no statute dealing with the Right of Publicity and because its courts had not ruled on the issue, the federal court of appeals in New York declared that it should rule as if it were a court sitting in Tennessee.³¹ Although there were no decisions out of Tennessee's state courts, the United States District Court in Memphis had recently decided the issue favorably for the Elvis Presley interests.³² That district court held that the Tennessee courts would find a descendible common law Right of Publicity and so enforced the Elvis Presley publicity rights against the seller of Elvis statues.³³ This would have ended the matter, except the Sixth Circuit reversed that district court's decision and said that Tennessee would not find a common law Right of Publicity.³⁴

The Sixth Circuit expressed a panoply of concerns. It said that if the Right of Publicity survived the individual's death, i.e., was an inheritable right, "[a] whole set of practical problems of judicial line-drawing" would occur.³⁵ "How long would the 'property' interest last? In perpetuity? For a term of years? Is the right of publicity taxable? At what point does the right collide with the right of free expression

26. *Factors II*, 652 F.2d at 278.

27. *Id.* at 280.

28. *Id.*

29. *Memphis Dev.*, 616 F.2d 956.

30. *Factors II*, 652 F.2d at 281.

31. *Id.* at 283.

32. *Id.*

33. *Id.* at 280. The statues were miniatures of a statue that was being sculpted to stand on Beale Street in Memphis in honor of Presley. *Id.* Selling the statues was a means of raising the funds to pay for the full sized statue. *Id.*

34. *Memphis Dev.*, 616 F.2d at 956.

35. *Id.* at 959.

guaranteed by the [F]irst [A]mendment?”³⁶

In any event, the Second Circuit, over a vigorous dissent by Judge Mansfield, decided that it should follow the Sixth Circuit’s decision in *Memphis Development* since the Sixth Circuit had considered the issue of whether or not Tennessee had a descendible Right of Publicity and there was no Tennessee court ruling on the issue.³⁷ The Second Circuit held there was no Right of Publicity in Tennessee.³⁸ Not only did this seem wrong because Tennessee, especially Nashville, is the residence of a considerable number of famous entertainers, but also because Tennessee recognized the protection of names as trade names at common law.³⁹ In fact, the Second Circuit, when discussing the holding in *Memphis Development*, noted that “[t]he writer would probably uphold a descendible right of publicity, were he serving on the Tennessee Supreme Court, and perhaps if he served on the Sixth Circuit when *Memphis Development* was decided.”⁴⁰ Nonetheless, the federal appeals court sitting in New York followed its sister court in the Sixth Circuit.⁴¹

These decisions caused serious problems for the Estate of Elvis Presley. A significant licensing program for Elvis products was in jeopardy. It had two options: go to court or go to the legislature. It did both.

2. The Tennessee Statute

The Estate of Elvis Presley successfully sponsored a Tennessee statute which strongly resembles the Lanham Act. There is a reason for this. First, the Presley rights were being secured as trademarks, because that area of the law was established. It could not rely solely on a publicity right which was relatively untested in most jurisdictions and was being applied against its interests. The analogy between the Right of Publicity and trademarks was apparent, and the similarities made the use of similar language for personal publicity rights seem appropriate.

Second, because the Sixth Circuit expressed concern about how long the right would last, the Tennessee act adopted trademark reasoning. It declares that the right continues for so long as it is not

36. *Id.*

37. *Factors II*, 652 F.2d at 283.

38. *Id.*

39. *See e.g.*, *C.F. Simmons Medicine Co. v. Mansfield Drug Co.*, 23 S.W. 165 (Tenn. 1893) (granting injunction for use of name and portrait under trademark and unfair competition theories).

40. *Factors II*, 652 F.2d at 282.

41. *Id.* at 282-83.

abandoned by its owners. Like a trademark, it can continue in perpetuity. The Tennessee act also recognizes that the right is descendible and devisable.

The perpetual grant of the publicity right granted by the Tennessee statute seems appropriate. Why should a valuable property right that is promoted, used and maintained become public domain? Why should persons who did nothing to develop or maintain the right have access to it for their personal gain? Why should those who created the *persona*, protected it, invested in it and made it valuable be deprived of it merely as a result of the passage of time?

3. Tennessee Common Law

The Estate of Elvis Presley also filed suit in Tennessee state court. Before the enactment of the Tennessee Right of Publicity statute, the Appeals Court of Tennessee reached a decision in this Presley case and ruled that Tennessee would recognize a common law Right of Publicity.⁴² This ruling was followed less than four weeks later by a Sixth Circuit decision in yet another Elvis Presley case. There, the Sixth Circuit acknowledged that its view of the termination of the Right of Publicity, as decided in *Memphis Development*, had been expressly rejected by a Tennessee state court.⁴³ The Estate of Elvis Presley succeeded on both the legal and legislative fronts in garnering rights in the Presley image.

4. The Right Should Descend

The argument against descendability of the publicity right seems to center around a particular economic argument. Would people be more likely to become celebrities if they knew that they could create and devise a property right that protected that celebrity? If the right were limited only to celebrities, the argument might have more weight. If we accept that the right belongs to all and that its infringement is the commercial use of it without authority, then whether the commercial use is mere "good luck" or the result of a well defined business plan seems immaterial. An important consideration is that once the commercial value of a *persona* is determined, for whatever reason, the individual and/or his or her heirs maintain that value. If the value has been

42. State ex rel. Elvis Presley Int'l Mem'l Found. v. Crowell, 733 S.W.2d 89, 97 (Tenn. Ct. App. 1987).

43. Elvis Presley Enters., Inc. v. Elvisly Yours, Inc., 817 F.2d 104, 104 (6th Cir. 1987).

maintained and if its maintenance continues by the heirs or assignees, why should it escheat at some predetermined time, to the public?

Judge Merritt of the Sixth Circuit in *Memphis Development* appeared to believe that fame is a result of public adoration that has little or nothing to do with the individual.⁴⁴ Elvis Presley would not have been famous if the public did not like his voice, but his voice and his charisma did cause great adoration of the public. Moreover, that charisma and interest in his *persona* has been maintained by his assignees, and his name, likeness and image continue to draw interest and revenues twenty-five years after his death.

On a different level is Dave Thomas of Wendy's Restaurant fame. What justification is there for another to trade on Dave Thomas's *persona*? Unlike Elvis, Mr. Thomas was a successful businessman who used his forthrightness as a marketing tool. His name, likeness and image became well known in association with, *inter alia*, restaurants. Should Wendy's competitors or others pushing their wares now be permitted to trade on Mr. Thomas's *persona*, merely because he is deceased? If so, why?

