

COMMENT

EVERYONE'S A CRITIC: TIGER WOODS, THE RIGHT OF PUBLICITY AND THE ARTIST*

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I. INTRODUCTION

John Wilson has just brought his son Billy to his first sport card show. The two walk among all displays, but only the bright poster of Tiger Woods catches both of their eyes. John asks Rick, the vendor and creator of the poster, how much the poster costs. Fifteen dollars, well that is not so bad. Billy, being a Tiger Woods fan, nudges his Dad to buy the print. John relents and both walk away happy. Would you ever guess that Rick, the vendor, would be sued by Tiger Woods for misappropriating Woods' image? If not, guess again.

American professional sports generate billions of dollars in revenue¹ allowing sports stars to profit millions from their multi-year contracts and endorsement deals.² With these arrangements, the athletes prosper—as does the booming sports memorabilia trade.³ Because of the high financial stakes inherent in professional sports, teams and athletes often litigate any encroachment on their apparent property right.⁴ Thus, it should not surprise Alabama sports artist Rick Rush that he

1. See PAUL C. WEILER & GARY R. ROBERTS, *SPORTS AND THE LAW* 390 (2d ed. 1998) (noting that NFL merchandise sales total \$3.5 billion). The enormous value of such teams derives itself from radio, cable, television, and pay-per-view programming. By 1998, the NFL's television contracts generated \$2.2 billion. The NBA's contracts totaled \$600 million; Major League Baseball garnered \$350 million while the NHL captured \$45 million from broadcasting rights. See *id.* at 389 (illustrating that in the 1960s the "vast majority" of sports revenue came from fans attending live games and how this support, a supplement to media income, in the form of luxury boxes, club seats, and personal seat licenses continues to extract even more money from willing fans). In addition to broadcasting revenues, sports teams generate billions more in "licensing the use of team names and logos on merchandising." See *id.* at 390. Further, of the \$70 billion merchandising industry, approximately \$15 billion has this "sports connection." *Id.*

2. See *id.* at 390 (estimating that Michael Jordan's \$33 million contract for the 1997-98 season fell short of the \$45 million he received for various endorsement deals); John Gibeaut, *Image Conscious*, 85 A.B.A. J., June 1999, at 47 (stating that in 1997, Tiger Woods earned \$24 million in endorsements, trailing only Michael Jordan, who nabbed \$47 million in endorsement deals).

3. *'First-Sale' Doctrine Applies to Right to Control Publicity*, 11th Cir. Rules, INTELL. PROP. LITIG. REP., Mar. 25, 1998, at 9 (emphasizing that if the first-sale doctrine does not apply to celebrities, then the \$2 billion "sports trading card and memorabilia industry" would be "profoundly" affected).

4. See Gibeaut, *supra* note 2, at 47 (detailing both the federal and state trademark claims filed by Tiger Woods' licensing agency, ETW Corp., against Rick Rush and noting that "Woods joins a growing list of star athletes and other celebrities . . . who are becoming increasingly aggressive in using the courts to keep others from cashing in on their famous names").

could raise a sports star's ire when appropriating the celebrity's image.⁵ Tiger Woods, the famous young American golfer, through his "Ohio-based licensing" company, ETW Corp., has sued Rush's publishing firm, claiming the artist has improperly profited from Tiger's likeness.⁶ ETW claims that Rush, who had previously sold his sports oriented works for twenty-three years,⁷ decided to depict Tiger Woods in his "historic" win at the 1997 Masters golf tournament.⁸ However, he did not just offer to sell one painting;⁹ Rush offered 250 serigraphs (silk-screens) for \$700 each and 5000 lithographs for \$15 each.¹⁰ Had Rush sold all his wares he would have generated \$250,000 in sales.¹¹ Not surprisingly, Woods' representatives have asked the courts to destroy all of Rush's prints and to award them triple damages from any of Rush's sales.¹² They seek this compensation through state right of publicity laws and the Federal Lanham Act.¹³ Contrary to ETW's wishes, the United States District Court for the Northern District of Ohio ruled that Rush's use of Tiger Woods' image was protected under the First Amendment.¹⁴ At first glance, this might seem like a classic David versus Goliath scenario—the already wealthy celebrity crushing the artist's right of expression.¹⁵ But, a closer inspection could lead to the opposite

5. See Ron Sirak, *Tiger Woods' Lawsuit Against Franklin Mint Settles*, THE LEGAL INTELLIGENCER, Apr. 22, 1998, at S6 (noting that Tiger Woods received a substantial monetary settlement and a permanent injunction against the Franklin Mint).

6. See Gibeaut, *supra* note 2, at 47 (listing other celebrity actions based on the right of publicity, such as Dustin Hoffman's \$3 million award against *Los Angeles Magazine* for placing a photo of his head on a model's body).

7. See *id.* (reporting Rush's belief that his creations are not "commercial" but rather fine works of art).

8. See *id.* (describing the controversial painting as a "depiction of Tiger Woods' historic 1997 Masters win, set against a montage of other legends from golf's most storied event").

9. See Marcia Chambers, *Lawsuit Pits Artists' Rights vs. Athletes*, N.Y. TIMES, Feb. 16, 1999, at D1.

10. See *id.* (noting that Rush produces prints through his company Jireh Publishing).

11. This figure seems large enough to rebut Rush's claim that he is not in the "commercial" business of selling the "T-shirts, the mugs, [or] the caps." See Gibeaut, *supra* note 2, at 47 (stating Rush's view that he remains only a fine artist).

12. See *id.* at 47-48 (noting that ETW seeks treble damages, which could amount to \$750,000, and that Rick Rush fears that such a judgment could "put him out of business").

13. See *id.* at 47.

14. See *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829, 835-36 (N.D. Ohio 2000) ("[T]he print at issue herein is an artistic creation seeking to express a message. The fact that it is sold is irrelevant to the determination of whether it receives First Amendment protection.").

15. See Chambers, *supra* note 9, at D1 (stating that Dennis J. Niermann, Rush's attorney, describes the lawsuit as "predatory" in its effect on the company's resources).

conclusion that Tiger Woods and his celebrity peers might not be cold-blooded profiteers after all.

Some commentators argue that Rush, and others like him, leech off the talents of the famous while failing to add any new or important ideas to constitutionally protected societal discourse.¹⁶ Besides the content of Rush's work, there remains a strong practical argument in favor of Woods' position: if Rush defends himself successfully, arguably no one would need to get a license from Tiger Woods or any other celebrity in order to market posters or pictures. In that case, the artist could paint her own creation, market it, distribute it, and all the while claim that she was fully exploring her own artistic vision.¹⁷

In contrast, a difficult question remains of whether society would benefit from judicial art critics deciding which art adds to societal commentary and which art does not.¹⁸ This discretion may inevitably lead to some art forms and artists truly being prevented from their expression simply because the work does not fit in with what a judge thinks constitutes art.

This comment will explore the right of publicity claim, while applying the facts from Woods' lawsuit, and discuss the artist's right of expression, production, and commerce from a celebrity's image. Further, it will propose a set of factors to aid courts in making the determination of who should prevail—the artist or the celebrity.

16. See *infra* notes 64–68 and accompanying text (explaining the “reap the fruits of their labors” justification for the right of publicity); George Vetter & Christopher C. Roche, *The First Amendment and the Artist-Part II*, 44 R.I.B.J. 9, 39 (1996) (explaining that courts have held that a “parody or satirical use of a trademark in a context not primarily for selling products” is non-actionable); see also L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987) (holding that *High Society* magazine's parody L.L. Bean's Back-to-School-Sex Catalog, filled with nude models, did not violate trademark law), *cert. denied*, 483 U.S. 1013 (1987).

17. See Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 178 (1993) (listing some justifications for this argument, including the moral right to one's image, the economic incentive the right of publicity brings, and consumer protection). Compare *id.* at 196 (stating that “[i]n judicial opinions and law reviews, right-of-publicity defendants are often described as ‘poachers,’ ‘parasites,’ ‘pirates,’ or ‘free riders’”), with *Onassis v. Christian Dior-N.Y., Inc.*, 472 N.Y.S.2d 254, 261 (N.Y. Sup. Ct. 1984) (“Let the word go forth—there is no free ride. The commercial hitchhiker seeking to travel on the fame of another will have to learn to pay the fare or stand on his own two feet.”).

18. See, e.g., A. Michael Warnecke, Note, *The Art of Applying the Fair Use Doctrine: The Postmodern-Art Challenge to the Copyright Law*, 13 REV. LITIG. 685, 723–24 (1994) (arguing that the court in *Rogers v. Koons*, 960 F.2d 301, 309–10 (2d Cir. 1992) imposed restrictions on an artist's ability to parody by not allowing artist Jeff Koons to parody a copyrighted photograph in a general sense, but in essence demanded specific parodies and satire to escape liability).

II. THE RIGHT OF PUBLICITY

A. *Historical Development*¹⁹

“Celebrities” or famous persons, throughout history, have been subject to commercial exploitation of their names and/or likenesses.²⁰ For example, in the late 18th century, an English entrepreneur named Josiah Wedgwood reproduced the likenesses of famous men, such as Voltaire and Rousseau, on household wares and medallions that he manufactured.²¹ Even Benjamin Franklin experienced an almost perverse commercialization of himself on his visit to France.²² French entrepreneurs plastered his face on medallions, snuffboxes, rings, clocks and even a chamber pot.²³ Certainly, this attention parallels any annoyances experienced by modern celebrities.²⁴ Franklin, however, found this inconvenience to be the price of fame and did not begrudge others the profits made by selling his likeness without his

19. Celebrities have not, until recently, demanded a property right in their names or likenesses. See Madow, *supra* note 17, at 147 (quoting Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954), in that the right of privacy did not “satisfactorily meet[] the needs of Broadway and Hollywood in 1954”).

20. It remains important to note that the basis of fame has changed throughout the years. See *id.* at 150–51 (discussing how fame was originally based on civic virtue and other intrinsic “final good” and not on any quest for power, sex, money or explicit adulation).

21. See *id.* at 148 (noting that these portraits were an immediate success with the public at large, outselling his tea service business, which was how he first made his wealth, and that the portraits were an inspiration for other English “entrepreneurs” as well).

22. Benjamin Franklin, ambassador to France in 1776, described his reactions to such reproductions of himself:

The clay medallion of me you say you gave to Mr. Hopkinson was the first of the kind made in France. A variety of others have been made since of different sizes; some to be set in lids of snuff boxes, and some so small as to be worn in rings; and the numbers sold are incredible. These, with the pictures, busts, and prints, (of which copies upon copies are spread every where) have made your father's face as well known as that of the moon, so that he durst not do any thing that would oblige him to run away, as his phiz would discover him wherever he should venture to show it. It is said by learned etymologists that the name Doll, for the images children play with, is derived from the word IDOL; from the number of dolls now made of him, he may truly be said, in that sense, to be i-doll-ized in this country.

Madow, *supra* note 17, at 149 (quoting MR. FRANKLIN: A SELECTION FROM HIS PERSONAL LETTERS 45, 45–46 (Leonard W. Labaree & Whitfield J. Bell, Jr. eds., 1956)).

23. See *id.* (stating that Louis XVI found the whole situation so “excessive” that he gave one of the chamber pots to one of Franklin's “devoted female admirers”).

