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Consultants Corner

Tiger Woods & Publicity Rights v. Artists Who Portray Famous Images: Who'll End Up In The Rough?

By Michael Vitt, J.D.

Regardless of their level of passion for golf, spectators of the intellectual property field are keeping a keen eye on a contest involving Tiger Woods, Meritas member firms report. The match pits the "right of publicity" against the right of free, artistic expression.

The final results of *ETW Corp. v. Jireh Publishing, Inc.* will directly affect the business of some, while bearing implications for many others regarding business promotion methods and protection of trademarks and images.

The 6th Circuit Court of Appeals is expected to rule in the case imminently, Meritas intellectual property experts advise — although the court had not ruled by press time for this article. Meritas is an international alliance of business law firms, whose intellectual property lawyers worldwide are watching this case. Some observers expect the final round to be played out before the U.S. Supreme Court.

The match began when artist Rich Rush produced a limited edition print depicting Woods golfing at The Masters

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tournament in 1997, in which he became the first African-American and Asian-American to win, explains Oscar Alcantara, of the Meritas firm in Chicago — Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd. The print also depicted other legendary golfers in the background.

Woods's licensing agent, ETW ("Eldrick 'Tiger' Woods") Corp., sued Rush's publishing company, which was selling 250 serigraphs and 5,000 smaller lithographs, Alcantara explains. A federal district court in Ohio issued a summary judgment against ETW's claims of trademark infringement and violation of Woods's common law right of publicity. (*ETW Corp. v. Jireh Publishing, Inc.*, 99 F.Supp. 829 (N.D. Ohio, 2000.))

The court ruled that the First Amendment protected Rush's right to artistic expression, even if he sold his work for profit. The court also ruled that there had been no trademark infringement, because Woods's name did not appear on the print and the public would not be misled into thinking that Woods was its source.

When Woods appealed, *amici* on both sides of the issue flocked to submit briefs, Alcantara observes. The pivotal issue: whether artists' sale of their works amounts to "commercial use."

The right of publicity has evolved from the common law right of privacy, explains Julia Frey, of the Meritas member firm in Orlando, Fla. — Lowndes, Drosdick, Doster, Kantor & Reed, P.A. It stems particularly from what the Restatement of Torts describes as "the right to prohibit the misappropriation of

one's name or likeness for another's benefit or advantage," Frey notes.

"The right of publicity gives an individual the exclusive right to exploit his or her identity, name or likeness for commercial purposes," Frey says. At least 24 states have recognized the right of publicity through case law, statute or both, she reports.

Both Frey and Alcantara observe that the right of publicity varies from state to state, regarding whom and what it protects, and whether it is assignable and descendible (and, if so, for what duration). In some states, it prohibits unauthorized imitations of voice or appearance; in others, it does not. Jurisdictions differ on whether one must be famous (with a commercially exploitable identity) to invoke protection.

"The right of publicity is probably the strangest and certainly the least intellectual form of intellectual property," says Michael J. Higgins, of the Meritas member firm in San Francisco, Farella Braun Martel LLP. Higgins explains that a 1953 decision by the 2nd Circuit Court of Appeals (*Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866) and subsequent influential commentaries led to treatment of the right of publicity predominantly as a property right.

Higgins notes that, viewed merely as a property interest, the right of publicity has come under fierce attack in recent years. Higgins argues that it should also protect individuals' dignitary interests.

Intellectual property law experts note that jurisdictions' conclusions have diverged about when First Amendment

interests should prevail over right of publicity interests.

In contrast to the Ohio federal court, last year the California Supreme Court concluded that a statutory right of publicity overrode the First Amendment rights of an artist who had rendered an unauthorized charcoal portrait of the Three Stooges and produced T-shirts and lithographs bearing it. In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001), the court ruled that an artist's First Amendment interests would prevail only if "the work in question adds significant creative elements so as to be transformed into something more than celebrity likeness or imitation."

Alcantara, of the Chicago Meritas firm, notes that the final outcome of the Tiger Woods litigation will impact directly on the business of companies like Woods' or Michael Jordan's, sports teams and leagues, and licensing agencies. However, he says, it is the rivalry between the First Amendment and the right of publicity that has intellectual property law observers packing the gallery for the Tiger Woods case.

"The most far-reaching impact of the decision will be on the way that First Amendment concerns are pitted against intellectual property rights, generally speaking — which could include trademark and copyright claims in the future," Alcantara comments. "This case might establish precedent for the reach of the First Amendment in traditional trademark cases — cases in which business corporations are more likely to be involved."

The prospect that the impact of the Woods case decision could veer into the trademark field concerns Linda Tancs, of the Meritas member firm in New Jersey

— Norris, McLaughlin & Marcus, P.A.

Tancs comments: "The use of common law rights of publicity to redress claims of trademark infringement invites the potential for inconsistent application, not to mention the stifling of creative expression. If a claim based on the right of publicity were to prevail in the Woods appeal, then any celebrated figure could be deemed to possess a moral entitlement to control the product of another's intellectual labor relating to that figure, regardless of whether the artist's product is likely to be confused with a product offered by the celebrity or whether it impedes the celebrity's ability to offer its own product in the marketplace."

Some observers — noting the use of widely recognized product images by pop artists like the late Andy Warhol (who prospered by portraying Campbell's Soup cans, Brillo boxes and Coca-Cola bottles) — wonder if the final Woods case decision will carry implications for trademark dilution, here and elsewhere.

Duk Yeul Baek, of Lee & Ko, the Meritas firm in Seoul, Korea, thinks so. "Concerns about trademark dilution are relevant here."

Under Colombian law, they would be relevant too, suggests Mauricio Jaramillo, the Meritas firm in Bogota — Gomez Pinzon, Linares, Samper, Suarez, Villamil & Asociados, Abogados S.A. Jaramillo comments that artists' unauthorized reproductions of images "undermine the celebrity's or trademark's marketing efforts and deprive him/her or the trademark's owner from their economic rewards; therefore, this would be a case of misappropriation of others' rights, because the artists are profiting by the fame of the celebrity or of the

trademark."

In the United Kingdom, Tiger Woods probably would fare no better with his right of publicity claim than he did in the British Open tournament this year, speculates Chris Parkinson, of the Meritas firm in London, England — Finers Stephens Innocent. Parkinson says, "It is clear in the UK that, in the absence of other remedies (e.g. libel, defamation, breach of copyright, breach of confidence, etc.), where freedom of expression under the Human Rights Act comes up against the right to privacy under the same act, the freedom of expression will tend to prevail, where the recipient of the attention is a celebrity and the focus of that attention is on the very part of their lives to which they have, in other circumstances in the past, drawn attention."

Dutch and other European courts might confront issues similar to those in the U.S., suggests Philip van Huizen, of Koster & Claassen, the Meritas firm in Rotterdam. "It is generally accepted in Dutch jurisprudence that a sportsman or an artist has the exclusive right to explore commercially his achievements. So it follows that in principle the portraitist has a right of copy unless he is using the portrait of the sportsman/artist in a commercial way."

In the U.S., a federal standard could end the uncertainty of the current legal patchwork on this issue, Alcantara says. Some intellectual property law groups are drafting proposals for a pre-emptive federal statute, he reports. Meanwhile, the Woods case's First Amendment issues could attract the U.S. Supreme Court — which then could determine what should be par for the course regarding the right of publicity.