

## PANEL III: Trademark and Publicity Rights of Athletes

Moderator: Tom Ferber<sup>\*</sup>  
Panelists: Edward Kelman<sup>†</sup>  
Bruce Meyer<sup>‡</sup>  
Dennis Niermann<sup>§</sup>  
Mike Principe<sup>||</sup>

MR. KLEIN: This summer the Sixth Circuit Court of Appeals affirmed an earlier decision that protected the artist's interests when he painted a portrait of Tiger Woods at the Masters.<sup>1</sup> Tiger's corporation, ETW Corp., sued Jireh Publishing, claiming that the print infringed and diluted his trademark and violated his common law right of publicity ("*Tiger Woods*" case).<sup>2</sup>

This panel will be moderated by Tom Ferber. Mr. Ferber has been a Partner at Pryor Cashman since 1991. He has represented a variety of clients in copyright infringement, trademark, right of publicity, privacy, and defamation cases. Mr. Ferber received his undergraduate degree from Tufts University and his J.D. from Georgetown. To kick off the final panel of the day I give you Tom Ferber.

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<sup>\*</sup> Partner, Pryor Cashman Sherman & Flynn LLP, New York, N.Y. J.D., Georgetown University Law Center, 1982; B.A., magna cum laude, Tufts University, 1979.

<sup>†</sup> The Law Offices of Edward Kelman, New York, N.Y. J.D., New York University, 1968; B.A., Cornell University, 1965.

<sup>‡</sup> Partner, Weil Gotshal & Manges LLP, New York, N.Y. J.D., Boston University School of Law, 1986; B.A., University of Pennsylvania, 1983.

<sup>§</sup> The Dennis Niermann Company, Cleveland, Ohio. J.D., Cleveland State University, 1979; B.A., John Carroll University, 1972.

<sup>||</sup> Executive Vice President, SFX Sports Group, New York, N.Y. J.D., Washington University School of Law, 1995; B.A. Washington University, 1992.

<sup>1</sup> ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 938 (6th Cir. 2003) [hereinafter *Jireh Publ'g II*], *aff'g* 99 F. Supp. 2d 829 (N.D. Ohio 2000) [hereinafter *Jireh Publ'g I*]. The panelists refer to these as the "Tiger Woods" case.

<sup>2</sup> *Jireh Publ'g II*, 332 F.3d at 919.

MR. FERBER: Good afternoon. We have a distinguished and diverse panel here today to discuss publicity law and the *Tiger Woods* case.

First, right in the middle, we have Bruce Meyer. Bruce is a Partner at Weil Gotshal & Manges in New York, where he has practiced law since 1986. In addition to his specialty in complex commercial litigation in a variety of industries, Bruce is also a specialist in sports law and has done extensive work representing player unions from all the major areas, as well as individual athletes and agents. Bruce has conducted numerous grievance arbitrations and Special Master proceedings for professional basketball and football players involving a variety of contract, free agency, and salary cap issues, as well as litigating groundbreaking antitrust cases concerning the NFL and other leagues.

Bruce has been an Adjunct Professor of sports law at both Fordham and at St. John's, and he is the co-author of the three-volume treatise entitled *International Sports Law and Business*. Of particular interest on this occasion, Bruce authored an *amicus brief* to the Sixth Circuit in the *Tiger Woods* case, on behalf of the NFL Players Association.<sup>3</sup>

Our second speaker will be Dennis Niermann, next to the end. Dennis hails from Cleveland Heights, Ohio, where he has had a varied legal career, from criminal defense work in a public defender's office, to his specialty in age, race, and gender discrimination and sexual harassment cases. After working with various law firms, Dennis has been in solo practice since 1998.

It was shortly after starting his own practice that Dennis was retained to defend Jireh Publishing in the *Tiger Woods* case, a matter which fit hand and glove with Dennis's passion for golf. As fact would have it, Tiger Woods was, and still is, Dennis's sports hero. Nevertheless, believing passionately in what he saw as his client's right, as Dennis describes it, "to express himself and share his artistic vision the same way Tiger displays his artistry on the golf course," Dennis took on the representation—and with some success, as we will see today.

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<sup>3</sup> Brief Filed by Bruce S. Meyer for Amicus Curiae Nat'l Football League, *Jireh Publ'g II*, 332 F.3d 915 (6th Cir. 2003) (No. 00-3584).

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Dennis also serves as an Acting Judge in Cleveland Heights, where he has been on the Public Defender Commission and was the Democratic Ward Leader.

At the end of the row here we have Mike Principe. Mike is the Executive Vice President Business and Legal Affairs for SFX Sports Group. He is responsible for the management of major business transactions, including multimillion-dollar corporate acquisitions and off-the-field negotiations, as well as corporate litigation and arbitration. Mike is one of the top decision-makers at SFX, where he also serves in the Sports Group Executive Committee.

He has been involved in directing many of the industry's most considerable transactions, including the acquisitions of Black Canyon Productions, Greg Norman Productions, Hendricks Management, ProServ, Tellem & Associates, and many others. Mike's involvement in these acquisitions, which comprise a significant piece of the SFX Sports Group, has afforded him a deep working knowledge of the sports world and familiarity with the business.

And finally, we have Ed Kelman. Ed is in private practice specializing in entertainment and media law, including film, television, merchandising, advertising, book and magazine publishing, records, music publishing, and home video. He regularly negotiates and drafts agreements in all these areas and has also done extensive work in copyright and trademark law, music and other rights clearances, and related work in connection with asset purchases and stock acquisitions in these fields.

Ed has worked in both a legal and a business capacity at CBS, PolyGram, and Thorn EMI Video and Television. He is a former member of the Committee on Entertainment Law of the Association of the Bar of the City of New York, and has spoken at numerous school and industry panels on topics in this field.

For our agenda today, just to give you a little bit of a roadmap: to begin, first we will have Bruce Meyer, and then Dennis Niermann, discussing the right of publicity as it relates to the Tiger

Woods litigation and the Sixth Circuit decision in that case;<sup>4</sup> Mike Principe will speak next, offering his insights from the perspective of the athletes' advocate; and finally, Ed Kelman will speak about considerations that should be given to these matters in negotiating and drafting agreements implicating the rights of athletes and other celebrities. We will have a question-and-answer period after all four gentlemen have spoken, so we'll ask the audience to hold their questions until that time.

MR. MEYER: Thank you, Tom.

I have been given the task of, in about ten minutes, summarizing all of the law with respect to the right of publicity and the *Tiger Woods* case,<sup>5</sup> so I'll talk fast.

The right of publicity is a strange creature. It's a product of common law, going back to some decisions decades ago.<sup>6</sup> Currently, there are some statutes in various states that relate to the right of publicity,<sup>7</sup> and if anyone is giving advice in this area in a particular state, he should look there.

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<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

<sup>6</sup> 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY §§ 1:3-1:4 (2d ed. 2004) [hereinafter MCCARTHY].

<sup>7</sup> CAL. CIV. CODE §§ 3344-3344.1 (West 2004) (proscribing the use of another's name, voice, signature, photograph, or likeness for advertising or selling or soliciting purposes); FLA. STAT. ANN. § 540.08 (West 2004) (proscribing unauthorized publication of name or likeness); 765 ILL. COMP. STAT. § 1075/1 (2004) (creating statutory right of publicity); IND. CODE ANN. §§ 32-36-1-1 to -1-20 (2004) (right of publicity); KY. REV. STAT. ANN. § 391.170 (Banks-Baldwin 2004) (proscribing the commercial rights to use of names and likenesses of public figures); MASS. GEN. LAWS ANN. ch. 214, § 3A (West 2004) (proscribing the unauthorized use of name, portrait or picture of a person); NEB. REV. STAT. §§ 20-202 (2004) (proscribing invasion of privacy and exploitation of a person for advertising or commercial purposes; N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 2004) (creating right or privacy); OHIO REV. CODE ANN. § 2741.01 (West 2004) (creating right of publicity); OKLA. STAT. ANN. tit. 12, §§ 1448-49 (West 2004) (providing for deceased personality's right of publicity and proscribing the unauthorized use of another person's rights of publicity); 42 PA. CONS. STAT. ANN. § 8316 (West 2004) (proscribing the unauthorized use of name or likeness); R.I. GEN. LAWS §§ 9-1-28 to -28.1(a)(2) (2004) (creating action for the unauthorized use of name, portrait, or picture); TENN. CODE ANN. §§ 47-25-1101 (2004) (recognizing that individual has property right in use of his name, photograph, or likeness); UTAH CODE ANN. §§ 45-3-1 to -3-6 (2004) (creating cause of action for misappropriation of personal identity); VA. CODE ANN. § 8.01-40 (West 2004) (proscribing the unauthorized use of name or picture of any person); WASH. REV. CODE

Generally, the genesis of the right of publicity is traced back to a case called *Haelan Laboratories* in the Second Circuit.<sup>8</sup> Although there are some precursors, that is the one that you see frequently cited.<sup>9</sup>

*Haelan Laboratories* involved some athletes who had given their exclusive rights to be used in connection with chewing gum products, and another company went out and used pictures of the same athletes in connection with their chewing gum.<sup>10</sup> The court held that there was this thing called the right of publicity, which, oddly enough, derives from the right to privacy.<sup>11</sup> You would think that these things would be completely inconsistent, the right to privacy and the right of publicity, but that is the genesis of the right of publicity.<sup>12</sup>

Basically, the right of publicity says that a person has an economic interest in the commercial exploitation of their image, likeness, name, that sort of thing.<sup>13</sup> Again, we don't have time, but there are articles by Prosser on this and there is a whole history in terms of the genesis of it.<sup>14</sup>

The *Haelan* case found that these athletes had the right to control the exclusive exploitation of their images in connection with these chewing gum products.<sup>15</sup>

Around twenty years later there was the famous "human cannonball" case, the *Zacchini*<sup>16</sup> case. *Zacchini* had a "human cannonball" act and when a reporter for a news station came to

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ANN. § 63.60.010 (West 2004) (creating "personality" rights); WIS. STAT. ANN. § 895.50 (West 2004) (creating right of privacy and right of publicity).