24. See, e.g., Gibeaut, *supra* note 2, at 47 (listing the supposed wrongs that the Tiger Woods, the Dustin Hoffman, and the Elvis Presley estates have endured through exploitation of their images).

consent.²⁵ Jefferson, Washington, Franklin and the “artistically puritanical” John Adams utilized such commercial exploitation of their images in order to convince France to support the American Revolution against England.²⁶ Besides the wartime “propaganda,” the founders used these “new heroes” to create a united nation such that, notwithstanding their distrust of “aristocratic visual arts,” they allowed others to freely distribute their likeness all over the country and overseas.²⁷

The major shift in public and even judicial attitude came at the end of the 19th century.²⁸ An 1895 editorial in *Case & Comment* called “Advertising Brigands” lambasted the use of presidents and philosophers to sell such mundane items as tea and cigars.²⁹ A lawsuit by a prominent comic-opera star against the unauthorized use of her image for promotional purposes, further highlights this shift in attitude.³⁰ Similarly, a prominent English physician brought suit and won an injunction in New York against the American manufacturer of “Soden Mineral Pastilles,” which had misappropriated the testimonial and signature of the good English doctor to sell its product.³¹ Some attribute this change to the rise in advertising expenditure by corporations,³² and the widespread dissemination of such advertisements through the print media and later through radio, movies, and television.³³ As a result of this information

25. See Madow, *supra* note 17, at 149 (contrasting the lack of Franklin’s resentment over the price of fame with the all too common lament from “modern celebrities”).

26. See *id.* at 150.

27. See *id.*

28. See *id.* at 151–52 (noting that the commercial exploitation of famous figures increased after the American Revolution and that by the late 1880s, such notable persons as Sarah Bernhardt, John Brown, Oscar Wilde, and such fictional characters as George du Maurier’s “Trilby” had been “appropriated for commercial purposes”).

29. See *id.* at 152–53 (expressing the editorial’s concern that “before long the sad, sublime face of Abraham Lincoln would be posted up everywhere to advertise ‘Bloater’s Bitters,’ or ‘Smart Cuss’s Corn Cure’ and that mannequins of Martha Washington and Mrs. Grover Cleveland would be used to display perfect fitting corsets or seamless suits of underwear”) (internal quotation marks omitted).

30. See *id.* at 153 (noting that the production manager of the event surreptitiously paid a photographer to photograph the reluctant diva during a performance).

31. See *id.* at 153–54 (citing *MacKenzie v. Soden Mineral Springs Co.*, 18 N.Y.S. 240, 249 (N.Y. Sup. Ct. 1891), and explaining that the good English doctor, Sir Morrell MacKenzie “complained of ‘damage to his professional standing and income as a physician,’ as well as ‘infringement of his right to the sole use of his own name’”).

32. See, e.g., *id.* at 156 (emphasizing that, from the end of the American Civil War to the beginning of the 20th century, total advertising expenditures multiplied tenfold, and that throughout America seemingly every available inch of advertising space on public and private buildings alike had been used to hock some product or another).

33. See *id.* at 157, 160 (noting that “daily newspaper circulation jumped from 2.6 million in 1870 to 8.4 million in 1890,” and that movies and radio “uncoupled fame from

explosion, the media moguls, movie stars, and their agents began to realize the commercial and profit potential in celebrity.³⁴ This commodity protection can best be observed in the movie studios of the 1930s. The studios tightly controlled and licensed the celebrity status of their prized stars as the “new aristocracy” for the mutual benefit of studio earnings and the star’s career.³⁵ In addition, during this period the judicial system became more adept at framing such issues, as evidenced by New York’s acceptance of the right of privacy as a cause of action.³⁶ Furthermore, celebrity status had advanced sufficiently in the United States to recognize the “publicity value” in marketing the image, name, likeness, or endorsement of celebrities.³⁷ However, the courts of the era found it difficult to determine exactly what offended them about others profiting from a celebrity’s image.³⁸ Some cases turned on the plaintiff’s embarrassment, while others sought to protect the naïve public from false and misleading advertisement.³⁹ Other decisions utilized defamation, trademark infringement, or unfair competition to cover the “unauthorized commercial appropriation of a celebrity’s name or persona.”⁴⁰

In 1953, the Second Circuit in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,⁴¹ officially recognized the right of

greatness of achievement,” thereby extending celebrity status to personalities irrespective of their civic heroism).

34. See *id.* at 164 (detailing that in the 1920s and 1930s Hollywood and advertisers began to see the “immense power of movies and movie stars to inspire emulation,” culminating in the first use of product placement in Hollywood matinees and features).

35. See *id.* at 164–66 (discussing how the first use of movie stars’ names and faces to promote personalized advertisements resulted in the revival of product testimonials and led the movie studios to view their stars as “commodities” to be licensed out for money, publicity, or “free supplies of props”).

36. See *Edison v. Edison Polyform Mfg.*, 67 A. 392, 394 (N.J. Ch. 1907) (holding that “[i]f a man’s name be his own property, as no less an authority than the United States Supreme Court says it is[,] it is difficult to understand why the peculiar cast of one’s features is not also one’s property, and why its pecuniary value, if it has one, does not belong to its owner, rather than to the person seeking to make an unauthorized use of it”) (internal citation omitted).

37. See *Madow*, *supra* note 17, at 166 (recognizing that by the early half of the twentieth century, movie and sports stars “could now be exploited profitably in a wide range of collateral endeavors,” because celebrity had then become an “immense” source of wealth in itself—an unrefined commodity like gold, silver or other minerals).

38. See *id.* at 155 (recognizing the amorphous quality of early cases against the use of a celebrity’s image).

39. See *id.* (summarizing the court’s dicta in *Mackenzie v. Soden Mineral Springs Co.*, 18 N.Y.S. 240, 241–42 (N.Y. Sup. Ct. 1891)).

40. See *id.* at 166–67 (summarizing the various causes of action submitted to the courts in the early 1900s).

41. 202 F.2d 866 (2d Cir. 1953). The case involved the plaintiff chewing gum company that had contracted with a famous baseball player for the exclusive right to use the player’s images in their products. Russell Publishing Company, the plaintiff’s rival,

publicity.⁴² The court held that individuals have “a right of publicity” and could license or assign their images, and that these licensees and assignees could enforce this right against infringing third parties.⁴³

B. *The Modern Right of Publicity*

Today, the right of publicity remains firmly grounded in most jurisdictions,⁴⁴ although the claim has been established more by the judiciary than state legislatures.⁴⁵ Even in the states that do not have the right of publicity firmly rooted in common law or statute, a celebrity may argue the extension of privacy rights to cover a specific claim.⁴⁶ Notably, the “right of publicity established in one state protects a resident celebrity in all other states.”⁴⁷ For example, “[i]f a Wyoming resident creates an ad that features a California domiciliary’s name or likeness, he’ll be subject to California right of publicity law even if he’s careful to

subsequently signed a similar deal with the same baseball star. Later, Russell assigned these rights to the defendant, another chewing gum manufacturer, which promoted its products with the player’s photographs. Plaintiff then sought an injunction against the defendant and the defendant argued that players had no legal rights in their photographs beyond the right of privacy. *Id.* at 867–68.

42. *See id.* at 868 (holding that “a man has a right in the public value of his photograph”).

43. *See id.* (holding that “prominent persons,” in the absence of the right of publicity, “would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways”); Madow, *supra* note 17, at 172–73 (noting that Judge Frank did not rule whether the right of publicity was a property right but (perhaps more importantly) that it certainly was a right of pecuniary worth).

44. *See* Alexander Margolies, *Sports Figures’ Right of Publicity*, 1 SPORTS LAW J. 359, 360 (1994) (citing J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1.10[C], 6.1[B] (1992), and noting that this right of publicity, as of May 1992, is the law in twenty-three states).

45. *See id.* at 363 (pointing out that these cases apply the right of publicity to individuals that “the general public would consider celebrities”); *see also* Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 825–26 (9th Cir. 1974) (holding that race car driver Lothar Motschenbacher had a legally-protected “proprietary interest in his own identity”); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (holding that World Champion boxer Muhammad Ali was a “public personality” and that his right to publicity had been violated); *Palmer v. Schonhorn Enters., Inc.*, 232 A.2d 458, 462 (N.J. Super. Ct. Ch. Div. 1967) (applying the status of celebrity to those who “have attained national or international recognition in a particular field of art, science, business, or other extraordinary ability,” and qualifying golfers like Gary Player, Arnold Palmer, and Jack Nicklaus as celebrities).

46. *See* Margolies, *supra* note 44, at 361 (citing *Chef Paul Prudhomme and Tasso Travel, Inc. v. Proctor & Gamble Co. and the Folgers Coffee Co.*, 800 F. Supp. 390, 395–96 (E.D. La. 1992) as an example of the right of privacy extended to cover, in reality, a celebrity’s right of publicity claim).

47. *Id.*

keep the ad from being shown in California.”⁴⁸ This can be especially potent because California law provides broad protection in its right of publicity statute.⁴⁹ Thus, “[r]esidents of states offering less protection to sports figures must look beyond the laws of their home state Since most sports figures may be able to identify with states such as California, New York, and Illinois, which strongly protect their right of publicity, the national trend in state law is significant.”⁵⁰ Additionally, federal law can be an effective tool in defending a person’s right of publicity.⁵¹ The Federal Trademark Statute, also known as the Lanham Act, bars the use of “false designations of origin or false representations.”⁵² This violation happens when there is an “unauthorized commercial use of a celebrity’s identity to help sell a defendant’s goods or services.”⁵³ Therefore, federal law requires proof of falsity while state law only demands exploitation of the celebrity’s likeness or name in product advertisement.⁵⁴

Another helpful feature of the Lanham Act allows the victorious plaintiff to receive treble damages.⁵⁵ Although the Lanham Act is narrower in scope than state right to publicity statutes, it does provide added protection unavailable under state

48. *Id.* (quoting *Vanna White v. Samsung Electronics Am., Inc.*, 989 F.2d 1512, 1518 (9th Cir. 1993)).

49. *See id.* (noting California’s “expansive interpretation” of the right of publicity).

50. *Id.*

51. *See id.* (noting that section 43(a) of the Federal Trademark Statute (commonly known as the Lanham Act) is an “integral part of a right of publicity cause of action”).

52. *See id.* (citing the Lanham Act § 43(a), 15 U.S.C. § 1125(a)).

53. Bruce P. Keller & David H. Bernstein, *The Right of Publicity: Towards a Federal Statute?*, in PLI’S FOURTH ANNUAL INSTITUTE FOR INTELLECTUAL PROPERTY LAW 413, 416 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. G0-0024, 1998), available at WL 532 PLI/PAT 413.

54. Clarifying the point:

The unpermitted use of a person’s identity to draw attention to a product or advertisement infringes [upon state laws governing the right of publicity]. There need be no false inference that plaintiff endorses or approves the product. For example, if advertising copy reads: “Famous football quarterback Ira Idaho may be the best in the league, but he has never tasted DOUBLE D beer. Why don’t you?” Literally read, the ad disclaims any endorsement by plaintiff, but certainly uses his identity to draw attention to the advertisement. Here there would be no false endorsement [under the Federal Trademark Act], but clearly an infringement of the Right of Publicity.

J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5.4[A] (1992).

55. *See Gibeaut, supra* note 2, at 47–48 (emphasizing that the treble damages available under the federal Lanham Act for claims of unfair competition and false advertising are the star’s choice weapons in contrast to the state right of publicity claims which are limited to actual damages).

law.⁵⁶ The benefits of federal protection were evident in Woody Allen's suit against a video store that hired an Allen impersonator in its advertisements.⁵⁷ While the court ultimately found that the ad violated the false endorsement prohibition of the Lanham Act, it remained "uncertain whether §§ 50 and 51 of the New York Civil Rights Law, which provides protection against nonconsensual use of a living person's name, portrait, or picture for purposes of trade, was violated."⁵⁸ Unfortunately for the video store, it felt the full power inherent in a publicity claim when the look-alike also sued arguing that the store misused his likeness.⁵⁹ The Woody Allen look-alike won summary judgment on his cross claims against the advertiser for violating his right of publicity even though he allowed the advertiser to use his photo and signed a release to this effect.⁶⁰ Seemingly, the look-alike won his suit because the advertiser did not follow the letter of the release in that there would be a disclaimer, the ad would be limited to magazine ads, and that the photograph could not be used in a manner to confuse the look-alike for the real thing.⁶¹ This illustrates the great danger any business can confront when appropriating a celebrity's name or likeness in selling goods or services.⁶²

56. See Margolies, *supra* note 44, at 362 (stating that the Lanham Act protects a celebrity from the use of look-alikes, which may give the false impression that the celebrity endorses the product advertised).

