

United States Court of Appeals,
 Ninth Circuit.
 Tom WAITS, Plaintiff-Appellee,
 v.
 FRITO-LAY, INC.; Tracy-Locke, Inc.,
 Defendants-Appellants.
 No. 90-55981.

Argued and Submitted Dec. 3, 1991.
 Decided Aug. 5, 1992.
 As Amended on Denial of Rehearing and
 Rehearing En Banc
 Oct. 6, 1992.
 As Amended Oct. 22, 1992.

Singer whose unique voice was imitated in radio commercial brought suit for false endorsement under Lanham Act and voice misappropriation under California law. Jury returned verdict in favor of performer following trial in the United States District Court for the Central District of California, James M. Ideman, J. Appeal was taken. The Court of Appeals, Boochever, Circuit Judge, held that: (1) claim under California law for infringement of voice was not preempted by federal copyright law; (2) singer was "widely known" as needed to prevail on voice misappropriation claim; (3) compensatory damages award totaling \$375,000 was supported by evidence; (4) \$2 million punitive damages award was supported by clear and convincing evidence; (5) false endorsement claim was cognizable under Lanham Act; (6) singer had standing to bring false endorsement claim under Lanham Act; and (7) award of attorney fees under § 35 of Lanham Act was not abuse of discretion.

Affirmed in part and vacated in part.

West Headnotes

[1] Federal Courts ⚡776
170Bk776 Most Cited Cases
 Court of Appeals reviews questions of law de novo.

[2] States ⚡18.15
360k18.15 Most Cited Cases

[2] Torts ⚡328
379k328 Most Cited Cases
 (Formerly 379k8.5(5.1), 379k8.5(5))

Voice misappropriation claim under California law, arising from radio commercial featuring vocal performance imitating performer's unique singing voice, was not preempted by federal copyright law since copyright infringement challenges unauthorized use of song or recording while voice misappropriation claim challenges use of voice. 17 U.S.C.A. § 114.

[3] Federal Civil Procedure ⚡2182.1
170Ak2182.1 Most Cited Cases
 (Formerly 170Ak2182)

Court of Appeals considers jury instructions as whole to determine if instructions are misleading or inadequate.

[4] Federal Courts ⚡822
170Bk822 Most Cited Cases

Court of Appeals reviews challenges to formulation of jury instructions for abuse of discretion.

[5] Federal Courts ⚡776
170Bk776 Most Cited Cases

Whether jury instruction misstates elements of claim that must be proved at trial is question of law which Court of Appeals reviews de novo.

[6] Torts ↪389

379k389 Most Cited Cases

(Formerly 379k28)

Jury instruction on claim for voice misappropriation under California law arising from radio commercial imitating performer's unique singing voice was not misleading, even though proposed instruction distinguishing between voice and style was denied, since instructions limited jury's consideration to voice, did not imply that style could be considered, and that style imitation alone was insufficient for tort liability.

[7] Torts ↪389

379k389 Most Cited Cases

(Formerly 379k28)

Jury instruction inviting jury to use common sense in determining whether performer had distinctive enough voice to warrant protection was appropriate instruction in claim under California law for voice misappropriation arising from imitation of performer's voice in radio commercial; distinctiveness of voice was not separate concept of identifiability.

[8] Torts ↪389

379k389 Most Cited Cases

(Formerly 379k8.5(5.1), 379k8.5(5))

Professional singer's voice is "widely known," for purposes of voice appropriation claim under California law, if voice is known to large number of people throughout relatively large geographic area.

[9] Damages ↪57.37

115k57.37 Most Cited Cases

(Formerly 115k49.10)

Under California law, damages in right of publicity actions are not limited to economic injury only; appropriation of identity of celebrity may induce humiliation, embarrassment, and mental distress.

[10] Damages ↪140.7

115k140.7 Most Cited Cases

(Formerly 115k130.1, 115k130(1))

Damage award in claim for voice misappropriation under California law of \$200,000 for injury to peace, happiness, and feelings of performer whose unique singing voice was imitated in radio commercial was supported by evidence that commercial use of performer's voice was particularly offensive to performer, performer had outspoken public stance against doing commercial endorsements, and commercial embarrassed performer.

[11] Damages ↪30

115k30 Most Cited Cases

Under California law, compensation for injury to reputation is appropriate if misappropriation of identity causes such injury. West's Ann.Cal.Civ.Code § 3333.

[12] Damages ↪137

115k137 Most Cited Cases

Under California law, jury's award of \$75,000 to performer whose unique singing voice was imitated in radio commercial, for injury to performer's good will and future publicity value, was supported by evidence that performer was made to appear hypocritical for making commercial endorsement, performer's artistic reputation was damaged, and fee which performer could command if performer decided to do commercial in future was lowered because

of imitation. West's Ann.Cal.Civ.Code § 3333.

[13] Damages ⚡91.5(1)

115k91.5(1) Most Cited Cases

(Formerly 115k91(1))

Under California law, exemplary or punitive damages are available when it is proven by clear and convincing evidence that defendant has been guilty of oppression, fraud, or malice. West's Ann.Cal.Civ.Code § 3294(a).

[14] Damages ⚡91.5(1)

115k91.5(1) Most Cited Cases

(Formerly 115k91(1))

Punitive damages are generally unavailable under California law when issue is one of first impression or where right has not been clearly established. West's Ann.Cal.Civ.Code § 3294(a).

[15] Damages ⚡91.5(3)

115k91.5(3) Most Cited Cases

(Formerly 115k91(1))

Punitive damages were available under California law in voice appropriation claim by performer whose unique singing voice was imitated in radio commercial since right of well-known professional singer to control commercial use of distinctive voice was clearly established at time commercial was run, persons responsible for making commercial were familiar with performer's right to control commercial use of voice, and defendants consciously disregarded performer's rights by using commercial. West's Ann.Cal.Civ.Code § 3294(a).

[16] Damages ⚡189.5

115k189.5 Most Cited Cases

(Formerly 115k184)

"Clear and convincing evidence," as required by California law to support punitive damages, is evidence sufficient to support finding of high probability. West's Ann.Cal.Civ.Code § 3294(a).

[17] Antitrust and Trade Regulation ⚡19

29Tk19 Most Cited Cases

(Formerly 382k870(2), 382k870.1 Trade Regulation)

[17] Antitrust and Trade Regulation ⚡22

29Tk22 Most Cited Cases

(Formerly 382k870(2), 382k870.1 Trade Regulation)

[17] Antitrust and Trade Regulation ⚡29

29Tk29 Most Cited Cases

(Formerly 382k870(2), 382k870.1 Trade Regulation)

Lanham Act prohibits use of false designations of origin, false descriptions, and false representations in advertising and sale of goods and services. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[18] Antitrust and Trade Regulation ⚡30

29Tk30 Most Cited Cases

(Formerly 382k870(2), 382k870.1 Trade Regulation)

False endorsement claims, including those premised on unauthorized imitation of entertainer's distinctive voice, are cognizable under § 43(a) of Lanham Act, which prohibits use of false designations of origin, descriptions, or representations in advertising in sale of goods and services. Lanham Trade-Mark Act, § 43(a), as

amended, 15 U.S.C.A. § 1125(a).

[19] Antitrust and Trade Regulation

↪64

29Tk64 Most Cited Cases

(Formerly 382k870(2), 382k870.1 Trade Regulation)

Discernibly competitive injury must be alleged to have standing to bring suit for false representation under Lanham Act where alleged misrepresentation in advertising and sale of goods and services simply concerns product's qualities. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[20] Trademarks ↪1563

382Tk1563 Most Cited Cases

(Formerly 382k870(2), 382k870.1 Trade Regulation)

Parties with standing to bring claim for misuse of mark under Lanham Act include parties with commercial interest in product wrongfully identified with another's mark or with commercial interest in misused mark, regardless of actual competition. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[21] Trademarks ↪1419

382Tk1419 Most Cited Cases

(Formerly 382k407 Trade Regulation)

[21] Antitrust and Trade Regulation

↪30

29Tk30 Most Cited Cases

Concerning.

(Formerly 382k407 Trade Regulation)

False association claim under Lanham Act requires that misuse of trademark or other distinguishing device confuse consumers as to origin, approval, or endorsement of

product. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[22] Trademarks ↪1095

382Tk1095 Most Cited Cases

(Formerly 382k407 Trade Regulation)

[22] Trademarks ↪1104

382Tk1104 Most Cited Cases

(Formerly 382k407 Trade Regulation)

"Consumer confusion" needed to prevail in false association claim under Lanham Act, may be demonstrated by use of similar or identical trademarks on competing goods. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[23] Antitrust and Trade Regulation

↪64

29Tk64 Most Cited Cases

(Formerly 382k544 Trade Regulation)

Celebrity whose endorsement of product is implied through imitation of distinctive attribute of celebrity's identity has standing to sue for false endorsement under Lanham Act. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[24] Antitrust and Trade Regulation

↪30

29Tk30 Most Cited Cases

(Formerly 382k596 Trade Regulation)

Jury finding in false endorsement claim under Lanham Act, in favor of performer whose unique singing voice was imitated in radio commercial, was supported by similarities between performer's recordings and commercial, impersonator of performer delivered endorsement, commercial was targeted to audience which overlapped with performer's audience, and evidence of actual consumer confusion. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. §

1125(a).

[25] Trademarks ↪1754(2)
382Tk1754(2) Most Cited Cases
(Formerly 382k729)

Lanham Act authorizes attorney fee awards for prevailing plaintiffs in exceptional cases, including those in which defendants' conduct is malicious, fraudulent, deliberate, or willful. Lanham Trade-Mark Act, § 35, as amended, 15 U.S.C.A. § 1117.

[26] Federal Courts ↪830
170Bk830 Most Cited Cases
(Formerly 382k729)

Attorney fee awards under Lanham Act are reviewed for abuse of discretion. Lanham Trade-Mark Act, § 35, as amended, 15 U.S.C.A. § 1117.

[27] Antitrust and Trade Regulation ↪118

29Tk118 Most Cited Cases
(Formerly 382k729 Trade Regulation)

Award of reasonable attorney fees under Lanham Act to performer whose unique singing voice was imitated in commercial was not abuse of discretion in light of jury finding that defendants acted with oppression, fraud, or malice. Lanham Trade-Mark Act, § 35, as amended, 15 U.S.C.A. § 1117.

*1096 Lionel S. Sobel, Liebig & Kulzick, Los Angeles, Cal., Robert M. Callagy, Satterlee, Stephens, Burke & Burke, New York City, for defendants-appellants.

Howard King, Gang, Tyre, Ramer & Brown, Los Angeles, Cal., for plaintiff-appellee.

Appeal from the United States District Court for the Central District of California.

Before: BROWNING, BOOCHEVER, and REINHARDT, Circuit Judges.

ORDER

The opinion in the above-entitled case, No. 90-55981, slip op. 9429 (9th Cir. Aug. 5, 1992), is amended by deleting footnote 4 on page 9449, and substituting in its place the following:

[Editor's Note: This change has been incorporated into the published opinion.]

With this amendment the panel has voted to deny the petition for rehearing. Judges Browning and Reinhardt reject the suggestion for rehearing en banc and Judge Boochever recommends rejection of the suggestion for rehearing en banc.

The full court has been advised of the suggestion for rehearing en banc and no active judge has requested a vote on whether to rehear the matter en banc. (Fed.R.App.P. 35.)

The petition for rehearing is denied and the suggestion for rehearing en banc is rejected.

OPINION

BOOCHEVER, Circuit Judge:

Defendants Frito-Lay, Inc., and Tracy-Locke, Inc., appeal a jury verdict and award of \$2.6 million in compensatory damages, punitive damages, and attorney's fees, in favor of singer Tom Waits. Waits sued the snack food manufacturer and its advertising agency for voice misappropriation and false endorsement following the broadcast of a radio commercial for SalsaRio Doritos which featured a vocal performance

imitating Waits' raspy singing voice. On appeal, the defendants mount attacks on nearly all aspects of the judgment.

In challenging the judgment on Waits' voice misappropriation claim, the defendants first contend that our decision in Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir.1988), cert. denied, 503 U.S. 951, 112 S.Ct. 1513, 1514, 117 L.Ed.2d 650 (1992), recognizing voice misappropriation as a California tort, is no longer good law. Next, they contend that the district court erred in instructing the jury on the elements of voice misappropriation. Finally, the defendants urge us to vacate portions of the jury's damage award, arguing that several types of compensatory damages as well as punitive damages are unavailable as a matter of law, and in any event lack evidentiary support.

In challenging the judgment on Waits' false endorsement claim under section 43(a) of the Lanham Act, the defendants contend that Waits lacks standing to sue because he is not in competition with the defendants. They also argue that Waits did not establish his claim at trial, and that damages and attorney's fees were improperly awarded.

Because it is duplicative, we vacate the award of damages under the Lanham Act. We affirm in all other respects.

*1097 BACKGROUND

Tom Waits is a professional singer, songwriter, and actor of some renown. Waits has a raspy, gravelly singing voice, described by one fan as "like how you'd sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades.... Late at night. After not sleeping for three days." Since

the early 1970s, when his professional singing career began, Waits has recorded more than seventeen albums and has toured extensively, playing to sold-out audiences throughout the United States, Canada, Europe, Japan, and Australia. Regarded as a "prestige artist" rather than a musical superstar, Waits has achieved both commercial and critical success in his musical career. In 1987, Waits received *Rolling Stone* magazine's Critic's Award for Best Live Performance, chosen over other noted performers such as Bruce Springsteen, U2, David Bowie, and Madonna. *SPIN* magazine listed him in its March 1990 issue as one of the ten most interesting recording artists of the last five years. Waits has appeared and performed on such television programs as "Saturday Night Live" and "Late Night with David Letterman," and has been the subject of numerous magazine and newspaper articles appearing in such publications as *Time*, *Newsweek*, and the *Wall Street Journal*. Tom Waits does not, however, do commercials. He has maintained this policy consistently during the past ten years, rejecting numerous lucrative offers to endorse major products. Moreover, Waits' policy is a public one: in magazine, radio, and newspaper interviews he has expressed his philosophy that musical artists should not do commercials because it detracts from their artistic integrity.

Frito-Lay, Inc. is in the business of manufacturing, distributing, and selling prepared and packaged food products, including Doritos brand corn chips. Tracy-Locke, Inc. is an advertising agency which counts Frito-Lay among its clients. In developing an advertising campaign to introduce a new Frito-Lay product, SalsaRio Doritos, Tracy-Locke found inspiration in a

1976 Waits song, "Step Right Up." Ironically, this song is a jazzy parody of commercial hucksterism, and consists of a succession of humorous advertising pitches. [FN1] The commercial the ad agency wrote echoed the rhyming word play of the Waits song. In its presentation of the script to Frito-Lay, Tracy-Locke had the copywriter sing a preliminary rendition of the commercial and then played Waits' recorded rendition of "Step Right Up" to demonstrate the feeling the commercial would capture. Frito-Lay approved the overall concept and the script.

FN1. Waits characterizes the song as an indictment of advertising. It ends with the line, "What the large print giveth, the small print taketh away." See Murray Ohio Mfg. Co. v. Continental Ins. Co., 705 F.Supp. 442, 444 (N.D.Ill.1989) (quoting "Tom Waits' noted maxim" in interpreting insurance contract).

The story of Tracy-Locke's search for a lead singer for the commercial suggests that no one would do but a singer who could not only capture the feeling of "Step Right Up" but also imitate Tom Waits' voice. The initial efforts of the ad agency's creative team, using a respected professional singer with a deep bluesy voice, met with disapproval from executives at both Tracy-Locke and Frito-Lay. Tracy-Locke then auditioned a number of other singers who could sing in a gravelly style.

Stephen Carter was among those who auditioned. A recording engineer who was acquainted with Carter's work had recommended him to Tracy-Locke as someone who did a good Tom Waits

imitation. Carter was a professional musician from Dallas and a Tom Waits fan. Over ten years of performing Waits songs as part of his band's repertoire, he had consciously perfected an imitation of Waits' voice. When Carter auditioned, members of the Tracy-Locke creative team "did a double take" over Carter's near-perfect imitation of Waits, and remarked to him how much he sounded like Waits. In fact, the commercial's musical director warned Carter that he probably wouldn't get the job because he sounded too much like Waits, which *1098 could pose legal problems. Carter, however, did get the job.

At the recording session for the commercial David Brenner, Tracy-Locke's executive producer, became concerned about the legal implications of Carter's skill in imitating Waits, and attempted to get Carter to "back off" his Waits imitation. Neither the client nor the members of the creative team, however, liked the result. After the session, Carter remarked to Brenner that Waits would be unhappy with the commercial because of his publicly avowed policy against doing commercial endorsements and his disapproval of artists who did. Brenner acknowledged he was aware of this, telling Carter that he had previously approached Waits to do a Diet Coke commercial and "you never heard anybody say no so fast in your life." Brenner conveyed to Robert Grossman, Tracy-Locke's managing vice president and the executive on the Frito-Lay account, his concerns that the commercial was too close to Waits' voice. As a precaution, Brenner made an alternate version of the commercial with another singer.

On the day the commercial was due for

release to radio stations across the country, Grossman had a ten-minute long-distance telephone consultation with Tracy-Locke's attorney, asking him whether there would be legal problems with a commercial that sought to capture the same feeling as Waits' music. The attorney noted that there was a "high profile" risk of a lawsuit in view of recent case law recognizing the protectability of a distinctive voice. Based on what Grossman had told him, however, the attorney did not think such a suit would have merit, because a singer's style of music is not protected. Grossman then presented both the Carter tape and the alternate version to Frito-Lay, noting the legal risks involved in the Carter version. He recommended the Carter version, however, and noted that Tracy-Locke would indemnify Frito-Lay in the event of a lawsuit. Frito-Lay chose the Carter version.

The commercial was broadcast in September and October 1988 on over 250 radio stations located in 61 markets nationwide, including Los Angeles, San Francisco, and Chicago. Waits heard it during his appearance on a Los Angeles radio program, and was shocked. He realized "immediately that whoever was going to hear this and obviously identify the voice would also identify that [Tom Waits] in fact had agreed to do a commercial for Doritos."

In November 1988, Waits sued Tracy-Locke and Frito-Lay, alleging claims of misappropriation under California law and false endorsement under the Lanham Act. The case was tried before a jury in April and May 1990. The jury found in Waits' favor, awarding him \$375,000 compensatory damages and \$2 million punitive damages

for voice misappropriation, and \$100,000 damages for violation of the Lanham Act. The court awarded Waits attorneys' fees under the Lanham Act. This timely appeal followed.

DISCUSSION

I. Voice Misappropriation

In Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir.1988), cert. denied, 503 U.S. 951, 112 S.Ct. 1513, 1514, 117 L.Ed.2d 650 (1992), we held that "when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California." The *Midler* tort is a species of violation of the "right of publicity," the right of a person whose identity has commercial value--most often a celebrity--to control the commercial use of that identity. See Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 824-25 (9th Cir.1974). See generally J.T. McCarthy, *The Rights of Publicity and Privacy* (1987) (hereafter *Publicity and Privacy*). We recognized in *Midler* that when voice is a sufficient indicia of a celebrity's identity, the right of publicity protects against its imitation for commercial purposes without the celebrity's consent. See Midler, 849 F.2d at 463.

The jury found that the defendants had violated Waits' right of publicity by broadcasting a commercial which featured a deliberate imitation of Waits' voice. In doing *1099 so, the jury determined that Waits has a distinctive voice which is widely known. On appeal, the defendants attack the legal underpinnings of voice misappropriation, arguing that *Midler* is no longer an accurate statement of California

law. They also find fault with the court's formulation of the elements of voice misappropriation in its instructions to the jury. Finally, they attack both the compensatory and punitive damages awarded by the jury as legally inappropriate and unsupported by the evidence. We address each contention in turn.

A. Continuing Viability of *Midler*

[1] As a threshold matter, the defendants ask us to rethink *Midler*, and to reject it as an inaccurate statement of California law. *Midler*, according to the defendants, has been "impliedly overruled" by the Supreme Court's decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989). Additionally, they argue that the *Midler* tort is preempted by the federal Copyright Act. We review these questions of law *de novo*. See *Kruso v. International Tel. & Tel. Corp.*, 872 F.2d 1416, 1421 (9th Cir.1989), *cert. denied*, 496 U.S. 937, 110 S.Ct. 3217, 110 L.Ed.2d 664 (1990).

Bonito Boats involved a Florida statute giving perpetual patent-like protection to boat hull designs already on the market, a class of manufactured articles expressly excluded from federal patent protection. The Court ruled that the Florida statute was preempted by federal patent law because it directly conflicted with the comprehensive federal patent scheme. In reaching this conclusion, the Court cited its earlier decisions in *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661 (1964), and *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669 (1964), for the proposition that "publicly known design and utilitarian ideas

which were unprotected by patent occupied much the same position as the subject matter of an expired patent," *i.e.*, they are expressly unprotected. *Bonito Boats*, 489 U.S. at 152, 109 S.Ct. at 978.

The defendants seize upon this citation to *Sears* and *Compco* as a reaffirmation of the sweeping preemption principles for which these cases were once read to stand. They argue that *Midler* was wrongly decided because it ignores these two decisions, an omission that the defendants say indicates an erroneous assumption that *Sears* and *Compco* have been "relegated to the constitutional junkyard." Thus, the defendants go on to reason, earlier cases that rejected entertainers' challenges to imitations of their performances based on federal copyright preemption, were correctly decided because they relied on *Sears* and *Compco*. See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716-18 (9th Cir.1970), *cert. denied*, 402 U.S. 906, 91 S.Ct. 1376, 28 L.Ed.2d 646 (1971); *Booth v. Colgate-Palmolive Co.*, 362 F.Supp. 343, 348 (S.D.N.Y.1973); *Davis v. Trans World Airlines*, 297 F.Supp. 1145, 1147 (C.D.Cal.1969). This reasoning suffers from a number of flaws.

Bonito Boats itself cautions against reading *Sears* and *Compco* for a "broad pre-emptive principle" and cites subsequent Supreme Court decisions retreating from such a sweeping interpretation. "[T]he Patent and Copyright Clauses do not, by their own force or by negative implication, deprive the States of the power to adopt rules for the promotion of intellectual creation." *Bonito Boats*, 489 U.S. at 165, 109 S.Ct. at 985 (citing, *inter alia*, *Goldstein v. California*, 412 U.S. 546, 552-61, 93 S.Ct. 2303, 2307-

08, 37 L.Ed.2d 163 (1973) and Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 478-79, 94 S.Ct. 1879, 1885, 40 L.Ed.2d 315 (1974)). Instead, the Court reaffirmed the right of states to "place limited regulations on the use of unpatented designs in order to prevent consumer confusion as to source." *Id.* *Bonito Boats* thus cannot be read as endorsing or resurrecting the broad reading of *Compco* and *Sears* urged by the defendants, under which Waits' state tort claim arguably would be preempted.

Moreover, the Court itself recognized the authority of states to protect entertainers' "right of publicity" in Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977). In *1100 *Zacchini*, the Court endorsed a state right-of-publicity law as in harmony with federal patent and copyright law, holding that an unconsented-to television news broadcast of a commercial entertainer's performance was not protected by the First Amendment. *Id.* at 573, 576-78, 97 S.Ct. at 2856, 2858-59. The cases *Frito* asserts were "rightly decided" all predate *Zacchini* and other Supreme Court precedent narrowing *Sears'* and *Compco*'s sweeping preemption principles. In sum, our holding in *Midler*, upon which Waits' voice misappropriation claim rests, has not been eroded by subsequent authority.

The defendants ask that we rethink *Midler* anyway, arguing as the defendants did there that voice misappropriation is preempted by section 114 of the Copyright Act. Under this provision, a state cause of action escapes Copyright Act preemption if its subject matter "does not come within the subject matter of copyright ... including works or authorship not fixed in any

tangible medium of expression." 17 U.S.C. § 301(b)(1). We rejected copyright preemption in *Midler* because voice is not a subject matter of copyright: "A voice is not copyrightable. The sounds are not 'fixed.'" *Midler*, 849 F.2d at 462. As a three-judge panel, we are not at liberty to reconsider this conclusion, and even if we were, we would decline to disturb it.

[2] Waits' claim, like Bette Midler's, is for infringement of voice, not for infringement of a copyrightable subject such as sound recording or musical composition. Moreover, the legislative history of section 114 indicates the express intent of Congress that "[t]he evolving common law rights of 'privacy,' 'publicity,' and trade secrets ... remain unaffected [by the preemption provision] as long as the causes of action contain elements, such as an invasion of personal rights ... that are different in kind from copyright infringement." H.R.Rep. No. 1476, 94th Cong., 2d Sess. 132, reprinted in 1976 U.S.C.C.A.N. 5659, 5748. Waits' voice misappropriation claim is one for invasion of a personal property right: his right of publicity to control the use of his identity as embodied in his voice. See *Midler*, 849 F.2d at 462-63 ("What is put forward as protectable here is more personal than any work of authorship.... A voice is as distinctive and personal as a face.") The trial's focus was on the elements of voice misappropriation, as formulated in *Midler*: whether the defendants had deliberately imitated Waits' voice rather than simply his style and whether Waits' voice was sufficiently distinctive and widely known to give him a protectable right in its use. These elements are "different in kind" from those in a copyright infringement case challenging the

unauthorized use of a song or recording. Waits' voice misappropriation claim, therefore, is not preempted by federal copyright law.

B. *Jury Instructions*

[3][4][5] The defendants next contend that the district court committed prejudicial error by rejecting their proposed jury instructions on three elements of the *Midler* tort: the deliberate misappropriation for commercial purposes of (1) a voice, that is (2) distinctive and (3) widely known. We consider jury instructions as a whole to determine if they are misleading or inadequate. *United States v. Beltran-Rios*, 878 F.2d 1208, 1214 (9th Cir.1989). We review challenges to the formulation of jury instructions for abuse of discretion. *Id.* Whether a jury instruction misstates the elements that must be proved at trial, however, is a question of law which we review *de novo*. *United States v. Spillone*, 879 F.2d 514, 525 (9th Cir.1989), *cert. denied*, 498 U.S. 864, ---, 111 S.Ct. 173, 210, 112 L.Ed.2d 137, 170 (1990).

(1) "Voice" vs. "Style"

The defendants argued at trial that although they had consciously copied Tom Waits' style in creating the Doritos commercial, they had not deliberately imitated his voice. They accordingly proposed a jury instruction which distinguished in detail between voice, which is protected under *Midler*, and style, which is not. [FN2] The district *1101 court rejected this instruction. Instead, its instructions on voice misappropriation track closely the elements of the tort as formulated in *Midler*.

The court's instruction directed the jury to decide whether Waits' voice is distinctive,

whether his voice is widely known, and whether the defendants had deliberately imitated his voice.

FN2. The proposed instruction read in pertinent part:

Style is the way, manner or method of carrying out an activity.... In contemporary music, there are a great many styles or "sounds," for example ... blues, dixieland, country and western, rock, rap, rhythm and blues, etc. Style is *how* a song is sung, how the music is delivered, how the words of a song are expressed. Style includes mood, phrasing, and timing, whether a selection is performed loudly or quietly, whether the song is expressed in singing, talking, or a combination of the two.

Style is not subject to ownership. No singer can appropriate for himself any style and exclude others from performing in the same style.

Any singer is free to sing in the same style as any other singer. That is why we have a great many opera singers, blues singers, country-western singers, etc.

Defendants could not be held liable to plaintiff merely because the singer in their commercial performed in the same style as plaintiff has performed in.

The defendants argue that their proposed "style" instruction was crucial because of the deliberate stylistic similarities between the Doritos commercial and "Step Right Up" and because in instructing the jury on Waits' Lanham Act claim, the court told the jury that it could consider Waits' singing style,

songwriting style, and manner of presentation. In failing to give their proposed instruction, the defendants contend, the court misled the jury into believing that it could also consider the defendants' admitted imitation of Waits' style in determining liability for voice misappropriation.

[6] We disagree because, read as a whole, the instructions were not misleading. In charging the jury, the court repeatedly noted that two claims were presented for determination and gave separate instructions on each claim. The court's voice misappropriation instructions limited the jury's consideration to voice, and in no way implied that it could consider style. Indeed, in addressing the jury in closing argument, Waits' attorney agreed with the defendants that style was not protected. Moreover, the court included an additional instruction that effectively narrowed the jury's focus to Waits' voice and indicated that style imitation alone was insufficient for tort liability. For the defendants to be liable for voice misappropriation, the court stated, the imitation had to be so good that "people who were familiar with plaintiff's voice who heard the commercial *believed plaintiff performed it*. In this connection it is not enough that they were reminded of plaintiff or thought the singer sounded like plaintiff..." [FN3] (Emphasis added.) Even if the jury were initially confused about whether the defendants could be liable simply for imitating Waits' style, this instruction would have disabused them of this notion.

FN3. This instruction effectively added an additional element to *Midler*'s formulation of voice

misappropriation: actual confusion. The validity of this instruction is not before us in this appeal and we express no opinion on this issue.

(2) Definition of "Distinctive"

The defendants next argue that the court's instruction concerning the meaning of "distinctive" was an unfair and inaccurate statement of the law because it confuses the "distinctiveness" of a voice with its identifiability or recognizability. The instruction given states in part: "A voice is distinctive if it is distinguishable from the voices of other singers.... if it has particular qualities or characteristics that identify it with a particular singer." At trial the defendants' experts testified that identifiability depends, not on distinctiveness, but on the listener's expectations; that distinctiveness and recognizability are not the same thing; and that recognizability is enhanced by style similarity. The defendants argue that these theories were inadequately dealt with by the court's instruction and that because *anyone's* voice is identifiable by someone, it was error for the court not to make clear the difference between distinctiveness and identifiability. We disagree.

*1102 The defendants' technical argument that distinctiveness is a separate concept from identifiability, while supported by their experts' testimony, has no basis in law. Identifiability is properly considered in evaluating distinctiveness, for it is a central element of a right of publicity claim. See *Publicity and Privacy* § 3.4[A] & n. 1 (citing cases). Our *Midler* holding is premised on the fact that a person is as identifiable by voice as by any other indicia

of identity previously recognized as protectable. Although we did not define "distinctiveness" in *Midler*, we stated: "A voice is as *distinctive* and personal as a face. The human voice is one of the most palpable ways *identity is manifested*. We are all aware that a friend is at once *known* by a few words on the phone.... [T]hese observations hold true of singing...." *Midler v. Ford*, 849 F.2d at 463 (emphasis added). See also *Motschenbacher*, 498 F.2d at 826-27 (rejecting trial court's ruling that because plaintiff's face was not recognizable in advertisement photograph, his identity had not been misappropriated, and finding that plaintiff was identifiable from distinctive decorations on race car).

[7] The court's "distinctiveness" instruction informed the jury that it could consider the recordings of Waits' voice introduced into evidence and the testimony of expert and other witnesses. The court thus invited members of the jury to use their common sense in determining whether Waits has a distinctive enough voice to warrant protection, and to consider as well what the experts had to say. This was entirely appropriate. See *Publicity and Privacy*, § 3.4 [C] (jury must use "common sense ... guided by the weight of the evidence" in determining minimum threshold of identifiability in right of publicity actions). The court was not required to formulate instructions endorsing expert opinions which lacked legal foundation. Finally, we are unpersuaded by the defendants' argument that the court's instruction would have allowed the jury to hold them liable for imitation of a voice that was identifiable by only a small number of people, inasmuch as *Midler* also requires that the plaintiff's voice be "widely known."

(3) Definition of "Widely Known"

[8] The defendants next object to the district court's instruction concerning the element of "widely known" on the ground that it was too vague to guide the jury in making a factual determination of the issue. The court instructed the jury: "A professional singer's voice is widely known if it is known to a *large number* of people throughout a *relatively large* geographic area." (Emphasis added.) The court rejected an instruction proposed by the defendants, which reflected their contention at trial that Tom Waits is a singer known only to music insiders and to a small but loyal group of fans: "A singer is not widely known if he is only recognized by his own fans, or fans of a particular sort of music, or a small segment of the population."

The legal underpinnings of this proposed instruction are questionable. The defendants assert that because Waits has not achieved the level of celebrity Bette Midler has, he is not well known under the *Midler* standard. We reject this crabbed interpretation of *Midler*. The defendants' proposed instruction would have excluded from legal protection the voices of many popular singers who fall short of superstardom. "Well known" is a relative term, and differences in the extent of celebrity are adequately reflected in the amount of damages recoverable. See *Motschenbacher*, 498 F.2d at 824 n. 11 ("Generally, the greater the fame or notoriety of the identity appropriated, the greater will be the extent of the economic injury suffered."). Moreover, even were these instructions inadequate in some regard the error would be harmless, for we agree

with the district court that the "great weight of evidence produced at trial indicates that Tom Waits is very widely known."

In sum, we find no error in the instructions given to the jury on Waits' voice misappropriation claim.

C. Compensatory Damage Award

The jury awarded Waits the following compensatory damages for voice misappropriation: *1103 \$100,000 for the fair market value of his services; \$200,000 for injury to his peace, happiness and feelings; and \$75,000 for injury to his goodwill, professional standing and future publicity value. The defendants contest the latter two awards, disputing both the availability of such damages in a voice misappropriation action and the sufficiency of the evidence supporting the awards.

1. Injury to Peace, Happiness and Feelings

[9] The defendants argue that in right of publicity actions, only damages to compensate for economic injury are available. We disagree. Although the injury stemming from violation of the right of publicity "may be largely, or even wholly, of an economic or material nature," we have recognized that "it is quite possible that the appropriation of the identity of a celebrity may induce humiliation, embarrassment, and mental distress." *Motschenbacher*, 498 F.2d at 824 & n. 11. Contrary to the defendants' assertions, *Midler* neither discussed nor limited the damages recoverable in a voice misappropriation action. *Midler* makes reference to the market value of *Midler*'s voice solely to support its conclusion that her voice has economic value and, therefore,

is a protectable property right. See 849 F.2d at 463.

[10] In assessing the propriety of mental distress damages, our focus is properly directed to the nature of the infringement and its embarrassing impact on the plaintiff. *Publicity and Privacy* § 4.2[A]. Often the objectionable nature of the use will cause mental distress. *Id.* § 4.2[B], [C], [D] (discussing cases). In *Grant v. Esquire, Inc.*, 367 F.Supp. 876 (S.D.N.Y.1973), for example, the court found that the mere use of a celebrity's identity could cause embarrassment for which mental distress damages would be available. The case involved a suit by Cary Grant against *Esquire* magazine for publishing a photograph in which Grant's head was superimposed on a clothing model's torso. Like Waits, Grant had taken a public position against reaping commercial profits from the publicity value of his identity. *Id.* at 880. The court, after finding that Grant had a protectable right of publicity, noted that "[i]f the jury decides in plaintiff Grant's favor he will of course be entitled to recover for any lacerations to his feelings that he may be able to establish" in addition to the fair market value of use of his identity. *Id.* at 881. Given the evidence that the commercial use of his voice was particularly offensive to Waits, we conclude that Waits' prayer for mental distress damages was properly submitted to the jury.

The defendants argue, however, that merely taking offense is an insufficient basis for awarding mental distress damages, and that under California law the evidence was insufficient to support the award. In California, mental distress damages may be

recovered for "shame, humiliation, embarrassment, [and] anger." Young v. Bank of America, 141 Cal.App.3d 108, 114, 190 Cal.Rptr. 122 (1983); see also Moore v. Greene, 431 F.2d 584, 591 & n. 3 (9th Cir.1970) (damages available for anxiety, humiliation and indignity). Waits testified that when he heard the Doritos commercial, "this corn chip sermon," he was shocked and very angry. These feelings "grew and grew over a period of a couple of days" because of his strong public opposition to doing commercials. Waits testified, "[I]t embarrassed me. I had to call all my friends, that if they hear this thing, please be informed this is not me. I was on the phone for days. I also had people calling me saying, Gee, Tom, I heard the new Doritos ad." Added to this evidence of Waits' shock, anger, and embarrassment is the strong inference that, because of his outspoken public stance against doing commercial endorsements, the Doritos commercial humiliated Waits by making him an apparent hypocrite. This evidence was sufficient both to allow the jury to consider mental distress damages and to support their eventual award.

2. Injury to Goodwill and Future Publicity Value

The defendants next argue that reputational damages are available only in defamation *1104 actions and that since Waits did not allege or prove defamation, they were unavailable here. Further, they argue, there was no evidence to support the award of such damages because Waits did not show that his career had suffered. Again, we reject these contentions.

[11][12] We have no doubt, in light of

general tort liability principles, that where the misappropriation of identity causes injury to reputation, compensation for such injury is appropriate. See Cal.Civ.Code § 3333 (West 1970) (available damages are those "which will compensate for all of the detriment" caused by defendant's tortious conduct). Reputational damages, moreover, have been awarded in right of publicity cases. See Clark v. Celeb Publishing, Inc., 530 F.Supp. 979, 984 (S.D.N.Y.1981) (applying California law); Hirsch v. S.C. Johnson & Son, Inc., 90 Wis.2d 379, 280 N.W.2d 129, 138 (1979). The central issue is not whether these damages were available, but whether the evidence was sufficient to establish injury to Waits' reputation. As we noted above, the jury could have inferred from the evidence that the commercial created a public impression that Waits was a hypocrite for endorsing Doritos. Moreover, it also could have inferred damage to his artistic reputation, for Waits had testified that "part of my character and personality and image that I have cultivated is that I do not endorse products." Finally, from the testimony of Waits' expert witness, the jury could have inferred that if Waits ever wanted to do a commercial in the future, the fee he could command would be lowered by \$50,000 to \$150,000 because of the Doritos commercial. This evidence was sufficient to support the jury's award of \$75,000 for injury to Waits' goodwill and future publicity value.

D. Punitive Damage Award

The jury awarded Waits a total of \$2 million in punitive damages for voice misappropriation: \$1.5 million against Tracy-Locke and \$500,000 against Frito-

Lay. The defendants ask that we vacate this award, arguing that punitive damages are unavailable as a matter of law, and alternatively, that the evidence was insufficient to support their award. [FN4]

FN4. Beyond arguing that the issue should not have been submitted to the jury in the first instance, the defendants do not challenge the sufficiency of the court's jury instructions on punitive damages. Because we affirm the jury's conclusion that the defendants acted in conscious disregard of Waits' rights, we reject defendants' claim that the award of punitive damages violated their due process rights because they lacked notice that their conduct would violate Waits' rights.

[13] In California, exemplary or punitive damages are available "where it is proven by clear and convincing evidence that the defendant has been guilty of oppression, fraud, or malice." Cal.Civ.Code § 3294(a) (West Supp.1992). The statute defines "malice" in pertinent part as "despicable conduct which is carried on by the defendant with a *willful and conscious disregard of the rights or safety of others.*" Id. § 3294(c)(1) (emphasis added). The defendants contend that because *Midler* was so recently decided and so imprecise in the scope of its holding, they could not have been aware of the rights they were infringing upon in broadcasting the commercial. Thus, they reason, their conduct was not in "conscious disregard" of Waits' property right in his voice.

[14] Where an issue is one of first impression or where a right has not been clearly established, punitive damages are

generally unavailable. See, e.g., *Morgan Guar. Trust Co. v. American Sav. & Loan Ass'n*, 804 F.2d 1487, 1500 (9th Cir.1986), *cert. denied*, 482 U.S. 929, 107 S.Ct. 3214, 96 L.Ed.2d 701 (1987); *Bartling v. Glendale Adventist Medical Center*, 184 Cal.App.3d 961, 229 Cal.Rptr. 360, 364 (1986). The right of a well-known professional singer to control the commercial use of a distinctive voice, however, was not an "issue of first impression" in this case. The right had been established clearly by *Midler*. The evidence was unequivocal that, although *Midler* was decided just three months before the conduct at issue, Tracy-Locke personnel responsible for making the Doritos commercial were familiar with the *Midler* decision. Tracy-Locke was concerned *1105 enough that the commercial could result in voice misappropriation liability that it cautioned Frito-Lay of the legal risks in choosing the Carter version. At the same time, however, Tracy-Locke stated its readiness to indemnify Frito-Lay against damages. Frito-Lay, reassured by the indemnification, chose to proceed with the Carter version. In going forward with the commercial, the defendants knowingly took a calculated risk, thereby consciously disregarding the effect of these actions on Waits' legally recognized rights.

The defendants argue, however, that although they may have been aware that legal risks were involved, they had a good faith belief that Waits' rights would not be infringed because they read the legal precedents differently. This argument leaves us unpersuaded. Good faith cannot be manufactured by looking to the law of other jurisdictions to define the rights of California residents. *Midler* could not be more clear that, in California at least, a well-

known singer with a distinctive voice has a property right in that voice. Waits is a California resident, a fact of which Tracy-Locke personnel were aware. The defendants made a conscious decision to broadcast a vocal performance imitating Waits in markets across the country, including San Francisco and Los Angeles. This evidence is sufficient to raise at least a prima facie showing that defendants acted in conscious disregard of rights recognized in California.

