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**TIGER WOODS LOSES AT AUGUSTA:
COURTS SAY: “RICK RUSH GETS THE GREEN JACKET”
*ETW CORP V. JIREH PUBLISHING, INC.***

Matt Link

INTRODUCTION

This note discusses the court's decision in *ETW Corp., v. Jireh Publishing, Inc.* [EN 1]. In *ETW*, Tiger Woods attempted to stop an artist from selling prints portraying him golfing in the Masters Tournament. Woods' claims were based on trademark law and his right of publicity. The court dismissed his trademark infringement claims ruling that Woods had not exhibited a trademark in the particular image used in defendant's prints. However, this note will primarily focus on the courts rationale regarding Woods' right of publicity claim. The court concluded that defendant's prints merited First Amendment protection because they were neither sports merchandise nor commercial speech [EN 2]. Based on this conclusion, the court ruled that Woods' publicity right claim failed.

This note argues that although the court was correct to rule in favor of defendant, it applied faulty analysis. This note also suggests that the *ETW* decision sets an undesirable precedent for future publicity right claims. Part I describes *ETW* and its rationale. Part II first discusses why *ETW*'s analysis was wrong. It then presents the proper test for analyzing publicity right claims in these circumstances. Finally, Part II applies the balancing test to *ETW* and concludes that Woods' claim still should fail.

II. BACKGROUND

Plaintiff, *ETW Corp.*, sued *Jireh Publishing, Inc.* in a trademark infringement case. *ETW* is the exclusive licensing agent of Tiger Woods. *Jireh* is a publishing company and the exclusive publisher of sports artist Rick Rush [EN 3]. In 1998, *ETW* received registration for the trademark "TIGER WOODS" from the U.S. Patent and Trademark Office [EN 4]. The case arose after Rick Rush created a print of Tiger Woods entitled "The Masters of Augusta" without Woods' consent. The print features Tiger Woods swinging in the center flanked by his caddie and his playing partner's caddie [EN 5]. Only 5,000 of Rush's prints were available worldwide. The parties agreed on the notoriety of Tiger Woods [EN 6].

ETW filed suit in the U.S. District Court for the Northern District of Ohio. *ETW*'s complaint asserted six claims. Counts One through Five were based on the premise that *Jireh* had infringed upon *ETW*'s trademark of Tiger Woods. Count Six alleged that *Jireh* violated Tiger Woods' right of publicity in violation of Ohio common law [EN 7]. Both parties moved for summary and partial judgment on the issues of freedom of speech and expression, lack of customer confusion, and likelihood of confusion [EN 8]. The court granted defendant's motions for summary judgment and the plaintiff's motions were denied. As a result, judgment was entered for the defendant.

The court reasoned that the plaintiff failed to establish the validity of its claim to the trademark rights in the image of Tiger Woods. Although plaintiff had received registration for the trademark "TIGER WOODS," plaintiff did not "demonstrate that it use[d] the image of Tiger Woods, which is used in the defendant's print as a trademark, i.e., an identification source" [EN

9]. As a result, the court concluded that plaintiff's trademark infringement claims, counts One through Five, failed.

However, the focus of this note is on the court's conclusion and reasoning concerning plaintiff's sixth count. Count Six alleged violation of Tiger Woods' right of publicity in violation of Ohio common law [EN 10]. The court dismissed this claim based strictly on its conclusion that defendant's print was an artistic creation seeking to express a message, and was protected by the First Amendment [EN 11].

The court recognized that Ohio common law protects the right of publicity. The court pointed out that "the right of publicity protects the celebrity's pecuniary interest in the commercial exploitation of his identity" [EN 12]. However, the court went on to point out that the right of publicity is limited by the First Amendment [EN 13]. The court explained that "the right of publicity does not authorize a celebrity to prevent the use of her name in an expressive work protected by the First Amendment" [EN 14]. As a result, the court's conclusion focused on whether defendant's print deserved First Amendment protection.

The court began by dismissing plaintiff's argument that defendant's prints were merely sports merchandise and not entitled to First Amendment protection. The court distinguished its case from preceding cases where courts denied First Amendment protection to posters. The court first distinguished its case from *Factors Etc., Inc. v. ProArts, Inc.* [EN 15]. In *Factors*, the court ruled against a defendant who published a poster entitled "In Memory" using a copyrighted photograph of Elvis. ETW argued that the "defendant's artistic prints seeking to convey a message may be distinguished from posters which merely reproduce an existing photograph" [EN 16].