57. See *id.* (noting that Woody Allen prevailed on a claim of "false endorsement" under the Federal Trademark Statute). National Video obtained the photograph of a Woody Allen look-alike and placed it in *Video Review* as well as National's *Take One* publication. There was a small disclaimer on the *Video Review* advertisement but National failed to use a disclaimer on the other advertisements. Woody Allen then sued National Video because he felt the ad campaign was "materially misleading and likely to result in consumer confusion as to his endorsement of National's services." See *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 618 (S.D.N.Y. 1985).

58. Margolies, *supra* note 44, at 362 (citing *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985)). The court found, that there would have been no violation of the right of publicity where "the overall context makes it completely clear that [the model] is a look-alike and that [Woody Allen] has nothing to do with the project." *Allen*, 610 F. Supp. at 630. Thus, the Lanham Act test is the "reasonable likelihood of confusion as to endorsement, authorization, or participation or affiliation." See Richard A. Kurnit, *Right of Privacy/Publicity and the Lanham Act*, C739 ALI-ABA 329, 341 (1992).

59. See Kurnit, *supra* note 58, at 346 (stressing the "scope of danger presented by the right of publicity claims").

60. See *id.* (confirming that the advertiser must ensure that "all persons who are recognizable in an advertisement have given sufficient consent for the particular use").

61. See *id.* (noting that a look-alike may be used in advertisements as long as "the overall context makes it completely clear that he is a look-alike and that [the celebrity] had nothing to do with the project").

62. See, e.g., Sirak, *supra* note 5, at S6 (noting that the Franklin Mint settled its suit with Tiger Woods over the unauthorized use of his name and likeness, with Woods receiving "a substantial monetary settlement" and a permanent injunction).

C. *Justifications for the Right of Publicity*

Commentators advance three main justifications for the right of publicity.⁶³ First, many maintain that “moral” arguments exist to justify the claim through the “reap the fruits of their labors” theory.⁶⁴ According to Professor Nimmer, “every person is entitled to the fruit of his labors unless there are important countervailing public policy considerations.”⁶⁵ Courts have recognized that celebrities cultivate their talents and public persona and are due a right to the commercial value of their efforts in order to prevent others from “free riding” on their fame.⁶⁶ Furthermore, Professor McCarthy compares the right of publicity to other property rights in that “while one person may build a home, and another knit a sweater so also may a third create a valuable personality, and all three should be recognized by the law as “property” protected against trespass and theft.”⁶⁷ Additionally, in right of publicity cases courts denounce defendants for “reaping what others have sown” and thus seek to establish the “publicity value” solely on the celebrity’s own contributions and thereby, prevent unjust enrichment.⁶⁸

Second, commentators advance “economic” arguments which fall into two basic categories.⁶⁹ Some, like Professor Posner, argue that the benefits of private property rights create “dynamic” incentives for production such that “people will farm land or write books only if they have some measure of assurance that they will be able to reap what they sow.”⁷⁰ These justifications mirror copyright ideals in that both provide an economic incentive for “enterprise, creativity, and achievement.”⁷¹

63. See Madow, *supra* note 17, at 178.

64. *Id.*

65. *Id.* at 181 (observing that courts have justified the right of publicity on the bases that the celebrity is affirmatively entitled to “control what he has created” and alternatively, that it is an “injustice [to permit] strangers to ‘reap where they have not sown’”).

66. See *id.* at 200 (arguing that society has a moral interest to prohibit people from “free riding” and that “[u]nless the law gives the celebrity a property right in [his] persona,” the courts may be unable to prevent such unjust gains).

67. See *id.* at 183 (arguing for labor-based moral argument on the basis that the celebrity expends considerable resources in pursuit of his trade—the fact that his success is measured in terms of “publicity value” based on the image that he has helped to create in the public mind is no less deserving of protection).

68. See *id.* at 196–97 (discussing that the “proper measure” of a celebrity’s publicity value is the value he personally contributes, which is not necessarily the “market value of the resulting product”).

69. See *id.* at 205 n.384.

70. See *id.* at 205.

71. See *id.* at 206.

So as the founders believed that there should be explicit constitutional protection for the “useful arts,” so does the right of publicity permit celebrities to “enrich our society.”⁷² The other basic economic argument holds that private property rights induce what Posner calls “static” economic benefits.⁷³ These “static” benefits “ensure[] that users of resources pay the full social cost of their activities.”⁷⁴ For example, imagine a society of herdsmen that hold a pasture in “common.”⁷⁵ This means that the herdsmen could graze their cattle at anytime and without any cost.⁷⁶ Because the herdsmen do not have to pay, they can ignore the real and social detriment to the land and to other herdsmen brought on by their overuse.⁷⁷ So if a herdsman decides to add another cow to feed on the pasture, other herdsmen, the argument goes, would feel compelled to add their own new grazing cattle.⁷⁸ In effect, all these aggregated “self-interested defensive efforts” would grind the common pasture into dust.⁷⁹ Therefore, unlike community property that promotes overuse, private property assures the “efficient use of pre-existing scarce resources.”⁸⁰

The third main reason people advance to justify the right of publicity lies with consumer protection.⁸¹ Others, like Professor Treece, argue that right of publicity protections function to insulate consumers from being “misled about the willingness of a celebrity to associate himself with a product or service.”⁸² Moreover, they argue that such protections allow the public to make “rational economic choices” and ensure that consumers do not become “confused by a false implication that a particular celebrity has endorsed a particular good.”⁸³ In sum, the right of

72. See *id.* at 206–07 (noting the dissenting opinion of Chief Justice Bird in *Lugosi v. Universal Pictures*, 603 P.2d 425, 441 (Cal. 1979), which outlines the necessity for legal protections as a societal incentive).

73. See Madow, *supra* note 17, at 205 (noting the use of Posner’s “static” benefits theory in supporting arguments for private property rights).

74. *Id.* at 206.

75. See *id.* at 220.

76. See *id.*

77. See *id.*

78. See *id.*

79. See *id.*

80. See *id.* at 206.

81. See *id.* at 228 (noting that the consumer protection argument is an analog of the argument that the right of publicity “functions in effect as a private law mechanism for advertising regulation”).

82. See James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 647 (1973).

83. See Douglas G. Baird, Note, *Human Cannonballs and the First Amendment*:

publicity shields the consumer from “dangerous or shoddy” goods, which advertisers promote by “exploiting powerful celebrity images.”⁸⁴

D. Criticisms of the Right of Publicity

Some commentators criticize the “just dessert” moral justification for the right of publicity by noting that a celebrity does not alone create a marketable image.⁸⁵ For example, for someone to be considered a great actor or athlete there remains countless others such as writers and directors, who ensure the star’s success.⁸⁶ Thus, the “moral” argument that the celebrity alone should economically benefit from that collectively created persona diminishes.⁸⁷ These critics point out the right of publicity claim only rewards the celebrity with a cause of action and not the countless others who do not get to reap the fruits of their labors.⁸⁸ Accordingly, some courts, like the Ninth Circuit in *White v. Samsung Electronics America, Inc.*,⁸⁹ recognize that the value of a celebrity’s likeness may come from “dumb luck” and not from some vast physical/mental endeavor or even talent.⁹⁰

Second, commentators counter the “unjust enrichment” justification of the right of publicity by arguing that even if a person benefits from another’s image, this new use should be protected from the celebrity because society must be free to use the star’s “images as a means of public discourse.”⁹¹ These critics insist that the media and the public require celebrities to “tell stories, to educate, to titillate, to attract an audience, and to sell newspapers, magazines, radio shows, television programming, movies, and web sites.”⁹² The use of a celebrity’s name, image or

Zacchini v. Scripps-Howard Broadcasting Co., 30 STAN. L. REV. 1185, 1186 n.7 (1978).

84. See Madow, *supra* note 17, at 228.

85. See, e.g., Ira J. Kaplan, *They Can't Take That Away From Me: Protecting Free Trade in Public Images From Right of Publicity Claims*, 18 LOY. L.A. ENT. L.J. 37, 70 (1997) (stating that the image an actor creates, which results from lines written for him and spoken at a director’s instruction, can be the design of several people).

86. See *id.* (asserting that while an actor’s image can be the product of several individuals, the right of publicity extends solely to the actor).

87. See *id.* (challenging the right to publicity on grounds that “the hero is only partly responsible for creating” the image portrayed to the public).

88. See *id.* (noting that giving all the credit to the hero engenders fiction as fact because the personal property right in the image is not shared among those who helped create the image).

89. 971 F.2d 1395 (9th Cir. 1992).

90. See *id.* at 1399 (emphasizing that “the law protects the celebrity’s sole right to exploit [the celebrity’s] value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof”).

91. See Kaplan, *supra* note 85, at 71.

92. *Id.*

persona, the argument goes, can become a cornerstone for the dissemination of ideas in a free society.⁹³

Last, some critics maintain that the right of publicity serves to create deception and to inhibit the free discourse in society.⁹⁴ The deception occurs because the celebrity, who already receives handsome payment, controls who can use their image and what each licensee can say.⁹⁵ Far from protecting the consumer, the right of publicity grants the celebrity an information monopoly⁹⁶ so that the consumer has no way of judging or comparing the veracity of the celebrity's licensed message. *Nature's Way Products, Inc. v. Nature-Pharma, Inc.*⁹⁷ effectively illustrates this danger. In that case, the plaintiff, a well-known herbalist, sold his business along with recipes (but not his right of publicity) to the defendants.⁹⁸ Later, the defendant advertised that the plaintiff had developed the herbal formula they now offered, causing the plaintiff to sue for an injunction.⁹⁹ The defendant argued that "the right of publicity does not protect dissemination of historical information."¹⁰⁰ However, the court granted the injunction even though such information would be helpful to any consumer making purchasing decisions.¹⁰¹ Critics argue this "censorial control" prevents the consumer from having a complete foundation to base purchasing decisions on.¹⁰² Maybe, the consumer prefers the products created by the "well-known herbalist," and to deny a producer from sharing such information hinders the consumer in getting what he or she truly wants.¹⁰³ So, far from creating economic efficiency, the right of publicity negates any "dynamic" or "static" benefits.¹⁰⁴

93. See *id.* at 72 (stating that "the public uses heroes to help describe and define our world," achieving "greater freedom of cultural self-definition").

94. See *id.* at 63.

95. See *id.* at 62 (questioning whether "it is socially desirable to allow public figures the right to censor and to extract pay for reference to them and their accomplishments, particularly when they are already paid handsomely").

96. See *id.* at 62–63 (questioning whether public figures should have monopoly control over their fame or whether the public, "as cultural stockholders," should "have a share in the currency of their celebrity to spend as [it] pleases").

97. 736 F. Supp. 245 (D. Utah 1990).

98. See *id.* at 245.

99. See *id.* at 247.

100. *Id.* at 253.

101. See *id.*; see also Kaplan, *supra* note 85, at 64.

102. See Kaplan, *supra* note 85, at 64 (complaining that the court's decision to grant the injunction allowed the plaintiff to censor truthful information that could be useful to consumers when deciding between different brands).