[15][16] Even if punitive damages are available, the defendants argue, the award must be vacated because it is not supported by clear and convincing evidence, as required by California law. Cal.Civ.Code § 3294(a). Clear and convincing evidence means evidence sufficient to support a finding of "high probability." Mock v. Michigan Millers Mutual Ins. Co., 4 Cal.App. 4th 306, 5 Cal.Rptr.2d 594, 610 (1992). On appeal, we must determine whether, viewing the evidence in the light most favorable to Waits, any rational jury could have found a high probability that the defendants acted with malice, *i.e.*, despicably and with willful and conscious disregard of Waits' rights. *See Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1013-14 (9th Cir.1985) (evidence supports civil jury verdict if there is "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion"), *cert. denied*, 474 U.S. 1059, 106 S.Ct. 802, 88 L.Ed.2d 778 (1986); *cf. United States v. Juvenile Male*, 864 F.2d 641, 647 (9th Cir.1988) (evidence supports criminal conviction if, viewed in light most favorable to prosecution, any rational jury could find elements of crime beyond a reasonable doubt).

The evidence the jury heard included testimony that Carter, the Waits' impersonator, told Brenner that Waits had a policy against doing commercials and would not like this one. Brenner knew of Waits' policy because he had tried unsuccessfully to hire him for another commercial. In the face of Brenner's warnings that the commercial sounded too much like Waits and presented serious legal concerns, Grossman called a lawyer. Although the lawyer thought the scenario Grossman painted him did not present a colorable legal problem, Grossman had not told the lawyer that the commercial featured a voice that sounded like Waits--only that the "feeling" of the music was the same. Grossman urged Frito-Lay to choose the Carter version over one that did not sound like Waits. Moreover, at the same time Grossman disclosed the legal risk involved with the Carter version, he stated that Tracy-Locke would indemnify Frito-Lay in the event of a lawsuit. The responsible Frito-Lay executive, who was also familiar with Waits and his background, chose to go with the Carter version. The effect of their actions on Waits, according to his testimony, was to tarnish the artistic integrity which he had striven to achieve.

We believe that, viewed most favorably to Waits, this evidence was adequate to support a finding of high probability that Tracy-Locke and Frito-Lay acted with malice. Despicability reflects a moral judgment, "conscious disregard" a state of mind. A rational jury could have found the defendants' conduct despicable because they knowingly impugned Waits' integrity in the public eye. A rational jury also *1106 could have found that the defendants, in

spite of their awareness of Waits' legal right to control the commercial use of his voice, acted in conscious disregard of that right by broadcasting the commercial. We therefore affirm the award of punitive damages.

II. Lanham Act Claim

[17] Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), prohibits the use of false designations of origin, false descriptions, and false representations in the advertising and sale of goods and services. *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir.1981). Waits' claim under section 43(a) is premised on the theory that by using an imitation of his distinctive voice in an admitted parody of a Tom Waits song, the defendants misrepresented his association with and endorsement of SalsaRio Doritos. The jury found in Waits' favor and awarded him \$100,000 in damages. The district court also awarded him attorneys' fees under section 35 of the Lanham Act. On appeal, the defendants argue that Waits lacks standing to bring a Lanham Act claim, that Waits' false endorsement claim fails on its merits, that the damage award is duplicative, and that attorneys' fees are improper. Before we address these contentions, however, we turn to the threshold issue of whether false endorsement claims are properly cognizable under section 43(a) of the Lanham Act, [FN5] a question of first impression in this circuit. [FN6]

[FN5] Although we agree with the defendants that the damage award is duplicative and vacate it, the underlying issues of the cognizability of false endorsement actions, Waits' standing to sue, and the merits of his Lanham Act claim are not moot, inasmuch as the judgment on this

claim also supports an award of attorneys' fees.

[FN6] In *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634, 637 n. 1 (9th Cir.1982), cert. denied, 462 U.S. 1120, 103 S.Ct. 3089, 77 L.Ed.2d 1350 (1983), we expressly declined to decide whether the Lanham Act provides relief for such a claim, and based our decision instead on state unfair competition law.

A. False Endorsement

[18] At the time of the broadcast of the Doritos commercial, section 43(a) provided in pertinent part:

Any person who shall affix, apply, or annex, or use in connection with any goods or services ... a false designation of origin, or any false designation or representation ... shall be liable to a civil action ... by any person who believes that he is or is likely to be damaged by the use of any such false designation or representation.

15 U.S.C. § 1125 note (Amendments) (1988). Courts in other jurisdictions have interpreted this language as authorizing claims for false endorsement. *E.g.*, *Better Business Bureau v. Medical Directors, Inc.*, 681 F.2d 397 (5th Cir.1982); *Jackson v. MPI Home Video*, 694 F.Supp. 483 (N.D.Ill.1988); *Wildlife Internationale, Inc. v. Clements*, 591 F.Supp. 1542 (S.D.Oh.1984); *Geisel v. Poynter Prods., Inc.*, 283 F.Supp. 261, 267 (S.D.N.Y.1968). Moreover, courts have recognized false endorsement claims brought by plaintiffs, including celebrities, for the unauthorized imitation of their distinctive attributes, where those attributes amount to an

unregistered commercial "trademark." See Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 205 (2d Cir.1979) (recognizing claim under § 43(a) because uniform worn by star of X-rated movie was confusingly similar to plaintiffs' trademark uniforms, falsely creating impression that plaintiffs "sponsored or otherwise approved the use" of the uniform); Allen v. Men's World Outlet, Inc., 679 F.Supp. 360, 368 (S.D.N.Y.1988) (celebrity states a claim under § 43(a) by showing that advertisement featuring photograph of a look-alike falsely represented that advertised products were associated with him); Allen v. National Video, Inc., 610 F.Supp. 612, 625-26 (S.D.N.Y.1985) (recognizing celebrity's false endorsement claim under § 43(a) because celebrity has commercial investment in name and face tantamount to interests of a trademark holder in distinctive mark); see also Lahr v. Adell Chemical Co., 300 F.2d 256, 258 (1st Cir.1962) (imitation of unique voice actionable as common law unfair competition); cf. *1107Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711, 716 (9th Cir.1970) (rejecting common law unfair competition claim because plaintiff's voice not sufficiently unique to be protectable), cert. denied, 402 U.S. 906, 91 S.Ct. 1376, 28 L.Ed.2d 646 (1971).

The persuasiveness of this case law as to the cognizability of Waits' Lanham Act claim is reinforced by the 1988 Lanham Act amendments. See Trademark Law Revision Act of 1988, Pub.L. 100-667, § 132, 102 Stat. 3935, 3946. The legislative history states that the amendments to section 43(a) codify previous judicial interpretation given this provision. S.Rep. No. 515, 100th Cong., 2d Sess., at 40, reprinted in 1988

U.S.C.C.A.N. 5577, 5603. Although these amendments did not take effect until November 1989, approximately a year after the broadcast of the defendants' Doritos commercial, as a codification of prior case law and in the absence of controlling precedent to the contrary, they properly inform our interpretation of the previous version of section 43(a). Specifically, we read the amended language to codify case law interpreting section 43(a) to encompass false endorsement claims. Section 43(a) now expressly prohibits, *inter alia*, the use of any symbol or device which is likely to deceive consumers as to the association, sponsorship, or approval of goods or services by another person. [FN7] Moreover, the legislative history of the 1988 amendments also makes clear that in retaining the statute's original terms "symbol or device" in the definition of "trademark," Congress approved the broad judicial interpretation of these terms to include distinctive sounds and physical appearance. See S.Rep. No. 101-515 at 44, 1988 U.S.C.C.A.N. at 5607. In light of persuasive judicial authority and the subsequent congressional approval of that authority, we conclude that false endorsement claims, including those premised on the unauthorized imitation of an entertainer's distinctive voice, are cognizable under section 43(a).

FN7. Section 43(a), as amended in 1988, now reads in pertinent part:

Any person who, on or in connection with any goods or services ... uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation or origin, false or misleading description of fact, or

false or misleading representation of fact, which--

(1) *is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or*

(2) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a) (1988)
(emphasis added).

B. Standing

According to the defendants, however, Waits lacks standing to sue for false endorsement. They assert that because he is not in competition with the defendants, he cannot sue under the Lanham Act. Common sense contradicts this argument, for the purported endorser who is commercially damaged by the false endorsement will rarely if ever be a competitor, and yet is the party best situated to enforce the Lanham Act's prohibition on such conduct. Our circuit precedent, however, throws into question whether such a plaintiff must be a competitor of the defendant's in order to sue under section 43(a).

In Smith v. Montoro, 648 F.2d 602 (9th

Cir.1981), we declined to restrict standing under the Lanham Act to competitors. The plaintiff in *Smith*, an actor who had played a starring role in a movie, sued a film distributor when it replaced his name with another actor's name in the movie's credits and advertising. *Id.* at 603. We characterized the section 43(a) claim there as a "reverse passing off" claim, because the plaintiff's "mark"--his name--had been removed and another's substituted. We analogized this conduct to trademark infringement, because the injury involved was "of the same economic nature." *See id.* at 606-07 (quoting Truck Equipment Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1216 (8th Cir.), *cert. denied*, 429 U.S. 861, 97 S.Ct. 164, 50 L.Ed.2d 139 (1976)). Like trademark infringement, the film distributor's *1108 conduct was "an attempt to misappropriate or profit from [the plaintiff's] talents and workmanship." *Id.* at 607 (citations omitted).

To have standing under the Lanham Act, we declared, "the plaintiff need not be in actual competition with the alleged wrongdoer." Smith, 648 F.2d at 607. Rather, the "dispositive question" in determining standing is whether the plaintiff "has a reasonable interest to be protected against false advertising." *Id.* at 608 (quoting 1 R. Callman, *Unfair Competition, Trademarks and Monopolies*, § 18.2(b), at 625 (3d ed. 1967) and citing New West Corp. v. NYM Co. of Calif., Inc., 595 F.2d 1194, 1198 (9th Cir.1979)). We concluded that, like a trademark holder, an actor has a "reasonable interest" in having his work product properly identified with his name, and therefore the plaintiff had standing under section 43(a). *See id.*

On the other hand, in *Halicki v. United Artists Communications, Inc.*, 812 F.2d 1213 (9th Cir.1987), we dismissed the plaintiff's claim because he had failed to show competitive injury. The plaintiff, a movie producer, had entered into a contract with a film distributor under which the plaintiff's movie would be advertised with a "PG" rating. Instead, it was advertised with an "R" rating, thus curtailing its market among young audiences. *Id.* at 1213. The gravamen of the complaint was that the defendant had misrepresented the film's content in advertising it. We rejected the plaintiff's contention that to state a claim under the Lanham Act, all he need do was "show that the defendants made a false representation about his film and that he was injured by the representation." *Id.* at 1214.

Rather, the plaintiff must also show that type of injury sustained is one the Lanham Act is intended to prevent.

We noted that an express purpose of the Lanham Act is to protect commercial parties against unfair competition. *Id.* Thus, we held that "[t]o be actionable, [the defendant's] conduct must not only be unfair but must in some discernible way be competitive." *Id.* The misrepresentation as to the film's rating, we concluded, while possibly actionable as breach of contract, was not actionable under the Lanham Act inasmuch as the plaintiff had not been injured by a competitor. *Id.* at 1214-15. This result, we stated, accords with congressional intent, for if such a limitation were not in place the Lanham Act would become a "federal statute creating the tort of misrepresentation." *Id.* at 1214.

To interpret *Halicki* as suggested by the defendants, for the broad proposition that only competitors have standing under

section 43(a) regardless of the type of claim asserted, would create an impermissible conflict with *Smith*, where we held that actual competition is unnecessary. *See Smith*, 648 F.2d at 607-08. Where circuit precedent appears in conflict, we must attempt to reconcile it; if we cannot do so consideration en banc is appropriate. *See Atonio v. Wards Cove Packing Co.*, 810 F.2d 1477, 1478-79 (9th Cir.1987) (en banc). We find that *Smith* and *Halicki* may be reconciled, and we begin with the basic principle both embody: that standing under section 43(a) exists where the interest asserted by the plaintiff is a commercial interest protected by the Lanham Act.

Its drafters wrote the purposes of the Lanham Act, two of which are relevant here, into the statute itself: to make "actionable the deceptive and misleading use of marks in ... commerce" and "to protect persons engaged in ... commerce against unfair competition." 15 U.S.C. § 1127 (1988). Section 43(a) reflects both of these purposes, providing two bases of liability: (1) false representations concerning the origin, association, or endorsement of goods or services through the wrongful use of another's distinctive mark, name, trade dress, or other device ("false association"), and (2) false representations in advertising concerning the qualities of goods or services ("false advertising"). *See, e.g., 2 J. Thomas McCarthy, Trademarks and Unfair Competition* §§ 27:2-27:4, at 344-68 (2d ed. 1984) (discussing two prongs of section 43(a)); *U-Haul Int'l, Inc. v. Jartran, Inc.*, 681 F.2d 1159, 1160 (9th Cir.1982) (discussing trademark infringement and false comparative advertising as two distinct causes of action under § 43(a));

*1109 Spring Mills, Inc. v. Ultracashmere House, Ltd., 532 F.Supp. 1203, 1220 (S.D.N.Y.) (discussing false association and false advertising), *rev'd on other grounds*, 689 F.2d 1127 (2d Cir.1982). *Halicki* and *Smith* are distinguishable, because they involve different prongs of section 43(a) liability and implicate distinct interests. Cf. Halicki, 812 F.2d at 1214 (distinguishing *Smith* on the basis of type of claim asserted).

[19] We have recognized that simple claims of false representations in advertising are actionable under section 43(a) when brought by competitors of the wrongdoer, even though they do not involve misuse of a trademark. See U-Haul, 681 F.2d at 1160-61. The plaintiff's claim in *Halicki* was exclusively such a "false advertising" claim, for it sought redress for a simple misrepresentation as to a product's quality, the content of a movie. [FN8] We were at pains to point out that the plaintiff's injury was not related to the Lanham Act's purpose of preventing the "deceptive and misleading use of marks," 15 U.S.C. § 1127, declaring that the statute's purposes with regard to the use of trademarks were irrelevant to his claim. See Halicki, 812 F.2d at 1214. Rather, where the misrepresentation simply concerns a product's qualities, it is actionable under section 43(a) only insofar the Lanham Act's other purpose of preventing "unfair competition" is served. See U-Haul, 681 F.2d at 1162 (noting congressional intent to allow false advertising suits by competitors "to stop the kind of unfair competition that consists of lying about goods or services"). In such cases, *Halicki* counsels that a discernibly competitive injury must be alleged. We take an example close to *Halicki*'s facts,

assuming for purposes of this hypothetical only that producers may rate their own films. If a film's distributor wrongfully indicates that a film is "PG"-rated when in reality it should be "R"-rated, a competitor with a PG-rated film would have standing: the misrated film theoretically draws young audiences away from the competitor's film because of the misrepresentation concerning the suitability of its content. In *Halicki*, however, the plaintiff lacked a discernibly competitive interest: he and the distributor were not independent actors in the marketplace, but rather had a contractual relationship in which the distributor agreed to act in the marketplace on the plaintiff's behalf. The interests asserted, therefore, were solely contractual and not within the zone of interests protected by the Lanham Act.

[FN8] Although *Halicki* in passing characterizes the plaintiff's claim as one for "false designation" it does not use this term as a term of art to indicate the misuse of a trademark which falsely designates the film's origin or the association of the trademark's owner with the film. Instead, the term is used in its generic sense to refer to the use of a rating designation which falsely represents the film's content.

[20][21][22] The plaintiff's claim in *Smith*, on the other hand, was a type of false association claim stemming from the misuse of a mark, for it alleged the wrongful removal of the plaintiff's name and the wrongful substitution of another's name. *Smith* teaches that where such a claim is presented, the plaintiff need not be a competitor, for the Lanham Act also grants a

cause of action to certain noncompetitors who have been injured commercially by the "deceptive and misleading use of marks." See 15 U.S.C. § 1127; see also Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 467 F.Supp. 366, 374 (S.D.N.Y.1979) (owner of a mark has right to exploit mark commercially by having consumers associate mark only with owner's goods or services, regardless of whether misappropriator deals in competing or noncompeting goods or services). Those with standing to bring such a claim include parties with a commercial interest in the product wrongfully identified with another's mark, as in *Smith*, or with a commercial interest in the misused mark. [FN9] See *1110 Dovenmuehle v. Gilldorn Mortgage Midwest Corp., 871 F.2d 697, 700-01 (7th Cir.1989) (only those with present commercial interest in trade name have standing to sue for its wrongful use under § 43(a)); Berni Int'l Gourmet Restaurants of America, Inc., 838 F.2d 642, 648 (2d Cir.1988) (plaintiff must have commercial or ownership interest in mark to have standing under § 43(a)); cf. Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co., 316 U.S. 203, 205, 62 S.Ct. 1022, 1024, 86 L.Ed. 1381 (1942) ("If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.").

[FN9] We do not mean to imply that competition between the parties is irrelevant, for it is one factor examined by courts in analyzing the merits of a false association claim. A false association claim requires that the misuse of a trademark or other distinguishing device confuse consumers as to the origin, approval,

or endorsement of the product. See International Order of Job's Daughters v. Lindeburg & Co., 633 F.2d 912, 919-20 (9th Cir.1980) (limiting infringement claims under section 43(a) to those where use of trademark leads to confusion over endorsement or sponsorship), cert. denied, 452 U.S. 941, 101 S.Ct. 3086, 69 L.Ed.2d 956 (1981). Consumer confusion may be demonstrated by the use of similar or identical trademarks on competing goods, but may also be established in other ways. See Lindy Pen Co. v. Bic Pen Corp., 796 F.2d 254, 255 (9th Cir.1986) (competition between parties not automatically required to prevail on trademark infringement claim, but is one factor in determining likelihood of consumer confusion). Our conclusion that competition is unnecessary relates only to the determination of standing under section 43(a); analysis of the merits of such a claim is a separate inquiry. See *infra*, section II.C.

[23] A false endorsement claim based on the unauthorized use of a celebrity's identity is a type of false association claim, for it alleges the misuse of a trademark, *i.e.*, a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product. Standing, therefore, does not require "actual competition" in the traditional sense; it extends to a purported endorser who has an economic interest akin to that of a trademark holder in controlling the commercial exploitation of his or her identity. See Allen

v. National Video, 610 F.Supp. at 625, 628 (celebrity's interest in the marketing value of his identity is similar to that of a trademark holder, and its misuse through evocation of celebrity's persona that creates likelihood of consumer confusion as to celebrity's endorsement is actionable under Lanham Act). Moreover, the wrongful appropriator is in a sense a competitor of the celebrity, even when the celebrity has chosen to disassociate himself or herself from advertising products as has Waits. They compete with respect to the use of the celebrity's name or identity. They are both utilizing or marketing that personal property for commercial purposes. Accordingly, we hold that a celebrity whose endorsement of a product is implied through the imitation of a distinctive attribute of the celebrity's identity, has standing to sue for false endorsement under section 43(a) of the Lanham Act. [FN10] Tom Waits, therefore, need not be a competitor in the traditional sense to sue under the Lanham Act for the imitation of his voice on the theory that its use falsely associated him with Doritos as an endorser. Rather, his standing was sufficiently established by the likelihood that the wrongful use of his professional trademark, his unique voice, would injure him commercially.

[FN10]. In reaching this conclusion, we are mindful that *Midler*, on facts similar to those involved here, disapproved the plaintiff's unfair competition claim because she "did not do television commercials. The defendants were not in competition with her." *Midler*, 849 F.2d 460, 462-63. *Midler*, however, did not involve a Lanham Act claim, but rather a common law unfair

competition claim. Nor were we called upon there to examine standing in the specific context of a false endorsement claim, for *Midler* had not grounded her unfair competition claim on such a theory. Notably, *Midler* had sought in the district court to amend her complaint to include a claim under section 43(a) of the Lanham Act on a theory of false endorsement. The district court denied her request, not because she lacked standing as the defendants there had argued, but because her delay in seeking to amend was prejudicial. See *Midler v. Ford Motor Co.*, No. 86-2683 (C.D.Cal.), Record at 7, 43, 48. Our statement in *Midler*, therefore, is dicta as it relates to Lanham Act standing and is not controlling here.

C. Merits

The defendants next argue that Waits' false endorsement claim must fail on its merits because the Doritos commercial "did not represent that ... [Waits] sponsored or endorsed their product." We disagree. The court correctly instructed the jury that *1111 in considering Waits' Lanham Act claim, it must determine whether "ordinary consumers ... would be confused as to whether Tom Waits sang on the commercial ... and whether he sponsors or endorses SalsaRio Doritos." The jury was told that in making this determination, it should consider the totality of the evidence, including the distinctiveness of Waits' voice and style, the evidence of actual confusion as to whether Waits actually sang on the commercial, and the defendants' intent to imitate Waits' voice. See generally, *Clamp*

Mfg. Co. v. Enco Mfg. Co., 870 F.2d 512, 517 (9th Cir.) (discussing factors to be considered in determining likelihood of confusion, including strength of mark, similarity of marks, evidence of actual confusion, marketing channels used, and intent in selecting marks), *cert. denied*, 493 U.S. 872, 110 S.Ct. 202, 107 L.Ed.2d 155 (1989).

[24] At trial, the jury listened to numerous Tom Waits recordings, and to a recording of the Doritos commercial in which the Tom Waits impersonator delivered this "hip" endorsement of SalsaRio Doritos: "It's buffo, boffo, bravo, gung-ho, tally-ho, but never mellow.... try' em, buy 'em, get 'em, got 'em." The jury also heard evidence, relevant to the likelihood of consumer confusion, that the Doritos commercial was targeted to an audience which overlapped with Waits' audience, males between the ages of 18 to 35 who listened to the radio. Finally, there was evidence of actual consumer confusion: the testimony of numerous witnesses that they actually believed it was Tom Waits singing the words of endorsement.

This evidence was sufficient to support the jury's finding that consumers were likely to be misled by the commercial into believing that Waits endorsed SalsaRio Doritos. See Allen v. Men's World Outlet, 679 F.Supp. at 368-69 (likelihood of consumer confusion established where advertiser intentionally used a look-alike of well-known celebrity and where audience to whom commercial was directed intersected with celebrity's audience); Allen v. National Video, 610 F.Supp. at 626-27 & n. 8 (use of celebrity look-alike in pose of product spokesperson sufficient to indicate endorsement). The

jury's verdict on Waits' Lanham Act claim must therefore stand.

D. Damages

The defendants urge us to vacate the damage award on Waits' Lanham Act claim as duplicative of those damages awarded for voice misappropriation representing the fair market value of Waits' services. Waits does not contest this point. Standing by the representations he made to the jury at trial that he was not seeking a double recovery, he asserts on appeal that he "does not oppose a reduction of the final judgment in the amount of \$100,000 based on the overlapping Lanham Act award."

In instructing the jury on Waits' Lanham Act claim, the court stated that it could award damages for the fair market value of Waits' services. The jury awarded Waits \$100,000 on this claim. It also awarded Waits \$100,000 for the fair market value of his services on his voice misappropriation claim. The damages awarded under the Lanham Act, therefore, are duplicative. Accordingly, we vacate this portion of the judgment.

E. Attorneys' Fees

[25][26] Section 35 of the Lanham Act authorizes attorneys' fee awards for prevailing plaintiffs in "exceptional cases." 15 U.S.C. § 1117. Exceptional cases include those in which the defendants' conduct is "malicious, fraudulent, deliberate, or wilful." Sealy, Inc. v. Easy Living, Inc., 743 F.2d 1378, 1384 (9th Cir.1984) (citing S.Rep. No. 1400, 93rd Cong., 2d Sess. (1974), *reprinted in* 1974 U.S.C.C.A.N. 7132); see Transgo, 768 F.2d at 1026. We review attorneys' fee

awards under the Lanham Act for abuse of discretion. Transgo, 768 F.2d at 1026.

[27] In awarding punitive damages on Waits' voice misappropriation claim, the jury specifically found that the defendants had acted with oppression, fraud, or malice. That finding qualifies this case as an exceptional one within the meaning of section 35. The district court was therefore within its *1112 discretion in awarding Waits reasonable attorneys' fees.

CONCLUSION

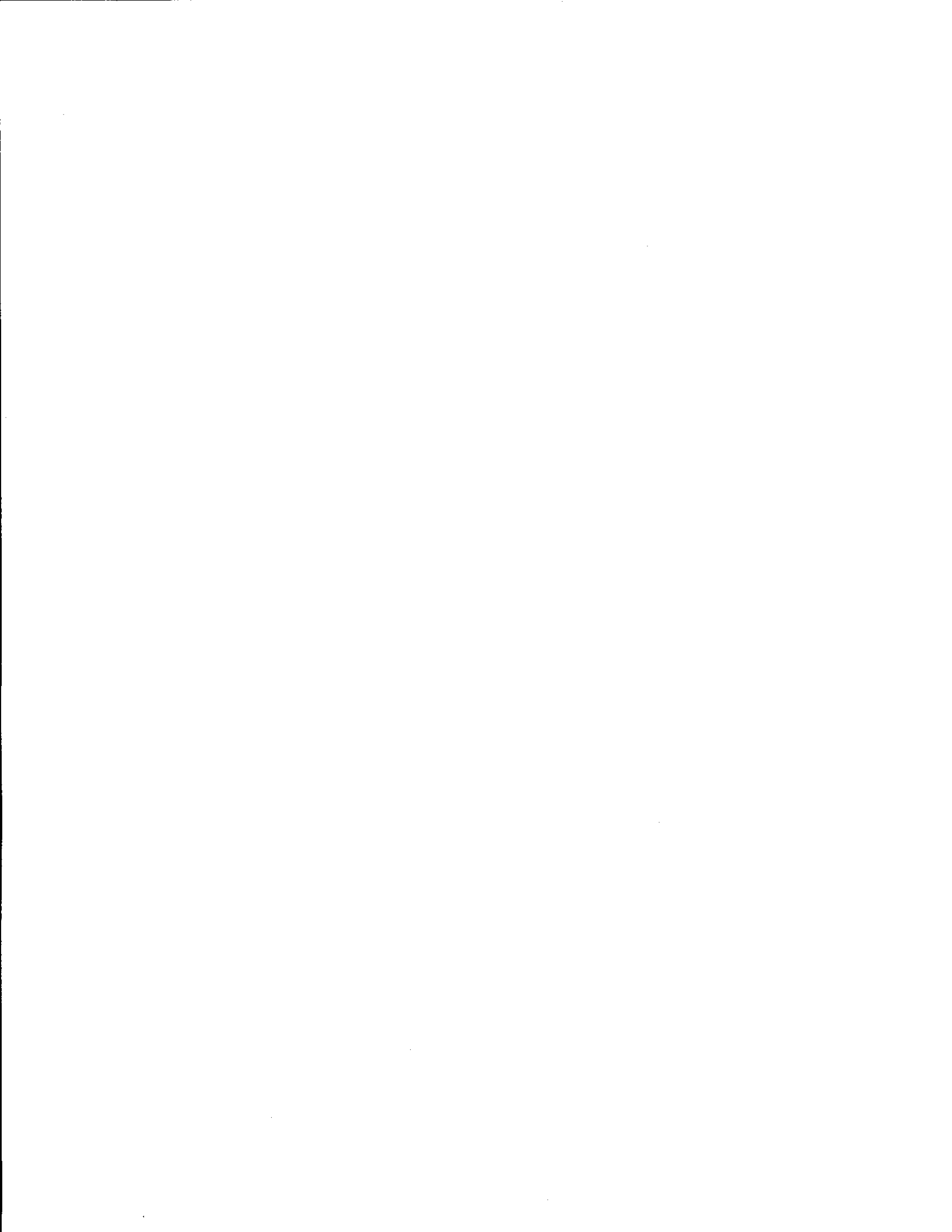
Waits' voice misappropriation claim and his Lanham Act claim are legally sufficient. The court did not err in instructing the jury on elements of voice misappropriation. The jury's verdict on each claim is supported by substantial evidence, as are its damage awards. Its award of damages on Waits' Lanham Act claim, however, is duplicative of damages awarded for voice misappropriation; accordingly we vacate it. Finally, the court did not abuse its discretion in awarding attorneys' fees under the Lanham Act.

Waits is awarded his costs on appeal.

AFFIRMED in part and VACATED in part.

978 F.2d 1093, 1992 Copr.L.Dec. P 26,950

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United States Court of Appeals,
Ninth Circuit.
Vanna WHITE, Plaintiff-Appellant,
v.
SAMSUNG ELECTRONICS AMERICA, INC.;
David Deutsch Associates, Defendants-Appellees.
No. 90-55840.

March 18, 1993.

Prior report: 971 F.2d 1395.

Before GOODWIN, PREGERSON and ALARCON,
Circuit Judges.

The panel has voted unanimously to deny the petition for rehearing. Circuit Judge Pregerson has voted to reject the suggestion for rehearing en banc, and Circuit Judge Goodwin so recommends. Circuit Judge Alarcon has voted to accept the suggestion for rehearing en banc.

The full court has been advised of the suggestion for rehearing en banc. An active judge requested a vote on whether to rehear the matter en banc. The matter failed to receive a majority of the votes of the nonrecused active judges in favor of en banc consideration. Fed.R.App.P. 35.

The petition for rehearing is DENIED and the suggestion for rehearing en banc is REJECTED.

KOZINSKI, Circuit Judge, with whom Circuit Judges O'SCANNLAIN and KLEINFELD join, dissenting from the order rejecting the suggestion for rehearing en banc.

I

Saddam Hussein wants to keep advertisers from using his picture in unflattering contexts.^{FN1} Clint Eastwood doesn't want tabloids to write about him.^{FN2} Rudolf Valentino's heirs want to control his film biography.^{FN3} The Girl Scouts don't want their image soiled by association with certain activities.^{FN4}

George Lucas wants to keep Strategic Defense Initiative fans from calling it "Star Wars."^{FN5} Pepsico doesn't want singers to use the word "Pepsi" in their songs.^{FN6} Guy Lombardo wants an exclusive *1513 property right to ads that show big bands playing on New Year's Eve.^{FN7} Uri Geller thinks he should be paid for ads showing psychics bending metal through telekinesis.^{FN8} Paul Prudhomme, that household name, thinks the same about ads featuring corpulent bearded chefs.^{FN9} And scads of copyright holders see purple when their creations are made fun of.^{FN10}

FN1. See Eben Shapiro, Rising Caution on Using Celebrity Images, N.Y. Times, Nov. 4, 1992, at D20 (Iraqi diplomat objects on right of publicity grounds to ad containing Hussein's picture and caption "History has shown what happens when one source controls all the information").

FN2. Eastwood v. Superior Court, 149 Cal.App.3d 409, 198 Cal.Rptr. 342 (1983).

FN3. Guglielmi v. Spelling-Goldberg Prods., 25 Cal.3d 860, 160 Cal.Rptr. 352, 603 P.2d 454 (1979) (Rudolph Valentino); see also Maheu v. CBS, Inc., 201 Cal.App.3d 662, 668, 247 Cal.Rptr. 304 (1988) (aide to Howard Hughes). Cf. Frank Gannon, *Vanna Karenina*, in *Vanna Karenina and Other Reflections* (1988) (A humorous short story with a tragic ending. "She thought of the first day she had met VR SKY. How foolish she had been. How could she love a man who wouldn't even tell her all the letters in his name?").

FN4. Girl Scouts v. Personality Posters Mfg., 304 F.Supp. 1228 (S.D.N.Y.1969) (poster of a pregnant girl in a Girl Scout uniform with the caption "Be Prepared").

FN5. Lucasfilm Ltd. v. High Frontier, 622 F.Supp. 931 (D.D.C.1985).

FN6. Pepsico Inc. claimed the lyrics and packaging of grunge rocker Tad Doyle's

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"Jack Pepsi" song were "offensive to [it] and [...] likely to offend [its] customers," in part because they "associate [Pepsico] and its Pepsi marks with intoxication and drunk driving." Deborah Russell, *Doyle Leaves Pepsi Thirsty for Compensation*, *Billboard*, June 15, 1991, at 43. Conversely, the Hell's Angels recently sued Marvel Comics to keep it from publishing a comic book called "Hell's Angel," starring a character of the same name. Marvel settled by paying \$35,000 to charity and promising never to use the name "Hell's Angel" again in connection with any of its publications. *Marvel, Hell's Angels Settle Trademark Suit*, *L.A. Daily J.*, Feb. 2, 1993, § II, at 1.

Trademarks are often reflected in the mirror of our popular culture. See Truman Capote, *Breakfast at Tiffany's* (1958); Kurt Vonnegut, Jr., *Breakfast of Champions* (1973); Tom Wolfe, *The Electric Kool-Aid Acid Test* (1968) (which, incidentally, includes a chapter on the Hell's Angels); Larry Niven, *Man of Steel, Woman of Kleenex*, in *All the Myriad Ways* (1971); *Looking for Mr. Goodbar* (1977); *The Coca-Cola Kid* (1985) (using Coca-Cola as a metaphor for American commercialism); *The Kentucky Fried Movie* (1977); *Harley Davidson and the Marlboro Man* (1991); *The Wonder Years* (ABC 1988-present) ("Wonder Years" was a slogan of Wonder Bread); Tim Rice & Andrew Lloyd Webber, *Joseph and the Amazing Technicolor Dream Coat* (musical).

Hear Janis Joplin, *Mercedes Benz*, on *Pearl* (CBS 1971); Paul Simon, *Kodachrome*, on *There Goes Rhymin' Simon* (Warner 1973); Leonard Cohen, *Chelsea Hotel*, on *The Best of Leonard Cohen* (CBS 1975); Bruce Springsteen, *Cadillac Ranch*, on *The River* (CBS 1980); Prince, *Little Red Corvette*, on *1999* (Warner 1982); dada, *Dizz Knee Land*, on *Puzzle* (IRS 1992) ("I just robbed a grocery store-I'm going to Disneyland / I just flipped off President George-I'm going to Disneyland"); Monty Python, *Spam*, on *The Fi-*

nal Rip Off (Virgin 1988); Roy Clark, *Thank God and Greyhound [You're Gone]*, on *Roy Clark's Greatest Hits Volume I* (MCA 1979); Mel Tillis, *Coca-Cola Cowboy*, on *The Very Best of* (MCA 1981) ("You're just a Coca-Cola cowboy / You've got an Eastwood smile and Robert Redford hair ...").

Dance to Talking Heads, Popular Favorites 1976-92: Sand in the Vaseline (Sire 1992); Talking Heads, *Popsicle*, on *id. Admire Andy Warhol, Campbell's Soup Can*. Cf. REO Speedwagon, 38 *Special*, and Jello Biafra of the Dead Kennedys.

The creators of some of these works might have gotten permission from the trademark owners, though it's unlikely Kool-Aid relished being connected with LSD, Hershey with homicidal maniacs, Disney with armed robbers, or Coca-Cola with cultural imperialism. Certainly no free society can demand that artists get such permission.

FN7. *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (1977).

FN8. *Geller v. Fallon McElligott*, No. 90-Civ-2839 (S.D.N.Y. July 22, 1991) (involving a Timex ad).

FN9. *Prudhomme v. Procter & Gamble Co.*, 800 F.Supp. 390 (E.D.La.1992).

FN10. E.g., *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429 (6th Cir.1992); *Cliffs Notes v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir.1989); *Fisher v. Dees*, 794 F.2d 432 (9th Cir.1986); *MCA, Inc. v. Wilson*, 677 F.2d 180 (2d Cir.1981); *Elsmere Music, Inc. v. NBC*, 623 F.2d 252 (2d Cir.1980); *Walt Disney Prods. v. The Air Pirates*, 581 F.2d 751 (9th Cir.1978); *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541 (2d Cir.1964); *Lowenfels v. Nathan*, 2 F.Supp. 73 (S.D.N.Y.1932).

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Something very dangerous is going on here. Private property, including intellectual property, is essential to our way of life. It provides an incentive for investment and innovation; it stimulates the flourishing of our culture; it protects the moral entitlements of people to the fruits of their labors. But reducing too much to private property can be bad medicine. Private land, for instance, is far more useful if separated from other private land by public streets, roads and highways. Public parks, utility rights-of-way and sewers reduce the amount of land in private hands, but vastly enhance the value of the property that remains.

So too it is with intellectual property. Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture.^{FN11}

FN11. See Wendy J. Gordon, *A Property Right in Self Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 Yale L.J. 1533, 1556-57 (1993).

*1514 The panel's opinion is a classic case of overprotection. Concerned about what it sees as a wrong done to Vanna White, the panel majority erects a property right of remarkable and dangerous breadth: Under the majority's opinion, it's now a tort for advertisers to *remind* the public of a celebrity. Not to use a celebrity's name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity's image in the public's mind. This Orwellian notion withdraws far more from the public domain than prudence and common sense allow. It conflicts with the Copyright Act and the Copyright Clause. It raises serious First Amendment problems. It's bad law, and it deserves a long, hard second look.

II

Samsung ran an ad campaign promoting its consumer electronics. Each ad depicted a Samsung product and

a humorous prediction: One showed a raw steak with the caption "Revealed to be health food. 2010 A.D." Another showed Morton Downey, Jr. in front of an American flag with the caption "Presidential candidate. 2008 A.D."^{FN12} The ads were meant to convey—humorously—that Samsung products would still be in use twenty years from now.

FN12. I had never heard of Morton Downey, Jr., but I'm told he's sort of like Rush Limbaugh, but not as shy.

The ad that spawned this litigation starred a robot dressed in a wig, gown and jewelry reminiscent of Vanna White's hair and dress; the robot was posed next to a Wheel-of-Fortune-like game board. *See* Appendix. The caption read "Longest-running game show. 2012 A.D." The gag here, I take it, was that Samsung would still be around when White had been replaced by a robot.

Perhaps failing to see the humor, White sued, alleging Samsung infringed her right of publicity by "appropriating" her "identity." Under California law, White has the exclusive right to use her name, likeness, signature and voice for commercial purposes. Cal.Civ.Code § 3344(a); *Eastwood v. Superior Court*, 149 Cal.App.3d 409, 417, 198 Cal.Rptr. 342, 347 (1983). But Samsung didn't use her name, voice or signature, and it certainly didn't use her likeness. The ad just wouldn't have been funny had it depicted White or someone who resembled her—the whole joke was that the game show host(ess) was a robot, not a real person. No one seeing the ad could have thought this was supposed to be White in 2012.

The district judge quite reasonably held that, because Samsung didn't use White's name, likeness, voice or signature, it didn't violate her right of publicity. 971 F.2d at 1396-97. Not so, says the panel majority: The California right of publicity can't possibly be limited to name and likeness. If it were, the majority reasons, a "clever advertising strategist" could avoid using White's name or likeness but nevertheless remind people of her with impunity, "effectively eviscerat[ing]" her rights. To prevent this "evisceration," the panel majority holds that the right of publicity must extend beyond name and likeness, to any "appropriation" of White's "identity"—anything that "evoke[s]" her personality. *Id.* at 1398-99.

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III

But what does “evisceration” mean in intellectual property law? Intellectual property rights aren't like some constitutional rights, absolute guarantees protected against all kinds of interference, subtle as well as blatant.^{FN13} They cast no penumbras, emit no emanations: The very point of intellectual property laws is that they protect only against certain specific kinds of appropriation. I can't publish unauthorized copies of, say, *Presumed Innocent*; I can't make a movie out of it. But I'm *1515 perfectly free to write a book about an idealistic young prosecutor on trial for a crime he didn't commit.^{FN14} So what if I got the idea from *Presumed Innocent*? So what if it reminds readers of the original? Have I “eviscerated” Scott Turow's intellectual property rights? Certainly not. All creators draw in part on the work of those who came before, referring to it, building on it, poking fun at it; we call this creativity, not piracy.^{FN15}

FN13. Cf., e.g., *Guinn v. United States*, 238 U.S. 347, 364-65, 35 S.Ct. 926, 931, 59 L.Ed. 1340 (1915) (striking down grandfather clause that was a clear attempt to evade the Fifteenth Amendment).

FN14. It would be called “Burden of Going Forward with the Evidence,” and the hero would ultimately be saved by his lawyer's adept use of Fed.R.Evid. 301.

FN15. In the words of Sir Isaac Newton, “[i]f I have seen further it is by standing on [the shoulders] of Giants.” Letter to Robert Hooke, Feb. 5, 1675/1676.

Newton himself may have borrowed this phrase from Bernard of Chartres, who said something similar in the early twelfth century. Bernard in turn may have snatched it from Priscian, a sixth century grammarian. See *Lotus Dev. Corp. v. Paperback Software Int'l*, 740 F.Supp. 37, 77 n. 3 (D.Mass.1990).

