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Tiger's Paper Tiger: The Endangered Right of Publicity

David J. Michnal

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Tiger's Paper Tiger: The Endangered Right of Publicity

David J. Michnal*

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I. Introduction

In 1997, Tiger Woods took the sports world by storm with a record-breaking performance at the 1997 Masters golf tournament in Augusta, Georgia.¹ Alabama resident Rick Rush, a life-long sports fan, also attended the tournament.² More significantly for Woods, Mr. Rush is a painter who specializes in painting sports subjects.³ Inspired by Woods's phenomenal victory, Rush began work on what became the subject of a bitter and costly lawsuit – a painting entitled *The Masters of Augusta*.⁴ Rush's publisher, Jireh Publishing, Inc. (Jireh), made over 5,000 copies of the painting and sold them to the public.⁵ Impelled by what he perceived to be the exploitation of his identity, Tiger Woods, via his marketing company, ETW Corp. (ETW), filed suit in the United States District Court for the Northern District of Ohio against Jireh, seeking an injunction and damages.⁶

Woods based his lawsuit, in part, on a rapidly evolving area of the law known as the "right of publicity."⁷ The right of publicity is a quasi-intellectual property right that protects the pecuniary interest of an individual's identity.⁸ In *ETW Corp. v. Jireh Publishing, Inc.*,⁹ the district court considered whether the First Amendment's protection of expression shields an artist from liability when he appropriates the likeness of a celebrity without license or consent.¹⁰ The case concerned a painting that depicted professional golfer

1. See Marcia Chambers, *Lawsuit Pits Artists' Rights vs. Athletes*, N.Y. TIMES, Feb. 16, 1999, at D1 (reporting background of legal dispute between Tiger Woods and Jireh Publishing, Inc.).

2. *Id.*

3. *Id.*

4. *Id.*

5. *Id.*

6. *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000), *appeal docketed*, No. 00-3584 (6th Cir. 2001).

7. See *id.* at 830-31 (summarizing plaintiff's allegations).

8. See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983) (explaining nature of right of publicity).

9. 99 F. Supp. 2d 829 (N.D. Ohio 2000), *appeal docketed*, No. 00-3584 (6th Cir. 2001).

10. See *ETW*, 99 F. Supp. 2d at 836 (granting defendant's motion for summary judgment on ETW's right of publicity claim). In *ETW*, the underlying dispute involved a claim by Tiger Woods's licensee, ETW Corp., that Jireh Publishing reproduced and sold lithographs of a painting of Mr. Woods at the Masters Golf Tournament in violation of the Lanham Act and Mr.

Tiger Woods in three different poses against the backdrop of the Master's Golf Tournament.¹¹ Woods's marketing agent, ETW, sued Jireh for, *inter alia*, infringement of Woods's publicity rights.¹² In its opinion, the court ruled that the First Amendment protected Rush and his assignee, Jireh, from Woods's right of publicity claim, allowing Jireh to copy and sell prints of Rush's painting without license from, or giving proceeds to, ETW.¹³ The court's decision was consistent with the trend toward broader First Amendment protection of artistic expression and the concomitant erosion in the value of publicity rights.¹⁴

In contrast, the assignee of the "Three Stooges" publicity rights, Comedy III Productions, Inc., sued a California artist for selling t-shirts and prints of his rendering of the famous trio and won \$225,000 in damages.¹⁵ In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,¹⁶ the California Court of Appeals rejected the defendant's First Amendment argument, stating that although art is generally protected by the First Amendment, "reproductions of an image, made to be sold for profit, do not per se constitute speech."¹⁷ The court ruled

Woods's right of publicity. *Id.* at 830. Subsequently, ETW brought suit against Jireh Publishing for the misappropriation of the name and likeness of Tiger Woods under several intellectual property theories. *Id.* The district court granted the defendant's motion for summary judgment on trademark infringement claims (Counts One through Five), stating that ETW failed to establish the validity of its claim to trademark rights in the image of Tiger Woods. *Id.* at 831-34. The court also granted defendant's motion for summary judgment on ETW's claim that Jireh Publishing violated Tiger Woods's right of publicity (Count Six), asserting that the print was a work of art which enjoys full First and Fourteenth Amendment freedom of expression protection. *Id.* at 834-36.

11. *See id.* at 830 (summarizing facts of case).

12. *Id.* at 830-31.

13. *Id.* at 835.

14. *See* Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity*, 9 DEPAUL-LCA J. ART. & ENT. L. & POL'Y 35, 60 (1998) (noting recent opinions doubting continued viability of regulations that restrict commercial speech).

15. *See Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 80 Cal. Rptr. 2d 464, 466 (Cal. 1998), *aff'd*, 21 P.3d 797 (Cal. 2001) (relaying facts and procedural history of case).

16. 80 Cal. Rptr. 2d 464 (1998), *aff'd*, 21 P.3d 797 (Cal. 2001).

17. *See Comedy III*, 80 Cal. Rptr. 2d at 470 (stating that reproductions of art do not necessarily receive First Amendment protection). In *Comedy III*, The California Court of Appeals addressed the issue of whether the reproduction of a charcoal rendering of the Three Stooges on t-shirts and lithographs for sale to the public violated a California law that protected publicity rights. *Id.* at 466. The court rejected the defendant's argument that this use of the Three Stooges likeness fell outside of CAL. CIV. CODE § 990(a). *Id.* at 467. The court determined that the defendant had sold the likeness itself, rather than the likeness "on or in products, merchandise, or goods," noting that t-shirts clearly fall within the ambit of § 990. *Id.* Likewise, the court rejected the defendant's argument that § 990 addresses only advertising uses. *Id.* at 468. Further, the court rejected the claim that § 990's exemption for newsworthy material

that art does not necessarily convey any message, emotion, or idea and, therefore, is not protected per se.¹⁸ The California Supreme Court affirmed the court's judgment but for different reasons.¹⁹ Rather than relying on the lower court's reasoning that reproductions are not entitled to First Amendment protection,²⁰ the California Supreme Court ruled that "depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment."²¹ Although *ETW* and *Comedy III* were litigated under differing publicity rights laws, the First Amendment issues are identical.²² Nonetheless, the results and reasoning of the two decisions are at complete odds.²³ This contradiction illustrates the continued uncertainty regarding the breadth of First Amendment protection in publicity rights cases.²⁴

This Note explores the friction between the right of publicity and the First Amendment's protection of expression.²⁵ Parts I.A and I.B examine the evolution of the publicity right from its humble beginnings as a right of privacy tort to its current incarnation as a commercial interest recognized in

applied to these facts. *Id.* The court reasoned that the material, not the person, must be of newsworthy value, otherwise all celebrities would be exempted because they are inherently newsworthy. *Id.* Turning to the defendant's claim that its use was a form of expression protected by the First Amendment, the court ruled that even if the image was individually drawn, rather than copied, it did not necessarily follow that it expressed any message, idea, or emotion. *Id.* at 470. Further, the court posited that even if the original drawing was protected expression, the First Amendment does not protect the reproduction and sale of copies. *Id.* at 471. The court agreed, however, that the injunctive relief granted to the plaintiff was overly broad and, therefore, reversed the injunction, while affirming the damages imposed at trial. *Id.* at 472.

18. *Comedy III*, 80 Cal. Rptr. 2d at 470.

19. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001) (ruling that Saderup's work was not sufficiently transformative and that his depiction of "The Three Stooges" merely exploited trio's fame).

20. *Id.* at 799.

21. *Id.* at 805.

22. See *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829, 836 (N.D. Ohio 2000), appeal docketed, No. 00-3584 (6th Cir. 2001) (evaluating defendant's First Amendment defense); *Comedy III*, 80 Cal. Rptr. 2d at 469-71 (same).

23. Compare *ETW*, 99 F. Supp. 2d at 836 (N.D. Ohio 2000) (stating that art deserves full First Amendment protection because it seeks to express a message) (citing with approval, *Berry v. City of New York*, 97 F.3d 689, 695 (2d Cir. 1996) (stating that "[art] always communicate[s] some idea or concept to those who view it, and as such are entitled to full First Amendment protection)), with *Comedy III*, 80 Cal. Rptr. 2d at 470 (asserting that not all art contains expression protected by First Amendment).

24. See generally Zimmerman, *supra* note 14 (discussing unsettled relationship between publicity rights and First Amendment).

25. See *infra* Parts III-IV (examining tension between publicity rights and First Amendment and attempting to reconcile these competing interests).

just over half of the states.²⁶ Part II examines the justifications for vigorous First Amendment protection of expression and the ramifications of minimal protection.²⁷ Part III explores the growing tension between freedom of expression and the right of publicity.²⁸ Part IV examines the various approaches employed by courts and commentators to reconcile these competing interests and proposes an alternative approach that protects the right of publicity interest without "chilling" free expression.²⁹ Part V applies this alternative approach to the facts of *ETW*.³⁰ Finally, Part VI concludes by examining the ramifications of this proposal.³¹

It should be noted at the outset that this Note is not intended to be either a justification or a criticism of publicity rights generally. Although the author believes that the concept of publicity rights is constructive and deserving of general adoption, this Note does not attempt to support or rebut the voluminous commentary regarding the right of publicity's legitimacy.³² As Steven Getzoff, Chairman of the American Bar Association's Taskforce on Federalizing the Right of Publicity, noted in regard to the establishment of publicity rights, "the genie is out of the bottle," and the right of publicity is here is to stay.³³

A. Evolution of Publicity Rights

The right of publicity is a relatively new doctrine that developed as an offshoot of the right of privacy.³⁴ In their seminal article, *The Right to Privacy*, Samuel D. Warren and Louis D. Brandeis contended that people had a

26. See *infra* Part I.A-B (examining evolution of and justifications for right of publicity).

27. See *infra* Part II (examining justifications for and restriction of First Amendment protection of expression).

28. See *infra* Part III (exploring growing tension between First Amendment and right of publicity).

29. See *infra* Part IV (examining alternative approaches to reconciling conflict between First Amendment and right of publicity and proposing restitutional remedy that would compensate plaintiff for portion of profits arising from appropriation of celebrity's likeness).

30. See *infra* Part V (applying proposed alternative to *ETW*).

31. See *infra* Part VI (examining ramifications of proposal's adoption).

32. See generally Alice Haemmerli, *Whose Who? The Case For a Kantian Right of Publicity*, 49 DUKE L.J. 383 (1999) (proposing Kantian right of publicity); Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994) (advocating property and liability rule analysis); Zimmerman, *supra* note 14 (criticizing justifications for publicity rights).

33. Symposium, *Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress*, 16 CARDOZO ARTS & ENT. L.J. 209, 219 (1998).

34. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b (1995) (noting origins of right of publicity doctrine).

right to be left alone.³⁵ Subsequently, Dean Prosser argued for legal recognition of a right of privacy which could support four distinct causes of action: (1) unreasonable intrusions upon the seclusion of another, (2) public disclosure of private facts, (3) false light portrayals, and (4) the misappropriation of an individual's name or likeness.³⁶ The right of publicity sprang from this fourth prong of privacy rights, the misappropriation of an individual's identity.³⁷

Curiously, the interests protected by the modern right of publicity bear little resemblance to the justifications for its tortious ancestor.³⁸ Originally, the misappropriation of identity tort was designed to compensate an individual for the emotional distress that resulted from the victim's witnessing an unauthorized use of her identity.³⁹ Over the last century, however, this tort evolved into a legally cognizable property interest that protects an individual from an unauthorized commercial exploitation of her identity.⁴⁰

Sixty-three years after Warren and Brandeis argued for recognition of the right of privacy, a court recognized the right of publicity as a separate cause of action.⁴¹ In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,⁴² the Second Circuit coined the term "right of publicity," while determining which of two chewing gum companies owned exclusive rights to the image of a baseball player on its trading cards.⁴³ The court concluded that "a man has a

35. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195 (1890) (quoting Judge Cooley).

36. See W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 117, at 851-68 (5th ed. 1984) (detailing four prongs of right of privacy).

37. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b, 529 (1995) (noting historical connection between publicity rights and right of privacy).

38. See Laura Lee Stapleton & Matt McMurphy, *The Professional Athlete's Right of Publicity*, 10 MARQ. SPORTS L.J. 23, 30-32 (tracing evolution of right of publicity).

39. See WILLIAM PROSSER, HANDBOOK OF THE LAW OF TORTS 804-07 (4th ed. 1971) (stating requirement of emotional injury to recover damages in misappropriation of identity variation of invasion of privacy tort).

40. See 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, 130 (1995) (stating that publicity rights allow individuals control over commercial uses of their identity).