103. See *id.* at 63–64.

104. See Madow, *supra* note 17, at 205–07 (discussing the supposed economic benefits inherent in the right of publicity, and concluding that there has been no evidence

III. THE FIRST AMENDMENT AND THE ARTIST

Congress shall make no law respecting establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press¹⁰⁵

The primary objective of trademark and right of publicity laws lies with protecting the intellectual endeavors of authors and inventors.¹⁰⁶ Limited monopolies in the form of patents, copyrights, and trademarks as well as publicity rights serve to enforce these safeguards.¹⁰⁷ Ultimately, these laws foster innovation, facilitate creativity, and ensure economic morality towards the public.¹⁰⁸ However, many litigants challenge these laws as violative of the “First Amendment guarantees of free speech and free press.”¹⁰⁹ Thus, there constantly remains the battle between the prized economic property rights of one’s own image and First Amendment ideals. The First Amendment has come to guard against censorship such that “[a]ny prior restraint on expression comes . . . with a ‘heavy presumption’ against its constitutional validity.”¹¹⁰ The First Amendment “looks beyond written or spoken works as mediums of expression,”¹¹¹ and covers all forms of “peaceful expression in its myriad of manifestations.”¹¹² The First Amendment, therefore, grants visual expression the same status as the written word because “[o]ne cannot look at Winslow Homer’s paintings on the Civil War without seeing, in his depictions of the boredom and hardship of the individual soldier, expressions of anti-war sentiments, the idea that war is not heroic.”¹¹³ While this protection seems broad, it does not grant the artist an absolute

or practical argument presented, in any of the cases or the law reviews, to support the claim that the right of publicity generally enriches or benefits society).

105. U.S. CONST. amend. I.

106. See Tara J. Goldsmith, Note, *What’s Wrong with this Picture? When the Lanham Act Clashes with Artistic Expression*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 821, 826 (1997).

107. See *id.*

108. See *id.* at 827.

109. *Id.* at 839.

110. *Organization for a Better Austin v. Keefe*, 402 U.S. 415, 419 (1971) (quoting *Carroll v. Princess Anne*, 393 U.S. 175, 181 (1968); *Bantam Books, Inc. v. Sullivan*, 372 U.S. 58, 70 (1963)).

111. Goldsmith, *supra* note 106, at 840.

112. *Id.* at 840–41.

113. *Bery v. City of New York*, 97 F.3d 689, 695 (2d Cir. 1996).

right to appropriate a trademark or a celebrity's name or likeness.¹¹⁴

If the artist engages in commercial speech the First Amendment protections diminish because “[commercial speakers] . . . are well situated to evaluate the accuracy of their messages,” and do not become “particularly susceptible to . . . overbroad regulation.”¹¹⁵ *Mendonsa v. Time Inc.*¹¹⁶ illustrates the court's reluctance to extend First Amendment protections to commercial speech.¹¹⁷ In 1987, *Life* magazine offered prints of the famous “Kissing Sailor” photograph for \$1600 each.¹¹⁸ A Rhode Island man claimed to be the sailor in the photograph and sued Time Inc. for violating his right of publicity.¹¹⁹ Time Inc. subsequently moved for a dismissal, but the court refused, holding that “selling the prints at \$1,600 each” is solely a commercial use and does not merit constitutional protection.¹²⁰

A. Right of Publicity and the First Amendment

The right of publicity can be a powerful tool for the athlete or the celebrity in guarding her economic interests.¹²¹ But this legal right cannot violate the First Amendment guarantees of the Constitution.¹²² The First Amendment allows the artist or anyone else the “unauthorized use of an individual's name or likeness” only for the “dissemination of ideas and information,” or for other cultural purposes.¹²³ The main protection lies with the media in the “newsworthiness doctrine” but also applies to the “artist's use doctrine” and parody.¹²⁴

114. See Goldsmith, *supra* note 106, at 848.

115. *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 564 n.6 (1980).

116. 678 F. Supp. 967 (D.R.I. 1988).

117. See Vetter & Roche, *supra* note 16, at 48–49 (explaining that the First Amendment limits suits to the taking of a name or likeness for commercial purposes).

118. See *id.* at 49 (noting that the picture depicts a sailor kissing a nurse in Times Square, moments after the Japanese surrendered in World War II).

119. See *id.*

120. *Id.*

121. See Margolies, *supra* note 44, at 364; see also *Martin Luther King, Jr., Ctr. for Social Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697, 706 (Ga. 1982) (holding that Dr. Martin Luther King “could have exploited his name and likeness during his lifetime” and that this “does not mean that others have the right to use his name and likeness in ways he himself chose not to do”).

122. See Margolies, *supra* note 44, at 366.

123. *Id.*

124. See *id.* at 374–75 (the newsworthiness doctrine includes the use of factual, historical or educational data, and extends to those uses that are entertaining and amusing, “concerning interesting phases of human activity in general”); see also Vetter & Roche, *supra* note 16, at 48–49 (outlining cases dealing with the artist's use

1. Newsworthiness Doctrine

The newsworthiness doctrine permits the media to use the unauthorized likeness of celebrities or anyone of interest in its "everyday news coverage."¹²⁵ The definition of "news coverage" has been given a broad reading such that it includes "facts relating to the accomplishments or activities of celebrities."¹²⁶ The best example of the broad leeway given to the media can be seen in the case of *New Kids on the Block v. News America Publishing, Inc.*¹²⁷ In that dispute, the national newspaper *USA Today* set up a 1-900 phone line to determine "who is the sexiest New Kid?"¹²⁸ The group sued the newspaper claiming a right of publicity violation, which the court dismissed, even though the newspaper profited from the polling.¹²⁹ The court justified its position by stating "[t]he First Amendment is not limited to those who publish without charge."¹³⁰ Ultimately, courts apply a broad reading of the news media exemption because they believe "it is not the place of courts to determine which issues may or may not interest the general public."¹³¹ In *Paulsen v. Personality Posters, Inc.*,¹³² a New York court declared that "[t]he privilege of enlightening the public is by no means limited to dissemination of news in the sense of current events but extends far beyond to include all types of factual, educational and historical data, or even entertainment and amusement, concerning interesting phases of human activity in general."¹³³ On the other hand, the Supreme Court has limited the Constitutional protection given to media organizations in their coverage of "news" events when such coverage destroys the total economic viability of a performer's act.¹³⁴ In *Zacchini v. Scripps-Howard Broadcasting*

doctrine and parody).

125. See Margolies, *supra* note 44, at 366.

126. *Id.*

127. 745 F. Supp. 1540 (C.D. Cal. 1990), *aff'd*, 971 F.2d 302 (9th Cir. 1992).

128. See Vetter & Roche, *supra* note 16, at 48.

129. See *id.* at 48-49; see also *New Kids on the Block*, 745 F. Supp. at 1542-43 (stating one of the causes of action brought by New Kids is misappropriation of publicity rights).

130. Vetter & Roche, *supra* note 16, at 49.

131. Margolies, *supra* note 44, at 374; see also *Ann-Margret v. High Society Magazine, Inc.*, 498 F. Supp. 401, 405 (S.D.N.Y. 1980) (stating that the broad reading of the exemption includes "matters of 'entertainment and amusement, concerning interesting phases of human activity in general'") (internal citation omitted).

132. 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968). A comedian engaged in a satirical campaign for president filed a right of publicity suit against a company distributing posters of his likeness without permission. See *id.* at 503.

133. *Id.* at 506 (stating that the posters are privileged as newsworthy).

134. See Margolies, *supra* note 44, at 366 (noting that in *Zacchini v. Scripps-Howard*

Co.,¹³⁵ the Supreme Court held that the First Amendment does not “immunize the media [from liability for damages] when they broadcast a performer’s entire act without his consent.”¹³⁶ The news media filmed Zacchini’s entire “human cannonball” act and broadcasted it on the news.¹³⁷ Zacchini sued, claiming that he was an entertainer and performs an act “invented by his father,” and stating further that Scripps-Howard “showed and commercialized the film of his act without his consent, and that such conduct was an unlawful appropriation of [his] professional property.”¹³⁸ In upholding Zacchini’s right of publicity claim, Justice White concluded that the performer’s “proprietary interest” trumps the media’s right to broadcast an entire performance, and that this “protection provides an economic incentive to him to make the investment required to produce a performance of interest to the public.”¹³⁹ Justice White further indicated “that neither the public nor [the] respondent will be deprived of the benefit of [Zacchini’s] performance as long as his commercial stake in his act is appropriately recognized.”¹⁴⁰ Further, in cases like *Grant v. Esquire, Inc.*,¹⁴¹ courts have refused to grant news media First Amendment exemptions when the “celebrity’s name or likeness is used to attract attention to an event rather than as a part of a news comment on the event.”¹⁴² Therefore, these court battles underscore the continuing give-and-take between property interests and the freedom of speech and press.

2. Artist’s Use and Parody

a. Artist’s Use. In addition to the newsworthiness exemption, courts bar right of publicity claims against the use of a “celebrity’s name in the title and text of a fictional or semifictional book or movie.”¹⁴³ In *Rogers v. Grimaldi*,¹⁴⁴ Ginger

Broadcasting Co., 433 U.S. 562 (1977), the Supreme Court upheld a performer’s right of publicity, stating that a television news broadcast of his act is not protected by the First Amendment).

135. 433 U.S. 562 (1977) (regarding suit brought by a “human cannon ball” performer whose entire act was filmed by a freelance reporter without performer’s permission).

136. *Id.* at 575.

137. *See id.* at 564.

138. *See id.*

139. *Id.* at 576.

140. *Id.* at 578.

141. 367 F. Supp. 876 (S.D.N.Y. 1973) (regarding a photograph of Cary Grant from an *Esquire* news article in 1946 that was republished in 1971 but modified by placing Grant’s head on the body of a model wearing a cardigan sweater-jacket).

142. Margolies, *supra* note 44, at 366.

143. *See Vetter & Roche, supra* note 16, at 49 (explaining that “[a]rtists have limited

Rogers brought suit against the producers and distributors of "Ginger and Fred," a film by Federico Fellini about a fictitious cabaret act performed by Ginger Rogers and Fred Astaire impersonators.¹⁴⁵ The Court of Appeals for the Second Circuit noted that Oregon's right of publicity law would allow the use of Roger's name unless the title was wholly unrelated to the film or was "simply a disguised commercial advertisement for the sale of goods or services."¹⁴⁶ Moreover, many states' right of publicity statutes explicitly grant exceptions for artistic use.¹⁴⁷ In Rhode Island, for example, photographers can "display the portraits or likenesses of others about their premises."¹⁴⁸ In *Preston v. Martin Bregman Prods., Inc.*,¹⁴⁹ the court states that the doctrine of incidental use limits New York's publicity law; in other words, "incidental or isolated uses of a name, picture or portrait are not actionable."¹⁵⁰

b. Parody. Another area of artistic endeavor that could be protected from a right of publicity claim is parody.¹⁵¹ For example, in *Hughes v. Plumsters, Ltd.*,¹⁵² the estate of Andy Warhol sued the manufacturer of the T-shirt "Andy Warhol's Cat" basing its claims on trademark and right of publicity infringement of "Warhol's name and likeness."¹⁵³ The court, in a pretrial order, "took the view that it would be unconstitutional if the right of publicity could prevent a parody."¹⁵⁴ However,

First Amendment rights to use the name and likeness of a person"); see, e.g., *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978) (finding that "the right of publicity does not attach here where a fictionalized account of an event in the life of a public figure is depicted in a novel or movie, and in such novel or movie it is evident to the public that the events so depicted are fictitious"); *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454 (Cal. 1979) (holding that "the use of a deceased celebrity's name and likeness in a fictional film exhibited on television" is not an "infringement of that person's right of publicity").

