

## ARTICLES

# **Artists and Athletes: Balancing the First Amendment and the Right of Publicity in Sport Celebrity Portraits**

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### I. INTRODUCTION

For centuries, artists have painted the portraits of noteworthy members of society, ranging from kings and queens to nobles, celebrities, and athletes. From the prehistoric cave drawings of Lascaux to Leonardo Da Vinci's portrayal of Mona Lisa, portraiture has served important historical and cultural roles in world history.

Not everyone, however, wants their picture painted. In the sport marketplace, where a professional athlete's image can be worth millions of dollars, some athletes have resorted to litigation to guard against the unauthorized use of their persona. In contrast are sport artists who seek to convey the world of sport in artistic form — a form of expression typically shielded by the First Amendment.

This article addresses a professional athlete's right to control his or her image under the right of publicity versus a sport artist's First Amendment right to paint an athlete's portrait. The prevailing issue rests on whether sport art is commercial merchandise in disguise or a form of protected expression.

### II. ARTISTIC EXPRESSION AND PORTRAITURE

Individual interpretive expression dates back to the beginning of human civilization to the Paleolithic, Mesolithic, and Neolithic time periods and has

appeared in every culture since.<sup>1</sup> One common form of individual expression is the ancient practice of painting. Thousands of years ago, the earliest painters served as guardians of prehistoric culture by recording the thoughts, feelings, and achievements of society. Without paintings, historians would have few visual cues of ancient rulers, landscapes, and events of historical significance. Several millennia later, these ancient paintings help us imagine what life was like and who and what were important.

Like other disciplines, painting has evolved from its prehistoric days when humans scrounged pigments from the earth and copied drawings of animals on cave walls. As civilization has advanced, so did painting. Likewise, portraiture, the act of creating one's own or another person's likeness, exhibits a rich and prominent past. Until the invention of the camera, portraits were the only method of recording a person's image.<sup>2</sup> Throughout history, artists have used portraiture in an attempt to portray everything from angels and athletes to God himself. Believing that there is more to glean from artistic representations of individuals than a person's hairstyle, eye color, or physical stature, portraiture is said to be an attempt to capture the meaning and essence of humanity itself by capturing a subject's persona.<sup>3</sup> Said differently, portraiture is "the art that immortalizes."<sup>4</sup>

Because of society's longing to venerate their favorite sport teams and sport stars, it is not surprising that this art form has also widely been used in sport. Trophies, statues, and pictures are used not only to reward the victors, but also to memorialize sporting achievements. The commemoration of sporting events and athletes, however, is not new concepts, but rather an ancient practice dating back to the fifth century B.C. when Olympic heroes were as revered as today's sport icons.<sup>5</sup> Long before Michael Jordan became the template of commercial endorsements and sport memorabilia products, the Greeks and Romans enshrined their athletes in marble statues, wooden figurines, clay pottery, and silver coins.<sup>6</sup> Today's bobble-head dolls, team

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1. E.H. GOMBRICH, *THE STORY OF ART* 39-43 (16th ed. 1995).

2. Artists have portrayed humans as "omens and sacred fetishes, divine beings and historical personages, a part of nature and conquerors of nature, passionate individuals and part of a mass consciousness, subjects of experimentation and icons of self." Net Kinnections, Inc., *A History of portraiture: Postmodernism: Pop Art and Portraiture Today*, at <http://www.netkin.com/portraits/history/history8.php3> (last visited Nov. 7, 2003).

3. *Id.*

4. *Id.*

5. G. Crane, *Athletes' Stories*, at <http://www.perseus.tufts.edu/Olympics/stories.html> (last visited at April 27, 2004).

6. University of Pennsylvania Museum of Archeology and Anthropology, *Are Today's Olympians Too Commercial? Depends...*, *THE REAL STORY OF THE ANCIENT OLYMPIC GAMES*, at

posters, and baseball cards are mere byproducts of ancient phenomena that fall within portraiture's lineage.

Given the great diversity of human action in sport and its colorful physical settings, sport naturally lends itself to the inventiveness and creativity of artists.<sup>7</sup> Just as Picasso painted the pageantry of Spanish bullfighters in the 1960s, contemporary artists capture sporting heroes in their own form. While the human desire to portray athletes has not changed for thousands of years, the long-standing tradition of "professional courtesy" has changed. In the past, artists would simply paint a series of portraits, give one to the athlete, and then sell the remainder. The progression of the right of publicity doctrine, however, has all but abolished this customary practice. Although the commercialization of sport and athletes is much the same today as it was in ancient Rome,<sup>8</sup> the practice of professional athletes protecting their self-image has changed dramatically. Many of today's highly paid professional athletes have resorted to litigation to protect their images, including Michael Jordan, Tiger Woods, and Muhammad Ali, to name a few.<sup>9</sup> In contrast to those professional athletes who attempt to protect their image at all cost are sport artists who seek to cover their blank canvasses with one of society's most beloved subjects – sport celebrities.

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### III. THE RIGHT OF PUBLICITY AND PROFESSIONAL ATHLETES

A person's right to control the commercial use of his or her name and likeness falls under the legal theory known as "the right of publicity."<sup>10</sup> The right of publicity protects professional athletes' marketable identities from commercial misappropriation by recognizing their right to control and profit

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<http://www.museum.upenn.edu/new/Olympics/olympiccommercialism.html> (last visited April 27, 2004).

7. J. Carter Brown, *[Sport and Art]. Introduction 1* (Aug. 26, 2003) (unpublished manuscript, on file with the National Art Museum of Sport).

8. Gladiators were highly paid professional athletes whose images were commemorated in works of art. See Roger Dunkle, *Roman Gladiatorial Games*, at <http://dephome.brooklyn.cuny.edu/classics/gladiatr/> (last modified Aug. 11, 2002).

9. Laura Lee Stapleton & Matt McMurphy, *The Professional Athlete's Right of Publicity*, 10 MARQ. SPORTS L.J. 23, 23 (1999).

10. The right of publicity is said to be "the inherent right of every human being to control the commercial use of his or her identity." 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 28:1, at 28-3 (4th ed. 2000).

from the use of their names<sup>11</sup> and nicknames,<sup>12</sup> likenesses,<sup>13</sup> performances,<sup>14</sup> biographical facts,<sup>15</sup> symbolic representations,<sup>16</sup> or essentially anything else that evokes another's marketable identity,<sup>17</sup> such as the commercial use of a professional athlete's portrait.<sup>18</sup> Although the right of publicity is a relatively new body of law, it has opened the door for professional athletes to earn more money from endorsement contracts than from the annual salary or earnings of their respective sport.<sup>19</sup>

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11. *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (9th Cir. 1996). *But see Vinci v. Am. Can Co.*, 591 N.E.2d 793, 794 (Ohio App. 3d 1990) (mentioning athletes' names and accomplishments were considered historical information and incidental to the promotion of Dixie Cups). In addition, some courts have refused to extend the right of publicity to bar the use of a celebrity's name in the title and text of a fiction or semi-fictional book or movie. *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978); *Guglielmi v. Spelling-Goldberg Prod's*, 603 P.2d 454, 455 (Cal. 1979).