41. See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (naming interest "the right of publicity").

42. 202 F.2d 866 (2d Cir. 1953).

43. *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (recognizing "the right of publicity" as separate tort from right of privacy). In *Haelan*, the plaintiff sued a rival bubble gum company for infringing on its exclusive right to use a ballplayer's image on its trading cards. *Id.* at 867. While acknowledging its use of the player's image, the defendant claimed that plaintiff's contract was merely a waiver of the ballplayer's privacy rights,

right in the publicity value of his photograph."⁴⁴ The court deemed a celebrity's interest in protecting his or her identity to be a pecuniary interest rather than a dignitary interest, which privacy law was designed to protect.⁴⁵

Since *Haelan*, courts and commentators continue to cultivate the right of publicity, the latter most notably in Thomas McCarthy's *The Rights of Publicity and Privacy*,⁴⁶ Melville Nimmer's seminal article *The Right of Publicity*,⁴⁷ and the *Restatement (Third) of Unfair Competition*.⁴⁸ The enthusiastic support for publicity rights displayed in *Factors Etc., Inc. v. Pro Arts, Inc.*⁴⁹ is a good example of the doctrines's positive reception.⁵⁰ In *Factors*, the assignee of Elvis Presley's publicity rights sought both damages and a permanent injunction prohibiting the defendant from marketing Elvis memorabilia.⁵¹ The case involved a poster consisting of a photograph of Elvis Presley captioned "In Memory."⁵² The defendants claimed that the right of publicity was contrary to and preempted by the federal copyright laws.⁵³ The court disagreed, reasoning that the right of publicity covered an area that federal law did not reach and was not equivalent to the general scope of copyright law.⁵⁴

and not a grant for the exclusive use of the image. *Id.* The court disagreed, ruling that an individual has a "right of publicity" in his identity. *Id.* at 868. The court further reasoned that it is the exclusivity of this right that makes the celebrity's image valuable. *Id.* Without this right, the use of the celebrity's image would yield nothing. *Id.*

44. *Id.*

45. *See id.* (recognizing that many celebrities are not very concerned with "having their feelings bruised through public exposure of their likeness").

46. *See generally* J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* (2d ed. 2000) (delineating contours of publicity rights doctrine).

47. *See generally* Melville Nimmer, *The Right of Publicity*, 19 *LAW & CONTEMP. PROBS.* 203 (1954) (justifying and defining parameters of right).

48. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46-49 (1995) (delineating scope and use of publicity rights doctrine).

49. 496 F. Supp. 1090 (S.D.N.Y. 1980)

50. *See Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1104 (S.D.N.Y. 1980) (awarding injunctive relief and damages in face of First Amendment defense). In *Factors*, the plaintiff assignee of Elvis Presley's publicity rights alleged that the defendant exploited the name and likeness of Elvis Presley, in violation of his publicity rights, by marketing a poster featuring a photograph of Elvis with the caption "In Memory" overlaid. *Id.* at 1092. The plaintiff moved for summary judgment seeking a permanent injunction prohibiting the defendants from marketing Presley memorabilia and an order directing further proceedings to determine damages. *Id.* at 1093. Despite copyright preemption and First Amendment defenses, the court granted the permanent injunction and awarded damages equal to the amount of profits received by the defendant for its sale of Elvis merchandise. *Id.* at 1104.

51. *See id.* at 1092 (summarizing background of case).

52. *Id.*

53. *Id.* at 1095.

54. *Id.* at 1100.

The defendants also asserted a First Amendment defense, claiming that the posters commemorated a newsworthy event and, therefore, were protected speech.⁵⁵ The court dismissed the defense, stating that the Second Circuit previously considered and rejected this argument.⁵⁶ In conclusion, the court reaffirmed its initial ruling that Elvis Presley's right of publicity was neither contrary to nor preempted by federal copyright law and that the First Amendment did not prevent the assertion of this right.⁵⁷ Consequently, the court ordered a permanent injunction prohibiting the defendant from marketing Elvis memorabilia and awarded damages equal to the amount of profits received from the sale of the poster.⁵⁸ The plaintiff's complete victory connotes the right of publicity's early enthusiastic acceptance.⁵⁹

Today, twenty-seven states recognize a statutory or common law form of the right of publicity.⁶⁰ This patchwork of statutes and common law protects an ever-widening range of identity, including name,⁶¹ likeness,⁶² voice,⁶³ and numerous other attributes associated with an individual.⁶⁴ Despite the popularity of this cause of action, a model right of publicity statute has not yet been formulated.⁶⁵

55. See *id.* at 1103 (noting that although decision on preliminary injunction does not conclusively determine all issues, both district court and court of appeals previously decided First Amendment issue in favor of plaintiff).

56. *Id.*

57. *Id.* at 1104.

58. *Id.*

59. See Zimmerman, *supra* note 14, at 44-45 (noting that right of publicity quickly gained credibility).

60. See J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 6.1[B] (1st ed. 1987 & Supp. 1999) (surveying state right of publicity law).

61. See *McFarland v. Miller*, 14 F.3d 912, 923 (3d Cir. 1994) (concluding that plaintiff actor only held superior publicity rights to his television character's name if he could establish that people identified him with that name).

62. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 80 Cal. Rptr. 2d 464, 467 (Cal. 1998), *aff'd*, 21 P.3d 797 (Cal. 2001) (imposing liability for defendant's sale of "Three Stooges" likenesses on t-shirts and prints).

63. See *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (holding that deliberate imitation of distinctive singer's voice for commercial purposes violated singer's publicity rights).

64. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (ruling that district court erred in rejecting Vanna Whites's right of publicity action involving use of robot mimicing White's likeness and duties on *Wheel of Fortune* game-show in commercial); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 836 (6th Cir. 1983) (holding that defendant invaded plaintiff's right of publicity because defendant intentionally appropriated plaintiff's identity for commercial purposes).

65. See Symposium, *supra* note 33, at 210 (discussing need for uniform right of publicity statute to replace patchwork of law now in place throughout United States).

*Zacchini v. Scripps-Howard Broadcasting Co.*⁶⁶ is the only right of publicity case to reach the Supreme Court.⁶⁷ The central issue in *Zacchini* was whether the First Amendment protected a news program's broadcast of the plaintiff's entire "human cannonball" act.⁶⁸ The defendant asserted that the act was newsworthy and, therefore, was entitled to full First Amendment protection.⁶⁹ The plaintiff maintained that although the act might be newsworthy, the broadcast of the act in its entirety effectively deprived him of its commercial value.⁷⁰ The public would be less willing to pay for that which they could see for free on television.⁷¹ The Supreme Court agreed.⁷² Although the Court upheld *Zacchini's* publicity rights in the face of a First Amendment challenge, it failed to demarcate a clear line between the First Amendment and the right of publicity.⁷³ However, the Court added legitimacy to the infant doctrine by defining it expansively and by finding liability even in the face of a First Amendment challenge.⁷⁴ Thus, the *Zacchini* Court provided at least some ammunition for the right of publicity's supporters against First Amendment challenges.

B. Justifications for the Right of Publicity

In *Zacchini*, the Supreme Court stated the following:

The rationale for protecting the right of publicity is the straight-forward one of preventing unjust enrichment by the theft of good will. No social purpose

66. 433 U.S. 562 (1977).

67. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977) (denying full First Amendment protection to those who infringe on individual's right of publicity). In *Zacchini*, the underlying dispute involved the broadcast of *Zacchini's* "human cannonball" act on the television news. *Id.* at 563-64. Despite *Zacchini's* explicit instructions not to broadcast the entire act, a local television station aired the entire fifteen-second performance on its news broadcast the next day. *Id.* Respondant maintained that the cannonball act was newsworthy and, therefore, entitled to full First Amendment protection. *Id.* at 569. The Court disagreed and ruled that the petitioner's right of publicity was violated and that the First Amendment did not exempt the respondent from liability. *Id.* at 578-79.

68. See *id.* at 564-65 (stating central issue of case).

69. *Id.* at 569.

70. *Id.*

71. *Id.* at 576.

72. *Id.* at 578-79.

73. See Zimmerman, *supra* note 14, at 49-50 (distinguishing *Zacchini* court's holding because it concerned appropriation of act, rather than identity or image, and thus was more akin to works of authorship, which are protected by copyright).

74. See *id.* at 45 (noting that "*Zacchini* lent the right of publicity a legitimacy that undoubtedly encouraged it to extend its reach").

is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.⁷⁵

Zacchini's reasoning begs the question: what is unjust enrichment? The *Restatement of Restitution* states, "A person is enriched if he has received a benefit . . . [a] person is unjustly enriched if the retention of the benefit would be unjust."⁷⁶ In *Zacchini*, the Court found that although the First Amendment generally protects the press's right to broadcast images of the subject of a newsworthy event, the broadcast of the plaintiff's entire act was a misappropriation of his publicity rights and, therefore, unjust.⁷⁷ Although *Zacchini* held that the plaintiff's right of publicity claim outweighed the defendant's First Amendment interest, the First Amendment poses the most serious threat to the continued vitality of the publicity rights doctrine.⁷⁸

II. First Amendment Protection of Expression

Courts are quite resistant to attempts to limit First Amendment activity.⁷⁹ As Ninth Circuit Chief Judge Reinhardt opined, "[t]he first amendment [sic] is at the heart of our democratic system of government. It is the most fundamental of our rights and liberties."⁸⁰ Although persuasive justifications for vigorous application of the First Amendment exist,⁸¹ expression is not immune from limited restrictions.⁸²

A. Justifications

Despite *Zacchini's* favorable treatment of publicity rights in the face of a First Amendment challenge, numerous courts and commentators have

75. *Zacchini*, 433 U.S. at 576 (quoting Kalver, *Privacy in Tort Law – Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROB., 326, 331 (1966)).

76. RESTATEMENT OF RESTITUTION § 1 cmt. a (1937).

77. See *Zacchini* 433 U.S. at 576 (1977) (noting that broadcast of petitioner's entire act threatened his ability to earn living).

78. See Michael J. Higgins, *A Pitch for the Right of Publicity*, INTELL. PROP. MAG., Dec. 1998 (LEXIS, Legal News Publications File) (discussing development of First Amendment argument to attack publicity rights).

79. See Diane Leenheer Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on Marketplaces and the Bill of Rights*, 33 WM. & MARY L. REV. 665, 681 (asserting that Supreme Court jurisprudence does not permit government or private parties to interfere with dissemination of ideas except under extraordinary circumstances).

80. *Crane v. Az. Republic*, 972 F.2d 1511, 1526 (9th Cir. 1992) (Reinhardt, C.J., concurring).

81. See *infra* Part II.A (noting traditional justifications for First Amendment's protection of speech and expression).

82. See *infra* Part II.B (recognizing legal restrictions on First Amendment activity).

warned that an expansive publicity right regime would be detrimental to society's interest in full freedom of expression.⁸³ One argument contends that political freedom is dependent upon a full and rich public domain of information to fuel it.⁸⁴ Indeed, "public common" proponents include many early speech theorists who placed great value on the right to borrow from others in the advancement of knowledge.⁸⁵ As Robert Burton explained to his readers in *The Anatomy of Melancholy*, "[t]hough there were many Giants of old in Physick and Philosophy, . . . [a] dwarf standing on the shoulders of a Giant may see farther than a Giant himself."⁸⁶

Another persuasive justification for First Amendment guarantees is that free speech facilitates our innate need for self-expression.⁸⁷ This position argues that "freedom of expression is essential as a means of assuring individual self-fulfillment."⁸⁸ To this end, the mind must be free from the repression of ideas, beliefs, and expression or risk non-realization of human potential and

83. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996) (concluding that application of Oklahoma's right of publicity statute creates overprotection of raw materials vital to creative expression); *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829, 834 (N.D. Ohio 2000), *appeal docketed*, No. 00-3584 (6th Cir. 2001) (noting that publicity rights are limited by public's right to know and by press's freedom to disseminate information); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 143 (1993) (arguing that celebrity images are raw materials out of which individuals and groups establish their "presence, identity, and meaning" (quoting PAUL WILLIS ET AL., *COMMON CULTURE: SYMBOLIC WORK AT PLAY IN THE EVERYDAY CULTURES OF THE YOUNG* (1998))); Zimmerman, *supra* note 14, at 53, 76 (arguing that commodification of personality that degrades public domain violates freedom of speech).

84. See Brief of Amici Curiae Law Professors in Support of Defendant/Appellee Jireh Publishing, Inc., For Affirmance at 23, *ETW Corp. v. Jireh Publ'g, Inc.*, (6th Cir. 2001) (No. 00-3584) (citing Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999)) (arguing that restrictions on public domain endanger First Amendment freedoms). See generally Zimmerman, *supra* note 79 (same).

