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ETW Corp. v. Jireh Publishing, Inc.: A Workable Standard, an Unworkable Decision*

*Jacy T. Jasmer***

I don't know why this has happened to me. I work hard and I'm dedicated, but overall I'm totally surprised. What did I do to deserve this?

-Vanna White¹

The celebrity is a person who is known for his well-knownness . . . He is neither good nor bad, great nor petty. He is the human pseudo event.

-Daniel Boorstin²

INTRODUCTION

In 1997 Tiger Woods became the youngest golfer ever to win the Masters Tournament³. Artist Rick Rush commemorated the historic event in a painting titled “The Masters of Augusta”, which he later sold to the public.⁴ Tiger Woods subsequently sued Rush, asserting that the painting violated Woods’s right of publicity.⁵ Rush claimed First Amendment protection for his work, and both the district court and the Sixth Circuit agreed.⁶ In its decision the Sixth Circuit adopted the test created by the California Supreme Court in

* This article is published online at <http://mipr.umn.edu>.

** J.D. Candidate, 2005, University of Minnesota Law School; B.A., 2002, University of North Dakota. For my parents, who will never know how much they are appreciated.

1. Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 127 (1993) (citing Dan Hurley, *The End of Celebrity*, PSYCHOL. TODAY, Dec. 1988, at 50, 55 (quoting Vanna White)).

2. *Id.* at 127-28 (citing Daniel J. Boorstin, *The Image: A Guide to Pseudo Events in America* 57 (1961)).

3. *ETW Corp. v. Jireh Publ'g., Inc.*, 332 F.3d 915, 918 (6th Cir. 2003).

4. *Id.*

5. *Id.*

6. *Id.* at 919; *ETW v. Jireh Publ'g., Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000).

Comedy III Productions, Inc. v. Gary Saderup, Inc.^{7,8} Known as the “transformative elements” test, it is the most recent judicial attempt to strike a balance between a celebrity’s right of publicity and an artist’s or author’s First Amendment rights. It states 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 interests in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.”⁹ However, “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.”¹⁰

This Comment first addresses the inconsistent and evolving background of the right of publicity, including the justifications for the right, its tension with the First Amendment, and judicial and academic attempts to balance the two. The Comment then explains the *ETW Corp. v. Jireh Publishing, Inc.*¹¹ decision in light of this background, focusing on the Sixth Circuit’s application of the “transformative elements” test. It is the position of this Comment that while the “transformative elements” test is essentially workable, the *ETW* court’s application of the test was faulty and has the potential to unjustly derail the test’s usefulness. However, by recognizing these faults and making a few simple changes, future courts can ensure that this test receives proper analysis. This will prevent critics from convincing courts and scholars that the test has no value to the ongoing debate regarding the proper way to balance the right of publicity with the First Amendment.

I. THE RIGHT OF PUBLICITY

The right of publicity is generally recognized as an intellectual property right.¹² Its justifications, which include moral rights, the prevention of unjust enrichment, and the

7. 21 P.3d 797 (Cal. 2001).

8. *ETW*, 332 F.3d 915.

9. *Comedy III*, 21 P.3d at 808.

10. *Id.*

11. 332 F.3d 915.

12. Gil Peles, *Comedy III Productions v. Saderup*, 17 BERKELEY TECH. L.J. 549, 550 (2002).

preservation of economic incentives, are controversial.¹³ The right of publicity often conflicts with the First Amendment rights of freedom of speech and expression. In light of the questionable justifications behind the right of publicity, courts have struggled for many years to find the appropriate balance between the two.¹⁴ A recent solution to this conflict was the “transformative elements” test set forth in *Comedy III*.¹⁵ This decision spurred considerable discussion and debate, and several commentators proposed a number of alternatives to this test.¹⁶ Therefore, at the time of the *ETW*¹⁷ decision, the standard for determining the right of publicity in the Sixth Circuit was uncertain.

A. THE RIGHT OF PUBLICITY’S ORIGIN

The right of publicity can be defined as “the right of a celebrity (or other person) to prevent others from using his or her name, likeness, or . . . ‘identity’ for commercial purposes without a license.”¹⁸ A product of slow evolution, its ancestors include unfair competition, misappropriation, tort, fraud, and most importantly, the right of privacy.¹⁹ More recently courts

13. See *infra* text accompanying notes 27-46.

14. See *infra* Part I.C.

15. 21 P.3d 797.

16. See *infra* Part I.D.

17. *ETW Corp. v. Jireh Publ’g., Inc.*, 332 F.3d 915 (6th Cir. 2003).

18. Stephen R. Barnett, *The Right of Publicity Versus Free Speech in Advertising: Some Counter-Points to Professor McCarthy*, 18 *HASTINGS COMM. & ENT. L.J.* 593, 594 (1996) (citing J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture - The Human Persona as Commercial Property: The Right of Publicity*, 19 *COLUM.-VLA J.L. & ARTS* 129 (1995)).

19. See Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 *LOY. L.A. ENT. L. REV.* 471, 478 (2003); John Gillison, *Recent Development, California’s Right of Publicity Undergoes a Significant Transformation: Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 29 *W. ST. U.L. REV.* 359, 362 (2002).

While the “right of privacy” is “primarily intended to protect a person’s feelings and sensibilities rather than to safeguard property, business, or other pecuniary interests,” the “right of publicity” recognizes that the “association of one’s name, face or likeness with a business, product or service creates a tangible and salable product in much the same way as property may be created by one who organizes under his other name a business to build or sell product.” 62A *AM. JUR. 2D Privacy* § 25 (2003). Thus, while the rationales for a right of publicity can be broken down into specific “economic incentive” arguments, “unjust enrichment” justifications, and even “moral justifications,” the right as recognized in the United States is more closely aligned with property rights, and as such, primarily protects economic interests.

and academia have started to view the right of publicity as a form of intellectual property.²⁰

The right of publicity was first recognized in *Haelan Labs, Inc. v. Topps Chewing Gum, Inc.*²¹ in 1953.²² The U.S. Supreme Court approved of a right of publicity in 1977 when it held that a news station violated a plaintiff's state law right of publicity by videotaping and re-broadcasting his entire human cannonball act without permission.²³ Today at least thirty-six states have adopted some form of a right of publicity either through a statute or the common law.²⁴

While the right of privacy has been widely established, there has been great disagreement as to its justifications. In *Zacchini v. Scripps-Howard Broadcasting Co.*,²⁵ the Supreme Court noted that the right of publicity served three basic functions: (1) it prevented others from being unjustly enriched by the plaintiff's good will, (2) it kept others from interfering with the plaintiff's right to make a living as an entertainer, and (3) it provided entertainers and celebrities an economic incentive to continue to invest in creating performances that the public could enjoy.²⁶ Courts generally follow *Zacchini*, but disagreements over the relative merit and importance of each of these three justifications remains.²⁷

The economic justification for a right of publicity is heavily relied upon by courts and scholars, despite the fact that this justification is quite controversial.²⁸ As some critics note, the right of publicity "rewards far more than exemplary achievement; it offers no incentives to those who become famous accidentally, such as lottery winners."²⁹ This statement

20. See Peles, *supra* note 12.

21. 202 F.2d 866 (2d Cir. 1953).

22. Lee, *supra* note 19, at 478; Gillison, *supra* note 19, at 362.

23. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1976).

24. Lee, *supra* note 19, at 479.

25. 433 U.S. 562.

26. *Id.* at 576.

27. Vincent M. de Grandpré, *Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity*, 12 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 73, 74 (2001). Mr. de Grandpré notes that some courts question whether a right of publicity is justified at all, while others only "disagree about the likelihood and extent of injuries that result from unauthorized expressive uses of celebrity likeness." *Id.* at 74.

28. See *infra* notes 29-34 and accompanying text.

29. de Grandpré, *supra* note 27, at 101-02 (citing JULIUS C.S. PINCKAERS, *FROM PRIVACY TOWARD A NEW INTELLECTUAL PROPERTY RIGHT IN PERSONA* 245-49 (1996)).

requires an inquiry into whether the right of publicity is the best way to promote fame and achievement.³⁰ Fame existed long before the right of publicity was invented, and “no one apparently needed the law’s protection to become famous before this century.”³¹ Nevertheless, while a right of publicity might only give minimal incentive to create fame, it offers greater incentives to prevent the over-exploitation of a celebrity’s image or persona.³² It is not clear, however, that society needs to prevent over-exploitation of a celebrity’s image. Not “all uses of human identity tire the public”;³³ and certain uses of a celebrity’s persona may actually increase the so-called “shelf life” of the celebrity’s image or fame.³⁴

The moral rights justification³⁵ for the right of publicity is

30. *Id.* at 102. Mr. de Grandpré notes:

Even without invoking such an extreme case [as the lottery winner example], the importance of skills or talent in the making of celebrity should not be overstated. Fame rewards pure talent only unreliably and, as the RESTATEMENT (THIRD) OF UNFAIR COMPETITION points out: “[i]n 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.”

Id. He continues by explaining that “[m]arginal analysis tells us nothing about how much the right of publicity contributes to the overall supply of celebrity” since the “elusive character of fame probably makes it difficult for an aspiring celebrity to assess rationally the marginal value of additional preparation.” *Id.*

31. de Grandpré, *supra* note 27, at 103.

32. *Id.* de Grandpré states that the “over-exploitation” rationale is the “better argument” for a right of publicity, but he still finds it insufficient in a number of ways. See *infra* notes 33-34 and accompanying text.

33. de Grandpré, *supra* note 27, at 104. de Grandpré criticizes the “over-exploitation” argument by stating that while “individual consumption of celebrity identity . . . results in negative externalities” it also “leads to positive network effects.” *Id.* This occurs because “[m]any uses of celebrity identity are faddish and, at certain points along the demand curve for celebrity goods and services, individual consumptions are not rivalrous, but complementary.”

Id. This occurs for two reasons: a “bandwagon effect, in which early consumption of goods by some people modifies the tastes of others” and because “consumption and learning may take place simultaneously.” *Id.* at 105.

34. *Id.* at 104. Such uses are primarily informative. See *id.* at 105. While unauthorized uses of a person’s identity in news, magazines, etc. do “cause congestion externalities by adding to a celebrity’s exposure” the “informative character of these uses creates net positive externalities because . . . [they] enrich the social meaning of celebrities.” *Id.*

35. The moral justification argument is best described as a “fruits of labor argument” and is closely related to the “unjust enrichment” justification. See *infra* notes 36-41.

likewise controversial. A common premise in intellectual property law is that a person is entitled to the fruits of his or her labor.³⁶ It can be argued that celebrities “work[] hard to create an identity that has commercial value.”³⁷ Therefore, they deserve the benefits gained from this identity. This argument, however, ignores the fact that the idea of “celebrity” is the result of a “complex social . . . process in which the ‘labor’ (time, money, effort) of the celebrity herself (and of the celebrity industry, too) is but one ingredient, and not always the main one.”³⁸ While a celebrity can, to a certain extent, increase her strength, knowledge, or even beauty, she cannot make herself famous “any more than [s]he can make [her]self loved.”³⁹ Therefore, celebrities and athletes labor to develop their own skill but not necessarily to develop the commercial value of their images.⁴⁰ “[N]amely the public image and persona of the celebrity, is in large part created by the . . . media and society.”⁴¹ This undercuts the argument that a person attempting to capitalize on a celebrity’s value is taking something that is the sole creation of the celebrity.

Closely related criticism attends the unjust enrichment justification for the right of publicity. The Supreme Court has viewed the use of a person’s identity without his or her permission as a “theft of good will.”⁴² Such use is seen as “‘reaping’ where others have ‘sown.’”⁴³ However, this argument is questionable as well. Not only do celebrities “develop their . . . craft . . . using already-existing forms, sounds, narratives, and images”,⁴⁴ but the use of their identity may actually “advance the development of the sport”⁴⁵ or art as a

36. Jessica Villardi, *ETW Corp. v. Jireh Publishing, Inc.: Why the First Amendment Should Trump the Right of Publicity When Art Imitates Life*, 34 CONN. L. REV. 293, 298-99 (2001) (citing Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 216 (1954)).