12. *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979) (deciding a dispute between a former professional football player and a shaving gel manufacturer concerning the use of Hirsch's nickname, "Crazylegs").

13. *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (holding that a nude drawing of an African American male seated in a boxing ring evoked Muhammad Ali's marketable identity and violated his right of publicity).

14. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (holding that the broadcast of a performer's entire act in a news program violated the performer's right of publicity); *see also Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 681 (7th Cir. 1986) (acknowledging that Major League Baseball players' rights of publicity might be violated wherever their performances are broadcast without their consent).

15. *Abdul-Jabbar*, 85 F.3d 407 (holding that the unauthorized use of Kareem Abdul-Jabbar's former name and his college basketball statistics violated his common law right of publicity); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1283 (D. Minn. 1970) (ruling that the unauthorized use of professional baseball players' names and statistics in table games violated the players' rights of publicity); *Palmer v. Schonhorn Enters.*, 232 A.2d 458 (N.J. Super. Ct. 1967) (holding that the unauthorized use of professional golfers' names and career statistics in a board game violated their rights of publicity).

16. *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974).

17. *Abdul-Jabbar*, 85 F.3d at 416.

18. *Haelan Labs, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953) (discussing the unauthorized use of baseball players' pictures on baseball cards to market chewing gum); *Shamsky v. Garan, Inc.*, 632 N.Y.S.2d 930, 933-34 (Sup. Ct. 1995) (detailing the unauthorized use of a photograph on articles of clothing, although the photograph did not clearly identify the individual players).

19. *Stapleton & McMurphy*, *supra* note 9, at 23. Michael Jordan earned \$36 million dollars during his last season with the Chicago Bulls, whereas sport marketers estimate Jordan earned up to \$40 million a year in endorsements at the peak of his career. Scott Street, *Jordan Lives On Without Endorsements*, UCLA DAILY BRUIN ONLINE, at <http://www.dailybruin.ucla.edu/db/issues/00/04/06/sports.street.html> (April 6, 2000). According to FORBES magazine, Tiger Woods earned \$70 million in endorsements in 2002. Bill Hoffmann, *Aniston Tops Forbes Most Powerful List* (June 20, 2003), NYPOST.COM, available at <http://www.foxnews.com/story/0,2933,89965,00.html>. "Fresh off his British Open victory last summer, the golfer signed a reported \$100 million, five-year pact with Nike in what may be the richest sports endorsement contract ever. Woods, who earned an estimated \$47

The right of publicity grew out of the right of privacy identified in the late-nineteenth century. Samuel Warren and Louis Brandeis initially described the right to privacy as "the right to be let alone."<sup>20</sup> Warren and Brandeis believed one's privacy rights should protect against the unauthorized commercial use of a person's name, image, or any recognizable personal attribute.<sup>21</sup> Eventually, legal commentators advanced Warren and Brandeis' notion of unauthorized exploitation by including wrongful appropriation in the theory of invasion of privacy.<sup>22</sup> Wrongful exploitation, however, did not adequately protect a victim's property rights because the tortfeasor not only violated privacy, but generally also profited from the invasion.<sup>23</sup> Over time, the increased commercial value of one's likeness, particularly for Hollywood celebrities and professional athletes, strengthened the argument for a separate property right outside of the right of privacy, referred to as the right of publicity.

The first court to formally recognize the right of publicity was *Haelan Labs, Inc. v. Topps Chewing Gum, Inc.*<sup>24</sup> In *Haelan Labs*, a professional baseball player contracted out the right to use his photograph on a baseball trading card to both Haelan and Topps.<sup>25</sup> Haelan claimed that Topps' photograph invaded its exclusive right to use such pictures.<sup>26</sup> Topps did not deny that Haelan acquired some rights through its agreement with the player, but argued that these rights stemmed from a statutory right to privacy, qualifying them as personal rights and thereby not assignable.<sup>27</sup> The court

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million last year may become the world's first billion-dollar athlete[.]" David Dukceovich, *Forbes Faces: Tiger Woods*, FORBES.COM, <http://www.forbes.com/2000/11/14/1114faces.html> (Nov. 14, 2000).

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

21. *Id.* at 195.

22. William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960). Prosser's definition of an invasion of privacy includes: "(1) intrusion upon the plaintiff's seclusion or solitude . . . [,] (2) public disclosure of embarrassing private facts . . . [,] (3) publicity which places the plaintiff in a false light . . . [,] (4) appropriation, for the defendant's advantage, of the plaintiff's name or likeness" (emphasis added). *Id.*

23. Edward J. Bloustein, *Privacy is Dear at Any Price: A Response to Professor Posner's Economic Theory*, 12 GA. L. REV. 429 (1978); Edward J. Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962 (1964); Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326 (1966).

24. *Haelan Labs, Inc.*, 202 F.2d at 866.

25. *Id.* at 867.

26. *Id.*

27. *Id.*

rejected Topps' argument that Haelan did not receive any property rights to use the player's image and judicially "founded" the right of publicity.<sup>28</sup>

Since *Haelan Labs*, courts and commentators have cultivated the right of publicity, distinguishing it from the right of privacy.<sup>29</sup> In 1977, the Supreme Court recognized the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*, holding that the right to control the commercial use of one's name, likeness, or image, was a property right, not a privacy right.<sup>30</sup> Today, the majority of states recognize, either at common law or by statute, an independent right of publicity.<sup>31</sup>

### A. Art, the First Amendment, and the Right of Publicity

There are two primary defenses available to the defendant when the plaintiff asserts a right of publicity claim: consent and the First Amendment.<sup>32</sup> The First Amendment protects not only written and spoken words, but also a wide range of expression,<sup>33</sup> including artistic expression. Even though it is not explicitly mentioned in the First Amendment, the Supreme Court has characterized artistic expression as a protected form of symbolic speech.<sup>34</sup>

28. *Id.* at 868. "In addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph. . . [t]his right might be called a 'right of publicity.'"

29. See generally J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* §1:3 (2d ed. 2001); Melville Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

30. *Zacchini*, 433 U.S. at 571-72.

31. MCCARTHY, *supra* note 10, at 6-5.

32. Anne S. Jordan, *Update on the Right of Publicity*, in 1 PLI'S FIFTH ANNUAL INSTITUTE FOR INTELLECTUAL PROPERTY LAW, at 225, 233-36 (PLI Intell. Prop. Course, Handbook Series No. G-573, 1999); MCCARTHY, *supra* note 29, at § 3:6.

33. Examples of protected expression include music, film, pictures, photographs, paintings, drawings, engravings, prints, and sculptures. *ETW Corporation v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003), citing *Hurly v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, 515 U.S. 557, 569 (1995) (noting that "[t]he Constitution looks beyond written or spoken words as mediums of expression."); *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989) (holding that "[m]usic, as a form of expression and communication, is protected under the First Amendment."); *Kaplan v. California*, 413 U.S. 115, 119-120 (1973) (ruling that "[p]ictures, films, paintings, drawings, and engravings. . . have First Amendment protection[.]").