85. See Zimmerman, *supra* note 79, at 679 (summarizing "public common" argument).

86. *Id.* at 679-80 (citing ROBERT BURTON, *THE ANATOMY OF MELANCHOLY* (Floyd Dell & Paul Jordan-Smith eds., Tudor Publ'g Co. 1955) (1628)).

87. See *First Nat'l Bank of Boston v. Bellotti*, 435 U.S. 765, 804, 807 (1978) (White, J., dissenting) (explaining that individual self-expression is one principle justification for constitutional protection of speech afforded by First Amendment); Kwall, *supra* note 32, at 66 (noting prominent justifications for First Amendment's free speech guarantees) (citing Ronald K.L. Collins & David M. Skover, *Commerce & Communication*, 71 TEX. L. REV. 697, 733 (1992) (recognizing that individual self-expression is one primary justification for freedom of speech); Helene Bryks, Note, *A Lesson in School Censorship: Hazlewood v. Kuhlmeier*, 55 BROOK. L. REV. 291, 310 (1989) (noting that self-expression is major justification for freedom of speech)).

88. THOMAS I. EMERSON, *THE SYSTEM OF FREEDOM OF EXPRESSION* 6 (Vintage Books 1971).

character.⁸⁹ To limit the search for, or the expression of, truth is to elevate the state over the individual.⁹⁰

B. Restrictions on Expression

The reverence bestowed upon free expression does not mean that speech is immune from restriction.⁹¹ Although expression receives broad First Amendment protection, the United States Supreme Court has upheld the constitutionality of numerous federal acts, state statutes, and local ordinances that limit expression.⁹² Examples include the following: political advertising,⁹³ draft card mutilation,⁹⁴ unlicensed parades,⁹⁵ solicitation,⁹⁶ the use of fighting words,⁹⁷ and various broadcasting restrictions.⁹⁸ Thus, the First Amendment, though mighty, is not absolute.⁹⁹ As with other constitutional protections, the First Amendment's reach is relative to those interests with which it competes.¹⁰⁰

For example, in *Hudgens v. NLRB*,¹⁰¹ the Supreme Court concluded that picketers protesting working conditions imposed by their employer did not have a First Amendment right to picket a private shopping mall.¹⁰² In this

89. *Id.*

90. *Id.*

91. *See infra* notes 93-98 and accompanying text (noting valid restrictions on speech).

92. *See infra* Part II.B (surveying legislative restrictions on expression).

93. *See Lehman v. Shaker Heights*, 418 U.S. 298, 304 (1974) (upholding right of city to accept commercial advertising on city-owned buses, while rejecting political advertising).

94. *See United States v. O'Brien*, 391 U.S. 367, 386 (1968) (affirming conviction of war protester who burned his draft card in violation of federal statute prohibiting draft card mutilation).

95. *See Cox v. New Hampshire*, 312 U.S. 569, 576 (1941) (upholding ordinance requiring permit for all parades and public meetings so long as accompanied by procedural safeguards).

96. *See Heffron v. Int'l Soc. for Krishna Consciousness*, 452 U.S. 640, 655 (1981) (upholding state regulation limiting solicitation at Minnesota State Fair to assigned booth).

97. *See Feiner v. New York*, 340 U.S. 315, 321 (1951) (upholding disorderly conduct conviction of protester whose conduct constituted incitement to riot).

98. *See FCC v. Pacifica*, 438 U.S. 726, 750 (1978) (upholding FCC's restrictions on "seven dirty words" from radio broadcasts during hours that children would likely hear them).

99. *See Fla. Bar v. Went For It, Inc.*, 515 U.S. 618, 623 (1995) (distinguishing commercial speech from "speech at the First Amendment's core"); *Greer v. Spock*, 424 U.S. 828, 842 (1976) (recognizing that "First Amendment rights are not absolute under all circumstances").

100. *Cf. Went For It*, 515 U.S. at 623-24 (discussing Court's *Central Hudson* test that evaluates magnitude of governmental interest in regulation of speech with breadth of restriction on that speech).

101. 424 U.S. 507 (1976).

102. *See Hudgens v. NLRB*, 424 U.S. 507, 521 (1976) (ruling that striking employees had no First Amendment right to enter privately owned shopping center and advertise strike against employer). In *Hudgens*, striking warehouse employees picketed their employer's retail store

case, the free speech rights of the picketers conflicted with private property rights of the shopping mall owner.¹⁰³ The Court rejected the picketer's claim, reasoning that the First Amendment does not give to those who wish to express themselves the freedom to trespass on the private property rights of others.¹⁰⁴ *Hudgens* is analogous to many publicity rights cases in that it concerned a conflict between one party's First Amendment rights and the property rights of another.¹⁰⁵ Publicity rights proponents argue that speakers, like those in *Hudgens*, do not have a First Amendment right to use another's publicity right as a vehicle for their speech.¹⁰⁶

C. Chilling Effects of Prior Restraint

Courts are particularly critical of restrictions that act as a prior restraint on speech.¹⁰⁷ In *Bery v. City of New York*,¹⁰⁸ the Second Circuit examined a city ordinance that limited the ability of street artists to sell their art on city

in a privately-owned shopping center. *Id.* at 508. After an agent of the center threatened to have them arrested for trespass, the strikers left. *Id.* at 509. Subsequently, the union to which they belonged filed an unfair labor practice charge with the National Labor Relations Board (NLRB), alleging interference with rights protected under § 7 of the National Labor Relations Act. *Id.* The NLRB entered a cease and desist order against the shopping center owner, reasoning that the employees enjoyed a First Amendment right to picket the store. *Id.* at 510. On appeal, the United States Court of Appeals for the Fifth Circuit remanded the case to the NLRB to reconsider the case in light of the intervening decision in *Lloyd Corp. v. Tanner*, 407 U.S. 551 (1972), which held that persons protesting the military operations in Vietnam had no First Amendment right to distribute private handbills concerning the Vietnam war in a shopping center. *Id.* Again, the NLRB concluded that the shopping center had committed an unfair labor practice. *Id.* at 510-11. The Court of Appeals affirmed the order, concluding that the Board had sustained its burden of showing that no adequate alternative location existed which was less intrusive on the shopping center owner. *Id.* at 511-12. The Supreme Court vacated the Court of Appeals judgment, ruling that the striking employees had no First Amendment right to enter the shopping center and advertise their strike against their employer. *Id.* at 520-21, 23. The Court remanded the case to the NLRB to resolve the conflict between the private property rights of the shopping center owner and the striking employees. *Id.* at 523.

103. *See generally id.* (adjudicating conflict between First Amendment rights of picketers and property rights of mall owner).

104. *See id.* at 1036 (noting that Court's constitutional jurisprudence does not require dedication of private property to public use) (citing *Lloyd Corp. v. Tanner*, 407 U.S. 551, 568-69 (1972)).

105. *See MCCARTHY*, *supra* note 46, § 8:31-32 (analogizing shopping center cases to conflict between First Amendment and right of publicity).

106. *See id.* (comparing property right versus speech issues in shopping mall cases to right of publicity cases).

107. *See Bantam Books, Inc. v. Sullivan*, 372 U.S. 58, 70 (1963) (noting that systems of prior restraints on expression are presumptively unconstitutional); *see also Near v. Minnesota*, 283 U.S. 697, 713 (1931) (same).

108. 97 F.3d 689 (2d Cir. 1996).

property.¹⁰⁹ The court held that the City of New York's licensing requirement for street vendors violated their First Amendment rights to free expression.¹¹⁰ Speaking for the court, Judge Robert Carter noted that a speaker does not lose constitutional protection merely because he profits from it.¹¹¹ More importantly, *Bery* struck down a restriction that resulted in a "de facto bar" of expression.¹¹² The court recognized that less intrusive restrictions would pass Constitutional muster while serving the city's interest of keeping the sidewalks free of congestion.¹¹³ The court's primary concern was the chilling effect that the city's "de facto bar" had on expressive output.¹¹⁴ The court concluded that no suitable alternative market existed for these artists, and thus, under the licensing regime, they would likely not engage in the protected activity.¹¹⁵ In its opinion, the court cited *United States v. National Treasury Employees Union*,¹¹⁶ in which the Supreme Court ruled that the government's ban on public employees receiving honoraria was a restriction that chilled speech before it occurred, which would inevitably curtail expressive output.¹¹⁷ Thus,

109. *Bery v. City of New York*, 97 F.3d 689, 698 (2d Cir. 1996) (concluding that city's requirement that artists be licensed to sell art-work on sidewalks violates First Amendment). In *Bery*, a group of artists appealed a district court order denying their request to enjoin enforcement of a licensing ordinance which required them to obtain a license to sell their art on city sidewalks. *Id.* at 691-93. The district court ruled that the ordinance was a content-neutral restriction which did not violate the First Amendment, although it had the incidental effect of limiting the sale of art on the sidewalks of New York. *Id.* at 692-93. On appeal, the city argued that the licensing ordinance did not prohibit the artists from expressing themselves because they were still able to create and display their artwork. *Id.* at 695. Rather, the ordinance only restricted the sale of it. *Id.* The Court of Appeals disagreed, noting that "[i]t is well settled that a speaker's rights are not lost merely because compensation is received." *Id.* at 695-96. Finding that the ordinance was not tailored sufficiently narrowly to meet a content neutral requirement, the Court of Appeals reversed, and held that the ordinance violated the First Amendment rights of the artists. *Id.* at 697-98.

110. *Id.* at 698.

111. *Id.* at 696.

112. *See id.* at 697 (noting that lack of available licenses effectively bars artists from selling their art on sidewalks).

113. *See id.* at 698 n.8 (illustrating less restrictive alternative, such as that employed by City of San Francisco, which limits sales to certain areas with lottery to assign spots).

114. *See id.* at 696 (noting that without incentive of payment, plaintiffs would not have engaged in protected expressive activity).

115. *See id.* at 698 (concluding that New York's vending restriction failed to provide alternative channel for artistic expression).

116. 513 U.S. 454 (1995).

117. *See United States v. Nat'l Treasury Employees Union*, 513 U.S. 454, 468 (1995) (reasoning that banning government employees from accepting honoraria would chill speech by acting as disincentive to engage in protected expression). In *NTEU*, the Court was faced with the issue of whether a ban on federal employees receiving compensation for making speeches or writing articles violated their First Amendment rights to free speech. *Id.* at 457 The United

the regulation was an impermissible prior restraint on speech.¹¹⁸

The potential to chill free expression, enunciated in *Bery*, is perhaps the greatest danger that publicity rights pose in the merchandising context. Because merchandise often contains elements of both expression and appropriation, an overly broad right of publicity regime diminishes both the speaker's incentive to engage in expression and the public's opportunity to appreciate such expression or to be informed by it.¹¹⁹ The added uncertainty as to the breadth of the First Amendment's protection only adds to the chilling effect posed by such restrictions.¹²⁰

III. Growing Tension Between First Amendment and Publicity Rights

As noted above, general academic acceptance of the right of publicity has been thwarted by concerns that the right of publicity too often infringes on the First Amendment and limits information available in the public domain.¹²¹ Indeed, a jurisprudential trend has developed toward limiting the applicability of the right of publicity in the face of First Amendment challenges.¹²² The inconsistent application of First Amendment protections to the right of publicity, coupled with the lack of conformity in the various statutory and common law incarnations of the right, has confounded those who would assert and defend this right.¹²³

A. Settled Uses

Although distinguishing between protected and unprotected uses remains a difficult proposition, the history of publicity rights jurisprudence suggests that some uses of another's publicity rights are more constitutionally protected

States Supreme Court affirmed the injunction against enforcement of the statute as to the respondents based largely on the chilling effect the act would have on speech by low-level federal employees. *Id.* at 468-70. The Court reasoned that the honoraria ban would inhibit the employee's output of information and diminish the corresponding value to society in receiving it. *Id.*

118. *Id.*

119. *Cf. Bery v. City of New York*, 97 F.3d 689, 696 (2d Cir. 1996) (reasoning that licensing restriction would diminish incentives to create, thus having detrimental effect on society).

120. *See MCCARTHY*, *supra* note 46, § 8:9 (noting that uncertainty regarding First Amendment creates "chilling effect" on speech).

121. *See Zimmerman*, *supra* note 14, at 76 (expressing concern that publicity rights limit public domain).

122. *See supra* Parts III.A-B (surveying publicity rights cases involving First Amendment issues). *But see White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401-02 (9th Cir. 1993) (ruling that parody as form of commercial speech is not protected by First Amendment).