<sup>8</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.* 202 F.2d 866 (2d Cir. 1953); see 1 MCCARTHY, *supra* note 6, § 1:4.

<sup>9</sup> 1 MCCARTHY, *supra* note 6, § 1:4.

<sup>10</sup> *Haelan Labs.*, 202 F.2d 866.

<sup>11</sup> *Id.* at 868 ("[I]n addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . .").

<sup>12</sup> 1 MCCARTHY, *supra* note 6, § 1:4.

<sup>13</sup> See Bruce P. Keller, *The Right of Publicity: Past, Present, and Future*, 1207 PLI CORP. LAW AND PRAC. HANDBOOK 159, 161–63 (2000).

<sup>14</sup> E.g., William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960) (explaining that torts of privacy include appropriation of individual's likeness for advantage).

<sup>15</sup> See *Haelan Labs.*, 202 F.2d 866.

<sup>16</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

film it, Zacchini asked him not to. The reporter filmed it anyways, and then showed it on the evening news in connection with a story—obviously a slow news day—about the “human cannonball” act, during the course of which they actually showed the entire act.<sup>17</sup>

So Mr. Zacchini, the “human cannonball,” who as I recall had inherited the act from his father, sued and complained essentially that this was depriving him of his livelihood, because if everyone got to see the act for free, no one would pay to come see his act.<sup>18</sup>

The policy behind the right of publicity is generally one of fairness.<sup>19</sup> A person who has accomplished something, or put on some form of entertainment, or built up that person’s name or likeness into something that has commercial value, should be the one to benefit from the exploitation.<sup>20</sup> And also, occasionally you see courts talk about a societal benefit from encouraging people to succeed, to build something of value.<sup>21</sup> With protection, there is an incentive for people to do things, creative or otherwise, and society reaps the reward.<sup>22</sup>

There is a series of cases trying to define the contours of the right of publicity. A particularly interesting one is the *Cardtoons*<sup>23</sup> case, which involved baseball players.

Before I get to that, I should point out that the right of publicity is the basis for all of the licensing you see—and though I’m focusing on athletes, it’s not limited to athletes.<sup>24</sup> Things like trading cards, video games, posters—these are things that athletes

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<sup>17</sup> See *id.*

<sup>18</sup> See *id.*

<sup>19</sup> 2 MCCARTHY, *supra* note 6, § 9:14.

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> See *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (9th Cir. 1996).

<sup>24</sup> See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

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license, and people pay a lot of money to license these rights from athletes.<sup>25</sup>

Players' associations in the organized sports generally have the rights assigned to them by the players so the associations can exploit those rights in group applications for things like trading cards and video games.<sup>26</sup> It generates revenues for the athletes and the players' associations.

This *Cardtoons* case I mentioned involved trading cards—parodical, satirical trading cards that had caricatures of players and funny things on the back.<sup>27</sup> The court held that there was no right of publicity—that the players could not stop this—because the First Amendment took precedence.<sup>28</sup> That case involved parody and satire, which are classic core First Amendment concerns that for decades First Amendment cases have said should be given special deference.<sup>29</sup>

In brief, the *Tiger Woods* case involved the picture that you see over there, which was done by an artist.<sup>30</sup> Dennis knows more, I'm sure, than anybody up here about the specifics of the case.

But basically we're not talking about a sole work of art that is hung in a museum. Rick Rush, the artist, produced 5000 copies and sold them, including 250 serigraphs for \$700 each.<sup>31</sup> So we're talking about the mass product, the mass exploitation, of this supposed work of art.<sup>32</sup>

We can differ—and I'm sure we will differ—but if you take a look at it, I think we can all agree that essentially what it consists

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<sup>25</sup> See, e.g., NFL Players Inc., *About Us*, at [http://www.playersinc.com/about\\_us/about\\_main.aspx](http://www.playersinc.com/about_us/about_main.aspx) (last visited Feb. 23, 2005) (describing examples of athletic licensing rights).

<sup>26</sup> *Id.*

<sup>27</sup> See *Cardtoons*, 95 F.3d at 962.

<sup>28</sup> *Id.* at 976.

<sup>29</sup> *Id.* at 972 (“[P]arody, both as social criticism and a means of self-expression is a vital commodity in the marketplace of ideas.”).

<sup>30</sup> See *Jireh Publ'g II*, 332 F.3d 915, 918 (6th Cir. 2003).

<sup>31</sup> *Id.* at 919.

<sup>32</sup> *Id.*

of is a picture of Tiger Woods.<sup>33</sup> Now, there are other things in the background, there are the shadows of other golfers, but I think it's fair to say that anybody who would buy this and pay \$700 for it is buying it to have a picture of Tiger Woods.<sup>34</sup>

MR. NIERMANN: It's \$750.<sup>35</sup>

MR. MEYER: Sorry. No accounting for taste. People with too much money.

In the *Tiger Woods* case, Tiger Woods sued, saying that he wasn't paid for this, he didn't give his consent, and that this violates his right of publicity.<sup>36</sup> The artist, represented by Mr. Niermann, and the artist's company contend they have a First Amendment right to perpetrate this because this is a great work of art and there's a message and freedom of expression—you know, it's not just a picture of Tiger Woods; it's conveying these messages about Tiger Woods.<sup>37</sup> My opinion is that the message is "Tiger Woods plays golf and he's really good at it."<sup>38</sup> I'm sure, again, you will hear some contrary views.

The district court basically adopted a blanket rule that said because it's a work of art, the First Amendment trumps the right of publicity.<sup>39</sup>

The Sixth Circuit adopted, I think, a more balanced approach, although it came out with the same result, again saying the First Amendment governed.<sup>40</sup>

They cited to a case where somebody had done drawings of the Three Stooges and put them on T-shirts, which, according to the

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<sup>33</sup> Rick Rush, *The Masters of Augusta*, [http://www.herndonfineart.com/images/Sports-/rush\\_masters\\_of\\_augusta.jpg](http://www.herndonfineart.com/images/Sports-/rush_masters_of_augusta.jpg) (last visited on Feb. 17, 2005) [hereinafter *The Masters of Augusta*].

<sup>34</sup> *Id.*

<sup>35</sup> The work is currently priced at \$1,500.00. *Rick Rush Limited Editions and Originals*, at <http://www.herndonfineart.com/rush.htm> (last visited on Feb. 17, 2005).

<sup>36</sup> *See Jireh Publ'g II*, 322 F.3d at 919.

<sup>37</sup> *Id.* at 919–20.

<sup>38</sup> *The Masters of Augusta*, *supra* note 33.

<sup>39</sup> *See Jireh Publ'g I*, 99 F. Supp. 2d 829, 834 (N.D. Ohio 2000) (citing J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 28:40–41 (4th ed. 1999)) ([T]he "right of publicity . . . does not authorize a celebrity to prevent the use of her name in an expressive work protected by the First Amendment.").

<sup>40</sup> *See Jireh Publ'g II*, 332 F.3d 915.

California Supreme Court, violated the right of publicity of the Stooges' heirs.<sup>41</sup> The court used a test derived from fair use in copyright law that considers how much the work adds to the images, or whether the work is really just the images.<sup>42</sup> They call it a transformative test.<sup>43</sup>

I know Dennis is going to say that courts should not be art critics, but courts draw lines like this all the time in all kinds of areas, including intellectual property.<sup>44</sup> Basically the approach, which I think influenced the Sixth Circuit, is to look on a case-by-case basis and say: Is this really nothing more than, or little more than, an exploitation of a person's image?<sup>45</sup>

And again, I would submit to you that in this case—if this were a picture of me playing golf, this would not be worth \$700, far less than that—and that it is pretty clear that people were buying this to get a picture of Tiger Woods.

I frequently get attacked when I speak on this subject because I think people have a knee-jerk reaction when they hear First Amendment. They say, "Oh, First Amendment—wave the flag."

And particularly in this case, where on the one hand you have the First Amendment, and on the other you have "greedy athletes who already make millions of dollars and why do they need a few more shekels from these pictures?" So if that's the dichotomy, the First Amendment versus greedy athletes, obviously you are going to get a lot of results-oriented jurisprudence.

But many of the attacks on the Tiger Woods position are really attacks on the right of publicity itself. If you accept for the moment, as reflected by the Supreme Court in decades of jurisprudence and now some statutes, that there is and should be a right of publicity, then the question is: where do you draw the line?<sup>46</sup>

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<sup>41</sup> See *id.* at 934 (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001)).

<sup>42</sup> *Id.* at 935.

<sup>43</sup> *Id.* at 934–36.

<sup>44</sup> See, e.g., *Comedy III Prods., Inc.*, 25 Cal. 4th 387.

<sup>45</sup> See *Jireh Publ'g II*, 332 F.3d at 936–38.

<sup>46</sup> See Michael Madow, Comment, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125 (1993).