34. *Hurly*, 515 U.S. at 569; *Kaplan*, 413 U.S. at 119-20; *Jacobellis v. Ohio*, 378 U.S. 184 (1964); *Roth v. United States*, 354 U.S. 476 (1957). The Supreme Court has upheld the constitutionality of numerous federal, state, and local laws that limit expression. Examples include: political advertising, *Lehman v. Shaker Heights*, 418 U.S. 298 (1974); draft card mutilation, *United States v. O'Brien*, 391 U.S. 367 (1968); unlicensed parades, *Cox v. New Hampshire*, 312 U.S. 569 (1941); the use of fighting words, *Feiner v. New York*, 340 U.S. 319 (1951); and various broadcasting restrictions, *FCC v. Pacifica*, 438 U.S. 726 (1978).

Not every form of artistic expression, however, is protected by the First Amendment. Some works that depict the human body using graphic sexual themes, for example, are labeled obscene and thus fall outside the bounds of the First Amendment.<sup>35</sup>

Another potential limitation to artistic expression involves sport portraiture. While sport artists prefer to depict athletes because of sport's social and cultural significance, some professional athletes have alleged that portraits of an athlete sold for profit are not protected by the First Amendment because these works violate the athlete's right of publicity. In defense, sport artists have contended that artistic expression outweighs a professional athlete's pecuniary rights in their persona. With varying degrees of analysis and outcomes, three recent cases applied balancing tests to decide the conflict between a celebrity's right of publicity and an artist's freedom of expression rights.

In *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, Cardtoons L.C. (Cardtoons) contracted with a sport artist, a political cartoonist, and a sport author-journalist to design a set of trading cards which featured the caricatures of major league baseball players.<sup>36</sup> The cards, using similar names, recognizable images, distinctive team colors, and commentaries about individual players, ridiculed the players using a variety of themes.<sup>37</sup> The Major League Baseball Players Association sued, alleging the trading cards violated the players' rights of publicity. The Tenth Circuit acknowledged that the cards' unauthorized use of the players' likenesses violated the right of publicity under Oklahoma's right of publicity statute, but opined that, on balance, Cardtoons' First Amendment rights outweighed the players' proprietary rights:

Cardtoons' parody trading cards receive full protection under the First Amendment. The cards provide social commentary on public figures, major league baseball players, who are involved in a significant commercial enterprise, major league baseball. While not core political speech. . .this type

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35. *New York v. Ferber*, 458 U.S. 747 (1982) (holding that pornography shown to minors can be prohibited whether or not the images are obscene because of the state's interest in protecting children); *Miller v. California*, 413 U.S. 15 (1973) (ruling that pornography can be banned only if obscene); *Kaplan*, 413 U.S. at 119-20 (holding that pictures, films, paintings, drawings, and engravings are entitled to First Amendment protection unless they are obscene). See also *Ali*, 447 F. Supp. at 726 (holding that a nude drawing of an African American male seated in a boxing ring evoked Muhammad Ali's marketable identity and violated his right of publicity).

36. *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959 (10th Cir. 1996).

37. *Id.*

of commentary on an important social institution constitutes protected expression.<sup>38</sup>

In striking the balance between the players' proprietary rights and *Cardtoons'* First Amendment rights, the court noted that society's social and cultural interest in professional athletes outweighed the players' proprietary rights.<sup>39</sup>

[E]ven in the absence of publicity rights, celebrities would still be able to reap financial reward from authorized appearance and endorsements. The extra income generated by licensing one's identity does not provide a necessary inducement to enter and achieve in the realm of sports and entertainment. Thus, while publicity rights may provide some incentive for creativity and achievement, the magnitude and importance of the incentive has been exaggerated.<sup>40</sup>

In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,<sup>41</sup> the California Supreme Court fashioned a test to balance the right of publicity with the First Amendment. The plaintiff, Comedy III Productions (Comedy III), was the registered owner of all rights to the deceased personalities of the comedy act known as "The Three Stooges."<sup>42</sup> The defendant, Gary Saderup, was an artist with over 25 years of experience, specializing in charcoal drawings of celebrities. Saderup's hand-drawn charcoal images were used to create lithographic and silk screen masters, which then were used to produce lithographic prints and silk screen T-shirt images without Comedy III's consent.<sup>43</sup> Comedy III discovered Saderup's unauthorized use of The Three Stooges' likenesses and sued, seeking damages and injunctive relief for violating California's right of publicity statute and related business torts.<sup>44</sup> In response, Saderup raised a First Amendment defense claiming that the enforcement of a judgment against him violated his right to free expression.<sup>45</sup>

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38. *Id.* at 969.

39. *Id.* at 972. "[C]elebrities are common points of reference for millions of individuals who may never interact with one another, but who share by virtue of their participation in a mediated culture, a common experience and collective memory," quoting JOHN B. THOMPSON, *IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION* 163 (1990).

40. *Cardtoons, L.C.*, 95 F.3d at 974.

41. *Comedy III Prod's, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805 (Cal. 2001).

42. *Id.* at 800.

43. *Id.* at 800-01. Saderup sold these items and profited \$75,000.

44. *Id.*

45. *Id.* at 805.



During its analysis, the California Supreme Court determined that Saderup's portraits were entitled to First Amendment protection because they were "expressive works and not an advertisement or endorsement of a product,"<sup>46</sup> but then proceeded to balance Saderup's First Amendment rights with Comedy III's publicity rights using a "transformative test." In constructing the transformative test, the court imported one factor of the fair use doctrine from copyright law, "the purpose and character of the use," which asks whether and to what extent a work is transformative.<sup>47</sup> According to the California court, transformative elements can take many forms, such as parody, factual reporting, fictionalized portrayal, heavy-handed lampooning, or subtle social criticism.<sup>48</sup> Outside of these constitutionally protected uses, works of art bearing the portrait of a celebrity must contain significant transformative elements. To determine whether Saderup's work contained significant transformative elements, the court asked two transformative use questions and conducted a subsequent "subsidiary inquiry."<sup>49</sup>

According to the court, the transformative elements test first asks whether the creative elements of a portrait predominate its literal and imitative elements.<sup>50</sup> If creative elements dominate, the work is considered worthy of First Amendment protection.<sup>51</sup> If literal and imitative elements dominate, however, a second transformative use query seeks to determine whether a

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46. *Comedy III Prod's*, 21 P.3d at 802.

47. *Id.* at 808. Section 107 of the 1976 Copyright Act lists four factors to determine whether a use is fair: (1) the purpose and character of the use, including whether such use is of commercial nature or is for non-profit 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. 17 U.S.C §107(1)-(4) (1994). The *Comedy III* court rejected the use of the second and third factors because of their general lack of usefulness in determining whether the First Amendment protects a celebrity depiction. *Comedy III Productions*, 21 P.3d at 807-08. The court rejected the fourth factor because of its potential for circularity when applied. *Id.* at 808 n.10.

48. *Id.* at 809. According to the court, these depictions automatically become transformative because they generally do not significantly impact the economic interest of celebrities.

49. *Comedy III Prod's*, 21 P.3d at 809. The subsidiary inquiry is used for "particularly close cases" to gauge whether "the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted." *Id.* at 808. Unlike the first prong that is based on copyright law, however, the subsidiary inquiry appears to be a judicially created standard because the court cited no authority for its construction.

50. *Id.* at 809.