The majority isn't, in fact, preventing the “evisceration” of Vanna White's existing rights; it's creating a new and much broader property right, a right unknown in California law.^{FN16} It's replacing the existing balance between the interests of the celebrity and

those of the public by a different balance, one substantially more favorable to the celebrity. Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to *anything that reminds the viewer of her*. After all, that's all Samsung did: It used an inanimate object to remind people of White, to “evoke [her identity].” 971 F.2d at 1399.^{FN17}

FN16. In fact, in the one California case raising the issue, the three state Supreme Court Justices who discussed this theory expressed serious doubts about it. *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal.3d 860, 864 n. 5, 160 Cal.Rptr. 352, 355 n. 5, 603 P.2d 454, 457 n. 5 (1979) (Bird, C.J., concurring) (expressing skepticism about finding a property right to a celebrity's “personality” because it is “difficult to discern any easily applied definition for this amorphous term”).

Neither have we previously interpreted California law to cover pure “identity.” *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir.1988), and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir.1992), dealt with appropriation of a celebrity's voice. See *id.* at 1100-01 (imitation of singing style, rather than voice, doesn't violate the right of publicity).

Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir.1974), stressed that, though the plaintiff's likeness wasn't directly recognizable by itself, the surrounding circumstances would have made viewers think the likeness was the plaintiff's. *Id.* at 827; see also *Moore v. Regents of the Univ. of Cal.*, 51 Cal.3d 120, 138, 271 Cal.Rptr. 146, 157, 793 P.2d 479, 490 (1990) (construing *Motschenbacher* as “hold [ing] that every person has a proprietary interest in his own likeness”).

FN17. Some viewers might have inferred White was endorsing the product, but that's a different story. The right of publicity isn't aimed at or limited to false endorsements, *Eastwood v. Superior Court*, 149

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Cal.App.3d 409, 419-20, 198 Cal.Rptr. 342, 348 (1983); that's what the Lanham Act is for.

Note also that the majority's rule applies even to advertisements that unintentionally remind people of someone. California law is crystal clear that the common-law right of publicity may be violated even by unintentional appropriations. *Id.* at 417 n. 6, 198 Cal.Rptr. at 346 n. 6; *Fairfield v. American Photocopy Equipment Co.*, 138 Cal.App.2d 82, 87, 291 P.2d 194 (1955).

Consider how sweeping this new right is. What is it about the ad that makes people think of White? It's not the robot's wig, clothes or jewelry; there must be ten million blond women (many of them quasi-famous) who wear dresses and jewelry like White's. It's that the robot is posed near the "Wheel of Fortune" game board. Remove the game board from the ad, and no one would think of Vanna White. See Appendix. But once you include the game board, anybody standing beside it—a brunette woman, a man wearing women's clothes, a monkey in a wig and gown—would evoke White's image, precisely the way the robot did. It's the "Wheel of Fortune" set, not the robot's face or dress or jewelry that evokes White's image. The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living.^{FN18}

^{FN18}. Once the right of publicity is extended beyond specific physical characteristics, this will become a recurring problem: Outside name, likeness and voice, the things that most reliably remind the public of celebrities are the actions or roles they're famous for. A commercial with an astronaut setting foot on the moon would evoke the image of Neil Armstrong. Any masked man on horseback would remind people (over a certain age) of Clayton Moore. And any number of songs—"My Way," "Yellow Submarine," "Like a Virgin," "Beat It," "Michael, Row the Boat Ashore," to name only a few—would instantly evoke an image of the person or group who made them famous, regardless of who is singing.

See also Carlos V. Lozano, *West Loses*

Lawsuit over Batman TV Commercial, L.A. Times, Jan. 18, 1990, at B3 (Adam West sues over Batman-like character in commercial); *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775, 1989 WL 407484 (C.D.Cal.1989) (1950s TV movie hostess "Vampira" sues 1980s TV hostess "Elvira"); text accompanying notes 7-8 (lawsuits brought by Guy Lombardo, claiming big bands playing at New Year's Eve parties remind people of him, and by Uri Geller, claiming psychics who can bend metal remind people of him). Cf. *Motschenbacher*, where the claim was that viewers would think plaintiff was actually in the commercial, and not merely that the commercial reminded people of him.

*1516 This is entirely the wrong place to strike the balance. Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large. Where would we be if Charles Lindbergh had an exclusive right in the concept of a heroic solo aviator? If Arthur Conan Doyle had gotten a copyright in the idea of the detective story, or Albert Einstein had patented the theory of relativity? If every author and celebrity had been given the right to keep people from mocking them or their work? Surely this would have made the world poorer, not richer, culturally as well as economically.^{FN19}

^{FN19}. See generally Gordon, *supra* note 11; see also Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 Cal.L.Rev. 125, 201-03 (1993) (an excellent discussion).

This is why intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us: The relatively short life of patents; the longer, but finite, life of copyrights; copyright's idea-expression dichotomy; the fair use doctrine; the prohibition on copyrighting facts; the compulsory license of television broadcasts and musical compositions; federal preemption of overbroad state intellectual property laws; the nominative use doctrine in trademark law; the right to make soundalike recordings.^{FN20} All of these diminish an intellectual property owner's rights. All let the public use something created by someone else.

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But all are necessary to maintain a free environment in which creative genius can flourish.

FN20. See 35 U.S.C. § 154 (duration of patent); 17 U.S.C. §§ 302-305 (duration of copyright); 17 U.S.C. § 102(b) (idea-expression dichotomy); 17 U.S.C. § 107 (fair use); *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, ----, 111 S.Ct. 1282, 1288, 113 L.Ed.2d 358 (1991) (no copyrighting facts); 17 U.S.C. §§ 115, 119(b) (compulsory licenses); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989) (federal preemption); *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 306-308 (9th Cir.1992) (nominative use); 17 U.S.C. § 114(b) (soundalikes); accord *G.S. Rasmussen & Assocs. v. Kalitta Flying Serv., Inc.*, 958 F.2d 896, 900 n. 7 (9th Cir.1992); Daniel A. Saunders, Comment, *Copyright Law's Broken Rear Window*, 80 Cal.L.Rev. 179, 204-05 (1992). But see *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir.1988).

The intellectual property right created by the panel here has none of these essential limitations: No fair use exception; no right to parody; no idea-expression dichotomy. It impoverishes the public domain, to the detriment of future creators and the public at large. Instead of well-defined, limited characteristics such as name, likeness or voice, advertisers will now have to cope with vague claims of "appropriation of identity," claims often made by people with a wholly exaggerated sense of their own fame and significance. See pp. 1512-13 & notes 1-10 *supra*. Future Vanna Whites might not get the chance to create their personae, because their employers may fear some celebrity will claim the persona is too similar to her own.^{FN21} The public will be robbed of parodies of celebrities, and *1517 our culture will be deprived of the valuable safety valve that parody and mockery create.

FN21. If Christian Slater, star of "Heathers," "Pump up the Volume," "Kuffs," and "Untamed Heart"-and alleged Jack Nicholson clone-appears in a commercial, can Nicholson sue? Of 54 stories on LEXIS that talk about Christian Slater, 26 talk about Slater's alleged similarities to Nicholson. Apparently

it's his nasal wisecracks and killer smiles, St. Petersburg Times, Jan. 10, 1992, at 13, his eyebrows, Ottawa Citizen, Jan. 10, 1992, at E2, his sneers, Boston Globe, July 26, 1991, at 37, his menacing presence, USA Today, June 26, 1991, at 1D, and his sing-song voice, Gannett News Service, Aug. 27, 1990 (or, some say, his insinuating drawl, L.A. Times, Aug. 22, 1990, at F5). That's a whole lot more than White and the robot had in common.

Moreover, consider the moral dimension, about which the panel majority seems to have gotten so exercised. Saying Samsung "appropriated" something of White's begs the question: *Should* White have the exclusive right to something as broad and amorphous as her "identity"? Samsung's ad didn't simply copy White's schtick-like all parody, it created something new.^{FN22} True, Samsung did it to make money, but White does whatever she does to make money, too; the majority talks of "the difference between fun and profit," 971 F.2d at 1401, but in the entertainment industry fun *is* profit. Why is Vanna White's right to exclusive for-profit use of her persona-a persona that might not even be her own creation, but that of a writer, director or producer-superior to Samsung's right to profit by creating its own inventions? Why should she have such absolute rights to control the conduct of others, unlimited by the idea-expression dichotomy or by the fair use doctrine?

FN22. Cf. *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 307 n. 6 (9th Cir.1992) ("Where the infringement is small in relation to the new work created, the fair user is profiting largely from his own creative efforts rather than free-riding on another's work.").

To paraphrase only slightly *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, ----, 111 S.Ct. 1282, 1289-90, 113 L.Ed.2d 358 (1991), it may seem unfair that much of the fruit of a creator's labor may be used by others without compensation. But this is not some unforeseen byproduct of our intellectual property system; it is the system's very essence. Intellectual property law assures authors the right to their original expression, but encourages others to build freely on the ideas that underlie it. This result is neither unfair nor unfortunate: It is the means

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by which intellectual property law advances the progress of science and art. We give authors certain exclusive rights, but in exchange we get a richer public domain. The majority ignores this wise teaching, and all of us are the poorer for it.^{FN23}

^{FN23} The majority opinion has already earned some well-deserved criticisms on this score. Stephen R. Barnett, *In Hollywood's Wheel of Fortune, Free Speech Loses a Turn*, Wall St. J., Sept. 28, 1992, at A14; Stephen R. Barnett, *Wheel of Misfortune for Advertisers: Ninth Circuit Misreads the Law to Protect Vanna White's Image*, L.A. Daily J., Oct. 5, 1992, at 6; Felix H. Kent, *California Court Expands Celebrities' Rights*, N.Y.L.J., Oct. 30, 1992, at 3 ("To speak of the 'evisceration' of such a questionable common law right in a case that has probably gone the farthest of any case in any court in the United States of America is more than difficult to comprehend"); Shapiro, *supra* note 1 ("A fat chef? A blond robot in an evening gown? How far will this go?" (citing Douglas J. Wood, an advertising lawyer)). See also Mark Alan Stamaty, *Washington*, Wash. Post, Apr. 5, 1993, at A21.

IV

The panel, however, does more than misinterpret California law: By refusing to recognize a parody exception to the right of publicity, the panel directly contradicts the federal Copyright Act. Samsung didn't merely parody Vanna White. It parodied Vanna White appearing in "Wheel of Fortune," a copyrighted television show, and parodies of copyrighted works are governed by federal copyright law.

Copyright law specifically gives the world at large the right to make "fair use" parodies, parodies that don't borrow too much of the original. *Fisher v. Dees*, 794 F.2d 432, 435 (9th Cir.1986). Federal copyright law also gives the copyright owner the exclusive right to create (or license the creation of) derivative works, which include parodies that borrow too much to qualify as "fair use." See *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1434-35 (6th Cir.1992).^{FN24} When Mel Brooks, for instance, decided to parody *Star Wars*, he *1518 had two options: He could have stuck with his fair use rights

under 17 U.S.C. § 107, or he could have gotten a license to make a derivative work under 17 U.S.C. § 106(b) from the holder of the *Star Wars* copyright. To be safe, he probably did the latter, but once he did, he was guaranteed a perfect right to make his movie.^{FN25}

^{FN24} How much is too much is a hotly contested question, but one thing is clear: The right to make parodies belongs either to the public at large or to the copyright holder, not to someone who happens to appear in the copyrighted work.

^{FN25} See *Spaceballs* (1987). Compare *Madonna: Truth or Dare* (1991) with *Medusa: Dare to Be Truthful* (1991); *Loaded Weapon I* (1993) with *Lethal Weapon* (1987); *Young Frankenstein* (1974) with *Bride of Frankenstein* (1935).

The majority's decision decimates this federal scheme. It's impossible to parody a movie or a TV show without at the same time "evok[ing]" the "identit[ies]" of the actors.^{FN26} You can't have a mock *Star Wars* without a mock Luke Skywalker, Han Solo and Princess Leia, which in turn means a mock Mark Hamill, Harrison Ford and Carrie Fisher. You can't have a mock *Batman* commercial without a mock Batman, which means someone emulating the mannerisms of Adam West or Michael Keaton. See Carlos V. Lozano, *West Loses Lawsuit over Batman TV Commercial*, L.A. Times, Jan. 18, 1990, at B3 (describing Adam West's right of publicity lawsuit over a commercial produced under license from DC Comics, owner of the Batman copyright).^{FN27} The public's right to make a fair use parody and the copyright owner's right to license a derivative work are useless if the parodist is held hostage by every actor whose "identity" he might need to "appropriate."

^{FN26} 17 U.S.C. § 301(b)(1) limits the Copyright Act's preemptive sweep to subject matter "fixed in any tangible medium of expression," but White's identity-her look as the hostess of *Wheel of Fortune*-is definitely fixed: It consists entirely of her appearances in a fixed, copyrighted TV show. See *Baltimore Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663, 675 & n. 22 (7th Cir.1986).

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FN27. Cf. *Lugosi v. Universal Pictures*, 25 Cal.3d 813, 827-28, 160 Cal.Rptr. 323, 331-32, 603 P.2d 425, 433-34 (1979) (Mosk, J., concurring) (pointing out that rights in characters should be owned by the copyright holder, not the actor who happens to play them); *Baltimore Orioles*, 805 F.2d at 674-79 (baseball players' right of publicity preempted by copyright law as to telecasts of games).

Our court is in a unique position here. State courts are unlikely to be particularly sensitive to federal preemption, which, after all, is a matter of first concern to the federal courts. The Supreme Court is unlikely to consider the issue because the right of publicity seems so much a matter of state law. That leaves us. It's our responsibility to keep the right of publicity from taking away federally granted rights, either from the public at large or from a copyright owner. We must make sure state law doesn't give the Vanna Whites and Adam Wests of the world a veto over fair use parodies of the shows in which they appear, or over copyright holders' exclusive right to license derivative works of those shows. In a case where the copyright owner isn't even a party—where no one has the interests of copyright owners at heart—the majority creates a rule that greatly diminishes the rights of copyright holders in this circuit.

V

The majority's decision also conflicts with the federal copyright system in another, more insidious way. Under the dormant Copyright Clause, state intellectual property laws can stand only so long as they don't "prejudice the interests of other States." *Goldstein v. California*, 412 U.S. 546, 558, 93 S.Ct. 2303, 2310, 37 L.Ed.2d 163 (1973). A state law criminalizing record piracy, for instance, is permissible because citizens of other states would "remain free to copy within their borders those works which may be protected elsewhere." *Id.* But the right of publicity isn't geographically limited. A right of publicity created by one state applies to conduct everywhere, so long as it involves a celebrity domiciled in that state. If 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 keep the ad from being shown

in California. See *Acme Circus Operating Co. v. Kuperstock*, 711 F.2d 1538, 1540 (11th Cir.1983); *Groucho Marx Prods. v. Day and Night Co.*, 689 F.2d 317, 320 (2d Cir.1982); see *1519 also *Factors Etc. v. Pro Arts*, 652 F.2d 278, 281 (2d Cir.1981).

The broader and more ill-defined one state's right of publicity, the more it interferes with the legitimate interests of other states. A limited right that applies to unauthorized use of name and likeness probably does not run afoul of the Copyright Clause, but the majority's protection of "identity" is quite another story. Under the majority's approach, any time anybody in the United States—even somebody who lives in a state with a very narrow right of publicity—creates an ad, he takes the risk that it might remind some segment of the public of somebody, perhaps somebody with only a local reputation, somebody the advertiser has never heard of. See note 17 *supra* (right of publicity is infringed by unintentional appropriations). So you made a commercial in Florida and one of the characters reminds Reno residents of their favorite local TV anchor (a California domiciliary)? Pay up.

This is an intolerable result, as it gives each state far too much control over artists in other states. No California statute, no California court has actually tried to reach this far. It is ironic that it is we who plant this kudzu in the fertile soil of our federal system.

VI

Finally, I can't see how giving White the power to keep others from evoking her image in the public's mind can be squared with the First Amendment. Where does White get this right to control our thoughts? The majority's creation goes way beyond the protection given a trademark or a copyrighted work, or a person's name or likeness. All those things control one particular way of expressing an idea, one way of referring to an object or a person. But not allowing *any* means of reminding people of someone? That's a speech restriction unparalleled in First Amendment law.^{FN28}

FN28. Just compare the majority's holding to the intellectual property laws upheld by the Supreme Court. The Copyright Act is constitutional precisely because of the fair use doctrine and the idea-expression dichotomy, *Harper & Row v. Nation Enterprises*,

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471 U.S. 539, 560, 105 S.Ct. 2218, 2230, 85 L.Ed.2d 588 (1985), two features conspicuously absent from the majority's doctrine. The right of publicity at issue in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576, 97 S.Ct. 2849, 2857-58, 53 L.Ed.2d 965 (1977), was only the right to "broadcast of petitioner's entire performance," not "the unauthorized use of another's name for purposes of trade." *Id.* Even the statute upheld in *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 530, 107 S.Ct. 2971, 2977, 97 L.Ed.2d 427 (1987), which gave the USOC sweeping rights to the word "Olympic," didn't purport to protect all expression that reminded people of the Olympics.

What's more, I doubt even a name-and-likeness-only right of publicity can stand without a parody exception. The First Amendment isn't just about religion or politics-it's also about protecting the free development of our national culture. Parody, humor, irreverence are all vital components of the marketplace of ideas. The last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them, or from "evok[ing]" their images in the mind of the public. 971 F.2d at 1399.^{FN29}

^{FN29} The majority's failure to recognize a parody exception to the right of publicity would apply equally to parodies of politicians as of actresses. Consider the case of Wok Fast, a Los Angeles Chinese food delivery service, which put up a billboard with a picture of then-L.A. Police Chief Daryl Gates and the text "When you can't leave the office. Or won't." (This was an allusion to Chief Gates's refusal to retire despite pressure from Mayor Tom Bradley.) Gates forced the restaurant to take the billboard down by threatening a right of publicity lawsuit. Leslie Berger, *He Did Leave the Office-And Now Sign Will Go, Too*, L.A. Times, July 31, 1992, at B2.

See also *Samsung Has Seen the Future: Brace Yourself*, Adweek, Oct. 3, 1988, at 26 (ER 72) (Samsung planned another ad that would show a dollar bill with Richard

Nixon's face on it and the caption 'Dollar bill, 2025 A.D.,' but Nixon refused permission to use his likeness); Madow *supra* note 19, at 142-46 (discussing other politically and culturally charged parodies).

The majority dismisses the First Amendment issue out of hand because Samsung's ad was commercial speech. *Id.* at 1401 & n. 3. So what? Commercial speech may be less protected by the First Amendment than noncommercial speech, but less protected means protected nonetheless. *1520 *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n.*, 447 U.S. 557, 100 S.Ct. 2343, 65 L.Ed.2d 341 (1980). And there are very good reasons for this. Commercial speech has a profound effect on our culture and our attitudes. Neutral-seeming ads influence people's social and political attitudes, and themselves arouse political controversy.^{FN30} "Where's the Beef?" turned from an advertising catchphrase into the only really memorable thing about the 1984 presidential campaign.^{FN31} Four years later, Michael Dukakis called George Bush "the Joe Isuzu of American politics."^{FN32}

^{FN30} See, e.g., Bruce Horowitz, *Nike Does It Again; Firm Targets Blacks with a Spin on "Family Values"*, L.A. Times, Aug. 25, 1992, at D1 ("The ad reinforces a stereotype about black fathers" (quoting Lawrence A. Johnson of Howard University)); Gaylord Fields, *Advertising Awards-Show Mania: CEBA Awards Honors Black-Oriented Advertising*, Back Stage, Nov. 17, 1989, at 1 (quoting the Rev. Jesse Jackson as emphasizing the importance of positive black images in advertising); Debra Kaufman, *Quality of Hispanic Production Rising to Meet Clients' Demands*, Back Stage, July 14, 1989, at 1 (Hispanic advertising professional stresses importance of positive Hispanic images in advertising); Marilyn Elias, *Medical Ads Often Are Sexist*, USA Today, May 18, 1989, at 1D ("There's lots of evidence that this kind of ad reinforces stereotypes" (quoting Julie Edell of Duke University)).

^{FN31} See *Wendy's Kind of Commercial; "Where's the Beef" Becomes National Craze*, Broadcasting, Mar. 26, 1984, at 57.

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FN32. See Gregory Gordon, *Candidates Look for Feedback Today*, UPI, Sept. 26, 1988.

In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared. Is the Samsung parody any different from a parody on Saturday Night Live or in Spy Magazine? Both are equally profit-motivated. Both use a celebrity's identity to sell things—one to sell VCRs, the other to sell advertising. Both mock their subjects. Both try to make people laugh. Both add something, perhaps something worthwhile and memorable, perhaps not, to our culture. Both are things that the people being portrayed might dearly want to suppress. See notes 1 & 29 *supra*.

Commercial speech is a significant, valuable part of our national discourse. The Supreme Court has recognized as much, and has insisted that lower courts carefully scrutinize commercial speech restrictions, but the panel totally fails to do this. The panel majority doesn't even purport to apply the *Central Hudson* test, which the Supreme Court devised specifically for determining whether a commercial speech restriction is valid.^{FN33} The majority doesn't ask, as *Central Hudson* requires, whether the speech restriction is justified by a substantial state interest. It doesn't ask whether the restriction directly advances the interest. It doesn't ask whether the restriction is narrowly tailored to the interest. See *id.* at 566, 100 S.Ct. at 2351.^{FN34} These are all things the Supreme Court told us—in no uncertain terms—we must consider; the majority opinion doesn't even mention them.^{FN35}

FN33. Its only citation to *Central Hudson* is a seeming afterthought, buried in a footnote, and standing only for the proposition that commercial speech is less protected under the First Amendment. See 971 F.2d at 1401 n. 3.

FN34. See also *Board of Trustees v. Fox*, 492 U.S. 469, 476-81, 109 S.Ct. 3028, 3032-35, 106 L.Ed.2d 388 (1989) (reaffirming “narrowly tailored” requirement, but making clear it's not a “least restrictive means” test).

The government has a freer hand in regu-

lating false or misleading commercial speech, but this isn't such a regulation. Some “appropriations” of a person's “identity” might misleadingly suggest an endorsement, but the mere possibility that speech might mislead isn't enough to strip it of First Amendment protection. See *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 644, 105 S.Ct. 2265, 2278, 85 L.Ed.2d 652 (1985).

FN35. Neither does it discuss whether the speech restriction is unconstitutionally vague. *Posadas de P.R. Assocs. v. Tourism Co.*, 478 U.S. 328, 347, 106 S.Ct. 2968, 2980, 92 L.Ed.2d 266 (1986).

Process matters. The Supreme Court didn't set out the *Central Hudson* test for its health. It devised the test because it saw lower courts were giving the First Amendment short shrift when confronted with commercial speech. See *Central Hudson*, 447 U.S. at 561-62, 567-68, 100 S.Ct. at 2348-49, 2352. The *Central Hudson* test was an attempt to constrain lower courts' discretion, to focus judges' thinking *1521 on the important issues—how strong the state interest is, how broad the regulation is, whether a narrower regulation would work just as well. If the Court wanted to leave these matters to judges' gut feelings, to nifty lines about “the difference between fun and profit,” 971 F.2d at 1401, it could have done so with much less effort.

Maybe applying the test would have convinced the majority to change its mind; maybe going through the factors would have shown that its rule was too broad, or the reasons for protecting White's “identity” too tenuous. Maybe not. But we shouldn't thumb our nose at the Supreme Court by just refusing to apply its test.

VII

For better or worse, we *are* the Court of Appeals for the Hollywood Circuit. Millions of people toil in the shadow of the law we make, and much of their livelihood is made possible by the existence of intellectual property rights. But much of their livelihood—and much of the vibrancy of our culture—also depends on the existence of other intangible rights: The right to draw ideas from a rich and varied public domain, and

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the right to mock, for profit as well as fun, the cultural icons of our time.

In the name of avoiding the "evisceration" of a celebrity's rights in her image, the majority diminishes the rights of copyright holders and the public at large. In the name of fostering creativity, the majority sup-

presses it. Vanna White and those like her have been given something they never had before, and they've been given it at our expense. I cannot agree.

*1522 APPENDIX



Vanna White

*1523

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Ms. C3PO?

C.A.9,1993.
White v. Samsung Electronics America, Inc.
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Rep. 1330

END OF DOCUMENT



▷ COMEDY III PRODUCTIONS, INC., Plaintiff
and Respondent,
v.
GARY SADERUP, INC., et al., Defendants and Ap-
pellants.
No. S076061.

Supreme Court of California
Apr. 30, 2001.

SUMMARY

A corporation brought an action against an artist and his corporation, seeking damages and injunctive relief for infringement of the right of publicity under Civ. Code, former § 990 (now Civ. Code, § 3344.1). The action arose from defendants' sale of lithographed copies of a sketch of the likenesses of three deceased personalities, as well as T-shirts bearing reproductions of the sketch. The trial court found for plaintiff and entered judgment against defendants awarding damages and attorney fees plus costs. The trial court also issued an injunction. (Superior Court of Los Angeles County, No. EC020205, Carl J. West, Judge.) The Court of Appeal, Second Dist., Div. Two, No. B120382, modified the judgment by striking the injunction and affirmed the judgment as modified.

The Supreme Court affirmed the judgment of the Court of Appeal. The court held that defendants violated Civ. Code, former § 990 (now Civ. Code, § 3344.1), which prohibits not merely the advertisement, endorsement, or sponsorship of a product, but also the use of a deceased personality's likeness on or in products, merchandise, or goods. Giving effect to its plain meaning, the statute makes liable any person who, without consent, uses a deceased personality's name, voice, signature, photograph, or likeness, either (1) on or in a product, or (2) in advertising or selling a product. Defendants sold more than just the incorporeal likeness of the deceased personalities. The lithographic prints and the T-shirts were themselves tangible personal property. By producing and selling these products, defendants used the likeness of personalities on products, merchandise, or goods within the meaning of the statute. The court further held that enforcement of the judgment did not violate

defendants' rights of free speech and expression under U.S. Const., 1st Amend. While an action for infringement of the right of publicity can be maintained only if the proprietary interests clearly outweigh the value of free expression in the context at issue, depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment. An artist depicting a celebrity must create something recognizably his or her own in order to qualify for legal protection. There was no significant transformative or creative contribution in defendants' work. The artist's skill was manifestly subordinated to the overall goal of creating literal, conventional depictions of the deceased personalities so as to exploit their fame. (Opinion by Mosk, J., expressing the unanimous view of the court.)

HEADNOTES

Classified to California Digest of Official Reports

(1) Privacy § 3--Nature and Extent of Right--Statutory Protection--Right of Publicity--Sale of Lithographic Prints and T-Shirts with Deceased Personalities' Likenesses.

An artist and a corporation who sold lithographed copies of a sketch of the likenesses of three deceased personalities, as well as T-shirts bearing reproductions of the sketch, violated Civ. Code, former § 990 (now Civ. Code, § 3344.1), which prohibits not merely the advertisement, endorsement, or sponsorship of a product, but also the use of a deceased personality's likeness on or in products, merchandise, or goods (Civ. Code, former § 990, subd. (a)). When first enacted in 1971, the companion statute applying to living personalities applied only to advertising products, merchandise, goods or services, or for purposes of solicitation of purchases. The Legislature inserted the phrase, "on or in products, merchandise, or goods" when it amended the companion statute in 1984, and in the same legislation, it adopted Civ. Code, former § 990, and inserted the identical phrase in that statute as well. Giving effect to its plain meaning, the statute makes liable any person who, without consent, uses a deceased personality's name, voice, signature, photograph, or likeness, either (1) on or in a product, or (2) in advertising or selling a product.

Defendants sold more than just the incorporeal likeness of the deceased personalities. The lithographic prints and the T-shirts were themselves tangible personal property. By producing and selling these products, defendants used the likeness of personalities on products, merchandise, or goods within the meaning of the statute.

[See 5 Witkin, Summary of Cal. Law (9th ed. 1988) Torts, § 594.]

(2a, 2b) Constitutional Law § 55.2--First Amendment Rights--Freedom of Speech--Right of Publicity--Sale of Lithographic Prints and T-Shirts with Deceased Personalities' Likenesses.

Enforcement of a judgment for violation of Civ. Code, former § 990 (now Civ. Code, § 3344.1) (right of publicity), against an artist and a corporation, who sold lithographed copies of a sketch of the likenesses of three deceased personalities as well as T-shirts bearing reproductions of the sketch, did not violate defendants' rights of free speech and expression under U.S. Const., 1st Amend. While an action for infringement of the right of publicity can be maintained only if the proprietary interests clearly outweigh the value of free expression in the context at issue, depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment. When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. An artist depicting a celebrity must create something recognizably his or her own in order to qualify for legal protection. There was no significant transformative or creative contribution in defendants' work. The artist's skill was manifestly subordinated to the overall goal of creating literal, conventional depictions of the deceased personalities so as to exploit their fame. Also, the marketability and economic value of the work derived primarily from the fame of the celebrities.

(3) Constitutional Law § 55--First Amendment Rights--Freedom of Speech--Speech and Expression Undertaken for Profit.

U.S. Const., First Amend., is not limited to those who publish without charge. An expressive activity does not lose its constitutional protection because it is undertaken for profit.

(4) Constitutional Law § 55--First Amendment Rights--Freedom of Speech--Right of Publicity--Transformative Elements of Work.

When an artist is faced with a right of publicity challenge to his or her work pursuant to Civ. Code, former § 990 (now Civ. Code, § 3344.1) (use of deceased personality's likeness), he or she may raise as an affirmative defense that the work is protected by U.S. Const., First Amend., inasmuch as it contains significant transformative elements, or that the value of the work does not derive primarily from the celebrity's fame. The transformative elements or creative contributions that require protection are not confined to parody and can take many forms. The court asks whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness. The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work. Furthermore, in determining whether a work is sufficiently transformative, courts may find useful a subsidiary inquiry, particularly in close cases: does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted? If this question is answered in the negative, then there is generally no actionable right of publicity. If the question is answered in the affirmative, however, it does not necessarily follow that the work is without First Amendment protection-it may still be a transformative work.

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MOSK, J.

A California statute grants the *right of publicity* to specified successors in interest of deceased celebrities, prohibiting any other person from using a celebrity's name, voice, signature, photograph, or likeness for commercial purposes without the consent of such successors. (Former Civ. Code, § 990.)^{FN1} The United States Constitution prohibits the states from abridging, among other fundamental rights, freedom of speech. (U.S. Const., 1st and 14th Amendments.) In the case at bar we resolve a conflict between these two provisions. The Court of Appeal concluded that the lithographs and silkscreened T-shirts in question here received no First Amendment protection simply because they were reproductions rather than original works of art. As will appear, this was error: reproductions are equally entitled to First Amendment protection. We formulate instead what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation. Applying this test to the present case, we conclude that there are no such creative elements here and that the right of publicity prevails. On this basis, we will affirm the judgment of the Court of Appeal.

FN1 After we granted review, the Legislature renumbered the statute as section

3344.1 of the Civil Code. (Stats. 1999, ch. 998, § 1; *id.*, ch. 1000, § 9.5.) At the same time, it amended the wording of the statute in several respects. Because we interpret the former statute, we will refer to it throughout, in the present tense, as section 990.

I. The Statute

In this state the right of publicity is both a statutory and a common law right. The statutory right originated in Civil Code section 3344 (hereafter section 3344), enacted in 1971, authorizing recovery of damages by any living person whose name, photograph, or likeness has been used for commercial purposes without his or her consent. Eight years later, in *Lugosi v. Universal Pictures* (1979) 25 Cal.3d 813 [160 Cal.Rptr. 323, 603 P.2d 425, 10 A.L.R.4th 1150] (*Lugosi*), we also recognized a common law right of publicity, which the statute was said to complement (*id.* at p. 818 and fn. 6). But because the common law right was derived from the law of privacy,^{FN2} we held in *Lugosi* that the cause of action did not survive the death of the person whose identity was exploited and was not descendible to his or her heirs or assignees. (25 Cal.3d at pp. 819-821.)

FN2 Specifically, from the fourth type of privacy invasion identified by Dean Prosser in his seminal article on the subject. (Prosser, *Privacy* (1960) 48 Cal. L.Rev. 383, 389 [“Appropriation, for the defendant's advantage, of the plaintiff's name or likeness”].)

In 1984 the Legislature enacted an additional measure on the subject, creating a second statutory right of publicity that *was* descendible to the *392 heirs and assignees of deceased persons. (Stats. 1984, ch. 1704, § 1, p. 6169.) The statute was evidently modeled on section 3344: many of the key provisions of the two statutory schemes were identical. The 1984 measure is the statute in issue in the case at bar. At the time of trial and while the appeal was pending before the Court of Appeal, the statute was numbered section 990 of the Civil Code.

Section 990 declares broadly that “Any person who uses a deceased personality's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of

advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without prior consent from the person or persons specified in subdivision (c), shall be liable for any damages sustained by the person or persons injured as a result thereof." (*Id.*, subd. (a).) The amount recoverable includes "any profits from the unauthorized use," as well as punitive damages, attorney fees, and costs. (*Ibid.*)

The statute defines "deceased personality" as a person "whose name, voice, signature, photograph, or likeness has commercial value at the time of his or her death," whether or not the person actually used any of those features for commercial purposes while alive. (§ 990, subd. (h).)

The statute further declares that "The rights recognized under this section are property rights" that are transferable before or after the personality dies, by contract or by trust or will. (§ 990, subd. (b).) Consent to use the deceased personality's name, voice, photograph, etc., must be obtained from such a transferee or, if there is none, from certain described survivors of the personality. (*Id.*, subds. (c), (d).) Any person claiming to be such a transferee or survivor must register the claim with the Secretary of State before recovering damages. (*Id.*, subd. (f).)

The right to require consent under the statute terminates if there is neither transferee nor survivor (§ 990, subd. (e)), or 50 years after the personality dies (*id.*, subd. (g)).^{FN3}

FN3 Under the new statute, this period has increased to 70 years. (*Civ. Code*, § 3344.1, subd. (g).)

The statute provides a number of exemptions from the requirement of consent to use. Thus a use "in connection with any news, public affairs, or sports broadcast or account, or any political campaign" does not require consent. (§ 990, subd. (j).) Use in a "commercial medium" does not require consent solely because the material is commercially sponsored or contains *393 paid advertising; "Rather it shall be a question of fact whether or not the use ... was so directly connected with" the sponsorship or advertising that it requires consent. (*Id.*, subd. (k).) Finally, subdivision (n) provides that "[a] play, book, magazine, newspaper, musical composition, film,

radio or television program" (*id.*, subd. (n)(1)), work of "political or newsworthy value" (*id.*, subd. (n)(2)), "[s]ingle and original works of fine art" (*id.*, subd. (n)(3)), or "[a]n advertisement or commercial announcement" for the above works (*id.*, subd. (n)(4)) are all exempt from the provisions of the statute.

II. Facts

Plaintiff Comedy III Productions, Inc. (hereafter Comedy III), brought this action against defendants Gary Saderup and Gary Saderup, Inc. (hereafter collectively Saderup), seeking damages and injunctive relief for violation of section 990 and related business torts.^{FN4} The parties waived the right to jury trial and the right to put on evidence, and submitted the case for decision on the following stipulated facts:

FN4 The action was also commenced by an unrelated celebrity whose claim was settled before trial.

Comedy III is the registered owner of all rights to the former comedy act known as The Three Stooges, who are deceased personalities within the meaning of the statute.

Saderup is an artist with over 25 years' experience in making charcoal drawings of celebrities. These drawings are used to create lithographic and silkscreen masters, which in turn are used to produce multiple reproductions in the form, respectively, of lithographic prints and silkscreened images on T-shirts. Saderup creates the original drawings and is actively involved in the ensuing lithographic and silkscreening processes.

Without securing Comedy III's consent, Saderup sold lithographs and T-shirts bearing a likeness of The Three Stooges reproduced from a charcoal drawing he had made. These lithographs and T-shirts did not constitute an advertisement, endorsement, or sponsorship of any product.

Saderup's profits from the sale of unlicensed lithographs and T-shirts bearing a likeness of The Three Stooges was \$75,000 and Comedy III's reasonable attorney fees were \$150,000.

On these stipulated facts the court found for Comedy

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III and entered judgment against Saderup awarding damages of \$75,000 and attorney fees of *394 \$150,000 plus costs. The court also issued a permanent injunction restraining Saderup from violating the statute by use of any likeness of The Three Stooges in lithographs, T-shirts, "or any other medium by which [Saderup's] art work may be sold or marketed." The injunction further prohibited Saderup from "Creating, producing, reproducing, copying, distributing, selling or exhibiting any lithographs, prints, posters, t-shirts, buttons, or other goods, products or merchandise of any kind, bearing the photograph, image, face, symbols, trademarks, likeness, name, voice or signature of The Three Stooges or any of the individual members of The Three Stooges." The sole exception to this broad prohibition was Saderup's original charcoal drawing from which the reproductions at issue were made.

Saderup appealed. The Court of Appeal modified the judgment by striking the injunction. The court reasoned that Comedy III had not proved a likelihood of continued violation of the statute, and that the wording of the injunction was overbroad because it exceeded the terms of the statute and because it "could extend to matters and conduct protected by the First Amendment"

The Court of Appeal affirmed the judgment as thus modified, however, upholding the award of damages, attorney fees, and costs. In so doing, it rejected Saderup's contentions that his conduct (1) did not violate the terms of the statute, and (2) in any event was protected by the constitutional guaranty of freedom of speech.

We granted review to address these two issues.^{FN5}

FN5 In its brief on the merits plaintiff asks us also to review the Court of Appeal's ruling striking the injunction. We decline to do so: plaintiff failed to raise this issue in its answer to the petition for review (Cal. Rules of Court, rule 28(e)(5)) and in any event presents little or no argument in support of the point.

III. Discussion

A. The Statutory Issue

(1) Saderup contends the statute applies only to uses of a deceased personality's name, voice, photograph, etc., for the purpose of advertising, selling, or soliciting the purchase of, products or services. He then stresses the stipulated fact (and subsequent finding) that the lithographs and T-shirts at issue in this case did not constitute an advertisement, endorsement, or sponsorship of any product. He concludes the statute therefore does not apply in the case at bar. As will appear, the major premise of his argument-his construction of the statute-is unpersuasive. *395

As noted above, the statute makes liable any person who, without consent, uses a deceased personality's name, voice, photograph, etc., "in any manner, *on or in products, merchandise, or goods, or* for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services" (§ 990, subd. (a), italics added.) Saderup's construction reads the emphasized phrase out of the statute. Yet the Legislature deliberately inserted it, as the following sequence of events demonstrates. When first enacted in 1971, section 3344 -the companion statute applying to living personalities-contained no such phrase: the statute simply made liable any person who uses another's identity "in any manner, for purposes of advertising products, merchandise, goods or services, or for purposes of solicitation of" such purchases. (Stats. 1971, ch. 1595, § 1, p. 3426.) The Legislature inserted the phrase, "on or in products, merchandise, or goods, or," when it amended section 3344 in 1984. (Stats. 1984, ch. 1704, § 2, p. 6172.) And in the very same legislation, the Legislature adopted section 990 and inserted the identical phrase in that statute as well. (Stats. 1984, ch. 1704, § 1, p. 6169.)

We therefore give effect to the plain meaning of the statute: it makes liable any person who, without consent, uses a deceased personality's name, voice, photograph, etc., either (1) "on or in" a product, *or* (2) in "advertising or selling" a product. The two uses are not synonymous: in the apt example given by the Court of Appeal, there is an obvious difference between "placing a celebrity's name on a 'special edition' of a vehicle, and using that name in a commercial to endorse or tout the same or another vehicle."

Applying this construction of the statute to the facts at hand, we agree with the Court of Appeal that Saderup sold more than just the incorporeal likeness of

The Three Stooges. Saderup's lithographic prints of The Three Stooges are themselves tangible personal property, consisting of paper and ink, made as products to be sold and displayed on walls like graphic art. Saderup's T-shirts are likewise tangible personal property, consisting of fabric and ink, made as products to be sold and worn on the body like similar garments. By producing and selling such lithographs and T-shirts, Saderup thus used the likeness of The Three Stooges "on ... products, merchandise, or goods" within the meaning of the statute.^{FN6}

FN6 This conclusion is not inconsistent with the statement of the trial court that in the case at bar "the product consists of the likeness." The court did not make that statement in answering the statutory contention we address here, but in response to the constitutional claim we address later in this opinion (pt. III.B., *post*). On the statutory issue, the court expressly found that "the products sold by the defendants are, in fact, *lithographs and T-shirts* with the likeness of The Three Stooges." (Italics added.)