Both the name and likeness of Elvis and Dave Thomas are trademarks. Perhaps both are sufficiently famous as trademarks that they would find additional protection under the dilution acts of the states or the Federal Trademark Dilution Act.⁴⁵ Nonetheless, if others use these *personas* to promote products without authorization, they are and should be subject to the sanctions under a Right of Publicity infringement theory. These others have done nothing to make these *personas* well-known and commercially important icons. They have done nothing to protect these images while the persons were alive or since. The culture and philosophy of American business is not to reward those who "reap where [they] ha[ve] not sown."⁴⁶ This philosophy is the underpinning of the law of unfair competition. The Right of Publicity is a part of the law of unfair competition and that law's philosophy should be applied to it.

B. What Trumps What and When: the Right of Publicity v. the First Amendment

As the Right of Publicity has become a more familiar cause of action, pleading of First Amendment defenses has increased and led to

44. *Memphis Dev.*, 616 F.2d at 958.

45. Federal Trademark Dilution Act, 15 U.S.C. § 1125(c) (1996).

46. *Int'l News Serv., Inc. v. Associated Press*, 248 U.S. 215, 221 (1918).

an unfortunate friction between these rights.⁴⁷ Property ownership and property rights are highly valued in our capitalistic society, and a considerable number of our laws are devoted to the protection of property. However, we also place a high value on our freedoms, particularly the freedom of speech and freedom of the press, both of which are fundamental to a democratic society.

Thus, there has been a continual issue in the development of the Right of Publicity law relative to the extent to which the First Amendment constrains the exercise of the Right of Publicity. Courts continue to differ in the scope of protection they afford each right. The decisions may reflect a social bias of the particular court either for property rights and recognition of limits to the First Amendment, or for limited property rights and an unfettered First Amendment right. It is clear that the unfettered First Amendment right advocates are more focused, more vocal and more zealously organized than are the publicity rights advocates. To prevent the whittling away of intellectual property rights, intellectual property lawyers need, from time-to-time, to push for a wider orbit of protection for the rights they represent, lest those rights be diminished.

Interestingly, those who have a vested interest in and frequently undertake the enforcement of their own intellectual property rights, primarily the publishing, press and advertising industries, also have an opposing interest in limiting the scope of the Right of Publicity. When they use the publicity rights of others to sell their products, they seek an expansive reading of the First Amendment and frequently obtain it. From time-to-time, there is an indication from a court that someone has pushed too far and First Amendment protection is unavailable.⁴⁸ However, sometimes the most offensive acts are deemed protected under the First Amendment, as *Hustler Magazine v. Falwell* reveals.⁴⁹

In *Hustler Magazine*, the hardcore pornographic magazine, *Hustler*, depicted Jerry Falwell, the leader of a religious organization, in a sexually explicit act with his mother.⁵⁰ Falwell sought damages based on claims of defamation and intentional infliction of emotional

47. "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances." U.S. CONST. amend. I (emphasis added).

48. See, e.g., *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Inc.*, 604 F.2d 200 (2d Cir. 1979).

49. *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988).

50. *Id.* at 48.

distress.⁵¹ The Supreme Court held that a public figure is unable to recover damages for infliction of emotional distress.⁵²

In other cases, the Supreme Court has held secure the freedom of expression over personal rights by encompassing newsworthy purposes⁵³ and certain art forms, such as plays⁵⁴ and film.⁵⁵ There remains, however, the question of when the use of the publicity right is a protected expression and when is it merely an unauthorized commercial use for the sole purpose of profit. It appears that, if a claim of parody can be established, almost anything can be said without regard to the insult that it may cause.⁵⁶ But determining when the unauthorized use of a *persona* is protected speech and when it is infringement of the Right of Publicity, remains a hotly contested issue. Our discussion here is restricted to a few key cases of unauthorized use of a *persona* for commercial purposes where the defendant has asserted a First Amendment privilege. These cases represent issues yet to be directly presented to the Supreme Court and inconsistently decided by lower courts.

The friction that we address does not arise from the desire to be let alone as Brandeis and Warren argued in *Right to Privacy*,⁵⁷ but rather from that belief in the law of unfair competition that holds that one may not reap where one has not sown.⁵⁸ When an advertiser uses the rights of others to promote and sell a product, it should expect to and be required to obtain authorization from the holder of the right to make that use or be penalized for the unauthorized use.

Two types of unauthorized use of publicity rights that have been defended by asserting a First Amendment privilege provide the material for this discussion. These areas are (1) the use of a *persona* in consumer art, and (2) the unauthorized use of a *persona* by newspapers and magazines to sell their newspapers and magazines.

51. *Id.* at 47-48.

52. *Id.* at 57.

53. *See, e.g.*, *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964).

54. *See Time, Inc. v. Hill*, 385 U.S. 374 (1967).

55. *See, e.g.*, *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1952); *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

56. *See Hustler*, 485 U.S. at 46.

57. *Warren & Brandeis, supra* note 20, at 193.

58. *See Int'l News Serv., Inc. v. Associated Press*, 248 U.S. 215, 221 (1918).

1. The Right of Publicity and Art

We begin with two of the more recent Right of Publicity cases in which the Right of Publicity and the First Amendment face off. Both involve the use of art for commercial purposes. While the *personas* that are subjects of the art and the outcomes of the cases are dissimilar, the plaintiffs in both cases claimed infringement of the publicity right and the defendants in both cases relied on First Amendment defenses. One decision limits the Publicity Right and the other amplifies a test for determining when the First Amendment should trump the Publicity Right.

a. Tiger Woods and The Masters of Augusta

This case is currently pending before the Sixth Circuit. In *ETW Corp. v. Jireh Publishing, Inc.*,⁵⁹ an artist painted the image of Tiger Woods, the professional golfer, with Woods's caddy, his final round partner's caddy, and other famous golfers - Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones, and Jack Nicklaus.⁶⁰ The artist then licensed the painting to the defendant for the purpose of making "limited edition" prints for sale to the general public.⁶¹ The painting and the subsequent prints are entitled "The Masters of Augusta."⁶² According to the court, the painting was intended to celebrate the victory of Tiger Woods at the 1997 Masters Tournament in Augusta, Georgia. Woods's exclusive licensing agent asserted, *inter alia*, that the prints infringed Woods's Right of Publicity and, in cross motions for summary judgment, contended that the prints were commercial products, "merely sports merchandise."⁶³ Defendant raised a First Amendment defense that the prints were protected speech "because they are art works and do not constitute commercial speech."⁶⁴ Defendant described the paintings and prints as expressing the "majesty of a newsworthy moment."⁶⁵ The plaintiff did not directly address the publicity claim in its summary judgment motion but did address the First Amendment issue in its argument directed to its trademark infringement claims, citing cases that

59. *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000).