51. *Id.* The court gave no clear indication as to what it considers "creative."

work is so transformed that it has become primarily the artist's personal expression rather than a mere duplicate image of the celebrity.<sup>52</sup>

Because of the acknowledged difficulty of determining when artists add creative contributions to their works, *Comedy III* also proposed a subsidiary inquiry for "close cases," which asks whether the marketability and economic value of the challenged work derive primarily from the artist or the fame of the celebrity depicted: "When the value of the work comes principally from some source other than the fame of the celebrity – from the creativity, skill, and reputation of the artists – it may be presumed that sufficient transformative elements are present to warrant First Amendment protection."<sup>53</sup> In *Saderup's* case, the court, with little to no discussion on how it arrived at its determination, concluded that *Saderup's* charcoal sketches were imitative and did not contain any transformative elements.<sup>54</sup> In other words, *Saderup's* sketches lacked were primarily imitative charcoal remakes of The Three Stooges image, designed to exploit their fame. Thus, according to the transformative test, *Comedy III's* publicity rights outweighed *Saderup's* First Amendment rights.

The most recent case regarding a First Amendment defense to a right of publicity claim, and the seminal case involving a sport artist and professional athlete, is *ETW Corp. v. Jireh Publishing, Inc.*<sup>55</sup> In *ETW Corp.*, the plaintiff, ETW Corporation (ETW), was the exclusive licensing agent of Tiger Woods. ETW had registered the trademark "TIGER WOODS" for such items as art prints, calendars, mounted photographs, notebooks, pencils, pens, posters, trading cards, and unmounted photographs.<sup>56</sup> The defendant, Jireh Publishing, Inc. (Jireh), was the exclusive publisher for the artworks of sport artist, Rick Rush.<sup>57</sup> ETW filed suit against Jireh alleging its company unlawfully sold prints using the name, image, and likeness of Tiger Woods.<sup>58</sup>

At the time of the lawsuit, Rush had been a sport artist for 23 years and had painted the images of several popular professional athletes, such as Magic

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52. *Id.* The term 'expression' in this sense means "expression of something other than the likeness of the celebrity." *Id.*

53. *Comedy III Prod's*, 21 P.3d at 810.

54. *Id.* at 811.

55. *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829, 915 (N.D. Ohio 2000), *aff'd*, 332 F.3d 915 (6th Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 19044 (6th cir. 2003) (deciding whether poster prints violate an athlete's right of publicity).

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

57. *Id.*

58. *Id.*

Johnson, Jack Nicklaus, and Michael Jordan.<sup>59</sup> Rush also admitted to painting three separate paintings of Tiger Woods during his 1997 Masters Tournament victory.<sup>60</sup> As Rush's exclusive publisher, Jireh turned these paintings into 250 limited edition serigraphs and 5,000 lithographs, selling the serigraph prints for \$700 each and the lithograph prints for \$15 each.<sup>61</sup> If Jireh sold all of these prints, it stood to gross approximately \$250,000. Rush's prints were labeled "The Masters of Augusta" and included a separate narrative insert that said, "featuring Tiger Woods in the center displaying that awesome swing and flanked by his caddie."<sup>62</sup> Each print also was packaged in an envelope with large print that read, "Rick Rush – Painting America Through Sports."<sup>63</sup> Under the back flap, the envelope contained the words, "Masters of Augusta, Tiger Woods."<sup>64</sup>

In its defense, Jireh argued Rush's prints were protected by the First Amendment.<sup>65</sup> ETW disagreed. In addition to its trademark allegations, ETW claimed that the prints were "merely sports merchandise" and were "not entitled to First Amendment protection or [are] at best, commercial speech entitled to less protection under the First Amendment."<sup>66</sup>

The federal district court acknowledged that sport art must be distinguished from sport merchandise and commercial speech, but the court did not find ETW's "sport merchandise" arguments on this issue persuasive.<sup>67</sup> Citing a string of cases, the court dismissed ETW's assertion that "all posters are the equivalent of merchandise" and held that "artistic prints seeking to convey a message may be distinguished from posters which merely reproduce

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59. *Id.*

60. *Id.*

61. A serigraph is a stencil method of printmaking in which an image is imposed on a screen of silk or other fine mesh, with blank areas coated with an impermeable substance. Ink is then forced through the mesh onto the printing surface. It is also called silkscreen process and screen-printing. Artlex, *Artlex Art Dictionary*, at <http://www.artlex.com> (last visited Nov. 10, 2003). A lithograph is a method of printing from a prepared flat stone or metal or plastic plate. A drawing is made on the stone or plate with a greasy crayon or tusche and then washed with water. When ink is applied, it sticks to the greasy drawing, but runs off the wet surface allowing a print to be made of the drawing. The artist, or other print maker under the artist's supervision, then covers the plate with a sheet of paper and runs both through a press under light pressure. For color lithography, separate drawings are made for each color. *Id.*

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

63. *Id.*

64. *Id.*

65. *Id.* at 834.

66. *Id.*

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

an existing photograph."<sup>68</sup> The court based its decision in part on Rush's "unique expression of an idea," but like *Comedy III*, failed to offer any support on how it arrived at its determination.<sup>69</sup>

Next, the district court addressed whether Jireh's art prints were commercial speech and consequently entitled to less First Amendment protection. The district court defined commercial speech as that "which does no more than propose a commercial transaction" or that "which merely advertises a product or service for business purposes."<sup>70</sup> Noting that the prints in question were of a limited edition, the district court concluded that the prints did not exist solely as commercial merchandise.<sup>71</sup> For these reasons, the court found in favor of Jireh.<sup>72</sup>

On appeal, the Sixth Circuit affirmed the district court's ruling and upheld Jireh's motion for summary judgment.<sup>73</sup> In a four-part analysis, the appellate court addressed Ohio's right of publicity law and its apparent conflict with Jireh's First Amendment defense.<sup>74</sup>

The court began its analysis by quashing ETW's claims that only original works of art, not art prints, were entitled to First Amendment protection, noting that "ETW's argument that only the original work and not its copies are protected would lead to absurd results."<sup>75</sup> Like the district court, the appellate

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68. *Id.* at 835. The appellate court noted that "ETW's argument that only the original work and not its copies are protected would lead to absurd results. For example, the original manuscript of an unauthorized biography would be protected, but not the published copies. The original script of a play or a movie would be protected, but not the live performances or films produced from it." *ETW Corp.*, 332 F.3d at 926 n.8.

69. *Id.* at 926.

70. *Id.*

71. *ETW Corp.*, 99 F. Supp. 2d at 835-36, citing *Hurly*, 515 U.S. at 569 ("It appears that the United States Supreme Court would find such expression to fall within the ambit of the First Amendment.").

72. *ETW Corp.*, 99 F. Supp. 2d at 836.

73. *ETW Corp.*, 332 F.3d 915, *rehearing denied*, 2003 U.S. App. LEXIS 19044.

74. The scope of this article is limited to the right of publicity and the First Amendment. However, "the elements of a Lanham Act false endorsement claim are similar to the elements of a right of publicity claim under Ohio Law. In fact, one legal scholar has said that a Lanham Act false endorsement claim is the federal equivalent of the right of publicity." *ETW Corp.*, 332 F.3d at 924, citing Bruce P. Keller, *The Right of Publicity: Past, Present, and Future*, 1207 PLI CORP. LAW & PRAC. HANDBOOK 159, 170 (2000).