Similarly, the court distinguished its case from *Dallas Cowboys Cheerleaders v. Scoreboard Posters* [EN 17]. In *Dallas Cowboy Cheerleaders*, the court ruled against the defendant, which produced a poster that intentionally parodied another copyrighted poster. Defendant's poster featured partially nude ex-Dallas Cowboys Cheerleaders wearing nearly identical outfits to those in the original poster. There, the court argued that "free expression is enriched by protecting the creations of authors from exploitation by others" [EN 18]. The court in ETW distinguished itself from that case by first stressing that the claim before it involved the right of publicity and not copyright. Also, the court argued that it was not faced with an instance of mere copying of an idea but with a unique expression of an idea [EN 19].

The court next concluded that plaintiff's prints were not commercial speech, which would merit limited First Amendment protection. The court ruled that paintings and drawings are fully protected by the First Amendment [EN 20]. The court concluded that the prints were artistic creations seeking to express a message. The court focused on the fact that the prints were done by Rick Rush who characterized himself as "America's Sporting Artist - Painting America through Sports" [EN 21]. It focused on Rush's narrative that was included with the print. It stated what he wished to express through his art: "As man is valuable, so is what man does, and sports - perhaps more than other activities - reminds us of life's best moments and its brevity in the same instance" [EN 22]. The court concluded that the Supreme Court would find such expression to fall within the ambit of the First Amendment. It pointed out that "visual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection" [EN 23].

Consequently, the court concluded that defendant's prints were neither commercial speech nor sports merchandise. As a result, the court ruled that defendant's prints deserved First Amendment protection and plaintiff's publicity claim failed.

II. ANALYSIS

This section of the note argues that although the court ruled correctly in *ETW*, it applied the wrong test. This section will first critique the test used by the court. It will then present the proper balancing test for analyzing publicity right claims. Finally, this section will explain that applying the balancing test would yield the same result.

A. THE ETW DECISION APPLIED THE WRONG TEST

The court's analysis regarding plaintiff's publicity right claim focused on whether defendant's print was sports merchandise or commercial speech. Once the court determined that defendant's print deserved First Amendment protection, it concluded that plaintiff's publicity right claim failed. This conclusion is flawed for two main reasons. First, the court failed to recognize the importance of publicity rights. It wrongly assumed that the state's interest in protecting First Amendment values automatically trumps the state's interest in protecting publicity rights.

There are strong policy reasons for protecting publicity rights. Morally speaking, an image created by an individual that has an associative value ought to be protected from "free riders." "The rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of goodwill. No social purpose is served by having the defendant get some free aspect of the plaintiff that would have market value and for which he would normally pay" [EN 24]. Therefore, society should not implicitly send the message that people are encouraged to get something for nothing. It would discourage people from working hard to produce uniquely creative works.

Similarly, there are economic reasons for protecting one's publicity rights. The right of publicity is "not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame through the merchandising of the 'name, voice, signature, photograph or likeness of the celebrity'" [EN 25]. Protecting people's economic interests in their identities fosters creativity. If the law protects the value created by people's efforts, they will be encouraged to partake in socially useful tasks. As a result, the court failed to attach sufficient weight to publicity rights when it implied that all First Amendment interests trump publicity rights.

Secondly, the court's reasoning is flawed because it ended its analysis once it determined that defendant's prints were "seeking to express a message" [EN 26]. The court reasoned that defendant's prints were neither sports merchandise nor commercial speech. Therefore, the court concluded that "it appears that the United States Supreme Court would find such expression to fall within the ambit of the First Amendment" [EN 27]. However, the court's analysis should not have ended there. The court's holding sends the message that any work of art, however much it trespasses on the right of publicity and however much it lacks additional creative elements, is categorically shielded from liability by the First Amendment [EN 28].

Following the court's analysis in subsequent cases could produce troublesome results. The court's conclusion suggests that all non-commercial works deserving First Amendment protection are immune from publicity right claims. However, the implication of this rule is that individuals may unfairly exploit a celebrity's image by claiming that their work is expressive although they essentially used the celebrity's image for commercial purposes. The court failed to

foresee instances when society's interest in applying First Amendment protection to particular works would be minimal and outweighed by another's publicity rights.