60. *ETW Corp.*, 99 F. Supp. 2d at 830.

61. *Id.*

62. *Id.*

63. *Id.* at 834.

64. *Id.*

65. *Id.*

hold that posters are not protected by the First Amendment.⁶⁶

The court held that the prints seek to express a message.⁶⁷ Therefore, the court reasoned, because the Supreme Court has said (albeit in dicta) that paintings are protected by the First Amendment,⁶⁸ the prints are protected speech.⁶⁹ The message is not clearly identified other than in the self-serving platitudes the author set forth in the packaging for the prints to describe what he believes his art represents.⁷⁰

b. The Three Stooges and Silk Screening

The *ETW* decision needs to be juxtaposed with the decision of the Supreme Court of California in the Three Stooges case.⁷¹ In this case, the defendant drew a picture of Larry, Curly and Moe, the famous slapstick vaudeville and movie stars, silk screened the picture onto T-shirts, and produced lithographic prints of the drawing, all of which he sold.⁷² The plaintiff was the registered owner of all of the rights to the Three Stooges and sued, *inter alia*, for infringement of the Right of Publicity.⁷³

The decision of the California Supreme Court, relying heavily on its earlier decision, as well as the concurring opinion of then Chief Justice Bird, in *Guglielmi v. Spelling-Goldberg Productions*,⁷⁴ is instructive.

The California Court discussed (1) how the Right of Publicity is frequently a claim in commercial speech cases where a celebrity's *persona* is used in a misleading manner as an endorsement of something the celebrity does not in fact endorse and (2) how the First Amendment does not protect false speech.⁷⁵ The court then noted that false and misleading speech was not at issue.⁷⁶ The court acknowledged that entertainment is entitled to First Amendment protection, as is visual art,

66. *Id.*

67. *Id.* at 835.

68. *See* *Hurley v. Irish Am. Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 569 (1995); *Kaplan v. California*, 413 U.S. 115, 119-20 (1973).

69. *ETW Corp.*, 99 F. Supp. 2d at 835-36.

70. *Id.*

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

72. *Id.* at 800.

73. *Id.*

74. *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454 (Cal. 1979).

75. *Comedy III Prods.*, 21 P.3d at 802; *see also* *Central Hudson Gas & Elec. v. Public Serv. Comm'n*, 447 U.S. 557, 563-64 (1980).

76. *Comedy III*, 21 P.3d at 802.

“even if it conveys no discernable message.”⁷⁷ Even unconventional media for the art, as the Three Stooges art was, appearing as it did on T-shirts, is not a factor for denying the protection of the First Amendment to the work, the court said.⁷⁸ Then, however, the court said:

But having recognized the high degree of First Amendment protection for noncommercial speech about celebrities, we need not conclude that all expression that trenches on the right of publicity receives such protection. The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility.⁷⁹

....

Although surprisingly few courts have considered in any depth the means of reconciling the right of publicity and the First Amendment, *we follow those that have in concluding 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.*⁸⁰

The court then reviewed the decisions of the Courts in *Zacchini* (U.S. Supreme Court),⁸¹ *Guglielmi* (Supreme Court of California),⁸² *Estate of Presley* (Federal District Court of New Jersey),⁸³ and *Groucho Marx Productions* (Second Circuit),⁸⁴ in which First Amendment defenses were considered, but found not to apply.⁸⁵

The court noted that, in *Zacchini*, the Supreme Court denied First Amendment protection to the television station that televised the entire act of Mr. Zacchini, the human cannonball, and upheld a Right of Publicity claim pleaded under Ohio common law.⁸⁶ Quoting the Court in *Zacchini*, the *Comedy III* court said: “[T]he rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No 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.”⁸⁷ This

77. *Id.* at 804 (citing *Hurley*, 515 U.S. at 569).

78. *Id.*

79. *Id.*

80. *Id.* at 805 (emphasis added).

81. *Zacchini*, 433 U.S. 562.

82. *Guglielmi*, 603 P.2d 454.

83. *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).

84. *Groucho Marx Prods., Inc. v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982).

85. *Comedy III Prods.*, 21 P.3d at 805-807.

86. *Id.* at 805.

87. *Id.*

language is very reminiscent of the Supreme Court's early unfair competition case where it said that one may not reap where he has not sown.⁸⁸ The California court in *Comedy III* went on to say:

To be sure, *Zacchini* was not an ordinary right of publicity case: the defendant television station had appropriated the plaintiff's entire act Nonetheless, two principles enunciated in *Zacchini* apply to this case: (1) state law may validly safeguard forms of intellectual property not covered under federal copyright and patent law as a means of protecting the fruits of a performing artist's labor; and (2) the state's interest in preventing the outright misappropriation of such intellectual property by others is not automatically trumped by the interest in free expression or dissemination of information; rather, as in the case of defamation, the state law interest and the interest in free expression must be balanced, according to the relative importance of the interests at stake.⁸⁹

The next case the *Comedy III* court considered was *Guglielmi*; its own decision in which it had adopted a similar balancing approach.⁹⁰ The *Comedy III* court wrote:

Guglielmi concluded that the First Amendment protection of entertainment superseded any right of publicity *Guglielmi* proposed a balancing test to distinguish protected from unprotected appropriation of celebrity likenesses: "an action for infringement of the right of publicity can be maintained only if the proprietary interests at issue clearly outweigh the value of free expression in this context."⁹¹

The court then looked to the *Presley* case from the District of New Jersey.⁹² That court also applied a balancing test. The *Comedy III*, court referring to the *Presley* decision, said:

Acknowledging that the First Amendment protects entertainment speech, the court nonetheless rejected that constitutional defense. "[E]ntertainment that is merely a copy or imitation, even if skillfully and accurately carried out, does not really have its own creative component and does not have a significant value as pure entertainment. As one authority has emphasized: 'The public interest in entertainment will support the sporadic, occasional and good-faith imitation of a famous person to achieve humor, to effect criticism or to season a particular episode, but it does not give a privilege to appropriate

88. *Int'l News Serv., Inc. v. Associated Press*, 248 U.S. 215, 239 (1918).

89. *Comedy III Prods.*, 21 P.3d at 806.

90. *Id.*

91. *Id.* at 806.