144. See 875 F.2d 994 (2d Cir. 1989).

145. See *id.* (finding that the Lanham Act does not bar the minimal use of a celebrity's name in the title of an artistic work); see *Vetter & Roche, supra* note 16, at 49 (explaining that "several courts (citing their concern for free expression) have refused to extend the right of publicity to bar the use of a celebrity's name in the title and text of a fictional or semi-fictional book or movie").

146. See *Rogers*, 875 F.2d at 1004.

147. See *Vetter & Roche, supra* note 16, at 49.

148. *Id.*

149. 765 F. Supp. 116 (S.D.N.Y. 1991).

150. See *id.* at 119.

151. See *Vetter & Roche, supra* note 16, at 49 (noting the use of the parody exception in a case involving right of publicity and trademark infringement claims).

152. 11 U.S.P.Q.2d 1572 (N.D. Cal. 1989).

153. See *id.* at 1572-73 (noting that Warhol's estate also sued for false designation of origin, unfair competition, dilution, and injury to business representation); *Vetter & Roche, supra* note 16, at 49.

154. *Vetter & Roche, supra* note 16, at 49; see also *Hughes*, 11 U.S.P.Q.2d at 1573-

despite the dicta of this court, the Ninth Circuit Court of Appeals expressly declined to declare a right of publicity parody exception.¹⁵⁵ The parody exception traditionally has been relegated to trademark law although some commentators propose its explicit extension to right of publicity actions.¹⁵⁶ Accordingly, when dealing with parody in right of publicity actions, it becomes important to remember parodies have not been given explicit protections.

B. *The Lanham Act and the First Amendment*

Through the fair use doctrine, First Amendment principles also place limitations upon the Lanham Act's trademark protections.¹⁵⁷

1. Fair Use Doctrine

Trademarks serve to identify product "sources" and recently many of these marks "have become part of the products themselves."¹⁵⁸ The fair use doctrine balances the broad "societal interest" in using such descriptive words or images with the trademark owner's exclusive property rights.¹⁵⁹ The fair use doctrine permits "fair and good faith use of another's mark to describe a second comer's goods or services, or the geographic origin thereof."¹⁶⁰ In addition, it even allows a commercial competitor to employ "another's registered trademark to describe aspects of one's own goods."¹⁶¹ This exception to the Lanham Act should be seen as "non-trademark" use of a mark, and only

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155. See *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1401 n.3 (9th Cir. 1992) (excluding the parody exception, especially in commercial speech).

156. See Gretchen A. Pemberton, *The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity*, 27 U.C. DAVIS L. REV. 97, 98-100 (1993) (noting the lack of explicit parody protection against right of publicity claims, and arguing for the exception's acceptance).

157. See Goldsmith, *supra* note 106, at 837-38 (explaining how this affirmative defense can be used to protect speech); 15 U.S.C. § 1115(b)(4) (1994) (stating "[t]hat the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly" as a defense against a claim of trademark infringement).

158. See Goldsmith, *supra* note 106, at 837; see also Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 960-61 (1993) (noting how McDonald's and 7-UP's trademarks have been used as characters in video games).

159. See Goldsmith, *supra* note 106, at 837-38.

160. *Id.* at 838; see also 15 U.S.C. § 1115 (b)(4) (1994); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (pointing out "it is often virtually impossible to refer to a particular product for the purposes of comparison, criticism, point of reference or any other such purpose without using the mark").

161. *Mattel, Inc. v. Azrak-Hamway Int'l, Inc.*, 724 F.2d 357, 361 (2d Cir. 1983).

negates trademark infringement when use of the trademark does not create customer confusion or “appropriate the first product’s cachet for a different one.”¹⁶² For example, in *Volkswagenwerk Aktiengesellschaft v. Church*,¹⁶³ the Court of Appeals for the Ninth Circuit ruled that a car repair shop’s use of “Volkswagen” in a sign to advertise its business did not violate trademark law, indicating that using a trademark to describe one’s own service does not equal infringement.¹⁶⁴ Significantly, the shop’s use of Volkswagen’s trademark did not “implicate the source identification function” of trademark or suggest Volkswagen’s “sponsorship or endorsement.”¹⁶⁵

2. First Amendment Limits to the Lanham Act

a. Artistic Expression. Trademark law allows trademark holders the right to restrict their use. Accordingly this right can inhibit free and open discourse.¹⁶⁶ Recognizing the potential danger of the Lanham Act, Congressional Representative Kastenmeier stated “[t]he proposed change in section [1125(a)] should not be read in any way to limit political speech, consumer or editorial comment, parodies, satires, or other constitutionally protected material.”¹⁶⁷ In accordance with this philosophy, some courts have recently granted individuals greater use of another’s trademark in parodies or other forms of artistic expression.¹⁶⁸ The Court of Appeals for the Second Circuit noted that in the area of artistic expression trademark enforcement “carries a risk of inhibiting free expression.”¹⁶⁹ Another case, *New York Racing Ass’n, Inc. v. Perlmutter Publishing, Inc.*,¹⁷⁰ demonstrates the

162. See Goldsmith, *supra* note 106, at 838; see also *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 412 (9th Cir. 1996) (explaining prior decisions relating to the fair use doctrine).

163. 411 F.2d 350 (9th Cir. 1996).

164. See *id.* at 351 (explaining that defendant appropriately distinguishes his business so as not to suggest that he is part of Volkswagen’s organization).

165. Goldsmith, *supra* note 106, at 839.

166. See *id.* at 845; see also *Yankee Publ’g, Inc. v. News Am. Publ’g Corp.*, 809 F. Supp. 267, 275–76 (S.D.N.Y. 1992) (explaining how the use of another’s trademark without permission will generally result in trademark law prevailing over the First Amendment).

167. 135 CONG. REC. H1216–17 (daily ed. Apr. 13, 1989) (statement of Rep. Kastenmeier); see also Goldsmith, *supra* note 106, at 845–46 n.142 (referring to the legislative history of the Lanham Act and Congress’s awareness of the Act’s potential for intruding into First Amendment protection of expression).

168. See Goldsmith, *supra* note 106, at 846.

169. *Id.* at 847 (contrasting the protection afforded artistic speech to that of commercial speech); see also *Silverman v. CBS Inc.*, 870 F.2d 40, 48 (2d Cir. 1989).

170. 1996 WL 465298 (N.D.N.Y. 1996), *subsequently published* as *New York Racing Ass’n, Inc. v. Perlmutter Publ’g, Inc.*, 959 F. Supp. 578 (N.D.N.Y. 1997).

effect and extent of First Amendment protections in trademark litigation.¹⁷¹ In that case, Jeness Cortez created many paintings depicting the Saratoga Race Course often containing New York Racing Authority's ("NYRA") trademarks found on "banners hanging from the grandstand, complete with NYRA's logo of a jockey on a horse."¹⁷² The NYRA sued Cortez for violating its registered trademark and sought monetary compensation for Cortez's use.¹⁷³ The court disagreed stating that "[n]ot only does the interest of free expression outweigh the interest of avoiding consumer confusion as to the source of products displaying these images, the evidence in the record shows that defendants use the images to describe Saratoga horse racing and not as an indication of source."¹⁷⁴ Furthermore, the court held the inclusion of NYRA's trademarks in Cortez's paintings "serves the artistically relevant purpose of accurately depicting that scene," and thus Cortez's free speech interest trumps NYRA's economic rights.¹⁷⁵

b. Parody. Courts also give First Amendment protections against the Lanham Act with regards to parodies.¹⁷⁶ A good example of the parody exception to the Lanham Act resides in *L.L. Bean, Inc. v. Drake Publishers, Inc.*¹⁷⁷ In that case, the adult magazine *High Society* produced L.L. Bean's Back-to-School-Sex Catalog, filled with nude models, parodying L.L. Bean's popular clothing catalog.¹⁷⁸ L.L. Bean sued the magazine, but the Court of Appeals for the First Circuit declared that trademark rights do not entitle a trademark holder to "quash" the use of the mark when it is being used to communicate opinions or ideas.¹⁷⁹ In addition, the court found that restricting noncommercial parody

171. See Goldsmith, *supra* note 106, at 849 (indicating that the court protected Jeness Cortez' paintings because the artist did not use the images to indicate a source, but only to "accurately depict[] that scene").

172. See *id.* at 849.

173. See *id.*

174. *Perlmutter*, 1996 WL 465298, at *3 n.13.

175. *Id.* at *4.

176. See Goldsmith, *supra* note 106, at 846-47; see generally *Pillsbury Co. v. Milky Way Prods.*, 215 U.S.P.Q. 124 (N.D. Ga. 1981) (holding no trademark infringement for *Screw* magazine's use of parody in an ad showing figures resembling the trademarked characters "Poppin Fresh" and "Poppie Fresh" engaged in fellatio); *Girl Scouts of Am. v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228 (S.D.N.Y. 1969) (allowing the depiction of a pregnant woman wearing a Girl Scout uniform due to the fact that plaintiff could not prove damages); *Vetter & Roche, supra* note 16, at 39.

177. 811 F.2d 26 (1st Cir. 1987), *cert. denied*, 483 U.S. 1013 (1987).

178. See *Vetter & Roche, supra* note 16, at 39.

179. See Goldsmith, *supra* note 106, at 847 (citing *L.L.Bean*, 811 F.2d at 29 (citing *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 933, 935 (D.D.C. 1985))).

would chill the First Amendment.¹⁸⁰ The court explained that First Amendment concerns “were tantamount because the magazine had not used the mark either to identify or to market goods or services, but rather solely to identify the owner of the trademark as the object of its parody.”¹⁸¹

On the other hand, *Rogers v. Koons*¹⁸² shows the potential difficulty in bringing a parody defense against trademark infringement. In 1980, photographer Art Rogers photographed an acquaintance, Jim Scanlon, and his wife holding their eight German Shepherd puppies.¹⁸³ Rogers exhibited the “Puppies” prints, offered them for sale in his catalogue, licensed them out, and allowed Museum Graphics to manufacture “Puppies” postcards.¹⁸⁴ Later in 1987, post-modern artist Jeff Koons copied the “Puppies” postcard in four polychrome wood sculptures for his “Banality Show,” renaming the work as “String of Puppies.”¹⁸⁵ Three out of the four “String of Puppies” sculptures exhibited sold for \$367,000, which prompted Rogers to sue for copyright infringement.¹⁸⁶ Koons argued that his work parodies and satirizes the “banality” of modern American society much like “Dadaism, Cubism, and the Readymades of Marcel Duchamps.”¹⁸⁷ Further, he stated that he “belong[ed] to the school of American artists who believ[ed] [that] the mass production of commodities and media images has caused a deterioration in the quality of society,” and that his sculptures necessarily criticize that culture.¹⁸⁸ The court rejected Koons’ argument, taking the position that Koons parodied society in general and did not satirize the copied work in the least.¹⁸⁹ The court stated that “though the satire need not be only of the copied work . . . , the copied work must be, at least in part, an object of the parody.”¹⁹⁰ Koons, in the eyes of the court, had no need to use the

180. See Goldsmith, *supra* note 106, at 847–48 (contrasting the use of a trademark to identify a commodity as a form of commercial speech to the use of trademarks in the area of artistic speech, and indicating that artistically using a trademark warrants protection by the First Amendment, and thus the trademark owner’s property right may not be enforced).

181. *Id.* at 848.

182. 960 F.2d 301 (2d Cir. 1992).