Saderup contends this construction is inconsistent with precedent, but the cases on which he relies are readily distinguishable. *396 *Eastwood v. Superior Court* (1983) 149 Cal.App.3d 409, 417 [198 Cal.Rptr. 342], involving section 3344, was decided when that statute prohibited the use of another's identity only for advertising purposes. And although *Newcombe v. Adolf Coors Co.* (9th Cir. 1998) 157 F.3d 686 was decided after the Legislature inserted the phrase, "on or in products, merchandise, or goods," into section 3344, the case is not authority for reading that phrase out of the statute or section 990: because the sole issue in the case was the unauthorized use of a celebrity's likeness in a beer advertisement, the court quoted only those portions of section 3344 dealing with advertisements. (*Newcombe*, at p. 692.)

B. The Constitutional Issue

(2a) Saderup next contends that enforcement of the judgment against him violates his right of free speech and expression under the First Amendment. He raises a difficult issue, which we address below.

The right of publicity is often invoked in the context

of commercial speech when the appropriation of a celebrity likeness creates a false and misleading impression that the celebrity is endorsing a product. (See *Waits v. Frito-Lay, Inc.* (9th Cir. 1992) 978 F.2d 1093; *Midler v. Ford Motor Co.* (9th Cir. 1988) 849 F.2d 460.) Because the First Amendment does not protect false and misleading commercial speech (*Central Hudson Gas & Elec. v. Public Serv. Comm'n* (1980) 447 U.S. 557, 563-564 [100 S.Ct. 2343, 2350, 65 L.Ed.2d 341]), and because even nonmisleading commercial speech is generally subject to somewhat lesser First Amendment protection (*Central Hudson*, at p. 566 [100 S.Ct. at p. 2351]), the right of publicity may often trump the right of advertisers to make use of celebrity figures.

But the present case does not concern commercial speech. As the trial court found, Saderup's portraits of The Three Stooges are expressive works and not an advertisement for or endorsement of a product. (3) Although his work was done for financial gain, "[t]he First Amendment is not limited to those who publish without charge.... [An expressive activity] does not lose its constitutional protection because it is undertaken for profit." (*Guglielmi v. Spelling-Goldberg Productions* (1979) 25 Cal.3d 860, 868 [160 Cal.Rptr. 352, 603 P.2d 454] (conc. opn. of Bird, C. J.) (*Guglielmi*).)^{FN7}

FN7 Chief Justice Bird's concurring opinion in *Guglielmi* was signed by Justices To-briner and Manuel. The principles enunciated in her concurrence were also endorsed by Justice Newman, who nonetheless did not join the opinion because he shared the view of the majority that the common law right of publicity was not descendible (the case predated the passage of section 990). (*Guglielmi, supra*, 25 Cal.3d at p. 876.) Therefore, Chief Justice Bird's views in *Guglielmi* commanded the support of the majority of the court. Hereafter, all references to *Guglielmi* in this opinion will be to the Chief Justice's opinion.

The tension between the right of publicity and the First Amendment is highlighted by recalling the two distinct, commonly acknowledged purposes *397 of the latter. First, " 'to preserve an uninhibited marketplace of ideas' and to repel efforts to limit the ' 'uninhibited, robust and wide-open " debate on public is-

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sues.' ” (*Guglielmi, supra*, 25 Cal.3d at p. 866.) Second, to foster a “fundamental respect for individual development and self-realization. The right to self-expression is inherent in any political system which respects individual dignity. Each speaker must be free of government restraint regardless of the nature or manner of the views expressed unless there is a compelling reason to the contrary.” (*Ibid.*, fn. omitted; see also Emerson, *The System of Freedom of Expression* (1970) pp. 6-7.)

The right of publicity has a potential for frustrating the fulfillment of both these purposes. Because celebrities take on public meaning, the appropriation of their likenesses may have important uses in uninhibited debate on public issues, particularly debates about culture and values. And because celebrities take on personal meanings to many individuals in the society, the creative appropriation of celebrity images can be an important avenue of individual expression. As one commentator has stated: “Entertainment and sports celebrities are the leading players in our Public Drama. We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles, their modes of conversation and of consumption. Whether or not celebrities are ‘the chief agents of moral change in the United States,’ they certainly are widely used—far more than are institutionally anchored elites—to symbolize individual aspirations, group identities, and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.” (Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights* (1993) 81 Cal. L.Rev. 125, 128 (Madow), italics and fns. omitted.)

As Madow further points out, the very importance of celebrities in society means that the right of publicity has the potential of censoring significant expression by suppressing alternative versions of celebrity images that are iconoclastic, irreverent, or otherwise attempt to redefine the celebrity's meaning. (Madow, *supra*, 81 Cal. L.Rev. at pp. 143-145; see also Coombe, *Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders* (1992) 10 Cardozo Arts and Ent. L.J. 365, 377-388.) A majority of this court recognized as much in *Guglielmi*: “The right of publicity derived from public

prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comment.” (*Guglielmi, supra*, 25 Cal.3d at p. 869.) *398

For similar reasons, speech about public figures is accorded heightened First Amendment protection in defamation law. As the United States Supreme Court held in *Gertz v. Robert Welch, Inc.* (1974) 418 U.S. 323 [94 S.Ct. 2997, 41 L.Ed.2d 789], public figures may prevail in a libel action only if they prove that the defendant's defamatory statements were made with actual malice, i.e., actual knowledge of falsehood or reckless disregard for the truth, whereas private figures need prove only negligence. (*Id.* at pp. 328, 342, 344-345 [94 S.Ct. at pp. 3001, 3008, 3009-3010].) The rationale for such differential treatment is, first, that the public figure has greater access to the media and therefore greater opportunity to rebut defamatory statements, and second, that those who have become public figures have done so voluntarily and therefore “invite attention and comment.” (*Id.* at pp. 344-345 [94 S.Ct. at p. 3010].) Giving broad scope to the right of publicity has the potential of allowing a celebrity to accomplish through the vigorous exercise of that right the censorship of unflattering commentary that cannot be constitutionally accomplished through defamation actions.

Nor do Saderup's creations lose their constitutional protections because they are for purposes of entertaining rather than informing. As Chief Justice Bird stated in *Guglielmi*, invoking the dual purpose of the First Amendment: “Our courts have often observed that entertainment is entitled to the same constitutional protection as the exposition of ideas. That conclusion rests on two propositions. First, ‘[t]he line between informing and entertaining is too elusive for the protection of the basic right. Everyone is familiar with instances of propaganda through fiction. What is one man's amusement, teaches another doctrine.’ ” (*Guglielmi, supra*, 25 Cal.3d at p. 867, fn. omitted.) “Second, entertainment, 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 of the affirmation of self. The power to realize his potentiality as a human being begins at this point and must extend at least this far if the whole nature of man is not to be thwarted.’ ” (*Ibid.*)

Nor does the fact that expression takes a form of nonverbal, visual representation remove it from the ambit of First Amendment protection. In *Bery v. City of New York* (2d Cir. 1996) 97 F.3d 689, the court overturned an ordinance requiring visual artists—painters, printers, photographers, sculptors, etc.—to obtain licenses to sell their work in public places, but exempted the vendors of books, newspapers or other written matter. As the court stated: “Both the [district] court and the City demonstrate an unduly restricted view of the First Amendment and of visual art itself. Such myopic vision not only overlooks case law central to First Amendment jurisprudence *399 but fundamentally misperceives the essence of visual communication and artistic expression. Visual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection.... One 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.” (*Id.* at p. 695.)

Moreover, the United States Supreme Court has made it clear that a work of art is protected by the First Amendment even if it conveys no discernable message: “[A] narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expressions conveying a ‘particularized message,’ [citation], would never reach the unquestionably shielded painting of Jackson Pollock, music of Arnold Schoenberg, or Jabberwocky verse of Lewis Carroll.” (*Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc.* (1995) 515 U.S. 557, 569 [115 S.Ct. 2338, 2345, 132 L.Ed.2d 487].)

Nor does the fact that Saderup's art appears in large part on a less conventional avenue of communications, T-shirts, result in reduced First Amendment protection. As Judge Posner stated in the case of a defendant who sold T-shirts advocating the legalization of marijuana, “its T-shirts ... are to [the seller] what the *New York Times* is to the Sulzbergers and the Ochs—the vehicle of her ideas and opinions.” (*Ayres v. City of Chicago* (7th Cir. 1997) 125 F.3d 1010, 1017; see also *Cohen v. California* (1971) 403 U.S. 15 [91 S.Ct. 1780, 29 L.Ed.2d 284] [jacket with words “Fuck the Draft” on the back is protected

speech].) First Amendment doctrine does not disfavor nontraditional media of expression.

But having recognized the high degree of First Amendment protection for noncommercial speech about celebrities, we need not conclude that all expression that trenches on the right of publicity receives such protection. The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility. “Often considerable money, time and energy are needed to develop one's prominence in a particular field. Years of labor may be required before one's skill, reputation, notoriety or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion. [Citations.] For some, the investment may eventually create considerable commercial value in one's identity.” (*Lugosi, supra*, 25 Cal.3d at pp. 834-835 (dis. opn. of Bird, C. J.).)

The present case exemplifies this kind of creative labor. Moe and Jerome (Curly) Howard and Larry Fein fashioned personae collectively known as *400 The Three Stooges, first in vaudeville and later in movie shorts, over a period extending from the 1920's to the 1940's. (See Fleming, *The Three Stooges: Amalgamated Morons to American Icons* (1999) pp. 10-46.) The three comic characters they created and whose names they shared—Larry, Moe, and Curly—possess a kind of mythic status in our culture. Their journey from ordinary vaudeville performers to the heights (or depths) of slapstick comic celebrity was long and arduous. (*Ibid.*) Their brand of physical humor—the nimble, comically stylized violence, the “nyuk-nyuks” and “whoop-whoop-whoops,” eye-pokes, slaps and head conks (see, e.g., *Three Little Pigskins* (Columbia Pictures 1934), *Hoi Polloi* (Columbia Pictures 1935), *A Gem of a Jam* (Columbia Pictures 1943), *Micro-Phonies* (Columbia Pictures 1945))—created a distinct comedic trademark. Through their talent and labor, they joined the relatively small group of actors who constructed identifiable, recurrent comic personalities that they brought to the many parts they were scripted to play. “Groucho Marx just being Groucho Marx, with his moustache, cigar, slouch and leer, cannot be exploited by others. Red Skelton's variety of self-devised roles would appear to be protectible, as would the unique personal creations of Abbott and Costello, Laurel and Hardy and others of that genre.... [W]e deal here with actors portraying themselves and

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developing their own characters.'” (*Lugosi, supra*, 25 Cal.3d at pp. 825-826 (conc. opn. of Mosk, J.))

In sum, society may recognize, as the Legislature has done here, that a celebrity's heirs and assigns have a legitimate protectible interest in exploiting the value to be obtained from merchandising the celebrity's image, whether that interest be conceived as a kind of natural property right or as an incentive for encouraging creative work. (See 1 McCarthy, *The Rights of Publicity and Privacy* (2d ed. 2000) §§ 2.2-2.7, pp. 2-1 to 2-22 (McCarthy).) Although critics have questioned whether the right of publicity truly serves any social purpose (see, e.g., Madow, *supra*, 81 Cal. L.Rev. at pp. 178-238), there is no question that the Legislature has a rational basis for permitting celebrities and their heirs to control the commercial exploitation of the celebrity's likeness.

Although surprisingly few courts have considered in any depth the means of reconciling the right of publicity and the First Amendment, we follow those that have in concluding that depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment. We begin with *Zacchini v. Scripps-Howard Broadcasting Co.* (1977) 433 U.S. 562, 576 [97 S.Ct. 2849, 2857-2858, 53 L.Ed.2d 965] (*Zacchini*), the only United States Supreme Court case to directly address the right of publicity. *Zacchini*, the performer *401 of a human cannonball act, sued a television station that had videotaped and broadcast his entire performance without his consent. The court held the First Amendment did not protect the television station against a right of publicity claim under Ohio common law. In explaining why the enforcement of the right of publicity in this case would not violate the First Amendment, the court stated: “[T]he rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.” (*Id.* at p. 576 [97 S.Ct. at p. 2857].) The court also rejected the notion that federal copyright or patent law preempted this type of state law protection of intellectual property: “[Copyright and patent] laws perhaps regard the 'reward to the owner [as] a secondary consideration,' [citation], but they were 'intended definitely to grant valuable, enforceable rights' in

order to afford greater encouragement to the production of works of benefit to the public. [Citation.] The Constitution does not prevent Ohio from making a similar choice here in deciding to protect the entertainer's incentive in order to encourage the production of this type of work.” (*Id.* at p. 577 [97 S.Ct. at p. 2858].)

To be sure, *Zacchini* was not an ordinary right of publicity case: the defendant television station had appropriated the plaintiff's entire act, a species of common law copyright violation. Nonetheless, two principles enunciated in *Zacchini* apply to this case: (1) state law may validly safeguard forms of intellectual property not covered under federal copyright and patent law as a means of protecting the fruits of a performing artist's labor; and (2) the state's interest in preventing the outright misappropriation of such intellectual property by others is not automatically trumped by the interest in free expression or dissemination of information; rather, as in the case of defamation, the state law interest and the interest in free expression must be balanced, according to the relative importance of the interests at stake. (See *Gertz v. Robert Welch, Inc., supra*, 418 U.S. at pp. 347-350 [94 S.Ct. at pp. 3010-3012].)

Guglielmi adopted a similar balancing approach. The purported heir of Rudolph Valentino filed suit against the makers of a fictional film based on the latter's life. *Guglielmi* concluded that the First Amendment protection of entertainment superseded any right of publicity. This was in contrast to the companion *Lugosi* case, in which Chief Justice Bird concluded in her dissenting opinion that there may be an enforceable right of publicity that would prevent the merchandising of Count Dracula using the likeness of Bela Lugosi, with whom that role was identified. (*Lugosi, supra*, *40225 Cal.3d at pp. 848-849 (dis. opn. of Bird, C. J.)) *Guglielmi* proposed a balancing test to distinguish protected from unprotected appropriation of celebrity likenesses: “an action for infringement of the right of publicity can be maintained only if the proprietary interests at issue clearly outweigh the value of free expression in this context.” (*Guglielmi, supra*, 25 Cal.3d at p. 871.)

In *Estate of Presley v. Russen* (D.N.J. 1981) 513 F.Supp. 1339 (*Russen*), the court considered a New Jersey common law right of publicity claim by Elvis Presley's heirs against an impersonator who per-

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formed The Big El Show. The court implicitly used a balancing test similar to the one proposed in *Guglielmi*. Acknowledging that the First Amendment protects entertainment speech, the court nonetheless rejected that constitutional defense. “[E]ntertainment that is merely a copy or imitation, even if skillfully and accurately carried out, does not really have its own creative component and does not have a significant value as pure entertainment. As one authority has emphasized: ‘The public interest in entertainment will support the sporadic, occasional and good-faith imitation of a famous person to achieve humor, to effect criticism or to season a particular episode, but it does not give a privilege to appropriate another’s valuable attributes on a continuing basis as one’s own without the consent of the other.’” (*Russen, supra*, 513 F.Supp. at pp. 1359-1360.) Acknowledging also that the show had some informational value, preserving a live Elvis Presley act for posterity, the court nonetheless stated: “This recognition that defendant’s production has some value does not diminish our conclusion that the primary purpose of defendant’s activity is to appropriate the commercial value of the likeness of Elvis Presley.” (*Id.* at p. 1360.)

On the other side of the equation, the court recognized that the Elvis impersonation, as in *Zacchini*, represented “‘what may be the strongest case for a ‘right of publicity’—involving, not the appropriation of an entertainer’s reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.’” (*Russen, supra*, 513 F.Supp. at p. 1361, quoting *Zacchini, supra*, 433 U.S. at p. 576 [97 S.Ct. at p. 2858].) Thus, in balancing the considerable right of publicity interests with the minimal expressive or informational value of the speech in question, the *Russen* court concluded that the Presley estate’s request for injunctive relief would likely prevail on the merits. (*Russen*, at p. 1361; see also *Factors etc. Inc. v. Creative Card Co.* (S.D.N.Y. 1977) 444 F.Supp. 279 [poster of Elvis Presley labeled “In Memory ... 1935-1977” did not possess sufficient newsworthiness to be eligible for First Amendment protection].)

In *Groucho Marx Productions, Inc. v. Day & Night Co.* (S.D.N.Y. 1981) 523 F.Supp. 485, reversed on other grounds (2d Cir. 1982) 689 F.2d 317, the *403 court considered a right of publicity challenge to a new play featuring characters resembling the Marx

Brothers. The court found in favor of the Marx Brothers’ heirs, rejecting a First Amendment defense. In analyzing that defense, the court posed a dichotomy between “works ... designed primarily to promote the dissemination of thoughts, ideas or information through news or fictionalization,” which would receive First Amendment protection, and “use of the celebrity’s name or likeness ... largely for commercial purposes, such as the sale of merchandise,” in which the right of publicity would prevail. (523 F.Supp. at p. 492.) In creating this dichotomy, the court did not appear to give due consideration to forms of creative expression protected by the First Amendment that cannot be categorized as ideas or information. Moreover, the court, borrowing from certain copyright cases, seemed to believe that the validity of the First Amendment defense turned on whether the play was a parody, without explaining why other forms of creative appropriation, such as using established characters in new theatrical works to advance various creative objectives, were not protected by the First Amendment.^{FN8} Nonetheless, the case is in line with *Zacchini*, *Guglielmi* and *Russen* in recognizing that certain forms of commercial exploitation of celebrities that violate the state law right of publicity do not receive First Amendment protection.

FN8 The Second Circuit Court of Appeals in *Groucho Marx Productions v. Day and Night Co., supra*, 689 F.2d at pages 320-323, reversed the district court on the grounds that it had mistakenly applied New York rather than California law, and that under the latter at the time, the right of publicity terminated at the death of the celebrity. The court therefore had no occasion to rule on the validity of the district court’s First Amendment analysis.

It is admittedly 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. Certainly, any such test must incorporate the principle that the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity’s image by censoring disagreeable portrayals. Once the celebrity thrusts himself or herself forward 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

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given broad scope. The necessary implication of this observation is that the right of publicity is essentially an economic right. What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame through the merchandising of the "name, voice, signature, photograph, or likeness" of the celebrity. (§ 990.)

Beyond this precept, how may courts distinguish between protected and unprotected expression? Some commentators have proposed importing the *404 fair use defense from copyright law (17 U.S.C. § 107), which has the advantage of employing an established doctrine developed from a related area of the law. (See Barnett, *First Amendment Limits on the Right of Publicity* (1995) 30 *Tort & Ins. L.J.* 635, 650-657; Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases* (1988) 29 *Wm. & Mary L.Rev.* 781, 812-820.) Others disagree, pointing to the murkiness of the fair use doctrine and arguing that the idea/expression dichotomy, rather than fair use, is the principal means of reconciling copyright protection and First Amendment rights. (2 McCarthy, *supra*, § 8.38, pp. 8-358 to 8-360; see also Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis* (1994) 70 *Ind. L.J.* 47, 58, fn. 54.)

We conclude that a wholesale importation of the fair use doctrine into right of publicity law would not be advisable. At least two of the factors employed in the fair use test, "the nature of the copyrighted work" and "the amount and substantiality of the portion used" (17 U.S.C. § 107(2), (3)), seem particularly designed to be applied to the partial copying of works of authorship "fixed in [a] tangible medium of expression" (17 U.S.C. § 102); it is difficult to understand why these factors would be especially useful for determining whether the depiction of a celebrity likeness is protected by the First Amendment.

Nonetheless, the first fair use factor—"the purpose and character of the use" (17 U.S.C. § 107(1))—does seem particularly pertinent to the task of reconciling the rights of free expression and publicity. As the Supreme Court has stated, the central purpose of the inquiry into this fair use factor "is to see, in Justice Story's words, whether the new work merely 'superse[d] the objects' of the original creation, [citations], or instead adds something new, with a further

purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.' [Citation.] Although such transformative use is not absolutely necessary for a finding of fair use, [citation], the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works." (*Campbell v. Acuff-Rose Music, Inc.* (1994) 510 U.S. 569, 579 [114 S.Ct. 1164, 1171, 127 L.Ed.2d 500], fn. omitted.)

This inquiry into whether a work is "transformative" appears to us to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment. As the above quotation suggests, both the First Amendment and copyright law have a common goal of encouragement of free expression and creativity, the former by protecting such expression from *405 government interference, the latter by protecting the creative fruits of intellectual and artistic labor. (See 1 Nimmer on Copyright (2000 ed.) § 1.10, pp. 1-66.43 to 1-66.44 (Nimmer).) The right of publicity, at least theoretically, shares this goal with copyright law. (1 McCarthy, *supra*, § 2.6, pp. 2-14 to 2-19.) When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain,^{FN9} directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. (See *Zacchini, supra*, 433 U.S. at pp. 575-576 [97 S.Ct. at pp. 2857-2858].)

FN9 Inquiry into the "purpose and character" of the work in copyright law also includes "whether such use is of a commercial nature or is for nonprofit educational purposes." (17 U.S.C. § 107(1).) It could be argued that reproduction of a celebrity likeness for noncommercial use—e.g., T-shirts of a recently deceased rock musician produced by a fan as a not-for-profit tribute—is a form of personal expression and therefore more worthy of First Amendment protection. This is an issue, however, that we need not decide in this case. It is undisputed that Saderup sold his reproductions for financial gain.

On the other hand, when a work contains significant

transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity. As has been observed, works of parody or other distortions of the celebrity figure are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect. (See *Cardtoons v. Major League Baseball Players* (10th Cir. 1996) 95 F.3d 959, 974 (*Cardtoons*)). Accordingly, First Amendment protection of such works outweighs whatever interest the state may have in enforcing the right of publicity. The right-of-publicity holder continues to enforce the right to monopolize the production of conventional, more or less fungible, images of the celebrity. ^{FN10} *406

FN10 There is a fourth factor in the fair use test not yet mentioned, "the effect of the use upon the potential market for or value of the copyrighted work" (17 U.S.C. § 107(4)), that bears directly on this question. We do not believe, however, that consideration of this factor would usefully supplement the test articulated here. If it is determined that a work is worthy of First Amendment protection because added creative elements significantly transform the celebrity depiction, then independent inquiry into whether or not that work is cutting into the market for the celebrity's images—something that might be particularly difficult to ascertain in the right of publicity context (see *Madow, supra*, 81 Cal. L.Rev. at pp. 221-222)—appears to be irrelevant. Moreover, this "potential market" test has been criticized for circularity: it could be argued that if a defendant has capitalized in any way on a celebrity's image, he or she has found a potential market and therefore could be liable for such work. (See 4 Nimmer, *supra*, § 13.05[A][4], pp. 13-183 to 13-184.) The "transformative" test elaborated in this opinion will, we conclude, protect the right-of-publicity holder's core interest in monopolizing the merchandising of celebrity images without unnecessarily impinging on the artists' right of free expression.

Cardtoons, supra, 95 F.3d 959, cited by *Saderup*, is consistent with this "transformative" test. There, the court held that the First Amendment protected a company that produced trading cards caricaturing and parodying well-known major league baseball players against a claim brought under the Oklahoma right of publicity statute. The court concluded that "[t]he cards provide social commentary on public figures, major league baseball players, who are involved in a significant commercial enterprise, major league baseball," and that "[t]he cards are no less protected because they provide humorous rather than serious commentary." (*Cardtoons*, at p. 969.) The *Cardtoons* court weighed these First Amendment rights against what it concluded was the less-than-compelling interests advanced by the right of publicity outside the advertising context—especially in light of the reality that parody would not likely substantially impact the economic interests of celebrities—and found the cards to be a form of protected expression. (*Cardtoons*, at pp. 973-976.) While *Cardtoons* contained dicta calling into question the social value of the right of publicity, its conclusion that works parodying and caricaturing celebrities are protected by the First Amendment appears unassailable in light of the test articulated above.

(4) We emphasize that the transformative elements or creative contributions that require First Amendment protection are not confined to parody and can take many forms, from factual reporting (see, e.g., *Rosemont Enterprises, Inc. v. Random House, Inc.* (1968) 58 Misc.2d 1 [294 N.Y.S.2d 122, 129], *affd.* mem. (1969) 32 A.D.2d 892 [301 N.Y.S.2d 948]) to fictionalized portrayal (*Guglielmi, supra*, 25 Cal.3d at pp. 871-872; see also *Parks v. Laface Records* (E.D.Mich. 1999) 76 F.Supp.2d 775, 779-782 [use of civil rights figure Rosa Parks in song title is protected expression]), from heavy-handed lampooning (see *Hustler Magazine v. Falwell* (1988) 485 U.S. 46 [108 S.Ct. 876, 99 L.Ed.2d 41]) to subtle social criticism (see *Coplans et al., Andy Warhol* (1970) pp. 50-52 [explaining Warhol's celebrity portraits as a critique of the celebrity phenomenon]).

Another way of stating the inquiry is whether the celebrity likeness is one of the "raw materials" from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celeb-

rity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness. And when we use the word "expression," we mean expression of something other than the likeness of the celebrity. *407

We further emphasize that in determining whether the work is transformative, courts are not to be concerned with the quality of the artistic contribution—vulgar forms of expression fully qualify for First Amendment protection. (See, e.g., *Hustler Magazine v. Falwell*, *supra*, 485 U.S. 46; see also *Campbell v. Acuff-Rose Music, Inc.*, *supra*, 510 U.S. at p. 582 [114 S.Ct. at p. 1173].) On the other hand, a literal depiction of a celebrity, even if accomplished with great skill, may still be subject to a right of publicity challenge. The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.

FN11

FN11 *Saderup* also cites *ETW Corp. v. Jireh Publishing, Inc.* (N.D. Ohio 2000) 99 F.Supp.2d 829, 835-836, in which the court held that a painting consisting of a montage of likenesses of the well-known professional golfer Eldridge "Tiger" Woods, reproduced in 5,000 prints, was a work of art and therefore protected under the First Amendment. We disagree with the *ETW Corp.* court if its holding is taken to mean that any work of art, however much it trespasses on the right of publicity and however much it lacks additional creative elements, is categorically shielded from liability by the First Amendment. Whether the work in question in that case would be judged to be exempt from California's right of publicity, either under the First Amendment test articulated in this opinion or under the statutory exception for material of newsworthy value, is, of course, beyond the scope of this opinion.

Furthermore, in determining whether a work is sufficiently transformative, courts may find useful a subsidiary inquiry, particularly in close cases: does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted? If this question is answered in the negative, then there would generally be no actionable right of publicity. When the value of the work comes princi-

pally from some source other than the fame of the celebrity—from the creativity, skill, and reputation of the artist—it may be presumed that sufficient transformative elements are present to warrant First Amendment protection. If the question is answered in the affirmative, however, it does not necessarily follow that the work is without First Amendment protection—it may still be a transformative work.

In sum, when an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive primarily from the celebrity's fame.

(2b) Turning to the present case, we note that the trial court, in ruling against *Saderup*, stated that "the commercial enterprise conducted by [*Saderup*] involves the sale of lithographs and T-shirts which are not original single works of art, and which are not protected by the First Amendment; the enterprise conducted by [*Saderup*] was a commercial enterprise designed to *408 generate profits solely from the use of the likeness of The Three Stooges which is the right of publicity ... protected by section 990." Although not entirely clear, the trial court seemed to be holding that reproductions of celebrity images are categorically outside First Amendment protection. The Court of Appeal was more explicit in adopting this rationale: "Simply put, although the First Amendment protects speech that is sold [citation], reproductions of an image, made to be sold for profit do not per se constitute speech." But 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. It is true that the statute at issue here makes a distinction between a single and original work of fine art and a reproduction. (§ 990, subd. (n)(3).) Because the statute evidently aims at preventing the illicit merchandising of celebrity images, and because single original works of fine art are not forms of merchandising, the state has little if any interest in preventing the exhibition and sale of such works, and the First Amendment rights of the artist should therefore prevail. But the inverse—that a reproduction receives no First Amendment protection—is patently false: a reproduction of a celebrity image that, as explained above, contains significant creative

elements is entitled to as much First Amendment protection as an original work of art. The trial court and the Court of Appeal therefore erred in this respect.

Rather, the inquiry is into whether Saderup's work is sufficiently transformative. Correctly anticipating this inquiry, he argues that all portraiture involves creative decisions, that therefore no portrait portrays a mere literal likeness, and that accordingly all portraiture, including reproductions, is protected by the First Amendment. We reject any such categorical position. Without denying that all portraiture involves the making of artistic choices, we find it equally undeniable, under the test formulated above, that when an artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist's right of free expression is outweighed by the right of publicity. As is the case with fair use in the area of copyright law, an artist depicting a celebrity must contribute something more than a " ' ' merely trivial " ' variation, [but must create] something recognizably ' ' his own " ' ' ' (*L. Bailin & Son, Inc. v. Snyder* (2d Cir. 1976) 536 F.2d 486, 490), in order to qualify for legal protection.

On the other hand, we do not hold that all reproductions of celebrity portraits are unprotected by the First Amendment. The silkscreens of Andy Warhol, for example, have as their subjects the images of such celebrities as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. Through distortion *409 and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself. (See Coplans et al., *supra*, at p. 52.)^{FN12} Such expression may well be entitled to First Amendment protection. Although the distinction between protected and unprotected expression will sometimes be subtle, it is no more so than other distinctions triers of fact are called on to make in First Amendment jurisprudence. (See, e.g., *Miller v. California* (1973) 413 U.S. 15, 24 [93 S.Ct. 2607, 2615, 37 L.Ed.2d 419] [requiring determination, in the context of work alleged to be obscene, of "whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value"].)

FN12 The novelist Don DeLillo gives this

fictional account of an encounter with Warhol's reproductions of images of Mao Zedong: "He moved along and stood finally in a room filled with images of Chairman Mao. Photocopy Mao, silk-screen Mao, wallpaper Mao, synthetic-polymer Mao. A series of silk screens was installed over a broader surface of wallpaper serigraphs, the Chairman's face a pansy purple here, floating nearly free of its photographic source. Work that was unwitting of history appealed to [him]. He found it liberating. Had he ever realized the deeper meaning of Mao before he saw these pictures?" (DeLillo, *Mao II* (1991) p. 21.)

Turning to Saderup's work, we can discern no significant transformative or creative contribution. His undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame. Indeed, were we to decide that Saderup's depictions were protected by the First Amendment, we cannot perceive how the right of publicity would remain a viable right other than in cases of falsified celebrity endorsements.

Moreover, the marketability and economic value of Saderup's work derives primarily from the fame of the celebrities depicted. While that fact alone does not necessarily mean the work receives no First Amendment protection, we can perceive no transformative elements in Saderup's works that would require such protection.

Saderup argues that it would be incongruous and unjust to protect parodies and other distortions of celebrity figures but not wholesome, reverential portraits of such celebrities. The test we articulate today, however, does not express a value judgment or preference for one type 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. Stated another way, we are concerned not with whether conventional celebrity images *410 should be produced but with who produces them and, more pertinently, who appropriates the value from their production. Thus, under section 990, if Saderup

wishes to continue to depict The Three Stooges as he has done, he may do so only with the consent of the right of publicity holder.

George, C. J., Kennard, J., Baxter, J., Werdegar, J., Chin, J., and Brown, J., concurred. *411

IV. Disposition

*412

The judgment of the Court of Appeal is affirmed.

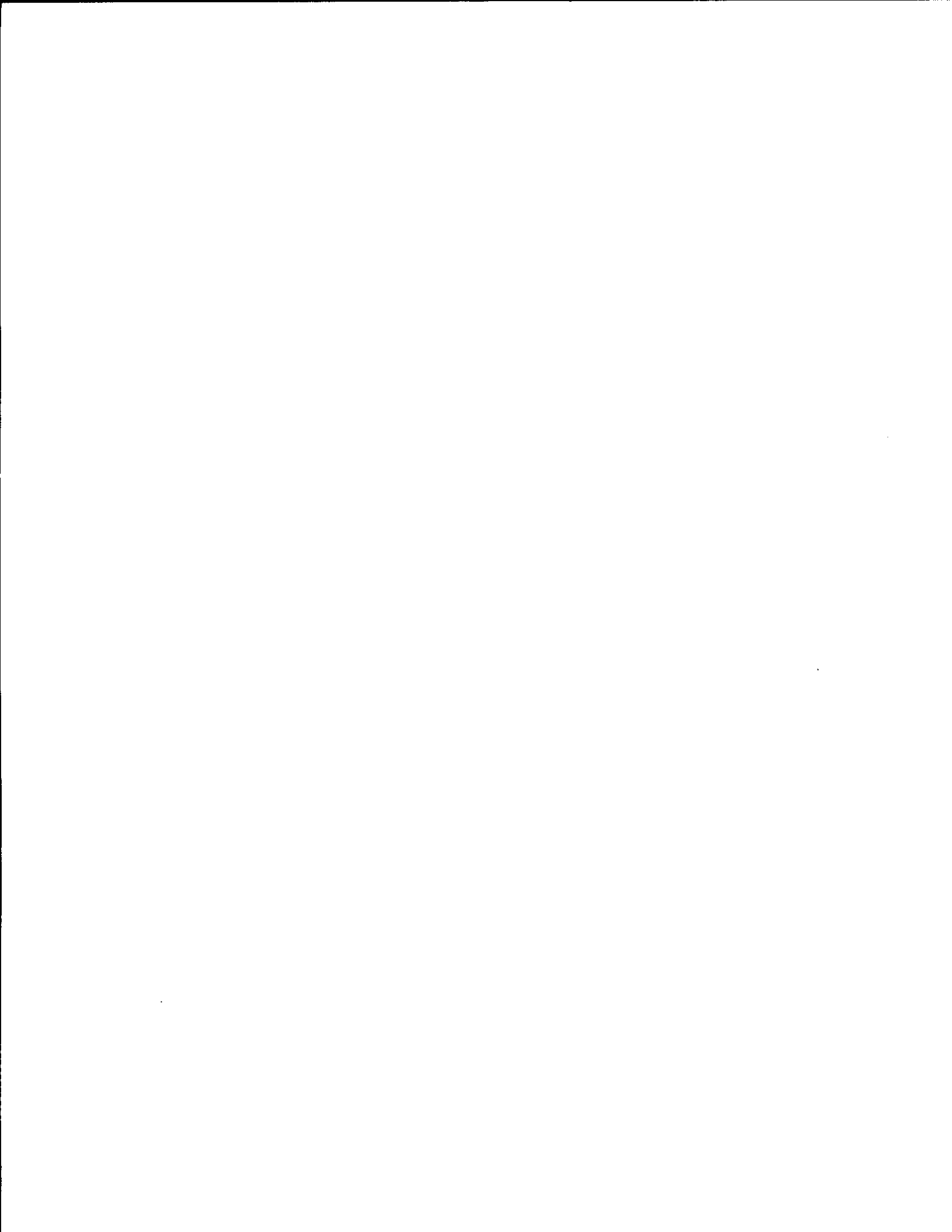
APPENDIX



Cal. 2001.

Comedy III Productions, Inc. v. Gary Saderup, Inc.
25 Cal.4th 387, 21 P.3d 797, 106 Cal.Rptr.2d 126, 58
U.S.P.Q.2d 1823, 29 Media L. Rep. 1897, 01 Cal.
Daily Op. Serv. 3380, 2001 Daily Journal D.A.R.
4163

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332 F.3d 915, 67 U.S.P.Q.2d 1065, 2003 Fed.App. 0207P
(Cite as: 332 F.3d 915)

▽

United States Court of Appeals,
Sixth Circuit.
ETW CORPORATION, Plaintiff-Appellant,
v.
JIREH PUBLISHING, INC., Defendant-Appellee.
No. 00-3584.

Argued: Sept. 14, 2001.
Decided and Filed: June 20, 2003.
Rehearing En Banc Denied Sept. 8, 2003.^{FN*,FN**}

FN* Hon. James L. Graham, United States District Judge for the Southern District of Ohio, sitting by designation.

FN** Judge Moore recused herself from participation in this ruling.

Professional athlete sued sports artist, claiming that print infringed and diluted his trademark and violated his common law right of publicity. The United States District Court for the Northern District of Ohio, Patricia A. Gaughan, J., 99 F.Supp.2d 829, granted summary judgment for artist, and appeal was taken. The Court of Appeals, Graham, District Judge, sitting by designation, held that: (1) use of athlete's trademarked name was noninfringing fair use; (2) athlete's image was not protected; and (3) print was entitled to First Amendment protection.

Affirmed.

Clay, Circuit Judge, dissented and filed opinion.

West Headnotes

[1] Federal Courts 170B ↪776

170B Federal Courts
170BVIII Courts of Appeals
170BVIII(K) Scope, Standards, and Extent
170BVIII(K)1 In General
170Bk776 k. Trial De Novo. Most Cited Cases
District court's grant of summary judgment is re-

viewed de novo.

[2] Federal Civil Procedure 170A ↪2466

170A Federal Civil Procedure
170AXVII Judgment
170AXVII(C) Summary Judgment
170AXVII(C)1 In General
170Ak2465 Matters Affecting Right to Judgment
170Ak2466 k. Lack of Cause of Action or Defense. Most Cited Cases

Federal Civil Procedure 170A ↪2470.4

170A Federal Civil Procedure
170AXVII Judgment
170AXVII(C) Summary Judgment
170AXVII(C)1 In General
170Ak2465 Matters Affecting Right to Judgment
170Ak2470.4 k. Right to Judgment as Matter of Law. Most Cited Cases
Central issue on motion for summary judgment is whether evidence presents sufficient disagreement to require submission to jury or whether it is so one-sided that one party must prevail as matter of law. Fed.Rules Civ.Proc.Rule 56(c), 28 U.S.C.A.

[3] Trademarks 382T ↪1421

382T Trademarks
382TVIII Violations of Rights
382TVIII(A) In General
382Tk1418 Practices or Conduct Prohibited in General; Elements
382Tk1421 k. Infringement. Most Cited Cases
(Formerly 382k334.1 Trade Regulation)
Trademark infringement claims under Ohio law follow same analysis as those under Lanham Act. Lanham Trade-Mark Act, § 32, as amended, 15 U.S.C.A. § 1114.

[4] Trademarks 382T ↪1523(2)

382T Trademarks

332 F.3d 915, 67 U.S.P.Q.2d 1065, 2003 Fed.App. 0207P
(Cite as: 332 F.3d 915)

382TVIII Violations of Rights

382TVIII(D) Defenses, Excuses, and Justifications

382Tk1521 Justified or Permissible Uses

382Tk1523 Identification or Description

382Tk1523(2) k. Of One's Own Product; Fair Use. Most Cited Cases

(Formerly 382k375.1 Trade Regulation)

Use of professional athlete's trademarked name on back of envelope containing artist's print and in narrative description of the print was noninfringing fair use; use was purely descriptive and there was no evidence of bad faith. Lanham Trade-Mark Act, § 33(b)(4), as amended, 15 U.S.C.A. § 1115(b)(4).

[5] Trademarks 382T ↪1421

382T Trademarks

382TVIII Violations of Rights

382TVIII(A) In General

382Tk1418 Practices or Conduct Prohibited in General; Elements

382Tk1421 k. Infringement. Most Cited Cases

(Formerly 382k331 Trade Regulation)

Section of the Lanham Act which provides federal cause of action for infringement of unregistered trademark affords such marks essentially same protection as those that are registered. Lanham Trade-Mark Act, §§ 32, 43(a), as amended, 15 U.S.C.A. §§ 1114, 1125(a).

[6] Trademarks 382T ↪1028

382T Trademarks

382TII Marks Protected

382Tk1028 k. Indication of Origin or Ownership; Identification. Most Cited Cases

(Formerly 382k11 Trade Regulation)

Trademarks 382T ↪1030

382T Trademarks

382TII Marks Protected

382Tk1029 Capacity to Distinguish or Signify; Distinctiveness

382Tk1030 k. In General. Most Cited Cases

(Formerly 382k11 Trade Regulation)

To be protectable as trademark, word, name, symbol or device in question must perform job of identification, i.e., to identify one source and to distinguish it from other sources.

[7] Trademarks 382T ↪1186

382T Trademarks

382TVI Nature, Extent, and Disposition of Rights

382Tk1186 k. Rights in Gross; Relation of Mark to Good Will or Business in General. Most Cited Cases

(Formerly 382k1 Trade Regulation)

Trademark, unlike copyright or patent, is not "right in gross" that enables holder to enjoin all reproductions.