37. *Id.*

38. Villardi, *supra* note 36, at 299 (citing Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 195 (1993)).

39. *Id.* (citing Madow, *supra* note 38, at 188).

40. *See id.*

41. *Id.*

42. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1976).

43. Villardi, *supra* note 36, at 299.

44. *Id.*

45. *Id.* Villardi explains that “modern athletes . . . often use techniques invented by other previous greats in order to advance the development of a sport as a whole.” *Id.* Viewed in that light, “reaping” where others have

whole, increasing its value. In turn, the celebrity may reap greater benefits as an indirect result of this use, in the form of monetary gain, recognition, or personal satisfaction with their achievements.⁴⁶ If such a chain of events occurs, the value of the celebrity's identity can not only be credited to their own talent, but also to the general popularity of the game they play, music they perform, or the art they create.

B. CONFLICTING INTERESTS AMONG THE RIGHT OF PUBLICITY AND FIRST AMENDMENT

Not surprising, the right of publicity and the First Amendment are often in tension with one another.⁴⁷ The First

"sown" actually helps create great athletes." *Id.*

46. It is a logical extension from Villardi's argument, *supra* note 36, that if the popularity of a sport increases due to an athlete's personal achievements, the increased interest in the sport will filter down to the athlete as an individual, resulting in increased promotional opportunities and media recognition of the athlete (or celebrity's) personal efforts. Thus, the cyclical nature of an athlete's own achievement may both directly and indirectly promote celebrity.

47. Artistic expression, among other things, can be considered "speech" for purposes of the First Amendment. See CHEMERINSKY, ERWIN, CONSTITUTIONAL LAW PRINCIPLES AND POLICIES, §11.3.7.1-3 (Aspen L. & Bus. 1997). First Amendment concerns are generally implicated when a state restricts free speech in some form, such as when it recognizes a right of publicity. See Villardi, *supra* note 36. While forms of speech considered to be "commercial" were once unprotected, the Supreme Court changed this in 1976 when it ruled that "commercial speech," in addition to speech that is considered "newsworthy," is protected by the First Amendment, although to a lesser extent. See *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 761-62 (1976). The Supreme Court has developed a strict test for determining the constitutionality of commercial speech: "[C]ommerical speech may be freely regulated, or even banned, if it is 'false, deceptive, or misleading'; but . . . otherwise . . . only if 'the State shows that the restriction directly and materially advances a substantial state interest in a manner no more extensive than necessary to serve that interest.'" Barnett, *supra* note 18, at 599-600 (citing *Ibanez v. Florida Dept. of Bus. & Prof. Regulation*, 512 U.S. 136, 142 (1994)). However, while the "commercial" – "newsworthy" distinction is no longer supposed to strictly determine the answer to the preliminary question of whether a particular form of speech gets protection, some argue that it does still seem to matter. Villardi, *supra* note 36, at 301-02. Whether or not the "commercial" – "newsworthy" distinction should matter, and how much it should determine whether or not something gets full First Amendment protection, remains controversial. See, e.g., Ralph S. Brown, *Copyright and its Upstart Cousin: Privacy, Publicity, Unfair Competition: The Sixteenth Donald C. Brace Memorial Lecture*, 33 J. COPYRIGHT SOC'Y USA 301 (1986); Rosemary J. Coombe, *Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders*, 10 CARDOZO ARTS & ENTER. L.J. 365 (1992); Diane Leenheer Zimmerman, *Amicus Curiae Brief of Seventy-Three Law Professors in Support of Jireh*

Amendment's goals of promoting an open marketplace of ideas and freedom of self-expression mean that artists, media, and other interested parties must be able to write about and interpret "the thought process of illustrious individuals who have shaped our society."⁴⁸ If the three justifications for the right of publicity noted above are correct, this view directly conflicts with the right of entertainers to control the use of their talent and persona for their own gain.⁴⁹ Furthermore, any unauthorized use of another person's intellectual property in their image "chills speech by increasing the cost of creating works."⁵⁰ On the other hand, giving others free rein to use of such property also "chills speech, since it chills [both] the creation of intellectual property" and "the cost of creating works" in general.⁵¹

The tension between the right of publicity and the First Amendment right of freedom of expression becomes especially strong when the person attempting to enforce the right is someone whose "exploits, activities, accomplishments, and [even] personal life" are subjected to the spotlight.⁵² Such individuals have become part of the fabric of our culture, and thus the use of their personas becomes important to debate on public issues, especially those dealing with culture and values.⁵³ Celebrities often acquire a personal meaning to many

Publishing, Inc., 22 WHITTIER L. REV. 391, 406-07 (2000) (arguing that the "commercial" – "newsworthy" distinction in right of publicity/First Amendment jurisprudence is outdated and that the Supreme Court rejected this distinction in *Zacchini*).

48. Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 68 (1994).

49. When a right of publicity exists, a court typically orders a defendant to stop the unauthorized use of the celebrity's likeness or image. Villardi, *supra* note 36, at 300. Defendants may then use the First Amendment right to free speech and freedom of expression as a defense that their use of the "celebrity's image or likeness is speech that is entitled to constitutional protection and cannot be restricted by the state." *Id.* Allowing the defendant in such a case to continue using the celebrity's likeness may result in monetary detriment to the celebrity, unjust enrichment of the defendant, and a decrease in incentive for the plaintiff celebrity to continue creating. *Id.* However, if the defendant is ordered to stop using the celebrity's likeness, her expression is restricted by the court—an arm of the government—which may be considered a violation of the First Amendment right to freedom of speech or expression. *Id.*

50. Lee, *supra* note 19, at 479.

51. *Id.* at 479-80.

52. *ETW Corp. v. Jireh Publ'g., Inc.*, 332 F.3d 915, 931 (6th Cir. 2003).

53. *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 803 (Cal. 2001).

fans, making the celebrity persona an “important avenue of individual expression.”⁵⁴ However, public figures often put a vast amount of resources into developing their “prominence in a particular field.”⁵⁵ Years of work may be required before any economic return on the investment is realized.⁵⁶ “For some, [this] investment may eventually create considerable commercial value in one’s identity.”⁵⁷

C. STRIKING A BALANCE

For decades, courts have struggled to find the appropriate balance between a public figure’s right of publicity and the First Amendment protection of the freedom of expression. Courts have held that the unauthorized use of a celebrity’s signature phrase⁵⁸ and a robot designed to mimic the physical appearance and usual activities of an actress were violations of celebrities’ rights of publicity.⁵⁹ Others have asserted that marketing of an action figure with a resemblance to an actor’s character⁶⁰ and the sale of baseball cards featuring caricatures of players and sarcastic commentary on their careers were protected expression.⁶¹

The recent cases of *Hoffman v. Capital Cities/ABC, Inc.*⁶² and *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,⁶³ illustrate that the difficulties courts encounter in striking this balance are still contemporary challenges. In *Hoffman*, Capital

54. *Id.*

55. *Id.* at 804.

56. *Id.*

57. *Id.*

58. *See Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (holding that Johnny Carson’s right of publicity was invaded by a company’s use of his identity for commercial exploitation, even though his name and likeness were not used).

59. *See White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (refusing to reconsider a petition for rehearing of the panel holding that an electronic robot that bore an uncanny similarity to Vanna White violated her right of publicity).

60. *See Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 625-26 (6th Cir. 2000) (holding that an actor did not show a violation of his right of publicity by failing to establish that his persona had significant value or that the action figure invoked his persona as separate from the character he portrayed).

61. *See Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 976 (10th Cir. 1996) (holding that parody trading cards did not infringe on players’ rights of publicity).

62. 255 F.3d 1180 (9th Cir. 2001).

63. 21 P.3d 797 (Cal. 2001).

Cities Media used Dustin Hoffman's 1982 movie character, "Tootsie", in a magazine.⁶⁴ Sticking to the historic, commercial/non-commercial distinction used by many courts, the Ninth Circuit noted that "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."⁶⁵ Any commercial aspects are 'inextricably entwined' with expressive elements, and so they cannot be separated out 'from the fully protected whole.'⁶⁶ The court therefore held that Capital Cities' use of "Tootsie" was entitled to the full protection under the First Amendment.⁶⁷ In *Comedy III*, the California Supreme Court similarly noted that the defendant's works were "non-commercial" for purposes of a First Amendment analysis⁶⁸ but used a far different approach to the constitutional issue presented by defendant Saderup's cartoon drawings of the Three Stooges. The court stated the test for determining whether an artist's work is protected by the First Amendment as follows:

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.⁶⁹

Later in the opinion, the court stated that another way to look at this test is to determine whether the celebrity's image was one of the "raw materials" from which the author created the original work, or whether the image was an imitation that constituted the very substance of the artist's piece.⁷⁰ The court further emphasized that in applying this test, courts were "not to be concerned with the quality of artistic contribution", nor

64. *Hoffman*, 255 F.3d at 1180.

65. *Id.* at 1185.

66. *Id.* (citing *Gaudiya Vaishnava Soc'y v. City & County of San Francisco*, 952 F.2d 1059, 1064 (9th Cir. 1990) (as amended)).

67. *Id.* at 1189.

68. *Comedy III*, 21 P.3d at 802 (stating that "the present case does not concern commercial speech . . . Saderup's portraits . . . are expressive works and not an advertisement for or endorsement of a product").

69. *Id.* at 808 (emphasis added).

70. *Id.* at 809.

were they to assume that a “literal depiction of a celebrity, even if accomplished with great skill” would not be subject to challenge.⁷¹

In addition, the *Comedy III* court added a second “subsidiary inquiry”, intended to be helpful, but not determinative, on the issue of whether the art had significant “transformative elements” to allow it to be protected.⁷² The “subsidiary inquiry” asked a court to consider the extent to which the “marketability and economic value of the challenged work derive[d] primarily from the fame of the celebrity depicted.”⁷³ Overall the court stated that the “transformative elements” test was to be “quantitative [rather] than qualitative, asking whether the literal and imitative or the creative elements predominate[d] in the work.”⁷⁴ The *Comedy III* court went on to hold that the cartoon drawings in question violated Comedy III’s right of publicity because it found “no significant transformative or creative contribution” in them.⁷⁵ While admitting that Saderup had considerable skill, it stated that this skill was “manifestly subordinated to the overall goal of creating literal, conventional depictions of the Three Stooges so as to exploit their fame”, and that “the marketability and economic value of Saderup’s work” was derived from the fame of the Three Stooges.⁷⁶ Thus, for Saderup to continue using the images, he would have to seek permission from Comedy III.⁷⁷

D. SOLUTIONS

The “transformative elements” test espoused in *Comedy III* has come under intense criticism. Some scholars argue that the California Supreme Court failed to create a clear standard by importing part of an “already confused” paradigm from copyright law.⁷⁸ In addition, such scholars believe that the

71. *Id.*

72. *Id.* at 810.

73. *Id.*

74. *Id.*

75. *Id.* at 811.

76. *Id.*

77. *Id.*

78. Pete Singer, Note, The Three Stooges Latest Act: Attempting to Define the Scope of Protection the First Amendment Provides to Works of Art Depicting Celebrities, *Comedy III Productions, Inc. v. Saderup, Inc.*, 27 U. DAYTON L. REV. 313, 322-25 (2002). Singer first attacks the “transformative use” test of fair use in copyright law on the grounds that it is “both over and under inclusive, allowing pure copying to constitute transformative use in

court's analysis leaves far too many questions unanswered and will chill the creation of future artistic works.⁷⁹ Others cite the subsidiary prong as the major problem, since it may apply differently to works depicting ordinary people as opposed to celebrities and to works created by celebrity artists as opposed to non-celebrity artists.⁸⁰ Finally, the test has simply proven to be too "vague to provide proper guidance" for some scholars.⁸¹

The critics of the "transformative elements" test have provided a number of possible solutions to the problems of the *Comedy III* decision. The first, the "Cultural Niche Theory of Art" proposes a distinction between "Popular Art" and "Fine Art". Under this theory, "Fine Art" would be entitled to transformative use status and its "concomitant First

some contexts, and over-protecting copyrighted works from seemingly transformative uses in others." *Id.* at 323 (footnotes omitted). Singer then suggests the same problem will be imported into right of publicity jurisprudence. *Id.* at 323-25 (a "parallel path will result in creating the same problems of over-and under-protectiveness").

