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JUST SHORT OF THE GREEN: SIXTH CIRCUIT AND THE RIGHT OF PUBLICITY

Jennifer M. Karrels

INTRODUCTION

This question is approached differently in each state in our country. The United States Constitution is silent on the right of publicity. [EN 1] Consequently, states have independently developed laws that encompass publicity rights. These rights, similar to other intellectual property rights, seek to protect one's investments in people, especially people who achieve celebrity status. [EN 2] While there is no single definition of the right of publicity, all definitions center on the question "who has the right to enjoy the values inhering in a person's individual characteristics, the celebrity or the public at large?" This question creates tension between a state right of publicity and the U.S. Constitution's First Amendment. Artists, like Rick Rush, need to know what is and is not 'fair game' to use as a basis in their art. One must ask, when an artist is inspired, must he run to a lawyer first to make sure he is able to paint his inspiration? "Journalists and artists must be able to use an image with confidence, knowing exactly the scope of the right of publicity." [EN 3] For this reason, federal legislation is needed to resolve the tension because while a celebrity's publicity rights should not invalidate another's constitutionally protected rights, one should not be able to 'cash in' on another's investment.

II. BACKGROUND

While the right of publicity consists of different factors in each state, the fundamental principle encompasses a quasi-intellectual property right that seeks to protect an investment in a person. This right, however, must be balanced with the U. S. Constitution's First Amendment, allowing freedom of speech and press. Controversy has arisen in striking a balance between these competing interests, specifically between celebrity and public rights. Federal legislation is needed. This is illustrated in the application of the principle of the right of publicity in the Sixth Circuit and California, as seen in *ETW Corporation v. Jireh Publishing* [EN 4] and *Comedy III Productions, Inc. v. Saderup*. [EN 5]

A. ETW Corporation v. Jireh Publishing

In 2000, ETW Corporation ("ETW"), the exclusive licensing agent of Tiger Woods ("Woods"), sued Jireh Publishing ("Jireh") under the Lanham Act, [EN 6] claiming that the sale of a painting's print by Rick Rush ("Rush") of Woods infringes on their trademark. Wood's fame is undisputable, being that he has been named 'player of the year, 'Sportsman of the Year' and 'PGA Tour Player of the Year.' He is a role model to many as the first champion of a major PGA Tour event of either African or Asian heritage. He holds a significant place in golf's history.

ETW holds the trademark 'Tiger Woods' for art prints, calendars, mounted photographs, notebooks, pencils, pens, posters, trading cards, and unmounted photographs. [EN 7] Jireh is the exclusive publisher of Rush's artwork. Rush is a well known 'sports artist' who has painted portraits of many greats such as Michael Jordan. [EN 8] Rush painted 'The Masters of Augusta'

which, according to the narrative that accompanies the print, features Woods “displaying that awesome swing” and “flanked by his caddie and final round player's caddie.” [EN 9] The painting was reproduced and 5,000 were available for sale as a limited edition print. [EN 10]

The court, in adopting the Sixth Circuit position, held for Jireh, stating, “ETW has failed to establish the validity of its claim to trademark rights in the image of Woods.” [EN 11] The court reasoned that ETW does not use a consistent image of Woods as a trademark as seen in their sale of six different depictions of him, therefore it does not hold trademark rights to his image. [EN 12] Furthermore, the court gave the right of publicity a narrow meaning and stated, “Jireh's print was an artistic creation seeking to express a message and was protected under the United States Constitution's First Amendment.” [EN 13]

C. Comedy III Productions, Inc. v. Saderup

In 2001, the California Supreme Court decided the ‘Three Stooges case.’ The plaintiff, as the registered owner of the deceased comedians' rights, sued an artist for infringement of those rights. The artist sold lithographs and T-shirts with the likeness of the Three Stooges, which he reproduced from his own original charcoal drawing. The artist's profits from the unlicensed sale exceeded \$75,000. The Court, in holding for the plaintiff, established a balancing test between the First Amendment and the right of publicity. [EN 14] This test asks if the work “adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.” [EN 15] While the works here were expressive non-advertisements, entitled to First Amendment protection, they amounted to nothing more than mere depictions of celebrities created solely for profit. [EN 16] In this case, the right of publicity trumped the First Amendment.