My view, and the view of my clients on behalf of whom we submitted the brief—football players—is that this opens the door to complete elimination of the right of publicity. If the test is “Did it add anything beyond the picture itself?” which is how I interpret the Sixth Circuit decision, the threshold for deeming something an expressive work of art is considerably too low.<sup>47</sup> If the art adds any element beyond simply the picture, as I read this decision, you don’t have the right of publicity; you don’t have the right to stop it or get paid for it.<sup>48</sup>

The results could be absurd. Photography is artistic. If you want to take very artistic pictures of players and put them on trading cards, why can’t you do that? Why can’t you put the pictures on T-shirts? Why can’t I make Tiger Woods T-shirts if I do a drawing of Tiger Woods? And if courts aren’t allowed to assess the artistic merit—for example, by definition it’s art because I drew it, or I took a really nice photograph of Tiger Woods—you could argue that anything is a work of art, anything has artistic value, anything has a message, because you put a couple of things in the background or show how great the athlete is.<sup>49</sup>

If you have Michael Jordan taking a shot—and again, posters, statuettes, figurines, T-shirts, all of these things—all you would have to do is inject some arguably artistic element to it, which is not that hard to do, and according to the decision as I read it, the right of publicity doesn’t apply.<sup>50</sup>

That’s why I think the decision is wrong. It is, of course, only the law in one circuit. I am told by Dennis that there hasn’t been a petition for certiorari filed, so the Supreme Court won’t be hearing the *Tiger Woods* case.<sup>51</sup> Conceivably, it could come up in another

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<sup>47</sup> See *Jireh Publ’g II*, 332 F.3d at 936 (“The evidence in the record reveals that Rush’s work consists of much more than a mere literal likeness of Woods . . . . These elements in themselves are sufficient to bring Rush’s work within the protection of the First Amendment.”).

<sup>48</sup> *Id.*

<sup>49</sup> *See id.*

<sup>50</sup> *See id.*

<sup>51</sup> *Id.*

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case—perhaps the Bruce Meyer case—“please exploit me, please feel free to exploit me.”<sup>52</sup>

MR. PRINCIPE: He could probably get you \$850.

MR. MEYER: SFX I’m sure could get me more.

I think that covers it, given the timeframe, and I will reserve time for rebuttal after Dennis speaks.

MR. FERBER: Let me just pose one question to Bruce before we move on. We’re talking about the basics and the context of this case. As you discussed *Haelan* and the evolution of the publicity right, which of course did start from the right of privacy, it’s the notion of public person, private person, and it’s mostly something that is afforded to celebrities.<sup>53</sup> How famous do you have to be to be entitled to have a right of publicity you can enforce in court? Would it apply to minor league athletes, amateur athletes? Who is entitled to it?

MR. NIERMANN: I think there’s one case that talks about homeless people having a right of publicity.<sup>54</sup> I’m serious.

MR. MEYER: If somebody considers your image or likeness to be worthy of commercial exploitation, then by definition you are famous enough to have the right of publicity.<sup>55</sup>

MR. FERBER: How would it be distinguished, though? If you wind up seeing your name or image in a national magazine, how would we determine as lawyers whether that person would really be entitled to enforce a right to privacy violation or a right of

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<sup>52</sup> See *Outside the Lines: Athletes vs. Artists* (ESPN television broadcast, July 14, 2002) [hereinafter *Outside the Lines*], <http://216.239.39.104/search?q=cache:pww2mbiAH5-YJ:sports.espn.go.com/page2/tvlistings/show120transcript.html+leroy+neiman+lawsuit&hl=en> (last visited Feb. 17, 2005) (transcript of broadcast) (arguing that artists are exploiting the success of athletes such as Tiger Woods).

<sup>53</sup> See, e.g., *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

<sup>54</sup> See Laurel Kallen, Note, *Invading the “Homes” of the Homeless: Is Existing Right-of-Privacy/Publicity Legislation Adequate?*, 19 *CARDOZO ARTS & ENT. L.J.* 405 (2001) (discussing how the right of publicity generally does not apply to the homeless, yet suggesting that courts should provide protection or, in the alternative, consider other legal alternatives); see also Wes Daniels, “*Derelicts*,” *Recurring Misfortune, Economic Hard Times and Lifestyle Choices: Judicial Images of Homeless Litigants and Implications for Legal Advocates*, 45 *BUFF. L. REV.* 687, 691 (1997).

<sup>55</sup> See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

publicity, which I think has different damage calculations depending on which claim you're asserting?<sup>56</sup>

MR. MEYER: You might have both. They're not necessarily inconsistent.<sup>57</sup> In addition, there is a whole other category—things that are newsworthy or somehow are making political statements.<sup>58</sup>

Again, I wouldn't view this piece over here as newsworthy.<sup>59</sup> One question is: if you put Tiger Woods on the cover of *Sports Illustrated* do you have to pay him?<sup>60</sup> I would think that is distinguishable because it is reporting on a newsworthy event, which presumably just happened.<sup>61</sup>

From here, you can ask: What about framed pictures of John F. Kennedy? There have actually been some cases involving Martin Luther King and things like that.<sup>62</sup>

So there is a whole range of really interesting hypotheticals and variations you can run on this.

MR. FERBER: Dennis?

MR. NIERMANN: Thank you.

First of all, thanks to Mike Klein for asking me to come and speak.

I want to make a couple of comments. The keynote speaker mentioned that eighty percent of executives cheat at golf. I just told Mike, "As an avid golfer, if you want to find out about a person, just play eighteen holes of golf with him and you'll figure out whether they have integrity or not."

Another thing I learned about this case, about taking swipes—first, I was up against a small firm in Cleveland known as Jones, Day. That was at the district court level.<sup>63</sup> After practicing

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<sup>56</sup> See 2 MCCARTHY, *supra* note 6, § 28:6.

<sup>57</sup> See Lloyd L. Rich, *Right of Publicity*, at <http://www.publaw.com/rightpriv.html> (last visited Jan. 29, 2005).

<sup>58</sup> See *supra* notes 40–43.

<sup>59</sup> *The Masters of Augusta*, *supra* note 33.

<sup>60</sup> See *infra* note 279.

<sup>61</sup> See *id.*

<sup>62</sup> See *The Martin Luther King, Jr., Ctr. for Soc. Change, Inc., v. Am. Heritage Prods., Inc.*, 694 F.2d 674 (11th Cir. 1983).

<sup>63</sup> *Jireh Publ'g I*, 99 F. Supp. 2d 829 (N.D. Ohio 2000).

law for about eighteen years and having been a probation officer, I wasn't ready—I got suckered into what they call an *ad hominem*. I kept being swiped by the other lawyer in briefs, and finally I gave in and I swiped back, and the swipes went back and forth, until the district court judge, the last time I saw her, slammed her hands down and said, “Enough. You'll be sanctioned a thousand dollars if you don't cut it out.”

But now let's get to the case. “The Masters of Augusta”—which is not entitled “Tiger Woods of Augusta,” but “The Masters of Augusta”—we have just been told that it is not a newsworthy event. It depicts Tiger Woods winning the 1997 Masters, the youngest person to win it, the only minority African-American/Asian to win it.<sup>64</sup> He won it by the most strokes.<sup>65</sup>

When we take a look at this and ask ourselves “Does it deliver a message?”—take a look at the background.<sup>66</sup> On the left is Arnold Palmer, to the right of him is Sam Snead, to the right of him is Ben Hogan, to the right of him are Walter Hagen and Jack Nicklaus.<sup>67</sup> The only thing the Sixth Circuit got wrong was it said they were all former winners of The Masters.<sup>68</sup> They weren't.<sup>69</sup> Bobby Jones, who is pictured in the background, was not a winner; he created the event.<sup>70</sup>

Now, there is a significant difference between everybody in the background and Tiger Woods—he's the only minority.<sup>71</sup> And supposedly this isn't newsworthy and this isn't expression.

There is a whole line of Supreme Court cases cited in the Sixth Circuit decision that talk about two things.<sup>72</sup> The first is that just

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<sup>64</sup> *Id.* at 830.

<sup>65</sup> *Jireh Publ'g II*, 332 F.3d 915, 918 (6th Cir. 2003).

<sup>66</sup> *The Masters of Augusta*, *supra* note 33.

<sup>67</sup> *Id.*

<sup>68</sup> *Jireh Publ'g II*, 332 F.3d at 936.

<sup>69</sup> *Past Masters Winners*, at <http://espn.go.com/golfonline/masters00/almanac> (last visited Feb. 17, 2005).

<sup>70</sup> *Id.*

<sup>71</sup> *See The Masters of Augusta*, *supra* note 33.

<sup>72</sup> *Jireh Publ'g II*, 332 F.3d at 924 (citing *Simon & Schuster, Inc., v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991); *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 286–88 (1964); *First Nat'l Bank of Boston v. Bellotti*, 435 U.S. 765, 782 (1978)).

because the painting was copied and reproduced—and this applies equally to pictures, music, etc.—any type of expression is protected by the First Amendment.<sup>73</sup> In the *Cardtoons* case that was discussed earlier, the court observed that copies of expression do not lose their First Amendment protection because they are copies.<sup>74</sup> Otherwise—and we argued this in front of the Sixth Circuit—you would wind up having to read *The New York Times* in a museum. So to say that making copies or calling this a knockoff somehow takes away First Amendment protection or removes it from protection of the First Amendment is just dead wrong.<sup>75</sup>

Seldom, if ever, does a lawyer have the opportunity to argue a case against an esteemed panel like this having already won the case twice. And we would have liked to have this case go to the Supreme Court because we really thought we would win.