123. *See Stapleton & McMurphy*, *supra* note 38, at 30 (noting difficulty of applying right of publicity doctrine given confusion over its legal basis).

than others.¹²⁴ For example, a newspaper's use of a picture and name of a celebrity is generally protected by the First Amendment.¹²⁵ In *Montana v. San Jose Mercury News, Inc.*,¹²⁶ the former quarterback for the San Francisco 49'ers brought suit against a California newspaper for distributing posters that reproduced a photograph of him that had previously appeared on the front page of the paper.¹²⁷ The newspaper produced and sold the posters to the public for five dollars each and gave them away at charity events.¹²⁸ Both the common law and the statutory right of publicity exempt uses that report on matters of public interest.¹²⁹ Citing *Paulsen v. Personality Posters, Inc.*,¹³⁰ the court ruled that the First Amendment protected the defendant's use because the posters portrayed Montana in a role of public interest, thus making it newsworthy.¹³¹

Of all the varieties of expression protected by the First Amendment, political speech is afforded the greatest constitutional protection.¹³² The New

124. See Zimmerman, *supra* note 14, at 54 (noting general rule that newsworthy speech receives First Amendment protection, whereas purely commercial speech usually does not).

125. See *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 640 (Cal. Ct. App. 1995) (noting that First Amendment protects even republishing of newsworthy photographs in newspapers).

126. 40 Cal. Rptr. 2d 639 (Cal. Ct. App. 1995).

127. See *Montana*, 40 Cal. Rptr. 2d at 640 (Cal. Ct. App. 1995) (stating background of litigation). In *Montana*, the plaintiff, Joe Montana, appealed the decision of a lower court that granted summary judgment for the defendant, San Jose Mercury News (SJMN). *Id.* at 640. Montana alleged that SJMN violated his publicity rights by reproducing previously published photographs and then selling them as posters to the public. *Id.* The lower court had asserted that SJMN's use was privileged by the First Amendment's protection of speech. *Id.* The California Court of Appeals affirmed the lower court's ruling, noting that both the common law and statutory forms of publicity rights causes of action exempt uses that report on matters of public interest. *Id.* at 643.

128. *Id.*

129. *Id.*

130. 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968)

131. See *Montana*, 40 Cal. Rptr. 2d at 639, 641 (Cal. Ct. App. 1995) (ruling that First Amendment protected newspaper's use of Montana's photograph on poster because it was newsworthy); see also *Paulsen v. Personality Posters, Inc.*, 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968) (ruling that comedian's mock presidential election campaign was matter of public interest). In *Paulsen*, a comedian engaged in a mock campaign for President of the United States moved to enjoin Personality Posters, Inc. (Personality) from the continued printing and marketing of posters containing an enlarged picture of him with the words "For President" overlaid on it. *Id.* at 503. Though the plaintiff couched his action on the right of privacy, the court correctly identified his complaint as arising from a publicity right. *Id.* at 508. The court denied Paulsen's claim, reasoning that the poster was speech advocating a political campaign, albeit a mock campaign. *Id.* at 507-08. The use of Paulsen's image and identity were newsworthy and, therefore, entitled to full First Amendment protection. *Id.*

132. See *Mayer v. Grant*, 486 U.S. 414, 425 (1988) (stating that First Amendment protection is greatest involving political speech); see also *supra* note 131 (discussing background of *Paulsen*).

York County Supreme Court adjudicated an early right of publicity case involving overtones of political speech.¹³³ *Paulsen v. Personality Posters, Inc.*¹³⁴ concerned the printing and marketing of posters urging support for then-famous comedian, Pat Paulsen, for President of the United States in 1968.¹³⁵ Although Paulsen alleged a violation of privacy rights, the court correctly identified his case as an action for violation of Paulsen's publicity rights.¹³⁶ The court weighed Paulsen's pecuniary interest against society's interest in free expression and favored the latter's interest over Paulsen's publicity rights, noting that it is not the court's role to "pass value judgments predicated upon ephemeral subjective considerations which would serve to stifle free expression."¹³⁷

The courts have also settled the First Amendment issue regarding the use of an individual's publicity right in the advertising context. The First Amendment generally affords less protection to appropriations of identity or likeness when they are used to further marketing efforts.¹³⁸ In *Carson v. Here's Johnny Portable Toilets, Inc.*,¹³⁹ Johnny Carson, the former host of *The Tonight Show*, sued Here's Johnny Portable Toilets, Inc. for violating his publicity rights.¹⁴⁰ Carson challenged the defendant's use of the words "Here's Johnny" in the brand name of their portable toilet.¹⁴¹ That phrase was Carson's standard introduction by his *Tonight Show* sidekick Ed McMahon and became forever linked in the public mind to Johnny Carson and his television personality.¹⁴² By misappropriating these words, Here's Johnny Toilets, Inc. exploited part of Carson's identity for the sole purpose of market-

133. See generally *Paulsen v. Personality Posters, Inc.*, 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968) (adjudicating publicity rights case involving political speech).

134. 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968).

135. See *Paulsen*, 299 N.Y.S.2d at 503-04 (stating background of case).

136. *Id.* at 508.

137. *Id.*

138. See MCCARTHY, *supra* note 46, § 8:18 (noting that commercial speech receives lower level of protection than political or social speech).

139. 698 F.2d 831 (6th Cir. 1983).

140. See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 833 (6th Cir. 1983) (summarizing Carson's claim against defendant). In *Here's Johnny*, the plaintiff asserted two claims against the defendant for its use of the phrase "Here's Johnny" to market its portable toilets. *Id.* at 832. First, Carson claimed that its use constituted unfair competition in violation of § 43(a) of the Lanham Act. *Id.* at 833. Second, Carson claimed that defendant's use of the phrase violated his common law right of publicity. *Id.* at 834. The court held that the company did not violate the Lanham Act in that it did not create the likelihood of customer confusion, mistake, or deception. *Id.* at 833-34. The court did, however, find that Here's Johnny Portable Toilets, Inc. violated Mr. Carson's publicity rights. *Id.* at 836.

141. *Id.* at 833.

142. *Id.* at 832.

ing a product.¹⁴³ The court held that the defendant's use of the phrase infringed on Mr. Carson's publicity rights, concluding that Carson's right of publicity outweighed the protection due commercial speech.¹⁴⁴ Thus, pure commercial speech, as that in *Here's Johnny*, receives less protection from publicity rights claims than political or newsworthy speech.¹⁴⁵

B. Unsettled Uses

In the right of publicity context, political and newsworthy speech generally receives greater protection than pure commercial speech.¹⁴⁶ Such cases rest on relatively settled principles and represent a mere fraction of the publicity rights suits litigated today.¹⁴⁷ What lies between political-newsworthy speech and pure commercial speech remains unsettled, however.¹⁴⁸ Use of the phrase "Here's Johnny" to market portable toilets clearly violates Mr. Carson's publicity rights.¹⁴⁹ Use of the same phrase in the text or the headline of a newspaper article would certainly not be.¹⁵⁰ But what about a character in a horror film who announces his presence by snarling, "Here's Johnny?"¹⁵¹

This uncertainty is largely a result of an inability to classify easily the type of speech involved.¹⁵² For example, the use on a greeting card of Judy

143. See *id.* at 836 (noting that defendant admittedly used Mr. Carson's identity for commercial exploitation purposes).

144. See *id.* at 837 (vacating judgment of district court).

145. See *supra* Part III.A (surveying degree of First Amendment protection afforded various types of uses).

146. See MCCARTHY, *supra* note 46, § 8:18 (concluding that commercial speech enjoys lesser position within First Amendment hierarchy); Zimmerman, *supra* note 14, at 54-55 (noting that scholars, courts, and legislators accept that newsworthy speech is privileged by First Amendment, while liability is reserved for commercial uses).

147. Cf. Zimmerman, *supra* note 14, at 55-57 (discussing evolution of "newsworthy" defense in right of publicity cases).

148. See Darren F. Farrington, *Should the First Amendment Protect Against Right of Publicity Infringement Actions Where the Media Is Merchandiser? Say It Ain't So, Joe*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 779, 781 (1997) (noting that although many states have codified publicity rights, "many remain unsettled"); Haemmerli, *supra* note 32, at 440 (questioning whether merchandise such as mugs and t-shirts constitute expression); Kwall, *supra* note 32, at 47 (1994) (addressing conflict between right of publicity and First Amendment).

149. See *supra* notes 138-45 and accompanying text (discussing commercial appropriation of publicity rights).

150. Cf. *supra* notes 125-31 and accompanying text (discussing appropriation of celebrity identity by newspaper).

151. See THE SHINING (Warner Bros. 1980) (quoting Johnny Carson's famous introduction on "The Tonight Show").

152. See Haemmerli, *supra* note 32, at 441-43 (noting difficulty in categorizing merchandise as commercial rather than as more protected form of expression).

Garland's picture in a gay bar accompanied by her famous line, "Toto, I don't think we're in Kansas anymore," was arguably a powerful means of self expression in the gay community.¹⁵³ Was this use of Ms. Garland's image a marketing ploy to sell a product, a contribution to public discourse, or both? Although the First Amendment might not protect the appropriation of an individual's identity to sell "mere merchandise," the question remains: Are publicity rights violated when use of the persona also contains an element of protected speech?¹⁵⁴

Many earlier right of publicity cases, while acknowledging free expression concerns, concluded that mere merchandise relying heavily on a connection to the celebrity was not protected by the First Amendment.¹⁵⁵ Gradually, however, First Amendment concerns weighed more heavily on the lower courts, paralleling the growing breadth of protection afforded by modern First Amendment jurisprudence.¹⁵⁶ Should this issue in the publicity rights context more closely track the breadth and strength of protection afforded by general First Amendment jurisprudence, the value of a celebrity's publicity rights likely will continue to decline.

A case involving the marketing of parody baseball cards is a good example of this trend.¹⁵⁷ Parody as a form of expression generally receives full First Amendment protection in right of publicity cases.¹⁵⁸ As the United States Court of Appeals for the Tenth Circuit recognized in *Cardtoons, L.C. v. Major League Baseball Players Ass'n*,¹⁵⁹ parody is a "form of social commentary that dates to Greek antiquity" and has been an important medium of

153. See Madow, *supra* note 83, at 194-95 (1993) (discussing how gay men used Judy Garland's image as means of self expression).

154. Cf. *Bery v. City of New York*, 97 F.3d 689, 695 (1996) (discussing distinction between "mere merchandize" and visual art).

155. See, e.g., *Hicks v. Casablanca Records*, 464 F. Supp. 426, 430 (S.D.N.Y. 1978) (distinguishing books and movies from merchandise like bubble gum cards and posters, which generally are not afforded constitutional protections); *Lugosi v. Universal Pictures*, 603 P.2d 425, 449 (Cal. 1979) (Bird, C.J., dissenting) (asserting that commercial exploitation of plaintiff's interests in merchandising products is not insulated by First Amendment); *Rosemont Enters., Inc. v. Urban Sys., Inc.*, 340 N.Y.S.2d 144, 146 (N.Y. Sup. Ct. 1973) (rejecting defendant's claim that board game is as deserving of free speech protection as is biography, articles, or movie).

156. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996) (ruling that First Amendment protected defendant's baseball cards); *ETW Corp. v. Jireh Publ'g Inc.*, 99 F. Supp. 2d 829, 835 (N.D. Ohio 2000), *appeal docketed*, No. 00-3584 (6th Cir. 2001) (ruling that First Amendment protects prints made of Tiger Woods painting).

157. See *Cardtoons*, 95 F.3d at 969, 972-76 (finding that First Amendment protects *Cardtoons'* trading cards due to court's determination that society's interest in card's informational and social commentary value is greater than pecuniary interest of baseball players).

158. Cf. *id.* at 972 (noting that parody is protected form of expression partly due to its value as social criticism and commentary). *But see Samsung*, 971 F.2d at 1401-02 (ruling that parody as form of commercial speech is not protected by First Amendment).

159. 95 F.3d 959 (10th Cir. 1996).