III. ANALYSIS

The obvious contradiction in state law, illustrated in the above cases, demonstrates that a case's holding will be determined, not on the art or the celebrity, but rather on where the lawsuit has been filed. Ohio, part of the Sixth Circuit, which aided in deciding *ETW*, recognizes a common law right of publicity which seeks to protect the celebrity's pecuniary interest in the commercial exploitation of his identity. [EN 17] However, Ohio has severely limited the right with the First Amendment. [EN 18] The Circuit reasoned that the common law right of publicity, which protects creations of authors from exploitation of others, is trumped by the constitutional protection of the people's freedom of speech and press. [EN 19] On the other hand, the California Supreme Court, which decided *Comedy III*, has developed a broader right of publicity that more accurately reflects our society's values. This model should be used in developing federal legislation to reflect trends in our society.

A. Significance of the Right of Publicity

The right of publicity, a quasi-intellectual property right, protects one's investment in people.

Often considerable money, time, and energy are needed to develop one's prominence in a particular field. Years of labor may be required before one's

skill, reputation, notoriety, or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion. For some, the investment may eventually create considerable commercial value in one's identity. [EN 20]

While *Comedy III* discusses Moe and Jerome Howard and Larry Fein's (a.k.a. "The Three Stooges") "creative labor," [EN 21] the same can be said of many other celebrities. Many actors literally live in their cars when they first arrive in Hollywood hoping to make a name for themselves. They attend numerous auditions and are rejected many times before they ever land a part. Even then they still struggle to retain their reputation or reinvent themselves. The purpose of this right, as in all intellectual property rights, is to encourage individuals to take risks and make personal sacrifices by providing them with monetary incentives.

The Florida court in *Gridiron.com, Inc. v. National Football League Player's Association*, [EN 22] further emphasized the importance of this right by applying it to entertainment-related contractual obligations.

The public interest is well served when the court protects those with valid, valuable exclusive rights of publicity and protects those contractual relations. Additionally, it would be unfair to allow a party to infringe on another's exclusive licensing rights to a celebrity, when that agreement was freely made. [EN 23]

Woods, like most other celebrities, has contracted with a licensing agent, ETW. ETW has contracted with Nike, a licensee, to sell posters and other products featuring Woods.

The United States Supreme Court has also spoken on the right of publicity's importance. In *Zacchini v. Scripps-Howard Broadcasting Co.*, [EN 24] the Court analyzed the tension between the right of publicity and the First Amendment. The case involved a television broadcast of the plaintiff's entire act without consent; the Court stated that had the television station merely reported that the plaintiff was performing at the fair and described or commented on his act, with or without showing his picture on television, we would not have a case. [EN 25] The broadcast went beyond the reporting of a newsworthy event. The Court stated,

the rationale for protecting the right of publicity is to prevent 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. [EN 26]

B. Model for Right of Publicity Federal Legislation

California, a part of the controversial Ninth Circuit, is a leader among states in regard to new legislation. California's right of publicity states "it is the right of any person to prevent others from using their identity for commercial purposes." [EN 27] To succeed on a claim, a plaintiff must show: (1) the defendant's use of the plaintiff's identity; (2) the appropriation of the plaintiff's name, likeness, or distinguishing characteristics to the defendant's advantage, usually commercial; (3) lack of consent; and (4) resulting injury. [EN 28]

However, California has created exclusions for works with "a use in connection with any news, public affair, sports broadcast or account, or political campaign," or "use in a commercial

medium.” The statute further provides “a play, book, magazine, newspaper, musical composition, film, radio, or television program” as a work of “political or newsworthy value,” “single and original work of fine art” or “an advertisement or commercial announcement” is exempt from the provisions of the statute. [EN 29]