It is true that courts have awarded First Amendment protection to a wide array of expressions. The fact that expression takes a form of nonverbal, visual representation does not remove it from the ambit of First Amendment protection [EN 29]. Moreover, "the United States Supreme Court has made it clear that a work of art is protected by the First Amendment even if it conveys no discernable message" [EN 30]. Therefore, it is evident that much expression will merit some level of First Amendment protection. However, this should not necessarily lead to the conclusion that the interest in defending First Amendment rights always trumps society's interest in enforcing publicity rights.

B. THE PROPER TEST IS A BALANCING TEST

The ETW court should have implemented a balancing test in its analysis. The proper test for balancing property rights against First Amendment rights was implemented in *Comedy III Productions Inc. v. Gary Saderup Inc.* [EN 31]. In that case, the court ruled that defendant violated plaintiff's publicity rights when he sold lithographs and t-shirts bearing a likeness of The Three Stooges reproduced from a charcoal drawing he had made [EN 32]. The court acknowledged that defendant's portraits of The Three Stooges were expressive works and not an advertisement for or endorsement of a product [EN 33]. Similarly, the court acknowledged that defendant's creations do not lose constitutional protections because they are for purposes of entertaining rather than informing. Additionally, the court stated the fact that defendant's art appeared on t-shirts did not reduce First Amendment protection [EN 34]. However, the court continued, "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" [EN 35].

The court suggested a test in which publicity rights would be balanced against First Amendment concerns. In formulating its test, the court considered similar preceding cases. In *Estate of Presley v. Russen*, [EN 36] the court dismissed defendant's First Amendment defense regarding his Elvis impersonation act. There the court reasoned that the "recognition that defendant's production has some value does not diminish our conclusion that the primary purpose of defendant's activity is to appropriate the commercial value of the likeness of Elvis Presley" [EN 37].

The *Comedy III Productions Inc.* decision also relied on the court's analysis in *Groucho Marx Productions, Inc. v. Day & Night Co.* [EN 38]. There the court rejected a First Amendment defense to defendant's production of a play featuring characters resembling the Marx Brothers. In analyzing the defense, the court posed a dichotomy between "works...designed primarily to promote the dissemination of thoughts, 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 [EN 39].

After recognizing that First Amendment protections may be limited by publicity rights, the court discussed how to distinguish between protected and unprotected expression. The court adopted a version of the copyright law's fair use test by focusing on whether and to what extent the new work is transformative. The court stated that "this 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" [EN 40]. "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 interest of the imitative artist" [EN 41].

The transformative test determines "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" [EN 42]. The court stressed that "when an artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist's right of free expression is outweighed by the right of publicity" [EN 43]. In applying the balancing test, courts should not be concerned with the quality of the artistic expression. Rather the inquiry is more "quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work" [EN 44].

This balancing test would best protect publicity rights without chilling expressive speech that disseminates valuable thoughts and ideas. The test prevents individuals from misappropriating the economic value generated by a celebrity's fame through the merchandising of the name, voice, signature, photograph or likeness of the celebrity [EN 45]. Celebrities and athletes such as Tiger Woods work hard to both become successful at their trade and to create favorable public images. The economic value attached to their images should be adequately protected against unauthorized exploitation.

The fact that some legislatures have enacted publicity right statutes reflects society's interest in protecting intellectual property from unauthorized exploitation. In *ETW*, the plaintiff's publicity right claim was based on common law. That publicity rights originate in common law and statutes should not necessarily subordinate them to First Amendment rights. An amici curiae brief in support of the *ETW* defendant argued, "the right of publicity is merely a narrow limitation that applies to false and misleading advertisements" [EN 46]. This is untrue because the rationale for publicity rights is more expansive. Publicity rights are interested in protecting individuals from having the fruits of their labor unfairly exploited by others for purely economic purposes. Furthermore, the state has a legitimate interest in protecting unauthorized exploitation of another's image. The reality is that this right can potentially conflict with the First Amendment. Protecting publicity rights can potentially frustrate freedom of speech and expression guaranteed by the First Amendment. Balancing the two interests is the sensible method of resolving the conflict.

The balancing test would not significantly restrict First Amendment rights. The court would not be forced to evaluate the expressive value of a work to determine whether and to what extent a work is transformative. Rather, courts could quantitatively determine whether the author added significant elements to the celebrity's image. Furthermore, the balancing test would not give a celebrity the right to absolutely control his/her image by censoring disagreeable portrayals. Rather, the right of publicity is essentially an economic right [EN 47]. Its application would be limited to instances where defendants misappropriate the economic value generated by a celebrity's fame by distributing insufficiently transformative works.