[8] Trademarks 382T ↪1057(1)

382T Trademarks

382TII Marks Protected

382Tk1050 Format or Components of Term or Mark

382Tk1057 Nonliteral Elements

382Tk1057(1) k. In General. Most Cited Cases

(Formerly 382k34 Trade Regulation)

Generally, person's image or likeness cannot function as trademark. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[9] Antitrust and Trade Regulation 29T ↪30

29T Antitrust and Trade Regulation

29TII Unfair Competition

29TII(A) In General

29Tk30 k. Sponsorship, Approval, or Connection, Representations Concerning. Most Cited Cases

(Formerly 382k862.1 Trade Regulation)

Elements of Lanham Act false endorsement claim are similar to elements of right of publicity claim under Ohio law. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[10] Constitutional Law 92 ↪1490

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(A) In General

332 F.3d 915, 67 U.S.P.Q.2d 1065, 2003 Fed.App. 0207P
(Cite as: 332 F.3d 915)

92XVIII(A)1 In General

92k1490 k. In General. Most Cited

Cases

(Formerly 92k90.1(1))

Constitutional Law 92 ↪ 1545

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(A) In General

92XVIII(A)3 Particular Issues and Applications in General

92k1545 k. In General. Most Cited

Cases

(Formerly 92k90.1(1), 92k90(1))

Protection of First Amendment is not limited to written or spoken words, but includes other mediums of expression, including music, pictures, films, photographs, paintings, drawings, engravings, prints, and sculptures. U.S.C.A. Const.Amend. 1.

[11] Constitutional Law 92 ↪ 1535

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(A) In General

92XVIII(A)2 Commercial Speech in General

92k1535 k. In General. Most Cited

Cases

(Formerly 92k90.2)

Speech is protected by First Amendment, even though it is carried in form that is sold for profit. U.S.C.A. Const.Amend. 1.

[12] Constitutional Law 92 ↪ 1490

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(A) In General

92XVIII(A)1 In General

92k1490 k. In General. Most Cited

Cases

(Formerly 92k90.2)

Constitutional Law 92 ↪ 1535

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(A) In General

92XVIII(A)2 Commercial Speech in General

92k1535 k. In General. Most Cited

Cases

(Formerly 92k90.2)

Fact that expressive materials are sold does not diminish degree of protection to which they are entitled under First Amendment. U.S.C.A. Const.Amend. 1.

[13] Constitutional Law 92 ↪ 1545

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(A) In General

92XVIII(A)3 Particular Issues and Applications in General

92k1545 k. In General. Most Cited

Cases

(Formerly 92k90.1(1))

Publishers disseminating work of others who create expressive materials come wholly within protective shield of First Amendment. U.S.C.A. Const.Amend. 1.

[14] Antitrust and Trade Regulation 29T ↪ 30

29T Antitrust and Trade Regulation

29TII Unfair Competition

29TII(A) In General

29Tk30 k. Sponsorship, Approval, or Connection, Representations Concerning. Most Cited Cases

(Formerly 382k401 Trade Regulation)

False endorsement, as proscribed under Lanham Act, occurs when celebrity's identity is connected with product or service in such manner that consumers are likely to be misled about celebrity's sponsorship or approval of product or service. Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[15] Antitrust and Trade Regulation 29T ↪ 30

29T Antitrust and Trade Regulation

29TII Unfair Competition

29TII(A) In General

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29Tk30 k. Sponsorship, Approval, or Connection, Representations Concerning. Most Cited Cases
(Formerly 382k401 Trade Regulation)

Constitutional Law 92 ↪1630

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(D) False Statements in General

92k1630 k. Right of Publicity; Misappropriation of Likeness, Name, or Celebrity Status. Most Cited Cases

(Formerly 92k90.1(1), 382k401 Trade Regulation)
Where false endorsement defendant has articulated colorable claim that use of celebrity's identity is protected by First Amendment, likelihood of confusion test is not appropriate; rather, in such cases, public interest in free expression prevails if use of celebrity's image has artistic relevance, unless it is used in such a way that it explicitly misleads as to source of work. U.S.C.A. Const.Amend. 1; Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[16] Antitrust and Trade Regulation 29T ↪22

29T Antitrust and Trade Regulation

29TII Unfair Competition

29TII(A) In General

29Tk21 Advertising, Marketing, and Promotion

29Tk22 k. In General. Most Cited Cases

(Formerly 382k862.1 Trade Regulation)

Torts 379 ↪383

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k383 k. In General. Most Cited Cases

(Formerly 379k8.5(6))

Right of publicity is creature of state law, and its violation gives rise to cause of action for commercial tort of unfair competition.

[17] Antitrust and Trade Regulation 29T ↪30

29T Antitrust and Trade Regulation

29TII Unfair Competition

29TII(A) In General

29Tk30 k. Sponsorship, Approval, or Connection, Representations Concerning. Most Cited Cases

(Formerly 382k401 Trade Regulation)

Constitutional Law 92 ↪1630

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(D) False Statements in General

92k1630 k. Right of Publicity; Misappropriation of Likeness, Name, or Celebrity Status. Most Cited Cases

(Formerly 92k90.1(1))

First Amendment protection afforded to limited edition print of painting by sports artist, depicting professional golfer's tournament victory, precluded golfer's Lanham Act false endorsement claim; presence of golfer's image in painting had artistic relevance, and it did not explicitly mislead as to source of work. U.S.C.A. Const.Amend. 1; Lanham Trade-Mark Act, § 43(a), as amended, 15 U.S.C.A. § 1125(a).

[18] Constitutional Law 92 ↪1630

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(D) False Statements in General

92k1630 k. Right of Publicity; Misappropriation of Likeness, Name, or Celebrity Status. Most Cited Cases

(Formerly 92k90.1(1))

Torts 379 ↪391

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k391 k. Defenses in General. Most Cited Cases

(Formerly 379k8.5(6))

First Amendment protection afforded to limited edition print of painting by sports artist, depicting pro-

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professional golfer's tournament victory, trumped athlete's interest in his image under Ohio common law right of publicity. U.S.C.A. Const. Amend. 1.

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Before SILER and CLAY, Circuit Judges; GRAHAM, District Judge. ^{FN***}

^{FN***} The Honorable James L. Graham, United States District Judge for the Southern

District of Ohio, sitting by designation.

GRAHAM, D.J., delivered the opinion of the court, in which SILER, J., joined. CLAY, J. (pp. 938-960), delivered a separate dissenting opinion.

OPINION

GRAHAM, District Judge.

Plaintiff-Appellant ETW Corporation ("ETW") is the licensing agent of Eldrick "Tiger" Woods ("Woods"), one of the world's most famous professional golfers. Woods, chairman of the board of ETW, has assigned to it the exclusive right to exploit his name, image, likeness, and signature, and all other publicity rights. ETW owns a United States trademark registration for the mark "TIGER WOODS" (Registration No. 2,194,381) for use in connection with "art prints, calendars, mounted photographs, notebooks, pencils, pens, posters, trading cards, and unmounted photographs."

Defendant-Appellee Jireh Publishing, Inc. ("Jireh") of Tuscaloosa, Alabama, is the publisher of artwork created by Rick Rush ("Rush"). Rush, who refers to himself as "America's sports artist," has created paintings of famous figures in sports and famous sports events. A few examples include Michael Jordan, Mark McGuire, Coach Paul "Bear" Bryant, the Pebble Beach Golf Tournament, and the America's Cup Yacht Race. Jireh has produced and successfully marketed limited edition art prints made from Rush's paintings.

In 1998, Rush created a painting entitled *The Masters of Augusta*, which commemorates Woods's victory at the Masters Tournament in Augusta, Georgia, in 1997. At that event, Woods became the youngest player ever to win the Masters Tournament, while setting a 72-hole record for the tournament and a record 12-stroke margin of victory. In the foreground of Rush's painting are three views of Woods in different poses. In the center, he is completing the swing of a golf club, and on each side he is crouching, lining up and/or observing the progress of a putt. To the left of Woods is his caddy, Mike "Fluff" Cowan, and to his right is his final round partner's caddy. Behind these figures is the Augusta National Clubhouse. In a blue background behind the clubhouse are likenesses of famous golfers of the past looking down on

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Woods. These include Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones, and Jack Nicklaus. Behind them is the Masters leader board.

The limited edition prints distributed by Jireh consist of an image of Rush's painting which includes Rush's signature at the bottom right hand corner. Beneath the image of the painting, in block letters, is its title, "The Masters Of Augusta." Beneath the title, in block letters of equal height, is the artist's name, "Rick Rush," and beneath the artist's name, in smaller upper and lower case letters, is the legend "Painting America Through Sports."

As sold by Jireh, the limited edition prints are enclosed in a white envelope, accompanied with literature which includes a large photograph of Rush, a description of his art, and a narrative description of the subject painting. On the front of the envelope, Rush's name appears in block *919 letters inside a rectangle, which includes the legend "Painting America Through Sports." Along the bottom is a large reproduction of Rush's signature two inches high and ten inches long. On the back of the envelope, under the flap, are the words "Masters of Augusta" in letters that are three-eighths of an inch high, and "Tiger Woods" in letters that are one-fourth of an inch high. Woods's name also appears in the narrative description of the painting where he is mentioned twice in twenty-eight lines of text. The text also includes references to the six other famous golfers depicted in the background of the painting as well as the two caddies.^{FN1} Jireh published and marketed two hundred and fifty 22 1/2 " x 30" serigraphs and five thousand 9" x 11" lithographs of *The Masters of Augusta* at an issuing price of \$700 for the serigraphs and \$100 for the lithographs.

^{FN1}. The narrative reads as follows: **The Masters of Augusta** Undeniably, the essence of golf is Augusta National, The Masters. And, as sure as Spring itself, when the azaleas' plethora of color burst upon this uniquely manicured playground of golf's greatest, an almost heavenly awe overtakes the crowd. Because there is something about Augusta—a golden thread of nostalgia that weaves its way through the entire spectacle. Something will happen here that has happened for decades. Greatness will emerge. A Tiger Woods will unleash an incomparable

swing and bury his opponents in his wake.

Amid the memorable hanging baskets of the Augusta National Clubhouse, Ben Hogan's Bridge, the 13th rock wall, and the dazzling floral logo that greets each guest, a star is born, and he's for real. And attesting from the Leader Board are the men who have formed a golfer's "field of dreams."

Men like Arnold Palmer with his omnipresent "Arnie's Army" roaring its approval; there's flamboyant Slammin' Sammy Snead or the irrepressible Ben Hogan; of course, you'll find Walter Hagen, who played his first Masters in 1934. And who can forget Bobby Jones, a truly great one, who always played as an amateur here, never as a professional. Last there's the Golden Bear, Jack Nicklaus, standing tall with six Masters to his credit, a man whose golfing prowess sets him apart from mere mortals.

But the center of their gaze is 1997 winner Tiger Woods, here flanked by his caddie, "Fluff", and final round player partner's (Constantino Rocca) caddie on right, displaying that awesome swing that sends a golf ball straighter and truer than should be humanly possible. Only his uncanny putting ability serves to complete his dominating performance that lifts him alongside the Masters of Augusta.

In this unique work of art, America's Sports Artist, Rick Rush has blended the charm and boastful beauty of nature with the magnificence of a gilded golfing history and unabashed power and confidence of youth to deliver a masterpiece: "The Masters of Augusta."

ETW filed suit against Jireh on June 26, 1998, in the United States District Court for the Northern District of Ohio, alleging trademark infringement in violation of the Lanham Act, 15 U.S.C. § 1114; dilution of the mark under the Lanham Act, 15 U.S.C. § 1125(c); unfair competition and false advertising under the Lanham Act, 15 U.S.C. § 1125(a); unfair competition

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and deceptive trade practices under Ohio Revised Code § 4165.01; unfair competition and trademark infringement under Ohio common law; and violation of Woods's right of publicity under Ohio common law. Jireh counterclaimed, seeking a declaratory judgment that Rush's art prints are protected by the First Amendment and do not violate the Lanham Act. Both parties moved for summary judgment.

The district court granted Jireh's motion for summary judgment and dismissed the case. *See ETW Corp. v. Jireh Pub., Inc.*, 99 F.Supp.2d 829 (N.D. Ohio 2000). ETW timely perfected an appeal to this court.

I. Standard of Review

[1][2] We review the district court's grant of summary judgment de novo. **920 Sperle v. Michigan Dep't of Corr.*, 297 F.3d 483, 490 (6th Cir.2002). Summary judgment is proper where there exists no issue of material fact and the moving party is entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c). In considering such a motion, the court construes all reasonable factual inferences in favor of the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986). The central issue is "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986).

II. Trademark Claims Based on the Unauthorized Use of the Registered Trademark "Tiger Woods"

[3] ETW claims that the prints of Rush's work constitute the unauthorized use of a registered trademark in violation of the Lanham Act, 15 U.S.C. § 1114, and Ohio law. Because trademark claims under Ohio law follow the same analysis as those under the Lanham Act, our discussion of the federal trademark claims will therefore encompass the state trademark claims as well.^{FN2} *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 754 (6th Cir.1998)(citing *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr.*, 109 F.3d 275, 288 (6th Cir.1997)).

^{FN2}. ETW acknowledges that the court need not separately address its state law

claims for trademark infringement, unfair competition and deceptive trade practices. *See* Final Brief of ETW, p. 31 n. 17.

ETW claims that Jireh infringed the registered mark "Tiger Woods" by including these words in marketing materials which accompanied the prints of Rush's painting. The words "Tiger Woods" do not appear on the face of the prints, nor are they included in the title of the painting. The words "Tiger Woods" do appear under the flap of the envelopes which contain the prints, and Woods is mentioned twice in the narrative which accompanies the prints.

The Lanham Act provides a defense to an infringement claim where the use of the mark "is a use, otherwise than as a mark, ... which is descriptive of and used fairly and in good faith only to describe the goods ... of such party [.]" 15 U.S.C. § 1115(b)(4); *see San Francisco Arts and Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 565, 107 S.Ct. 2971, 97 L.Ed.2d 427 (1987); *Herman Miller, Inc. v. Palazzetti Imports and Exports, Inc.*, 270 F.3d 298, 319 (6th Cir.2001)("Under the doctrine of 'fair use,' the holder of a trademark cannot prevent others from using the word that forms the trademark in its primary or descriptive sense.")(emphasis in the original); *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 270 (2nd Cir.1995)("[F]air use permits others to use a protected mark to describe aspects of their own goods [.]"). In evaluating a defendant's fair use defense, a court must consider whether defendant has used the mark: (1) in its descriptive sense; and (2) in good faith. *Victoria's Secret Stores v. Artco Equip. Co.*, 194 F.Supp.2d 704, 724 (S.D. Ohio 2002); *see also Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir.2002).

[4] A celebrity's name may be used in the title of an artistic work so long as there is some artistic relevance. *See Rogers v. Grimaldi*, 875 F.2d 994, 997 (2nd Cir.1989); *New York Racing Ass'n v. Perlmutter Publ'g, Inc.*, No. 95-CV-994, 1996 WL 465298 at *4 (N.D.N.Y. July 19, 1996) (finding the use of a registered mark on the title of a painting protected by the First Amendment). The use of Woods's *921 name on the back of the envelope containing the print and in the narrative description of the print are purely descriptive and there is nothing to indicate that they were used other than in good faith. The prints, the envelopes which contain them, and the narrative ma-

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terials which accompany them clearly identify Rush as the source of the print.^{FN3} Woods is mentioned only to describe the content of the print.

FN3. ETW's survey evidence on likelihood of confusion was limited to the prints of Rush's painting and did not include the materials which used Woods's name.

The district court properly granted summary judgment on ETW's claim for violation of its registered mark, "Tiger Woods," on the grounds that the claim was barred by the fair use defense as a matter of law.^{FN4}

FN4. The dissent misunderstands the basis for our holding that defendant's use of the registered mark "Tiger Woods" is not infringing. We find only that defendant's use of the mark was a fair use under established trademark law. This finding is not linked in any way with our separate finding that defendant's use of Woods's image was not an infringement of plaintiff's claimed unregistered trademark in all images and likenesses of Woods. The dissent's discussion of plaintiff's evidence of consumer confusion in connection with plaintiff's claim of violation of the registered trademark "Tiger Woods" is inapposite because the survey subjects were shown only the Rush print, which does not contain the words "Tiger Woods."

III. Trademark Claims Under 15 U.S.C. § 1125(a) Based on the Unauthorized Use of the Likeness of Tiger Woods

Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), provides "a right of action to persons engaged in interstate and foreign commerce, against deceptive and misleading use of words, names, symbols, or devices, or any combination thereof, which have been adopted by a ... merchant to identify his goods and distinguish them from those manufactured by others[.]" Federal-Mogul-Bower Bearings, Inc. v. Azoff, 313 F.2d 405, 408 (6th Cir.1963); see also Frisch's Restaurant, Inc. v. Shoney's, Inc., 759 F.2d 1261, 1264 (6th Cir.1985); Frisch's Restaurants, Inc. v. Elby's Big Boy of Steubenville, Inc., 670 F.2d 642, 647 (6th Cir.), cert. denied, 459 U.S. 916, 103 S.Ct. 231, 74 L.Ed.2d 182 (1982).

[5] ETW has registered Woods's name as a trademark, but it has not registered any image or likeness of Woods. Nevertheless, ETW claims to have trademark rights in Woods's image and likeness. Section 43(a) of the Lanham Act provides a federal cause of action for infringement of an unregistered trademark which affords such marks essentially the same protection as those that are registered. See Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992)("[I]t is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).").

[6] The Lanham Act defines a trademark as including "any word, name, symbol, or device, or any combination thereof" used by a person "to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127. The essence of a trademark is a designation in the form of a distinguishing name, symbol or device which is used to identify a person's goods and distinguish them from the goods of another. See Taco Cabana, 505 U.S. at 768, 112 S.Ct. 2753 *922 ("In order to be [protected], a mark must be capable of distinguishing the [owner's] goods from those of others."). Not every word, name, symbol or device qualifies as a protectable mark; rather, it must be proven that it performs the job of identification, i.e., to identify one source and to distinguish it from other sources. If it does not do this, then it is not protectable as a trademark. See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 3:1 (2002).

[7] "[A] trademark, unlike a copyright or patent, is not a 'right in gross' that enables a holder to enjoin all reproductions." Boston Athletic Ass'n v. Sullivan, 867 F.2d 22, 35 (1st Cir.1989)(citing Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1374 (Fed.Cir.1983)).

Here, ETW claims protection under the Lanham Act for any and all images of Tiger Woods.^{FN5} This is an untenable claim. ETW asks us, in effect, to constitute Woods himself as a walking, talking trademark. Im-

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ages and likenesses of Woods are not protectable as a trademark because they do not perform the trademark function of designation. They do not distinguish and identify the source of goods. They cannot function as a trademark because there are undoubtedly thousands of images and likenesses of Woods taken by countless photographers, and drawn, sketched, or painted by numerous artists, which have been published in many forms of media, and sold and distributed throughout the world. No reasonable person could believe that merely because these photographs or paintings contain Woods's likeness or image, they all originated with Woods.

FN5. The dissent states that we have incorrectly characterized plaintiff's claim, and that the plaintiff is not seeking to protect any and all images of Woods, but only the image which appears in Rush's print, and that there is "at the very least ... a question of fact ... as to whether Woods has used this image as a trademark...." We stand by our characterization of plaintiff's claim. Plaintiff's first amended complaint does not allege that Woods has used any specific image or likeness as a trademark. There is no evidence in the record that Woods has consistently used any specific image or likeness as a trademark. As the district court correctly pointed out, all of the images of Woods which were submitted by the plaintiff in the course of the summary judgment proceedings are different. The image of Woods in the Nike poster referred to in the dissent is readily distinguishable from the central image in the Rush print. It features, among other things, a different facial expression, a different position of the hands, and a different position of the golf club. Finally, we note that there is not just one but three very different images of Woods in the Rush print: one standing and swinging a club, and two crouching—one with hands on the ball and club, and the other with hands over eyes. Plaintiff claims that all three violated its unregistered trademark in Woods's likeness and image.

[8] We hold that, as a general rule, a person's image or likeness cannot function as a trademark. Our conclusion is supported by the decisions of other courts which have addressed this issue. In Pirone v. Mac-

Millan, Inc., 894 F.2d 579 (2nd Cir.1990), the Second Circuit rejected a trademark claim asserted by the daughters of baseball legend Babe Ruth. The plaintiffs objected to the use of Ruth's likeness in three photographs which appeared in a calendar published by the defendant. The court rejected their claim, holding that "a photograph of a human being, unlike a portrait of a fanciful cartoon character, is not inherently 'distinctive' in the trademark sense of tending to indicate origin." Id. at 583. The court noted that Ruth "was one of the most photographed men of his generation, a larger than life hero to millions and an historical figure[.]" Id. The Second Circuit Court concluded that a consumer *923 could not reasonably believe that Ruth sponsored the calendar:

[A]n ordinarily prudent purchaser would have no difficulty discerning that these photos are merely the subject matter of the calendar and do not in any way indicate sponsorship. No reasonable jury could find a likelihood of confusion.

Id. at 585. The court observed that "[u]nder some circumstances, a photograph of a person may be a valid trademark-if, for example, a particular photograph was consistently used on specific goods." Id. at 583. The court rejected plaintiffs' assertion of trademark rights in every photograph of Ruth.

In Estate of Presley v. Russen, 513 F.Supp. 1339, 1363-1364 (D.N.J.1981), the court rejected a claim by the estate of Elvis Presley that his image and likeness was a valid mark. The court did find, however, as suggested by the Second Circuit in Pirone, that one particular image of Presley had been consistently used in the advertising and sale of Elvis Presley entertainment services to identify those services and that the image could likely be found to function as a mark.

In Rock and Roll Hall of Fame, the plaintiff asserted trademark rights in the design of the building which houses the Rock and Roll Hall of Fame in Cleveland, Ohio, and claimed that defendant's poster featuring a photograph of the museum against a colorful sunset was a violation of its trademark rights. 134 F.3d at 751. This court, with one judge dissenting, reversed the judgment of the district court which granted plaintiff's request for a preliminary injunction. After reviewing the evidence, the majority concluded:

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In reviewing the Museum's disparate uses of several different perspectives of its building design, we cannot conclude that they create a consistent and distinct commercial impression as an indicator of a single source of origin or sponsorship. To be more specific, we cannot conclude on this record that it is likely that the Museum has established a valid trademark in every photograph which, like Gentile's, prominently displays the front of the Museum's building.

Id. at 755. In reaching this conclusion, this court approved and followed *Pirone* and *Estate of Presley*.

Here, ETW does not claim that a particular photograph of Woods has been consistently used on specific goods.^{FN6} Instead, ETW's claim is identical to that of the plaintiffs in *Pirone*, a sweeping claim to trademark rights in every photograph and image of Woods. Woods, like Ruth, is one of the most photographed sports figures of his generation, but this alone does not suffice to create a trademark claim.

^{FN6}. We disagree with the dissent's conclusion that the results of plaintiff's consumer confusion survey, in which the respondents were shown only the Rush print, show that the plaintiff has used a specific image of Woods as a trademark.

The district court properly granted summary judgment on ETW's claim of trademark rights in all images and likenesses of Tiger Woods.^{FN7}

^{FN7}. This includes ETW's claims of dilution under 15 U.S.C. § 1125(c). Because Woods's likeness does not function as a trademark which is subject to protection under the Lanham Act, it follows that a dilution claim does not lie. The dissent has correctly noted that Woods's dilution claim is limited to the registered mark "Tiger Woods". That claim would be precluded by the fair use doctrine as discussed in Part II above. Furthermore, unlike the dissent, we conclude that plaintiff's consumer survey evidence cannot support plaintiff's claim of dilution of its registered mark because the survey respondents were not shown any materials which included the registered mark.

***924 IV. Lanham Act Unfair Competition and False Endorsement Claims, Ohio Right to Privacy Claims, and the First Amendment Defense**

A. Introduction

[9] ETW's claims under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), include claims of unfair competition and false advertising in the nature of false endorsement. ETW has also asserted a claim for infringement of the right of publicity under Ohio law. 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. See Bruce P. Keller, *The Right Of Publicity: Past, Present, and Future*, 1207 PLI Corp. Law and Prac. Handbook, 159, 170 (October 2000). Therefore, cases which address both these types of claims should be instructive in determining whether Jireh is entitled to summary judgment on those claims.

In addition, Jireh has raised the First Amendment as a defense to all of ETW's claims, arguing that Rush's use of Woods's image in his painting is protected expression. Cases involving Lanham Act false endorsement claims and state law claims of the right of publicity have considered the impact of the First Amendment on those types of claims. We will begin with a discussion of the scope of First Amendment rights in the context of works of art, and will then proceed to examine how First Amendment rights have been balanced against intellectual property rights in cases involving the Lanham Act and state law rights of publicity. Finally, we will apply the relevant legal principles to the facts of this case.

B. First Amendment Defense

[10] The protection of the First Amendment is not limited to written or spoken words, but includes other mediums of expression, including music, pictures, films, photographs, paintings, drawings, engravings, prints, and sculptures. See *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, 515 U.S. 557, 569, 115 S.Ct. 2338, 132 L.Ed.2d 487 (1995)("[T]he Constitution looks beyond written or spoken words as mediums of expression."); *Ward v. Rock Against Racism*, 491 U.S. 781, 790, 109 S.Ct. 2746, 105 L.Ed.2d 661 (1989) ("Music, as a form of

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expression and communication, is protected under the First Amendment.”); Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 578, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977)(“There is no doubt that entertainment, as well as news, enjoys First Amendment protection.”); Kaplan v. California, 413 U.S. 115, 119-120, 93 S.Ct. 2680, 37 L.Ed.2d 492 (1973)(“[P]ictures, films, paintings, drawings, and engravings ... have First Amendment protection[.]”); Bery v. City of New York, 97 F.3d 689, 695 (2nd Cir.1996)(“[V]isual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection.”).

[11][12] Speech is protected even though it is carried in a form that is sold for profit. See Smith v. California, 361 U.S. 147, 150, 80 S.Ct. 215, 4 L.Ed.2d 205 (1959) (“It is of course no matter that the dissemination [of books and other forms of the printed word] takes place under commercial auspices.”); see also Buckley v. Valeo, 424 U.S. 1, 96 S.Ct. 612, 46 L.Ed.2d 659 (1976)(paid advertisement); Time, Inc. v. Hill, 385 U.S. 374, 397, 87 S.Ct. 534, 17 L.Ed.2d 456 (1967) (“That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment.”*925”)(quoting Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 501-502, 72 S.Ct. 777, 96 L.Ed. 1098) (1952); New York Times Co. v. Sullivan, 376 U.S. 254, 84 S.Ct. 710, 11 L.Ed.2d 686 (1964) (solicitation to pay or contribute money). The fact that expressive materials are sold does not diminish the degree of protection to which they are entitled under the First Amendment. City of Lakewood v. Plain Dealer Publ'g Co., 486 U.S. 750, 756 n. 5, 108 S.Ct. 2138, 100 L.Ed.2d 771 (1988).

[13] Publishers disseminating the work of others who create expressive materials also come wholly within the protective shield of the First Amendment. See, e.g., Simon & Schuster, Inc. v. Members of New York State Crime Victims Bd., 502 U.S. 105, 116, 112 S.Ct. 501, 116 L.Ed.2d 476 (1991)(both the author and the publishing house are “speakers” for purposes of the First Amendment); Sullivan, 376 U.S. at 286-88, 84 S.Ct. 710 (finding New York Times fully protected by the First Amendment for publishing a paid editorial advertisement). See also First Nat'l Bank of Boston v. Bellotti, 435 U.S. 765, 782, 98 S.Ct. 1407,

55 L.Ed.2d 707 (1978).^{FN8}

FN8. 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 live performances or films produced from it.

Even pure commercial speech is entitled to significant First Amendment protection. See City of Cincinnati v. Discovery Network, Inc., 507 U.S. 410, 423, 113 S.Ct. 1505, 123 L.Ed.2d 99 (1993); Bd. of Trustees of the State University of New York v. Fox, 492 U.S. 469, 473-74, 109 S.Ct. 3028, 106 L.Ed.2d 388 (1989); Central Hudson Gas and Electric Corp. v. Pub. Serv. Comm'n of New York, 447 U.S. 557, 100 S.Ct. 2343, 65 L.Ed.2d 341 (1980); Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc., 425 U.S. 748, 96 S.Ct. 1817, 48 L.Ed.2d 346 (1976). Commercial speech is “speech which does ‘no more than propose a commercial transaction [.]’ ” Virginia State Bd. of Pharmacy, 425 U.S. at 762, 96 S.Ct. 1817 (quoting Pittsburgh Press Co. v. Pittsburgh Comm'n on Human Relations, 413 U.S. 376, 385, 93 S.Ct. 2553, 37 L.Ed.2d 669 (1973)); see also Central Hudson Gas and Electric Corp., 447 U.S. at 566, 100 S.Ct. 2343 (articulating a four part test to bring commercial speech within the protection of the First Amendment).

Rush's prints are not commercial speech. They do not propose a commercial transaction. Accordingly, they are entitled to the full protection of the First Amendment. Thus, we are called upon to decide whether Woods's intellectual property rights must yield to Rush's First Amendment rights.

C. Lanham Act False Endorsement Claim

The district court did not specifically discuss ETW's false endorsement claim in granting summary judgment to Jireh. The gist of the false endorsement claim is that the presence of Woods's image in Jireh's print implies that he has endorsed Jireh's product. See MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY, § 5:30 (2d ed.2000)(hereinafter “MCCARTHY ON PUBLICITY AND PRIVACY”). Courts have recognized false endorsement claims

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under § 43(a) of the Lanham Act where a celebrity's image or persona is used in association with a product so as to imply that the celebrity endorses the product.

[14] False endorsement occurs when a celebrity's identity is connected with a product or service in such a way that consumers are likely to be misled about the celebrity's sponsorship or approval of *926 the product or service. *See, e.g., Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir.1997)(animatronic robotic figures resembling actors in *Cheers* television program used to advertise chain of airport bars modeled on Cheers set); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir.1996)(athlete's name and accomplishments used in television advertisement for Oldsmobile automobiles); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir.1992)(imitation of singer's unique voice used in radio commercial advertising Dorito Chips); *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir.1992)(female robot bearing resemblance to television celebrity, Vanna White, turning letters in what appeared to be the "Wheel of Fortune" game show set in television commercial advertising electronics products); *Allen v. National Video, Inc.*, 610 F.Supp. 612 (S.D.N.Y.1985)(photograph of Woody Allen look-alike in national advertising campaign for video club).

In *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir.2000), we noted:

A false designation of origin claim brought by an entertainer under § 43(a) of the Lanham Act in a case such as this is equivalent to a false association or endorsement claim, *see Waits*, 978 F.2d at 1110, and the "mark" at issue is the plaintiff's identity. *See White*, 971 F.2d at 1399-1400.

Id. at 626.

[15] In the ordinary false endorsement claim, the controlling issue is likelihood of confusion. This court has formulated an eight-factor test to determine the likelihood of confusion. *See Landham*, 227 F.3d at 626; *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1186 (6th Cir.1988). However, for the reasons discussed below, we conclude that where the defendant has articulated a colorable claim that the use of a celebrity's identity is protected by the First Amendment,

the likelihood of confusion test is not appropriate because it fails to adequately consider the interests protected by the First Amendment.

In *Rogers v. Grimaldi*, 875 F.2d 994 (2nd Cir.1989), Ginger Rogers, the surviving member of one of the most famous duos in show business history, brought suit against the producers and distributors of a movie entitled *Ginger and Fred*. The film was not about Ginger Rogers and Fred Astaire, but about two fictional Italian cabaret performers who imitated Rogers and Astaire and became known in Italy as "Ginger and Fred." Rogers asserted claims under § 43(a) of the Lanham Act. The Second Circuit began its analysis by noting that "[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection." *Id.* at 997. The court concluded that "[b]ecause overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict." *Id.* at 998.

The Second Circuit court rejected Rogers' argument that First Amendment concerns are implicated only where the author has no alternative means of expression. Her argument was based on *Lloyd Corp. v. Tanner*, 407 U.S. 551, 566-67, 92 S.Ct. 2219, 33 L.Ed.2d 131 (1972), where the Supreme Court held that respondents had no First Amendment right to distribute handbills in the interior mall area of petitioner's privately-owned shopping center, noting that respondents had adequate alternative means of communication. Noting that this test had been applied by several courts in the trademark context, the *Rogers* court rejected the "no alternative means" test because it "does not sufficiently accommodate the public's interest in free expression[.]" 875 F.2d at 999. The court concluded:

*927 We believe that in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.

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Id.

Although Rogers produced some evidence of consumer confusion, the court found:

The survey evidence, even if its validity is assumed, indicates at most that some members of the public would draw the incorrect inference that Rogers had some involvement with the film. But that risk of misunderstanding, not engendered by any overt claim in the title, is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act.

Id. at 1001. The Second Circuit affirmed the district court's decision granting summary judgment to the defendants.^{FN9}

^{FN9}. The court distinguished its earlier decision in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2nd Cir.1979), saying "We do not read *Dallas Cowboys Cheerleaders* as generally precluding all consideration of First Amendment concerns whenever an allegedly infringing author has 'alternative avenues of communication.'" 875 F.2d at 999 n. 4.

In *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490, 495 (2nd Cir.1989), the Second Circuit held that the *Rogers* test is not limited to literary titles but is generally applicable to Lanham Act claims against works of artistic expression. Like *Rogers*, ETW argues that the district court should have considered whether alternative means existed for Jireh to express itself without violating Woods's intellectual property rights.^{FN10} We agree with the Second Circuit's conclusion that the "no alternative means" test does not sufficiently accommodate the public's interest in free expression.

^{FN10}. ETW argues that this court adopted the "alternative means" test in *Elvis Presley Enterprises v. Elvisly Yours, Inc.*, 936 F.2d 889 (6th Cir.1991). This is not the case. *Elvisly Yours, Inc.* involved the sale of Elvis Presley memorabilia covered by plaintiff's trademarks. Defendant asserted the defenses of laches and acquiescence. No First Amendment issues were raised. This court affirmed a permanent injunction issued by

the district court but narrowed its scope because "there are various activities that Shaw could engage in that would not violate EPE's legitimate trademark and publicity rights, such as writing a magazine article or book about Elvis Presley, or dealing in properly licensed products." *Id.* at 897.

In *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir.2002), the Ninth Circuit adopted and applied the *Rogers* test where the plaintiff asserted Lanham Act claims against the producer of a song entitled "Barbie Girl" which evoked the image of plaintiff's famous doll. The court held that in the case of expressive speech, its traditional likelihood of confusion test "fails to account for the full weight of the public's interest in free expression." 296 F.3d at 900. After expressly adopting the *Rogers* standard as its own, the court set forth the following analysis:

Applying *Rogers* to our case, we conclude that MCA's use of Barbie is not an infringement of Mattel's trademark. Under the first prong of *Rogers*, the use of Barbie in the song title clearly is relevant to the underlying work, namely, the song itself. As noted, the song is about Barbie and the values Aqua claims she represents. The song title does not *928 explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel. The *only* indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity. We therefore agree with the district court that MCA was entitled to summary judgment on this ground.

296 F.3d at 902. Thus, both the Second Circuit and the Ninth Circuit have held that in Lanham Act false endorsement cases involving artistic expression, the likelihood of confusion test does not give sufficient weight to the public interest in free expression. Both courts rejected the "no alternative means" test. They held instead that the Lanham Act should be applied to artistic works only where the public interest in avoiding confusion outweighs the public interest in free expression. They agreed that the public interest in free expression should prevail if the use of the celebrity's image has artistic relevance, unless it is used in such a way that it explicitly misleads as to the source of the work.^{FN11}

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FN11. We disagree with the dissent's suggestion that the rule of *Rogers* and *Mattel* is limited to titles of artistic works. We believe that the principles identified in these decisions are generally applicable to all cases involving literary or artistic works where the defendant has articulated a colorable claim that the use of a celebrity's identity is protected by the First Amendment.

The dissent contends that we have overlooked the comment in *Mattel* that the result in *Rogers* may have been different if, for example, "a pair of dancing shoes had been labeled Ginger and Fred, [because] a dancer might have suspected that Rogers was associated with the shoes (or at least one of them), just as Michael Jordan has endorsed Nike sneakers that claim to make you fly through the air." *Mattel*, 296 F.3d at 901. We fail to see the relevance of this distinction, because Woods's image in Rush's print is not used to identify a product.

In *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir.2003), we joined the Second and Ninth Circuits in holding that the likelihood of confusion and "alternative means" tests do not give sufficient weight to the public interest in freedom of expression. In *Parks*, we adopted the *Rogers* test as the law of the Sixth Circuit: FN12

FN12. The dissent's continued insistence on applying the likelihood of confusion test appears untenable in light of *Parks*.

The application of *Rogers* in *Mattel*, as well as in cases decided in other circuits, persuades us that *Rogers* is the best test for balancing Defendants' and the public's interest in free expression under the First Amendment against Parks' and the public's interest in enforcement of the Lanham Act. We thus apply the *Rogers* test to the facts before us. *Id.* at 451-52 (quoting *Rogers*, 875 F.2d at 999).

D. Right of Publicity Claim

[16] ETW claims that Jireh's publication and market-

ing of prints of Rush's painting violates Woods's right of publicity. The right of publicity is an intellectual property right of recent origin which has been defined as the inherent right of every human being to control the commercial use of his or her identity. See MCCARTHY ON PUBLICITY AND PRIVACY, § 1:3. The right of publicity is a creature of state law FN13 and its violation gives rise to a cause of action for the commercial tort of unfair competition. *Id.*

FN13. Approximately half of the states have adopted some form of the right of publicity either at common law or by statute. See MCCARTHY ON PUBLICITY AND PRIVACY, § 6:1.

The right of publicity is, somewhat paradoxically, an outgrowth of the right of privacy. See MCCARTHY ON PUBLICITY AND *929 PRIVACY, § 1:4. A cause of action for violation of the right was first recognized in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2nd Cir.1953), where the Second Circuit held that New York's common law protected a baseball player's right in the publicity value of his photograph, and in the process coined the phrase "right of publicity" as the name of this right.

The Ohio Supreme Court FN14 recognized the right of publicity in 1976 in *Zacchini v. Scripps-Howard Broadcasting Co.*, 47 Ohio St.2d 224, 351 N.E.2d 454 (1976). FN15 In *Zacchini*, which involved the videotaping and subsequent rebroadcast on a television news program of plaintiff's human cannonball act, the Ohio Supreme Court held that Zacchini's right of publicity was trumped by the First Amendment. On appeal, the Supreme Court of the United States reversed, holding that the First Amendment did not insulate defendant from liability for violating Zacchini's state law right of publicity where defendant published the plaintiff's entire act. See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977). *Zacchini* is the only United States Supreme Court decision on the right of publicity.

FN14. ETW is a Florida corporation with its principal place of business in Cleveland, Ohio. Both parties have argued this case on the premise that Ohio law applies to ETW's right of publicity claim. Thus, the court will

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apply Ohio law. See Suarez Corporation v. CBS, Inc., No. 93-3307, 1994 WL 142785 (6th Cir. April 19, 1994) (applying Ohio law to invasion of privacy claim where Ohio was plaintiff's principal place of business).

FN15. In 1999, the right of publicity was codified in the provisions of Ohio Revised Code Chapter 2741. However, this litigation was commenced before the effective date of the Ohio statutory provisions, and ETW does not invoke them.

There are few Ohio decisions defining the contours of the right of publicity in the aftermath of Zacchini. In Vinci v. American Can Co., 9 Ohio St.3d 98, 459 N.E.2d 507 (1984), the Ohio Supreme Court merely reaffirmed its recognition of the right and devoted the remainder of its opinion to the issue of class action certification. Vinci was an Olympic gold medal weight lifter who brought a class action on behalf of himself and other Olympic athletes whose names and likenesses were used on a series of disposable drinking cups promoted by a partnership between the Minute Maid Corporation and the United States Olympic Committee. The Supreme Court of Ohio held that the action could be maintained as a class action. After remanding the case to the Cuyahoga County Court of Appeals, that court, with one judge dissenting, upheld the grant of summary judgment to the defendants, holding that "the mention of the athletes' names within the context of accurate, historical information was incidental to the promotion of the Dixie Cups by the partnership" and that the "reference to the athletes and their accomplishments was purely informational [.]". Vinci v. American Can Co., 69 Ohio App.3d 727, 729, 591 N.E.2d 793, 794 (1990).

In Bajpayee v. Rothermich, 53 Ohio App.2d 117, 372 N.E.2d 817 (1977), the Ohio Court of Appeals for Franklin County held that the plaintiff's right of publicity was violated where the defendant presented plaintiff's pharmacological research paper as his own before the American Society of Clinical Pharmacology and Therapeutics.