92. *Id.*; see also *Estate of Presley*, 513 F. Supp. at 1339.

another's valuable attributes on a continuing basis as one's own without the consent of the other."⁹³

The California court noted that the New Jersey *Presley* court recognized that there was some intrinsic value in the defendant's imitation of Presley but concluded that "the primary purpose of defendant's activity is to appropriate the commercial value of the likeness of Elvis Presley."⁹⁴

Finally, the California court cites the *Groucho Marx Productions* case but does not appear to agree that the Second Circuit court gave "due consideration" to the protection of various forms of expression.⁹⁵ The Second Circuit, in *Groucho Marx Productions*, posed a dichotomy, the California court said, "between 'works . . . designed primarily to promote the dissemination of thought, ideas or information through news or fictionalization,' which would receive First Amendment protection, and 'use of the celebrity's name or likeness . . . largely for commercial purposes, such as the sale of merchandise,' in which the right of publicity would prevail."⁹⁶

The *Comedy III* court concluded that the question to be answered is whether or not the use of the celebrity's image is *transformative*.⁹⁷ That is, does the complained-of use do something more than merely copy the image of the celebrity or does the use of the image create something more than the mere copy?⁹⁸ If a painting or statuary, memorabilia, etc., merely copies the image of the celebrity for the purpose of selling the merchandise to the public, then the publicity right should be given preferential weight to a First Amendment defense.⁹⁹ The California court borrowed from copyright law and its "fair use" concepts.¹⁰⁰ It noted that the fair use doctrine considers "the purpose and character of the use."¹⁰¹ This, the court said, "does seem particularly pertinent to the

93. *Id.*

94. *Id.*

95. *Comedy III Prods.*, 21 P.3d at 807.

96. *Id.*

97. *Id.* at 808

98. In the entertainment context, this is known as the "Rich Little" defense. Rich Little is, or was, a mimic who performed in Las Vegas and on television imitating well-known people. His abilities were concededly very good. He did not, however, perform one person for his entire act. Rather, he mimicked many different people during his performance. He brought something to the performance and could be said to have "transformed" the mere use of the celebrity's voice and appearance into a means of entertainment, providing a parody of the celebrity and no doubt creating something new.

99. *Comedy III Prods.*, 21 P.3d at 808.

100. *Id.* at 807-808.

101. *Id.* at 808; *see also* 17 U.S.C. § 107(1) (2003) (federal fair use statute).

task of reconciling the rights of free expression and publicity.”¹⁰²

The California court recognized the difficulty that courts face in deciding whether the First Amendment is a proper defense to the use of a celebrity’s image in those cases where “art” is at issue.¹⁰³ However, the test it articulates provides plaintiffs and defendants some ability to assess whether their case contains a transformative element.¹⁰⁴ If it does, a First Amendment defense should prevail. If it does not, the infringement of the publicity right should exist. Some certainty to the decision-making process and the likely outcome has been added, though it is not a bright-line test by any means.¹⁰⁵

Returning to the *ETW* case, we are told that the plaintiff did not directly address the First Amendment privilege claim in the Right of Publicity context.¹⁰⁶ We have the court’s opinion that the defendant’s painting and prints were different in kind from the Elvis posters in the *Factors* case in which the posters were held not to be protected.¹⁰⁷ The *ETW* court said that the “defendant’s artistic prints seeking to convey a message may be distinguished from posters which merely reproduce an existing photograph.”¹⁰⁸ Unfortunately, the only message that we are made aware of as being conveyed by the paintings of Tiger Woods is what the artist claims in its promotional literature and, apparently, applies to all of his “sports figure” works.¹⁰⁹ Perhaps the work is transformative or perhaps it is merely slick merchandising. A more thorough review of the work itself and an effort to distinguish the other First Amendment defense cases would have been more useful. The conclusion may well be correct, but the decision is not very helpful as guidance in future cases. Perhaps the Sixth Circuit will be more

102. *Id.*

103. *Id.*

104. *Id.*

105. The Supreme Court of California had a recent opportunity to apply the *Comedy III* test. In *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003), the court found that a portrayal of the well-known performing and recording musicians Johnny and Edgar Winters in a comic book did not infringe the Winters’ Rights of Publicity. *Id.* at 476. There, the comic book characters were “not just conventional depictions of [the] plaintiffs but contain[ed] significant expressive content other than plaintiffs’ mere likenesses.” *Id.* at 479. The drawings were “distorted for purposes of lampoon, parody, or caricature.” *Id.* In short, the fact that the comic book parodied the brothers and that “[p]laintiffs’ fans who want[ed] to purchase pictures of [the Winter brothers] would find the drawings . . . unsatisfactory as a substitute for conventional depictions,” resulted in a ruling in favor of the defendants. *Id.* The First Amendment trumped the Right of Publicity.

106. *ETW Corp.*, 99 F. Supp. 2d at 834.

107. *See Factors I*, 579 F.2d at 222.

108. *ETW Corp.*, 99 F. Supp. 2d at 835.

109. *Id.* Rick Rush’s works have featured Michael Jordan, Mark McGwire, Coach Paul “Bear” Bryant, the Pebble Beach Golf Tournament, and the America’s Cup Yacht Race.

elucidating in its opinion.

The two cases, *ETW* and *Comedy III*, provide a clear look at the friction between the Right of Publicity and the First Amendment in those cases where the celebrity's image is used for the sale of a product consisting of the celebrity's image.

2. The Right of Publicity and Newspapers/Magazines

The next set of cases that cause a rub between the First Amendment and the Right of Publicity deal with the unauthorized use of celebrity *personas* by media, primarily newspapers and magazines.

It is well settled that the press can use the name, likeness and image of a celebrity in a newsworthy context without fear of reprisal, including freedom from fear of suit for infringement of the Right of Publicity.¹¹⁰ Few will quarrel with the need to maintain that freedom of the press. The press, however, should not, and need not, be exempt from paying for the use of the *persona* of a celebrity when the use is for purely commercial purposes. However, perhaps due to the success of the consistent claim that any restriction on the activities of the press has a "chilling" effect, newspapers and magazines are sometimes given a pass on the unauthorized use of *personas* in the promotion of their newspapers and magazines.¹¹¹ The bookend cases, that seem particularly egregious in terms of time and geography, are state court cases from New York and California involving the famous professional quarterbacks Joe Namath and Joe Montana.

In 1969, Joe Namath led the New York Jets to the Super Bowl championship over the then Baltimore Colts, beating all the odds. Prior to the game, Namath asserted that his team would win, and because of his lifestyle and personality, he became a favorite of the sports press and a well-known sports personality. As with most sports figures, Namath sold his publicity rights to advertisers who asked him to endorse their products. He alleged that in 1972 he earned "in excess of several

110. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974) (discussing *New York Times, Co. v. Sullivan*, 376 U.S. 254 (1964), which requires public figures demonstrate "actual malice" in libel suits against news sources).