It would be unwise to conclude that all expression that trenches on the right of publicity receives First Amendment protection. That conclusion would significantly dilute the potency of publicity rights. Individuals should not be allowed to hide behind the First Amendment when their work's marketability and economic value derives primarily from the celebrity depicted. This

would allow people to unfairly exploit another's image by adding minimal creative effort to their work. Therefore, the proper analysis should balance the First Amendment with publicity rights by determining whether a work is sufficiently transformative. A sufficiently expressive work "must contribute something more than a merely trivial variation, but must create something recognizably his own" [EN 48].

C. APPLYING THE BALANCING TEST TO ETW

This note has critiqued the analytical framework used by the court in ETW. However, the court came to the proper conclusion. In applying the balancing test to ETW, it is evident that defendant's prints deserve First Amendment protection.

The items at issue are prints of paintings done by Rick Rush, who characterizes himself as "America's Sporting Artist - Painting America through Sports" [EN 49]. Rush's print portrays Tiger Woods, his caddie and his playing partner's caddie. Plaintiff's prints are not commercial speech; they are not an advertisement for or endorsement of a product. Rather, they are expressive works that are entitled to full First Amendment protection. Additionally, although the prints were done for financial gain, "the First Amendment is not limited to those who publish without charge" [EN 50]. Therefore, it is necessary to balance the First Amendment with plaintiff's publicity rights.

It cannot be said that the interest in defending plaintiff's publicity rights outweighs the value of defendant's free expression. The balancing test demands that the court determine whether and to what extent the defendant's work is transformative. Defendant's prints contain a creative expressive element, which supports the conclusion they are sufficiently transformative.

First, defendant's works are sufficiently transformative because Rush used them to convey a particular message. Defendant's prints are the type of works "designed primarily to promote the dissemination of thoughts, ideas or information," which would receive First Amendment protection [EN 51]. Defendant's prints reminded people of Woods' skill, focus, determination and sportsmanship that led to his victory at Augusta. Rush's creations were different from those considered in *Comedy III Productions Inc.*. In *Comedy III Productions Inc.*, defendant merely reproduced the likenesses of The Three Stooges on t-shirts, while conveying no discernable message. In ETW, however, the defendant uniquely portrayed Tiger Woods as he triumphantly conquered Augusta. The title of the print is "The Masters of Augusta," which strengthens defendant's argument that the prints "express the majesty of a newsworthy moment" [EN 52]. Furthermore, Rush included a narrative with the prints that explained what he wished to express. Rush stressed that sports "reminds us of life's best moments and its brevity in the same instance" [EN 53]. Therefore, Rush's print does more than merely reproduce Woods' image to sell his work. Woods' image was used to express a transcendent message of sports' significance in society.

Secondly, defendant used Woods' image only as one of the raw materials to create the prints. The prints are not merely literal depictions of Woods. Rather, they are artistic creations expressing the "majesty of the moment" when Woods played in the Masters Tournament at Augusta [EN 54]. Rush added his own creative instinct to formulate a work that conveyed the brilliance of Woods' performance at Augusta. Rush's prints have uniquely become his own even though they utilize Tiger Woods' image. Rush's expressed his view that Tiger Woods' presence at Augusta was of great significance to the sporting world. The prints have a meaning exceeding that which could be achieved by a mere literal depiction of Woods.

Furthermore, the marketability and economic value of the prints do not derive primarily from Woods. Rather, several other factors increased the marketability and economic value of the prints. Rush expected his authorship to increase public demand for the prints. He describes himself as "America's Sporting Artist - Painting America through Sports" thereby elevating the importance of works creating by him. Rush treats himself as a serious artist claiming that he wants to "give America serious art" on sports subjects. Similarly, the prints contained a limited edition certificate verifying that only 5,000 were available worldwide. These facts indicate that the prints are not merely simple reproductions of Woods that depend primarily on his image for value and marketability. Rather, Rush considers himself a reputable artist whose unique expression of sporting subjects creates independent value.

Therefore, in applying the balancing test to ETW, it is evident that the plaintiff's publicity interests do not outweigh the value of defendant's free expression. This is not one of those circumstances where the primary purpose of a defendant's activity is to appropriate the commercial value of a celebrity. Rather, defendant's prints add significant transformative elements to Woods' image that made the prints uniquely his own creation.