This case really typifies the fact that if you take paintbrushes from the artists, then you have to take pens from the writers and music from the singers. Where does that end?

One of the questions posed in the materials you got when you came in was: Can a money-making enterprise be an artistic enterprise? When you think about it, if you are on ESPN you are communicating. If you are LeRoy Neiman, Madonna, if you are doing the “Passion of Christ” or “War and Peace,” or Andy Warhol—all of that is expression.<sup>76</sup> *Time* magazine is expression, so is *Sports Illustrated*. It’s all expression, no different than this painting.

I want to talk a little bit about who the *amici* were.<sup>77</sup> They had four and we had five.<sup>78</sup> Numerosity didn’t carry the day, but I

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<sup>73</sup> *Id.*

<sup>74</sup> *Cardtoons, L.C. v. Major League Baseball Player’s Ass’n*, 95 F.3d 959, 968–70 (10th Cir. 1996).

<sup>75</sup> *See generally id.*

<sup>76</sup> *Cf. Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501–02 (1952) (“It cannot be doubted that motion pictures are a significant medium for the communication of ideas. They may affect public attitudes and behavior in a variety of ways, ranging from direct espousal of a political or social doctrine to the subtle shaping of thought which characterizes all artistic expression.”).

<sup>77</sup> *Amici Curiae Brief of the Reporters Committee for Freedom of the Press and the Society of Professional Journalists in Support of Defendant-Appellee, ETW Corp. v.*

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think it's interesting to see who lined up where. They had the National Football League Players' Association, and Bruce wrote that brief; they also had the Major League Baseball Players' Association.<sup>79</sup> I got these briefs one day at a time, and if you don't think there was a lot of fear going on inside of here, there was. The next day it was the Screen Actors Guild.<sup>80</sup> How do they make their money—by expression, right? The next day was Elvis Presley Enterprises & Associates—I thought, “Okay, all this is actually happening!”<sup>81</sup>

We had *The New York Times* and Time, Inc.<sup>82</sup> I want to tell a little story that is I think interesting. We got seventy-three independent law professors from across the country who teach either intellectual property law or constitutional/First Amendment law. How did we get them?

I was at home one day, middle of the case, kind of bored, and I typed into my computer “Tiger Woods lawsuit.” A lot of the hits were about Tiger Woods and not about the lawsuit. But out of sixty pages I got to page fifty-eight and I saw this little ellipses, and it said “Tiger Woods would be better off polishing his five iron than continuing on with this b.s. lawsuit . . . .” I thought, “Oh my God, I wonder what this is.”

It was a chat room of law professors. So I got all their email addresses, and when the case came out I did a blast email to all of them.

Diane Leenheer Zimmerman of New York University School of Law wrote that brief, and her student Adam Liptak, who at the time was counsel for *The New York Times*, wrote *The New York Times*' brief.<sup>83</sup>

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Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003) (No. 00-3584), <http://www.rcfp.org/news/documents/tigerwoods.html>.

<sup>78</sup> *Jireh Publ'g II*, 332 F.3d 915, 917 (6th Cir. 2003).

<sup>79</sup> *Id.*

<sup>80</sup> *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

My position is this: the only athlete image protection necessary is that athletes should be protected from the use of their image in the unauthorized advertising of products. That's it.

Tiger is not going to lose a thing—Tiger is just so big that he's not going to gain or lose a thing based upon this painting.<sup>84</sup>

I did one request for admissions in this case because I'm such a Tiger fan. The request for admission was: "Admit or deny that on the date this lawsuit was filed that Eldrick 'Tiger' Woods knew nothing about it." The answer was: "Objection: compound, convoluted. Without waiving the objection, admit."

So this case was not filed by Eldrick "Tiger" Woods; it was filed by the ETW Corporation—or as I like to call them, "Tiger's bean counters." They're trying to squeeze every dollar out, but they weren't able to in this case.<sup>85</sup> You have to ask yourself: Had they won, what would this do for artists across the country? There's a little bit of an imbalance.

I could talk about the *Three Stooges* case.<sup>86</sup> The *Three Stooges* case out of California, the one that talks about this transformative element, made the following findings and then ruled against the artist: "That reproductions"—read commercial knockoffs—"are equally entitled to protection as are original artworks,"<sup>87</sup> that "Gary Saderup's portraits are expressive works, not an advertisement for, or endorsement of, a product,"<sup>88</sup> that—referring to the Three Stooges on a T-shirt—that "expressive activity does not lose its constitutional protection because it is undertaken for profit,"<sup>89</sup> that "speech by public figures is accorded heightened First Amendment protection in defamation law,"<sup>90</sup> and that "expression taking the form of non-verbal, visual representation does not remove it from First Amendment protection."<sup>91</sup>

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<sup>84</sup> See Lisa DeCarlo, *Six Degrees of Tiger Woods* (Mar. 18, 2004), at [http://www.forbes.com/bbsbrands/2004/03/18/cx\\_ld\\_0318nike.html?partner=yahoo](http://www.forbes.com/bbsbrands/2004/03/18/cx_ld_0318nike.html?partner=yahoo).

<sup>85</sup> See *Jireh Publ'g II*, 332 F.3d at 937–38.

<sup>86</sup> *Comedy III Prods., Inc., v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001).

<sup>87</sup> *Id.* at 396.

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*

<sup>90</sup> *Id.* at 398.

<sup>91</sup> *Id.*

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And then, illogically, it jumps to the conclusion that it is going to set out this test where you have to have transformative elements versus copying, which sets up judges as art critics.<sup>92</sup>

And then it says: “But let’s take a look at Andy Warhol. Andy Warhol could have a picture of Marilyn Monroe and by distorting it slightly you could read that there was a transformative element, about social commentary on dehumanization of society.”<sup>93</sup> Now, one wonders what the result would be for a Campbell’s soup can but nonetheless.<sup>94</sup>

I’m going to stop here, but at some point I want to talk about—and I’m sure some of the other panelists will talk about—the supposed survey that was done.<sup>95</sup> They did a survey to determine whether there was customer confusion.<sup>96</sup> But I’ll save my remarks for later.

MR. FERBER: Dennis, I’d like to ask you something.

MR. NIERMANN: Sure.

MR. FERBER: I was rereading the decision again this week.<sup>97</sup> Just as it happened in the *Ginger Rogers* case here in New York,<sup>98</sup> which I was involved with many years ago, this was kind of a two-tiered attack.<sup>99</sup> It was based both in right of publicity, which is a matter of state law,<sup>100</sup> and there were claims based on the Lanham Act, the federal trademark and unfair competition statute.<sup>101</sup>

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<sup>92</sup> See *id.* at 404.

<sup>93</sup> *Id.* at 408–09.

<sup>94</sup> See *Cairns v. Franklin Mint Co.*, 107 F. Supp. 2d 1212, 1216 (C.D. Cal. 2000) (stating that because Warhol does not use the trademarked names or product designs to identify the source of the painting, his use does not imply endorsement of the artwork by either Campbell’s or Coca-Cola).

<sup>95</sup> See *infra* notes 221–222 and accompanying text.

<sup>96</sup> *Id.*

<sup>97</sup> *Jireh Publ’g II*, 332 F.3d 915 (6th Cir. 2003).

<sup>98</sup> *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

<sup>99</sup> *Jireh Publ’g II*, 332 F.3d 915.

<sup>100</sup> See *Rogers*, 875 F.2d at 1003–04. The District Court judge explains that the common law of Oregon, as interpreted in New York, “grants celebrities an exclusive right to control the commercial value of their names and to prevent others from exploiting them without permission.” *Id.* This right, however, is only applicable when the use of a celebrity’s name in a movie title is “wholly unrelated” to the movie or is “simply a disguised commercial advertisement for the sale of goods or services.” *Id.* Thus, the right

MR. NIERMANN: Right.

MR. FERBER: Could you say a few words about what happened with respect to the Lanham Act portion of Tiger's claim?

MR. NIERMANN: The trademark?

MR. FERBER: Right.

MR. NIERMANN: The Sixth Circuit mentions and we argued—it was in my brief, and I was very happy to see that the Sixth Circuit put it in their opinion; it's always nice to be copied—I said, "If Tiger had his way . . ."—they actually argued that every image of Tiger Woods was a trademark.<sup>102</sup> I said, "Hold on now. You can't be a walking, talking trademark. That's absurd."<sup>103</sup>

What's a trademark? What's a good example of an image of a trademark? If I put my hand out here and my foot back and there was a shadow, who do you think I'd be? Michael Jordan, right?<sup>104</sup> If you see two yellow things like this, any idea what that is? How about a mark like that [gesturing]—that's a Nike swoosh, right?<sup>105</sup>

In the Babe Ruth case, *Perone*,<sup>106</sup> one of Babe Ruth's daughters filed a lawsuit that was cited in the Sixth Circuit<sup>107</sup> and the district court opinion.<sup>108</sup> In that case, two daughters of Babe

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is rather restricted and allows filmmakers to avoid liability by showing any non-commercial relation between their film title and the name of a celebrity. *Id.*

<sup>101</sup> *Id.* The District Court judge discusses how the Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (codified as amended at 15 U.S.C. §§ 1051–1127 (2000)), affects a filmmaker's choice of a title for his film when that film involves the use of someone's name who has not given consent. The decision holds that the standard for constitutionality is somewhere between allowing any title "within the realm of artistic expression," *id.* at 997 (citing *Lloyd Corp. v. Tanner*, 407 U.S. 551, 556–57 (1972)), and allowing a title only when there are "no alternate avenues of communication." *Rogers*, 875 F.2d at 998–99. The court finally determines that the Act only applies "where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Id.* at 999.