75. *ETW Corp.*, 332 F.3d at 925, n.8. In addition, the court noted that Rush's work was considered newsworthy and fully protected by the First Amendment.

Rush's work consists of much more than a mere literal likeness of Woods. It is a panorama of Woods's victory at the 1997 Masters Tournament, with all of the trappings of that tournament in full view, including the Augusta clubhouse, the leader board, images of Woods's caddy, and his final round partner's caddy. These elements in themselves are sufficient to bring Rush's work

court dismissed ETW's commercial speech arguments with little commentary stating that, "Rush's prints are not commercial speech. They do not propose a commercial transaction. Accordingly, they are entitled to full protection of the First Amendment."<sup>76</sup> Furthermore, the court noted that the commercial sale of artwork would not diminish its First Amendment protection.<sup>77</sup>

The core of the Sixth Circuit's opinion focused on how the court should resolve the "inherent tension between the right of publicity and the right of freedom of expression under the First Amendment."<sup>78</sup> The appellate court openly conceded "the problems of judicial line drawing" and sought to balance the right of publicity with the First Amendment.<sup>79</sup> Because the right of publicity is an object of state law, the Sixth Circuit first turned to Ohio's right of publicity law to begin its balancing test. Finding few cases defining Ohio's right of publicity law's scope, the federal court reasoned that Ohio likely would construe the right of publicity "as suggested in the Restatement (Third) of Unfair Competition, Chapter 4, Section 47, Comment d, which articulates a rule analogous to the rule of fair use in copyright law."<sup>80</sup> Under this rule, "the substantiality and market effect of the use of the celebrity's image is analyzed

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within the protection of the First Amendment. The Masters Tournament is probably the world's most famous golf tournament and Woods's victory. . . was a historic event in the world of sports.

*Id.* at 937. See also *Comedy III Productions*, 21 P.3d at 797, which rejected a claim that T-shirts lose their First Amendment protection because they were not original, single works of art, but were instead part of a commercial enterprise designed to generate profit. "This position has no basis in logic or authority. No one would claim that a published book, because it is one of many copies, receives less First Amendment protection than the original manuscript." *Id.* at 810.

76. *ETW Corp.*, 332 F.3d at 926. The court noted that the commercial sale of artwork does not diminish its First Amendment protection. *Id.* at 925, citing *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750 (1988), noting that even pure commercial speech is entitled to significant First Amendment protection. *Id.* at 926, citing, *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 423 (1993). See also *Bd. of Trustees of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473-474 (1989); *Central Hudson Gas & Electric Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557 (1980); *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976).

77. *ETW Corp.*, 332 F.3d at 926.

78. *Id.* at 931.

79. *White v. Samsung Electronics Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993); *Cardtoons, L.C.*, 95 F.3d at 959; *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001); *Comedy III Prod's*, 21 P.3d at 797.

80. *ETW Corp.*, 332 F.3d at 938. In its attempt to apply Ohio right of publicity law, the court first looked to the Ohio Supreme Court in *Zacchini v. Scripps-Howard Broad. Co.*, 376 N.E.2d 582 (Ohio 1978). Recognizing the right of publicity, *Zacchini* heavily relied on THE RESTATEMENT (SECOND) OF TORTS, § 652 which was transferred to the RESTATEMENT (THIRD) OF UNFAIR COMPETITION, CHAPTER 4 § 46 in 1995 by the American Law Institute. *ETW Corp.*, 332 F.3d at 930.

in light of the informational and creative content of the defendant's use."<sup>81</sup> Noting the Restatement's suggestion "that courts may justifiably be reluctant to adopt a broad construction of the right,"<sup>82</sup> the appellate court emphasized that "the use of a person's identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity."<sup>83</sup> Like its predecessors, giving little attention as to how it applied the applicable rule of law to the facts of the case, the Sixth Circuit concluded that "Rush's work has substantial informational and creative content which outweighs any adverse effect on ETW's market and that Rush's work does not violate Woods's right of publicity."<sup>84</sup>

Noting that "celebrities...are an important element of the shared communicative resources of our cultural domain,"<sup>85</sup> the court reasoned that limiting Rush's artistic expression would have a significant impact on society. Quoting Judge Kozinski's dissenting remarks in *White v. Samsung Electronics America, Inc.*,<sup>86</sup> the court noted that "intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain."<sup>87</sup> The court further concluded that "Ohio is inclined to give substantial weight to the public interest in freedom of expression when balancing it against the personal and proprietary interests recognized by the right of publicity."<sup>88</sup>

On balance, the Sixth Circuit also was not persuaded that Tiger Woods would suffer any material financial harm, doubting that "artwork prints which display one of his major achievements will reduce the commercial value of his likeness."<sup>89</sup> The apparent negligible impact on Woods, compared to the significant impact on Rush and society's interest in freedom of artistic expression, tipped the court's scales in favor of Rush and his licensee, Jireh.<sup>90</sup>

In seemingly pre-emptive commentary to stave off possible dissenters, the Sixth Circuit applied the transformative elements test adopted by *Comedy III*

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81. *ETW Corp.*, 332 F.3d at 938.

82. *Id.* at 930.

83. *Id.* at 930, quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION, CHAPTER 4 § 47.

84. *Id.* at 938.

85. *Id.* at 939, quoting *Cardtoons, L.C.*, 95 F.3d at 972.

86. *White*, 989 F.2d at 1512.

87. *ETW Corp.*, 332 F.3d at 933, quoting *White*, 989 F.2d at 1516.

88. *Id.* at 930, referring to *Zacchini*, 433 U.S. at 562.

89. *Id.* at 939.

90. *Id.* "The effect of limiting Woods's right of publicity in this case is negligible and significantly outweighed by society's interests in freedom of artistic expression."

and concluded that Rush's artworks contained significant creative elements, noting that unlike Saderup's unadorned and nearly photographic reproduction of the Three Stooges, Rush's prints were not literal depictions of Tiger Woods.<sup>91</sup>

Rush's work consists of a collage of images in addition to Woods's image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods's achievement in that event. Because Rush's work has substantial transformative elements, it is entitled to full protection of the First Amendment.<sup>92</sup>

### B. Discussion and Analysis

For several decades now, courts have been asked to resolve cases involving commercial products and the First Amendment. In *Hicks v. Casablanca Records*, for example, the court distinguished between protected forms of expression, like books and movies, and those items generally regarded as merchandise, such as bubble gum cards and posters, noting that the former items are vehicles through which ideas and opinions are disseminated, whereas the latter forms typically are not instruments of expression.<sup>93</sup> Likewise, the court in *Rosemont Enterprisers, Inc. v. Urban Systems, Inc.*, rejected a defendant's claim that a board game deserved First Amendment protection as much as a biography, article, or movie.<sup>94</sup>

When determining constitutional worth, modern jurisprudence largely has ignored categorizing products and deciphering whether a product's use is primarily commercial.<sup>95</sup> Following the Supreme Court's decision in *Cohen v. California*, which held that political speech on a jacket is entitled to First Amendment protection,<sup>96</sup> courts have all but ignored the expression's

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91. *Id.* at 939.