III. CONCLUSION

Although this note concludes that the value of defendant's free expression outweighs plaintiff's publicity rights, one should not underestimate the danger of strictly applying ETW's analysis. ETW's apparent holding, that any work of art, however much it lacks additional creative elements, [EN 55] is categorically shielded from liability by the First Amendment, would produce undesirable results in future cases. It encourages people to copy rather than create. Furthermore, it trivializes society's interest in preventing people from misappropriating economic value earned by others.

[EN 1] ETW Corp., vs. Jireh Publ'g Inc., 99 F. Supp. 2d 829 (N.D. Ohio 2000).

[EN 2] *Id.*

[EN 3] *Id.*

[EN 4] *Id.*

[EN 5] *Id.*

[EN 6] Woods is one of the world's most well-known professional golfers, being the youngest ever to win the U.S. Junior Championship and the only player to win this title three times. He also became the youngest-ever winner of the U.S. Amateur Championship and the first player to win this title in three consecutive years. In the years 1991 through 1994 several golf magazines named Tiger Woods to such distinctions as 'player of the year.' Tiger Woods became a full-time professional golfer in 1996, winning two Professional Golf Association (PGA) tour events that year and was named 'Sportsman of the Year' by Sports Illustrated magazine. In 1997, Tiger Woods won the masters Tournament, becoming the youngest player to do so. That year he won six PGA Tour events, was named PGA Tour Player of the year and became the first champion of a major PGA Tour event of either African or Asian heritage.

Id. at 830.

[EN 7] *Id.* at 830-31.

[EN 8] *Id.* at 830.

[EN 9] *Id.* at 832.

[EN 10] *Id.* at 834.

[EN 11] *Id.* at 835.

[EN 12] *Id.* at 834.

[EN 13] *Id.*

[EN 14] *Id.*

[EN 15] *Factors Etc., Inc. v. ProArts. Inc.*, 579 F.2d 215 (2nd Cir. 1978).

[EN 16] *ETW*, 99 F. Supp. 2d at 835.

[EN 17] *Dallas Cowboy Cheerleaders v. Scoreboard Posters*, 600 F.2d 1184 (5th Cir. 1979).

[EN 18] *Id.* at 1187.

[EN 19] *ETW*, 99 F. Supp. 2d at 835.

[EN 20] *Id.*

[EN 21] *Id.*

[EN 22] *Id.*

[EN 23] *Id.* at 836.

[EN 24] *Comedy III Prod. Inc. v. Gary Saderup Inc.*, 21 P.3d 797 (2001).

[EN 25] *Id.* at 807.

[EN 26] *ETW*, 99 F. Supp. 2d at 829.

[EN 27] *Id.* at 835.

[EN 28] *Comedy III Prod. Inc.*, 21 P.3d at 809.

[EN 29] *Id.* at 804.

[EN 30] *Id.*

[EN 31] *See Id.*

[EN 32] *Id.* at 804.

[EN 33] *Id.* at 802.

[EN 34] *Id.* at 804.

[EN 35] *Id.*

[EN 36] *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).

[EN 37] *Id.* at 1360.

[EN 38] *Groucho Marx Prod., Inc. v. Day & Night Co.*, 523 F. Supp. 485, rev'd on other grounds (S.D.N.Y. 1982).

[EN 39] *Id.* at 492.

[EN 40] *Comedy III Prod.*, 21 P.3d at 808.

[EN 41] *Id.*

[EN 42] *Id.* at 809.

[EN 43] *Id.* at 810.

[EN 44] *Id.* at 809.

[EN 45] *Id.* at 807.

[EN 46] Brief of Amici Curiae Reporters Committee for Freedom of the Press and the Society of Professional Journalists at 2, *ETW*, 99 F. Supp. 2d at 829.

[EN 47] *Comedy III Prod.*, 21 P.3d at 807.

[EN 48] *Id.* at 810.

[EN 49] *ETW*, 99 F. Supp. 2d at 829.

[EN 50] *Comedy III Prod.*, 21 P.3d at 802.

[EN 51] *Id.* at 807.

[EN 52] *ETW*, 99 F. Supp. 2d at 830.

[EN 53] *Id.* at 835.

[EN 54] *Id.* at 834.

[EN 55] *Comedy III Prod.*, 21 P.3d at 809.