79. *See id.* at 322-27. Singer argues against the "transformative use" test by highlighting the questions that remain unanswered after the *Comedy III* decision, such as "how does something become recognizably the artist's own work? . . . [W]hen does a work become more than a mere trivial variation?" *Id.* at 325. "When does a creative contribution or a significant creative contribution occur? . . . [A]t what point do the creative elements of a celebrity portraiture dominate the literal and imitative elements of the work?" *Id.* at 326. Singer argues that so many unanswered questions will chill freedom of expression, thereby causing artists to hesitate to experiment with "creative modes" since they will be afraid of possible liability. *Id.* at 328-30.

80. Gillison, *supra* note 19, at 380. Gillison argues that the greatest flaw with the transformative elements test is that the second, "subsidiary" prong rests on the celebrity status of the artist. *Id.* at 380. He states:

Just as in copyright infringement where it is irrelevant who infringes on a person's right of publicity, there is no exemption here for famous people. The focus of copyright law is on the infringement itself . . . [s]o too, with the right of publicity, the focus should not be on who created the work, but rather the focus should be on the amount of the source that has been appropriated, the nature and purpose of the appropriation, the degree of transformation that has taken place, and the extent to which the appropriation will detrimentally impact the 'source' celebrity.

Id. at 381 (emphases omitted) (footnotes omitted). He also notes that in creating the subsidiary test, the *Comedy III* court "lost sight of the fact that anyone's right of publicity can be infringed upon, even though only celebrities will generally litigate this type of tort." *Id.* Gillison maintains that through the transformative elements test, "the court [now] requires the trier of fact to define 'celebrity.'" *Id.*

81. Peles, *supra* note 12, at 549-50 ("the court failed to create a clear test to determine how much 'social comment' must be included in order to be considered 'transformative'").

Amendment protection”, but “Popular Art” would not.⁸² Another suggestion is simply to apply the entire “fair use” standard used in copyright law to any right of publicity claim.⁸³ A related proposal includes using a modified “fair use” standard that emphasizes the possible economic harm to the celebrity.⁸⁴

82. Singer, *supra* note 78, at 330-32. Singer advocates Susan B. Josephson’s “Cultural Niche Theory of Art” as an alternative to the “transformative elements” test. *Id.* Under the theory, “popular art” will not receive First Amendment protection, but “fine art” will. *Id.* at 333. “Popular art” is work that “is not measured by its creativity.” *Id.* at 331.

Popular Art is very inexpensive compared to Fine Art and is marketed in venues where the greatest number of people have access to it. Many copies of the same image can be distributed, all of relatively equal value because of its unoriginality or lack of uniqueness. Popular Art tends to use images that are not new, that have proven effective in the past, that are conventional and that are familiar to people. Popular Art tends to lack a message or expression and is generally ‘meant to entertain, to stimulate emotion, or project sentimentality.’

Id. at 332 (footnotes omitted).

“Fine art” on the other hand, “is the result of the artist’s inspiration.” *Id.* There is generally an original work and any copies “are either sanctioned ‘reprints’ or they are considered forgeries.” *Id.* at 334. According to this test, Singer proffers that the decision in *Comedy III* would have been the same, but the rationale would have been different:

[B]ecause the inherent qualities of some forms of Popular Art, as defined by the Cultural Niche Theory, cause it to fall outside transformative use and because Saderup’s depiction of the Three Stooges can be categorized as Popular Art, the *Comedy III* court correctly concluded that Saderup’s work was not transformative according to the Culture Niche theory. Further, because original works of Popular Art, such as The Three Stooges, require protection from appropriation in order to maintain its economic value, the court correctly decided to protect Comedy III’s right to the image of The Three Stooges by denying Saderup’s work First Amendment protection.

Id. at 336.

83. Gillison, *supra* note 19, at 383-84.

84. Peles, *supra* note 12, at 566. Peles suggests that a proper test for drawing the line between the First Amendment and the right of publicity should “separate economic and transformative elements.” *Id.* at 564. Such a test would incorporate both the third and fourth “fair use” factors from copyright law. *Id.* at 565-68. Copyright’s fourth fair use factor asks a court to consider “the effect of the use upon the potential market for or value of the copyrighted work.” *Id.* at 565 (citing 17 U.S.C. § 107(4) (1994)) (quotations omitted). Peles advocates using this question as a “determinative consideration” in cases “where it is unclear whether a work is transformative, such as with Saderup’s works [in *Comedy III*].” *Id.* at 566. The third fair use factor, the functional test, asks if “regardless of medium, the defendant’s work, though containing substantially similar material performs a different function than that of the plaintiffs.” *Id.* at 567 (quoting 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[B][1] (2001)) (quotations

Other possible solutions, proposed prior to the *Comedy III* decision, include “balancing”, “relatedness”, and “alternative means” approaches.⁸⁵

omitted). Thus, the functional test “finds a use to be fair where its function does not act as a market substitution for the original copyrighted work.” *Id.* In a right of publicity case, this would cause a court to “lean towards fair use where expressive elements within a defendant’s works cause consumers to purchase those works primarily for the expression, and not the celebrity.” *Id.* Such “[a]n economic consideration would further decipher whether the infringing work performs the same function as the existing market created by a celebrity.” *Id.*

85. See Lee, *supra* note 19, at 482-86, 496-98 (summarizing the various approaches and noting their various strengths and weaknesses).

The ad hoc balancing test “weigh[s] competing expressive and property interests according to unspecified criteria.” *Id.* at 485. This approach was pioneered by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), and was more recently used in *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000), and *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002). *Id.* at 484-85 nn.93 & 98 and accompanying text. However, there are four basic problems with such an approach: (1) it is “arguably inconsistent with Supreme Court authority,” which appears to support the “alternative means” test; (2) it is “ultimately unsupported by authority,” since the original *Rogers* court “cite[d] no authority to support the approach it develop[ed]”; (3) it is “not limited by any meaningful evaluative guidelines or criteria, and amounts to little more than a Rorschach test for a particular judge’s philosophical predilections”; and (4) it can “chill speech by creating legal uncertainty as to whether the speech is or is not permitted.” *Id.* at 485-86.

The relatedness test allows the use of publicity rights in expressive works if “the rights ‘relate’ to the work, but not otherwise.” *Id.* at 496-97, quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, Reporter’s Note & cmts. a & c (1993) [hereinafter RESTATEMENT UNFAIR COMPETITION]. Using a deceased personality’s identity in “advertising, magazine or newspaper articles, biographies, films, or similar works relating to the identified individual is not an infringement of the right of publicity,” but “if the name or likeness is used solely to attract attention to the work that is not related to the identified person, the use may be subject to liability for the use of the other’s identity in advertising.” *Id.* (quoting RESTATEMENT UNFAIR COMPETITION at § 47, Reporter’s Note & cmts. a & c) (quotations omitted). The Kentucky Supreme Court using a relatedness test found there was “no right of publicity violation from the use of a deceased musical performer’s name and likeness in a music video for a song that was a tribute to the deceased musical performer. *Id.* at 497 n.178 and accompanying text (citing *Montgomery v. Montgomery*, 60 S.W.3d 524 (Ky. 2001)).

The alternative means test has not been adopted, but has “been discussed in connection with right of publicity claims.” *Id.* at 498. The Tenth Circuit applied the test, although overall the court “rejected the ‘adequate alternative avenues’ approach in favor of ad hoc balancing.” *Id.* at 498 n.180 (citing *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996)). Also called the “alternative means of communication” test, it holds “non-commercial speech . . . infringing if there is another way to convey the message without infringing intellectual property rights.” *Id.* at 482-83.

E. A NEW STANDARD

Thus, by the time *ETW Corp. v. Jireh Publishing, Inc.*⁸⁶ was decided by the Sixth Circuit in 2003, the right of publicity had already gone through a number of transformations and interpretations, but remained uncertain.⁸⁷ Starting out as an amalgam of other rights, its justifications have been questioned and, arguably, remain fairly weak. The tension between the right of publicity and the First Amendment has continued to cause strife in both the academic world and the courts. According to the *Comedy III* decision, the “transformative elements” test purportedly solved the issue of which standard to apply when balancing the two rights.⁸⁸ However, the test was strongly criticized, and scholars subsequently advocated a number of alternative options for striking a balance.⁸⁹ In the shadow of this scholarly debate, the parties in *ETW* faced an uncertain outcome as they addressed the issue of whether Rick Rush violated Tiger Woods’s right of publicity by creating and selling the painting “The Masters of Augusta” in late 1998.⁹⁰

II. *ETW V. JIREH*: “TRANSFORMATIVE ELEMENTS” REEMERGE

To answer the question of whether Rick Rush violated Tiger Woods’s right of publicity by creating and selling “The Masters of Augusta,” the *ETW* court analyzed precedent from a number of courts, including the Supreme Court, Federal Courts of Appeals, and Ohio state courts.⁹¹ Settling on the “transformative elements” test, it concluded that summary judgment should be granted for Rick Rush and left *ETW* and Tiger Woods without a claim on Rush’s proceeds from the painting or his attendant rights as creator of that painting.⁹²

While the Supreme Court may have supported this approach to reconcile intellectual property rights with First Amendment rights, *see id.* at 484 (citing *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 438 U.S. 522 (1987)), no appellate court since 1987 has used the approach. *Id.*

86. 332 F.3d 915 (6th Cir. 2003).

87. *See supra* Part I.C-D.

88. *See supra* Part I.C.

89. *See supra* Part I.D.

90. *See ETW*, 332 F.3d at 918-19.

91. *Id.* at 928-36.

92. *Id.* at 936-38.

A. THE FACTS

In 1997 Tiger Woods, “one of the world’s most famous professional golfers,” became the youngest player ever to claim a Masters victory.⁹³ His win at Augusta National was made even sweeter by the fact that he set a seventy-two hole record for the tournament, and completed the event with a twelve stroke lead over second place.⁹⁴ Rick Rush, referred to as “America’s sports artist”, commemorated the historic event in a painting called “The Masters of Augusta”.⁹⁵ Rush added the painting to his collection of works featuring famous athletes and great moments in sports.⁹⁶ The painting had original and expressive compositional elements. It featured Tiger Woods in three poses:⁹⁷ in the center image, he is swinging a golf club; on the left and right, he is crouching to line up a putt with his caddy observing.⁹⁸ In the background Rush portrayed the Augusta National Clubhouse, as well as famous golfers from the past “looking down” on Woods⁹⁹ with the Masters leader board set behind their images.¹⁰⁰ Jireh Publishing sold limited edition prints of the painting in the form of fifty serigraphs and five thousand lithographs.¹⁰¹ The serigraphs sold for \$700 each, and the lithographs each sold for \$100.¹⁰²

ETW Corporation, the licensing agent of Tiger Woods,¹⁰³ filed suit on June 26, 1998, in the United States District Court for the Northern District of Ohio. The suit alleged, among

93. *Id.* at 918.

94. *Id.*

95. *Id.*

96. *Id.* (including, for example, Michael Jordan, Mark McGuire, the Pebble Beach Golf Tournament, and America’s Cup Yacht Race).

97. *Id.*

98. *Id.*

99. *Id.*

100. *Id.*

101. *Id.* at 918-19. The prints included Rush’s signature at the bottom right hand corner. *Id.* The title of the work, “The Masters Of Augusta,” appeared below the painting’s image, along with the words “Rick Rush” and “Painting America Through Sports.” *Id.* at 918. Each limited edition print was enclosed in a white envelope and included a photograph of Rush, a description of his art, and a description of the painting itself. *Id.* The name “Tiger Woods” appeared on the back of the envelope and is mentioned in the description of the painting. *Id.* at 918-19.