Finally, in Parma International, Inc. v. Bartos, 1990 WL 11716, No. 89CA004573, 1990 Ohio App. LEXIS 508 (Feb. 7, 1990), the Ohio Court of Appeals for Lorain County reversed a trial court's grant

of summary judgment for the defendant *930 where the defendant had continued to use the plaintiff's name and likeness on the packaging of its product and in its advertising literature after the plaintiff ceased his employment with the defendant. The issue in Parma International was whether the plaintiff had consented to the continued use of his name and likeness.

When the Ohio Supreme Court recognized the right of publicity, it relied heavily on the RESTATEMENT (SECOND) OF TORTS, § 652. See Zacchini, 47 Ohio St.2d at 230, 351 N.E.2d 454. The court quoted the entire text of § 652(C) of the RESTATEMENT, as well as comments a., b., c. and d. *Id.*

The RESTATEMENT originally treated the right of publicity as a branch of the right of privacy and included it in a chapter entitled "Invasion of Privacy." In 1995, the American Law Institute transferred its exposition of the right of publicity to the RESTATEMENT (THIRD) OF UNFAIR COMPETITION, Chapter 4, § 46, in a chapter entitled "Appropriation of Trade Values." The current version of the RESTATEMENT (THIRD) OF UNFAIR COMPETITION defines the right of publicity as follows:

Appropriation of the Commercial Value of a Person's Identity: The Right of Publicity

One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules stated in §§ 48 and 49.

Id.

In § 46, Comment c, *Rationale for Protection*, the authors of the RESTATEMENT suggest that courts may justifiably be reluctant to adopt a broad construction of the right.

The rationales underlying recognition of a right of publicity are generally less compelling than those that justify rights in trademarks or trade secrets. The commercial value of a person's identity often results from success in endeavors such as entertainment or sports that offer their own substantial rewards. Any additional incentive attributable to

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the right of publicity may have only marginal significance. In other cases the commercial value acquired by a person's identity is largely fortuitous or otherwise unrelated to any investment made by the individual, thus diminishing the weight of the property and unjust enrichment rationales for protection. In addition, the public interest in avoiding false suggestions of endorsement or sponsorship can be pursued through the cause of action for deceptive marketing. Thus, courts may be properly reluctant to adopt a broad construction of the publicity right. See § 47.

In § 47, Comment c, the authors of the RESTATEMENT note, "The right of publicity as recognized by statute and common law is fundamentally constrained by the public and constitutional interest in freedom of expression." In the same comment, the authors state that "[t]he 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." Various examples are given, including the use of the person's name or likeness in news reporting in newspapers and magazines. The RESTATEMENT recognizes that this limitation on the right is not confined to news reporting but extends to use in "entertainment and other creative works, including both fiction and non-fiction." *Id.* The authors list examples of protected uses of a celebrity's identity, likeness or image, including unauthorized print or broadcast biographies and novels, plays or motion pictures. *Id.* According to the RESTATEMENT, such uses are not protected, however, if the name or likeness is used solely to *931 attract attention to a work that is not related to the identified person, and the privilege may be lost if the work contains substantial falsifications. *Id.*

We believe the courts of Ohio would follow the principles of the RESTATEMENT in defining the limits of the right of publicity. The Ohio Supreme Court's decision in *Zacchini* suggests 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. This suggestion is reenforced by the decision in *Vinci*.

This court first encountered the right of publicity in *Memphis Development Foundation v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.1980), where the issue

presented was whether the heirs of Elvis Presley retained his right of publicity after his death. We concluded that they did not. We held that under Tennessee law, "[t]he famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality." *Id.* at 957. Noting that the Tennessee courts had not addressed the issue, we decided the case "in the light of practical and policy considerations, the treatment of other similar rights in our legal system, the relative weight of the conflicting interests of the parties, and certain moral presuppositions concerning death, privacy, inheritability and economic opportunity." *Id.* at 958.

In *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir.1983), a majority of this court, with Judge Kennedy dissenting, held that television comedian and talk show host Johnny Carson's right of publicity was invaded when defendant used the phrase with which Carson was commonly introduced on his television program. In *Carson*, we held that "a celebrity has a protected pecuniary interest in the commercial exploitation of his identity." *Id.* at 835.

In *Landham*, 227 F.3d at 625-26, this court held that Landham, a fringe actor who played supporting roles in several motion pictures, had failed to show a violation of his right of publicity when defendant marketed an action figure of a character he had played but which did not bear a personal resemblance to him. This court found that Landham had failed to show that his persona had significant value or that the toy invoked his persona as distinct from that of the fictional character he played.

There is an inherent tension between the right of publicity and the right of freedom of expression under the First Amendment. This tension becomes particularly acute when the person seeking to enforce the right is a famous actor, athlete, politician, or otherwise famous person whose exploits, activities, accomplishments, and personal life are subject to constant scrutiny and comment in the public media. In *Memphis Development Foundation*, 616 F.2d at 959, this court discussed the problems of judicial line drawing that would arise if it should recognize the inheritability of publicity rights, including the question "[a]t what point does the right collide with the right of free expression guaranteed by the First Amendment?" In *Carson*, after noting that the First Amendment protects commercial speech, Judge Ken-

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ney opined in her dissent that “public policy requires that the public's interest in free enterprise and free expression take precedence over any interest Johnny Carson may have in a phrase associated with his person.” Carson, 698 F.2d at 841. In Landham, we noted “the careful balance that courts have gradually constructed between the right of publicity and the First Amendment [.]” 227 F.3d at 626.

*932 In a series of recent cases, other circuits have been called upon to establish the boundaries between the right of publicity and the First Amendment. In Rogers, the Second Circuit affirmed the district court's grant of summary judgment on Rogers' right of publicity claim, noting that commentators have “advocated limits on the right of publicity to accommodate First Amendment concerns.” 875 F.2d at 1004 n. 11. That court also cited three cases ^{FN16} in which state courts 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. Id. at 1004.

FN16. Hicks v. Casablanca Records, 464 F.Supp. 426 (S.D.N.Y.1978); Frosch v. Grossett & Dunlop, Inc., 75 A.D.2d 768, 427 N.Y.S.2d 828 (1st Dept. 1980); and Guglielmi v. Spelling-Goldberg Productions, 25 Cal.3d 860, 160 Cal.Rptr. 352, 603 P.2d 454, 455 (1979) (Bird, C.J., concurring).

In White, television celebrity Vanna White, brought suit against Samsung Electronics, alleging that its television advertisement which featured a female-shaped robot wearing a long gown, blonde wig, large jewelry, and turning letters in what appeared to be the “Wheel of Fortune” game show set, violated her California common law right of publicity and her rights under the Lanham Act. The Ninth Circuit, with Judge Alarcon dissenting in part, reversed the grant of summary judgment to defendant, holding that White had produced sufficient evidence that defendant's advertisement appropriated her identity in violation of her right of publicity, and that the issue of confusion about White's endorsement of defendant's product created a jury issue which precluded summary judgment on her Lanham Act claim. In so holding, the court rejected the defendant's parody defense which posited that the advertisement was a parody of White's television act and was protected speech.

A suggestion for rehearing *en banc* failed. Three judges dissented from the order rejecting the suggestion for a rehearing *en banc*. See White v. Samsung Electronics America, Inc., 989 F.2d 1512 (9th Cir.1993). Judge Kozinski, writing the dissenting opinion, observed, “Something very dangerous is going on here.... Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain.” 989 F.2d at 1513. Later, he commented:

Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large.... This is why intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us[.]

Id. at 1516. In Landham, this court declined to follow the majority in White and, instead, cited Judge Kozinski's dissent with approval. See 227 F.3d at 626.

In Cardtoons, L.C. v. Major League Baseball Players Assoc., 95 F.3d 959 (10th Cir.1996), the Tenth Circuit held that the plaintiff's First Amendment right to free expression outweighed the defendant's proprietary right of publicity. The plaintiff in Cardtoons contracted with a political cartoonist, a sports artist, and a sports author and journalist to design a set of trading cards which featured readily identifiable caricatures of major league baseball players with a humorous commentary about their careers on the back. The cards ridiculed the players using a variety of themes. The cards used similar names, recognizable caricatures, distinctive team colors and commentaries about individual players which left no doubt about their identity. The Tenth Circuit held that the *933 defendant's use of the player's likenesses on its trading cards would violate their rights of publicity under an Oklahoma statute. Addressing the defendant's First Amendment claim, the court held:

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 of commentary on an important social institution constitutes protected expression.

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Cardtoons, 95 F.3d at 969. The Tenth Circuit rejected the reasoning of the panel majority in *White*, and expressed its agreement with the dissenting opinions of Judges Alarcon and Kozinski. See 95 F.3d at 970 (“We disagree with the result in [White] for reasons discussed in the two dissents that it engendered.”). In striking the balance between the players’ property rights and the defendant’s First Amendment rights, the court in *Cardtoons* commented on the pervasive presence of celebrities in the media, sports and entertainment. The court noted that celebrities are an important part of our public vocabulary and have come to symbolize certain ideas and values:

As one commentator explained, celebrities 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 a collective memory.” John B. Thompson, *IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION* 163 (1990). Through their pervasive presence in the media, sports and entertainment celebrities come to symbolize certain ideas and values.... Celebrities, then, are an important element of the shared communicative resources of our cultural domain.

Cardtoons, 95 F.3d at 972.

The court observed that one of the justifications often given for the right of publicity is the furthering of economic goals such as stimulating athletic and artistic achievement by securing to celebrities the fruits of their labors and talents. The court then noted that major league baseball players’ salaries currently average over one million dollars per year and commented:

Such figures suggest that “even without the right of publicity the rate of return to stardom in the entertainment and sports fields is probably high enough to bring forth a more than ‘adequate’ supply of creative effort and achievement.” ... In addition, even in the absence of publicity rights, celebrities would still be able to reap financial reward from authorized appearances 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 entertain-

ment. Thus, while publicity rights may provide some incentive for creativity and achievement, the magnitude and importance of that incentive has been exaggerated.

Cardtoons, 95 F.3d at 974 (citation omitted). Noting that another justification for publicity rights is the prevention of unjust enrichment, the court observed that “Cardtoons added a significant creative component of its own to the celebrity identity and created an entirely new product.” Cardtoons, 95 F.3d at 976. The Tenth Circuit affirmed the district court’s ruling that the trading cards were expression protected by the First Amendment.

In Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir.2001), the Ninth Circuit was again presented with a case involving the tension between the right of *934 publicity and the First Amendment. The plaintiff, actor Dustin Hoffman, brought suit against a magazine and its publisher, seeking to recover on state law claims for the violation of his right of publicity, for unfair competition and for violation of the Lanham Act, based on allegations that the magazine used, without his permission, a still photograph from a motion picture to create a computer-generated image which falsely depicted him wearing fashion designer’s women’s clothes. The court rejected Hoffman’s claims, holding that the magazine article was entitled to full protection under the First Amendment.

In 1982, Hoffman starred in the movie *Tootsie*, playing a male actor who dresses as a woman to get a part on a television soap opera. A still photograph from the movie showed Hoffman in character in a red, long-sleeved sequined evening dress and high heels, posing in front of an American flag. In March, 1997, the defendant L.A. Magazine, Inc. (“LAM”) published an issue of its magazine which contained an article entitled “Grand Illusions”, which used computer technology to alter famous film stills to make it appear that the actors were wearing spring 1997 fashions. The article contained sixteen familiar scenes of famous actors from famous movies. In the photo of Hoffman, his head and the American flag appeared as they did in the original, but his body and the long sleeved, red dress were replaced by the body of a male model in the same pose, wearing a spaghetti-strapped, cream colored silk evening dress and high heeled sandals. The text on the page identified the still as from the movie *Tootsie* and read “Dustin

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Hoffman isn't a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels." *Id.* at 1183. Hoffman's complaint alleged that LAM's publication of the altered photograph misappropriated his name and likeness, in violation of his California common law and statutory rights of publicity. LAM replied that its challenged use of the *Tootsie* photo was protected under the First Amendment.

Quoting this court's decision in *Landham*, the Tenth Circuit began its opinion by stating, "We evaluate this defense aware of 'the careful balance that courts have gradually constructed between the right of publicity and the First Amendment and federal intellectual laws.'" *Hoffman*, 255 F.3d at 1183-1184. The court concluded that LAM's publication of the altered *Tootsie* photograph was not commercial speech:

Viewed in context, the article as a whole is a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors. Any commercial aspects are "inextricably entwined" with expressive elements, and so they cannot be separated out "from the fully protected whole". (Citations omitted).

Hoffman, 255 F.3d at 1185. The court concluded that LAM was entitled to the full First Amendment protection accorded non-commercial speech which could be defeated only by proof of actual malice.

In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797 (2001), the California Supreme Court adopted a transformative use test in determining whether the artistic use of a celebrity's image is protected by the First Amendment. Saderup, an artist with over twenty-five years experience in making charcoal drawings of celebrities, created a drawing of the famous comedy team, The Three Stooges. The drawings were used to create lithographic and silk screen masters, which were then used to produce lithographic prints and silk screen images on T-shirts. Comedy III, the owner of all rights to the former comedy act, brought suit against Saderup under a California statute, which *935 grants the right of publicity to successors in interest of deceased celebrities.

The California Supreme Court found that Saderup's portraits were entitled to First Amendment protection because they were "expressive works and not an ad-

vertisement or endorsement of a product." *Id.* at 396, 106 Cal.Rptr.2d 126, 21 P.3d at 802. In discussing the tension between the right of publicity and the First Amendment, the court observed:

[B]ecause celebrities take on personal meanings to many individuals in the society, the creative appropriation of celebrity images can be an important avenue of individual expression. As one commentator has stated: "Entertainment and sports celebrities are the leading players in our Public Drama. We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles, their modes of conversation and of consumption. Whether or not celebrities are 'the chief agents of moral change in the United States,' they certainly are widely used-far more than are our institutionally anchored elites-to symbolize individual aspirations, group identities and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation." (Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights* (1993)) 81 Cal. L.Rev. 125, 128 (Madow, italics and fns. omitted).

Id. at 397, 106 Cal.Rptr.2d 126, 21 P.3d at 803.

The court rejected the proposition that Saderup's lithographs and T-shirts lost 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 solely from the sale of multiple reproductions of likenesses of The Three Stooges:

[T]his 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.... [A] reproduction of a celebrity image that, as explained above, contains significant creative elements is entitled to as much First Amendment protection as an original work of art.

Id. at 408, 106 Cal.Rptr.2d 126, 21 P.3d at 810.

Borrowing part of the fair use defense from copyright

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law, the California court proposed the following test for distinguishing between protected and unprotected expression when the right of publicity conflicts with the First Amendment:

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.

On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity....

Accordingly, First Amendment protection of such works outweighs whatever interest the state may have in enforcing the right of publicity.

Id. at 405, 106 Cal.Rptr.2d 126, 21 P.3d at 808 (footnote and citations omitted). Later in its opinion, the California court restated the test as follows:

*936 Another way of stating the inquiry is whether the celebrity likeness is one of the "raw materials" from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.

Id. at 406, 106 Cal.Rptr.2d 126, 21 P.3d at 809.

Finally, citing the art of Andy Warhol, the court noted that even literal reproductions of celebrity portraits may be protected by the First Amendment.

Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.... Although the distinction between protected and unprotected expression will sometimes be subtle, it is no more so than other distinctions triers of fact are called on to make in First Amendment jurisprudence.

Id. at 408-409, 106 Cal.Rptr.2d 126, 21 P.3d at 811 (citations and footnote omitted).

We conclude that in deciding whether the sale of Rush's prints violate Woods's right of publicity, we will look to the Ohio case law and the RESTATEMENT (THIRD) OF UNFAIR COMPETITIONNNNNNNNNNNNNNNNN. In deciding where the line should be drawn between Woods's intellectual property rights and the First Amendment, we find ourselves in agreement with the dissenting judges in *White*,^{FN17} the Tenth Circuit's decision in *Cardtoons*, and the Ninth Circuit's decision in *Hoffman*, and we will follow them in determining whether Rush's work is protected by the First Amendment. Finally, we believe that the transformative elements test adopted by the Supreme Court of California in *Comedy III Productions*, will assist us in determining where the proper balance lies between the First Amendment and Woods's intellectual property rights. We turn now to a further examination of Rush's work and its subject.

FN17. In *Parks*, we applied the *Rogers* test to plaintiff's right of publicity claims and cited with approval Judge Kozinski's dissent in *White*, 989 F.2d at 1516. *Parks*, 329 F.3d at 449.

E. Application of the Law to the Evidence in this Case

The evidence in the record reveals that 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 within the protection of the First Amendment. The Masters Tournament is probably the world's most famous golf tournament and Woods's victory in the 1997 tournament was a historic event in the world of sports. A piece of art that portrays a historic sporting event communicates and celebrates the value our culture attaches to such events. It would be ironic indeed if the presence of the image of the victorious athlete would deny the work First Amendment protection. Furthermore, Rush's work includes not only images of Woods and the two caddies, but also carefully crafted likenesses of six past winners of the

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Masters Tournament: Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones, and Jack Nicklaus, a veritable pantheon of golf's greats. Rush's work conveys the message that Woods himself will someday join that revered group.

[17] Turning first to ETW's Lanham Act false endorsement claim, we agree *937 with the courts that hold that the Lanham Act should be applied to artistic works only where the public interest in avoiding confusion outweighs the public interest in free expression. The *Rogers* test is helpful in striking that balance in the instant case. We find that the presence of Woods's image in Rush's painting *The Masters Of Augusta* does have artistic relevance to the underlying work and that it does not explicitly mislead as to the source of the work.^{FN18} We believe that the principles followed in *Cardtoons*, *Hoffman* and *Comedy III* are also relevant in determining whether the Lanham Act applies to Rush's work, and we find that it does not.

FN18. Unlike *Parks*, here there is no genuine issue of material fact about the artistic relevance of the image of Woods in Rush's print. See *Ruffin-Steinback v. dePasse*, 82 F.Supp.2d 723 (E.D.Mich.2000) aff'd 267 F.3d 457 (6th Cir.2001) (likeness of members of Motown group "Temptations" used to promote televised mini-series and video cassette based on partly fictionalized story about group); *Seale v. Gramercy Pictures*, 949 F.Supp. 331 (E.D.Pa.1996) (use of plaintiff's name and likeness on cover of pictorial history book and home video clearly related to content of book and film).

We find, like the court in *Rogers*, that plaintiff's survey evidence, even if its validity is assumed, indicates at most that some members of the public would draw the incorrect inference that Woods had some connection with Rush's print.^{FN19} The risk of misunderstanding, not engendered by any explicit indication on the face of the print, is so outweighed by the interest in artistic expression as to preclude application of the Act. We disagree with the dissent's suggestion that a jury must decide where the balance should be struck and where the boundaries should be drawn between the rights conferred by the Lanham Act and the protections of the First Amendment.

FN19. Respondents in the survey were handed a copy of Rush's print and were asked the question: "Do you believe that Tiger Woods has an affiliation or connection with this print or that he has given his approval or has sponsored it?" Sixty-two percent answered "Yes"; eleven percent said "No"; and twenty-seven percent said "Don't Know." The terms "affiliated with" and "connected with" were not defined. Some respondents may have thought that Woods's mere presence in the print was itself an affiliation or connection. No control questions were asked to clarify this. Furthermore, the respondents were not given the packaging in which Jireh distributed the prints which prominently features Rush and contains no suggestion that Woods sponsored or approved the print.

[18] In regard to the Ohio law right of publicity claim, we conclude that Ohio would construe its right of publicity as suggested in the RESTATEMENT (THIRD) OF UNFAIR COMPETITIONNNNNNNNNN, Chapter 4, Section 47, Comment d., which articulates a rule analogous to the rule of fair use in copyright law. Under this rule, the substantiality and market effect of the use of the celebrity's image is analyzed in light of the informational and creative content of the defendant's use. Applying this rule, we conclude 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.

We further find that Rush's work is expression which is entitled to the full protection of the First Amendment and not the more limited protection afforded to commercial speech. When we balance the magnitude of the speech restriction against the interest in protecting Woods's intellectual property right, we encounter precisely the same considerations weighed by the Tenth Circuit in *Cardtoons*. These include consideration of the fact that through their pervasive presence in the media, sports and entertainment celebrities have come to symbolize certain ideas and values in our society and have become a valuable means *938 of expression in our culture. As the Tenth Circuit observed "[c]elebrities ... are an important element of the shared communicative resources

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of our cultural domain.” *Cartoons*, 95 F.3d at 972.

In balancing these interests against Woods's right of publicity, we note that Woods, like most sports and entertainment celebrities with commercially valuable identities, engages in an activity, professional golf, that in itself generates a significant amount of income which is unrelated to his right of publicity. Even in the absence of his right of publicity, he would still be able to reap substantial financial rewards from authorized appearances and endorsements. It is not at all clear that the appearance of Woods's likeness in artwork prints which display one of his major achievements will reduce the commercial value of his likeness.

While the right of publicity allows celebrities like Woods to enjoy the fruits of their labors, here Rush has added a significant creative component of his own to Woods's identity. Permitting Woods's right of publicity to trump Rush's right of freedom of expression would extinguish Rush's right to profit from his creative enterprise.

After balancing the societal and personal interests embodied in the First Amendment against Woods's property rights, we conclude that the effect of limiting Woods's right of publicity in this case is negligible and significantly outweighed by society's interest in freedom of artistic expression.

Finally, applying the transformative effects test adopted by the Supreme Court of California in *Comedy III*, we find that Rush's work does contain significant transformative elements which make it especially worthy of First Amendment protection and also less likely to interfere with the economic interest protected by Woods' right of publicity. Unlike the unadorned, nearly photographic reproduction of the faces of The Three Stooges in *Comedy III*, Rush's work does not capitalize solely on a literal depiction of Woods. Rather, 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 the full protection of the First Amendment. In this case, we find that Woods's right of publicity must yield to the First Amendment.

V. Conclusion

In accordance with the foregoing, the judgment of the District Court granting summary judgment to Jireh Publishing is affirmed.

CLAY, Circuit Judge, dissenting.

Genuine issues of material fact remain for trial as to the claims brought by Plaintiff, ETW Corporation, under the Lanham Act, 15 U.S.C. § 1114 and § 1125, and Ohio common law for trademark infringement, unfair competition, and dilution; therefore, I would reverse the district court's judgment and remand the case for trial as to these claims. No genuine issue of material fact remains for trial that Defendant, Jireh Publishing, violated Plaintiff's right of publicity under Ohio common law; therefore, I would reverse the district court's judgment on Plaintiff's right of publicity claim and remand with instructions that the district court enter summary judgment in favor of Plaintiff. For these reasons, I respectfully dissent from the majority opinion, and shall address Plaintiff's claims in an order somewhat different than that utilized by the majority.

***939 I. Trademark Claims Based on Defendant's Unauthorized Use of the Unregistered Mark- § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)**

At the outset, it should be noted that the majority's characterization of this claim as the “Unauthorized Use of the Likeness of Tiger Woods” is misleading. Such a characterization bolsters the majority's unfounded position that Plaintiff is seeking protection under the Lanham Act for any and all images of Tiger Woods, but, indeed, such is not the case. Plaintiff's amended complaint squarely sets forth Defendant's conduct to which Plaintiff takes issue—Defendant's portrayal of Woods in his famous golf swing at the Masters Tournament in Augusta as set forth in Rush's print. Plaintiff provided evidence that there was a “high incidence” of consumer confusion as to Woods being the origin or sponsor of *The Masters of Augusta* print by Rick Rush, thus demonstrating, at the very least, that a question of fact remains for trial as to whether Woods used this image as a trademark and whether Defendant's print infringed upon the mark. See *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753 (6th Cir.1998) (hereinafter “*Rock & Roll Hall of Fame*”

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or “Rock & Roll”).

The majority's contention as set forth in footnote 5 of its opinion, that “Plaintiff's first amended complaint does not allege that Woods has used any specific image or likeness as a trademark,” misses the point. That is, Plaintiff's complaint expressly takes issue with Defendant's unauthorized sale of Rush's print depicting Woods, and Plaintiff has proffered evidence to show that consumers are confused as to Woods being the sponsor or origin of the print, thereby establishing, particularly for purposes of summary judgment, that the image of Woods in Rush's print has been used as a trademark. The majority's repeated disagreement with this point as set forth in footnote 6 of its opinion flies in the face of several propositions of law.

Section 1125(a), or § 43(a), of the Lanham Act (“the Act”) “makes illegal a broad array of rather amorphous practices that are commonly arranged under the loose rubric of ‘unfair competition.’ ” Sovereign Order of Saint John of Jerusalem, Inc. v. Grady, 119 F.3d 1236, 1242 (6th Cir.1997); see also Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 209, 120 S.Ct. 1339, 146 L.Ed.2d 182 (2000) (quoting 15 U.S.C. § 1125(a)) (“In addition to protecting registered marks, the Lanham Act, in § 43(a), gives a producer a cause of action for the use by any person of ‘any word, term, name, symbol, or device, or any combination thereof ... which ... is likely to cause confusion ... as to the origin, sponsorship, or approval of his or her goods....’ ”). Section 1125(a) is the counterpart to section 1114 of the federal trademark infringement statute, where the former protects certain unregistered marks, while the latter protects registered marks. *Id.* However, “whether alleging infringement of a registered trademark, pursuant to 15 U.S.C. § 1114(1), or infringement of an unregistered trademark, pursuant to 15 U.S.C. § 1125(a)(1), it is clear that a plaintiff must show that it has actually used the designation at issue *as a trademark*, and that the defendant has also used the same or a similar designation, *as a trademark*.” Rock & Roll, 134 F.3d at 753 (emphasis in *Rock & Roll*). “[I]n order to be protected [or considered] as a valid trademark, a designation must create ‘a separate and distinct commercial impression, which ... performs the trademark function of identifying the source of the merchandise to the customers.’ ” *Id.* (quoting In re Chem. Dynamics, Inc., 839 F.2d 1569, 1571 (Fed.Cir.1988)).

To this end, “the plaintiff must establish a likelihood that the defendant's designation*940 will be confused with the plaintiff's trademark, such that consumers are mistakenly led to believe that the defendant's goods are produced or sponsored by the plaintiff.” *Id.* at 753-54. Indeed, whether a claim brought under § 1114 for infringement of a registered mark, or whether it is brought under § 1125(a) for infringement of an unregistered mark, the touchstone of the claim is “likelihood of confusion.” See Bird v. Parsons, 289 F.3d 865, 877 (6th Cir.2002) (“Generally speaking, the key question in cases where a plaintiff alleges trademark infringement and unfair competition is whether the defendant's actions create a likelihood of confusion as to the origin of the parties' goods or services.”); see also Paccar Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 249 (6th Cir.2003) (“The touchstone of liability under § 1114 is whether the defendant's use of the disputed mark is likely to cause confusion among consumers regarding the origin of the goods offered by the parties.”) (quoting Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr., 109 F.3d 275, 280 (6th Cir.1997)); Sovereign Order of Saint John of Jerusalem, Inc., 119 F.3d at 1243 (noting that “the touchstone of a section 1125(a) unfair competition claim is whether the defendant's actions are likely to cause confusion”) (citation and internal quotation marks omitted).

This Court has embraced the following eight-factor test for determining likelihood of confusion. These eight factors are not mechanically applied; rather, they simply serve as guidelines to aid in the Court's analysis:

1. strength of plaintiff's mark;
2. relatedness of the goods;
3. similarity of the marks;
4. evidence of actual confusion;
5. marketing channels used;
6. likely degree of purchaser care;
7. defendant's intent in selecting the mark;

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8. likelihood of expansion of the product lines.

Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 626-27 (6th Cir.2000) (“[These factors] ‘imply no mathematical precision, and a plaintiff need not show that all, or even most of the factors listed are present in any particular case to be successful.’”) (quoting Wynn Oil Co. v. Thomas, 839 F.2d 1183, 1186 (6th Cir.1988)); see also Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir.1961) (espousing the eight-factor likelihood of confusion test).

The majority ignores this body of well established jurisprudence by holding that “as a general rule, a person's image or likeness cannot function as a trademark.” Indeed, if a plaintiff alleging infringement in the unregistered mark of his image or likeness in the product of another brings forth evidence of consumer confusion, then the image or likeness of the plaintiff may very well be functioning “as a trademark” for purposes of § 1125(a), see Rock & Roll Hall of Fame, 134 F.3d at 753, and a question of fact may be created as to whether the defendant's unauthorized use of the mark infringed on the plaintiff's rights. See Tarrant Serv. Agency v. Am. Standard, Inc., 12 F.3d 609, 617 (6th Cir.1993) (holding that evidence of consumer confusion established a question of fact for the jury on the plaintiff's trademark infringement and unfair competition claims).

In support of its sweeping holding, the majority relies in part upon Pirone v. MacMillan, Inc., 894 F.2d 579 (2d Cir.1990); however, a close reading of Pirone does not support the majority's position but instead follows the long line of cases establishing that a plaintiff may succeed on a claim under § 1125(a) for infringement of the unregistered mark of his likeness or image by bringing forth evidence of consumer confusion. To illustrate, in Pirone *941 the estate of the famous baseball player Babe Ruth brought suit against the manufacturer of a pocket calender bearing the photograph of Babe Ruth, among other famous baseball players, claiming trademark infringement under § 32 (registered mark) and § 43(a) (unregistered mark). See *id.* at 582. In discussing the plaintiff's claims made under § 43(a), the Second Circuit noted that claims under § 43(a) are broader than those made under § 32, inasmuch as they cover a broader array of violations. *Id.* The court went on to state that

the crucial determinant in an action for trademark infringement or unfair competition is whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question. In order to be confused, a consumer need not believe that the Ruth estate actually produced the calender. *The public's belief that the mark's owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement.*

Id. at 584 (internal quotation marks and citations omitted; emphasis added). Because the plaintiff “failed to present a material issue of fact on the question of likelihood of consumer confusion,” the Second Circuit found that summary judgment on the plaintiff's § 43(a) claim was proper. *Id.* at 585. Thus, contrary to the majority's abbreviated discussion of Pirone, the Second Circuit did not find that the plaintiff's claim in that case failed because trademark rights cannot be established in the likeness of an individual; rather, the plaintiff's claim fell prey to the defendant's motion for summary judgment because no evidence of consumer confusion was presented to support the claim.

The majority also relies upon Rock & Roll Hall of Fame in support of its holding; however, as with Pirone, Rock & Roll Hall of Fame does not espouse the proposition that the majority claims. That is, contrary to the majority's implication here, the Court in Rock & Roll Hall of Fame did not conclude that the plaintiff's § 43(a) claim for trademark infringement of the Museum's building design failed because the Museum's image or design could not function as a trademark. Instead, the Court in Rock & Roll Hall of Fame held that the plaintiff's claim failed because there was no evidence of consumer confusion so as to demonstrate that the Museum's image had been used as a trademark. See 134 F.3d at 754. Indeed, the majority found the lack of evidence regarding consumer confusion to be “pivotal” in reaching its conclusion. *Id.*

Finally, the majority cites to Estate of Elvis Presley v. Russen, 513 F.Supp. 1339 (D.N.J.1981) in support of its holding that as a general rule a person's image or likeness cannot function as a trademark. As with the other cases upon which the majority relies, Presley does not stand for the proposition that a person's like-

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ness or image cannot function as a trademark; rather, the *Presley* court found that “the available evidence [did] not support” the plaintiff’s proposition that “the likeness and image of Elvis Presley serve[d] as a service mark.” *Id.* at 1363-64. In other words, if the plaintiff had proffered evidence to support its proposition, then its claim may very well have succeeded. Indeed, the court found that “there [was] sufficient evidence in the record” for the court to conclude that a certain image of Presley, coined by the court as the “Elvis Pose,” had acquired secondary meaning so as to be protectable as a service mark. *Id.* at 1365.

Simply stated, contrary to the majority’s contention, the jurisprudence clearly indicates that a person’s image or likeness *can* function as a trademark as long as there is *942 evidence demonstrating that the likeness or image was used as a trademark; which is to say, the image can function as a trademark as long as there is evidence of consumer confusion as to the source of the merchandise upon which the image appears. See, e.g., *Rock & Roll*, 134 F.3d at 753. And, significantly, in the matter at hand Plaintiff brought forth such evidence regarding the image of Woods portrayed in Rush’s print by way of an affidavit from Dr. Carl Block, President and CEO of Marketeam Associates, a national marketing and research firm. Dr. Block stated that a survey had been conducted regarding the public’s perception of Defendant’s poster in relation to Tiger Woods. Based on the results of the survey, Dr. Block concluded that “there is a high incidence of confusion among the relevant consuming universe concerning the affiliation, connection, approval or sponsorship between Tiger Woods and *The Masters of Augusta* print by Rick Rush” such that “there is an extremely high probability that members of the relevant consuming universe believe that Tiger Woods has an affiliation or connection with ... the print.” (J.A. at 311, Block Affidavit at ¶¶ 5-6.) Dr. Block also stated that the survey demonstrated that only 11% of respondents believed that Tiger Woods did not have an affiliation or connection with the poster, while fully 62% of respondents believed that Woods was affiliated or connected with the poster or had “approv[ed] or sponsored it.” (J.A. at 311, Block Aff. at ¶ 5.) Dr. Block characterized this as “one of the highest incidences of confusion that Marketeam has ever recorded in such surveys regarding whether or not a likelihood of confusion exists in a trademark dispute.” (J.A. at 211, Block Affidavit at ¶ 5.)

Inasmuch as Plaintiff proffered evidence of consumer confusion as to Woods’ affiliation with or sponsorship of the poster, Plaintiff proffered evidence that it has used this image of Tiger Woods “as a trademark.” See *Rock & Roll Hall of Fame*, 134 F.3d at 753-54 (noting that in order to demonstrate that it used a designation as a trademark, “the plaintiff must establish a likelihood that the defendant’s designation will be confused with the plaintiff’s trademark, such that consumers are mistakenly led to believe that the defendant’s goods are produced or sponsored by the plaintiff”); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b, 537 (1995) (emphasis added) (“[I]f the defendant’s unauthorized use creates a false suggestion of endorsement or a likelihood of confusion as to source or sponsorship, liability may also be imposed for ... trademark or trade name infringement.”). Thus, the district court erred in failing to inquire further into Plaintiff’s § 43(a) claims by conducting the eight-factor test, and Plaintiff should be provided the opportunity to have a jury decide whether its § 43(a) claims are viable. See *Pirone*, 894 F.2d at 584 (noting that the eight-factor test for likelihood of confusion is normally a factual question for the jury); see also *Tarrant Serv. Agency*, 12 F.3d at 617 (holding that evidence of consumer confusion established a question of fact for the jury on the plaintiff’s trademark infringement and unfair competition claims).

With that said, it is difficult to conceive how the majority arrives at its conclusion that Plaintiff “does not claim that a particular photograph of Woods has been consistently used on specific goods” but instead makes “a sweeping claim to trademark rights in every photograph and image of Woods.” As indicated in the outset of this discussion, Plaintiff’s complaint specifically takes issue with the image of Woods as depicted in Rush’s *Masters of Augusta* print and, moreover, Plaintiff has come forward with strong evidence of consumer confusion to support its claim that this image of Woods has been used as a trademark for purposes of supporting its *943 § 43(a) claim. The majority’s failure to acknowledge the significance of this evidence constitutes a fatal flaw in its analysis because it is settled that “if the defendant’s unauthorized use creates a false suggestion of endorsement or a likelihood of confusion as to source or sponsorship, liability may also be imposed for ... trademark or trade name infringement.” RESTATEMENT

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(THIRD) OF UNFAIR COMPETITION § 46 cmt. b, 537 (1995) (emphasis added); *see also Bird*, 289 F.3d at 877 (noting that “the key question in cases where a plaintiff alleges trademark infringement and unfair competition is whether the defendant’s actions create a likelihood of confusion as to the origin of the parties’ goods or services”).

Finally, as explained in the next section, even by adopting the Second Circuit’s balancing approach when considering a Lanham Act claim involving an artistic expression, Plaintiff’s likelihood of confusion evidence should, and indeed must, be considered in deciding Plaintiff’s claim for infringement of the unregistered mark. As the Second Circuit has also proclaimed, “[t]rademark protection is not lost simply because the alleging infringing use is in connection with an artistic expression.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 493 (2d Cir.1989) (alteration in *Cliffs Notes*) (quoting *Silverman v. CBS Inc.*, 870 F.2d 40, 49 (2d Cir.1989)).

II. Lanham Act Unfair Competition & False Endorsement Claims- § 1125(a)

Regarding Plaintiff’s claim for false endorsement, the majority concludes that “where the defendant has articulated a colorable claim that the use of a celebrity’s identity is protected by the First Amendment, the likelihood of confusion test is not appropriate because it fails to adequately consider the interests protected by the First Amendment.” In support of this conclusion, the majority relies upon the Second Circuit’s decision in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir.1989) and *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir.2002), and ultimately holds that under these cases, the Lanham Act is not applicable to Plaintiff’s claim, thus obviating the need to address Plaintiff’s evidence of consumer confusion. The majority misapplies the test set forth and applied in these cases, and thus reaches an erroneous result.

This dissent focuses on the majority’s misapplication of the *Rogers* balancing test and resulting erroneous conclusion; however, this dissent should not be interpreted as endorsing the application of the *Rogers* test to the facts of this case. Rather, the point made by the dissent is that even under the *Rogers* standard, questions of fact remain precluding summary judgment. This dissent also emphasizes that even relying solely

on the eight-factor likelihood of confusion test as the district court did below-i.e., not employing any balancing test-questions of fact remain for trial on Plaintiff’s § 43(a) claims inasmuch as there is evidence on the record of consumer confusion as to Woods’ sponsorship of Rush’s print, evidence that Woods has used the image portrayed in the print as a trademark, and evidence that, as a celebrity, Woods has property rights in his name and image. *See, e.g., Parks v. LaFace Records*, 329 F.3d 437, 447 & n. 3 (6th Cir.2003); *Rock & Roll*, 134 F.3d at 753.

This Court applied *Rogers* for the first time in *Parks v. LaFace Records*, 329 F.3d at 448, which was a trademark case involving “a dispute over the name of a song.” In doing so, the Court specifically stated that it found the standard set forth in *Rogers* and its progeny to be the “best test” of those available “for balancing Defendants’ and the public’s interest in free *944 expression under the First Amendment against Parks’ and the public’s interest in enforcement of the Lanham Act” as to “the facts before [it].” *Id.* at 451-52. In other words, in *Parks* this Court applied the *Rogers* test for the first time in this circuit, but the Court limited the application to the facts of that case, which involved a song title. *Id.* at 458 (stating the application of the second prong of the *Rogers* test “in the context of using a celebrity’s name in the title of some artistic work”). Contrary to the assertions made by the majority in this case, the *Parks* court did not, as the majority does here, adopt *Rogers* wholesale as the law of this circuit in *any* trademark dispute involving an artistic expression. Rather, *Parks* applied *Rogers*’s “to the facts before [it]” where like *Rogers*, *Parks* involved a title. *Id.* at 452.

In *Rogers* and later in *Mattel*, the Second Circuit and the Ninth Circuit, respectively, were faced with § 1125(a) false endorsement claims as they specifically related to titles. As explained by the *Rogers* court, the fact that the claims were brought as to titles was significant in determining the scope of the Lanham Act to be applied. That is, in analyzing the challenge brought by the actress Ginger Rogers to the film entitled *Ginger and Fred*, the Second Circuit recognized that although

First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless *inform our consideration of the scope of the Act as applied to claims in-*

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volving such titles. Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined. Film-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works. Furthermore, their interest in freedom of artistic expression is shared by their audience. The subtleties of a title can enrich a reader's or a viewer's understanding of a work. Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author's freedom of expression. For all of these reasons, the *expressive element of titles* requires more protection than the labeling of ordinary commercial products.

Rogers, 875 F.2d at 998 (emphasis added).