111. See *Booth v. Curtis Publ'g Co.*, 223 N.Y.S. 737, 744 (N.Y. App. Div. 1962); *Namath v. Sports Illustrated*, 371 N.Y.S.2d 10, 11 (N.Y. App. Div. 1975); *Ali*, 447 F. Supp. 723; *Lerman v. Chuckleberry Publ'g, Inc.*, 544 F. Supp. 966, 970-71 (S.D.N.Y. 1982), *rev'd*, *Lerman v. Flynt Distributing Co., Inc.*, 745 F.2d 123 (2d Cir. 1984); *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634, 639 (9th Cir. 1982); *Stephano*, 64 N.Y.2d 174, 184; *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 585 (2d Cir. 1990); *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 642 (Cal. Dist Ct. App. 1995).

hundred thousand dollars” through such endorsements.¹¹²

Sports Illustrated, of course, gave extensive coverage to the 1969 Super Bowl and, thereafter, from time-to-time, ran other articles and photographs of Namath reporting on his activities both as a player on the field and in his personal life.¹¹³ In 1972, *Sports Illustrated* ran advertisements for subscriptions to its magazine in other magazines.¹¹⁴ The ads featured Namath and included the statement “How to get Close to Joe Namath,” in the magazines oriented to the male reader; and the statement “The man you love loves Joe Namath,” in the magazines oriented to female readers.¹¹⁵ The district court concluded that, “[a]dmittedly, [the ad] was used to stimulate subscriptions but this is permissible.”¹¹⁶ The appellate court affirmed.¹¹⁷

Fast forward twenty years. Joe Montana, the heralded quarterback for the San Francisco Forty-Niners and Super Bowl champion in 1989 and 1990, found himself in a similar situation to that of Joe Namath.¹¹⁸ The *San Jose Mercury News* featured stories of the 1989 and 1990 victories on its front page.¹¹⁹ To celebrate the victories, the newspaper issued a special souvenir section devoted to the football team, and on the front page of the section, was an artist’s drawing of Montana.¹²⁰ Each of the souvenir pages was then reproduced in poster form, and the posters sold to the general public for five dollars each.¹²¹ Montana sued for infringement of his publicity right, and the newspaper asserted a First Amendment defense and filed a summary judgment motion.¹²² The trial court granted the newspaper’s motion and the appellate court affirmed.¹²³

The court relied on cases confirming that no cause of action lies against reporting on matters in the public interest and that such reporting need not be current events but can be from a historical perspective.¹²⁴ The court concluded that, because the actual newspaper accounts of the

112. *Namath v. Sports Illustrated*, 80 Misc. 2d 531, 532 (N.Y. Sup. Ct., N.Y. Cty. 1975), *aff’d*, 371 N.Y.S.2d 10 (1975).

113. *Id.* at 533.

114. *Id.*

115. *Id.* at 533-34.

116. *Id.* (citations omitted).

117. *Namath*, 371 N.Y.S.2d at 11.

118. *Montana*, 40 Cal. Rptr. 2d at 639-40.

119. *Id.* at 640.

120. *Id.*

121. *Id.*

122. *Id.*

123. *Id.*

124. *Id.*

victories were protected by the First Amendment, so too were the posters.¹²⁵ The appearance of Montana's picture on the posters was for the same reason it appeared in the newspaper, "because Montana was a major player in contemporaneous newsworthy sports events."¹²⁶

The court said it was unable to find any cases on point (though it later cites to *Namath*), but cited a few cases that relate to political speech, and stated that "[a] [n]ewspaper [h]as a [c]onstitutional [r]ight to [p]romote [i]tself by [r]eproducing [i]ts [n]ews [s]tories."¹²⁷ The court concluded: "[i]n summary, the First Amendment protects the posters complained about here for two distinct reasons: first, because the posters themselves report newsworthy items of public interest, and second, because a newspaper has a constitutional right to promote itself by reproducing its originally protected articles or photographs."¹²⁸

Namath and *Montana* stretch the envelope. Clearly, if correct, under the guise of self-promotion, newspapers and magazines have an unbridled right to enter the merchandise arena with photographs, names and likenesses of celebrities whose names, pictures and images appeared in their earlier issues. The *Montana* court said: "Where, as here, a newspaper page covering newsworthy events is reproduced for the purpose of showing the quality and content of the newspaper, the subsequent reproduction is exempt from the statutory and common law prohibitions."¹²⁹

While it seems far-fetched to suggest that a free license to use celebrity *personas* is what these cases provide, one must concede that reprinting and selling posters is a far cry from a newspaper using news stories to promote itself. It is one thing to say "look at our coverage of the Super Bowl and our excellent photographic coverage of the action and compare it to our competitors," and an entirely different thing to have an artist create a picture of a celebrity, run the picture in the paper and then make posters of the picture that are sold to the public. Such an undertaking by anyone else would be a clear infringement of Montana's Right of Publicity and, to make an exception for news media, mocks the publicity right.

In between the "bookend" cases of *Namath* and *Montana* is another New York case in which a model—a person who earns his living by posing for photographs for a fee—was denied recovery based on the

125. *Id.* at 640-41.

126. *Id.* at 641.

127. *Id.* at 642.

128. *Id.* at 643.

129. *Id.*

newsworthiness exception.¹³⁰ In that case, the model agreed to pose for and was paid for modeling for a particular issue of a magazine.¹³¹ The publisher took one of the pictures of the model wearing a bomber jacket and used it in a column entitled “Best Bets” in a different issue of the magazine.¹³² Along with the picture was a legend identifying the designer, the price and where the jacket might be purchased.¹³³

The Court of Appeals for New York (that state’s highest court) held that, because regularly appearing column in which the photograph appeared was one in which the editors provide information to readers including, from time-to-time, prices and other information about products of interest to its readers, it was a newsworthy event.¹³⁴ “It is the content of the article and not the defendant’s motive or primary motive to increase circulation which determines whether it is a newsworthy item, as opposed to a trade usage”¹³⁵ The problem with this thinking is that an advertisement imparts information and is contained in a publication for the same purpose as was the use of the photo in the “Best Bets” column. It must take more than “content” to determine whether a use is a “newsworthy use” or an “advertising use” or a “trade use.”

In yet another setting, two newspapers conducted separate polls of their readers to decide who was the most popular member of the singing group New Kids on the Block.¹³⁶ The newspapers ran pictures of the group and then asked a form of the question “who is your favorite New Kid?”¹³⁷ The “voting” occurred by placing a 900-number call. The call to one paper cost the caller 50 cents and to the other 95 cents.¹³⁸ One paper alleged it was donating the money it received and neither collected much money.¹³⁹ It is clear that the poll was not a standard “man on the street” survey that many newspapers run to determine public opinion.

The New Kids were not pleased that their names and images were being used for such purpose and alleged, *inter alia*, trademark infringement and misappropriation.¹⁴⁰ Defendants asserted a First

130. *Stephano v. New Group Publ’ns, Inc.*, 64 N.Y.2d 174 (N.Y. 1984).