<sup>102</sup> *Jireh Publ'g II*, 332 F.3d at 922.

<sup>103</sup> *Id.*

<sup>104</sup> See, e.g., *Michael Jordan - 1988 Slam Dunk Champion*, at <http://www.art.com/asp/sp.asp?PD=10035782&RFID=197750&TKID=1905979> (last visited Feb. 17, 2004).

<sup>105</sup> For a picture of the Nike Swoosh logo, see [http://www.sportkc.org/events-/images/nike\\_swoosh.jpg](http://www.sportkc.org/events-/images/nike_swoosh.jpg) (last visited Feb. 17, 2005).

<sup>106</sup> *Perone v. MacMillan, Inc.*, 894 F.2d 579 (2d Cir. 1990).

<sup>107</sup> *Jireh Publ'g II*, 332 F.3d at 922–23.

<sup>108</sup> *Jireh Publ'g I*, 99 F. Supp. 2d 829, 833 (N.D. Ohio 2000).

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Ruth filed a lawsuit saying his image was being misappropriated and it was a trademark.<sup>109</sup> The New York Appellate Court in *Perone* said: That's absurd.<sup>110</sup> You can't have every image of a person be a trademark.<sup>111</sup> It has to be repeatable.<sup>112</sup> All trademark does is show origin.<sup>113</sup>

The Sixth Circuit and the district court in this case found that there was nothing in connection with this artwork here that would lead anybody to believe that Tiger Woods endorsed it in any way, shape, or form.<sup>114</sup> When you get it, it says it's from Jireh Publishing.<sup>115</sup> Jireh is a Biblical term that means "God will provide," and apparently she has.

I guess that's the trademark answer.

MR. FERBER: For either Bruce or Dennis, the decision talks about an important legal concept that defense lawyers love to talk about in these contexts, the notion of fair use.<sup>116</sup> Could either of you address why the concept of fair use is important in this case?

MR. NIERMANN: Fair use was raised because ETW Corporation had a mark on the name "Tiger Woods" as used in art prints, etc.<sup>117</sup> Based on their registration, ETW argued that using that mark in connection with the painting was a trademark violation—but notice his name is not on the painting, but in the narrative instead.<sup>118</sup> There were 250 serigraphs—those are the

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<sup>109</sup> *Pirone*, 894 F.2d 579.

<sup>110</sup> *See id.* at 582.

<sup>111</sup> *Id.* (refusing to read *Pirone's* trademark on the words "Babe Ruth" as "to include every photograph of Ruth ever taken").

<sup>112</sup> *Id.* (stating that owners of a word trademark only receive protection against infringing use of a picture trademark when there is "a single pictorial representation used repeatedly as an indication of origin").

<sup>113</sup> *Id.* (citing *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126 (2d Cir. 1979)).

<sup>114</sup> *See Jireh Publ'g II*, 332 F.3d 915, 937 (6th Cir. 2003). Based on survey evidence, the court held that "at most . . . some members of the public would draw the incorrect inference that Woods had some connection with Rush's print." *Id.* The risk of misunderstanding though was "so outweighed by the interest in artistic expression as to preclude application of the [Lanham] Act." *Id.*

<sup>115</sup> *Id.* at 918–19.

<sup>116</sup> *Id.* at 920 (citing *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 319 (6th Cir. 2001)).

<sup>117</sup> *Id.* at 918.

<sup>118</sup> *Id.* at 920.

larger ones—and 5000 smaller ones.<sup>119</sup> The back label when you opened it up just said “Tiger Woods.”<sup>120</sup>

ETW tried to argue, “Aha! You used Tiger’s name. That’s a trademark violation.”<sup>121</sup>

The opinion said: “No, no, it’s a fair use because all fair use means is you have used the term to describe what it is.”<sup>122</sup> And so we were sustained at the district and circuit court levels on the fair use defense.<sup>123</sup>

MR. MEYER: As I mentioned too on the right of publicity side, the court looked to the *Three Stooges* case, which adopted this transformative approach essentially by analogy to fair use under copyright.<sup>124</sup>

MR. FERBER: Just one thing I want to say about that. Both Bruce and Ed, being New York practitioners, tell me if I’m wrong, because I was just thinking about this as you gentlemen were speaking.

I know that the transformative use has become a big topic of discussion analyzed in these cases since the Supreme Court had the *Pretty Woman* case.<sup>125</sup> But even before that, not referring to the concept of transformative use, the right of publicity has been a fairly fertile ground for litigation for forty years.<sup>126</sup>

I’m remembering a case that had nothing to do with discussing transformative use but still found for the defense in a case where, but for one small element, we would all, I think, be pretty shocked to see the plaintiff not prevail.

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<sup>119</sup> *Id.* at 919.

<sup>120</sup> *Id.* at 919.

<sup>121</sup> *Id.* at 920.

<sup>122</sup> *Id.* at 921.

<sup>123</sup> *Jireh Publ’g I*, 99 F. Supp. 2d 829, 834 (N.D. Ohio 2000).

<sup>124</sup> *Jireh Publ’g II*, 322 F.3d at 934–35 (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001)).

<sup>125</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

<sup>126</sup> See generally Douglas J. Ellis, Comment, *The Right of Publicity and the First Amendment: A Comment on Why Celebrity Parodies Are Fair Game for Fair Use*, 64 U. CIN. L. REV. 575 (1996).

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Many years ago, in the late 1960s, the Smothers Brothers had a weekly television show.<sup>127</sup> I don't know how many people in the audience remember that. There was a guy who came on frequently, a really sorry-looking guy, named Pat Paulson.<sup>128</sup> Do you remember that?

MR. NIERMANN: Yes. He ran for President, right?<sup>129</sup>

MR. FERBER: Exactly right. In 1968, Paulson had kind of a purely joke campaign "Pat Paulson for President."<sup>130</sup> Somebody put out posters. It was a poster that was nothing but, as I recall, a picture of Pat Paulson.<sup>131</sup>

Now, in any right of publicity analysis, I don't think anyone would disagree that if that's all you did was put out a picture of Pat Paulson and put "Pat Paulson" on the bottom, that would be a violation of Paulson's right of publicity. But they added the words "Paulson for President."<sup>132</sup> I'm pretty sure the defense won on that just because they added those words.<sup>133</sup> The court said it was not just a picture of Pat Paulson; some other thought, some other element was added.<sup>134</sup>

If you think about it, maybe that was laying the groundwork for this whole notion that if you have something more than a mere reproduction of the celebrity's name or likeness, there may be a defense here.<sup>135</sup>

MR. MEYER: Can I ask Dennis a question? I just want to confirm from your remarks—and, again, from what I thought reading the case—is your position that, under the Sixth Circuit

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<sup>127</sup> See *The Smothers Brothers*, at <http://www.worldhistory.com/wiki/T/The-Smothers-Brothers.htm> (last visited Feb. 17, 2005).

<sup>128</sup> See *Pat Answers*, at [http://www.nyla.org/index.php?page\\_id=749](http://www.nyla.org/index.php?page_id=749) (last modified Dec. 21, 2003).

<sup>129</sup> *Id.*

<sup>130</sup> *Id.*

<sup>131</sup> *Patrick L. Paulsen*, at <http://www.paulsen.com/book.jpeg> (last visited Feb. 17, 2005).

<sup>132</sup> See *id.*

<sup>133</sup> See *Paulsen v. Personality Posters, Inc.*, 299 N.Y.S.2d 501, 507–08 (N.Y. Sup. Ct. 1968).

<sup>134</sup> *Id.* at 507–08 (discussing the nature and value of the modified poster as "commentary").

<sup>135</sup> *Id.*

decision, basically you could do just about anything with an athlete's image: trading cards, bobblehead dolls, posters?<sup>136</sup> For example, I could go out and make Rolling Stones T-shirts, I could make a picture of the Rolling Stones and sell Rolling Stones T-shirts?<sup>137</sup> Is there any limit?

MR. NIERMANN: I'll tell you what I think the limit should be. I appreciate the question.

I've told some of the panelists that I'm a little conflicted as to who I am, and here's what I mean by that. I've been a plaintiffs' employment discrimination lawyer for about eighteen years before I got this case. When I got the decision from the district court and it said "judgment for defendant," I had to take it down the hall to another lawyer to have him interpret for me that we had prevailed, because, as a lawyer primarily for plaintiffs, I am so used to reading "judgment for defendant" as a loss.<sup>138</sup>

There are those who were on the defense side of this who would disagree with what I'm about to say. But one of the other lawyers on this case and I—and by that I mean Mike Murray, who used to be the President of the First Amendment Lawyers of the United States, and he did the *amicus* brief for the Media Photographers of America, people who go behind the ropes and take all the pictures<sup>139</sup>—in our discussion we came up with—and I think it's probably a good test—a use test. When you take a look at this painting over here, there's only one thing that's its essential use. I mean you could throw it on the floor and use as a newspaper for your dog, but that wouldn't be its essential use. Its essential use is for people who buy it or see it to take in the expression that it exudes, and that's it.

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<sup>136</sup> See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996) (discussing publicity rights with respect to trading cards). See generally *Jireh Publ'g II*, 332 F.3d 915 (6th Cir. 2003).

<sup>137</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 408 (2001) (discussing First Amendment rights of artist who created T-shirts with images of The Three Stooges); see also *supra* notes 41–43 and accompanying text.

<sup>138</sup> See *Jireh Publ'g I*, 99 F. Supp. 2d 829, 836 (N.D. Ohio 2000).