183. See *id.* at 304.

184. See *id.*

185. See *id.* at 305.

186. See *id.*

187. See Vetter & Roche, *supra* note 16, at 36.

188. *Rogers*, 960 F.2d at 309; see also Vetter & Roche, *supra* note 16, at 36–37.

189. See Vetter & Roche, *supra* note 16, at 38.

190. *Rogers*, 960 F.2d at 310–11 (declaring “[i]t is not really the parody flag that the appellants are sailing under, but rather the flag of piracy”).

photograph to make his statement because he did not criticize the copied work itself.¹⁹¹ This outcome has wide implications for artists because the “appropriation of imagery from mass media and other sources is . . . a strategy central to postmodern art.”¹⁹² Therefore, the post-modern artist must remain wary when he or she decides to “appropriate” a cultural icon, especially if the use makes a broad comment on society rather than focusing its satire towards copied work.¹⁹³

IV. ANALYSIS

Commentators criticize the right of publicity for creating a monopolistic control of a celebrity’s image that deceives the public at large and inhibits free discourse in an open society.¹⁹⁴ However, the right of publicity remains firmly rooted at the state and even federal level,¹⁹⁵ and demonizing celebrities does not clarify the conflict between economic and constitutional protections. The real problem arises in the differing range and scope of right of publicity statutes. These disparities can lead to discrepancies in the application of the various state laws to similar sets of facts, thus allowing a celebrity to have a publicity claim in one state and not another.¹⁹⁶ These differences can best be seen with Elvis impersonators.¹⁹⁷ Nevada law permits Elvis impersonators to profit off the deceased celebrity without fear of suit from Elvis’ estate.¹⁹⁸ In contrast, if the impersonators perform and profit in other states, they may be susceptible to suits by Elvis’ estate.¹⁹⁹ A uniform standard should be implemented ensuring a fair and constitutional right of publicity for the celebrity. This new standard would make disputes like

191. See Vetter & Roche, *supra* note 16, at 38.

192. See Martha Buskirk, *Appropriation Under the Gun*, ART IN AMERICA, June 1992, at 37; see also Vetter & Roche, *supra* note 16, at 38.

193. See Warnecke, *supra* note 18, at 688 (detailing the judgment against Koons).

194. See *supra* notes 85–104 and accompanying text (listing the various criticisms of the right of publicity).

195. See *supra* notes 44–46 and accompanying text (noting that twenty-three states have right of publicity statutes and in other states, the right of privacy can cover publicity claims); see also Gibeaut, *supra* note 2, at 48 (confirming that twenty-five states recognize the right of publicity either through statute or common law).

196. See Gibeaut, *supra* note 2, at 48 (expressing that “[t]hings can get particularly sticky in publicity rights, which differ widely in the . . . states that recognize them”).

197. See *id.*

198. See *id.*

199. See *id.* at 48 (pointing out that a dozen states, including California, “extend” publicity rights to the dead celebrity’s heirs and estate). It remains important to remember that depending on the celebrity’s domiciliary, one state’s right of publicity law may extend into other jurisdictions. See *supra* notes 45–50 and accompanying text.

that between Rick Rush and Tiger Woods less prevalent because each side would have a clearer understanding of their respective rights.²⁰⁰

A. Proposed Standard

An important starting point for a right of publicity balancing test lies with federal copyright law.²⁰¹ Although the source and protections offered by copyright law differ from the right of publicity, some standards and uses transfer effectively. Section 107 of the 1976 Copyright Revision Act states:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use . . . as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work . . . is a fair use the factors to be considered shall include:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.²⁰²

By appropriating the copyright standard as a starting point, a series of questions or factors can be extrapolated for the court's use.

1. What Does the Use of a Celebrity's Name or Likeness Add to Societal Discourse?

200. See Gibeaut, *supra* note 2, at 47 (stating that "Rush doesn't get it" to illustrate the artist's shock from being sued).

201. See Vetter & Roche, *supra* note 16, at 37 (listing the four factors courts use in analyzing a fair use claim under the Copyright Act).

202. 17 U.S.C. § 107 (1994).

This first determination recognizes the newsworthiness doctrine, artistic use, parody exception, and mirrors the copyright allowance for criticism, comment and teaching.²⁰³ To answer this question, a court should focus on who is using the celebrity's image.²⁰⁴ If a news organization appropriates a celebrity's image, the courts should apply the newsworthiness doctrine with its broad definition of what constitutes news events and ultimately adds to societal discourse. Courts have historically recognized that the media is in a better position to determine newsworthiness.²⁰⁵ Further, the Constitution explicitly provides protection to the press.²⁰⁶ *Montana v. San Jose Mercury News Inc.*²⁰⁷ illustrates the wide latitude courts should give to the media in deciding whether the news events they cover add to the dissemination of ideas. In that case, the San Jose Mercury News sold promotional posters depicting Joe Montana, and celebrating the San Francisco 49ers' four Super Bowl championships, which prompted Joe Montana to file suit.²⁰⁸ The court ruled that the First Amendment insulated the posters because they depicted newsworthy events to the public regardless of the profit earned.²⁰⁹

When confronted with a suit against a non-media defendant, a court should determine whether the artist's use constitutes criticism/commentary or parody.²¹⁰ For example, if an artist

203. See *id.*; see also Vetter & Roche, *supra* note 16, at 37; Margolies, *supra* note 44, at 374–75; Goldsmith, *supra* note 106, at 846.

204. This factor is essential because the identity of whoever appropriates the celebrity's image can make the difference between "piracy" and news media. See Margolies, *supra* note 44, at 374–75.

205. See *id.* at 374.

206. See U.S. CONST. amend. I.

207. 34 Cal. App. 4th 790 (1995). See Gibeaut, *supra* note 2, at 49–50 (noting that the "luck of the law" can either favor or dismiss celebrity publicity claims).

208. See Gibeaut, *supra* note 2, at 49.

209. See *id.*

210. See *supra* notes 105–24 and accompanying text (discussing a possible First Amendment limitation to the right of publicity); see also *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987) ("Denying parodists the opportunity to poke fun at symbols and names which have become woven into the fabric of our daily life is a violation of the First Amendment."); *Rogers v. Grimaldi*, 875 F.2d 994, 1005 (2d Cir. 1989) (holding that the First Amendment protects the right to use a celebrity's name in the title of a work where the use of the individual's name would not be construed as an endorsement or otherwise mislead the public); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 497 (2d Cir. 1989) (holding that parodies are afforded more protection based on the First Amendment, especially when there is "only a slight risk of consumer confusion"); *Pillsbury Co. v. Milky Way Prods.*, 215 U.S.P.Q. 124, 131–32 (N.D. Ga. 1981) (indicating that Milky Way's use of Pillsbury's characters was for an editorial rather than commercial purpose, and therefore was protected as fair use); *Girl Scouts of Am. v. Personality Posters Mfg.*, 304 F. Supp. 1228, 1234 (S.D.N.Y. 1969)

paints and offers 5000 prints of John Rocker, portraying the Braves' star reliever as a bigot or social pariah,²¹¹ this appropriation should garner protection because the artist is criticizing and commenting on the celebrity's role and function in society. Such representations foster another opinion or idea that the public can weigh, discuss, agree or disagree with. It should not make a difference that the artist could profit handsomely from the paintings given the underlying commentary the use promotes.²¹² Not only would the artist be profiting from the celebrity, the prints' negative portrayal could tarnish Rocker's economic viability in procuring endorsements.²¹³ Still, the use should be protected because it criticizes the celebrity, adding ideas or different views to societal discourse that would never be endorsed by the celebrity.²¹⁴ Under this scheme the creators of parody, satire, commentary or criticism would enjoy greater freedom from suits because their works negate or combat those ideas or ideals that the celebrity's public relations office or publicist disseminates to the public.²¹⁵ In addition, the *Rogers* parody limit²¹⁶ should be eliminated because sometimes the best way to comment or satire society in general is to use a specific celebrity or trademark.²¹⁷

(stating that prohibiting the defendant from publishing its parody of the Girl Scouts would be a violation of the First Amendment).

211. See, e.g., Jerry Green, *Braves' Rocker Confused Free Speech With Utter Stupidity*, DETROIT NEWS, Dec. 30, 1999, at D1 (detailing John Rocker's woes and the controversy surrounding him).

212. See, e.g., *New Kids on the Block v. Gannett Satellite Info. Network, Inc.*, 745 F. Supp. 1540, 1546 (declaring "[t]he First Amendment is not limited to those who publish without charge").

213. See, e.g., WEILER & ROBERTS, *supra* note 1, at 74–75 (noting how Los Angeles Dodger's Vice President, Al Campanis, Cincinnati Reds' Managing Partner, Marge Schott, and Central Michigan University basketball coach, Keith Dambrot, all lost positions due to alleged racial remarks).

214. See Kaplan, *supra* note 85, at 73 (arguing that "[o]nly by protecting the ability to freely evoke heroic images without assigning censorship control to the hero can we as a society aspire to virtue").

215. See *id.* at 63 ("[T]he right of publicity creates deception in advertising. Providing assignable ownership to people's images means that the rights to the discourse goes to the highest bidder. Granting image-control of the celebrity, or the assignee, assures that only their approved version is presented.").

216. See *supra* notes 182–90 and accompanying text (discussing a court's requirement that in order to receive parody protections, the original parodied work must at least in part be the "object of the parody," thus a work parodying society and not satirizing the original is not protected).

217. See Warnecke, *supra* note 18, at 730 (stating that one of the hallmarks of postmodern artists revolves around the almost total appropriation of "original works" to make their commentaries).

In contrast, if the print or painting merely glorifies a celebrity, the appropriation should be given much less protection from a right of publicity claim because the artist adds nothing new to societal discourse.²¹⁸ Less protection is justified because the celebrity already disseminates that part of societal discourse (positive celebrity characterizations).²¹⁹ The celebrities position themselves in a positive light and that slice of public discourse should belong to the celebrity alone to exploit economically.²²⁰ That does not mean an artist can never portray a celebrity in glowing terms; it only means that when it comes to profiting off of such views the celebrity's right of publicity claim controls.²²¹

Critics might argue that this serves to deceive the public or to give the celebrity monopolistic control over their image.²²² However, this argument seems unpersuasive given that, in order to prevent deception, all sides of the issue must be presented to the public.²²³ The celebrity's view of himself becomes crucial in telling his view of who he is; others in society can then dispute, disagree, or present their own views about the celebrity.²²⁴ If the key First Amendment consideration revolves around the dissemination of ideas, then restricting the artist's economic profit based on a celebrity's glorification does not limit this dissemination because the celebrity would only have monetary control over one channel of societal discourse—her positive portrayal.²²⁵

218. See *supra* text accompanying notes 121–54 (noting that First Amendment protections against publicity rights serve to disseminate new ideas).

219. See, e.g., Gibeaut, *supra* note 2, at 47 (stating that after Tiger Woods won the Masters, “he catapulted to second place on *Forbes* magazine’s 1997 list of top athlete”).

220. See *supra* text accompanying notes 63–84 (explaining the three major justifications for protecting a celebrity’s economic rights in their name, likeness or persona).

221. See *supra* text accompanying notes 63–84 (detailing situations where a celebrity’s right of publicity should bow to countervailing policy considerations).

222. See *supra* text accompanying notes 85–90 (explaining that a celebrity’s image may not be a result of the celebrity’s efforts alone, but also attributable to the help of others or “dumb luck”).

223. See *supra* text accompanying notes 97–104 (noting that the court in *Nature’s Way Prods., Inc. v. Nature-Pharma, Inc.*, 736 F. Supp. 245 (D. Utah 1990), while protecting the plaintiff’s right to publicity, recognized that the decision would restrict consumers’ access to helpful purchasing information).