102. *Id.* at 919.

103. *Id.* at 918. Tiger Woods is the Chairman of ETW’s board. *Id.* At the time of the action, ETW had the exclusive right to exploit Woods’s name, image, likeness, and signature, and all other publicity rights. *Id.*

other things, that Jireh and Rush violated Woods's right of publicity under Ohio common law.¹⁰⁴ Jireh counterclaimed, seeking a declaratory judgment that Rush's prints were protected by the First Amendment.¹⁰⁵ The parties promptly moved for summary judgment.¹⁰⁶ The district court granted Jireh's motion for summary judgment and then dismissed the case.¹⁰⁷ ETW appealed this decision.¹⁰⁸

B. THE RESOLUTION

In order to determine whether the district court's grant of summary judgment on the Ohio state right of publicity claim was proper, the Sixth Circuit first examined the right of publicity generally.¹⁰⁹ The court noted that the right of publicity was a state law right that gave rise to "a cause of action for the commercial tort of unfair competition."¹¹⁰ It then reviewed Ohio jurisprudence regarding the right of publicity, including *Zacchini v. Scripps-Howard Broadcasting Co.*,¹¹¹ which first recognized the right in Ohio.¹¹² Noting that the

104. *Id.* at 919. ETW also alleged trademark infringement in violation of the Lanham Act, 15 U.S.C. § 1114; dilution of the mark under 15 U.S.C. § 1125(c); unfair competition and false advertising under 15 U.S.C. § 1125(a); unfair competition and deceptive trade practices under Ohio Revised Code § 4165.01; and unfair competition and trademark infringement under Ohio common law. *Id.*

105. *Id.* Jireh also sought a declaratory judgment that the art prints did not violate the Lanham Act. *Id.*

106. *Id.*

107. *Id.* (citing *ETW Corp. v. Jireh Pub. Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000)).

108. *Id.*

109. *See id.* at 928-36.

110. *Id.* at 928.

111. 351 N.E.2d 454 (Ohio 1976), *rev'd on other grounds*, 433 U.S. 562 (1976) (recognizing a common law "right of publicity" in Ohio).

112. *ETW*, 332 F.3d at 929. In *Zacchini*, the Defendant videotaped and broadcast the Plaintiff's human cannonball act. *Zacchini*, 351 N.E.2d at 455. The Ohio Supreme Court recognized a common law right of publicity in Ohio. *See id.* at 460. But the court ultimately held that *Zacchini's* right was trumped by the news service's First Amendment right. *See id.* at 461-62 (holding that the newscast was "a matter of legitimate public interest"). The United States Supreme Court reversed the Ohio Supreme Court on other grounds. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578-79 (1977) (holding that the First Amendment did not require privileging the press where the public was not otherwise deprived of the performance in a commercial setting). But the Court upheld Ohio's state right of publicity. *Id.* at 576. *Zacchini* is the only United States Supreme Court decision dealing with the right of publicity. *ETW*, 332 F.3d at 929.

Ohio Supreme Court had relied heavily on the Restatement (Second) of Torts' formulation of the right of publicity as a branch of the right of privacy,¹¹³ the *ETW* court introduced the modern version of the right of publicity reformulated in the Restatement (Third) of Unfair Competition as a right to the commercial value of a person's identity.¹¹⁴ The court critically examined the rationales for a commercial basis for the right of publicity¹¹⁵ and found a limited right, constrained by the public's interest in expression.¹¹⁶ However, the *ETW* court found that the Ohio courts would probably "follow the principles of the Restatement in defining the limits of the right of publicity" and that the Ohio Supreme Court was "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."¹¹⁷ The court then examined circuit court cases regarding the right

In addition to the *Zacchini* decision, the court in *ETW* looked at *Vinci v. American Can Co.*, 459 N.E.2d 507 (Ohio 1984) (reaffirming the right of publicity); *Bajpayee v. Rothermich*, 372 N.E.2d 817 (Ohio Ct. App. 1977) (holding that a plaintiff's right of publicity was violated when the defendant represented and presented plaintiff's research paper as his own at an American Society of Clinical Pharmacology and Therapeutic conference); and *Parma Int'l, Inc. v. Bartos*, No. 89CA004573, 1990 WL 11716 (Ohio Ct. App. Feb. 7, 1990) (denying summary judgment to a defendant whether he had used the plaintiff's name and likeness on product packaging and in advertising information when the plaintiff was no longer employed by the defendant). See *ETW*, 332 F.3d at 929-33.

113. The right of publicity was included in the Restatement in the chapter "Invasion of Privacy". *Id.* at 930. The *ETW* court noted that the court in *Zacchini* "quoted the entire text of § 652 (C) of the Restatement, as well as comments a, b, c, and d." *Id.*

114. "In 1995, the American Law Institute transferred its exposition of the right of publicity to the Restatement (Third) of Unfair Competition . . . in a chapter entitled 'Appropriation of Trade Values.'" *Id.* The current version defines the right of publicity as, "[o]ne 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." *Id.* at 930 (quoting RESTATEMENT UNFAIR COMPETITION *supra* note 85, § 46 (n.d.)).

115. Such rationales are "generally less compelling than those that justify rights in trademarks or trade secrets." *Id.* (quoting RESTATEMENT UNFAIR COMPETITION, *supra* note 85, § 46, cmt. c (n.d.)).

116. The right of publicity is "fundamentally constrained by the public and constitutional interest in freedom of expression," but not "if the name or likeness is used solely to attract attention to work that is not related to the identified person." *Id.* (quoting RESTATEMENT UNFAIR COMPETITION, *supra* note 85, § 47, cmt. c (n.d.)).

117. *ETW*, 332 F.3d at 931.

of publicity,¹¹⁸ focusing heavily on the *Comedy III Productions, Inc. v. Gary Saderup, Inc.* decision.¹¹⁹

Based on this extensive discussion, the court set forth the rules it would follow when analyzing the case at bar. It concluded that “in deciding whether the sale of Rush’s prints violate Woods’s right of publicity, [it would] look to the Ohio case law and the Restatement (Third) of Unfair Competition.”¹²⁰ “In deciding where the line should be drawn between Woods’s intellectual property rights and the First Amendment”, the court stated that it would follow the dissenting opinion in *White v. Samsung Electronics America, Inc.*,¹²¹ the Tenth Circuit decision in *Cardtoons, L.C. v. Major League Baseball Players Association*,¹²² and the Ninth Circuit decision in *Hoffman v. Capital Cities/ABC, Inc.*¹²³ to determine whether “The Masters of Augusta” was protected by the First Amendment.¹²⁴ Finally, the court stated that it believed the “transformative elements test adopted by the Supreme Court of California” in *Comedy III* was appropriate for determining where the “proper balance [ay] between the First Amendment and Woods’s intellectual property rights.”¹²⁵

118. The court looked at *Memphis Development Foundation v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir. 1980) (holding that a “right of publicity” is not inheritable and so the deceased’s assignee was not able to enjoin a statute created in the deceased’s likeness); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (holding that Johnny Carson’s right of publicity was invaded by a company’s use of his identity for commercial exploitation, even though his name and likeness were not used); *White v. Samsung Elecs. America, Inc.*, 989 F.2d 1512 (9th Cir. 1993) (refusing to reconsider a petition for rehearing of the panel holding that an electronic robot who bore an uncanny similarity to Vanna White violated her “right of publicity”); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996) (holding that parody trading cards didn’t infringe on players’ “rights of publicity”); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (holding that a magazine’s use of a photo of Hoffman digitally altered to create an image of him wearing a designer’s brand of clothing was not pure commercial speech and so was entitled to full protection of the First Amendment; thus, it did not violate Hoffman’s “right of publicity”); and *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) (creating the “transformative elements” test). *ETW*, 332 F.3d at 931-36.

119. *ETW*, 332 F.3d at 934-36 (discussing *Comedy III*, 21 P.3d 797 (Cal. 2001)).

120. *Id.* at 936.

121. 989 F.2d 1512 (9th Cir. 1993).

122. 95 F.3d 959 (10th Cir. 1995).

123. 255 F.3d 1180 (9th Cir. 2001).

124. *ETW*, 332 F.3d at 936.

125. *Id.*

Applying these principles to Rush's work itself, the court first stated that "[t]he evidence in the record reveals that Rush's work consists of much more than a mere literal likeness of Woods", and that the artistic elements in the work were enough to entitle Rush's work to First Amendment protection.¹²⁶ Next, applying the Restatement (Third) of Unfair Competition, the *ETW* court concluded that "Rush's work has substantial informational and creative content which outweighs any adverse effect on ETW's market."¹²⁷ Further finding that Rush's work was "entitled to the full protection of the First Amendment",¹²⁸ the court used the balancing test employed by *Cardtoons L.C. v. Major League Baseball Players Association*¹²⁹ to conclude that the degree of the restriction on speech in this case was greater than Woods's intellectual property right, since "Woods, like most sports and entertainment celebrities with commercially valuable identities" would "still be able to reap substantial financial rewards from authorized appearances and endorsements", even without the right of publicity.¹³⁰ "It is not at all clear", the court stated, "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."¹³¹ By contrast, Rush supplemented Woods's identity with an important creative contribution of his own; by refusing Rush protection, the court would "extinguish [his] right to profit from his creative enterprise."¹³²

Finally, turning to the transformative elements test used in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,¹³³ the court found 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's right of publicity. Unlike the unadorned, nearly

126. *Id.* The court poetically noted that "[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." *Id.*

127. *Id.* at 937.

128. *Id.*

129. 95 F.3d 959 (10th Cir. 1996).

130. *ETW*, 332 F.3d at 937-38.

131. *Id.* at 938.

132. *Id.*

133. 21 P.3d 797 (Cal. 2001).

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.¹³⁴

Based on these conclusions, the court affirmed summary judgment to Jireh Publishing.¹³⁵

III. THE "TRANSFORMATIVE ELEMENTS" TEST IS A WORKABLE SOLUTION

Despite the criticism of the "transformative elements" test established in *Comedy III*, the test is essentially workable for three reasons: (1) it strikes a correct balance between the right of publicity and First Amendment rights; (2) it allows courts to make necessary fact specific determinations; and (3) other alternative approaches do not offer any improvements; on the contrary, they may be even more faulty. However, it is likely that the confusing and disjointed nature of the *ETW* decision will be used as proof that the "transformative elements" test should not be applied by future courts. Yet the "transformative elements" test is not to blame for the weaknesses of the *ETW* decision: poor organization, the failure to address the issues raised, and a lack of sufficient guidance regarding the definition of the Ohio right of publicity are at fault. By following a clear cut, step by step approach, the *ETW* court could have avoided these pitfalls and focused on a more thorough examination of Rush's work under the "transformative elements" test. Future courts can do the same and in the process provide better insight into the true strengths and weaknesses of the "transformative elements" test.

A. THE "TRANSFORMATIVE ELEMENTS" TEST ESTABLISHED IN *COMEDY III* IS ESSENTIALLY WORKABLE

While the "transformative elements" test established in *Comedy III* has been heavily criticized, it is essentially workable. Not only does the test strike the appropriate balance between the celebrity's interests and artist's rights, but it

134. *ETW*, 332 F.3d at 938.

135. *Id.*

leaves room for courts to make the fact specific determinations necessary to ensure fair results in unavoidably subjective decisions. In addition, the alternatives proposed up to this point do not offer realistic suggestions for either increasing clarity or decreasing subjectivity in court decisions; nor do they address the significant economic benefits that celebrities receive from some unauthorized use of their identities. Together, these three reasons provide sufficient justification for applying the “transformative elements” test to cases, such as *Comedy III* and *ETW*, where the right of publicity intersects with the First Amendment.