"political debate throughout our nation's history."¹⁶⁰ In *Cardtoons*, the Tenth Circuit considered an appeal by the Major League Baseball Players Association (MLBPA) from a judgment for *Cardtoons, L.C. (Cardtoons)*, an Oklahoma company wishing to market parody trading cards that lampooned the least admirable traits of professional baseball players.¹⁶¹ MLBPA contended that *Cardtoons* violated the publicity rights of its members and was not protected from liability by the First Amendment's freedom of expression.¹⁶² They argued that the defendant's product was merely merchandise and that sufficient alternative channels existed for the defendant's message.¹⁶³ The court disagreed, ruling that the detrimental effects of suppressing social commentary and criticism outweighed the publicity rights of the MLBPA.¹⁶⁴ While acknowledging that the invasion of the right of publicity presented some level of harm to the MLBPA, the court applied a balancing test to the two competing interests and concluded that society's interest in free expression outweighed the MLBPA's publicity rights.¹⁶⁵

IV. Reconciliation of the Conflict

Courts and commentators continue to search for a more satisfactory resolution to the conflict between the First Amendment and publicity rights.¹⁶⁶

160. *Cardtoons*, 95 F.3d at 969 (discussing value and importance of parody to social, political, and public commentary and criticism). *Cardtoons* involved an attempt by an Oklahoma company to market parody baseball trading cards without license or permission of the player depicted. *Id.* In response to a cease and desist order filed by the Major League Baseball Players Association (MLBPA), *Cardtoons* brought an action to obtain declaratory judgment that the parody trading cards did not infringe on the publicity rights of the MLBPA's members. *Id.* The district court ruled that these trading cards did enjoy First Amendment protection, establishing a parody exception to Oklahoma's right of publicity statute. *Id.* On appeal, the Tenth Circuit Court of Appeals considered MLBPA's argument that *Cardtoons* did not have a First Amendment right to market its trading cards without permission. *Id.* The court evaluated the claim using a three-part framework. *Id.* at 966. First, the court found that *Cardtoons* infringed on MLBPA's right of publicity. *Id.* at 968. Second, the court determined that the parody trading cards deserved some level of First Amendment protection. *Id.* at 970. Finally, the court weighed the legitimate publicity rights of the MLBPA against the First Amendment rights of *Cardtoons*. *Id.* at 970-76. Specifically, the court attempted to balance the "magnitude of the speech restriction" against the asserted governmental interest in protecting the intellectual property right. *Id.* at 972. The court concluded that the justifications for the right of publicity did not justify the loss of the entertainment and social commentary provided by the parody trading cards and thus affirmed the district court's decision. *Id.* at 976.

161. *Id.* at 962.

162. *See id.* (ruling in favor of defendant, *Cardtoons, L.C.*).

163. *See id.* at 969, 971 (arguing that First Amendment did not protect defendant's parody baseball cards).

164. *Id.* at 976.

165. *Id.* at 970-76.

166. *See generally* Haemmerli, *supra* note 32 (discussing merits of various proposals to

While some continue to advocate an expansive vision of the right of publicity,¹⁶⁷ a post-modernist trend toward minimizing the scope and efficacy of the right of publicity has developed.¹⁶⁸ Other commentators continue the search for a compromise between protecting publicity rights and society's First Amendment interests.¹⁶⁹ This section discusses the most commonly posited attempts at reconciling these opposing interests and notes their inherent deficiencies, emphasizing the need for an alternative approach.¹⁷⁰

A. Copyright's Fair Use Doctrine

Copyright's fair use doctrine is perhaps one of the most commonly advanced frameworks for accommodating First Amendment concerns.¹⁷¹ This is not surprising, as copyright and the right of publicity have much in common.¹⁷² Both seek to preserve the owner's incentive to create by preventing unauthorized appropriation of intellectual property rights.¹⁷³ Thus, scholars have attempted to borrow copyright's fair use doctrine to resolve the First Amendment dilemma.¹⁷⁴ The Copyright Act, which codifies the fair use

resolve First Amendment/right of publicity conflict, arguing instead for "Kantian Right of Publicity"); Kwall, *supra* note 32 (criticizing post-modernist approaches to First Amendment conflict and advocating liability and property rule framework); Zimmerman, *supra* note 14 (arguing that publicity rights doctrine has failed to track First Amendment jurisprudence and that publicity rights should be considered subordinate to all expression, including commercial speech).

167. See generally MCCARTHY, *supra* note 46 (defining extensive publicity rights doctrine).

168. See generally Zimmerman, *supra* note 14 (questioning justifications for publicity rights doctrine).

169. See generally Kwall, *supra* note 32 (proposing liability approach to First Amendment concerns).

170. See *infra* notes 171-94 and accompanying text (discussing common attempts to reconcile publicity rights with First Amendment).

171. See Kwall, *supra* note 32, at 57 (noting popularity of copyright's fair use doctrine to analyze publicity rights/First Amendment conflict).

172. See *id.* at 59 (noting that copyright and publicity rights are analogous).

173. See *id.* (stating that both doctrines provide incentives for individuals to devote themselves to creative activities).

174. See MCCARTHY, *supra* note 46, § 8:38 (citing Richard C. Ausness, *The Right of Publicity: A "Haystack in a Hurricane,"* 55 TEMP L.Q. 977, 1048 (1982) (suggesting usefulness of fair use doctrine in measuring First Amendment values); Roberta Rosenthal Kwall, *Is Independence Day Dawning for the Right of Publicity?*, 17 U.C. DAVIS L. REV. 191, 232 (1983) (advocating fair use doctrine as appropriate mechanism to balance competing interests of publicity rights and First Amendment); Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 915 (1983) (proposing modified version of fair use doctrine to accommodate First Amendment values)).

doctrine, accommodates First Amendment principles by considering the following four primary factors: "(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work."¹⁷⁵ With these factors in mind, the fair use doctrine mediates the balance between compensated and uncompensated access to works protected by the act.¹⁷⁶

An important difference between the rationale for copyright and that of publicity rights, which argues against application of the fair use doctrine, centers on its fourth factor – the effect on marketability. Although the right of publicity is concerned with dilution of the persona's commercial value, its main rationale is to prevent the unjust enrichment of the appropriator.¹⁷⁷ As argued below, the unjust enrichment doctrine provides not only the primary rationale for the existence of publicity rights (as elucidated in *Zacchini*), but also the key to a more satisfactory resolution of its conflict with the First Amendment.¹⁷⁸

B. Classification of Use Systems

Many analyses rely on classification systems that delineate the depth of First Amendment protection afforded to publicity rights appropriations.¹⁷⁹ One authority's analysis begins with a categorization of the use as either an informational, entertainment, or commercial use.¹⁸⁰ This approach advocates varying treatment based on the type of use, with commercial uses receiving the lowest level of protection.¹⁸¹ Such a framework is, at first, attractive due to its seeming simplicity.¹⁸² However, it is less helpful in application because

175. 17 U.S.C. § 107 (1994).

176. See Kwall, *supra* note 32, at 57 (discussing mechanics of fair use doctrine).

177. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) ("The rationale for [protecting the right of publicity] is the straight-forward one of preventing unjust enrichment by the theft of good will.").

178. See *infra* Part IV.E (proposing restitutionary remedy to accommodate First Amendment concerns in conjunction with right of publicity).

179. See Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1602 (1979) (classifying uses as informational, entertainment, or commercial).

180. See *id.* at 1597 (delineating three purposes of media's portrayal of individuals).

181. See *id.* at 1599 (stating that commercial uses of another's publicity right receive little First Amendment protection).

182. Cf. Kwall, *supra* note 32, at 56 (asserting that categorization of uses, while useful as starting point, must be developed more thoroughly).

it is often too difficult to categorize publicity uses.¹⁸³ Merchandise, such as Cardtoon's parody baseball cards, conceivably could be classified as a commercial, informational, or entertainment use.¹⁸⁴ As discussed above, parody contains elements of social commentary as well as entertainment.¹⁸⁵ In addition, baseball cards typically contain information about the players, including statistics and other vital information.¹⁸⁶ There is no doubt that baseball cards are primarily a commercial enterprise as well.¹⁸⁷ The inability to classify the use neatly into one of these three distinct categories renders such a system unworkable and is largely unhelpful.

C. Balancing Tests

More recently, the California Supreme Court attempted to relieve the tension between the First Amendment and the right of publicity in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*¹⁸⁸ by applying a balancing test.¹⁸⁹ In *Comedy III*, the court formulated a test based on whether the infringing use added sufficient creative elements to the image of the celebrity to transform it into something more than a mere imitation or literal likeness of the subject.¹⁹⁰ The court reasoned that mere "depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment."¹⁹¹ The court distinguished between defendant Saderup's literal depiction of the "Three Stooges" and Andy Warhol's transformative depictions of Marilyn Monroe and others.¹⁹²

While few would have difficulty distinguishing between a Saderup and a Warhol, "should constitutional protection turn on a judge's view as to

183. See *id.* (noting difficulty of assigning appropriated uses to particular categories).

184. Cf. Kwall, *supra* note 32, at 56-57 (questioning whether baseball version of Trivial Pursuit should be classified as informative, commercial, or entertainment use).

185. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996) (noting that cards are no less protected because they consist of humorous, rather than serious, commentary).

186. See *id.* (noting that trading cards have been important medium for dissemination of information for more than 100 years).

187. See *id.* at 970 (asserting that use in form of commercial merchandise is irrelevant in First Amendment analysis).

188. 21 P.3d 797 (Cal. 2001).

189. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001) (applying test that examines degree to which use transforms celebrity's identity in use). For background of underlying dispute, see *supra* note 17.

190. *Comedy III Prods.*, 21 P.3d at 799.

191. *Id.* at 805.

192. See *id.* at 811 (noting that unlike Warhol's paintings, Saderup's depiction lacked any "significant transformative or creative contribution").

whether a work of art is simple-minded and imitative, or instead conveys ironic social comment?"¹⁹³ As Justice Oliver Wendell Holmes warned, "It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."¹⁹⁴ Such an approach is unsatisfactory because it conditions constitutional protection upon the subjective considerations of one person.

D. *A New Direction*

Conventional approaches to reconciling the First Amendment with publicity rights present two fundamental problems.¹⁹⁵ First, they attempt to characterize or categorize the protected speech by its use to determine whether a First Amendment infringement exists, which results in crude and often contradictory results.¹⁹⁶ Second, they compound the problem by applying inflexible and inappropriate remedies to these rather imprecise determinations of liability, resulting in unjust and unpredictable outcomes.¹⁹⁷ Reconciliation of the First Amendment/publicity rights conflict requires a compromise that addresses each of these issues.

1. *Comparative Negligence Analogy*

Conventional approaches to this conflict are unsatisfactory because they impose all or nothing liability for appropriations of identity that contain an element of protectable speech. As discussed above, infringing uses of an individual's publicity rights often contain an arguable element of expression.¹⁹⁸ Barring a publicity rights cause of action completely in a use that contains a very limited speech element combined with a substantial appropriation of identity is akin to barring recovery of a minimally negligent driver for the gross negligence of another.

Such a result occurred in a Minnesota case involving two partially negligent drivers who collided at an unmarked intersection.¹⁹⁹ In *Haeg v. Sprague*,

193. Lewis R. Clayton, *Judges as Critics*, NAT'L L.J., July 16, 2001, at A23.

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

195. See *supra* Parts IV.A-C (noting inadequacies of conventional frameworks).

196. See *supra* Parts IV.B-C (employing subjective test to determine extent of First Amendment protection).

197. See *infra* Part IV.D.2 (reasoning that fair market value measure of damages chills expression because of uncertainty regarding whether use is infringing coupled with possibility that fair market value of damages might exceed profits).

198. See *supra* Parts III.A-B (surveying right of publicity cases that address First Amendment issues).

199. See *Haeg v. Sprague*, Warner & Co., 281 N.W. 261, 262-63 (Minn. 1938) (holding that state's contributory negligence regime barred plaintiff's recovery).

Warner & Co.,²⁰⁰ the Minnesota Supreme Court reluctantly barred any recovery by the plaintiff for an accident in which the defendant was the major cause.²⁰¹ Noting that "the rule of comparative negligence would serve justice more faithfully than that of contributory negligence," the court felt compelled to enforce the law as it was, rather than as it should have been, and thus, applied the contributory negligence doctrine.²⁰² The result, the court implied, was unfair.²⁰³ Why should a tortfeasor be barred from recovery in an auto accident in which the defendant is 90 percent at fault and the victim only 10 percent responsible? Similarly, why should a merchandiser be able to capitalize on the wholesale appropriation of a celebrity's identity by inserting a minimal element of protected expression?²⁰⁴

A better approach would follow the lead of the comparative negligence doctrine. In response to the inequitable outcomes that resulted from the application of the contributory negligence regime, nearly every state adopted some form of the comparative negligence doctrine, which apportions liability based on the negligence of each party in the accident.²⁰⁵ Applying this framework, a plaintiff found partially negligent in causing the accident collects only for the defendant's portion of fault.²⁰⁶ Likewise, a defendant who is overwhelmingly responsible for the plaintiff's injuries does not completely escape liability.²⁰⁷ Nor is a defendant completely liable for those injuries that were partially the result of the plaintiff's own negligence.²⁰⁸ As a law student and future President put it, "[C]omparative negligence statutes at least provide a more rational approach to the problem than the crude doctrines of the common law."²⁰⁹

200. 281 N.W. 261 (Minn. 1938).