Upon recognizing the specific nature of titles as they relate to protection under the Lanham Act, the Second Circuit addressed Rogers' contention that First Amendment concerns were implicated only where a title is so intimately related to the subject matter of a work that the author has no alternative means of expressing what the work is about. *Id.* The Second Circuit found that the "no alternative avenues" test "d[id] not sufficiently accommodate the public's interest in free expression," but also found that the district court's rule "that the Lanham Act [was] inapplicable to all titles that can be considered artistic expression[,] d[id] not sufficiently protect the public against flagrant deception." *Id.* at 999. As a result, the court crafted a balancing test and opined that "[w]e believe that in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Id.*

In applying this test to Rogers' claim, the Second Circuit first noted that the title "Ginger and Fred" contained "no explicit indication that Rogers [had] endorsed the film or had a role in producing it." *Id.* at *945 1001. The court went on to note that the survey evidence adduced by Rogers, even if validly assumed, "indicate[d] at most that some members of the public would draw the incorrect inference that

Rogers had some involvement with the film [;]" however, "that risk of misunderstanding, not engendered by any overt claim in the title, [was] so outweighed by the interests in artistic expression as to preclude application of the Lanham Act." *Id.* Thus, the court held that "the sponsorship and endorsement aspects of Rogers' Lanham Act claim [for false endorsement] raise[d] no 'genuine' issue that requires submission to the jury." *Id.*

The majority in the case at hand recognizes that the Second Circuit affirmed the district court's grant of summary judgment to Rogers, and also recognizes that the court considered Rogers' survey evidence when seeking to strike the appropriate balance between the public interest in not being misled and the public's interest in free expression for purposes of determining whether summary judgment was proper. However, in applying the *Rogers* balancing test to facts if this case, the majority fails to consider Plaintiff's survey evidence of consumer confusion and fails to do so under the scope of the Lanham Act relevant to the artistic work at issue.^{FN1} Instead, without any meaningful consideration whatsoever of Plaintiff's survey evidence, or for that matter any meaningful explanation of why Rush's print has artistic relevance for purposes of conducting a balancing of interests of any significance, the majority simply concludes that "the presence of Woods' image in Rush's painting *The Masters Of Augusta* does have artistic relevance to the underlying work and that it does not explicitly mislead as to the source of the work." Indeed, this is not the approach taken by the Second Circuit in *Rogers*, where the court specifically considered the survey evidence, and did so as to the specific form in which the false endorsement was made—a title to a motion picture, and found that although a factual dispute existed, it was not "genuine" for purposes of surviving summary judgment. *See Rogers*, 875 F.2d at 1001.

^{FN1}. Contrary to the claim made by the majority in footnote 11 of its opinion, this dissent in no way suggests that the balancing test set forth in *Rogers* is limited to titles. Rather, it is the majority's failure to consider evidence of confusion under the eight-factor test in relation to the specific artistic expression when applying the *Rogers* test to which this dissent takes issue.

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In response to this dissent, the majority merely set forth a single paragraph to its opinion claiming to take into account evidence of actual consumer confusion as balanced against Rush's "artistic expression" for purposes of concluding that the risk of consumer misunderstanding is so outweighed by the interest in artistic expression that application of the Act is "precluded." This single two-sentence paragraph fails to engage in any meaningful analysis of the balancing of the interests at hand, and particularly fails to account for the role of the eight-factor test in the *Rogers* balancing test. A significant inquiry into both prongs of the *Rogers* test is necessary when attempting to strike the appropriate balancing of interests, especially at the summary judgment stage, because questions of fact may be inappropriately decided in the absence any meaningful inquiry. See, e.g. *Parks*, 329 F.3d at 459 (remanding the case where issues of fact remained for trial as to the first prong, "the artistic relevance prong," of the *Rogers* test). Indeed, this Court remanded the case in *Parks* because questions of fact remained for trial as to the first prong of the *Rogers* test thus preventing the Court from balancing any interests as a matter of law at summary judgment. *Id.*

*946 The majority's contention that this case is like *Rogers* because the survey evidence merely indicates that some members of the public would draw the incorrect inference that Woods had some connection with Rush's print fails to account for the differences in the type of survey evidence in this case as opposed to that in *Rogers*. In *Rogers* the survey evidence indicated that only about 14% of the consumers polled indicated that Ginger Rogers was "involved in any way with making the film[;]" however, in this case, 62% of the consumers polled indicated that they believed that Woods had an "affiliation" or "connection" with Rush's print, or "approved" or "sponsored" the print. See 875 F.2d at 1001 n. 8. And of particular significance, the *Rogers* court found that such survey evidence failed to create a *genuine* issue of fact for the jury. Here, on the other hand, considering the stark difference in actual consumer confusion between this case and *Rogers*, a *genuine* issue of fact has been demonstrated for purposes of allowing this matter to proceed. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986) (noting that an issue of fact is "genuine" if the evidence is such that a reasonable jury could return a verdict for the nonmovant). The majority's misleading and wholesale use of language

from *Rogers* cannot serve to compel the outcome it argues for where the evidence and the facts involved differ so significantly.

As in *Rogers*, the artistic expression at issue in *Mattel*, the case from the Ninth Circuit relied upon by the majority, involved a title. See *Mattel*, 296 F.3d at 898. Specifically, the plaintiff, Mattel, Inc., creator of the Barbie doll, filed suit against MCA Records, Inc., along with others who produced, marketed, and sold the song "Barbie Girl," alleging trademark infringement, among other things. In addressing the plaintiff's claim, the Ninth Circuit first noted that "[o]ur likelihood-of-confusion test generally strikes a comfortable balance between the trademark owner's property rights and the public's expressive interests." *Id.* at 900 (citation omitted). However, the court went on to recognize that "when a trademark owner asserts a right to control how we express ourselves-when we'd find it difficult to describe the product any other way (as in the case of aspirin), or when the mark (like Rolls Royce) has taken on an expressive meaning apart from its source-identifying function-applying the traditional test fails to account for the full weight of the public's interest in free expression." *Id.* Said differently, "the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function." *Id.* (citation omitted).

With this in mind, the *Mattel* court then looked to *Rogers* and the Second Circuit's analysis therein. *Mattel*, 296 F.3d at 901. The Ninth Circuit noted that the result in *Rogers* may have been different if, for example, "a pair of dancing shoes had been labeled Ginger and Fred, [because] a dancer might have suspected that Rogers was associated with the shoes (or at least one of them), just as Michael Jordan has endorsed Nike sneakers that claim to fly through the air." *Id.* "But," the court went on to note, "*Ginger and Fred* was not a brand of shoe; it was the title of a movie and, for the reasons explained by the Second Circuit, deserved to be treated differently." *Id.* at 901-02. Thus, the court expressly noted the nature of the artistic expression, a title, and adopted the *Rogers* standard that "literary titles do not violate the Lanham Act 'unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.'" *Id.* at 902 (quoting *Rogers*, 875 F.2d at 999 (footnote omit-

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ted)). In concluding*947 that “MCA’s use of Barbie [was] not an infringement of Mattel’s trademark[,]” through the application of the *Rogers* balancing test, the court expressly found that “[t]he song title does not explicitly mislead as to source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel. The *only* indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy [the second] prong of the *Rogers* test, it would render *Rogers* a nullity.” *Id.* (emphasis in *Mattel*).

As indicated, the majority in the instant case relies in part upon *Mattel* when concluding that Plaintiff’s false endorsement claim fails because the presence of Woods’ image in Rush’s print has artistic relevance and does not explicitly mislead under the *Rogers* balancing test. However, the majority fails to consider the distinction set forth in *Mattel*—that the result in *Rogers* may have been different if, for example, “a pair of dancing shoes had been labeled Ginger and Fred, [because] a dancer might have suspected that *Rogers* was associated with the shoes (or at least one of them), just as Michael Jordan has endorsed Nike sneakers that claim to fly through the air.” *Id.* Indeed, the image of Woods holding his famous golf swing at the Masters, as nearly precisely portrayed in the poster sold by Nike by way of Plaintiff’s authorization, may have mislead a sports enthusiast or golfer to believe that Woods was associated with Rush’s print. And the survey evidence strongly indicates that such is the case. (J.A. at 311, Block Affidavit at ¶¶ 5-6.) (“[T]here is an extremely high probability that members of the relevant consuming universe believe that Tiger Woods has an affiliation or connection with ... the print.”). As a result, this case is distinguishable from *Mattel* because Plaintiff has brought forth evidence of a high degree of consumer confusion.

In response to this dissent, the majority added what appears as footnote 11 of its opinion stating, among other things, that it fails to see the significance of the comment made in *Mattel* that the result in *Rogers* may have been different if a pair of dancing shoes had been labeled Ginger and Fred, inasmuch as “Woods’s image in Rush’s print is not used to identify a product.” The “product” in this case is Rush’s print, and Rush prominently depicts Woods holding his swing at the Masters Tournament in the print, entitled *The Masters of Augusta*, such that the evidence indi-

cates that consumers believe that Woods sponsored or approved of the print.

While it is true that *Rogers* and *Mattel* employ a balancing test as opposed to the traditional eight-factor likelihood of confusion test set forth for trademark and unfair competition claims, these cases do not stand for the proposition that evidence of consumer confusion should be totally ignored in seeking to strike the appropriate balance between the public interest in free expression and the public interest in not being mislead. The *Rogers* court considered the survey evidence in striking the appropriate balance in that case, and thus the survey evidence should have been considered by the majority in this case, particularly where the expression at issue involves not just a title with no apparent connection to the product, but rather the total persona and embodiment of Woods in a pose closely associated with his status as a famous golfer which has been sold for commercial gain in the past. *See Rogers*, 875 F.2d at 1001 (concluding that the survey evidence did not raise a “genuine” issue of material fact for trial as to the plaintiff’s false endorsement claim, particularly where the “title ‘Ginger and Fred’ contain[ed] no explicit indication that *Rogers* endorsed the film or had a role in producing it”); *see also* *948*Mattel*, 296 F.3d at 902 (holding that summary judgment in favor of the defendants was appropriate because the “*only* indication that *Mattel* might be associated with the song [was] the use of Barbie in the title”—i.e., there was no evidence of likelihood of confusion) (emphasis in original).

The majority’s failure to meaningfully consider Plaintiff’s survey evidence is especially questionable in light of its citation and reliance upon *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir.1989). The Second Circuit decided *Cliffs Notes* shortly after deciding *Rogers* and, while recognizing that *Rogers* specifically involved a challenge to a title, found that the *Rogers* balancing test nonetheless applied to the parody at issue. *Id.* at 495. The court held that “the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression, a category that includes parody. *This approach takes into account the ultimate test in trademark law, namely, the likelihood of confusion as to source of the goods in question.*” *Id.* (citations and internal quotation marks omitted; emphasis added). In a footnote, the court explained that where the challenged

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work is one involving artistic expression, “the *Polaroid* factors [the eight-factor test] should be applied with proper weight given to First Amendment considerations....” *Id.* at 495 n. 3. In other words, in *Cliffs Notes* the Second Circuit made clear that when applying the *Rogers* balancing test—weighing the public interest in avoiding consumer confusion against the public interest in free expression—the eight-factor likelihood of confusion test and the evidence associated therewith, is to be considered in the balance when determining the weight to be afforded the public interest in avoiding consumer confusion. *See id.* at 495 & n. 3.

The majority claims in footnote 12 of its opinion that the dissent’s “insistence on applying the likelihood of confusion test appears untenable in light of *Parks*.” However, in light of the Second Circuit’s instruction in *Cliffs Notes*, that evidence associated with the eight-factor likelihood of confusion test is to be considered when determining the public interest in avoiding consumer confusion under the *Rogers* balancing test, it is the majority’s “insistence” in rejecting evidence of consumer confusion that “appears untenable.” *See Cliffs Notes*, 886 F.2d at 495 n. 3. And, in light of the express language of *Parks*, the majority’s position not only “appears untenable” but is completely unfounded. The *Parks* court recognized that *Rogers* qualified its holding in stating that “if the title of the work is artistically relevant to its content, there is no violation of the Lanham Act unless the ‘title explicitly misleads as to the source of or the content of the work.’ ” *Parks*, 329 F.3d at 458 (quoting *Rogers*, 875 F.2d at 999) (emphasis in *Parks*). Thus, *Parks* acknowledged that evidence of the likelihood of confusion must be considered for purposes of determining whether the expression at issue misleads the public as to the source of the work. *See id.* If the evidence establishes that the expression misleads the public as to the source of the work, then the balance likely weighs against the public interest in free expression. *Id.* Simply stated, in order to conduct any type of meaningful balance, the Court must consider evidence under both prongs of the *Rogers* test, and evidence of the likelihood of confusion as set forth in the eight-factor test is to be considered under the “misleading prong,” as characterized by *Parks*. *See id.*; *see also Cliffs Notes*, 886 F.2d at 495 n. 3.

In the matter at hand, however, the majority completely eschews the eight-factor test and the evidence

associated therewith when applying the *Rogers* balancing test. Thus, even if the majority is correct in its decision to broadly adopt the *Rogers* *949 balancing test as the law of this circuit in any case where a false endorsement or trademark claim is made against a work involving an artistic expression, the majority erroneously applies the balancing test by simply abandoning the considerations and evidence associated with the eight-factor likelihood of confusion test. In other words, the majority’s approach in this case not only adopts a standard that has never been used in this fashion by our circuit, but misapplies the standard, thereby leaving this circuit without proper guidance. As indicated, *supra*, the majority’s single-sentence attempt at balancing of the interests falls woefully short of any meaningful consideration of the matter.

Even under the *Rogers* standard, it is necessary for this case to be remanded on the issue of Plaintiff’s false endorsement claim since questions of fact remain as to the degree of consumer confusion associated with Rush’s print and Woods’ endorsement thereof. To hold otherwise not only runs counter to the approach espoused in *Rogers* and its progeny, but to the express word of Congress: that a plaintiff may prevail on a Lanham Act claim if he can prove that the use in commerce of the trademark “in connection with goods or services” is “likely to cause confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person....” 15 U.S.C. § 1125(a)(1)(A) (emphasis added). This is not to say that the ultimate outcome here would necessarily be a favorable one for Plaintiff; however, a jury should be able to make that decision after hearing all of the evidence presented by Plaintiff, as opposed to the majority’s truncated and abbreviated approach which fails to engage in any meaningful consideration of pertinent and relevant evidence of consumer confusion, and fails to engage in any significant balancing of the interests.

III. Trademark Claims Based on the Unauthorized Use of the Registered Mark- § 32 of the Lanham Act, 15 U.S.C. § 1114

Plaintiff brought suit against Defendant under § 32 for infringement of Plaintiff’s registered mark, “TI-

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GER WOODS.” The mark appears on the back of the envelope containing Rush’s print as well as in the narrative description of the print. The district court found that because Plaintiff failed to demonstrate that Defendant’s image of Woods was an infringing use, Defendant’s use of the registered mark amounted to a “fair use” under 15 U.S.C. § 1115(b). The majority makes a similar conclusion that Defendant’s use of the registered mark amounts to a fair use, but does so on the basis that the work upon which the registered mark appears or accompanies is an artistic expression. Whether following the reasoning of the district court or the majority, the result is shortsighted because it assumes that the underlying work upon which the registered mark appears is not an infringing use.

As explained in the above sections, Plaintiff brought forth evidence of actual consumer confusion in this case sufficient to create a genuine issue of material fact for trial as to whether the prints upon which the registered mark appears or accompanies is an infringing use of the unregistered mark under § 43(a). Indeed, the fatal flaw in the majority’s outcome as to Plaintiff’s claims brought under § 43(a) is its failure to consider the evidence of actual consumer confusion proffered by Plaintiff, or any of the other factors looked to when determining consumer confusion. Thus, to conclude that Defendant’s use of the registered mark is a fair use because the underlying work is not an infringing use is erroneous. Contrary to the majority’s contention in footnote 4 of its opinion, this dissent does not “misunderstand” the majority’s holding that Plaintiff’s claim on this issue fails because Defendant’s use of the registered mark was a fair use. The point made here is that the majority erroneously bases its fair use holding on its contention that the item upon which the mark appears, Rush’s print, is not itself an infringing use.

The proper approach is to look at Defendant’s use of the registered mark in the context of evidence of consumer confusion in order to determine whether the fair use doctrine can be applicable. See Paccar Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 255-56 (6th Cir.2003) (noting that “a finding of a likelihood of confusion forecloses a fair use defense”) (citations omitted). Once again, the majority fails to engage in any meaningful inquiry into consumer confusion and instead simply concludes that because Defendant’s print is an artistic expression, the use of the registered

mark in association therewith constitutes a permissible fair use under the Act. This approach is in contravention to the application of the fair use doctrine and § 32 of the Act. See id. at 249, 255-56.

Thus, as with Plaintiff’s claims brought under § 43(a) for infringement of the unregistered mark, the jury should be allowed to hear evidence as to the eight factors employed when ascertaining a likelihood of consumer confusion, and this is true even if a balancing approach is used. See, e.g., Rogers, 875 F.2d at 999. Furthermore, even assuming the majority to be correct in its notation that Plaintiff’s survey evidence of actual confusion was limited to the print itself and not the envelope or narrative accompanying the print, thus apparently leaving the fourth factor without evidentiary support, this still does nothing to change the fact that the remaining factors should be looked to for a proper determination of whether consumer confusion exists. See Wynn Oil Co. v. Am. Way Serv. Corp., 943 F.2d 595, 604 (6th Cir.1991) (finding that a lack of actual consumer confusion is not fatal to a § 32 claim where the remaining factors as a whole demonstrated consumer confusion). It should be pointed out that the majority’s contention, as set forth in footnote 4 of its opinion, that the dissent inappropriately discusses evidence of actual consumer confusion in reference to Plaintiff’s claim for infringement of the registered mark, is baffling and simply wrong. The point being made here is that even assuming that the evidence of actual consumer confusion does not apply to Plaintiff’s claim under § 32, this does nothing to change the fact that the other seven factors specific to the likelihood of confusion test should be examined, particularly at the summary judgment stage. See id.

IV. Dilution of the Mark under 15 U.S.C. § 1125

In Count II of its amended complaint, Plaintiff alleged dilution of the registered mark “TIGER WOODS” in violation of section 43(c) of the Act, 15 U.S.C. § 1125(c). The district court failed to engage in any independent analysis of Plaintiff’s dilution claim, and instead simply found that the dilution claim fell prey to summary judgment for the same reasons that Plaintiff’s trademark claims fell prey to summary judgment. See ETW Corp. v. Jireh Publ’g, Inc., 99 F.Supp.2d 829, 834 (N.D. Ohio 2000). The majority likewise fails to engage in any independent analysis and simply concludes in footnote 7 of its

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opinion that “since Woods's likeness does not function as a trademark which is subject to protection under the Lanham Act, it follows that a dilution claim does not lie.” Aside from its erroneous conclusion that Plaintiff has not brought forth evidence that Woods' image as portrayed in the *951 print functions as a trademark, the majority's conclusion in this regard is perplexing and legally incorrect inasmuch as Plaintiff based its dilution claim on the registered trademark. In addition, although it is true that “fair use” of a registered mark precludes an action for dilution under 15 U.S.C. § 1125(c)(4)(A), as stated in Part III of this dissent, the majority erroneously concludes that Defendant's use of the registered mark is a “fair use” inasmuch as the majority completely fails to consider evidence of consumer confusion. Thus, the majority's “short shrift given to [Plaintiff's] dilution claim[]” cannot carry the day. *Kellogg Co. v. Exxon Corp.*, 209 F.3d 562, 576 (6th Cir.2000); see also *Moseley v. Secret Catalogue, Inc.*, 537 U.S. 418, 123 S.Ct. 1115, 1119-122, 155 L.Ed.2d 1 (2003) (finding that a claim for dilution may stand even though the plaintiff's claim for trademark infringement was not successful).

The Lanham Act, as amended by the Federal Trademark Dilution Act of 1995, defines the term “dilution” as “the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.” 15 U.S.C. § 1127 (emphasis added). This Court has identified factors that a plaintiff must fulfill in order to succeed on a federal dilution claim, “(1) the senior mark must be famous; (2) it must be distinctive; (3) the junior use must be a commercial use in commerce; (4) it must begin after the senior mark has become famous; and (5) it must cause dilution of the distinctive quality of the senior mark.” *Kellogg*, 209 F.3d at 577 (quoting *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 215 (2d Cir.1999)). The Supreme Court recently made clear that in order to demonstrate dilution, the plaintiff must proffer objective evidence of actual dilution, “but that does not mean that the consequences of dilution, such as actual loss of sales or profits, must also be proved.” *Moseley*, 123 S.Ct. at 1124. Inasmuch as Plaintiff in the case at hand has brought forward evidence on each of these five elements of a federal dilution claim, the jury should be allowed to consider this claim as well.

V. Ohio Common Law Right of Publicity Claim

The majority makes a somewhat disjointed holding regarding Plaintiff's right of publicity claim. It first concludes that, under the rule of the Restatement, “Rush's work has substantial informational and creative content which outweighs any adverse effect on ETW's [Plaintiff's] market and the Rush's work does not violate Woods's right of publicity.” Then, the majority appears to engage in a separate analysis or balancing of the interests under the law of various circuits when it takes into account the degree of First Amendment protection that should be afforded Rush's print against Woods' “intellectual property right” in order to conclude that “[p]ermitting Woods' right of publicity to trump Rush's right of freedom of expression would extinguish Rush's right to profit from his creative enterprise.” Finally, engaging in yet a separate analysis under the “transformative effects test” pronounced by the California Supreme Court, the majority concludes that “[b]ecause Rush's work has substantial transformative elements, it is entitled to the full protection of the First Amendment. In this case, we find that Woods's right of publicity must yield to the First Amendment.” Thus, it appears that the majority engages in three separate analyses, and arrives at three separate holdings, although all of which reach the same result.

The majority's analysis not only fails in its disjointed approach but in its outcome *952 as well. The approach best suited for addressing Plaintiff's right of publicity claim in this case is that taken by the California Supreme Court in *Comedy III Productions v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797 (2001). This is so because the Court in *Comedy III* took account of a celebrity's right of publicity and the principles of the right in general, as balanced against competing First Amendment concerns, in arriving at a test for purposes of adjudicating a case that is nearly on all fours with the matter at hand. This approach takes into account all of the competing interests while allowing for a single well-determined outcome that provides guidance and adds to the jurisprudence as a whole. Before applying the *Comedy III* approach to the facts of this case, it is useful to review the background of the birth of the right of publicity, the considerations embodied in the right, and the competing First Amendment interests in freedom of expression.

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A. Background of the Right of Publicity

The right of publicity was born out of the common law right to privacy ^{FN2} when Circuit Judge Jerome Frank explicitly recognized the right of publicity as an independent action in *Haelan Laboratories, Inc. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir.1953). There, Judge Frank opined that

FN2. Commentators agree that the impetus behind privacy law in general was the seminal article authored by Samuel D. Warren and Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L.REVV. 193, 195 (1890), where the authors contended that people had a right to be left alone. See J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1.11 (2d ed.2000). Later, Prosser and Keeton proposed the legal recognition of a right to privacy encompassing four distinct causes of action, with the fourth being the misappropriation of an individual's name or likeness, from which the right of publicity evolved. See W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 117, at 851-68 (5th ed.1984); see also David J. Michna, *Tiger's Paper Tiger: The Endangered Right of Publicity*, 58 WASH. & LEE L.REV. 1155, 1159-160 (2001) (chronicling the evolution of publicity rights).

in addition to and independent of that right of privacy ..., a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross,' i.e., without an accompanying transfer of a business or of anything else. Whether it be labelled a 'property' right is immaterial; for here, as often elsewhere, the tag 'property' simply symbolizes the fact that courts enforce a claim which has pecuniary worth.

This right might be called a 'right of publicity.' For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing

advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. The right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

Id.; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b, 529 (1995) (noting the origins behind the right of publicity, and the historical connection between publicity rights and the right to privacy). Up until the time that Judge Frank labeled what he viewed as the right to control commercial use of human identity as the "right of publicity," the law "seemed unable to accommodate the claims of those whose identity was already public"-i.e, the famous. See MCCARTHY, *953 THE RIGHTS OF PUBLICITY AND PRIVACY § 1:7 (2d ed.2000). In other words, until the right of publicity was recognized, it appeared counterintuitive for a famous individual to base his claim that his identity was being used commercially without permission on the right of privacy. The right to privacy is premised upon the right to "left alone," and the famous person had already become well known commercially. However, it was the commercial nature of the person's identity which was precisely at issue; that is, it was not the desire to be left alone, but the desire to control the use of and be compensated for the use of one's persona. See *id.* And "thus was born the concept of a property right in the commercial value of every person's identity." *Id.* (emphasis in original)

Although the right of publicity grew out of the right of privacy, the right of publicity has within it characteristics of other rights such that it has been described as a " 'sui generis mixture of personal rights, property rights, and rights under unfair competition.' " See *id.* (quoting S.J. Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 112 (1980)). In addition, principles from various other areas of the law have been looked to and borrowed from when deciding right of publicity matters such as the law of copyright, trademark, and misappropriation. See *id.* Because of its inception in the law of privacy, and because of the various legal principles from other areas incorporated within it, the right of publicity remains a cause of action wherein the law is far from settled.

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That notwithstanding, since *Haelan*, “[t]he right of a person, whether or not termed ‘right of publicity,’ to control the commercial value and exploitation of his or her name and likeness has received wide recognition by the courts.” *Estate of Elvis Presley v. Russen*, 513 F.Supp. 1339, 1353 n. 6 (D.N.J.1981) (collecting cases). This Court has spoken on the right of publicity as follows:

The right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity. In *Memphis Development Foundation v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.1980), we stated: “The famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality.” *Id.* at 957.

Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 835 (6th Cir.1983) (analyzing right to publicity claim brought under Michigan common law). However, it should also be noted that other courts and commentators as well have found that “non-celebrities should also be permitted to recover upon proof that the appropriated identity possessed commercial value.” RESTATEMENT, *supra* § 46 cmt. d, 538; see MCCARTHY, *supra* § 4:3 (“[T]he basic possession of a right of publicity should have nothing to do with ‘celebrity’ status. Rather, ‘celebrity’ status will only be relevant to the economic value of a plaintiff's identity and persona.”) (footnote omitted); Roberta Rosenthal Kwall, *The Right of Publicity v. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 55-56 (1994) (noting that “the right of publicity has the potential for safeguarding from unauthorized use any marketable and publicly recognizable attribute of any individual, regardless of whether that person is a celebrity”) (footnote omitted); see also *Vinci v. Am. Can Co.*, 9 Ohio St.3d 98, 459 N.E.2d 507, 510 (1984) (finding that “the degree of notoriety” is relevant to damages rather than liability).

*954 At the present time, a majority of states recognize a right of publicity through common law, by statute, or both. See MCCARTHY, *supra* § 6:3 (noting that “at the time of this writing, under either stat-

ute or common law, the right of publicity is recognized as the law of twenty-eight states”); RESTATEMENT, *supra* § 46 statutory note (listing California, Florida, Kentucky, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, Texas, Virginia, and Wisconsin as those states recognizing a statutory right of publicity). Ohio recognizes the right of publicity as a part of the state's common law, see *Zacchini v. Scripps-Howard Broad. Co.*, 47 Ohio St.2d 224, 351 N.E.2d 454 (1976), *rev'd on other grounds*, 433 U.S. 562, 572, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977), and has recently codified that right.^{FN3} See Ohio Rev.Code § 2741.01 and § 2741.02 (defining “persona” to mean “an individual's name, voice, signature, photograph, image, likeness, or distinctive appearance, if any of these aspects have commercial” “value;” and making the unauthorized use of an individual's persona for a commercial purpose during the individual's lifetime or for a period of sixty years after the individual's death, a violation of the statute).

FN3. Because Ohio's right of publicity statute was enacted after the inception of this case, Plaintiff concedes that it is inapplicable here; however, Plaintiff looks to the statute by analogy as support for its common law right of publicity claim. See Plaintiff's Brief on Appeal at 19-20.

Although the wide recognition of the right of publicity among the states is a clear indication of its acceptance in the jurisprudence of society today, the differences between the various state statutes has led to confusion such that there is a large body of opinion advocating that a uniform preemptive federal law be adopted. See Symposium, *Rights of Publicity: An In-Depth Analysis of the New Legislative Proposal to Congress*, 16 CARDOZO ARTS & ENT. L.J. 209, 210 (1998) (“[O]ur Task Force has ... initiated a discussion aimed at producing its own federal right of publicity statute.... The subcommittee generally believes that a uniform body of law is desirable in this area, compared to the patchwork quilt with which the people of the United States are now afflicted.”)(comments of Steven M. Getzoff, then Chair of the American Bar Association Joint Task Force on federalizing the right of publicity); see also Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 477 (1999) (recognizing that “[t]here appears to be a general

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consensus that a uniform right of publicity is sorely needed," and that "[i]t also appears that most advocates of uniformity believe that preemptive federal law, rather than a uniform code or model state statutes, would more readily achieve that goal").

Aside from the confusing development of the right of publicity, and aside from the many differences associated with the various state statutes in effect, the point of confusion most associated with the right of publicity law is its interplay with the First Amendment. Each doctrine advances its own set of societal interests which often are in tension with one another. Those societal interests advanced by the right of publicity have been suggested to be that of "fostering creativity, safeguarding the individual's enjoyment of the fruits of her labors, preventing consumer deception, and preventing unjust enrichment." Roberta Rosenthal Kwall, *The Right of Publicity v. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 54 (1994) (footnotes omitted); see also Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L.REV. 127, 178-79 (1993) (suggesting that the "main justifications" *955 for the right of publicity are "moral arguments" (the right of individuals to reap the fruits of their labors)); "economic arguments" (needed incentive to stimulate creative growth); and "consumer protection" (protects consumers from deception and related marketplace harms). Two of the most frequently cited justifications for First Amendment free speech guarantees in this regard are the advancement of knowledge and search for the truth by fostering a free marketplace of ideas necessary to a democratic society, as well as the fulfillment of the human need for self-expression. *Id.* at 65-66. The tension between these interests is self-evident: while we want a free marketplace of ideas and expression, we wish to insure that any commercial value gained from that expression is not unjustly obtained through another's labors. See *Zacchini*, 433 U.S. at 576, 97 S.Ct. 2849 ("No social purpose is served by having the defendant [in a right of publicity case] get free some aspect of the plaintiff that would have market value and for which he would normally pay.").

Measures aimed at striking the appropriate balance between these competing interests have been the subject of much legal commentary. See, e.g., Haemmerli, *supra* at 383-84 (proposing to balance the right of

publicity as an autonomy-based property right and the First Amendment values of freedom of expression); Kwall, *supra* at 48, 63-113 (exposing the "massive confusion" surrounding the conflict between the right of publicity and the First Amendment, while proposing to resolve the conflict by applying a property and liability rule framework). Yet another commentator has expressed concern that the right of publicity frustrates the principles behind the First Amendment. See Madow, *supra* at 127 (arguing that "private, centralized ownership and control of celebrity images poses a more serious threat to cultural pluralism and self-determination than is sometimes realized"). The argument goes that as a society, we freely monitor the "comings and goings, missteps and heartbreaks" of celebrities, along with attempting to copy or emulate "their mannerisms, their styles, their modes of conversation and their modes of consumption;" however, "[b]y virtue of what is now widely known as the 'right of publicity,' the 'commercial' value of a celebrity's name, likeness, and other identifying characteristics is her private property, which she may enjoy and exploit, transfer and bequeath, as she alone thinks best." *Id.* at 128, 130 (footnotes omitted). This, it is maintained, leads to a potential right of censorship on the part of the celebrity thereby "limit[ing] the expressive and communicative opportunities of the rest of us." *Id.* at 145-46.

Despite the various commentary and scholarship assessing the virtues and drawbacks to the right of publicity when compared to First Amendment principles, the fact remains that the right of publicity is an accepted right and striking the balance between an individual's right of publicity against the speaker's First Amendment right is not an easy one. Bearing in mind the principles justifying the two rights, it is clear why Woods' right of publicity does not bow to Defendant's First Amendment rights in this case.

B. Woods' Right of Publicity Claim in this Case

Zacchini v. Scripps-Howard Broadcasting Company is the sole case from the Supreme Court to directly address the right of publicity, and the case came to the Supreme Court by way of *certiorari* from the Ohio Supreme Court under Ohio common law. See *Zacchini*, 47 Ohio St.2d 224, 351 N.E.2d 454 (1976), *rev'd on other grounds*, 433 U.S. 562, 572, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977). The plaintiff, *Zacchini*, was the performer of a live human *956 cannonball

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act who subsequently sued a television station that had videotaped and broadcast his entire performance without his consent. See 433 U.S. at 563-64, 97 S.Ct. 2849. The Supreme Court found in favor of Zacchini, holding that the First Amendment did not protect the television station against a right of publicity claim under Ohio common law. *Id.* at 565-66, 97 S.Ct. 2849. The Court explained that the enforcement of the right of publicity claim was not at odds with the First Amendment inasmuch as “the rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.” *Id.* at 576, 97 S.Ct. 2849.

Indeed, since *Zacchini*, “[t]he right of publicity has often been invoked in the context of commercial speech when the appropriation of a celebrity likeness creates a false and misleading impression that the celebrity is endorsing a product.” See *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797, 802 (2001) (citing *Waits v. Frito-Lay, Inc.* 978 F.2d 1093 (9th Cir.1992); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir.1988)). “Because the First Amendment does not protect false and misleading commercial speech, and because even non-misleading commercial speech is generally subject to somewhat lesser First Amendment protection, see *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Com’n*, 447 U.S. 557, 563-64 & 566, 100 S.Ct. 2343, 65 L.Ed.2d 341 (1980), the right of publicity often trumps the right of advertisers to make use of celebrity figures.” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 802. In this case, to the extent that the district court was correct in characterizing Defendant’s prints as expressive works and not as commercial products, even though Defendant was selling the prints for financial gain, the issue becomes what degree of First Amendment protection should be afforded to Defendant’s expressive work.

In answering this question, one must look beyond *Zacchini* inasmuch as *Zacchini* has been criticized as being very “narrowly drawn” in that it involved the wholesale reproduction of a live “entire act,” which is quite distinguishable from the unauthorized use of a person’s identity, particularly when the unauthorized use is in the form of an expressive work, as in the matter at hand. See MCCARTHY, supra at § 8:27

(recognizing that “while the *Zacchini* majority and dissenting opinions have been picked apart word by word by the commentators, no clear message emerges and no general rule is discernible by which to predict the result of conflicts between the right of publicity and the First Amendment.”) With that in mind, guidance is provided by the California Supreme Court because it has addressed the specific issue in a case nearly on all fours with that presented here; namely, *Comedy III Productions v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797 (2001). See MCCARTHY, supra at § 8:27 (stating that when deciding *Comedy III*, the California Supreme Court found that when the challenged speech is not in the category of “commercial speech,” what *Zacchini* teaches us is that valid interests behind the right of publicity must be balanced against First Amendment policies, and that an accommodation must be reached).

In *Comedy III*, the plaintiff, Comedy III Productions, which is the registered owner of all rights to the former comedy act known as The Three Stooges, filed suit against the defendants, Gary Saderup and Gary Saderup, Inc., seeking damages and injunctive relief for violation of, among other things, California’s right of publicity *957 statute in connection with the defendants’ sale of T-shirts and lithographs bearing the image of the Three Stooges produced from a charcoal drawing done by Saderup. See 106 Cal.Rptr.2d 126, 21 P.3d at 800. The defendants sold the T-shirts and lithographs without the plaintiff’s consent, profiting \$75,000 from the sale of these items. *Id.* at 800-01. The trial court found for the plaintiff, and entered judgment in the amount of \$75,000 as well as \$150,000 in attorney’s fees plus costs. *Id.* at 801. The court also issued a permanent injunction restraining Saderup from violating the statute by use of any likeness of The Three Stooges in lithographs, T-shirts, “or any other medium by which Saderup’s artwork may be sold or marketed.” *Id.* In addition, the trial court enjoined Saderup in several other respects regarding his marketing products in connection with The Three Stooges, but allowed Saderup’s original charcoal drawing from which the reproductions were made to be exempt from the injunction. *Id.* at 801.

The defendants appealed, and the court of appeals modified the judgment by striking the injunction on the basis that the plaintiff had not shown a likelihood of continued violation of the statute, and that the

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wording of the statute was overbroad. *Id.* However, the court of appeals affirmed in all other respects, thereby rejecting the defendants' arguments that 1) his conduct did not violate the terms of the statute; and 2) in any event, his conduct was protected by the constitutional guaranty of freedom of speech under the First Amendment. *Id.* The defendants appealed to the California Supreme Court, which granted leave to address the two arguments raised by the defendants. *Id.* For purposes of the matter at hand, we focus on the Supreme Court of California's analysis of the First Amendment argument.

The court began by recognizing that the defendants' First Amendment claim presented a difficult issue, in that the works in question were expressive works and not commercial advertisements. See Comedy III, 106 Cal.Rptr.2d 126, 21 P.3d at 802. The court noted that “[a]lthough [the defendants'] work was done for financial gain, the First Amendment is not limited to those who publish without charge.... An expressive activity does not lose its constitutional protection because it is undertaken for profit.” See *id.* (alterations, internal quotation marks, and citation omitted). The court then recognized the high degree of First Amendment protection for noncommercial speech about celebrities, but at the same time noted that not all expression that trenches on the right of publicity receives such protection. See *id.* Specifically, the court opined:

The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility. Often considerable money, time and energy are needed to develop one's prominence in a particular field. Years of labor may be required before one's skill, reputation, notoriety or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion. For some, the investment may eventually create considerable commercial value in one's identity.

Id. at 804-05 (internal quotation marks and citation omitted).

The court then found that the case before it exemplified that kind of creative labor. *Id.* According to the California Supreme Court, the three men who came to enjoy celebrity status began their career in vaudeville and it was a “long and arduous” process until

the three finally enjoyed the heights of slapstick comic celebrities known as The Three Stooges. See 106 Cal.Rptr.2d 126, 21 P.3d at 805. As the court stated, “[t]hrough their talent and *958 labor, they joined the relatively small group of actors who constructed identifiable, recurrent comic personalities that they brought to the many parts they were scripted to play.” *Id.* As a result, the issue became whether the defendants' First Amendment rights trumped the plaintiff's right of publicity.

Relying on *Zacchini* and several cases from lower courts recognizing a celebrity's right of publicity, the court found that depictions of celebrities which amounted to little more than the appropriation of the celebrity's economic value, were not protected by the First Amendment. See *id.* at 805. As that premise related to the expressive works at issue, the court opined:

It is admittedly 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. Certainly, any such test must incorporate the principle that the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity's image by censoring disagreeable portrayals. Once the celebrity thrusts himself or herself forward 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 scope. The necessary implication of this observation is that the right of publicity is essentially an economic right. What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame through the merchandising of the “name, voice, signature, photograph, or likeness” of the celebrity.

Comedy III, 21 P.3d at 807-08. Beyond this precept, the court looked to the first factor of copyright's fair use doctrine—“the purpose and character of the use”—for guidance. *Id.* at 808 (quoting 17 U.S.C. § 107(1)).

The court further looked to the United States Supreme Court regarding the purpose and application of this fair use factor and noted that the inquiry involved “ ‘whether the new work merely supersede[s] the

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objects of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is transformative.’ ” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 808 (internal quotation marks and citations omitted) (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579, 114 S.Ct. 1164, 127 L.Ed.2d 500 (1994)). The court found that looking to whether the work in question possessed any “transformative” elements squared with the Supreme Court’s finding in *Zacchini* that “[w]hen artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.” *Id.* (citing *Zacchini*, 433 U.S. at 575-76, 97 S.Ct. 2849). In other words, although the Supreme Court did not apply the transformative test *per se* in *Zacchini*, the Court looked to whether the defendant had simply appropriated the plaintiff’s performance in its entirety without any further creative effort. In addition, the court noted that the “transformative” test also squared with the First Amendment and the right of publicity inasmuch as “works of parody or other distortions of the celebrity figure are not, from the celebrity fan’s viewpoint, good substitutes for conventional depictions of the *959 celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect.” *Id.* (citing *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959, 974 (10th Cir.1996)). Said differently, “[t]he ‘transformative’ test ... protect[s] the right-of-publicity holder’s core interest in monopolizing the merchandising of celebrity images without unnecessarily impinging on the artists’ right of free expression.” *Id.* at 808 n. 10.

Applying the transformative test to an artist’s work at issue in *Comedy III*, the charcoal sketch made into lithographs and printed on T-shirts, the court found that the defendants’ work was not protected inasmuch as the creative contribution was subordinated to the overall goal of creating a literal image of the Three Stooges to commercially exploit their fame. *Id.* at 811. In doing so, the court noted that when an “artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her

fame, then the artist’s right of free expression is outweighed by the right of publicity.” *Id.*

In the instant case, where we are faced with an expressive work and the question of whether that work is protected under the First Amendment, the reasoning and transformative test set forth in *Comedy III* are in line with the Supreme Court’s reasoning in *Zacchini* as well as in harmony with the goals of both the right to publicity and the First Amendment. Applying the test here, it is difficult to discern any appreciable transformative or creative contribution in Defendant’s prints so as to entitle them to First Amendment protection. “A literal depiction of a celebrity, even if accomplished with great skill, may still be subject to a right of publicity challenge. The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809 (footnote omitted).