92. *ETW Corp.*, 332 F.3d at 939.

93. *Hicks*, 464 F. Supp. at 430. *But see* *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 643 (Ct. App. 1995) (holding that posters which reproduced a photograph depicting former NFL star Joe Montana that had previously appeared on the front page of the newspaper were protected under the First Amendment because the posters were newsworthy). *See also* *Lugosi v. Universal Pictures*, 603 P.2d 425, 449 (Cal. 1979) (holding that commercial exploitation of the plaintiff's interests in merchandising products is not protected by the First Amendment).

94. *Rosemont Enterprisers, Inc. v. Urban Systems, Inc.*, 340 N.Y.S.2d 144, 146 (Sup. Ct. 1973).

95. *Cardtoons, L.C.*, 95 F.3d at 976; *Bery v. City of N.Y.*, 97 F.3d 689, 695 (2d Cir. 1996); *ETW Corp.*, 332 F.3d 915.

96. *Cohen v. California*, 403 U.S. 15 (1971).

medium.<sup>97</sup> Furthermore, courts have clarified that even pure commercial speech may be entitled to First Amendment protection.<sup>98</sup> In addition, with regard to works of art, most commercial speech arguments may no longer be applicable. *Cardtoons, Comedy III*, and *ETW Corp.*, all held that artwork depicting celebrities was not a form of commercial speech because art is "not an advertisement for or endorsement of a product."<sup>99</sup> Even so, artwork produced solely for commercial gain "does not diminish the degree of protection to which [it is] entitled under the First Amendment."<sup>100</sup>

Even decorative art, which is commonly viewed as "merchandise" and not art, may be entitled to constitutional protection. In *Bery v. City of New York*<sup>101</sup> and the district court in *ETW Corp.*, both courts rejected the notion that only fine art can receive First Amendment protection stating, that "[s]uch myopic vision not only overlooks case law central to First Amendment jurisprudence but fundamentally misperceives the essence of visual communication and artistic expression."<sup>102</sup> In *Bery*, the plaintiff sought a preliminary injunction to enjoin enforcement of a city ordinance that prohibited visual artists from exhibiting or selling their street artwork without first obtaining a general vendor's license.<sup>103</sup> The Second Circuit held that the First Amendment's fundamental purpose is to protect expression "in all of its myriad manifestations."<sup>104</sup> Although the type of street art sold by *Bery* was amateur at best, the appellate court corrected the district court which equated these visual expressions with "the crafts of the jeweler, the potter and the silversmith

97. "[T]he fact that Saderup's art appears in large part on a less conventional avenue of communications, T-shirts, [does not] result in reduced First Amendment protection." *Comedy III Prod's*, 21 P.3d at 804. See also *Ayres v. City of Chicago*, 125 F.3d 1010, 1017 (7th Cir. 1997) ("T-shirts . . . are to [the seller] what the New York Times is to the Sulzerbers and the Ochs - the vehicle of . . . ideas and opinions.").

98. Commercial speech is "speech which does 'no more than propose a commercial transaction[.]'" *ETW Corp.*, 332 F.3d 915, citing *Virginia State Bd. of Pharmacy*, 425 U.S. at 762. See also *City of Cincinnati*, 507 U.S. at 423; *Bd. of Trustees of the State Univ. of N.Y.*, 492 U.S. at 473-74; *Central Hudson Gas & Electric Corp.*, 447 U.S. 557.

99. *Comedy III Prod's*, 21 P.3d at 802; *ETW Corp.*, 332 F.3d at 915; *Cardtoons, L.C.*, 95 F.3d at 959.

100. *ETW Corp.*, 332 F.3d at 926, citing *City of Lakewood*, 486 U.S. at 756 n.5. See also *Comedy III Productions*, 21 P.3d at 802, citing *Guglielmi*, 603 P.2d 454 ("[t]he First Amendment is not limited to those who publish without charge."). It is a well settled legal principle that, in regard to commercial speech, it is not constitutionally significant if one seeks to profit from their work. *Time Inc. v. Hill*, 385 U.S. 374, 397 (1967); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 502 (1952).

101. *Bery*, 97 F.3d at 689.

102. *Id.* at 695.

103. *Id.* at 689.

104. *Id.* at 694.



who seek to sell their work."<sup>105</sup> The Second Circuit noted that even craft-like objects "may at times have expressive content,"<sup>106</sup> noting that "paintings, photographs, prints and sculptures. . .always communicate some idea or concept to those who view it, and as such are entitled to full First Amendment protection."<sup>107</sup> The appellate court also dismissed the notion that an expression must be "inseparably intertwined with a 'particularized message'" in order to receive any constitutional protection, noting that "visual artwork is as much an embodiment of the artist's expression as a written text."<sup>108</sup>

*Berry's* decision reiterated the Supreme Court's holding in *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc.* which held that art is constitutionally protected even if it fails to convey a discernable message, "[A] narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expression conveying a 'particularized message,' [citation], would never reach the unquestionably shielded paintings of Jackson Pollock, music of Arnold Schoenberg, or Jabberwocky verse of Lewis Carroll."<sup>109</sup> Thus, courts acknowledge that art does not lose constitutional protection even when its purpose is to entertain rather than communicate a particular idea or message.<sup>110</sup>

When the legal principles outlined in *Bery, Comedy III, ETW Corp., and Cartoons*, are applied to sport art portraiture, questions remain as to how far an artist's First Amendment rights extend and whether a sport artist legally can paint an athlete's portrait. Uncertainty largely exists because there is relatively little case law to provide clear-cut answers, but also because courts have used various balancing tests to reach their decisions. For example, under *Comedy III*, the creative elements of the athlete's portrait must dominate its literal or imitative elements to receive the fruits of First Amendment protection.<sup>111</sup> If literal and imitative elements dominate the portrait, the image must be so transformed that it has become primarily the sport artist's personal expression and not merely a trivial variation of the athlete's likeness.<sup>112</sup> In other words, according to *Comedy III*, the portrait of the professional athlete must be recognized as something as the artist's own and not just an unadorned replica

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105. *Id.* at 695.

106. *Bery*, 97 F.3d at 695.

107. *Id.*

108. *Id.*

109. *Hurley*, 515 U.S. at 569.

110. *Comedy III Prod's*, 21 P.3d at 804, citing *Guglielmi*, 25 Cal. 3d at 867.

111. *Id.* at 808.