1. The “Transformative Elements” Test Strikes the Right Balance

Considering the questionable strength of the rationales for a right of publicity,¹³⁶ the *Comedy III* court struck the correct balance between a celebrity’s right of publicity and an artist’s First Amendment rights when formulating the “transformative elements” test. A celebrity’s right of publicity is primarily based on economic justifications.¹³⁷ How much their economic interests, and thus their publicity rights, should be protected should be premised on how important economic incentives are to the celebrity.¹³⁸ While one can hardly discount the significant investment a celebrity makes in herself, “fame pre-existed the right of publicity and no one apparently needed the law’s protection to become famous before this century.”¹³⁹ In addition, it is likely that some unauthorized use of a celebrity’s identity increases, rather than decreases, the celebrity’s value.¹⁴⁰ Concerns about “over exploitation” and “unjust enrichment” only become relevant when an artist’s or author’s use of the celebrity’s identity misappropriates or directly competes with the celebrity’s own use, “without being

136. See *supra* notes 23-46 and accompanying text.

137. See *supra* notes 23-46 and accompanying text.

138. In *de Grandpré*, *supra* note 27, *de Grandpré* asserts that the current rules governing a right of publicity are overbroad, and that “efficient rules of right of publicity infringement should prevent the over-exploitation of celebrity identity while at the same time encouraging communicative uses that produce greater positive externalities than negative ones.” *Id.* at 108. This comment suggests that the “transformative elements” test fulfills Mr. *de Grandpré*’s requirements.

139. *de Grandpré*, *supra* note 27, at 103.

140. See *supra* note 34 and accompanying text.

transformative.”¹⁴¹

The “transformative elements” test recognizes this by narrowing the number of situations in which a celebrity can claim a violation of the right of publicity. While the first prong of the test focuses on the artistic elements of a work, the “subsidiary prong” expressly urges that a court take account of the economic justifications for the right of publicity.¹⁴² In doing so, the test preserves the right of a celebrity to receive compensation if an artist simply takes a celebrity’s identity and uses it without contributing more than “trivial” artistic content or ideas, where the artist’s “creativity, skill, and reputation”¹⁴³ do not add to the work. In such a case, the bare use of the celebrity’s investment without any additional contribution amounts to almost a taking, since it is the celebrity’s investment alone that is being used. People viewing and buying the artwork will tire of the celebrity more quickly, since the only thing being portrayed in the artwork is the celebrity himself.

By contrast, an artist who has met the celebrity’s investment with his or her own contribution by adding expression separate from the celebrity’s identity is protected under the “transformative elements” test. Considering the questionable economic justifications for the right to publicity, this result seems to be fair. It is less likely that artists who

141. See de Grandpré, *supra* note 27, at 116-17. de Grandpré suggests that an efficient right of publicity would “prohibit unauthorized uses of identity that harm it—that result in net negative externalities—but would allow unauthorized uses that result in net positive externalities—informative or recoding uses, for example.” *Id.* at 114. The most inefficient uses of publicity are “[u]nauthorized deceptive uses of persona . . . [since they] have no social value and cause significant injury to a celebrity, especially if she has already endorsed goods or services in related markets.” *Id.* at 117. “[U]ses of persona in circumstances that are shocking or repulsive also result in near immediate harm, and should be considered deceptive” and violative of a right of publicity. *Id.* In addition, “unauthorized reproductions of performances [should] also remain right of publicity infringements because they directly compete with a performer’s business, while the social benefit of copied performances is limited if the defendant does not improve on the plaintiff’s act.” *Id.* By contrast, “uses that trigger curiosity rather than fatigue usually do not result in congestion externalities.” *Id.* at 117-18. Moreover, informative uses often entail high transaction costs because it is notoriously difficult to make consumers pay for the information” *Id.*

142. *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001) (stating that “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?”).

143. *Id.*

incorporate more than “trivial” content or ideas will be unjustly enriched, since they have had to make an investment in the artwork as well, whether it is through their own thoughts, talents, or “reputation” as an artist. In fact, the artist’s effort may even unjustly enrich the celebrity. It is entirely possible that the artist’s use of the celebrity’s identity will increase, rather than decrease, the popularity of the celebrity by adding to the number of people who recognize the celebrity and what he or she does.¹⁴⁴ In addition, a celebrity whose personal identity plays a minor role in a piece of artwork should not be as concerned about over-exploitation, since it is as likely that someone will purchase the artwork for the art itself as it is that he or she will purchase the art for the celebrity image thereon. Thus, any economic incentives the celebrity has to perform or create are not threatened by the use of his or her identity in such a situation.

2. The “Transformative Elements” Test Allows for a Fact-Specific Inquiry

Cases dealing with art, music, and related pursuits are inevitably unique and fact-intensive. The “transformative elements” test provides a workable solution in such cases because it allows courts to make case-by-case determinations on the contribution(s) of authors to the specific piece of art at issue. While the test implicates a minimal amount of subjectivity, such subjectivity is unavoidable and not necessarily undesirable. In fact, it may enhance the quality of court decisions by avoiding the confusion and possible unfairness that could result from bright line rules that attempt to squeeze diverse fact situations into the same, ill-fitting mold.¹⁴⁵

While some commentators have criticized the “transformative elements” test for being too vague¹⁴⁶ and allowing too much subjectivity in judgment,¹⁴⁷ this subjectivity

144. See *supra* notes 44-46 and accompanying text.

145. It is almost impossible to use a one-size-fits-all objective standard to judge such diverse works as paintings, sculptures, television and radios advertisements, web pages, etc. Our recent experience in attempting to merge new internet technology into the existing statutory regime (both in copyright and patent law) is just one example of the difficulties inherent in attempting to reconcile diverse forms of creativity under the same standards.

146. Peles, *supra* note 12, at 549.

147. See *supra* text accompanying note 79.

is probably an inevitable result, considering the subject matter to which the test is applied. Courts have attempted to make so-called “objective” decisions in cases involving artwork for decades, with mixed results.¹⁴⁸ Judges and juries have tastes, preferences, and opinions. Art appeals to these different tastes, preferences, and opinions in different ways. Instead of hiding behind a bright line rule with an illusory promise of objectivity, the “transformative elements” test rightly recognizes that that a minimal amount of subjective judgment will be involved in court cases involving art, music, writing and related pursuits. It puts the parties on notice that a court will be considering whether an artist has contributed something other than just a literal depiction of a celebrity to the world of art.

Related is the idea that art depicting celebrities comes in many forms. Likewise, the “expression” that adds a “transformative element” to the art can take many forms. The “transformative elements” test recognizes these differences by leaving the definition of “transformative elements” open so that future courts will be able to tailor its meaning to the facts of each individual case.¹⁴⁹ It is hardly unwise to do so, considering that art and its “elements” can encompass an infinite type and amount of expression limited only by the

148. Such difficulties have occurred in reference to the determination of originality, a constitutional prerequisite to protection in copyright law. *Compare* *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884) (stating that a photograph of Oscar Wilde is a “useful, new, harmonious, characteristic, and graceful picture, and that said plaintiff made the same . . . entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera” and therefore holding that the photograph was “an original work of art, the product of plaintiff’s intellectual invention” for which copyright protection was available and violated in this case) *with* *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951) (stating that “[o]riginal’ in reference to a copyrighted work means that the particular work ‘owes its origin’ to the ‘author.’ No large measure of novelty is necessary”); *and* *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 197 (S.D.N.Y. 1999) (stating that “‘slavish copying,’ although doubtless requiring technical effort, does not” entitle a work to copyright protection); *and* *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991) (holding that “[o]riginal, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possess at least some minimal degree of creativity”).

149. *Comedy III*, 21 P.3d 797, 809 (Cal. 2001). The *Comedy III* court emphasized that “transformative elements or creative contributions that require First Amendment protection are not confined to parody and can take many forms, from factual reporting . . . to fictionalized portrayal . . . to subtle social criticism [citations omitted].” *Id.*

imagination of the human mind. In doing so, the test avoids the unfairness that could result if it set forth specific factors or requirements that would be binding on future courts. Since the world of art is incredibly diverse, it is likely that any test that places artwork into categories, or subjects it to specific requirements, or requires that it meet certain factors, thereby preventing a court from delving into the content of the art, would itself cause unfair results.

Traditionally, however, the fear of integrating subjectivity into court decisions has, at least on the surface, caused courts to staunchly oppose standards that recognize the use of any subjective judgments.¹⁵⁰ However, there is nothing inherently wrong with making subjective judgments; judges and juries make them often.¹⁵¹ What is dangerous is failing to recognize

150. The most famous opinion cited in support of this idea is that of Justice Holmes in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). The “Bleistein Non Discrimination Principle” was stated in the copyright infringement case as such:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation . . . At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value- it would be bold to say that they have not an aesthetic and educational value- and the taste of any public is not to be treated with contempt.

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251-52 (1903).

151. See Julia Reytblat, *Is Originality in Copyright Law a “Question of Law” or a “Question of Fact?”: The Fact Solution*, 17 CARDOZO ARTS & ENT. L.J. 181, 185-86 (1999) (stating that “[c]ourts have wrestled with defining and measuring creativity, usually with little success, for over hundred years. Several specialized approaches have emerged, all of which are extremely subjective”). Reytblat explains these specialized approaches, which correspond to different types of protected works. The first approach is the *Feist* test for evaluating originality in compilations. *Feist* requires that there be a “collection of pre existing material facts or data,” that “the data must be selected, coordinated or arranged,” and that “by virtue of such selection, coordination, or arrangement, an original work of authorship must be created.” *Id.* at 187-88. While the court in *Feist* did not list the types of organization that would pass the creativity test, according to Reytblat, “it did say that the structure chosen must be a product of choice that reflects ‘the existence of . . . intellectual production, of thought, and conception.’” *Id.* at 188 (citing *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 348, 362 (1991)). The second area Reytblat looks at is “derivative works.” In this area a court must decide whether the “quantity and quality of the author’s contributions” constitute “sufficient minimal creativity to merit copyright protection.” *Id.* at 190. To determine this, courts often use the “distinguishable variation” test, in which “an author claiming ownership of a

subjectivity and appropriately constraining it.¹⁵² As set forth by the *Comedy III* court, the “transformative elements” test is appropriately constrained: courts are “not to be concerned with the quality of the artistic contribution—vulgar forms of expression fully qualify for First Amendment protection”¹⁵³ and the “inquiry is [intended to be] more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”¹⁵⁴ The “subsidiary inquiry” constrains judgment even further, asking courts to consider “in close cases” where the “economic value of the challenged work derive[s] . . . from.”¹⁵⁵ While none of these

valid copyright in a derivative work must point out the variations he has made, and then allow the court to determine if those variations are ‘distinguishable,’ rather than ‘merely trivial.’” *Id.* at 191 (citing Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801, 846 (1993)). Finally, Reytblat explains a test relied on by Judge (now Justice) Ginsburg in *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989) to “measure creativity in truly ‘original’ works of authorship, those that are neither derivative works nor compilations.” *Id.* at 192. Reytblat states that Ginsburg “relied upon an instinctive or subjective judgment of a work, based on one’s experience of the world” in finding that the “selection and rearrangement of common shapes demonstrated a minimal element of ingenuity heretofore unseen” and so gave Atari copyright in its video game “Breakout.” *Id.* at 193-94. The district court had held that the Register of Copyrights was correct in refusing to register the game because of lack of originality, since the game “consisted of nothing more than an aggregation of common geometric shapes and colors.” *Id.* at 193 (citing *Atari Games Corp. v. Oman*, 888 F.2d 878, 883 (D.C. Cir. 1989)).

Reytblat further states that “originality is inexorably linked to the communal perception of what is artistic, imaginative or inventive.” *Id.* at 196. This carries over into other areas of the law: “like originality, these three issues [trademark infringement, the “reasonableness of conduct in tort law,” and “[s]ubstantial similarity in copyright law”] are invariably subjective and are firmly tied to community standards, to what the community views as being reasonable, confusing, or pilfered. These determinations call for subjective judgments based on peoples’ experiences and perceptions of the world.” *Id.* at 197.