<sup>139</sup> See Marcia Chambers, *Artists vs. Icons, With Woods in Middle*, N.Y. TIMES, July 3, 2002, at D1.

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Now, if it is used to advertise golf clubs, American Express services, Buicks—hmm, why am I picking those?—then it is obviously a misrepresentation that Tiger is endorsing something.<sup>140</sup> This isn't about Tiger's endorsing it.<sup>141</sup>

If we were to write an unauthorized biography of Tiger Woods's life, there is no lawsuit in the world that could be brought that would be successful.<sup>142</sup> There would be complete and total First Amendment protection.<sup>143</sup>

One of the arguments that our opponents made in this case was that perhaps if Rick Rush wanted to express his joy in Tiger's accomplishment he could have used an alternative to the painting and he could have written a story.<sup>144</sup>

Mike Murray wrote in his brief: You know what? We've got a new saying now—a word is worth a thousand pictures.

MR. FERBER: I don't want to take any more time from the panelists, but I'm not sure I got a specific answer. I'm not sure. Trading cards, bobblehead dolls, posters?

MR. NIERMANN: It depends on what the use is.

MR. FERBER: I'm giving you examples of specific products.

MR. NIERMANN: What would you say the use of a bobblehead doll was?

MR. FERBER: I don't think it has any use other than to look at it and bobble the head.

MR. NIERMANN: No problem. If it's endorsing a product—

MR. FERBER: "No problem" meaning you don't have to pay the athlete to do a line of bobblehead dolls?

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<sup>140</sup> See *Jireh Publ'g II*, 332 F.3d 915, 925–26 (6th Cir. 2003); see also *Tiger Signs Deal With Accenture*, ORLANDO SENTINEL TRIB., Oct. 4, 2003, at D8 (“[Tiger] Woods has more than a dozen endorsements, the largest with Nike. They involve just about everything from cars (Buick) to financial services (American Express) to watches (Tag Heuer) to beverages (Asahi) to video games (EA Sports).”).

<sup>141</sup> See *Jireh Publ'g II*, 332 F.3d at 925–28.

<sup>142</sup> See Harriet Chiang, *Celebrities' Image Rights vs. First Amendment*, S.F. CHRON., May 13, 2003, at A1.

<sup>143</sup> See *id.*; see also *Jireh Publ'g II*, 332 F.3d at 930 (noting that the Second Restatement of Torts views the publishing of unauthorized biographies as generally protected).

<sup>144</sup> See *Jireh Publ'g II*, 332 F.3d at 927.

MR. NIERMANN: I don't think so, unless there's a use other than the expression.

MR. FERBER: T-shirts because you wear it?<sup>145</sup>

MR. NIERMANN: That's one where I'm somewhat uncertain. But does it make any difference that it's on a T-shirt? A T-shirt might keep you warm, so you might have an argument there.<sup>146</sup>

MR. FERBER: All right.

MR. PRINCIPE: This actually leads in perfectly to my discussion right now. Bruce, thank you for that humongous softball.

I'm going to discuss why from a client perspective, whether it's a client or an entertainer or just a celebrity, why when the right of publicity gets trumped it's extremely unsettling and what the potential negative ramifications of that could be.<sup>147</sup>

Really what's the harm? If the use is just for people to enjoy, how does that affect a client? Well, from a top-line perspective, it really can have a very chilling effect on that person's endorsement and marketing capabilities.<sup>148</sup> It creates an overexposure of the client at times.<sup>149</sup>

And also, from a different perspective, we work very hard as client managers to manicure and cultivate a client's image, their reputation, how they are perceived by the public.<sup>150</sup> Once you start losing control over how that person's image is disseminated in the public domain, you have the possibility for an absolute disaster.<sup>151</sup>

Before I get into how a client's endorsement possibilities are limited, let me just use an analogy that I commonly like to entertain when I'm discussing intellectual property.

I look at a person's intellectual property as a big pie. There are a host of different categories, products, which a client can

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<sup>145</sup> See *supra* notes 41–43, 137 and accompanying text.

<sup>146</sup> See *id.*

<sup>147</sup> See Bella English, *An All Out Blitz*, BOSTON GLOBE, Oct. 7, 2002, at D15 (detailing a football player's recent flood of endorsements).

<sup>148</sup> See *id.*

<sup>149</sup> See *id.*

<sup>150</sup> See Paul Farhi, *He Drives, He Putts, He Pitches*, WASH. POST, May 20, 1997, at A1.

<sup>151</sup> See *id.*

sell—whether it’s beverages, sneakers, fast food, pizza, you name it—and each piece of that pie is a valuable commodity.<sup>152</sup> We as a client manager want to keep as many of those pieces as possible.<sup>153</sup> We want to make sure when we do give a piece of that pie out it’s as valuable as possible.<sup>154</sup> We want to make it a true commodity.<sup>155</sup>

When the client’s image, his persona, is thrown out to the public without him controlling it, there is the potential that he will start to get overexposed and his pieces of the pie won’t become as valuable as they were because now everybody can see a piece of the pie.<sup>156</sup>

The reason why this can have a negative economic impact on the client is because an endorser is paying a certain amount of dollars for exclusivity.<sup>157</sup> They believe that their association with this client will produce positive effects in the consumer and they will be more likely to buy their product.<sup>158</sup> They want to be able to think: “When I think Tiger Woods, I want to think Buick.”<sup>159</sup>

Well, the more that Tiger Woods is thrown out, and the more that Tiger Woods—or any client—is perceived, the less value will be left to the current endorser.<sup>160</sup> So what happens when the current endorsement contract comes up and his value is diluted or

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<sup>152</sup> See *id.* (“Sports marketers say Woods’s next big score may be a fast-food, soft-drink or automotive company, the three most lucrative categories for celebrity endorsers after athletic-shoe companies.”).

<sup>153</sup> See *id.*

<sup>154</sup> See *id.* (noting Tiger Woods’s intent to be very careful about the endorsements he is willing to take on).

<sup>155</sup> See *id.*

<sup>156</sup> Cf. B. Zafer Erdogan et al., *Selecting Celebrity Endorsers: The Practitioner’s Perspective*, J. ADVERTISING RES., May 1, 2001, at 39 [hereinafter “Erdogan”].

<sup>157</sup> See *id.* (“Another important strategic issue is subsequent overexposure when a celebrity becomes an endorser for many diverse products and the relationship between the celebrity and a particular brand ceases to be distinctive. This may not only compromise the value of celebrities in the eyes of their fans but also make consumers overtly aware of the true nature of the endorsement . . . .”) (citations omitted).

<sup>158</sup> See Brian Anderson, *The Skinny on Brands*, WEARABLES BUS., Jan. 1, 2004, [http://www.findarticles.com/p/articles/mi\\_m0CXP/is\\_1\\_8/ai\\_111748059.html](http://www.findarticles.com/p/articles/mi_m0CXP/is_1_8/ai_111748059.html) (last visited Feb. 18, 2005) (discussing how marketing firms spend millions on, among other things, celebrity endorsements to “communicate . . . brand message to consumers”).

<sup>159</sup> See *id.*

<sup>160</sup> See Erdogan et al., *supra* note 156.

saturated?<sup>161</sup> You could maybe distribute 2000 of those serigraphs or daguerreotypes or whatever they are, and granted it might not have a true economic impact on him, but just the fact that he's getting overexposed, that is what is going to turn an endorser off.<sup>162</sup> So when that new endorsement contract comes up, the endorser is going to want a discount; they are not going to want to re-up at the same dollars.<sup>163</sup>

Future endorsers will be scared away from paying the big bucks if the athlete's picture or the celebrity's image is oversaturated.<sup>164</sup> They're not getting a limited number of eyeballs, not getting the close association between the product and the athlete.<sup>165</sup>

The other thing I want to talk about is the image, the persona. What if Tiger wants to cultivate the image of a real individual, of an independent spirit, or a guy who lives on his own, makes his own money, and is his own guy, and someone else tries to portray him as one who has usurped, is the new generation of golf, took over from the old masters . . . .

But he might not want this image. He might not think this is the image that he is trying to portray. So it's something which could have a significant impact on him.

When his image is out there in too many places, that could have a dilutive effect on the marketplace.<sup>166</sup> You want to make your pie as valuable as possible. You want to limit the slices.<sup>167</sup>

Rulings like this, when a right of publicity gets trumped, it gives away almost phantom slices of this pie.<sup>168</sup> It almost creates like a Krusty the Clown syndrome, where you endorse everything from a switchblade to broken glass or a cotton swab. This is a problem because you really want to make sure what you are endorsing is exactly the image that you want to put out.

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<sup>161</sup> *See id.*

<sup>162</sup> *See id.*

<sup>163</sup> *See id.*

<sup>164</sup> *See id.*

<sup>165</sup> *See id.*

<sup>166</sup> *See* Erdogan et al., *supra* note 156.

<sup>167</sup> *Id.*

<sup>168</sup> *See generally* Jireh Publ'g II, 332 F.3d 915 (6th Cir. 2003).

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Sometimes perception is reality and reality is perception. People might perceive Tiger to be doing one thing when he wants the complete opposite image.

One other thing I want to talk about, just briefly, is how I think the courts have to evolve to where we are from a societal perspective.

The *Ginger Rogers* case,<sup>169</sup> which Tom mentioned, which I heard was excellently argued—

MR. FERBER: It was brilliantly argued by the defense.

MR. PRINCIPE: Brilliantly, brilliantly.