131. *Id.* at 179.

132. *Id.*

133. *Id.*

134. *Id.* at 184.

135. *Id.* at 185 (citations omitted).

136. *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302 (9th Cir. 1992).

137. *Id.* at 304.

138. *Id.*

139. *Id.*

140. *Id.* at 304-05.

Amendment defense and the trial court granted summary judgment.¹⁴¹ The Ninth Circuit, Judge Kozinski writing for the court, declined to decide the issues on constitutional grounds and held that the use of the names and pictures was “nominative use.”¹⁴² The court reasoned that nominative use is one that arises

... where the use of the trademark does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one. Such *nominative use* of a mark - where the only word reasonably available to describe a particular thing is pressed into service - lies outside the strictures of trademark law: Because it does not implicate the source-identification function that is the purpose of trademark, it does not constitute unfair competition; such use is fair because it does not imply sponsorship or endorsement by the trademark holder.¹⁴³

The court decided that the “usual fair” use defense applied when the defendant used the plaintiff’s trademark to identify defendant’s product and the “nominative use” defense applies when the defendant uses the plaintiff’s mark to identify the plaintiff’s product.¹⁴⁴

The use of their names and likenesses without permission in a manner that would be misappropriation but for the unauthorized user’s status as newspapers, was not actionable because, the court said, “the papers have a complete defense to both claims [common law misappropriation and commercial misappropriation] if they used the New Kids name ‘in connection with any news, public affairs, or sports broadcast or account’ which was true in all material respects.”¹⁴⁵ In

141. *Id.* at 308.

142. *New Kids*, 971 F.2d at 308.

143. *Id.*

144. *Id.* It seems that use of the plaintiff’s mark to identify the plaintiff’s goods where there is no false advertising should be without any recourse. The Ninth Circuit, however, has now created a test with defined requirements to determine if the use of the plaintiff’s mark by the defendant to identify the plaintiff’s goods is actionable. *Id.* First, the product or service “must not be readily identifiable without use of the trademark;” second, only so much of the mark “may be used as is reasonably necessary to identify the product or service;” and, third, the defendant “must do nothing that would . . . suggest sponsorship or endorsement by the trademark owner.” *Id.* at 308. This accretion of tests may have merit, though it is hard to discern the need for a new set of factors when the issue is the use of a trademark to identify the actual trademarked product or service. The current factors used to determine unfair competition seem satisfactory. The use of the trademark of another should be permissible except where it is used to deceive or mislead in a manner prohibited under unfair competition theories and Section 43(a) of the Lanham Act. *See* 15 U.S.C. § 1125. Nonetheless, now there is such a new test and new defense, at least in the Ninth Circuit. *See New Kids*, 971 F.2d at 308. This new nominative use defense thwarted the recovery by the New Kids under their trademark and unfair competition claims. *Id.* at 309.

145. *Id.* at 309.

other words, the operation of a poll on a topic that seems designed purely for the purpose of selling papers and not, as the rather paltry participation indicates, for determining an answer to a current topic of particular interest, is sufficiently newsworthy to be entitled to the exception to liability found in the California publicity statute. The First Amendment need not be discussed because the issue can be resolved without considering constitutional questions.

The difficulty with the various cases and the problem that practitioners and owners of publicity rights have is supposing what the court will deem newsworthy. These cases suggest that, if the press in any form is the unauthorized user of a publicity right, the owner of the right will have a difficult time successfully prosecuting an infringement of his/her right. Newsworthiness is interpreted sufficiently loosely and broadly so that almost any activity associated with a press activity will be held to be under that umbrella.

Before closing, it is necessary to consider the one arena where the courts sometimes work very hard to find that a publicity right or a trademark right will prevail over an unauthorized use in a setting usually deemed to be First Amendment territory. That is in the area of pornography. The courts will try very hard to stop pornographic use. Sometimes, in construing the law so that pornography is stopped, law is created that cannot withstand close scrutiny.

In *Dallas Cowboys Cheerleaders v. Pussycat Cinema*,¹⁴⁶ the Second Circuit found that the Dallas Cowboys football team's cheerleader uniforms were so well-known that the use of similar costumes in a pornographic movie indicated an association with or approval by the plaintiff.¹⁴⁷ On the other hand, the use of the image of "Babe" Ruth on a calendar would not lead the public to believe that Ruth's heirs have approved of the calendar or are sponsors of it.¹⁴⁸ The holdings in these two cases seem to say that cheerleaders' outfits are more readily protected than is the *persona* of a celebrity.

In *Muhammad Ali v. Playgirl*,¹⁴⁹ the court enjoined *Playgirl* magazine from selling its issue depicting a nude black man in a boxing ring that was "unmistakably recognizable" as Ali.¹⁵⁰ The court held that the use of the likeness was for the purpose of trade and not informational

146. *Dallas Cowboys Cheerleaders*, 604 F.2d at 200.

147. *Id.* at 205.

148. *Pirone*, 894 F.2d at 585.

149. *Ali v. Playgirl*, 447 F. Supp. 723 (S.D.N.Y. 1978).

150. *Id.* at 725.

or newsworthy.¹⁵¹

IV. CONCLUSION

The Right of Publicity is a valuable property right. It provides recourse to those whose *personas* would be used, without authorization, by others to sell their own products or services. Whatever the reason, the unauthorized user decided that the use of the *persona* would help sell his or her product or service, that reason validates the value of that particular *persona*, be it the likeness or image, voice, or other indicia of the particular person. The value of that *persona* does not arise from the time, money, effort or any other activity of the unauthorized user. It is either inherent in the appearance or voice of the person whose *persona* is being used, much to the person's good fortune, or it has been acquired, built and created by the person. In the case of celebrities, the value of the *persona* can be attributed to the inherent value of the *persona* plus the added value resulting from something the *persona* has done to make himself or herself a celebrity. In any case, it is clear that the attractiveness of using the *persona* to sell a particular product or service has nothing to do with the unauthorized user's efforts. If the *persona* has value, who is more appropriate to capitalize on the use of the *persona* and who is more appropriate to decide what products and services the *persona* will be associated with or that it will not be associated with any commercial venture, than the person represented by the *persona*?

The First Amendment provides freedom of speech and freedom of the press. It does not provide that the press can use the property of others for its own commercial gain without compensation to the owner of the property. Newspapers and magazine publications should be exempt from compensating those who have spent their time, effort and money to build reputations and images that others want to use because of the goodwill associated with them. When they use the images of celebrities in advertisements intended to sell their publications, they should pay for the use just as car manufacturers and clothing manufacturers must.