224. See *supra* text accompanying note 92 (explaining that celebrities are required to participate in various channels of discourse).

225. See *supra* text accompanying notes 105–20 (discussing the tension between the First Amendment freedoms and trademark and copyright law protections).

2. Nature of the Use

A second determination a court should make resides with the nature of the challenged use.²²⁶ Such a determination focuses on whether the artist appropriates a celebrity's image for predominantly financial or artistic reasons, and harkens to the distinction between commercial and noncommercial speech.²²⁷ Therefore, the key test depends on whether the artist exploits the celebrity's image or name primarily to make money or if the artist's financial gain plays a secondary role to the message disseminated.²²⁸ Again, if the artwork merely glorifies the celebrity and truly becomes nothing more than a poster, then artistic claims rest on shaky First Amendment foundations.²²⁹ In this case the artwork itself is commercial speech and ultimately subject to stricter control.²³⁰ In addition, courts should scrutinize the context of how the artist sells the artwork.²³¹ If an art gallery sells the challenged work then it becomes more likely that artistic motives dominate; if the artist sells his work at a sports convention, memorabilia stores, or through catalogues, then a court could infer more of a financial motivation.²³² A court should also take the reputation of the artist into account.²³³ If Andy Warhol or Picasso or some other recognized artist creates images utilizing celebrities, the work probably does not reflect purely financial motives.²³⁴ On the other hand, if a publishing firm hires

226. See *supra* text accompanying notes 201–02 (proposing that the copyright fair use factors should be appropriated in right of publicity analysis).

227. See *supra* text accompanying notes 105–56 (describing the various First Amendment protections afforded to commercial and noncommercial speech).

228. See 17 U.S.C. § 107 (1994) (noting that the economic benefit to the appropriator should be considered).

229. See *supra* text accompanying notes 157–93 (explaining how courts have applied the fair use doctrine in determining whether use of another's trademark is permissible).

230. See *supra* text accompanying notes 166–93 (describing when courts have permitted use of another's trademark in parodies and other forms of artistic expression).

231. See Vetter & Roche, *supra* note 16, at 49 (discussing how, in the context of artistic use and parody, an appropriation of a celebrity's likeness receives free speech protections).

232. See 17 U.S.C. § 107 (1994) (indicating that the "purpose and character of the use" is a helpful factor when courts decide copyright infringement cases); see *supra* text accompanying notes 201–02 (proposing the adoption of copyright factors in publicity analysis).

233. See Gibeaut, *supra* note 2, at 47 (noting that artist Rick Rush began his career twenty-three years ago); see also Vetter & Roche, *supra* note 16, at 38 (describing Jeff Koons as a postmodern artist).

234. See Warnecke, *supra* note 18, at 730–31 (illustrating how artist Jeff Koons' fame results in the high prices for his works, implying that the copied work may not have as high a financial impact on Koon's work); see also *Rogers v. Koons*, 960 F.2d 301, 313 (2d Cir. 1992) (citing *Frank Music Corp. v. Metro-Goldwyn-Mayer Inc.*, 886 F.2d 1545, 1549 (9th Cir. 1989) ("Where a defendant alters infringing material to suit its own unique

a pool of relatively unknown artists to create a work and then distributes it by the thousands, then the purely artistic aesthetic diminishes and thus, so should its First Amendment protection in a right of publicity suit.²³⁵ That does not mean that every work by an unknown artist violates a celebrity's right of publicity. The relative exposure of the artist merely becomes another tool or factor for the court to consider in right of publicity claims.

The most reliable indicator in this test remains how much money the artist stands to gain from the appropriation of a celebrity's image.²³⁶ However, people like Koons, Warhol, or any nationally known artist automatically do not lose protections because of the high price tag that their art garners.²³⁷ They would still have protections because the high prices garnered become possible through the celebrity status of the artist himself and not through the appropriation of the image.²³⁸ Further, a Warhol painting would not negatively affect a celebrity or athlete because it would rarely enter the same market as the celebrity or athlete's endorsements.²³⁹ It would seem highly unlikely that a Michael Jordan would hire a Koons or Warhol to paint his portrait and then market the image. On the other hand, an unknown artist standing to gain enormous financial rewards through high production and distribution intrudes on the celebrity's endorsement market and indicates a primarily economic motive for the appropriations.²⁴⁰

purposes, those alterations and the creativity behind them should be taken into account in apportioning the profits of the infringing work.”).

235. See Stan Hochman, *Painting Controversy Raises Privacy Issues*, PITTSBURGH POST-GAZETTE, Mar. 28, 1999, at D11 (quoting Bill Goff of Bill Goff Inc./Good Sports Presents as stating that an artist crosses the line from First Amendment protection into copyright infringement “once [she] take[s] somebody's name and likeness and start[s] to reproduce them for commercial purposes”).

236. See 17 U.S.C. § 107 (1994) (listing economic gain as a factor for a court to consider); Warnecke, *supra* note 18, at 720 (stating that the key to determining whether the copying violates the fair use doctrine is “whether the copier stands to profit”).

237. See Warnecke, *supra* note 18, at 711 (arguing that all art remains both “educational and commercial” and that the “educational [purpose] should trump the fact that the artist makes a profit”).

238. See *Rogers*, 960 F.2d at 313 (permitting Koons to retain profits that derive solely from his own position in the art world).

239. See WEILER & ROBERTS, *supra* note 1, at 390 (noting that some of an athlete's endorsement profits derive from sports cards, Nike, Reebok, and from other merchandising firms).

240. See *supra* text accompanying notes 218–21 (explaining that when an artist merely glorifies a celebrity for profit, the celebrity's right to publicity controls).

3. Frequency of Use

The third question that a court should ask concerns the frequency of the appropriation.²⁴¹ This factor primarily rests on the number of art pieces the artist offers for sale.²⁴² If an artist paints one picture utilizing a celebrity's name or likeness, then such appropriation becomes less susceptible to a right of publicity suit.²⁴³ In contrast, if the artist produces 10,000 poster prints from a single painting depicting a slam-dunk, then the First Amendment claims should be viewed with a dubious eye.²⁴⁴ Every multi-edition work would not lose constitutional protections. The inquiry into the financial stakes is merely one factor among many for consideration. *Wayne Enterprises v. The Upstairs Gallery, Inc.*,²⁴⁵ illustrates how multiple editions can be protected.²⁴⁶ There the Andy Warhol Foundation produced limited edition silk-screens depicting John Wayne.²⁴⁷ The use prompted a suit by the John Wayne estate, but the Los Angeles Superior Court agreed with the defendants that the multiple edition work enjoys First Amendment protection.²⁴⁸

4. Effect of Use on Celebrity's Economic Value

The final question a court should ask involves what effect the artist's use will have on the celebrity's economic value.²⁴⁹ The key test resides with whether the use destroys the celebrity's ability to profit from his status or merely has a negligible economic impact.²⁵⁰ Thus, if an artist paints one or two works

241. See 17 U.S.C. § 107 (1994) (stating that "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes" is a factor to be considered in determining whether the use made of the work is fair).

242. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 568 (1985) (discussing how widespread use of the copyrighted work affects the market for the original work).

243. See *Wayne Enterprises v. Upstairs Gallery, Inc.*, No. C627-183 (La. Sup. Ct. Dec. 3, 1986) (noting how California law exempted single works of art from right of publicity claims), *construed in* *Vetter & Roche*, *supra* note 16, at 49.

244. The painting would not benefit society and thus should not be protected. See *Warnecke*, *supra* note 18, at 722 (pointing out that the *Rogers* court weighed the benefits of Koons' sculpture to society).

245. No. C627-183 (La. Sup. Ct. Dec. 3, 1986), *construed in* *Vetter & Roche*, *supra* note 16, at 49.

246. See *Vetter & Roche*, *supra* note 16, at 49.

247. See *id.*

248. See *id.*

249. See 17 U.S.C. § 107 (1994) (stating that "the effect of the use upon the potential market for or value of the copyrighted work" is a factor for determining whether the use made of a work in any particular case is a fair use).

250. In the context of fair use of a copyrighted work, some courts apply the following

with a celebrity's image and sells them, that appropriation probably will not greatly affect the celebrity's ability to license out her likeness or profit from it.²⁵¹ However, and this is especially important for athletes, if an artist takes a photograph and creates thousands of prints for sale, that use would have a greater likelihood of destroying the celebrity's ability to control their image or to license it.²⁵² Otherwise, a poster company would not pay an athlete money for the exclusive rights to produce and sell the athlete's poster when anyone could paint a picture, claim First Amendment artistic protections, and then manufacture, distribute, and sell thousands of prints to the public.²⁵³ Courts should take it very seriously when Bill Goff, head of Bill Goff Inc./Good Sports Presents, states "[f]or me, it's a win-win situation. Should Rush prevail, that would free me to do things without license fees. Should Woods prevail, then its business as usual."²⁵⁴ Even though a court should balance all the proposed factors, the Supreme Court has held that the economic factor remains the most important issue for a court to examine.²⁵⁵ Therefore, it is important to consider the economic justifications regarding the right of publicity.²⁵⁶

First, Goff, and people like him, can be thought of as being the communal herdsmen discussed earlier in this Comment.²⁵⁷ If Woods and other celebrities cannot prevent the appropriation of their likenesses, these herdsmen would realize no cost for their

two presumptions: (1) that the appropriated use of the work is commercial; and (2) commercial uses are unfair and result in harm to the copyrighted work's market. See Warnecke, *supra* note 18, at 733 (citing William F. Patry & Shira Perlmutter, *Fair Use Misconducted: Profit Presumptions, and Parody*, 11 CARDOZO ARTS & ENT. L.J. 667, 706 (1993)). Applying these presumptions to publicity rights, if an appropriator profits from the work then the presumptions should apply. Therefore, if there is a market for the celebrity, then the appropriated use is presumed to be harmful to that market. *Id.*

251. See *supra* text accompanying note 240.

252. See Gibeaut, *supra* note 2, at 47 (noting that lawyers for celebrities "say Rush and others are just pirates who rob famous people of their own chances to market themselves and control how they are depicted").

253. See Hochman, *supra* note 235, at D11 (quoting Bill Goff, head of Bill Goff Inc./Good Sports Presents, stating that "[s]hould Mr. Rush prevail, that would free me to do things without license fees"); see also Chambers, *supra* note 9, at 2 (describing how Rick Rush has his own publishing firm to manufacture his large editions).

254. Hochman, *supra* note 235, at D11.

255. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985); see also Warnecke, *supra* note 18, at 732-33 (discussing the rationale and application of the four copyright factors).

256. See *supra* Part II.C (discussing, in greater detail, the moral, economic, and consumer protection rationales that justify the right of publicity's existence).

257. See *supra* notes 73-80 and accompanying text (discussing Posner's "static" economic benefits theory and providing an example of resource depletion caused by self-interested defensive activities).

use.²⁵⁸ Goff would then be able to ignore the real costs to the economic viability of a celebrity's image overuse would cause; he would produce more and more posters to maximize his own economic gain.²⁵⁹ Others, similarly situated as Goff, would feel "compelled" to increase their use of a star's image to match the increase in use by their competitors, like Goff.²⁶⁰ In the end, this massive over-use would "grind the common pasture [the economic viability of the celebrity's image] into dust."²⁶¹ This analysis evokes that of *Zacchini v. Scripps-Howard Broadcasting Co.*, which illustrates how the right of publicity trumps First Amendment concerns when the unauthorized use destroys the economic value of a celebrity's act.²⁶²

B. *The Proposed Standard and its Effect on Tiger Woods and Artist Rick Rush*

Applying the above factors to the dispute between Tiger Woods and Rick Rush not only rectifies the suit but also serves to clarify the boundaries between free speech and economic rights for future artists and celebrities. First, the court would determine what exactly Rick Rush expresses in his painting of Woods' Masters win.²⁶³ The painting neither criticizes nor parodies Tiger Woods. Rather, the painting seems to glorify Tiger Woods, placing him in the same pantheon as other golfing giants who have won the Masters, in that Woods resides in the forefront of the composition with the other Masters winners behind.²⁶⁴ The painting appears to be no different than commercials, posters, sports cards, or other memorabilia for which distributors ordinarily pay Tiger Woods a royalty or licensing fee because the artwork portrays Woods as a hero/idol—just like every other advertisement. Accordingly, one

258. See *supra* note 77 and accompanying text. Similar to herdsmen who are allowed to appropriate pasture for grazing without incurring any cost, modern day entrepreneurs could appropriate the celebrity's image without incurring any cost. See *supra* note 77 and accompanying text.