201. *Haeg*, 281 N.W. at 263 (ruling that plaintiff was barred from recovery by Minnesota's contributory negligence law). In *Haeg*, plaintiff and defendant collided at an intersection in rural Minnesota. *Id.* at 261. Despite the clear evidence of defendant's negligence, the court found that the plaintiff was negligent for not recognizing and preventing the imminent collision, although he had the right of way. *Id.* at 263. Thus, the court found that both parties' negligence caused the accident. *Id.* at 262-63. Recognizing that Minnesota had adopted a contributory, not comparative negligence regime, the court reluctantly barred recovery by the plaintiff. *Id.* at 263.

202. *See id.* (ruling reluctantly for defendant).

203. *See id.* (noting that comparative negligence rule would better serve justice than contributory negligence rule).

204. *Cf. Valentine v. Chrestensen*, 316 U.S. 52, 55 (1942) (concluding that intent to evade restriction on commercial leafletting by inserting protest against official conduct was insufficient to justify First Amendment protection).

205. VICTOR E. SCHWARTZ, *COMPARATIVE NEGLIGENCE* § 1-1, at 2-4 (3d ed. 1994) (surveying American jurisdiction's adoption of comparative negligence doctrine).

206. *See id.* § 3.2, at 58-60 (defining pure comparative negligence regime).

207. *Id.*

208. *Id.*

209. Richard Nixon, Note, *Changing Rules of Liability in Automobile Accident Litigation*, 3 *LAW & CONTEMP. PROBS.* 476, 483 (1936).

The comparative negligence analogy can be applied to the publicity rights/First Amendment conflict to produce a more satisfactory result.²¹⁰ In a comparative system, a user would be liable for the appropriation of the celebrity's identity but not for the expressive element of the use. This approach addresses the concerns expressed in *Cardtoons*, in which the court faced the task of weighing the harms to society by choosing either complete liability or none at all.²¹¹ In *Cardtoons*, the court recognized that neither choice was completely satisfactory.²¹² On one hand, the court noted the incentive that protecting publicity rights has on creative output by the celebrity.²¹³ On the other hand, the court recognized that imposing liability would harm society by limiting a speaker's access to a full and rich public domain.²¹⁴ Furthermore, the court noted that imposing liability on *Cardtoons* would, in effect, unjustly enrich the baseball players in that they would receive profits that were partly attributable to the appeal of *Cardtoon's* skillful parody.²¹⁵

2. Professor Kwall's Approach

Professor Roberta Rosenthal Kwall proposed a step in the right direction in her article, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*.²¹⁶ In her thorough and somewhat complex analysis, Kwall compares the societal harms presented by allowing the unauthorized use of publicity rights with the benefits that society derives from that use.²¹⁷ To that end, Kwall examines a number of factors in order to determine the proper disposition of a case, including (1) economic harms to the plaintiff, (2) moral harms to the plaintiff, (3) likelihood of consumer deception, (4) decreased incentives for the plaintiff, (5) harms to relatives of plaintiff, (6) likelihood of unjust enrichment, and (7) type of use.²¹⁸ Most importantly, she recognizes the significance of the choice of remedy in accommodating the

210. See *infra* Part V (applying comparative approach to *ETW*).

211. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970-76 (1996) (weighing free speech interests against publicity rights interests); see also *supra* notes 157-65 and accompanying text (discussing *Cardtoons*).

212. See *id.* (finding justifications for publicity rights and expression in form of parody).

213. *Id.* at 974.

214. *Id.* at 972.

215. *Id.* at 976.

216. See generally Kwall, *supra* note 32 (proposing liability analysis to certain types of publicity rights violations where First Amendment issue exists).

217. *Id.* at 49.

218. See *id.* at 117-18 (proposing framework for resolving First Amendment/publicity rights conflict in matrix form).

competing interests of free expression and publicity rights.²¹⁹ She correctly recognizes that injunctive relief, as the most obvious form of prior restraint, is an extreme remedy to a publicity rights claim that contains an element of expression.²²⁰ Instead, she supports a liability rule approach that imposes damages equal to the fair market value of a license to use the celebrity's identity.²²¹

Her framework, nevertheless, suffers from some of the same limitations from which conventional attempts to reconcile these conflicting interests also suffer.²²² Kwall's analysis fails to confront fully the chilling effect that imposing even a fair market value liability on the appropriator might have on the output of expression.²²³ She would merely have the court consider whether the appropriator would forgo the use if faced with a mandatory damage award based on fair market value.²²⁴ For example, one can easily imagine an unestablished artist refraining from painting a celebrity who commands an exorbitant licensing fee in the marketplace because the fair market value of a license to use that identity would likely be substantially higher than the most optimistic forecast of profits. In this situation, Kwall would give the court discretion as to whether or not to impose damages; the court would consider whether the artist would likely forgo the creative endeavor if forced to pay the fair market value of the plaintiff's persona.²²⁵ However, not knowing how the court would decide this issue, the artist likely would prefer to avoid the risk of mandatory damages and the cost of litigation. Thus, Kwall's liability-rule framework, although a step in the right direction, fails to alleviate concerns that in some instances publicity rights chill free expression.

E. Proposal

A fair market valuation fails because it focuses on the pecuniary loss of the celebrity, rather than on the gain to the appropriator. As the Court in *Zacchini* stated, "[t]he rationale for protecting the right of publicity is the straight-

219. *See id.* at 50-52 (recognizing that choice of remedy may more satisfactorily resolve conflict between publicity rights and First Amendment).

220. *See id.* at 64-65 (recognizing that prior restraints on speech like injunctive relief are particularly offensive to First Amendment values).

221. *See id.* at 103-04 (suggesting imposition of damage award in form of fair market value for certain cases of publicity rights infringement).

222. *See generally id.* (proposing framework that relies on classification of speech).

223. *See id.* at 103-04 (requiring only that court consider whether or not fair market valuation of damages would act as disincentive to creative output).

224. *Id.*

225. *See id.* (proposing that court weigh whether defendant would forgo creative use if forced to pay fair market value of plaintiff's persona).

forward one of preventing unjust enrichment by the theft of good will.²²⁶ By focusing on the realized gain from the appropriation, rather than on the fair market value of what is appropriated, a court can separate more precisely the speech element from the appropriation element. Thus, the determination of the appropriator's gain, rather than the celebrity's loss, might provide a more appropriate remedial measure.²²⁷

Although three of the fourteen states that have publicity rights statutes authorize the recovery of an infringer's profits,²²⁸ few cases have considered this option.²²⁹ Support for this approach does appear in the academic literature, however.²³⁰ Comments c and d of the *Restatement (Third) of Unfair Competition* suggest that proportional profit remedies are available to a court for publicity rights infringement.²³¹ Comment d states that a "plaintiff may recover the proportion of the defendant's net profits that is attributable to the unauthorized use."²³²

This Note proposes the use of an "accounting for profits" form of restitution to accommodate First Amendment concerns in right of publicity cases.²³³ Accounting for profits is a form of restitutionary relief²³⁴ that evolved from the common law action of account.²³⁵ Chancery was justified in compelling

226. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

227. *See* MCCARTHY, *supra* note 46, § 11:34 (noting justifications for implementation of profits-based remedy).

228. *See* HANOCH DAGAN, UNJUST ENRICHMENT: A STUDY OF PRIVATE LAW AND PUBLIC VALUES 94 (1997) (noting limited availability of profits-based remedy) (citing MCCARTHY, *supra* note 46, § 6.2-6.15).

229. *See* *Factors Etc. Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1104 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981) (granting damages to extent of profits derived by defendants from unauthorized use of Elvis's identity); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 847 (S.D.N.Y. 1975) (denying relief because New York law only permits accounting of profits when plaintiff and defendant exist in fiduciary relationship); *Lugosi v. Universal Pictures*, 603 P.2d 425, 452 (Cal. 1979) (Bird, C.J., dissenting) (stating that court should hold defendant liable for profits attributable to misappropriation of identity).

230. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 49(1) (1995) (asserting that "[o]ne who is liable for an appropriation of the commercial value of another's identity . . . is liable for the pecuniary loss . . . or for the actor's own pecuniary gain resulting from the appropriation, whichever is greater, unless such relief . . . is otherwise inappropriate"); DAGAN, *supra* note 228, at 94 (noting grounds for profit-based remedy found in literature).

231. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 49 cmts. c-d (1995) (suggesting that accounting of defendant's profits is available to court in appropriate situations).

232. *Id.* § 49 cmt. d.

233. *See infra* Part IV.E (proposing use of accounting for profits form of restitution to reconcile tension between First Amendment and right of publicity).

234. *See* DAN D. DOBBS, DOBBS LAW OF REMEDIES § 4.3(5), at 608 (2d ed. 1993).

235. *See id.* § 4.3(5), at 608-09 (tracing evolution of accounting for profits remedy).

an accounting when the special abilities of masters were required to sort out complex details that were too difficult for a lay jury.²³⁶ Chancery was also justified to compel an accounting when a duty of trust existed between the defendant and the plaintiff.²³⁷ Today, it is clear that an accounting for profits is available in non-fiduciary cases.²³⁸ Copyright and trademark law specifically authorize profit recoveries without the existence of a fiduciary relationship between the infringer and the rightful owner.²³⁹ Support for this approach also appears in the *Restatement (Third) of Unfair Competition*.²⁴⁰

The *Restatement* asserts that the appropriate method of measuring relief for a publicity right violation depends upon an appraisal of the case's particular facts.²⁴¹ In general, the *Restatement* authorizes recovery of either the plaintiff's loss or the defendant's gain from the use, whichever is greater, for a publicity rights infringement.²⁴² It warns, however, that when the plaintiff's loss is less than the defendant's gain, an accounting for profits can result in a windfall to the plaintiff and, therefore, may not be appropriate in the case of an innocent infringer.²⁴³ Professor Dagan is even more cautious, asserting that a profit based recovery is only appropriate when the defendant's use degrades the commercial value of the publicity rights.²⁴⁴ Even Professor Dobbs suggests that such a remedy is appropriate only when the merits of the case justify "an extreme remedy."²⁴⁵ As Professor Dagan posits, a measure of recovery based on profits seeks to vindicate the plaintiff's liberty and control.²⁴⁶

236. *See id.* at 609 (explaining that need for masters of Chancery to make sense of complex accounting details justified equity jurisdiction).

237. *See id.* at 610-11 (noting that equity traditionally took jurisdiction in accounting of fiduciaries due to fiduciary's duty to account).

238. *See id.* at 611-12 (citing examples of situations when accounting for profits is appropriate though no fiduciary relationship exists).

239. *See id.* at 611 (noting existence of statutes authorizing accounting for profits in copyright and trademark cases).

240. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 49(2) (1995) (asserting that profit recovery is appropriate remedy for right of publicity infringement).

241. *Id.*

242. *Id.* § 49(1).

243. *Id.* § 49 cmt. c.

244. *See DAGAN, supra* note 228, at 96 (delineating situations when profit-based recovery is appropriate).

245. DOBBS, *supra* note 234, § 4.3(5), at 612 (asserting that non-fiduciaries may be required to relinquish their profits in some cases when merits justify such extreme remedy).

246. *See DAGAN, supra* note 228, at 18 (concluding that profits as measure of recovery vindicates plaintiff's liberty to control entitlement).

This Note proposes an accounting of profits form of restitution as a limiting mechanism on recovery.²⁴⁷ As discussed, the imposition of damages measured by fair market value is inappropriate in cases when an identity's use also contains protected forms of expression because such a remedy potentially chills free speech.²⁴⁸ Although its aim is merely compensatory, fair market valuation is too imprecise to accomplish this goal in every situation.²⁴⁹ Rather, the imposition of the lesser of fair market value and proportional profits is a more appropriate approach in right of publicity cases when the First Amendment is implicated. A proportional profits regime allows the plaintiff to recover profits attributable to the plaintiff's appeal.²⁵⁰ Thus, when the fair market value of the celebrity's publicity right is greater than the profits attributable to its use, the proportional profit remedy merely will hold the defendant accountable for profits earned from the appropriation.²⁵¹ Profits attributable to the defendant's contribution remain intact for the defendant.²⁵²

This proposal involves the following four-step analysis in order to determine the appropriate relief for a publicity rights infringement: (1) Is the appropriation predominantly informational/newsworthy (completely protected) or does it merely advertise a product (entitled to any form of relief, including injunction)?²⁵³ (2) Does the appropriation diminish the identity's commercial value?²⁵⁴ (3) Is there a legitimate First Amendment issue?²⁵⁵ (4) To what extent are profits derived from the good will of the appropriated identity?²⁵⁶

1. Type of Use

As discussed above, two categories of publicity rights appropriations are well settled.²⁵⁷ The First Amendment provides complete protection where the

247. See *infra* Part IV.E (proposing restitutionary scheme aimed at accommodating First Amendment values).

248. See *supra* notes 222-25 and accompanying text (arguing that fair-market-value-based remedy potentially chills free expression).