112. *Id.* at 809.

of the athlete's likeness.<sup>113</sup> If the portrait does not meet either one of these transformative tests, however, it conceivably may still receive constitutional protection under the subsidiary inquiry test which determines whether the marketability and economic value of the portrait derives primarily from the fame of the artist or the athlete.<sup>114</sup>

While many sport portraits are not literal depictions or imitations of professional athletes, in those instances when artists seek to recreate an exact likeness of a professional athlete, *Comedy III's* transformative approach may prove to be too rigid. As Saderup discovered in *Comedy III*, unless an exact likeness of a professional athlete contains "something recognizably as '[the artist's] own,'"<sup>115</sup> courts are free to reject the transformativeness of the portrait.<sup>116</sup>

Saderup's argument that all portraiture involves creative decisions, and that no work portrays a mere literal likeness of a celebrity, was rejected.<sup>117</sup> According to the court, a literal depiction, even if accomplished with great skill, must still add something as the artist's own.<sup>118</sup> Saderup argued that portraiture artists should not be penalized for making wholesome and reverential replicas of others, when other works involving parody, heavy-handed lampooning, or some other creative distortion are protected by the First Amendment.<sup>119</sup> The court, however, disagreed, holding that the transformative test does prefer one form of depiction over another, rather "it reflects a recognition that the Legislature has granted to the heirs and assigns of celebrities the property right to exploit the celebrities' images, and that certain forms of expressive activity protected by the First Amendment fall outside the boundaries of that right."<sup>120</sup>

For well-known sport artists, like LeRoy Neiman, the transformative test's "fame exemption" adequately protects a famous artist's works of art should he or she create a literal depiction or imitation of a professional athlete.<sup>121</sup> Lesser

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113. *Id.* at 811.

114. *Id.* at 810-11. If the portrait's worth comes principally from the creativity, skill, or reputation of the sport artist, for example, it is presumed to have sufficient transformative elements and is protected by the First Amendment.

115. *Comedy III Prod's*, 21 P.3d at 810.

116. *Id.*

117. *Id.*

118. *Id.* at 809.

119. *Id.*

120. *Comedy III Prod's*, 21 P.3d at 811.

121. *Id.* at 810.

known artists, however, may not fare as well. They still must make a showing that their portrait is transformative.

At what point, however, is something considered a mere trivial variation under *Comedy III's* transformative test? Peter Max, whose sporting subjects include the Super Bowl and World Series, to name a few, employs a technique that likely challenges the effectiveness of *Comedy III's* transformative test.<sup>122</sup> Much of Max's sport art, such as baseball and football cards commissioned by Topps Gallery Trading Cards, includes a photograph of a professional athlete outlined with bright acrylic paint around the player's image.<sup>123</sup> While this technique is beloved by Max's admirers and collectors, it is unclear whether it would meet *Comedy III's* definition of contributing "more than a 'merely trivial' variation" of the athlete's image.<sup>124</sup> Saderup's charcoal sketch of The Three Stooges, for example, did not pass transformative muster because, although well done, the portrait was a mere duplicate image of the comedy act and contained no significant creative elements. On one hand, artists using Max's acrylic outlining technique run the risk of courts failing to recognize this medium of expression as significantly creative or transformative, but on the other hand, if courts do conclude that images bearing this acrylic outlining technique are worthy of First Amendment protection, there is little to safeguard professional athletes from every aspiring sport artist who freely "trace" the image of a professional athlete with acrylic paint and then reproduce this image for financial gain.

The *ETW Corp.* holding is also indistinct in some respects. Because Rush's paintings portrayed a historical event, the 1997 Masters Tournament and Wood's subsequent victory, one may argue that *ETW Corp's* holding and analysis are limited to newsworthy sporting events. Others argue that the court's ruling, like *Comedy III*, wrongfully penalizes some portraiture sport artists because the very essence of their work depends on the artist's ability to intimately capture the athlete's persona and this may or may not require the sport setting or event.<sup>125</sup> In *ETW Corp.*, for example, the court distinguished Rush's paintings from Saderup's imitative charcoal sketches in *Comedy III*, noting that Rush's work consisted of more than a mere literal likeness of Woods. Rush's paintings consisted of a panorama of the tournament, including images of the Augusta clubhouse, leader board, Wood's caddy, and

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122. The Art of Peter Max, *Subjects: Sports*, PETER MAX ONLINE, at <http://www.PeterMax.com> (last visited April 27, 2004).

123. *Comedy III Prod's*, 21 P.3d at 810.

124. *Id.* at 810-11, citing *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976).

125. *ETW Corp.*, 332 F.3d at 936.

six past winners of the tournament.<sup>126</sup> *ETW Corp.* further noted that Rush's paintings consisted of a collage of images which were "combined to describe, in artistic form, a historic event in sports history and convey[ed] a message about the significance of Woods's achievement in that event."<sup>127</sup> Whether this language implies that constitutional protection will apply only to those sport portraits that incorporate some type of newsworthy event with the athlete's image is unclear.

#### IV. CONCLUSION

Courts openly acknowledge that it is "not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity."<sup>128</sup> Courts seemingly agree on the fundamental limitations of right of publicity protection — that this right cannot be used to censor First Amendment expression of disagreeable portrayals because the right of publicity is an economic right, not a right of censorship. Once a professional athlete thrusts him or herself "into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad [First Amendment] scope."<sup>129</sup> Moreover, if the right of publicity is limited to preventing "others from misappropriating the economic value generated by the celebrity's fame,"<sup>130</sup> both *Cardtoons* and *ETW Corp.* have pointed out that the economic impact on a professional athlete is minimal when an artist produces and sells his or her portrait. In fact, in many instances, an artistic rendition may serve to advance and bolster the athlete's fame which can lead to greater economic gain.

In general, most scholars and courts agree that fine art is, and should be, protected by the First Amendment. The dividing line appears to be how far artistic expression should extend. Some commentators advocate an expansive

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126. *Id.*

127. *Id.*

128. *Comedy III Prod's*, 21 P.3d at 807.

129. *Id.*

130. *Id.*

right of publicity doctrine,<sup>131</sup> some seek to minimize its scope,<sup>132</sup> and some support a middle ground.<sup>133</sup>

Debate on the apparent conflict between the right of publicity and the First Amendment varies. Professional athletes and their legal counsel, such as Bruce Meyer, an attorney for NFL players, fear an expansive interpretation of the First Amendment would lead to unregulated commercialization of sport memorabilia.<sup>134</sup> Legal counsel for sport artists, such as J. Michael Murray, Rick Rush's First Amendment attorney, note that public events warrant artistic reproduction<sup>135</sup> and that professional athletes are attempting to control public commentary:

What we are seeing here are public figures who are attempting to control what is said about them, what is written about them, what ideas are depicted in art and in literature. Under the claim of a right of publicity to control their persona, they are in the process of trampling on fundamental rights of expression.<sup>136</sup>

Others support an artist's freedom to paint a sport celebrity's portrait, but not the right to cash in on his or her likeness. Alternatively, some propose that celebrity carries with it certain responsibilities and burdens, "Mr. Woods' extraordinary accomplishments give rise to many benefits and a few burdens.

131. See generally MCCARTHY, *supra* note 29.

132. Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity*, 9 DEPAUL-LCA J. ART & ENT. L. & POL'Y 35, 60 (1998).

133. Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994).

134.

Can you knock off thousands of copies of the image of Tiger Woods and then hide behind the First Amendment and say it is a work of art? The judge's opinion threatens the very existence of the right of publicity, because nearly every commercial product, be it a figurine, trading card, replica jersey or poster, has design elements that could be characterized as artistic.