As seen in *Comedy III*, the dominant attribute of the artwork must be the artistic expression. “Entertainment 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.” [EN 30] In applying aspects of the fair use doctrine, [EN 31] an inquiry into the artist's purpose and the nature of his/her work should be made. One may ask: (1) Is the work produced for profit or for educational purposes? (2) How did the artist produce the piece? If it is a drawing or painting, did he/she copy a photograph or sketch at a public event? (3) What was the artist's intent? The fair use doctrine also questions the effect of the use upon the potential market for or value of the copyrighted work. (1) Does the work interfere with the celebrity's similar products? (2) What market is the artist addressing and where is he/she selling his works? While the fair use doctrine factors may be difficult to access, they may be used merely as a guide in the application of the transformative test described in *Comedy III*.

The transformative test asks whether the “celebrity likeness is one of the raw materials from which the original work is synthesized or whether the depiction or imitation of the celebrity is the very sum and substance of the work?” [EN 32] Has the work become so transformed that it is the artist's own expression rather than the celebrity's likeness? [EN 33] Does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted or does the value of the work come from the creativity, skill, and reputation of the artist? [EN 34] The courts, however, are not to be concerned with the actuality of the artistic contribution, just that the creative elements predominate in the work. [EN 35]

Just as lines are drawn in First Amendment protection, lines need to be drawn in the right of publicity protection. The questions stated previously can be used to help draw these lines. Furthermore, the right of publicity cannot be used to control the celebrity's image by censoring disagreeable portrayals. [EN 36] It is an economic right, which can only be used 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 37]

C. Application of the Model Right of Publicity to the ETW Case

Using the suggested model of the right of publicity, the *ETW* court should have determined that Rush's reproductions were not “original single works of art” and that his work was a “commercial enterprise” seeking profit from the likeness of Woods. However, as protected under the First Amendment, Rush may attend a public event, such as the Masters Tournament, and paint a picture depicting that event. However, it is not legal for Rush to then mass-produce the painting and sell it for profit without permission from the trademark holder.

While Jireh claims that this is an artistic expression, most consumers will buy the reproduction because it is of Woods, not because Rush painted it. This is similar to the idea that many entertainment magazines pay celebrities to be on their covers because they know they will sell more magazines with a Dennis Rodman cover, rather than a picture of a basketball court. That is what sells in today's society. Furthermore, by reproducing the “artistic expression” and selling it as a print, the work became “merely sports merchandise” not entitled to First Amendment protection. [EN 38]

Woods does not seek to withdraw his image from the marketplace of ideas in our society from which writers, artists, commentators, and others look for inspiration. [EN 39] He just does not want others to ‘cash in’ on his hard work. This does not necessarily chill free speech. It would just require artists to take one step further and gain permission or pay a fee before seeking to sell their art for profit. [EN 40]

IV. CONCLUSION

The right of publicity seeks to answer “who has the right to enjoy the values inhering in a person's individual characteristics, the celebrity or the public at large?” Federal legislation is needed to prioritize this right with First Amendment rights. Our society has taken an interest in celebrities, especially sports figures.

They are the leading players in our public drama. We tell tales, both tall and cautionary about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles, and their modes of conversation and of consumption. Whether or not celebrities are the chief agents of moral change in the United States, they certainly are widely used to symbolize individual aspirations, group identities, and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation. [EN 41]

This important image is the one that the right of publicity seeks to protect by controlling its commercial exploitation. Intellectual property rights are intended to grant valuable, enforceable rights in order to afford greater encouragement to the production of works of benefit to the public. Similarly, the right of publicity seeks to protect the entertainer's incentive in order to encourage the production of this type of work, whether it is as a golfer or comedy trio. Protecting this image gives an incentive to those seeking to become a celebrity, thereby giving our society more role models from which to help define our culture.

[EN 1] Vincent M. de Grandpre, *Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity*, FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73, 80 (2001) (discussing the right of publicity, as a quasi-intellectual property right, that protects one's investment in people). California's right of publicity will be further defined in this comment.