It actually says, if I understand it correctly, that the confusion test, the likelihood of confusion, will never trump a First Amendment right.<sup>170</sup> Well, I think where we are today, with the prevalence of branding and naming rights, where everything is branded right now, there is such a close association to branding and endorsement—New York City is branding itself, high schools are branding themselves . . .<sup>171</sup> Every time you see a bottle of water in a movie or a car in a TV show, it's there because of product placement.<sup>172</sup>

We'll get into the survey a little bit, because I know Dennis wanted to mention it. But I don't think the survey was overbroad—and I'm sure we'll talk about it.<sup>173</sup> Was there an affiliation between Tiger Woods and the painting? Where we are now, I think that's a very reasonable assumption.<sup>174</sup> I think when

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<sup>169</sup> See *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

<sup>170</sup> *Id.* at 999 (“[T]he [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has not artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source of the content of the work.”).

<sup>171</sup> See, e.g., Logan Mabe, *Pepsi High*, ST. PETERSBURG TIMES, Aug. 31, 2003, at [http://www.sptimes.com/2003/08/31/Perspective/Pepsi\\_high.shtml](http://www.sptimes.com/2003/08/31/Perspective/Pepsi_high.shtml); see also Ontario Secondary Sch. Teachers' Fed'n, *Commercialization in our Schools*, at <http://www.osstf.on.ca/www/abosstf/ampa01/commercialization/commercinschools.html> (last visited Feb. 9, 2005) (offering a critical analysis of commercialization in schools).

<sup>172</sup> See, e.g., Mabe, *supra* note 171.

<sup>173</sup> See *infra* notes 221–225.

<sup>174</sup> See *Outside the Lines*, *supra* note 52.

you see a can of Coke—I guess it started in “E.T.” with Reese’s Pieces, right?—it’s there for a reason.<sup>175</sup>

That so seeps into our brain that the courts might want to take a different perspective of this, and say “What is the likelihood of confusion to the consumer?”—that tension between the right of publicity and the First Amendment? I think the right of publicity for the client has to be upheld because also it tends to limit the likelihood of confusion, which I think is a very valid public interest.<sup>176</sup>

I just want to make one more point. Sorry about this. There is a lot of talk: “Oh, Tiger Woods or athletes do so well on the court, this is just peanuts.<sup>177</sup> He didn’t even know this lawsuit was going to happen. How is this really affecting his net worth? How is it affecting his value?”

I don’t care, to be honest with you. This is America. We live in a very capitalistic society. That’s one of the basic tenets of how we live. I think a person should really have the right to exploit himself or herself to the greatest extent of their abilities. Just because someone is making a lot of money on the field or on the court or on the screen doesn’t mean they shouldn’t be limited from making a lot of money off it.

Dennis, that’s basically where I am with this thing. That’s why I think this ruling can have a negative impact on a slippery slope.

MR. NIERMANN: Just one little response.

We ran into this all throughout the case. What I’m hearing is, “Tiger gets to be a capitalist—the artist does not.”<sup>178</sup>

MR. PRINCIPE: I’m not saying that at all. I’m saying any artist can be a capitalist. But if you want to use my person to make yourself money, it’s like *Goodfellas*—“Pay me, pay me.”<sup>179</sup> or “Show me the money!”<sup>180</sup>

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<sup>175</sup> See *infra* notes 221–225.

<sup>176</sup> *Id.*

<sup>177</sup> See, e.g., Dana Castillo et al., *40 under 40*, FORTUNE, Sept. 20, 2004, at 134 (estimating Woods’s net worth at \$295 million).

<sup>178</sup> See *infra* notes 204–207 and accompanying text.

<sup>179</sup> GOODFELLAS (Warner Studios 1990).

<sup>180</sup> See JERRY MAGUIRE (Columbia/Tristar Home Studios 1996).

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MR. NIERMANN: You create the art, you sell the art. Our opponents want to limit it to one piece.<sup>181</sup>

MR. PRINCIPE: I didn't say that, by the way.

MR. KELMAN: Under your theory, Dennis, a record pirate also could be an entrepreneur and somebody who feels he has the right to make money, even though he's copying somebody else's property. That to me—and I hate to use the word—is theft, just like the other is theft.

I follow along with Mike's concept here, that Tiger Woods had a right to this.

With a lot of the companies that I deal with in my practice over the years, almost every type of agreement in entertainment, media, sports, whatever, always asks for a grant of name and likeness rights.

Some of this is a bit overblown. I'll just read you a little bit here, where the company, meaning the third party, asks for "the exclusive perpetual right without liability to any party to use, or to authorize use of, artist's name and biographical material, and the names, including professional names, heretofore or hereafter adopted, and any approved likenesses"—that approval is negotiated—"whether or not current, including approved photographs, portraits, caricatures, and stills from any pictures made hereunder; autographs, including facsimile signatures; and biographical material relating to artist," etc., "for purposes of promotion, trade," and all other things.

Why would they ask for that if they felt they could do what you are doing? This runs throughout the course of all these agreements. And a lot of it has to do almost entirely with leverage. The practitioner's job representing talent, whether it's athletes or artists or songwriters or book writers or on-air personalities, has to be to try to limit this grant of name and likeness for the purposes of also carving up that person's rights. For example, the practitioner must limit them to certain things so that they can do other things with other people, limiting the term of the grant so you don't give a right to a record company in perpetuity when the agreement is only

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<sup>181</sup> *Jireh Publ'g II*, 332 F.3d 915 (6th Cir. 2003).

five years, and then if you go and make a deal with another record company afterwards you have no name and likeness rights to grant them.

So it's a very carefully negotiated provision, especially in the sports world, where you are dealing with products, services, promotion, cross-promotion, merchandising of various items, appearances, all these things.<sup>182</sup> These are things that really should be under the control of the person who owns that right, and in that case it's the talent.<sup>183</sup>

I don't want to give a bad name to your client, but it doesn't belong to your client, it doesn't belong to the pirate and it doesn't belong to the student in college who is doing P2P file sharing.<sup>184</sup> It belongs to the people who own the property.<sup>185</sup> From my perspective, that would have been, in this case, Tiger Woods.

The court saw otherwise.<sup>186</sup> Following from the grant of rights in these agreements—and this is not the main right that is granted; it's a right that is granted along with the right of a certain thing. For instance, in the recording industry you are granting exclusive rights to record master recordings to the record company.<sup>187</sup> For CBS Television—and I have a similar grant from them—it's to appear on a certain show at a certain time and do promotions for that show, or whatever.<sup>188</sup> It could be in golf an endorsement contract for an item where you have to do appearances and

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<sup>182</sup> See *infra* note 259.

<sup>183</sup> But see *Jireh Publ'g II*, 332 F.3d 915.

<sup>184</sup> "P2P" means Peer-to-Peer and is enabled by services such as the original Napster whereby users share material on their own computers with other users using the network. See *MGM Studios, Inc. v. Grokster Ltd.*, 380 F.3d 1154, 1158–60 (9th Cir. 2004) (general discussion of P2P mechanics).

<sup>185</sup> See *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001) [hereinafter *Napster*] (holding defendant liable for contributory and vicarious copyright infringement for, *inter alia*, knowingly providing central premises by which users could trade copyrighted files).

<sup>186</sup> *Jireh Publ'g II*, 332 F.3d 915.

<sup>187</sup> See, e.g., *Example Recording Contract*, at [http://www.vocalist.org.uk/recording\\_contract.html](http://www.vocalist.org.uk/recording_contract.html) (last visited Feb. 18, 2005).

<sup>188</sup> *Cf. id.*

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promote the product and get a royalty based on sales.<sup>189</sup> Those rights belong to the talent.<sup>190</sup>

I don't think that any entity has the right to just go out and do it on their own, and in this case clearly on a commercial basis: making copies, distributing it, and making money, without paying the artist his share.<sup>191</sup>

We're not in a Robin Hood society, as Mike said, in this type of industry. Just because somebody is making money, that doesn't mean that they are not entitled to more.

And the same with piracy. You know, some students feel that the record companies are fat cats, or Madonna is a fat cat, and as a result they can take what they want. It's not the way I feel it should be.

Dealing with a name and likeness right, can be separate and apart from the royalty for the overall deal, depending upon how important it is in conjunction with the overall grant. For example, a book, let's say, matches an album. An artist can get 5 or 10 percent of the retail selling price of that book based on the fact that their picture, their image, their likeness, is used on the cover of that book.

In sports, it depends upon the nature of the deal.<sup>192</sup> It could be an endorsement where they get a royalty.<sup>193</sup> It could be an appearance where they get paid for showing up.<sup>194</sup> And the same thing with merchandising of T-shirts and posters and all kinds of things with rock bands on tour, or items being sold at retail—there are royalties paid for that.<sup>195</sup> That's the way the business works.

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<sup>189</sup> See Lien Verbauwheide, *Savvy Marketing: Merchandising of Intellectual Property Rights*, at <http://www.wipo.int/sme/en/documents/merchandising.htm> (last visited Feb. 18, 2005).

<sup>190</sup> See *id.*

<sup>191</sup> See *Jireh Publ'g II*, 332 F.3d at 918.

<sup>192</sup> See, e.g., Michael McCarthy, *Win or Lose, Drawing Endorsements is Key*, USA TODAY, Aug. 21, 2003, available at [http://www.usatoday.com/money/advertising/2003-08-21-endorse\\_x.htm](http://www.usatoday.com/money/advertising/2003-08-21-endorse_x.htm).