Indeed, the rendition done by Rush is nearly identical to that in the poster distributed by Nike. Although the faces and partial body images of other famous golfers appear in blue sketch blending in the background of Rush’s print, the clear focus of the work is Woods in full body image wearing his red shirt and holding his famous swing in the pose which is nearly identical to that depicted in the Nike poster. Rush’s print does not depict Woods in the same vein as the other golfers, such that the focus of the print is not the Masters Tournament or the other golfers who have won the prestigious green jacket award, but that of Woods holding his famous golf swing while at that tournament. Thus, although it is apparent that Rush is an adequately skilled artist, after viewing the prints in question it is also apparent that Rush’s ability in this regard is “subordinated to the overall goal of creating literal, conventional depictions of [Tiger Woods] so as to exploit his ... fame [such that Rush’s] right of free expression is outweighed by [Woods’] right of publicity.” *See id.* at 811.

In fact, the narrative that accompanies the prints expressly discusses Woods and his fame:

But the center of their [other golfers’] gaze is 1997 winner Tiger Woods, here flanked by his caddie, “Fluff”, and final round player partner’s (Constantino Rocca) caddie on right, displaying that awesome swing that sends a golf ball straighter and

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truer than should be humanly possible. Only his uncanny putting ability serves to complete his dominating performance that lifts him alongside the Masters of Augusta.

*960 Accordingly, contrary to the majority's conclusion otherwise, it is clear that the prints gain their commercial value by exploiting the fame and celebrity status that Woods has worked to achieve. Under such facts, the right of publicity is not outweighed by the right of free expression. See Comedy III, 106 Cal.Rptr.2d 126, 21 P.3d at 811 (noting that the marketability and economic value of the defendant's work was derived primarily from the fame of the three celebrities that it depicted and was therefore not protected by the First Amendment).

This conclusion regarding Plaintiff's right of publicity claim is in harmony with that regarding Plaintiff's claims brought under the Lanham Act. As the Restatement explains:

Proof of deception or confusion is not required in order to establish an infringement of the right of publicity. However, if the defendant's unauthorized use creates a false suggestion of endorsement or a likelihood of confusion as to source or sponsorship, liability may also be imposed for deceptive marketing or trademark or trade name infringement.

RESTATEMENT, *supra* § 46 cmt. b, 537.

Because Plaintiff has come forward with evidence of consumer confusion as to Woods' sponsorship of the products in question, it is for the jury to decide whether liability should be imposed for Plaintiff's claims brought under the Lanham Act, and this is true whether employing the balancing approach set forth in *Rogers* or simply employing the eight-factor test in the traditional sense. The majority's failure to do so in this case is in complete contravention to the intent of Congress, the principles of trademark law, and the well-established body of jurisprudence in this area. In addition, the jury should also be allowed to consider evidence regarding Plaintiff's federal dilution claim inasmuch as Plaintiff has proffered evidence on each element of this claim. Finally, although Plaintiff is entitled to summary judgment on its right of publicity claim, at the very least, this claim presents a question for the jury as well.

I therefore respectfully dissent from the majority opinion affirming summary judgment to Defendant as to all of Plaintiff's claims.

C.A.6 (Ohio),2003.
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(Cite as: 110 S.W.3d 363)

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Supreme Court of Missouri,
En Banc.
John DOE, a/k/a Tony Twist, Appellant,
v.
TCI CABLEVISION, et al., Respondents.
No. SC 84856.

July 29, 2003.

Former professional hockey player brought action against creators, publishers, and marketers of comic book that contained a villainous character with hockey player's name, seeking an injunction and damages for misappropriation of name. The Circuit Court, City of St. Louis, Robert H. Dierker, J., entered judgment notwithstanding the verdict (JNOV) in favor of defendants, overturning a \$24.5 million verdict, and denied injunctive relief, but it granted motion for new trial in event JNOV was reversed on appeal. Hockey player appealed. On transfer from the Court of Appeals, the Supreme Court, Stephen N. Limbaugh, Jr., J., granted transfer from the Court of Appeals and held that: (1) player's action was actually one for right-of-publicity tort; (2) player presented sufficient evidence that defendants used his name as a symbol of his identity, as required to make submissible case for right-of-publicity tort; (3) evidence that defendants used player's name to attract consumer attention to their products was sufficient to show that they used name intending to obtain a commercial advantage, as required to make submissible case; (4) use of player's name was not protected speech; and (5) requested injunction was overbroad.

Affirmed in part, reversed in part, and remanded.

West Headnotes

[1] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness;

Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k8.5(6))

Action by former professional hockey player to recover the amount of the fair market value that comic book creators, publishers, and marketers should have paid to use his name in connection with their products and for damage done to the commercial or endorsement value of his name amounted to an action for "right-of-publicity tort," and not "misappropriation-of-name tort."

[2] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness;

Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k8.5(6))

The interest protected by the misappropriation-of-name tort is the interest of the individual in the exclusive use of his own identity, insofar as it is represented by his name or likeness, and in so far as the use may be of benefit to him or others. Restatement (Second) of Torts § 652C.

[3] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness;

Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k8.5(6))

Misappropriation-of-name tort protects against intrusion upon an individual's private self-esteem and dignity, while the right-of-publicity tort protects against commercial loss caused by appropriation of an individual's identity for commercial exploitation.

[4] Damages 115 ↪ 57.37

115 Damages

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115III Grounds and Subjects of Compensatory Damages

115III(A) Direct or Remote, Contingent, or Prospective Consequences or Losses

115III(A)2 Mental Suffering and Emotional Distress

115k57.36 Injury to Property or Property Rights

115k57.37 k. In General. Most Cited Cases

(Formerly 115k49.10, 115k49)

In a misappropriation-of-name action, a plaintiff may recover damages not only for pecuniary loss, but also for mental or emotional distress and suffering. Restatement (Third) of Unfair Competition § 49.

[5] Damages 115 ↪ 114

115 Damages

115VI Measure of Damages

115VI(B) Injuries to Property

115k114 k. Injuries Affecting Limited or Special Rights or Interests. Most Cited Cases

In a right-of-publicity action, the measure of damages properly focuses on the pecuniary loss to the plaintiff or the unjust pecuniary gain to the defendant. Restatement (Third) of Unfair Competition § 49.

[6] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases
(Formerly 379k8.5(6))

To establish a "misappropriation-of-name tort," the plaintiff must prove that the defendant used the plaintiff's name without consent to obtain some advantage.

[7] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k8.5(6))

In a right-of-publicity action, a plaintiff must prove that the defendant used the plaintiff's name to obtain a commercial advantage. Restatement (Third) of Unfair Competition § 46.

[8] Torts 379 ↪ 385

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k385 k. Elements of the Tort in General. Most Cited Cases

(Formerly 379k8.5(6))

The elements of a "right-of-publicity tort" include: (1) that defendant used plaintiff's name as a symbol of his identity; (2) without consent; (3) and with the intent to obtain a commercial advantage. Restatement (Third) of Unfair Competition § 46.

[9] Appeal and Error 30 ↪ 927(2)

30 Appeal and Error

30XVI Review

30XVI(G) Presumptions

30k927 Dismissal, Nonsuit, Demurrer to Evidence, or Direction of Verdict

30k927(2) k. Dismissal or Nonsuit in General. Most Cited Cases

Generally, in determining whether a plaintiff made a submissible case, the evidence is considered in the light most favorable to the plaintiff, giving him all reasonable beneficial inferences; it is only where there is a complete absence of probative fact to support the jury's conclusion that the Supreme Court will decide that a submissible case was not made.

[10] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases
(Formerly 379k8.5(6))

Former professional hockey player presented suffi-

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cient evidence to prove that comic book creators, publishers, and marketers used his name as a symbol of his identity, as required to make a submissible case for right-of-publicity tort, even though comic book character with player's name did not physically resemble player and its story line did not attempt to track his life, where both character and hockey player shared same unusual name and persona of a tough-guy enforcer, and at some point both player and his mother were approached by young hockey fans who believed that player was somehow affiliated with comic book character.

[11] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness;
Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k8.5(6))

To establish that a defendant used a plaintiff's name as a symbol of his identity, for purposes of establishing right-of-publicity tort, the name used by the defendant must be understood by the audience as referring to the plaintiff. Restatement (Third) of Unfair Competition § 46.

[12] Torts 379 ↪ 366

379 Torts

379IV Privacy and Publicity

379IV(B) Privacy

379IV(B)4 Evidence

379k366 k. Admissibility. Most Cited

Cases

(Formerly 379k27)

Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness;
Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k8.5(6))

In resolving issue of whether a defendant used a plaintiff's name as a symbol of his identity, for purposes of a right-of-publicity action, the fact-finder may consider evidence including the nature and extent of the identifying characteristics used by the defendant, the defendant's intent, the fame of the plaintiff, evidence of actual identification made by third persons, and surveys or other evidence indicating the perceptions of the audience. Restatement (Third) of Unfair Competition § 46.

[13] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness;
Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k8.5(6))

In meeting the commercial advantage element of misappropriation-of-name tort, it is irrelevant whether defendant intended to injure the plaintiff or actually succeeded in obtaining a commercial advantage from using plaintiff's name.

[14] Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness;
Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k8.5(6))

Evidence that comic book creators, publishers, and marketers used former professional hockey player's name for a villainous comic book character to attract consumer attention to the comic books and related products was sufficient to show that they used the name intending to obtain a commercial advantage, as required to make a submissible case for right-of-publicity tort, even if they did not intend to injure player's marketability and derived no pecuniary benefit from use of his name.

[15] Constitutional Law 92 ↪ 1630

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92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(D) False Statements in General

92k1630 k. Right of Publicity; Misappropriation of Likeness, Name, or Celebrity Status. Most Cited Cases

(Formerly 92k90.1(1))

Torts 379 ↪ 391

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k391 k. Defenses in General. Most Cited Cases

(Formerly 379k8.5(6))

Use of former professional hockey player's name as the name of a villainous comic book character with Mafia connections as a metaphorical reference, through literary device, to tough-guy enforcers had very little literary or artistic value compared to its commercial value, and thus was not protected speech under the First Amendment; use and identity of the name was predominantly a ploy to sell comic books and related products rather than artistic or literary expression. U.S.C.A. Const. Amend. 1.

[16] Appeal and Error 30 ↪ 1064.1(2.1)

30 Appeal and Error

30XVI Review

30XVI(J) Harmless Error

30XVI(J)18 Instructions

30k1064 Prejudicial Effect

30k1064.1 In General

30k1064.1(2) Particular Cases

30k1064.1(2.1) k. In General.

Most Cited Cases

Torts 379 ↪ 388

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k388 k. Name. Most Cited Cases

(Formerly 379k28)

By requiring that jury find only that defendants "derived advantage from the use or publication of plaintiff's name," as opposed to a finding that they used plaintiff's name with the intent to derive or for the purpose of deriving an advantage, the jury was allowed to render a verdict that could have been based on the mere incidental result of the use rather than the intentional result, and thus, such instruction warranted reversal of verdict in favor of plaintiff in action for tort of right of publicity; jury may well have determined that defendants obtained a commercial advantage even though they did not intend to do so.

[17] Constitutional Law 92 ↪ 1630

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(D) False Statements in General

92k1630 k. Right of Publicity; Misappropriation of Likeness, Name, or Celebrity Status. Most Cited Cases

(Formerly 92k90.1(1))

Injunction 212 ↪ 189

212 Injunction

212V Permanent Injunction and Other Relief

212k189 k. Nature and Scope of Relief. Most Cited Cases

Requested permanent injunction, prohibiting comic book creators, publishers, and marketers from using former professional hockey player's name, commercial image, persona, autograph or likeness "for any purpose" without his consent, was overbroad, considering that it would prohibit a variety of expressive activities undoubtedly protected by the First Amendment, such as, a parody of player, a commentary on his hockey fighting style, or a factual report on his lawsuit. U.S.C.A. Const. Amend. 1.

*365 John E. Bardgett, Sr., Robert D. Blitz, Thomas Avery, Clayton, James P. Holloran, St. Louis, for Appellant.

Michael A. Kahn, Peter W. Saisich, III, Geoffrey G. Gerber, Edwin D. Akers, Jr., Melanie R. King, St. Louis, for Respondents.

STEPHEN N. LIMBAUGH, JR., Judge.

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Appellant Anthony Twist, also known as Tony Twist, is a former professional hockey player in the National Hockey League. After learning of the existence of a comic book, titled *Spawn*, that contained a villainous character sharing his name, Twist brought misappropriation of name and defamation claims against respondents, the creators, publishers and marketers of *Spawn* and related promotional products. Respondents defended on First Amendment grounds. The circuit court dismissed the defamation count, but allowed the misappropriation of name count to go to trial, which resulted in a jury verdict in favor of Twist in the amount of \$24,500,000. The circuit court, however, granted respondents' motion for judgment notwithstanding the verdict and, in the alternative, ordered a new trial in the event that its judgment notwithstanding the verdict was overturned on appeal. A request for injunctive relief was also denied. After appeal to the Court of Appeals, Eastern District, this Court granted transfer. Mo. Const. art. V, sec. 10.

I.

Tony Twist began his NHL career in 1988 playing for the St. Louis Blues, later *366 to be transferred to the Quebec Nordiques, only to return to St. Louis where he finished his career in 1999, due to injuries suffered in a motorcycle accident. During his hockey career, Twist became the League's preeminent "enforcer," a player whose chief responsibility was to protect goal scorers from physical assaults by opponents. In that role, Twist was notorious for his violent tactics on the ice. Describing Twist, a *Sports Illustrated* writer said: "It takes a special talent to stand on skates and beat someone senseless, and no one does it better than the St. Louis Blues left winger." Austin Murphy, *Fighting For A Living: St. Louis Blues Enforcer Tony Twist, Whose Pugilistic Talents Appear To Run In The Family, Doesn't Pull Any Punches On The Job*, SPORTS ILLUSTRATED, Mar. 16, 1998, at 42. The article goes on to quote Twist as saying, "I want to hurt them. I want to end the fight as soon as possible and I want the guy to remember it." *Id.*

Despite his well-deserved reputation as a tough-guy "enforcer," or perhaps because of that reputation, Twist was immensely popular with the hometown fans. He endorsed products, appeared on radio and

television, hosted the "Tony Twist" television talk show for two years, and became actively involved with several children's charities. It is undisputed that Twist engaged in these activities to foster a positive image of himself in the community and to prepare for a career after hockey as a sports commentator and product endorser.

Respondent Todd McFarlane, an avowed hockey fan and president of Todd McFarlane Productions, Inc. (TMP), created *Spawn* in 1992. TMP employs the writers, artists and creative staff responsible for production of the comic book. *Spawn* is marketed and distributed monthly by Image Comics, Inc., which was formed by McFarlane and others.

Spawn is "a dark and surreal fantasy" centered on a character named Al Simmons, a CIA assassin who was killed by the Mafia and descended to hell upon death. Simmons, having made a deal with the devil, was transformed into the creature *Spawn* and returned to earth to commit various violent and sexual acts on the devil's behalf. In 1993, a fictional character named "Anthony 'Tony Twist' Twistelli" was added to the *Spawn* storyline. The fictional "Tony Twist" is a Mafia don whose list of evil deeds includes multiple murders, abduction of children and sex with prostitutes. The fictional and real Tony Twist bear no physical resemblance to each other and, aside from the common nickname, are similar only in that each can be characterized as having an "enforcer" or tough-guy persona.

Each issue of the *Spawn* comic book contains a section entitled "Spawning Ground" in which fan letters are published and McFarlane responds to fan questions. In the September 1994 issue, McFarlane admitted that some of the *Spawn* characters were named after professional hockey players, including the "Tony Twist" character: "Antonio Twistelli, a/k/a Tony Twist, is actually the name of a hockey player of the Quebec Nordiques." And, again, in the November 1994 issue, McFarlane stated that the name of the fictional character was based on Twist, a real hockey player, and further promised the readers that they "will continue to see current and past hockey players' names in my books."

In April 1996, *Wizard*, a trade magazine for the comic book industry, interviewed McFarlane. In the published article, "Spawning Ground: A Look at the

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Real Life People Spawn Characters Are Based Upon,” McFarlane is quoted as saying that *367 he uses the names of real-life people to create the identities of the characters. Brief biographies and drawings of the *Spawn* characters follow the McFarlane interview. The paragraph devoted to the “Tony Twist” character contained a drawing of the character accompanied by the following description:

First Appearance: *Spawn* # 6

Real-Life Persona: Tony Twist.

Relation: NHL St. Louis Blues right winger.

The Mafia don that has made life exceedingly rough for Al Simmons and his loved ones, in addition to putting out an ill-advised contract on the Violator, is named for former Quebec Nordiques hockey player Tony Twist, now a renowned enforcer (i.e. “Goon”) for the St. Louis Blues of the National Hockey League.

Below the character description was a photo of a Tony Twist hockey trading card, in which Twist was pictured in his St. Louis Blues hockey jersey.

In 1997, Twist became aware of the existence of *Spawn* and of the comic book’s use of his name for that of the villainous character. On one occasion, several young hockey fans approached Twist’s mother with *Spawn* trading cards depicting the Mafia character “Tony Twist.” Subsequently, at an autograph session Twist was asked to sign a copy of the *Wizard* article in which McFarlane was interviewed and Twist’s hockey trading card was pictured.

In October 1997, Twist filed suit against McFarlane and various companies associated with the *Spawn* comic book (collectively “respondents”), seeking an injunction and damages for, *inter alia*, misappropriation of name and defamation, the latter claim being later dismissed. McFarlane and the other defendants filed motions for summary judgment asserting First Amendment protection from a prosecution of the misappropriation of name claim, but the motions were overruled.

At trial, McFarlane denied that the comic book character was “about” the real-life Tony Twist despite the

fact that the names were the same. McFarlane also denied that he or the other defendants had attained any benefit by using Twist’s name. Twist, however, presented evidence that McFarlane and the other defendants had indeed benefited by using his name. For example, Twist introduced evidence suggesting that in marketing *Spawn* products, McFarlane directly targeted hockey fans—Twist’s primary fan base—by producing and licensing *Spawn* logo hockey pucks, hockey jerseys and toy zambonis. On cross-examination, McFarlane admitted that on one occasion defendants sponsored “*Spawn* Night” at a minor league hockey game, where McFarlane personally appeared and distributed *Spawn* products, including products containing the “Tony Twist” character. Another “*Spawn* Night” was planned to take place at a subsequent NHL game, but the event never occurred. On the issue of damages, Twist, through purported expert testimony, offered a formula for determining the fair market value that McFarlane and the other defendants should have paid Twist to use his name. In addition, Twist introduced evidence that his association with the *Spawn* character resulted in a diminution in the commercial value of his name as an endorser of products. To that end, Sean Philips, a former executive of a sports nutrition company, testified that his company withdrew a \$100,000 offer to Twist to serve as the company’s product endorser after Philips learned that Twist’s name was associated with the evil Mafia don in the *Spawn* comic book.

As noted, at the conclusion of the trial, the jury returned a verdict in favor of Twist and against the defendants jointly in *368 the amount of \$24,500,000. On motions for a judgment notwithstanding the verdict or in the alternative a new trial, the circuit court overturned the verdict finding that Twist had failed to make a submissible case on the misappropriation of name count. The court further held that in the event the judgment notwithstanding the verdict was reversed on appeal, the motion for new trial was granted for evidentiary and instructional errors. Finally, the circuit court denied Twist’s request for injunctive relief.

II.

[1][2][3] The tort of misappropriation of name is one of four recognized torts falling under the general heading of invasion of privacy. *Sullivan v. Pulitzer Broadcasting Co.*, 709 S.W.2d 475, 477 (Mo. banc

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1986). The interest protected by the misappropriation of name tort “is the interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness, and in so far as the use may be of benefit to him or others.” RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. a (1977). Recently, development of the misappropriation of name tort has given rise to a separate yet similar tort termed the “right of publicity,” which is said to “protect a person from losing the benefit of their [sic] work in creating a publicly recognizable persona.” Bear Foot, Inc. v. Chandler, 965 S.W.2d 386, 389 (Mo.App.1998). Though facially similar, the protections afforded by each tort are slightly different: “the [misappropriation of name tort] protects against intrusion upon an individual's private self-esteem and dignity, while the right of publicity protects against commercial loss caused by appropriation of an individual's [identity] for commercial exploitation.” 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION sec. 28.6 (4th ed.2003); see also Bear Foot, 965 S.W.2d at 389 (“In contrast to the [misappropriation of name tort], the right of publicity is not intended to protect the person's feelings....”)

[4][5] Because the two torts differ in the type of protection that each seeks to provide, there are corresponding differences between the types of damages that may be recovered. In a misappropriation of name action, a plaintiff may recover damages not only for pecuniary loss, but also for mental or emotional distress and suffering. See Haith v. Model Cities Health Corp. of Kansas City, 704 S.W.2d 684, 688 (Mo.App.1986); RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 49 cmt. b (1995); MCCARTHY, TRADEMARKS sec. 28.6 (explaining that in misappropriation of name actions, damages are “measured by ‘mental distress’-some bruising of the human psyche.”) By contrast, in a right of publicity action, “the measure of damages properly focuses on the pecuniary loss to the plaintiff or the unjust pecuniary gain to the defendant.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 49 cmt. b; see also Bear Foot, 965 S.W.2d at 389; Haith, 704 S.W.2d at 688.

In this case, Twist seeks to recover the amount of the fair market value that respondents should have paid to use his name in connection with Spawn products and for damage done to the commercial value-in ef-

fect the endorsement value-of his name. Therefore, Twist's case, though brought as a misappropriation of name action, is more precisely labeled a right of publicity action—a point that both parties appear to concede in their briefs.

[6][7] Despite the differences in the types of damages that may be recovered, the elements of the two torts are essentially the same. To establish the misappropriation tort, the plaintiff must prove that the defendant used the plaintiff's name without consent to obtain some advantage. *369 Nemani v. St. Louis Univ., 33 S.W.3d 184, 185 (Mo. banc 2000); Haith, 704 S.W.2d at 687. In a right of publicity action, the plaintiff must prove the same elements as in a misappropriation suit, with the minor exception that the plaintiff must prove that the defendant used the name to obtain a *commercial* advantage. RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46; see also RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. b (explaining that, in contrast, the misappropriation of name tort applies when plaintiff's name is used for commercial *or* non-commercial advantage). Given the similarity of elements of the two actions, Missouri cases analyzing the tort of misappropriation of name are pertinent to our recognition of a right of publicity claim.

In Nemani, the plaintiff, a research professor, brought suit against St. Louis University after the university used plaintiff's name in support of a federal grant application. This Court, reviewing the claim as a misappropriation of name tort, held that a defendant is liable under the tort when it uses a plaintiff's name without consent to obtain an advantage. 33 S.W.3d at 185. However, this Court was careful to point out that “[n]ot all uses of another's name are tortious”:

It is the plaintiff's name *as a symbol of [his] identity* that is involved here, and not [his name] as a mere name. Name appropriation occurs where a defendant makes use of the name to pirate the plaintiff's identity for some advantage.

Id. (Citations omitted.) (Emphasis added.) See also Haith, 704 S.W.2d 684; Munden v. Harris, 153 Mo.App. 652, 134 S.W. 1076 (1911).

In addition, though Nemani did not expressly so hold, an element of intent is implicit in the requirement that the identity be used to obtain an advantage. In a right

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of publicity case, plaintiff must prove that defendant intended to obtain a commercial advantage, and it is not enough to show that defendant incidentally obtained a commercial advantage by using plaintiff's name or that defendant had some other purpose in using plaintiff's name other than to obtain a commercial advantage. Wendt v. Host Int'l, Inc., 125 F.3d 806, 811 (9th Cir.1997); Benavidez v. Anheuser Busch, Inc., 873 F.2d 102, 104 (5th Cir.1989); Henley v. Dillard Dept. Stores, 46 F.Supp.2d 587, 596 (N.D.Tex.1999); see generally RESTATEMENT (SECOND) OF TORTS sec. 652C cmt. d (explaining that a misappropriation of name or likeness claim stands only if the name or likeness was used "for the purpose of appropriating to the defendant's benefit the commercial or other values associated with the name of likeness").

[8] To summarize, in view of Nemani and the earlier precedent of Bear Foot, and consistent with the RESTATEMENT (THIRD) OF UNFAIR COMPETITION, the elements of a right of publicity action include: (1) That defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage.

In this case, the circuit court's entry of JNOV was based on a finding that Twist failed to make a submissible case on the commercial advantage element. In addition, and though the court implicitly held otherwise, respondents claim that the grant of JNOV also was justified because Twist failed to prove that his name was used as "symbol of his identity."

[9] "Generally, in determining whether a plaintiff made a submissible case, the evidence is considered in the light most favorable to the plaintiff, giving him all reasonable beneficial inferences." Emery v. Wal-Mart Stores, Inc., 976 S.W.2d 439, 443 (Mo. banc 1998). It is "only where *370 there is a complete absence of probative fact to support the jury's conclusion" that this Court will decide that a submissible case was not made. Giddens v. Kansas City Southern Ry. Co., 29 S.W.3d 813, 818 (Mo. banc 2000).

A.

[10][11][12] Respondents' initial contention that Twist did not prove that his name was used as a "symbol of his identity" is spurious. To establish that a defendant used a plaintiff's name as a symbol of his

identity, "the name used by the defendant must be understood by the audience as referring to the plaintiff." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46 cmt. d; see also J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY sec. 4.48 (2d ed.2000) (quoting Geisler v. Petrocelli, 616 F.2d 636, 639 (2d Cir.1980)) (stating that the defendant's use of the name must be " 'something more than [an] amusing coincidence' "). In resolving this issue, the fact-finder may consider evidence including "the nature and extent of the identifying characteristics used by the defendant, the defendant's intent, the fame of the plaintiff, evidence of actual identification made by third persons, and surveys or other evidence indicating the perceptions of the audience." RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 46 cmt. d.

Here, all parties agree that the "Tony Twist" character is not "about" him, in that the character does not physically resemble Twist nor does the *Spawn* story line attempt to track Twist's real life. Instead, Twist maintains that the sharing of the same (and most unusual) name and the common persona of a tough-guy "enforcer" create an unmistakable correlation between Twist the hockey player and Twist the Mafia don that, when coupled with Twist's fame as a NHL star, conclusively establishes that respondents used his name and identity. This Court agrees. Indeed, respondent McFarlane appears to have conceded the point by informing his readers in separate issues of *Spawn* and in the *Wizard* article that the hockey player Tony Twist was the basis for the comic book character's name.

Arguably, without these concessions, some *Spawn* readers may not have made the connection between Twist and his fictional counterpart. However, other evidence at trial clearly demonstrated that, at some point, *Spawn's* readers did in fact make the connection, for both Twist and his mother were approached by young hockey fans under the belief that appellant was somehow affiliated with the *Spawn* character. On this record, respondents cannot seriously maintain that a good many purchasers of *Spawn* did not readily understand that respondents' use of the name referred to appellant. Accordingly, this Court holds that Twist presented sufficient evidence to prove that his name was used as a symbol of his identity.

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B.

As noted, the grant of JNOV was based on the commercial advantage element of the cause of action. Specifically, the court held that the record was devoid of credible evidence that respondents intended (1) “to injure Twist’s marketability,” (2) “to capitalize on the market recognition of the name,” or (3) “derived any pecuniary benefit whatsoever from the use of that name.”

[13][14] At the outset, two of the premises for the circuit court’s rationale are incorrect: Twist was under no obligation to prove that respondents intended to injure Twist’s marketability or that respondents actually derived a pecuniary benefit from the use of his name. As explained, the commercial advantage element of the right of publicity focuses on the defendant’s intent or purpose to obtain a commercial*371 benefit from use of the plaintiff’s identity. But in meeting the commercial advantage element, it is irrelevant whether defendant intended to injure the plaintiff, MCCARTHY, RIGHTS OF PUBLICITY sec. 3.28, or actually succeeded in obtaining a commercial advantage from using plaintiff’s name, see *Brown v. Ames*, 201 F.3d 654, 661-62 (5th Cir.2000); *Henley*, 46 F.Supp.2d at 597; MCCARTHY, RIGHTS OF PUBLICITY sec. 3.2. That said, it still was incumbent upon Twist to prove that respondents used his name intending to obtain a commercial advantage.

Twist contends, and this Court again agrees, that the evidence admitted at trial was sufficient to establish respondents’ intent to gain a commercial advantage by using Twist’s name to attract consumer attention to *Spawn* comic books and related products. As the Ninth Circuit noted in *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 416 (9th Cir.1996), “The first step toward selling a product or service is to attract the consumers’ attention.” (Citation omitted.) See also *id.* at 415 (holding that to the extent that defendant’s use of plaintiff’s name attracted consumers’ attention to its product, defendant gained a commercial advantage); *Henley*, 46 F.Supp.2d at 597 (holding that the commercial advantage or benefit element is shown if by using plaintiff’s name or likeness in the product defendant sought “to catch the eye of the consumer and make the [product] more interesting”); RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 47 cmt. c. At a minimum, re-

spondents’ statements and actions reveal their intent to create the impression that Twist was somehow associated with the *Spawn* comic book, and this alone is sufficient to establish the commercial advantage element in a right of publicity action. See *Abdul-Jabbar*, 85 F.3d at 414-16; *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835-36 (6th Cir.1983) (holding that defendants violated plaintiff Johnny Carson’s right of publicity when it used the phrase, “Here’s Johnny,” in its advertisement); *Henley*, 46 F.Supp.2d at 592-93 (holding in right of publicity case that defendant’s use of the words, “Don’s Henley,” in advertisement was intended to elicit an association with plaintiff Don Henley).

But this is not all. At trial, Twist introduced evidence that respondents marketed their products directly to hockey fans. For example, respondents produced and distributed *Spawn* hockey jerseys and pucks and sponsored a “*Spawn* Night” at a minor league hockey game where other *Spawn* products were distributed, including products featuring the character “Tony Twist.” Additionally, Twist points to McFarlane’s statement in the November 1994 issue of *Spawn*, in which he promised readers that “they will continue to see current and past hockey players’ names in [his] books.” This statement, Twist correctly contends, amounts to an inducement to *Spawn* readers, especially those who are also hockey fans, to continue to purchase the comic book in order to see the name Tony Twist and other hockey players. This is evidence from which the jury could infer that respondents used his name to obtain a commercial advantage.

In support of the court’s ruling that the evidence presented was insufficient to show that Twist’s name was used to obtain a commercial advantage, respondents cite *Nemani*, *Haith*, and *Munden* to demonstrate the kind of commercial advantage that must be shown and to highlight that Twist’s evidence was dissimilar. In *Nemani* and *Haith*, the defendants used the plaintiffs’ names in grant applications for money; in *Munden*, the defendant used a picture of the plaintiff in an advertisement. Though it is true that respondents’ intent to obtain a commercial advantage is not as *372 obvious as that found in *Nemani*, *Haith*, and *Munden*, the fact remains that to the extent that the evidence suggests that respondents used Twist’s name to attract attention to their product, they did so to obtain a commercial advantage. Therefore, this

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Court holds that Twist presented sufficient evidence to establish that respondents used his name for a commercial advantage.

III.

[15] Having determined that Twist made a submissible case at trial, we next address whether the right of publicity claim is nevertheless prohibited by the First Amendment. Courts throughout the country have struggled with this issue. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L.REV.V. 471, 488-98 (2003). Of course, not all speech is protected under the First Amendment, and in cases like this, courts often will weigh the state's interest in protecting a plaintiff's property right to the commercial value of his or her name and identity against the defendant's right to free speech.

Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977), is the first and only right of publicity case decided by the Supreme Court. The case involved the unauthorized broadcast of a videotape of the plaintiff's 15-second "human cannonball" act during a nightly news program. The plaintiff brought suit under the state-recognized tort of right of publicity, alleging that the unauthorized broadcast amounted to an "unlawful appropriation" of his "professional property," and the defendant broadcasting company defended on First Amendment grounds. In balancing the respective parties' interests, the Court held, "Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent." *Zacchini*, 433 U.S. at 574-75, 97 S.Ct. 2849. Because the *Zacchini* Court limited its holding to the particular facts of the case—the appropriation of plaintiff's "entire act"—it does not control the case at hand. Nonetheless, there are larger lessons that are certainly applicable.

First, the Court acknowledged, as had many lower courts previously, that the right of publicity is not always trumped by the right of free speech. Explaining the competing right of publicity interests, the Court observed that "[t]he rationale for protecting the right of publicity is the straightforward one of pre-

venting unjust enrichment by the theft of goodwill. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." *Id.* at 576, 97 S.Ct. 2849.

Second, the Court distinguished claims for right of publicity or name appropriateness from claims for defamation like those adjudicated in *New York Times v. Sullivan*, 376 U.S. 254, 84 S.Ct. 710, 11 L.Ed.2d 686 (1964), and *Hustler Magazine v. Falwell*, 485 U.S. 46, 108 S.Ct. 876, 99 L.Ed.2d 41 (1988), and claims for "publicity that places plaintiff in a 'false light'" like that adjudicated in *Time, Inc. v. Hill*, 385 U.S. 374, 87 S.Ct. 534, 17 L.Ed.2d 456 (1967). Because property interests are involved in the former categories but not the latter, *Zacchini*, 433 U.S. at 573, 97 S.Ct. 2849, the Court refused to apply the *New York Times v. Sullivan* "actual malice" standard that speech is privileged unless it was "knowingly false or was published with reckless disregard for the truth." *373 *Id.* at 571, 97 S.Ct. 2849, *et seq.* As the Court later made clear in *Hustler*, *Zacchini* stands for the proposition that "the 'actual malice' standard does not apply to the tort of appropriation of a right of publicity...." 485 U.S. at 52, 108 S.Ct. 876.

Right to publicity cases, both before and after *Zacchini*, focus instead on the threshold legal question of whether the use of a person's name and identity is "expressive," in which case it is fully protected, or "commercial," in which case it is generally not protected. For instance, the use of a person's identity in news, entertainment, and creative works for the purpose of communicating information or expressive ideas about that person is protected "expressive" speech. *See, e.g., Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir.2001); *Cardtoons v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969-70 (10th Cir.1996); *Rogers v. Grimaldi, MGM/UA*, 875 F.2d 994, 1003-05 (2nd Cir.1989). On the other hand, the use of a person's identity for purely commercial purposes, like advertising goods or services or the use of a person's name or likeness on merchandise, is rarely protected. *See, e.g., Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1002 (9th Cir.2001); *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1397-99 (9th Cir.1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462-64 (9th Cir.1988).

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Several approaches have been offered to distinguish between expressive speech and commercial speech. The RESTATEMENT, for example, employs a “relatedness” test that protects the use of another person’s name or identity in a work that is “related to” that person. The catalogue of “related” uses includes “the use of a person’s name or likeness in news reporting, whether in newspapers, magazines, or broadcast news ... use in entertainment and other creative works, including both fiction and nonfiction ... use as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program ... dissemination of an unauthorized print or broadcast biography, [and use] of another’s identity in a novel, play, or motion picture....” RESTATEMENT (THIRD) OF UNFAIR COMPETITION sec. 47 cmt. c at 549. The proviso to that list, however, is that “if the name or likeness is used solely to attract attention to a work that is *not related* to the identified person, the user may be subject to liability for a use of the other’s identity in advertising....” *Id.* (Emphasis added.)

California courts use a different approach, called the “transformative test,” that was most recently invoked in Winter v. D.C. Comics, 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473 (2003), a case with a remarkably similar fact situation. In that case, Johnny and Edgar Winters, well-known musicians with albino complexions and long white hair, brought a right of publicity action against defendant D.C. Comics for its publication of a comic book featuring the characters “Johnny and Edgar Autumn,” half-worm, half-human creatures with pale faces and long white hair. On appeal, the California Supreme Court considered whether the action was barred by the First Amendment and employed “‘what is essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.’” *Id.* at 475 (citing Comedy III Productions, Inc. v. Gary Saderup, Inc., 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797, 799 (2001)). Concluding that the comic book characters “Johnny and Edgar Autumn” “are not just conventional depictions of plaintiffs but contain significant expressive content other than plaintiffs’ mere likenesses,” *id.* at 479, the Court held *374 that the characters were sufficiently transformed so as to entitle the comic book to full First Amendment protection.

The weakness of the RESTATEMENT’S “relatedness” test and California’s “transformative” test is that they give too little consideration to the fact that many uses of a person’s name and identity have both expressive and commercial components. These tests operate to preclude a cause of action whenever the use of the name and identity is in any way expressive, regardless of its commercial exploitation. Under the relatedness test, use of a person’s name and identity is actionable only when the use is solely commercial and is otherwise unrelated to that person. Under the transformative test, the transformation or fictionalized characterization of a person’s celebrity status is not actionable even if its sole purpose is the commercial use of that person’s name and identity. Though these tests purport to balance the prospective interests involved, there is no balancing at all—once the use is determined to be expressive, it is protected. At least one commentator, however, has advocated the use of a more balanced balancing test—a sort of predominant use test—that better addresses the cases where speech is both expressive and commercial:

If a product is being sold that predominantly exploits the commercial value of an individual’s identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some “expressive” content in it that might qualify as “speech” in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.

Lee, supra, at 500.

The relative merit of these several tests can be seen when applied to the unusual circumstances of the case at hand. As discussed, Twist made a submissible case that respondents’ use of his name and identity was for a commercial advantage. Nonetheless, there is still an expressive component in the use of his name and identity as a metaphorical reference to tough-guy “enforcers.” And yet, respondents agree (perhaps to avoid a defamation claim) that the use was not a parody or other expressive comment or a fictionalized account of the real Twist. As such, the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value. On the record here, the use and

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identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.

IV.

[16] The circuit court held that in the event that its grant of JNOV was determined to be in error on appeal, as previously held, respondents' alternative motion for a new trial was granted on several grounds. One such dispositive ground is instructional error in the verdict director given for the misappropriation of name count. The verdict director for this claim, which was the same for each defendant, read:

Your verdict must be for plaintiff and against defendant Todd McFarlane if you believe:

First, defendant Todd McFarlane intentionally used or published plaintiff's name, and

Second, defendant Todd McFarlane derived advantage from the use or publication of plaintiff's name, or plaintiff suffered harm as a result of defendant *375 Todd McFarlane's use of publication of plaintiff's name, and

Third, plaintiff did not consent to the use of publication, and

Fourth, as a direct result thereof, plaintiff sustained damage.

In deciding whether the given verdict director was erroneous, it is helpful to again list the elements of the tort of right of publicity: (1) The defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage. Notably, the verdict director omitted any requirement that the jury find that defendant used plaintiff's identity rather than merely his name. This omission, however, did not prejudice respondents, as the evidence at trial so clearly established that appellant Tony Twist was the basis for the *Spawn* character's name.

However, a second and ultimately fatal flaw lies in the verdict director's failure to properly instruct the

jury on the commercial advantage element of the tort. By requiring that the jury find only that respondents "derived advantage from the use or publication of plaintiff's name," as opposed to a finding that respondents used plaintiff's name "with the intent to derive" or "for the purpose of deriving" an advantage, the jury was allowed to render a verdict that could have been based on the mere incidental result of the use rather than the intentional result. Here, this seemingly fine distinction could well have borne different results. Although the evidence supported a finding that respondents used Twist's name and identity "with the intent to obtain a commercial advantage," alternatively, the jury could have found that respondents had no intent to obtain a commercial advantage—that there was a different purpose for using the name—and to the extent that some advantage was obtained, it was merely incidental. In fact, respondent McFarlane so testified in his defense, adding that the real reasons he used Twist's name were

one, it's a pretty cool name, and, two, it's easy to remember, it's an easy thing—cause I create a lot of characters, you need sort of easy ways to remember names.... And again, ... [with] Twist, you always sort of have a Twist ending. You just sort of come up with stuff that sort of, you know, semi-clever, if you will.

Because the verdict director allowed the jury to render a verdict for plaintiff without a finding that respondents *intended* to obtain a commercial advantage, and because the jury may well have determined that respondents obtained a commercial advantage even though they did not intend to do so, the verdict must be set aside.

V.

[17] In addition to the misappropriation of name claim, Twist sought equitable relief from the circuit court in the form of a permanent injunction prohibiting respondents from using his "name, commercial image, persona, autograph and/or likeness for any purpose without his consent." (Emphasis added.) The court denied equitable relief concluding, *inter alia*, that the injunction sought was overbroad because it could "interfere with legitimate and proper action by the defendants in the future." This Court holds that the circuit court was correct in doing so, because, as respondents state in their brief, the requested injunc-

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tion attempted to prohibit respondents “from engaging in a variety of expressive activities unrelated to the subject matter of this lawsuit and undoubtedly protected by the First Amendment—*e.g.*, a parody of plaintiff, a commentary on his fighting style, a factual report on this lawsuit.”

*376 VI.

For the foregoing reasons, the circuit court's judgment notwithstanding the verdict is reversed, the judgment granting a new trial is affirmed, the judgment denying injunctive relief is affirmed, and the case is remanded.

All concur.

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