249. See *supra* Section IV.D.2 (illustrating chilling effect that fair market valuation might have on speech).

250. Cf. MCCARTHY, *supra* note 46, § 11:34 (noting similar regime in analogous copyright and trademark cases).

251. Cf. *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 508 F. Supp. 798, 801-02 (apportioning profits attributable to infringed song to plaintiff in copyright case).

252. Cf. *id.* (apportioning profits attributable to defendant's contribution to defendant).

253. See discussion *infra* Part IV.E.1 .

254. See discussion *infra* Part IV.E.2 .

255. See discussion *infra* Part IV.E.3.

256. See discussion *infra* Part IV.E.4.

257. See *supra* Part III (recognizing that pure informational uses of another's identity receive blanket First Amendment protection while pure commercial uses receive none).

use of a celebrity's identity is informational or newsworthy.²⁵⁸ Examples of such uses include documentaries, newspaper articles, and biographies.²⁵⁹ Such uses are entitled to full First Amendment protection and are therefore not subject to recovery.²⁶⁰

On the other hand, if the use is purely commercial – that is, purely for advertising purposes – the First Amendment provides no shelter to the appropriation.²⁶¹ Unauthorized use of a celebrity's name or likeness in a print advertisement or television commercial falls in this category.²⁶² So long as an award is not duplicative, the plaintiff would be entitled to an injunction, restitution, and/or damages at law because the First Amendment does not protect such uses.²⁶³ If the appropriation falls into neither of these categories, the analysis proceeds to step two.

2. Commercial Value Diminution

Should the plaintiff be able to prove that the defendant's use diminishes the commercial value of the plaintiff's identity, then the full panoply of remedies afforded in commercial misappropriation cases should apply.²⁶⁴ The First Amendment should not protect those who not only misappropriate the identity of another, but who also thereby diminish the commercial value of the plaintiff's persona.²⁶⁵ Using a celebrity's identity to express a controversial idea, for example, might diminish the value of that use. In such a case, the plaintiff should be able to enjoin such a use and recover damages and/or profits. Take, for example, the Garland example discussed in Part III.B.²⁶⁶

258. See MCCARTHY, *supra* note 46, § 8:90 (stating that "[t]he unpermitted use of human identity which bears a reasonable relationship to 'news' is constitutionally immune from liability . . . from infringement of the right of publicity").

259. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995) (noting that newsworthy exception applies to newspapers, magazines, print, and broadcast biographies, among others).

260. See *id.* (stating that informational uses are generally not actionable).

261. See *id.* § 47 cmt. a (1995) (stating that unauthorized use of another's name or likeness for advertising purposes will ordinarily subject user to liability for infringement of other's right of publicity).

262. *Id.*

263. See MCCARTHY, *supra* note 46, § 11:34 (asserting that profits as measure of recovery is appropriate so long as there is no double recovery).

264. See generally RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 48-49 (1995) (surveying remedies available in commercial misappropriation of identity cases).

265. See Kwall, *supra* note 32, at 117 (illustrating plaintiff's entitlement to injunctive relief for defendant's hybrid uses that contain moral and economic harm to plaintiff).

266. See *supra* notes 152-54 and accompanying text (using Judy Garland greeting card example to highlight difficulty in categorizing uses of identity).

The gay community's use of Judy Garland's image was arguably a powerful vehicle for self-expression.²⁶⁷ Were Ms. Garland aware of this use, however, she may have vehemently objected to such use because homosexuality was much less accepted fifty years ago than it is today. She probably could have persuasively argued that associating her name with the gay community greatly diminished the value of her persona, in that many moviemakers and advertisers were hesitant to associate their product with a controversial lifestyle.²⁶⁸ When diminution of the persona's commercial value can be shown, the plaintiff should have access to injunctive relief as well as some measure of damages or restitution. When the plaintiff is unable to show diminution of the persona's commercial value, the analysis proceeds to step three.

3. First Amendment Defense

Once the plaintiff establishes that the defendant has appropriated the celebrity's identity outside of a purely commercial or newsworthy use, the burden would shift to the defendant to show that the use implicates the First Amendment's protection of expression. Although the First Amendment question is similar to that posed in traditional publicity rights/First Amendment analysis, it differs in an important way. In this analysis, the defendant's ability to demonstrate some level of First Amendment protection determines the type of relief granted, rather than whether any relief is granted at all. If the defendant is unable to establish a threshold First Amendment showing, the plaintiff is entitled to the full panoply of relief, which includes injunctive relief, damages, and restitution. However, if the defendant is able to establish a First Amendment issue, the plaintiff is limited to restitution in the form of an accounting for profits. It should be noted here that the defendant's burden differs from that under traditional analysis. Under contemporary jurisprudence, once a court recognizes a First Amendment issue, it weighs society's interest in protecting this use against society's interest in preserving the plaintiff's commercial interest in identity.²⁶⁹ Under this Note's proposal, once the defendant has established some minimal level of protected expression, the analysis proceeds to a remedy stage.

267. See *supra* note 153 and accompanying text (discussing use of Judy Garland's identity as means of self-expression by gay community in 1950s).

268. *Contra* Madow, *supra* note 83, at 195 (noting that Garland's publicity value likely increased after gay community's use of her image). It is far from clear, however, that Ms. Garland's publicity value would have increased had the gay community's use occurred in the 1940s rather than in the 1980s.

269. See MCCARTHY, *supra* note 46, § 8:22 (explaining traditional balancing test employed by courts).

For example, once the plaintiff in *Cardtoons* established that *Cardtoons*, L.C. had appropriated the ballplayers' identities, *Cardtoons* would be required to raise a First Amendment defense.²⁷⁰ *Cardtoons* easily could meet this requirement by showing the informational and parodic expression present in their baseball cards.²⁷¹ Rather than attempting to weigh societal interests, the court, upon a First Amendment showing, would proceed to step four to determine the amount of restitution to which the plaintiff was entitled.

4. Restitution

The careful formulation of step four is critical to this proposal's success because this analysis proposes the restitutionary remedy of accounting for profits as the mechanism for resolving the conflict between the right of publicity and the First Amendment. As discussed above, First Amendment advocates are acutely concerned with the right of publicity's propensity to chill expression.²⁷² This Note proposes an alternative to both the all or nothing approach currently employed by United States courts and the fair market value approach favored by Professor Kwall and others.²⁷³ If a proportional profits rule is to succeed, however, it must be implemented so that it reaches only those profits attributable to the appropriation of the plaintiff's publicity rights. Allowing the plaintiff to recover any more would restrict the expressive component of the defendant's use, which approximates the chilling effect that fair market value damages pose to free expression.²⁷⁴

Initially, the plaintiff would bear the burden of showing gross receipts from the use at issue.²⁷⁵ The plaintiff would derive this figure from discovery.²⁷⁶ Once the court has made a finding of fact as to gross receipts, the focus turns to net profits.²⁷⁷ To arrive at this figure, the burden shifts to the defendant to show the legitimate business expenses that the court should deduct

270. For a general discussion of the issues raised in *Cardtoons*, see *supra* notes 156-60.

271. See *supra* note 159-60 (noting *Cardtoon's* use of parody).

272. See MCCARTHY, *supra* note 46, § 8:9 (noting chilling effect publicity rights have on expression).

273. Compare *supra* Part IV.E (proposing alternative approach based on restitution) with *supra* Parts IV.A-C, IV.D.2 (discussing other approaches).

274. Cf. *United States v. Nat'l Treasury Employees Union*, 513 U.S. 454, 468 (1995) (expressing concern that ban on honoraria would chill speech by taking away incentive to convey information to public).

275. See DOBBS, *supra* note 234, § 4.3(5), at 612 n.27 (citing 15 U.S.C. § 1117(a) (1994)) (noting that plaintiff need only prove defendant's sales).

276. See *id.* at 610 (noting that placement of burden to produce data regarding gross revenue is not needed with advent of extensive modern discovery).

277. See *id.* at 612 (discussing how courts determine profits).

from gross receipts in order to arrive at a net profit determination.²⁷⁸ This shift in burden to the defendant is appropriate because the defendant has the best access to expense information.²⁷⁹ Next, the court would have to apportion the net profits between that which can be attributed to the misappropriation of publicity rights and those resulting from the appeal of the defendant's creativity and skill.²⁸⁰

For example, the maker of parody baseball cards, Cardtoons, would be required to show legitimate business expenses attributable to the production of its product.²⁸¹ Costs may include the salary of the artists and writers who parodied the baseball players, the price of raw materials such as cardboard and ink, and marketing and shipping costs.²⁸² Once this total is subtracted from the gross receipts of the product's sales, the task of the court would be to apportion the profits.²⁸³ As is the case in copyright and trademark, it may be impossible to determine precisely the portion of profits attributable to each party.²⁸⁴ That is not to say that this task is merely guesswork. Certainly, the appeal of an Elvis poster with the defendant-created caption "In Memory" is due far more to Elvis's identity than to the marketer's caption.²⁸⁵ The burden remains on the defendant to show the extent to which net profits are due to the defendant's contribution.

As Professor Dobbs points out, precise apportionment may be difficult.²⁸⁶ However, the fact that part of the profits result from protected activity

278. See *id.* (asserting that burden should rest with defendant to show appropriate business expenses to deduct from gross receipts and noting that burden is placed this way in copyright and trademark cases).

279. See *id.* (justifying shift of burden to defendant to show deductible expenses). What should be included in legitimate business expenses is largely an accounting measure issue that is beyond the scope of this Note. However, case law on this subject undoubtedly exists and can be applied to this measurement. See, e.g., *infra* notes 281-83 and accompanying text (discussing legitimate business expense deductions).

280. Cf. *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 508 F. Supp. 798, 801-02 (S.D.N.Y. 1981) (apportioning profits based on relative contributions and appeal of parties in copyright infringement case).

281. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996) (recognizing Cartoon's creative and financial expenditures in producing trading cards); *supra* note 160 (discussing background of case).

282. See *Cardtoons*, 95 F.3d at 976 (noting Cartoon's various expenditures).

283. Cf. *ABKO Music*, 508 F. Supp. at 801 (denying deductions for otherwise legitimate expenses due to defendant's inability to specify those attributable solely to infringing song).

284. See DOBBS, *supra* note 234, § 4.5(3), at 642 (noting that precise apportionment may be difficult).

285. See generally *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980).

286. See DOBBS, *supra* note 235, § 4.5(3), at 642 ("A song that infringes the plaintiff's copyrighted melody may sell well partly because the melody is attractive but also because the infringer's lyrics are better.").

should not bar any recovery at all. Certainly, some profits garnered by the defendant due to publicity rights infringement are attributable to protected activity and expenses. Additionally, some of the profits are due to exploitation of the celebrity's appeal. That a jury cannot precisely apportion the exact contribution of negligence due to each driver in an auto accident should not bar any recovery by the less negligent victim.²⁸⁷ Similarly, uncertainty should not bar recovery in the publicity rights context.²⁸⁸ It is entirely conceivable that an unknown artist would forgo protected expressive activity if it was unclear that the venture would net enough in profits to cover damages equal to the fair market valuation of the appropriated identity.²⁸⁹ Under this approach, the most the artist would lose would be net profits. Furthermore, this possibility exists only in the unlikely instance where an appropriator contributes absolutely nothing to the appeal of the infringing product. Thus, where the court can determine the approximate portion of *net profits* attributable to each party, "want of precision is not a ground for denying apportionment altogether."²⁹⁰

Guidance to apportionment is provided by copyright case law, as it employs a similar regime.²⁹¹ In *Gaste v. Kaiserman*,²⁹² for example, the court affirmed the lower court's ruling, which held that the composer and publisher of the song *Feelings* infringed on the plaintiff's song, *Pour Toi*.²⁹³ To deter-

287. See *supra* Part IV.D.1 (discussing inequities of contributory negligence regimes).

288. It is important to differentiate the imprecision that may result from using a fair market valuation of damages from the imprecision in apportioning *net profits* between the plaintiff and the defendant. Using a fair market valuation of damages for a publicity rights infringement rather than actual attributable profits is imprecise; it ignores the relative contributions to the success of the infringing venture.