It should be noted that Reytblat argues that because judgments in copyright law and other areas of intellectual property are so subjective, they should be left to juries, not judges. This comment reserves judgment on that issue for other researchers and only notes that Reytblat’s arguments support the idea that judges and juries are called on to make subjective judgments regularly.

152. If one relies on the belief that courts are making entirely objective determinations, it is likely that he or she will fail to set boundaries to constrain that judgment. By recognizing the fact that all judgments are inherently subjective, one can tie in factors that guide a court’s judgment in order to increase predictability and consistency.

153. *Comedy III*, 21 P.3d at 809.

154. *Id.*

155. *Id.* at 810.

considerations will provide a rule that allows parties to determine their fate with one hundred percent accuracy, they do ensure that judges and juries cannot make determinations based on their personal opinions of the artist, artwork, or celebrity.

3. Alternative Tests Do Not Provide Appropriate Substitutes

Two main alternatives to the “transformative elements” test have been proposed: the Cultural Niche Theory of Art and the copyright “Fair Use” defense.¹⁵⁶ While each of these tests has their benefits, neither is an appropriate substitute for the “transformative elements” test.

a. The Cultural Niche Theory of Art

The Cultural Niche Theory of Art is not an appropriate substitute for the “transformative elements” test because it fails to eliminate the subjectivity. In addition, while the “transformative elements” test recognizes the relatively weak economic justifications behind the right of publicity, the Cultural Niche Theory of Art dispenses with them altogether, creating a situation where the most egregious violations of celebrities’ economic rights may go un-remedied, while small ones may be punished.

Proponents of the Cultural Niche Theory assert that the test removes some of the subjectivity of the “transformative elements” test by placing works into either the “Popular Art” category or the “Fine Art” category, with protection being given to “Fine Art.”¹⁵⁷ However, upon close examination, one comes to the realization that the line between what is “Popular Art” and “Fine Art” is blurred and subjective as well. For example, the Cultural Niche Theory asks the finder of fact to determine whether a work’s purpose is to “entertain, to stimulate emotion or project sentimentality” (evidence suggesting “Popular Art”) or to “exhibit a personal expression, originality, [or] creativity” (evidence suggesting “Fine Art”).¹⁵⁸ First and foremost, it seems that the two categories are not mutually exclusive. In addition, one must ask how judges and juries can be expected to make such a decision without consulting their own ideas about entertainment, emotion, and sentimentality.

156. See *supra* notes 82-83 and accompanying text.

157. See *supra* text accompanying note 82.

158. See *supra* text accompanying note 82.

Furthermore, the Cultural Niche Theory requires the fact finder to classify something as “Popular Art” based on what is “conventional” or “familiar”.¹⁵⁹ This classification, as well, ultimately depends on what is “conventional” or “familiar” to a particular person and necessarily requires judges and juries to consult their own ideas and opinions.

Since it fails to recognize the subjectivity inherent in these questions, the Cultural Niche Theory fails to constrain it.¹⁶⁰ The Cultural Niche Theory invites judges and juries to decide what “entertains” or is “familiar” to them, without setting guidelines regarding offensive materials or suggesting additional factors that may be considered in borderline cases. Thus, the Cultural Niche Theory may actually be more subjective and possibly more dangerous than the “transformative elements” test.

The Cultural Niche Theory is also faulty because it may protect art that significantly infringes on a celebrity’s economic right, but condemn art that results in only minimal conversion. This discrepancy completely ignores the unjust enrichment justification behind the right of publicity. If an artist created a one-of-a-kind, original painting depicting the exact replica of a celebrity, for example—a president, and sold it at an art sale for one million dollars, the work would be fully protected if the distinction between “Fine Art” and “Popular Art” is applied as suggested.¹⁶¹ However, if the artist created a small playing card out of this same painting and then made and sold 50,000 copies for one dollar each, the playing cards would be considered “Popular Art” and thus not protected.¹⁶² While the

159. See *supra* text accompanying note 82.

160. See *supra* text accompanying note 82.

161. Under the characteristics of “fine art”, noted *supra* text accompanying note 82, a realistic painting of the president’s likeness is likely to be considered “fine art.” In his article, *The Three Stooges Latest Act: Attempting to Define the Scope of Protection the First Amendment provides to Works of Art Depicting Celebrities, Comedy III Productions, Inc. v. Saderup, Inc.*, Singer uses the example of the Mona Lisa to illustrate fine art. See Singer, *supra* note 78. The Mona Lisa is a work of “fine art,” he states, because its value “arguably lies in its aesthetic form, its expression, its creative uniqueness or its appeal to intellect and reason of the mind. *Id.* More importantly, the Mona Lisa is valued as an original, one-of-a-kind work of Fine Art.” *Id.* at 334. A similar, expensive, one of a kind portrait of the president could be considered analogous.

162. Under the characteristics of “popular art”, noted *supra* text accompanying note 82, such an item would almost certainly be considered popular art, since playing cards are inexpensive, marketed in venues where

celebrity may suffer greater damage in the form of over-exposure via the 50,000 playing cards, the case for preventing unjust enrichment of the artist would be much greater with the one-of-a-kind original painting.¹⁶³ Arguably, this creates an unfair result for both the celebrity, who suffers greater damage from the protected work, and the artist, whose small-scale work is prejudiced by the fact that it appeals to a number of people whose art budget is limited to a one dollar playing card.

The “transformative elements” test avoids this problem by premising the distinction between protected and unprotected expression on the subject of the art itself and then considering where the economic value of the artwork comes from.¹⁶⁴ In our example above, the artist will be prevented from being unjustly enriched, since the test ensures that the artist has contributed something to the work and that the value of the work is not

the greatest number of people have access to them, and many copies of them can be distributed, all of relatively equal value because of their unoriginality or lack of uniqueness.

163. Hypothetically, more people would undoubtedly have access to seeing and obtaining a playing card than a one-of-a-kind million dollar painting. However, if we assume that the celebrity would ask for a twenty five percent cut on all the earnings of either type of artwork, the one of a kind, original work protected by the Cultural Niche theory is doing the greatest damage to the celebrity economically by denying him or her this cut. Furthermore, if the painting is famous enough, it is possible that potential for over-exposure could even be greater with the one-of-a-kind painting than with the playing cards.

164. Recall that the test requests a court to consider 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 . . . 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.” *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001). A court is then requested to consider whether the “marketability and economic value of the challenged work derive[s] primarily from the fame of the celebrity depicted.” *Id.* at 810. Under this test, one cannot be sure whether a court would protect the one-of-a-kind painting, but under the marketability prong, if the large economic value of this painting is due to the celebrity’s own fame, it would go against the idea that the painting should be protected by the First Amendment. This gives greater protection to a celebrity whose rights have truly been infringed, since a celebrity can suffer economic loss from either expensive or inexpensive items. Likewise, one cannot be sure that a court would not protect the playing cards; yet, again, under the marketability and economic value prong, a court must determine whether the value of the cards is rightfully due to the celebrity. The fine art/popular art test, by placing so much emphasis on the expense and venue of the art, misses the factor that matters most: whether the celebrity is due part of the proceeds from the item; whether expensive or inexpensive; in a museum or a convenience store; because he or she is the reason the article is of value.

solely due to the celebrity's fame. The expense and distribution of the work makes no difference; it is the content of the work itself that matters.

b. Copyright's Fair Use Defense

Scholars have also suggested that importing the entire fair use defense from copyright law will provide a more clear and predictable test in right of publicity cases. However, "the factors used in copyright analysis do not readily lend themselves to right of publicity" claims¹⁶⁵ and might result in overprotecting a celebrity's right of publicity.

The first major problem with using the fair use factors is that right of publicity does not correctly fit the paradigm. As Mark Lee notes:

[The first] copyright fair use factor[], the 'nature of the copyrighted work,' would generally not be helpful in right of publicity analysis because the identity rights involved would usually be of the same 'nature.' Another factor, 'the amount and substantiality of the portion used in relation to the copyrighted work as a whole,' also would not generally be meaningful, since by definition there must be a taking of an individual's identity before right of publicity liability attaches. A third factor, 'the effect of the use upon the potential market for or value of the copyrighted work,' would routinely favor a finding of infringement, as Supreme Court authority establishes that an uncompensated taking will generally have an adverse effect on the market for commercial exploitation of the celebrity's image.¹⁶⁶

Lee highlights the second major problem with using the fair use standard in right of publicity cases: the third factor in the fair use standard will almost always fall in favor of finding a violation of a right to publicity.¹⁶⁷ Since one factor is almost certainly determined against artists from the outset, they face what is effectively a presumption of infringement. Yet tipping the balance against the artists does not make sense. Not only are they arguably asserting the more important right in such cases, the First Amendment right, but the "presumption" fails to take account of an important difference between the right of publicity and copyright. While copyrights are limited in duration, many courts have held that the right of publicity exists posthumously and is both inheritable and devisable, without regard to time limits.¹⁶⁸ In order to preserve the balance between the right of the artist and the original author

165. Lee, *supra* note 19, at 492.

166. *Id.*

167. *See id.*

168. 62A AM. JUR. 2D *Privacy* § 25 (2003).

or celebrity, it would seem that the right of publicity should have broader exceptions than the fair use defense permits in copyright to offset the greater temporal protection it offers. Yet by simply applying the fair use factors to the right of publicity, one is narrowing the scope of the right without compensating for the fact that the right of the celebrity likely exists in perpetuity.

The “transformative elements” test adopted in *Comedy III* is thus workable. The test appropriately balances the right of publicity and the First Amendment, and allows courts the flexibility to make necessary fact specific determinations. Furthermore, the main alternatives to the test do not hold up under scrutiny. Yet the future of the “transformative elements” test depends on the ability of courts to correctly apply it. As noted below, for the *ETW* court, the application of this workable standard appeared to be a challenge.

B. THE *ETW V. JIREH* DECISION THREATENS THE FUTURE APPLICABILITY OF THE “TRANSFORMATIVE ELEMENTS” TEST

The Sixth Circuit, in *ETW Corp. v. Jireh Publishing, Inc.*,¹⁶⁹ was the next court to utilize the “transformative elements” test after the *Comedy III* decision. While the “transformative elements” test is essentially workable, a person reading the *ETW* decision may have serious doubts about the standard’s future. A closer look, however, reveals that it is not the test itself that makes the *ETW* decision confusing and unclear. The *ETW* court, while ultimately reaching a correct decision, encountered a number of problems when attempting to explain its reasoning. First and foremost, the very structure of the analysis does not lend itself easily to clarity.¹⁷⁰ Second, the court appears to break the right of publicity decision into three inquiries, but it fails to directly address the issues it presents. Third, the court’s analysis was made more difficult by the fact that it was working with common law, not a broad statute as in *Comedy III*.¹⁷¹ Finally, incorporating the comments accompanying a Restatement in its right of publicity definition led the court to overlook the fact that the “transformative elements” test was intended to be an

169. 332 F.3d 915 (6th Cir. 2003).