Kim, *First Amendment & Publicity: Who Controls Tiger Woods?*, THE INTERNET PARTY, at [http://www.theinternetparty.org/commentary/c\\_s.php?section\\_type=com&td=20020708000159](http://www.theinternetparty.org/commentary/c_s.php?section_type=com&td=20020708000159) (July 8, 2002).

135.

Tiger Woods was the first African-American, Asian-American to win the Masters, at a club that historically had excluded all minorities for so many years. This is a story of surpassing importance, for artists, writers, photographers, painters. All have, we believe, a right under the First Amendment to express their ideas about this important event, this public figure who now is becoming more important. They certainly have the right to sell their expression.

*Id.*

136. *Id.*

One of the burdens. . . is having to see himself depicted in words and pictures by people who have things to say about him."<sup>137</sup>

It is worth noting that *Cardtoons*, *ETW Corp.*, and *Comedy III* all discussed the social importance that celebrities play daily in society. Professional athletes take on personal meaning to spectators and fans, playing leading roles in the public drama of sport. "We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles, their modes of conversation and of consumption."<sup>138</sup> Athletes are not mere graceful beings who can command the human body to perform extraordinary feats. Their personas become "important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our culture business and everyday conversation."<sup>139</sup> Thus, while some believe that a professional athlete should be able to control the exploitation of his or her image, we must also tread lightly when we deprive others of the rights secured by the Constitution, particularly when those rights have such important social connections and implications.

Nevertheless, *Comedy III's* transformative test is well noted for its attempt to limit those instances whereby artists attempt to piggyback on a celebrity's fame without adding something more, such as social commentary or creative expression. However, as noted herein, *Comedy III's* solution is not without its inherent design flaws. The court ironically held that Saderup's charcoal sketches did not deserve First Amendment protection because they accurately depicted what he set out to draw. The transformative test unjustly penalizes skilled portraiture artists who produce wholesome and reverential portraits of celebrities, forcing these artists to create "something recognizably [as the artist's] own."<sup>140</sup> Such works should not be considered "merely trivial variations."<sup>141</sup>

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137. *Id.*

138. *Comedy III Prod's*, 21 P.3d at 803, quoting Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 128 (1993).

139. *Comedy III Prod's*, 21 P.3d at 803.

140. *Id.* at 810.

141. It should be noted the court concedes that some literal reproduction of celebrity portraits may be protected by the First Amendment, such as Andy Warhol's silk screens because "Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images." *Id.* The court seemingly contradicts itself, however, because both Saderup and Warhol's works are protected works of art, the former as entertainment or visual art and the latter because of its "ironic social comment on the dehumanization of celebrity", yet Saderup's works, though silk-screens like Warhol's, did not express a communicate message which is not required for First Amendment protection, a fact that even the California court acknowledges: "Nor do Saderup's creations lose their

Admittedly, it can be argued that *Comedy III* is a narrow holding, applying only to one man's charcoal drawing and its reproduction on lithographs and T-shirts. On the other hand, allowing free speech to be eroded in the name of image licensing is a slippery slope that courts should avoid.

*ETW Corp's.* holding is no less problematic. It could seemingly disenfranchise professional athletes of significant commercial rights to their image if construed too broadly. Opponents naturally fear the court's ruling allows sport artists and other vendors to run amuck in the sport memorabilia marketplace by encouraging artists to freely paint the portrait of a professional athlete, reproduce the image on any commercial product, and then exploit these items for financial gain thereby circumventing the professional athlete's right of publicity. Protecting products, however, is not the aim of the First Amendment.<sup>142</sup> The circuit courts in *Bery* and *ETW Corp.*, and even *Comedy III*, correctly looked past the medium of an artwork on the way to determining its constitutional worth.<sup>143</sup> The artist's preferred choice of 'canvas' is irrelevant to First Amendment consideration. Whether it is the back of a jacket, the front of a T-shirt, or the ceiling of the Sistine Chapel, artists and their patrons must be free to choose their media and convey their messages. Thus, whether sport artists such as Leroy Neiman should choose to place their artwork on a canvass or a coffee cup is for all practical purposes rightfully left up to the creative imagination of the artist, not the courts. Coffee cups are not canvasses by any stretch of the imagination, but courts have long recognized that "visual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing."<sup>144</sup> To hold otherwise would potentially chill First Amendment expression and the sport artist's ability to do what he or she does best, create sport art.<sup>145</sup>

This does not mean, however, that every T-shirt or coffee mug bearing a celebrity image automatically receives constitutional protection, just like every book, song, or portrait does not automatically qualify for First Amendment

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constitutional protections because they are for purposes of entertaining rather than informing. . . Our courts have often observed that entertainment is entitled to the same constitutional protection as the exposition of ideas." *Id.* at 803.

142. "Paintings, photographs, prints and sculptures. . . always communicate some idea or concept to those who view it, and as such are entitled to full First Amendment protections." *ETW Corp.*, 99 F. Supp. 2d at 836, citing *Bery*, 97 F.3d at 696.

143. *ETW Corp.*, 99 F. Supp. 2d at 836.

144. *Bery*, 97 F.3d at 695.

145. E. Kenly Ames, *Beyond Rogers v. Koons: A Fair Use Standard for Appropriation*, COLUM. L. REV. 1473, 1485 (1993); Michelle Brownlee, *Safeguarding Style: What Protection is Afforded to Visual Artists by the Copyright and Trademark Laws?*, 93 COLUM. L. REV. 1157, 1180 (1993); Patricia Krieg, *Copyright, Free Speech, and the Visual Arts*, 93 YALE L.J. 1565, 1568 (1984).

protection. When branding a work of sport art or tagging it as a sport memorabilia item outside the scope of the First Amendment, one cannot look solely to the work's form or medium or even its intended expression. Some works of art, for example, are created for pure entertainment purposes and express no discernable message, yet nevertheless retain all constitutional protections<sup>146</sup> Moreover, as *Comedy III* and *ETW Corp.* correctly noted, if the original work of art is protected, so are its derivative works, whether those works are placed on T-shirts or made into limited edition art prints.<sup>147</sup>

Where the boundary of "art" lies, no one knows for sure. Not even artists or art critics can know its limits. While portraiture may no longer serve as the only mechanism for recording the thoughts, feelings, and achievements of society, courts should take heed of Supreme Court Justice Oliver Holmes comments on judicial interpretation of art: "It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations. . ."<sup>148</sup>

When courts, however, are forced to distinguish sport merchandise from sport art, they would be wise to consult the history books, not legal text. Individual interpretive expression dates back to dawn of humankind. The Picassos, Monets, Van Goghs, and Andy Warhols of the world did not see art as mainstream society saw it. They daringly expressed their ideas outside of the conventional artistic box of their times. These "unconventional" expressions escaped even the most skilled critic at the time. Inevitably, the ability to critique art evades us all. Art defines itself.

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146. *Comedy III Prod's*, 21 P.3d at 804, citing *Guglielmi*, 25 Cal. 3d at 867. "[E]ntertainment, as a mode of self-expression, is entitled to constitutional protection irrespective of its contribution to the marketplace of ideas. For expression is an integral part of the development of ideas, of mental exploration and the affirmation of self."

147. *Id.* at 810.

148. *Bleistein v. Donaldson Co.*, 188 U.S. 239, 251 (1903).



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