289. See *supra* notes 223-25 and accompanying text (illustrating chilling effect that fair market valuation may have on free expression).

290. *Gaste v. Kaiserman*, 863 F.2d 1061, 1070 (2d Cir. 1988).

291. See *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 508 F. Supp. 798, 801-02 (S.D.N.Y. 1981) (noting that while exact precision is not possible, one quarter of infringing song's profits were due to defendant's lyrics and popularity with consumers).

292. 863 F.2d 1061 (2d Cir. 1988).

293. *Gaste v. Kaiserman*, 863 F.2d 1061, 1071 (2d Cir. 1988) (affirming lower court's finding of defendant's infringement and damages). In *Gaste*, the court considered the defendants' appeal of a judgment finding that the defendants' song, *Feelings*, infringed on the copyright of plaintiff's composition, *Pour Toi*. *Id.* at 1063. Affirming that defendants' song did infringe on plaintiff's composition, the court considered whether damages were properly determined. *Id.* at 1069-71. The court concluded that though it was not possible to ascertain precisely how the jury determined the damages, it was reasonable to conclude that the jury properly deducted business expenses and profits attributable to the defendant's efforts and lyrics. *Id.* at 1070-71. The Court affirmed the lower court's decision and the adjusted damages award. *Id.* at 1071.

mine the appropriate remedy, the court required the defendants to prove that they were entitled to certain expenses incurred in producing the song.²⁹⁴ The defendants also had the burden of proving what portion of the infringing song's net profits were attributable to their lyrics.²⁹⁵ Similarly, the court in *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*,²⁹⁶ upon a determination of the gross receipts attributable to the infringing song, *My Sweet Lord*, subtracted business expenses attributable to the song's production as well as one quarter of the net profit, which it attributed to the lyrics and appeal of the defendant, ex-Beatle, George Harrison.²⁹⁷ Thus, while this approach is novel to publicity rights, it has been tested in other contexts.

V. Application of Proportional Profits Approach to ETW

Application of this approach to the facts of *ETW* results in a far different and more just outcome than the district court's decision. First, there is no doubt that Jireh appropriated Tiger Woods's likeness in Rush's painting, *The Masters of Augusta*.²⁹⁸ Neither party disputes this fact.²⁹⁹ Second, Jireh adequately asserted that Rush's painting contained artistic expression deserving of First Amendment protection.³⁰⁰ It is widely accepted that art is a protected form of expression.³⁰¹ Thus, under this Note's approach, the court would have ordered proceedings to determine the amount of *restitution* due

294. *Id.* at 1069 (outlining burden of proof framework).

295. *Id.*

296. 508 F. Supp. 798 (S.D.N.Y. 1981).

297. *See* *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 508 F. Supp. 798, 801-02 (S.D.N.Y. 1981) (apportioning profits of infringing song between those due to original song and those due to expenses, lyrical contribution, and appeal of infringer). In *ABKCO*, the court considered what portion of the profits from a song that infringed on the copyright of another was attributable to each party. *Id.* at 799-801. In 1971, George Harrison subconsciously plagiarized the song *He's So Fine* in arriving at the melody of his song, *My Sweet Lord*. *Id.* at 799. Upon a determination of copyright infringement and subsequent hearings to determine damages, the court apportioned the net profits from the infringing song between each party. *Id.* at 802. The court determined that profits of \$1,599,987.00 were attributable to the music from *He's So Fine* after deducting expenses and those profits attributable to Harrison's lyrics and selling power. *Id.*

298. *See* *ETW Corp. v. Jireh Pub'g, Inc.*, 99 F. Supp. 2d 829, 830 (N.D. Ohio 2000), *appeal docketed*, No. 00-3584 (6th Cir. 2001) (stating unequivocally that Tiger Woods is subject of painting); *see also supra* notes 1-14 and accompanying text (discussing background of *ETW*).

299. *See id.* (containing no reference to dispute regarding subject of painting).

300. *Id.* at 836 (noting that defendant's artwork conveys message and is therefore distinguishable from reproductions of photograph).

301. *Id.* at 835-36 (citing multiple cases, which state that art is protected by First Amendment).

ETW from Jireh Publishing for the infringement of Tiger Woods's publicity rights. As in *Gaste v. Kaiserman*, the plaintiff would bear the burden of presenting proof of the infringer's gross revenue.³⁰² According to an article in the New York Times, Jireh issued 250 serigraphs, selling for seven hundred dollars each, along with 5,000 smaller lithographs, selling for fifteen dollars each.³⁰³ Assuming all copies were sold, Jireh would gross approximately \$250,000. Once ETW established this figure, the burden would shift to Jireh to identify those expenses solely attributable to the painting's production and promotion.³⁰⁴ For demonstration, assume that Jireh is able to identify \$50,000 in production and marketing expenses. This figure subtracted from gross revenue yields a total of \$200,000 to apportion.

The burden would remain with the defendant, Jireh, to establish that portion of the net profits attributable to the painting and Rush/Jireh's reputation or appeal as an artist/publisher of fine art. As discussed above, this showing, although difficult to make with great precision, is similar to that required in analogous trademark and copyright cases.³⁰⁵ Thus, Jireh would present evidence regarding the appeal of the expression itself, along with that value which is attributable to the reputation of the artist and publisher.

In this case, Jireh could probably show that a substantial portion of the profits is attributable to the quality of the painting and prints, as well as the reputation of the artist, Rick Rush.³⁰⁶ Rush has sold hundreds of paintings of athletes, including Michael Jordan, John Elway, Magic Johnson, and the University of Wisconsin football team.³⁰⁷ Rush's reputation is likely responsible for much of the print's net profit. It is likely that many collectors have purchased multiple works by Rush because of his artistic ability. Thus,

302. See *Gaste v. Kaiserman*, 863 F.2d 1061, 1069 (2d Cir. 1988) (stating that copyright owner is required to present proof of gross revenue); see also *supra* notes 292-95 (discussing background of *Gaste*).

303. See *Chambers*, *supra* note 1, at D1 (reporting prices charged per customer for prints of *The Masters of Augusta*).

304. It should be noted that Jireh could not merely claim the fee it paid to Rush as an expense. This would allow an artist to create a dummy business, which would pay the artist all projected profits in the form of a fee, while selling the prints without profit or perhaps a loss, which would deny the celebrity the profits attributable to him. Alternatively, ETW would have to sue Jireh and Rush to recover his share of the profits.

305. See *supra* notes 291-97 and accompanying text (noting that copyright infringement adjudication demands similarly difficult apportionment procedure).

306. The painting is quite striking, showing Woods in three positions on the golf course, flanked by his caddy, with ghostly images of past winners looming in the background. *The Masters of Augusta* is a very attractive work of art that probably sold quite well due in large part to its presentation.

307. See Jireh Publishing, Inc., available at <http://www.jirehpub.com> (last visited Mar. 3, 2001) (displaying Rush's paintings and prices).

much of the appeal and, therefore, profits are attributable to Rush and Jireh Publishing.

In rebuttal, ETW would present evidence regarding the painting's added value attributable to Mr. Woods's inclusion as the subject of the work. ETW should have no difficulty supplying ample evidence in this regard because ETW's business is marketing Woods's identity.³⁰⁸ Considering the millions of dollars that Mr. Woods receives each year from attaching his name to products, including Buick automobiles, Nike sportswear, and American Express, time and the court's patience are the only limitations on ETW's ability to offer such evidence.³⁰⁹

In making this determination, the court should take great care not to underestimate the profits more appropriately attributable to protected expression as was done in *Gaste* and *ABKCO*.³¹⁰ In *Gaste*, the court noted that although precise apportionment might not be possible, courts should err on the side of full recovery to the plaintiff.³¹¹ Here, where First Amendment concerns are present, the court should err on the side of the defendant to avoid awarding to ETW profits due to Rush's expressive activity. Hypothetically, the court might decide that sixty percent of the net profits from *The Masters of Augusta* is attributable to Rush's ability and reputation, while forty percent is due to the appeal of the painting's subject, Tiger Woods. Thus, ETW's share would be \$80,000, and Jireh's share would be \$120,000. While neither side would likely be completely satisfied with this outcome, the result is appealing in an intuitive sense, because each party would receive profits attributable to their respective contributions.

As illustrated above, this Note proposes to accommodate First Amendment concerns in right of publicity cases by following the lead of the comparative negligence doctrine.³¹² Rather than determining liability on an "all or nothing" basis, this proportional profits approach apportions net profits from the infringing use based on the relative contributions of each party. Thus, a plaintiff will only recover the portion of profits in the venture that are due to the plaintiff's appeal. Profits attributable to the defendant's protected expres-

308. See Chambers, *supra* note 1, at D1 (noting that ETW Corp. was created to control marketing of Tiger Woods's image).

309. See Greg Johnson, *Woods's Cautious Approach to the Green: Golf's Young Star Seems to Have a Long-Range Strategy That Could Lead to Unprecedented Riches*, L.A. TIMES, July 26, 2000, at A1 (noting several of Woods's lucrative endorsement deals).

310. For a discussion of the issues in *Gaste* and *ABKO*, see *supra* notes 291-97 and accompanying text.

311. *Gaste v. Kaiserman*, 863 F.2d 1061, 1070 (2d Cir. 1988).

312. See *supra* Part IV.D-E (proposing compromise framework, which, like comparative negligence doctrine, abandons "all or nothing" approach).

sion remain for the defendant. Thus, that portion of the defendant's venture attributable to the defendant's speech is unrestricted.

This Note's approach is also appealing because it removes the uncertainty regarding whether or not the court would impose liability exceeding the profits gained from the appropriation.³¹³ Where the defendant can show an element of protected expression, liability cannot exceed the net profits from the venture, thus removing the chilling effect that uncertainty poses for the speaker. Therefore, artists, activists, and other speakers will not be dissuaded by potential liability exceeding their ability to compensate the plaintiff.

The real benefit to society may be the effect that this approach has on litigation. As illustrated in the Tiger Woods example, the plaintiff will only recover the portion of profits that is due to the celebrity's appeal.³¹⁴ Accordingly, where either the venture was minimally profitable or the defendant's contribution was substantial, potential plaintiffs will likely abstain from filing expensive lawsuits. Likewise, where the profit potential is great or the defendant's contribution is relatively small, the potential defendant will likely negotiate for a license or refrain from appropriating the plaintiff's identity. Therefore, struggling artists like those in *Bery* would stand to lose very little, while an Elvis poster merchandiser would likely forgo the venture or negotiate for a license.³¹⁵

VI. Conclusion

Society's interest in open and free expression does not require its citizens to relinquish their private property rights to further this freedom.³¹⁶ However, free expression does require a rich and fully stocked public domain to fuel it.³¹⁷ To that end, artists, poets, filmmakers and other speakers need access to contemporary cultural icons in order to attach meaning to their ideas.³¹⁸ A speaker's ability to best express her ideas may be conditioned on the use of

313. See *supra* Part IV.D.2 (illustrating chilling effect with example of obscure artist's decision whether or not to paint celebrity who commands exorbitant licensing fee in marketplace).

314. See *supra* Part V (applying Note's approach to *ETW*).

315. Cf. *Bery v. City of New York*, 97 F.3d 689 (2d Cir. 1996); *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980).

316. See *Hudgens v. N.L.R.B.*, 424 U.S. 507, 521-523 (1976) (ruling that striking workers were not entitled to trespass on private property in order to engage in First Amendment activity).

317. Brief of Amici Curiae Law Professors, *supra* note 84, at 23 (arguing that restrictions on use of celebrity persona diminish vital public domain).

318. See Madow, *supra* note 83, at 239 (arguing that celebrity images should be included in cultural commons available for use in creation of cultural meaning).

another's persona, but "[t]he right to make a profit is not protected by the First Amendment."³¹⁹ Where profits derived from a speaker's use are attributable to the appeal of another's identity, the speaker is unjustly enriched and thus, should be required to relinquish that portion attributable to another's commercial appeal. As the most recognizable name in sports art, LeRoy Neiman, asked, "Why should an artist just looking for a hot market do something without having an arrangement? The [celebrity] is entitled to a cut."³²⁰ Restitution, in the form of an accounting for profits, accommodates society's fundamental interest in free expression, while apportioning profits from that expression to those who created it.

319. *Holloway v. Brown*, 403 N.E.2d 191, 195 (Ohio 1980) (citing *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447 (1978); *Breard v. Alexandria*, 341 U.S. 622 (1951)).

320. *Chambers*, *supra* note 1, at D1 (quoting LeRoy Neiman).

SYMPOSIUM