170. See *infra* Part III.B.1.a.

171. See *infra* Part III.B.1.c.

affirmative defense.¹⁷² These four problems, not the “transformative elements” test, are what complicated a fairly straightforward decision. By clarifying the structure of the decision, addressing the major issues it set out to analyze, and abandoning the Restatement comments as part of the Ohio right of publicity, the court could have avoided considerable confusion and focused instead on a clear, concise analysis under the “transformative elements” test. The *ETW* decision perhaps then could have provided better guidance to future courts on how to apply the “transformative elements” test and given future courts and litigants a more accurate picture of the test’s true value.¹⁷³

1. The *ETW v. Jireh* Decision Regarding the Right of Publicity Is Confusing and Unclear, But This Confusion Is Not Due to the “Transformative Elements” Test

In reading the Court’s right of publicity decision in *ETW*, one can spot four major problems: the court uses an inappropriate structure to tackle the problem, it fails to answer the questions it asks, the necessary use of Ohio common law, as opposed to statutory law, made the analysis more complex, and the court’s use of the Restatement and accompanying comments to determine whether Woods had a right of publicity led it to ignore the fact that the “transformative elements” test was intended to be an affirmative defense.

a. The Structure of the Court’s Analysis Was Inappropriate

In dealing with the numerous claims brought by *ETW* in this case, the Sixth Circuit attempted to separate them into logical categories for explanation and analysis. Under section IV, titled “Lanham Act Unfair Competition and False Endorsement Claims, Ohio’s Right to Privacy Claims, and the First Amendment Defense”, the court first talked about First Amendment defenses in general, quickly analyzed whether the First Amendment applies to Rush’s work, and then explained the Lanham Act claims and right of publicity claims, all in separate, clearly labeled sections.¹⁷⁴ It then attempted to apply

172. See *infra* Part III.B.1.d.

173. See *infra* Part III.B.2.

174. See *ETW Corp. v. Jireh Publ’g., Inc.*, 332 F.3d 915, 924-36 (6th Cir. 2003).

the law that it just explained in one large section.¹⁷⁵ The court moved with lightning speed from the Lanham Act claim to the right of publicity claim and mixed more First Amendment application in with each.¹⁷⁶

This structure leads to considerable confusion. The court painstakingly explained the law in each area but then failed to apply it as carefully. The decision reads as if the court suddenly became tired of thinking about the issues and uncomfortably penned a string of conclusions as fast as possible to get rid of the case. By using cases and analysis from the right of publicity explanation in the Lanham Act analysis, and vice versa, the reader begins to wonder just where the application of Lanham Act principles ends and the application of the right of publicity principles begins.¹⁷⁷ The First Amendment defense explanation and short application at the beginning of the decision¹⁷⁸ and then subsequent application of the First Amendment defense intermittently throughout the Lanham Act and right of publicity analyses¹⁷⁹ leaves the reader confused about which First Amendment principles apply to the facts. This frustrates the reader and fails to separate clearly the important issues implicated by the right of publicity long before the “transformative elements” test is applied.

b. The Court Fails to Address the Issues It Poses

The second major problem with the *ETW v. Jireh* decision is that the court fails to answer directly the questions it asks. The *ETW* court appears to be attempting to break the right of publicity issue into three basic inquiries: (1) Was Woods’s right of publicity violated?; (2) If so, does the First Amendment apply to Rush’s painting?; and finally (3) If the First Amendment does apply, do Rush’s First Amendment rights trump Woods’s right of publicity under the “transformative elements” test?¹⁸⁰ The substance and order of these questions is logical. The *Comedy III* court intended the “transformative elements” test to be an affirmative defense,¹⁸¹ so it only makes sense that a

175. See *id.* at 936-38.

176. See *id.* at 924-38.

177. See *id.*

178. See *id.* at 924-25.

179. See *id.* at 925-36.

180. See *id.* at 936.

181. See *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001) (“In sum, when an artist is faced with a right of publicity challenge

court first ask whether there was actually a violation, second consider whether a First Amendment defense is available at all, and finally take that defense and apply it to the facts at hand.

However, the court does not directly discuss the answers to these questions but engages in a prolonged discussion of balancing, precedent, and other tangential issues. As the dissent notes, “it appears that the majority engages in three separate analyses, and arrives at three separate holdings, although all of which reach the same result”¹⁸² and does so independently of one another. The first conclusion the court draws is that Rush’s work does not violate Woods’s right of publicity since “Rush’s work has substantial informational and creative content which outweighs any adverse effect on ETW’s market.”¹⁸³ The court then goes on to discuss whether the First Amendment applies to Rush’s work.¹⁸⁴ Yet this question is already answered in the preliminary discussion about First Amendment defenses when the court stated “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.”¹⁸⁵ Instead of simply stating this concept, the court discusses the balance between the restriction placed on Rush and the interest of Woods.¹⁸⁶ At this point, one begins to question the purpose of the prior First Amendment discussion. The answer to whether Rush’s work is entitled to full protection of the First Amendment apparently re-surfaces a few paragraphs later, but neither the analysis nor the conclusion match up with the question that was originally

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”).

182. *ETW*, 332 F.3d at 951 (Clay, J., dissenting).

183. *Id.* at 937.

184. *See id.* at 937-38. The court expressly states that “Rush’s work does not violate Woods’s right of publicity.” *Id.* at 937. One would think that this is the end of the story, since if Woods’s right of publicity has not been violated, then there is no cause of action, hence, no liability. Yet the beginning of the next sentence continues with the analysis: “We further find that Rush’s work is expression which is entitled to the full protection of the First Amendment.” *Id.* at 937. Note that there is no language indicating that this is an alternative argument but is a continuation of the prior analysis.

185. *Id.* at 925.

186. *See id.* at 937-38.

asked.¹⁸⁷ The court finally ends its First Amendment analysis by stating 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”;¹⁸⁸ but the balancing here was neither necessary nor relevant to the issue of whether Rush’s work was entitled to full First Amendment protection.

Finally, the court announced it would apply the “transformative elements” test to the facts at hand.¹⁸⁹ In a single, brief paragraph, it looked at the first prong of the test and then simply stated that because the work has substantial “transformative elements” it is entitled to First Amendment protection.¹⁹⁰

As described, none of the answers to the questions the court originally set out to ask are directly on point. The only inquiry that the court provides a direct response to is whether

187. *Id.* The court says originally that it is considering whether Rush’s work “is entitled to the full protection of First Amendment and not the more limited protection afforded to commercial speech.” *Id.* at 937. It then notes that “[w]hen 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*.” *Id.* However, the *Cardtoons* court explicitly stated that it was applying a balancing test to determine “whether *Cardtoons*’ First Amendment right trumps [Major League Baseball’s] property right,” and did so only after it had already discussed and concluded that the trading cards at issue in the case were not commercial and were subject to the full protection of the First Amendment. See *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996). The *ETW* court’s analysis is thus directed at the wrong question.

188. *ETW*, 332 F.3d at 938. In essence, the *ETW* court was applying a test that was supposed to be replaced by the “transformative elements” test. Neither the *Cardtoons* test nor the “transformative elements” test has anything to do with whether Rush’s work was entitled to the full protection of the First Amendment.

189. *ETW*, 332 F.3d at 938.

190. *Id.* The court only goes so far as to state that “Rush’s work does not capitalize solely on a literal depiction of Woods . . . [but] consists of a collage of images . . . 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.” *Id.* It does not specifically address whether the “marketability and economic value of the challenged work derives primarily from the fame” of Tiger Woods or whether the “creativity, skill, and reputation” of Rush gives it greater value. See *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d at 810. In doing so, the court misses the point behind the subsidiary prong: evaluation the economic harm to the celebrity, in proportion to the amount of the work that can be said to be rightfully “his/hers.” See *id.*

Woods's right of publicity is violated. However, it does so by engaging in a balancing approach that would be better addressed by the "transformative elements" analysis. If the court is correct in stating that Woods's right of publicity is not violated, the decision should be over.¹⁹¹ Confusion abounds, then, when the question of whether the First Amendment applies is considered; confusion increases exponentially when one considers that this question has already been asked and answered. Throughout discussions of the right of publicity violation and applicability of the First Amendment, the court intermittently drops references to Rush's addition of a "significant creative component" to Woods's "identity" and the reduction of "commercial value" in Woods's likeness, making it look like the "transformative elements" test was really the only issue the court was considering after all.¹⁹² When the court actually addresses what it explicitly states is the "transformative elements" test, it repeats the same arguments and comes to a conclusion that the reader thought was already made by the court.¹⁹³ Ultimately, the *ETW* Court's failure to clearly and directly address the three questions it sets out to analyze results in an analysis that keeps the reader guessing where one question's answer ends and where another's begins, and which questions are even relevant, much less essential, to the court's final decision in the case.

c. The Necessary Use of Ohio Common Law Made the Analysis More Complex

A third major factor that makes the *ETW* decision confusing is the fact that at the time of the decision, common law, rather than broad statutory law, governed the right of publicity in Ohio.¹⁹⁴ The lack of case law regarding the right of

191. As noted *supra* note 184, if the court was intending to provide the parties and the reader with alternative arguments, it fails to make this clear.

192. *ETW*, 332 F.3d at 922-38.

193. *See id.* at 938. The court ends this analysis by stating 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." *Id.* As noted previously, the question of whether the work is entitled to the full protection of the First Amendment was already determined prior to the right of publicity analysis, and has nothing to do with whether the work has substantial transformative elements.

194. *Id.* at 929 n.15 (stating that the right of publicity was codified in the Ohio Revised Code, chapter 2741, in 1999). However, the *ETW* litigation began before the effective date of the statute, and *ETW* did not invoke the

publicity in Ohio forced the court to plunge into unfamiliar territory with little or no guidance in its decision making process.

As the court in *ETW* noted, Ohio did not have a statutory right of publicity until 1999.¹⁹⁵ While it was clear to the court that a right of publicity existed, the Ohio case law on the subject was incredibly sparse.¹⁹⁶ By contrast, the court in *Comedy III* had a broad California statute. The California statute simply set forth the elements of a right of publicity and did not incorporate any First Amendment concerns.¹⁹⁷ This made it much easier for the *Comedy III* court to determine first, whether the right of publicity existed and next, whether and how the First Amendment applied. By contrast, the *ETW* court had to go through additional steps to define the right of publicity in Ohio. This meant not only looking at Ohio cases, but also interpreting inconsistent federal court authority and Restatement provisions as well.¹⁹⁸ Most of the cases the court considered incorporated First Amendment concerns in their primary lines of analysis, so the form of the right of publicity that the cases adopted did not match up with the idea of a First Amendment “affirmative defense.”¹⁹⁹ Thus, when the court

relevant provisions. *Id.*

195. *Id.*

196. The *ETW* court noted that the Ohio Supreme Court recognized the right of publicity in *Zacchini v. Scripps-Howard Broad. Co.*, but that there were “few [other] Ohio decisions defining the contours of the right of publicity in the aftermath of *Zacchini*.” See *ETW*, 332 F.3d at 929.

197. *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 800 (Cal. 2001). Section 990 of the California Civil Code stated, at the time the *Comedy III* litigation was commenced:

Any person who uses a deceased personality’s name, voice, signature, photograph, or likeness, in any manner, on or in any 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. (citing CAL. CIV. CODE § 1 (1984)). The court noted that after it had granted review, the California legislature renumbered the statute as § 3344.1 of the Civil Code, but that it was interpreting the former statute, so was referring to it as section 990. *Id.* at 799 n.1 (citing CAL. CIV. CODE § 1 (1999)).

198. See *supra* notes 109-125 and accompanying text.

199. See *supra* notes 109-125 and accompanying text. All the cases the *ETW* court considered were, naturally, decided before the *Comedy III* decision. While these cases were relevant to determining the basis for the *Comedy III* “transformative elements” test, the difficulty with relying on them as precedent was that the “transformative elements” test was intended to replace

described the right of publicity in Ohio, it included many of the concerns that underlie the “transformative elements” test before it even got to the test as a defense. This is a major source of confusion since it makes the “transformative elements” test repeat the factors already considered by the court under the inquiry of whether the right of publicity exists.

d. The Use of the Restatement and Accompanying Comments Ignored the Fact That the “Transformative Elements” Test Was Intended to Be an Affirmative Defense

The final factor that casts doubt on the “transformative elements” test in *ETW v. Jireh* is the right of publicity definition the court eventually settles on. The definition used by the court incorporates considerations used by the “transformative elements” test and thus ignores the fact that the test was intended to be an affirmative defense.²⁰⁰ Consequently, the decision is unclear as to where the burden of proof lies on the issues in the case.

After considering case law and possible interpretations of the right of publicity, the *ETW* court finally settled on a definition in the Restatement (Third) of Unfair Competition § 47, including comment (d).²⁰¹ In order to evaluate completely

the different forms of analysis that they were decided upon.