259. See *supra* note 78 and accompanying text.

260. See *supra* note 78 and accompanying text.

261. See *supra* note 79 and accompanying text. The analogy is that even though overuse would ruin the profitability of the resource (i.e. the celebrity's image), competitors would engage in the same activities as Goff to prevent from becoming entrenched in an economically disadvantaged position.

262. See *supra* notes 134–40 and accompanying text. But see *supra* notes 121–24 and accompanying text (noting that the right of publicity cannot violate the First Amendment guarantees of the Constitution).

263. See *supra* notes 166–91 and accompanying text (demonstrating courts' strict requirements for classifying a work as a critique, satire or parody before it can be granted First Amendment protection against Lanham Act claims).

264. See Gibeaut, *supra* note 2, at 50 (detailing Rush's imagery).

could strongly argue that Rush's work adds nothing new or pertinent to societal discourse. He merely paints nice pictures of Tiger Woods, glorifying him as do countless other Tiger Woods' commercial and sporting endeavors. Rush intrudes, therefore, on that slice of societal discourse from which Tiger Woods occupies and profits.²⁶⁵ If Rush had parodied Woods or even openly criticized him, then Rush's use of Tiger's image should receive First Amendment protection because such use would provide the public with a visual viewpoint that Tiger Woods or his licensing agencies do not already or would ever want to provide.²⁶⁶

Next, the court should look to the nature of Rush's use of Tiger Woods' image or name, and whether it signifies commercial or more protected artistic speech.²⁶⁷ The court should then look to Rick Rush's reputation as an artist.²⁶⁸ Although he has been painting for twenty-three years,²⁶⁹ nothing has been shown to suggest that the art community considers him a legitimate member. It may seem harsh that one type of art should capture constitutional protections rather than another, but the proper focus is to address who should profit from these types of depiction. The Second Circuit, in giving First Amendment protections to visual expression, stated "[o]ne cannot look at Winslow Homer's paintings . . . without seeing . . . the idea that war is not heroic."²⁷⁰ In the case of Rick Rush, can one legitimately argue that showing Tiger Woods swinging a golf club engenders such sentiments?²⁷¹ Moreover, the fact that Rush stands to gain a quarter of a million dollars from his art²⁷² also calls into question his artistic credibility. Rush cannot generate this type of money without Tiger Woods' image or the large number of prints.

265. See *id.* at 47 (noting that ETW Corp. sued Rush for trademark infringement and a violation of Woods' state law right to profit from his own image).

266. See Kaplan, *supra* note 85, at 63 (arguing that "granting image-control to the celebrity . . . assures that only [his or her] approved version is presented"); see also Warnecke, *supra* note 18, at 722 (noting how criticism and comment, which encompasses parody or satire, foster the creativity copyright law is supposed to protect in the first place).

267. See *supra* notes 201–62 and accompanying text (discussing proposed standards for exempting artistic works from suit).

268. See *Rogers v. Koons*, 960 F.2d 301, 313 (2d Cir. 1992) (admitting that Koons' "notoriety" accounts for the high price he charges for his work).

269. See Gibeaut, *supra* note 2, at 47.

270. *City of New York v. Bery*, 97 F.3d 689, 695 (2d Cir. 1996).

271. Rick Rush boldly asserted that his paintings express the best moments of life: "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." See *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829, 835 (N.D. Ohio 2000).

272. See Gibeaut, *supra* note 2, at 47–48 (confirming the large amounts of money at stake).

Thus, Rush does not sell his work because of his own reputation or fame—he merely piggybacks on another's.

The next consideration that a court should make, which closely relates to the second, concerns the frequency of Rush's use of Tiger Woods' name or likeness.²⁷³ The more an artist appropriates a celebrity's image or name, the less likely the use derives primarily from artistic considerations.²⁷⁴ The mere fact that an artist utilizes multiple editions does not automatically restrict First Amendment protections.²⁷⁵ However, the frequency of use solidifies whether the artist creates primarily to make a buck or to inject some ideas into public discourse.²⁷⁶ Rick Rush does not simply paint one or two Tiger Woods pieces; rather, he offers over 5000 for public consumption.²⁷⁷ Furthermore, Rush owns a publishing firm,²⁷⁸ which can distribute these vast amounts of prints for public consumption and economic profit—he does not distribute through an art gallery like many artists. Even Andy Warhol, who created vast amounts of multi-edition celebrity prints, paintings, and silk-screens, did not have a publishing firm to disseminate his art to the public.²⁷⁹

Some might contend that an artist, to effectively disseminate his message, must or should use mass printing.²⁸⁰ On the other hand, should not an artist first have a message to mass distribute? It seems that Rush only glorifies Woods and does not add any new ideas or commentary about the golfer that Tiger Woods himself has not already put forth. If the primary justification for First Amendment protection centers on idea dissemination, then it would be more efficient for Tiger Woods to control the discourse of his image because he has advertisers, newspapers, and other media eager to print his ideas or message.²⁸¹ But, if others can economically exploit positive portrayals of the golfer, then there would be less economic incentive for Woods to put out his

273. See *supra* notes 241–48 and accompanying text (discussing the “frequency of use” factor in determining whether an artistic work should receive First Amendment protection).

274. See *supra* notes 241–48 and accompanying text.

275. See, e.g., Vetter & Roche, *supra* note 16, at 44 (citing *Wayne Enterprises v. The Upstairs Gallery, Inc.*, No. C627-183 (La. Sup. Ct. Dec. 3, 1986) (agreeing with the Andy Warhol Foundation that multi-edition silk-screens did not violate publicity laws)).

276. See *supra* notes 241–48 and accompanying text.

277. See Gibeaut, *supra* note 2, at 47.

278. See Chambers, *supra* note 9, at 1.

279. See H.W. JANSON, *HISTORY OF ART* 750–51 (4th ed. 1991) (discussing the artistic techniques and contributions of Andy Warhol, a preeminent American artist).

280. See *supra* notes 26–27 and accompanying text (describing how the Founding Fathers utilized mass dissemination of their images to distribute their message).

281. See *supra* notes 69–72 and accompanying text (discussing the “dynamic” economic incentives the right of publicity protects).

message.²⁸² Certainly, if graphic art companies do not need licenses from Woods, then why would these companies allow Woods to control what they put out?²⁸³ Could it be that Woods would have to pay these companies to have his personally approved posters in the stream of societal discourse?

The last and the most important question a court should resolve deals with the economic impact on Tiger Woods if Rick Rush can successfully sell his prints without interference.²⁸⁴ Besides winning tournaments and endorsing products in advertisements, Tiger Woods could potentially exploit the sports poster market much like Michael Jordan has done in the past.²⁸⁵ If Rick Rush can merchandise his posters unfettered, then that possible economic arena could disappear. In the alternative, such use could adversely affect any already existing poster licensing deals. Rush would destroy this market because he, or any self proclaimed artist, could paint or photograph their own celebrity portrait and then produce hundreds, thousands, or even millions of prints from these initial works.²⁸⁶ In addition, the artist could distribute and flood the market with such posters, reducing the profit for poster merchants who pay for Woods' permission to use his name and likeness.²⁸⁷ The motivation for poster or art companies to pay for Tiger Woods' authorization would dry up because of diminishing profit margins and the newly created incentive to hire their own artists. Therefore, Tiger Woods would be stuck in a position where others, not authorized by him, use his image, name, and success to profit handsomely, all the while claiming the guise of First Amendment artistic expression.²⁸⁸ It seems shockingly clear that to allow wholesale publication by Rick Rush could potentially destroy any property rights a celebrity would have in their name or image to the

282. See *supra* notes 73–80 and accompanying text (presenting the dangers of “community” property ownership).

283. See *supra* notes 249–56 and accompanying text (showing how artists like Rick Rush could destroy a celebrity’s ability to license out his or her image).

284. See *supra* notes 249–56 and accompanying text (discussing the effect of non-authorized use on a celebrity’s economic value).

285. See Gibeaut, *supra* note 2, at 47 (noting that Woods could potentially earn one billion dollars over his lifetime); see also WEILER & ROBERTS, *supra* note 1, at 390–91 (noting the success of Michael Jordan’s various commercial ventures, and the large deals Tiger Woods was able to secure just as he was beginning his PGA career).

286. See Gibeaut, *supra* note 2, at 47 (quoting ETW’s lawyer, Timothy P. Fraelich, as saying that someone like Rush act only as a “parasite . . . trying to make money off another human being’s image”).

287. See Hochman, *supra* note 235, at D11 (quoting Bill Goff, the head of a production company of sports representation, noting that if Rush prevails, he can ignore his licensing agreements; if Woods prevails, its “business as usual”).

288. See Gibeaut, *supra* note 2, at 47 (describing Rush’s reliance on the First Amendment in the suit against Woods).

extent that Benjamin Franklin so begrudgingly accepted over two centuries ago.²⁸⁹ From the totality of the circumstances, especially in viewing the potential adverse economic impact to Woods, Rick Rush, and others like him, should not be able to claim First Amendment safeguards against a right of publicity claim. The simple truth remains that under the proposed right of publicity factors, Rick Rush's works and free speech claims do not outweigh Tiger Woods right of publicity.

V. CONCLUSION

Perhaps a certain segment of society resents celebrities because they have too much money. Others may truly believe that the right of publicity, as used by celebrities, denies First Amendment freedom and monopolizes information. These concerns remain valid, and courts should consider them when addressing a celebrity's right of publicity. However, these critics and commentators must understand that through reasonable use, the right of publicity can serve as a tool in protecting legitimate economic interests. Thus, the key has always been to find a balance; a balance that protects public freedoms and private property.

The four-part test advocated in this comment satisfies this demand. It recognizes that some speech, such as news reports, parody, satire, or criticism, will always be safeguarded against a celebrity's claim, no matter how detrimental to the celebrity's pecuniary status. In contrast, this balancing test gives wide economic protection to a celebrity when it comes to her glorification. This means that if an individual appropriates an image merely to glorify and profit from a celebrity, that use will not be protected. However, only the economic use of such glorification loses constitutional protections. Consequently, a person's right to glorify a celebrity who provides a great or a positive force to society should be protected, but such protection should end when the person starts to profit from such portrayals. Without such protection, the economic licensing ability of the celebrity would become negligible. Moreover, such protections do not inhibit treasured societal discourse, because they only prevent a sliver of expression that the celebrity herself will ensure gets into the mainstream of ideas. Therefore, if both the individual and celebrity put out positive images of the celebrity, it would not harm society to prevent the individual from profiting from such use because the celebrity

289. See *supra* notes 22–25 and accompanying text (detailing the indignities suffered by Franklin).

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remains the distributor of the message. If there were no economic protections afforded by the right of publicity the only one to be hurt would be the celebrity.

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