[EN 2] *Id.* at 80 (“[E]veryone, not only celebrities, has a right of publicity. Because of the economics of litigation, however, mostly celebrities are likely to rely on it.”) (quoting Thomas McCarthy, *The Rights of Publicity and Privacy* § 1:3, 4.1, 4.3, at 4-5 to 4-7 (2d ed. 2001))).

[EN 3] Brief of Amici Curiae Reporters Committee for Freedom of the Press and Society of Professional Journalists, at 1, *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000) (No. 00-3584).

[EN 4] *ETW Corp.*, 99 F. Supp. 2d at 829.

[EN 5] *Comedy III Prod., Inc. v. Saderup*, 25 Cal. 4th 387, 21 P.3d 797 (2001).

[EN 6] *ETW Corp.*, 99 F. Supp. 2d at 830 (plaintiff sued under the Lanham Act, 15 U.S.C.S. § 1114, 1125 (a), (c)). “The Lanham Act is a federal trademark statute, enacted in 1946, that provides for a national system of trademark registration and protects the owner of a federally registered mark against the use of similar marks if any confusion

might result. The Lanham Act's scope is independent of and concurrent with state common law." (quoting Black's Law Dictionary 709 (7th ed. 1999)).

[EN 7] *ETW Corp.*, 99 F. Supp. 2d at 830.

[EN 8] *Id.*

[EN 9] *Id.*

[EN 10] *Id.*

[EN 11] *Id.* at 832-33.

[EN 12] *Id.*

[EN 13] *Id.* at 834-36.

[EN 14] *Comedy III Prod., Inc.*, 25 Cal. 4th at 403-07, 21 P.3d at 807-09.

[EN 15] *Id.*

[EN 16] *Id.* 407-08, 21 P.3d at 810.

[EN 17] *ETW Corp.*, 99 F. Supp. 2d at 834.

[EN 18] *Id.*

[EN 19] *Id.* at 829 (discussing the limits on the right of publicity by the First Amendment).

[EN 20] *Comedy III Prod., Inc.*, 25 Cal. 4th at 399, 21 P.3d at 804-05 (citing *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425 (1979) (Bird, C.J., dissenting)).

[EN 21] *Comedy III Prod., Inc.*, 25 Cal. 4th at 399-400, 21 P.3d at 804-05.

[EN 22] *Gridiron.com, Inc. v. Nat'l Football League, Player's Ass'n., Inc.*, 106 F. Supp. 2d 1309 (S.D. Fla. 2000).

[EN 23] *Id.* at 1316.

[EN 24] *Comedy III Prod., Inc.*, 25 Cal. 4th at 400-01, 21 P.3d at 805-06 (citing *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977)).

[EN 25] *Id.*

[EN 26] *Id.* (quoting *Zacchini*, 433 U.S. at 562).

[EN 27] de Grandpre, *supra* note 1, at 80.

[EN 28] *Id.*

[EN 29] *Comedy III Prod., Inc.*, 25 Cal. 4th at 392-93, 21 P.3d at 800.

[EN 30] *Id.* at 402 (discussing *Estate of Presley v. Russen*, 513 F. Supp. 1339 (1981)).

[EN 31] *Id.* at 404-06 (discussing the "fair use doctrine", 17 U.S.C § 107, and its application to the right of publicity).

[EN 32] *Id.* at 406.

[EN 33] *Id.*

[EN 34] *Id.* at 407.

[EN 35] *Id.*

[EN 36] *Id.* at 403.

[EN 37] *Id.*

[EN 38] *ETW Corp.*, 99 F. Supp. 2d at 834.

[EN 39] Brief of Amici Curiae, *supra* note 3, at 1 (discussing what Woods seeks to do).

[EN 40] *Id.* at 1 (discussing Woods' beliefs).

[EN 41] *Comedy III Prod., Inc.*, 25 Cal. 4th at 397, 21 P.3d at 803.