200. The court stated:

In sum, when an artist is faced with a right of publicity challenge to his or her work, he or she may raise as an 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.

Comedy III, 21 P.3d at 810.

201. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47:

[T]he name, likeness, and other indicia of a person’s identity are used ‘for purposes of trade under the rule stated in § 46 if they are used in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, uses ‘for purposes of trade’ does not ordinarily include the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.

Id. at § 46. The Right of Publicity states “[o]ne 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.* Comment (d) of § 47 (which the *ETW* court said an Ohio court would construe its right of publicity as) states that “some courts have engaged in an analysis analogous to the determination of a fair use in copyright law. The substantiality and market effect of the appropriation have been analyzed in

whether a right of publicity has been violated under this rule, a court has to look to “the substantiality and market effect of the use of the celebrity’s image . . . in light of the informational and creative content of the defendant’s use.”²⁰² This is, essentially, what the “transformative elements” test does in its evaluation. When considering the “market effect” and “informational and creative content” in the right of publicity inquiry, the court is taking the burden of proof away from the defendant and placing it on the plaintiff, presumably a celebrity, in the first instance. If a right of publicity under this rule exists, once a court gets to the question of “transformative elements”, there is little left to consider. The existence of “transformative elements” has in large part been proven, or disproven, already. If a right of publicity does not exist under this rule, it is as if the “transformative elements” test has already been applied, with the plaintiff unfairly bearing the burden as to issues that the *Comedy III* court intended to place at the defendant’s feet.²⁰³ This upsets the balance that the *Comedy III* court forged with the “transformative elements” test and unfairly prejudices a plaintiff in an action to recover for infringement.

2. How the *ETW* Court Should Have Analyzed the Case to Preserve the Future Value of the “Transformative Elements” Test

a. Ways the Decision Could Have Been Improved

There are a number of ways that the court in *ETW* could have improved the quality of its decision and preserved the value of the “transformative elements” test. Most importantly, the court should have separated the Lanham Act and right of publicity claims, explained their substance and interaction with the First Amendment separately, and then applied them to the *ETW* facts in different sections. This would have avoided many of the problems in the analysis by simply clarifying what logic applied to each cause of action and how future courts should use the First Amendment defenses in relation to both of them. Second, the court should have expressly stated the three-step inquiry it appeared to be engaging in, and then directly

light of the informational or creative content of the defendant’s use.” *Id.* at § 47 cmt. d (1995). This is essentially the *Comedy III* “transformative elements” test.

202. *ETW Corp. v. Jireh Publ’g., Inc.*, 332 F.3d at 937.

203. *Comedy III*, 21 P.3d at 810.

addressed each question, without borrowing language or reasoning from the other inquiries.

The *ETW* court should have also defined the Ohio right of publicity differently. The actual Restatement definition of the right of publicity is clear: “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.”²⁰⁴ It is the comment from the subsequent section that takes this description and incorporates portions of the “transformative elements” test. While the main part of the rule focuses on the celebrity, the comment focuses on the artist’s contribution, which is the proper function of the “transformative elements” affirmative defense. Thus, the court should have ignored the comment and stuck to the basic rule for the purposes of determining whether Woods’s right of publicity was violated in this case.

If the court had defined the Ohio right of publicity as such, it would have made the three step analysis it was trying to engage in much clearer. Since Rush was selling a painting with Woods’s likeness on it without his consent, Woods’s right of publicity had been violated. Yet as non-commercial speech, Rush’s painting was entitled to the full protection of the First Amendment. Then the court could have moved on to a much better examination of the “transformative elements” inquiry.

b. Applying the “Transformative Elements” Test

Once the court finally arrived at the “transformative elements” test, it should have looked at the factors the *Comedy III* court set out in greater detail. Under the first prong of the test, it appears that Rush probably added “significant expression” beyond just the “literal depiction or imitation” of Tiger Woods.²⁰⁵ While the focal point(s) of the painting are three images of Tiger, he is not the only person, thing, or even celebrity depicted.²⁰⁶ The golf course, the caddy, the scenery, and the historical setting of the event all add to the work. Tiger appears to be only one of many “raw materials”²⁰⁷ from

204. *ETW*, 332 F.3d at 930 (quoting RESTATEMENT UNFAIR COMPETITION, *supra* note 85, § 47 (1995)).

205. *See Comedy III*, 21 P.3d at 808-09.

206. *ETW*, 332 F.3d at 918, 919 n.1.

207. *Comedy III*, 21 P.3d at 809.

which the painting is formed, considering the substantial portion of the work that is devoted to evoking images of past golf champions, the uniqueness of this moment in history, and the “feel” of the setting in which it takes place. Undeniably, this work appears to be much more than just “Tiger”—it is capturing something much bigger. Rush has sought to express not just the essence of “Tiger Woods,” but of golf, of Georgia, of history, and probably of the emotion of sports in general. Looking at the painting in a “quantitative” rather than “qualitative” manner,²⁰⁸ the literal or imitative elements of Tiger Woods are only three poses. The “creative” elements are much more numerous.

Under the second prong, the marketability prong, some of the value of the work does come from Tiger Woods himself. Many people who buy such a painting will be fans of Tiger Woods. However, considering the following Rush has gathered, it is likely that a significant number of people who buy the painting are Rush fans as well.²⁰⁹ Others may be simply golf fans or fans of the historic golf legends in the painting. Still others may be residents of Augusta who want to commemorate the event. No matter what their reasons, it is probable that because the painting contains much more than just Tiger’s face, body, or likeness, its value is due at least as much to the other facets of expression in the painting as it is to Tiger. Unlike the three bare faces depicted in *Comedy III*, there is so much more to the painting here than simply Tiger. As a result, his fame, while significant, cannot account for its entire value.

C. IMPLICATIONS AND SUGGESTIONS FOR FUTURE DECISIONS

Considering the volume of criticism that accompanied the *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,²¹⁰ decision,²¹¹ the *ETW Corp. v. Jireh Publishing, Inc.*²¹² decision is likely to come under significant fire as well. The problems with the *ETW* court’s analysis of the right of publicity will almost certainly add to the criticism of the “transformative elements” test. Legal scholars already skeptical about the test will find much fuel for their fire in the *ETW* decision; the poor

208. *Id.* at 809.

209. See text accompanying notes 94-96.

210. 21 P.3d 797.

211. See *supra* notes 78-85 and accompanying text.

212. 332 F.3d 915 (6th Cir. 2003).

organization, failure to address the appropriate issues at the appropriate times, and the incomplete use of the “transformative elements” test exaggerates the problems inherent in using any standard to judge a piece of artwork.²¹³

However, courts that wish to adopt the “transformative elements” test can avoid these problems in the same ways the *ETW* court could have avoided problems. First and foremost, the right of publicity claims should be clearly separated from other claims, such as the Lanham Act claims. Courts should then identify the right of publicity statute or doctrine applicable in that jurisdiction, clearly define it, and determine whether that right has been violated. If a court finds that it has been violated, the First Amendment defense may be raised by the defendant. The First Amendment analysis consists of two basic parts. First, defendant must show a particular piece of work is subject to full First Amendment protection.²¹⁴ Second, the defendant must fulfill the two pronged “transformative elements” test: she bears the burden of showing not only that her artwork contains significant “transformative elements” such that it has become “primarily [her] own expression rather than the celebrity’s likeness,”²¹⁵ but that the “marketability and economic value of the challenged work [does not] derive from the fame of the celebrity depicted” but “principally from some other source.”²¹⁶ Following this simple pattern will avoid confusion and allow courts to move forward with the “transformative elements” test, refining and molding it along the way to better address the concerns raised by legal scholars and assure that not only celebrities and artists, but society as a whole, is enhanced by the results of their decisions.

213. Legal standards used to judge art have difficulties such as vagueness, subjectivity, and difficulty in transferring the standard to different mediums.

214. How a court should go about doing this is controversial. This comment saves that question for another day. However, considering the fact that whether or not something like Rush’s work is entitled to the full protection of the First Amendment is still being discussed, any court seeking to provide a well thought out analysis and decision should therefore at least address the position that it is taking in that particular state or circuit. See *supra* note 47.

215. *Comedy III*, 21 P.3d at 809.

216. *Id.* at 810.

IV. CONCLUSION

In *ETW Corp. v. Jireh Publishing, Inc.*,²¹⁷ the court adopted the “transformative elements” test first elaborated in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*²¹⁸ The test states:

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 interests in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.²¹⁹

However, “when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but is also less likely to interfere with the economic interest protected by the right of publicity.”²²⁰ Attempting to provide a detailed analysis of the First Amendment and right of publicity issues in the case, the *ETW* court examined both state and federal jurisprudence regarding the right of publicity and the Restatement (Third) of Unfair Competition. It then determined that Ohio case law and the Restatement (Third) of Unfair Competition would determine whether Rush’s prints violated Woods’s right of publicity. To draw the line “between Woods’s intellectual property rights and the First Amendment”, the court stated that it would follow the reasoning of decisions in both the Ninth and Tenth Circuits.²²¹ Finally, the court decided that balancing the First Amendment and the right of publicity would be done under the “transformative elements” test.²²² Through a confusing and disjointed application of these principles, the court concluded that Tiger Woods’s right of publicity did not trump Rush’s First Amendment rights and granted summary judgment in favor of Rush.

The “transformative elements” test as established by the *Comedy III Productions, Inc. v. Gary Saderup, Inc.*²²³ court is practicable because it strikes the appropriate balance between the celebrity’s interests and the artist’s rights, and leaves room for courts to make the fact specific determinations necessary to ensure fair results in unavoidably subjective decisions. In

217. 332 F.3d 915.

218. 21 P.3d 797.

219. *Comedy III*, 21 P.3d at 808.

220. *Id.*

221. *ETW*, 332 F.3d at 936.

222. *Id.*

223. 21 P.3d 797.

addition, alternatives proposed up to this point do not offer realistic suggestions for either increasing clarity or decreasing subjectivity in court decisions, nor do they address the significant economic benefits that celebrities receive from some unauthorized use of their identities.

Yet the decision in *ETW* puts the “transformative elements” test in jeopardy because the court’s analysis makes the test appear confusing and unworkable. However, a close analysis of the decision reveals that a number of other factors in the court’s decision contribute: the court uses an inappropriate structure to tackle the problem, it fails to answer the questions it asks, the use of Ohio common law made the analysis more complex, and the court’s use of the Restatement and accompanying comments to determine whether Woods had a right of publicity leads it to ignore the fact that the “transformative elements” test was intended to be an affirmative defense.

The *ETW* court should have separated the Lanham Act and right of publicity claims and then explained and applied their interaction with the First Amendment and the facts of *ETW* separately. It should have also directly addressed the three questions it asked at the outset of the analysis and avoided overlapping language and reasoning between them. In sum, a court addressing a similar case in the future has a simple, straightforward task: identify the right of publicity statute or doctrine applicable in that jurisdiction, clearly define it, and determine whether that right has been violated. Further, the First Amendment defense may be raised by the defendant, who must first show that a particular piece of work is subject to full First Amendment protection. The defendant must then meet the requirements of the “transformative elements” test by demonstrating that the artwork contains significant transformative elements such “that it has become primarily the defendant’s own expression rather than the celebrity’s likeness”,²²⁴ and that the “marketability and economic value of the challenged work [does not] derive from the fame of the celebrity depicted” but “principally from some other source.”²²⁵ If a court sticks to this analysis, many of the confusions that look inevitable after the *ETW* decision will disappear, and courts will be able to judge the “transformative elements” test

224. *Comedy III*, 21 P.3d at 809.

225. *Id.* at 810.

on its true worth. If necessary, courts can refine the test to address the concerns raised by legal scholars in both writing and practice. A better analysis will lead to a better test, which, in the end ensures that the public receives greater benefits from both the right of publicity and the First Amendment with reduced costs.