151. *Id.* at 727.

ADDENDUM

Since this paper was presented at the 2002 Sughrue Symposium at the University of Akron Law School, the Sixth Circuit has decided two Right of Publicity appeals in which the First Amendment was raised as a defense; one being the appeal of *ETW Corporation*. The two appeals were decided within a month of one another and the two panels came to completely different decisions. Admittedly the panels were applying different state law - one applied the law of Michigan and the other the law of Ohio. Nevertheless, the application of the First Amendment should be consistent, especially by the same circuit court.

A.. Rosa Parks

In September 1998, OutKast, LaFace, Arista Records and BMG Entertainment released an album entitled *Aquemini*.¹⁵² The first single release from the album was a song titled "Rosa Parks."¹⁵³ This song was highlighted on the album with a sticker labeling "Rosa Parks" a "hit single."¹⁵⁴ This sticker also contained a parental warning that the album contained "explicit content."¹⁵⁵

Rosa Parks, the civil rights movement activist, was not affiliated with the record or any of the parties involved in its creation or release. As a result, Parks brought an action for infringement of her right of publicity, defamation, and interference with ongoing business relationships in state court.¹⁵⁶ The action was later removed to federal court and Parks then added claims of false advertising under Section 43(a) of the Lanham Act.¹⁵⁷

The district court found in favor of defendants on cross motions for summary judgment on all counts of the complaint, including on the claims of false advertising and the Right of Publicity.¹⁵⁸

In reviewing the lower court's decision with respect to the false advertising claim under the Lanham Act, the court of appeals found that, "Rosa Parks clearly has a property interest in her name akin to that of a person holding a trademark."¹⁵⁹ Parks's prior commercial activities and

152. *Parks v. LaFace Records*, 329 F.3d 437, 442 (6th Cir. 2003).

153. *Id.*

154. *Id.*

155. *Id.*

156. *Id.* at 441.

157. *Id.* at 442.

158. *Id.*

159. *Id.* at 447.

her international renown as a civil rights activist provided her with “a trademark interest in her name the same as if she were a famous actor or musician.”¹⁶⁰ Thus, Parks has an economic interest in her name, a required element for a Right of Publicity case.¹⁶¹ This fact was undisputed and, in fact, stipulated to by the parties.¹⁶² In addition, the parties agreed that Michigan law applied and that Michigan would recognize a Right of Publicity claim.¹⁶³ The parties only disputed, not surprisingly, the application of that right.¹⁶⁴

Noting the importance of a First Amendment defense to a claim of infringement of one’s Right of Publicity, the Sixth Circuit acknowledged that a balancing test must be employed: “Parks’ [sic] property right in her own name versus the freedom of artistic expression.”¹⁶⁵

In applying these principles, the court relied on its analysis of the false advertising claims under the Lanham Act. Specifically, the court adopted the test the Second Circuit developed in *Rogers v. Grimaldi*.¹⁶⁶ The *Rogers* test provides that “a title will be protected unless it has ‘no artistic relevance’ to the underlying work or, if there is artistic relevance, the title ‘explicitly misleads as to the source or the content of the work.’”¹⁶⁷

Rogers concerned the potential infringement of the Rights of Publicity of Fred Astaire and Ginger Rogers by a movie title and the Second Circuit found that “movie titles are protected from right of publicity actions unless the title is ‘wholly unrelated’ to the content of the work or was ‘simply a disguised commercial advertisement for the sale of goods or services.’”¹⁶⁸ Under these guidelines, the Sixth Circuit had to examine the actual nature of the song.

The song entitled “Rosa Parks” makes no mention of Parks but does have a refrain “move to the back of the bus.”¹⁶⁹ A translation of the lyrics, presented to the court by Parks, identified the chorus as follows: “Be quiet and stop the commotion. OutKast is coming back out [with new music] so all other MCs [mic checks, rappers, Master of Ceremonies] step aside. Do you want to ride and hang out with us?

160. *Id.*

161. *See id.* at 460.

162. *Id.* at 460.

163. *Id.* at 459.

164. *Id.*

165. *Id.* at 461.

166. *Id.* at 451-52.

167. *Id.* at 448 (quoting *Rogers*, 875 F.2d at 999).

168. *Id.* at 461 (quoting *Rogers*, 875 F.2d at 1004).

169. *Id.* at 452.

OutKast is the type of group to make the clubs get hyped-up/excited.”¹⁷⁰ The chorus where “move to the back of the bus” was heard clearly had nothing to do with Rosa Parks and the court made this finding.¹⁷¹ Moreover, one of the OutKast members admitted that the song was not about Parks but was a message to OutKast’s competitors.¹⁷²

Thus, under the *Rogers* test, the Sixth Circuit noted that the title was unrelated to the lyrics and, therefore, the song was a “disguised commercial advertisement” or “adopted solely to attract attention.”¹⁷³ The First Amendment did not trump Parks’s Right of Publicity and the lower court decision as to the Right of Publicity claim was reversed and remanded.

OutKast and the other defendants appealed the Sixth Circuit ruling to the U.S. Supreme Court. The Court denied certiorari.¹⁷⁴ The case will now proceed in the U.S. District Court for the Eastern District of Michigan.

B. *Tiger Woods*

Just one month after the *Rosa Parks* decision, a different panel of the Sixth Circuit issued its decision in *ETW Corp. v. Jireh Publishing*.¹⁷⁵

As stated, ETW Corporation is the exclusive licensing agent for the professional golfer Tiger Woods and brought a multi-count cause of action against Jireh Publishing, the publisher of artwork created by Rick Rush.¹⁷⁶ ETW’s complaint, filed in the Northern District of Ohio, alleged a mixture of federal and common law claims: trademark infringement, dilution, unauthorized use of Woods’s likeness, unfair competition, false endorsement, and right to privacy.¹⁷⁷ The Sixth Circuit found in favor of Jireh on all counts. The only relevant claim here is that of the Right of Publicity, although mention of the ruling on the trademark claims is required.

For the trademark infringement claims relating to the use of Woods’s likeness in the painting, the Sixth Circuit found that ETW’s claimed trademark rights in all Woods’s images/likenesses was

170. *Id.* at 452.

171. *Id.*

172. *Id.* at 452-453.

173. *Id.* at 461.

174. *LaFace Records v. Parks*, 124 S. Ct. 925 (2003).

175. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

176. *Id.* at 918.

177. *Id.* at 919.

untenable.¹⁷⁸ According to the court, “[i]mages and likenesses of Woods are not protectable as a trademark because they do not perform the trademark function of designation.”¹⁷⁹ Moreover, the court found that generally, “a person’s image or likeness cannot function as a trademark.”¹⁸⁰ Thus, the claims for trademark infringement of Woods’s image failed.¹⁸¹ This is in direct contrast to the Sixth Circuit finding in *Parks* that Rosa Parks had a protectable right in her name because of her commercial activities and fame. Had the *ETW* court followed *Parks*, it could easily have found Woods’s commercial exploitation of and his fame in his image or likeness provided him with the ability to protect both through trademark law.

With this backdrop, the *ETW* court went on to consider Woods’s Right of Publicity claim. In reviewing this claim, the court noted that the Ohio Supreme Court recognized the Right of Publicity in 1976 in its *Zacchini* decision but found the common law Right of Publicity trumped any First Amendment right the defendant may have had.¹⁸² *Zacchini* was eventually appealed to the U.S. Supreme Court, which overturned the state court decision and held that the First Amendment did not insulate the defendant from liability.¹⁸³ The Ohio courts, according to the Sixth Circuit, have done little since to develop the Right of Publicity since *Zacchini*.¹⁸⁴ Accordingly, the Sixth Circuit looked back to *Zacchini* to determine how the Ohio Supreme Court defined the right in its decision.

The Sixth Circuit found that the Ohio high court had relied heavily on the Restatement (Third) of Unfair Competition in defining the right in *Zacchini*.¹⁸⁵ Moreover, the *Zacchini* decision indicated that the Ohio Supreme Court would “give substantial weight to the public interest in freedom of expression when balancing it against the personal and proprietary interests recognized by the right of publicity.”¹⁸⁶ After a review of various Right of Publicity decisions, including *Memphis Development*, *Carson v. Here’s Johnny Portable Toilets*, *White v.*

178. *Id.* at 922.

179. *Id.*

180. *Id.* The court fails to explain how its holding can be squared with “Colonel Sanders,” “Elvis Presley” and the many, many other federal trademark registrations of the images of particular people.

181. *Id.* at 923.

182. *Id.* at 929.

183. *Id.*

184. *Id.*

185. *Id.* at 930.

186. *Id.* at 931.

Samsung Electronics America, Cardtoons v. Major League Baseball Players Association, and Comedy III, among others, the Sixth Circuit chose to look to Ohio case law and the Restatement to decide “where the line should be drawn between Woods’s intellectual property rights and the First Amendment.”¹⁸⁷ It further decided to apply the transformative elements test the Supreme Court of California adopted in *Comedy III*.¹⁸⁸

In sitting as an Ohio court, the Sixth Circuit determined that “Ohio would construe its Right of Publicity as suggested in the Restatement (Third) of Unfair Competition . . . which articulates a rule analogous to the rule of fair use in copyright law.”¹⁸⁹ This ‘rule’ looks to the substantiality and market effect of the celebrity image “in light of the informational and creative content of the defendant’s use.”¹⁹⁰ To summarize, the Sixth Circuit balanced the celebrity’s market for its image against the informational and creative nature of the use.¹⁹¹ In so doing, the court found in favor of Jireh.¹⁹²

The court also addressed the application of the First Amendment and favorably cited the Tenth Circuit’s decision in *Cardtoons*. According to the Sixth Circuit, Woods generates significant sums of money from his job—playing professional golf.¹⁹³ His primary job is completely unrelated to his Right of Publicity.¹⁹⁴ Moreover, in addition to his income directly generated from his golf game, Woods reaps “substantial financial rewards from authorized appearances and endorsements” and these rewards are unrelated to his Right of Publicity.¹⁹⁵

In considering Rush’s freedom of expression, the court found that Rush “added a significant creative component of his own to Woods’s identity.”¹⁹⁶ Balancing this interest and the societal interest in the First Amendment, the Sixth Circuit concluded “that the effect of limiting Woods’s right of publicity in this case is negligible and significantly outweighed by society’s interest in freedom of artistic expression.”¹⁹⁷

Last, the court finally reached the issue of the transformative nature

187. *Id.* at 931-36.

188. *Id.* at 936.

189. *Id.* at 937.

190. *Id.*

191. *Id.* at 938

192. *Id.*

193. *Id.*

194. *Id.*

195. *Id.*

196. *Id.*

197. *Id.*

of the work. The work at issue did 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 event in sports history and to convey a message about the significance of Woods’s achievement in that event.”¹⁹⁸ The transformative elements of Rush’s work entitled it to the full protection of the First Amendment.¹⁹⁹ The curious reasoning of the court seems to state that the multiple unauthorized uses of *personas* (the collage) created an artistic element to the depiction and thereby provided a First Amendment defense for the infringement of any one of the unauthorized uses.

In a highly critical dissent, Judge Clay stated that he would have reversed the lower court’s judgment, and remanded the case for trial on the Lanham Act and Ohio common law trademark and unfair competition claims.²⁰⁰ With respect to the right of publicity claim, Judge Clay would have reversed and remanded with instructions to enter summary judgment in favor of ETW.²⁰¹

As to Woods’s likeness, Judge Clay notes that ETW was not attempting to protect all images of Tiger Woods, only the one depicted in the painting at issue.²⁰² Judge Clay stated: “contrary to the majority’s contention, the jurisprudence clearly indicates that a person’s image or likeness can function as a trademark as long as there is evidence demonstrating that the likeness or image was used as a trademark; which is to say, the image can function as a trademark as long as there is evidence of consumer confusion as to the source of the merchandise upon which the image appears.”²⁰³ In this particular case, ETW submitted such evidence in the form of a survey showing a high incidence of confusion.²⁰⁴

In reviewing the majority’s holding as to the right of publicity claim, Judge Clay agreed that the correct test is the transformative test set forth in *Comedy III* but argued the majority’s application of that test was incorrect.²⁰⁵

Rush’s print, according to the dissent, “gain[s] [its] commercial value by exploiting the fame and celebrity status that Woods has worked

198. *Id.*

199. *Id.*

200. *Id.* at 938.

201. *Id.*

202. *Id.* at 939.

203. *Id.* at 941-942 (citations omitted).

204. *Id.* at 942.

205. *Id.* at 959.

to achieve.”²⁰⁶ There is nothing transformative about the work, and freedom of speech does not trump the right of publicity.²⁰⁷

These two decisions not only further cloud the field of Right of Publicity law in the various circuit courts, but they also present problems for plaintiffs and defendants in Right of Publicity cases in the Sixth Circuit. Which test will be applied to balance the First Amendment against a celebrity’s Right of Publicity? Is the *Parks* decision limited to titles? Is the *ETW* ruling confined to paintings? The Sixth Circuit has provided practitioners little, if any, guidance on how to protect and enforce a celebrity’s Right of Publicity or on how to defend such an action on First Amendment grounds.

206. *Id.*

207. *Id.*