<sup>193</sup> See *id.*

<sup>194</sup> See *id.*

<sup>195</sup> See Christopher Knab, *Income and Expense for Developing Your Music Career* (Jan. 2003), at <http://www.musicbizacademy.com/knab/articles/incomeexp.htm> (including merchandising royalties as a portion of a musician or band's source of income).

To me, any other way to go, that's not business, that's stealing.

MR. FERBER: Ed, I've got a question for you. Entertainment entities—whether it's cable television, film studios, network television—are constantly looking for more subject matter, so they frequently produce programming based on real life or biographical kind of things—stories that are familiar to people, that they might want to hear more about on prime time during the week.

So they will say they want to do a life story of a famous person—Magic Johnson's battle with HIV,<sup>196</sup> Roger Clemens's pursuit of 300 wins,<sup>197</sup> Mariano Rivera's climb from the streets of Panama, being barefoot and playing with a cardboard box as a glove, to being the greatest reliever in baseball history, etc.<sup>198</sup>

What if they go to that person and the athlete says, "Okay, I'm going to cooperate with you. I will give you my exclusive life story rights to do this film." Is that enforceable? What's the value of that deal?

MR. KELMAN: To the production entity?

MR. FERBER: Yes.

MR. KELMAN: They get that cooperation, they get additional information, they get additional pictures, they get this person who sometimes is there on the set, working with the writers, and all this kind of thing over a period of time.<sup>199</sup> It also precludes that person from doing the same thing for somebody else.<sup>200</sup>

MR. FERBER: Does it preclude someone else from doing it just because the athlete has intended to give exclusive life story rights to that production entity?

MR. KELMAN: Probably not.

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<sup>196</sup> See *Earvin Magic Johnson HIV Events*, at <http://www.magicandhiv.com> (last visited Feb. 18, 2005).

<sup>197</sup> See New York Yankees History, *Rocket Reaches Major Milestone* (2004), at <http://mlb.mlb.com/NASApp/mlb/mlb/events/clemens300/index.jsp> (last visited Feb. 18, 2005).

<sup>198</sup> See *Mariano Rivera*, at [http://www.baseballlibrary.com/baseballlibrary/ballplayers-R/Rivera\\_Mariano.stm](http://www.baseballlibrary.com/baseballlibrary/ballplayers-R/Rivera_Mariano.stm) (last visited Feb. 18, 2005).

<sup>199</sup> See *supra* note 187.

<sup>200</sup> *Id.*

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MR. MEYER: I just want to make a point, actually to repeat a point I made before, which is a lot of the philosophical argument to me is not really over this legal point that was addressed in the *Tiger Woods* decision,<sup>201</sup> it's really over should there be a right of publicity.

And again, that's not really the issue. I mean, there is a right of publicity.<sup>202</sup> This is not controversial.<sup>203</sup> This is not something that we made up. The courts have recognized, and the statutes have recognized, there is a right of publicity.<sup>204</sup> The athletes do have a property right in their name, likeness, and image.<sup>205</sup> Again, that is not controversial. That exists. They have the right to be paid for it.<sup>206</sup>

Instead, issue in this case is: to what extent is that recognized property right trumped by a countervailing First Amendment right to do this kind of product?<sup>207</sup>

Again, I agree obviously with Ed. But Ed's position that this kind of commercial exploitation, this value, belongs to the artist or the celebrity or the athlete—again that is not controversial.<sup>208</sup> I think even the Sixth Circuit decision doesn't challenge that.<sup>209</sup>

The question here is: because of the nature of this particular usage, because it's either a work or art or conveys some message, does this usage trump that right?<sup>210</sup> But the existence of the right is well established.<sup>211</sup>

MR. KELMAN: In reading some of the language in this name and likeness grant, when they're talking about caricatures, likenesses—that's a likeness, it's a caricature to him to a point, in

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<sup>201</sup> See generally *Jireh Publ'g II*, 322 F.3d 915 (6th Cir. 2003).

<sup>202</sup> 1 MCCARTHY, *supra* note 6, §§ 1:1–1:20.

<sup>203</sup> *Id.*

<sup>204</sup> *Id.*

<sup>205</sup> 18 AM. JUR. 2D *Copyright and Literary Property* § 49 (2004).

<sup>206</sup> *Id.*

<sup>207</sup> See *Jireh Publ'g II*, 322 F.3d 915, 932 (6th Cir. 2003).

<sup>208</sup> See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

<sup>209</sup> *Jireh Publ'g II*, 322 F.3d 915.

<sup>210</sup> *Id.* at 932.

<sup>211</sup> 1 MCCARTHY, *supra* note 6, §§ 1:1–1:20.

that it's not a photograph.<sup>212</sup> It is being used to make money for the person other than Tiger Woods.<sup>213</sup>

The bobblehead doll question is really very good. I know people who have done those deals. There is a royalty paid to those people, even though a bobblehead doll is a work of art.<sup>214</sup>

MR. NIERMANN: We're not talking about bobblehead dolls here.

MR. KELMAN: The *LeRoy Neiman* case was based on royalties.<sup>215</sup>

MR. NIERMANN: And congratulations to him. That's fine. He's got that option.

But what we're saying here is that we want athletes and celebrities to be able to control the First Amendment.<sup>216</sup>

MR. KELMAN: No, not at all.

MR. NIERMANN: Hold on.

Tiger doesn't like that picture, so he gets to say, "Well, I'm in it and I don't like it, so you can't do it."<sup>217</sup> This is the United States. We've got a First Amendment.<sup>218</sup> If this was the *New York Times* writing an article, there's no difference between that article being written and this painting being painted. It's all expression, beginning and end.

But I do need to flip over to one thing that Mike said, because he was talking about customer confusion.<sup>219</sup> Customer confusion is an analysis, I learned, that is done once a trademark is

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<sup>212</sup> See *The Masters of Augusta*, *supra* note 33.

<sup>213</sup> See *supra* note 35.

<sup>214</sup> See, e.g., Stephen Hudak, *Bobblehead Settlement Gets Nod*, CLEVELAND PLAIN DEALER, Aug. 3, 2004, at B1.

<sup>215</sup> LeRoy Neiman is a world-renowned sports artist, whose subjects include Mark McGwire, Michael Jordan, Muhammad Ali, among many others. See <http://www.leroyneiman.com> (last visited Feb. 18, 2005). Mr. Neiman believes his subjects deserve royalties from the works he produces. See *Outside the Lines*, *supra* note 52.

<sup>216</sup> *Jireh Publ'g II*, 332 F.3d 915 (6th Cir. 2003).

<sup>217</sup> See *id.*

<sup>218</sup> U.S. CONST. amend. I (holding in relevant part that Congress shall make no law abridging the freedom of speech).

<sup>219</sup> See *supra* note 170 and accompanying text.

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established, and Judge Gaughan correctly ruled in this case: No trademark, no customer confusion analysis.<sup>220</sup>

But a survey was done.<sup>221</sup> I want to just point a couple of things out about that survey.<sup>222</sup> It was conducted in St. Louis. It was conducted at a shopping mall. It was not conducted in an art store. It was not conducted in a sports art store.

People were walking through the mall, like any mall you've ever been to, and they were shown this painting. They were not shown the write-up that's in the lower right-hand corner that you see there, which you can read on the way out. They weren't shown that.

They were asked the following question by a man named Dr. Block: "Was Tiger Woods affiliated with, or connected to, or had he given approval to, or had he sponsored the Masters of Augusta?"

When I deposed this guy, I said, "Which question, which of these four, was he answering?"

"Oh, I don't know." Now, 62 percent of the people said "yes." He didn't know to what, but 62 percent said "yes."

My question is: Why didn't 100 percent say "yes?" Is Tiger Woods connected with it? Of course he's connected with it!

But I then did some further analysis and I punched in on Lexis the name of Dr. Carl Block, and found three other cases.<sup>223</sup>

The first one was *Winning Ways, Inc. v. Holloway Sportswear, Inc.*,<sup>224</sup> where the court wrote: "Dr. Block's failure to survey customers at sporting goods stores extinguishes the probative value of the survey engaging the perceptions of consumers in this

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<sup>220</sup> See *Jireh Publ'g I*, 99 F. Supp. 2d 829, 832 (N.D. Ohio 2000).

<sup>221</sup> See *Jireh Publ'g II*, 332 F.3d at 921.

<sup>222</sup> See *id.*

<sup>223</sup> Dr. Block is the President and CEO of Marketeam Associates, a national marketing and research firm. Dr. Block characterized the survey as "one of the highest incidences of confusion that Marketeam has ever recorded in such surveys regarding whether or not a likelihood of confusion exists in a trademark dispute." *Id.* at 942.

<sup>224</sup> 913 F. Supp. 1454 (D. Kan. 1997).

market. A survey should sample ‘the full range of potential consumers for whom plaintiff and defendants’ compete.’<sup>225</sup>

Case two, *R.J. Corr Naturals, Inc. v. Coca-Cola Co.*,<sup>226</sup> “Dr. Block’s survey was fatally flawed by the alteration of the stimulus shown to the respondents . . . . [H]e cropped the ad, rendering it an inaccurate replication.”<sup>227</sup>

Third, *Simon Property Group L.P. v. MySimon, Inc.*,<sup>228</sup> “Dr. Block has proposed surveys that are merely transparent paths to a desired but artificial result, one driven by leading and suggestive questions, distortions of customer [consumer] experiences.”<sup>229</sup>

I wish they would have tried to put him on in a *Daubert* hearing.<sup>230</sup> He would have been toast.

MR. FERBER: He would have been toast.

By the way, I just want to clarify something for the audience. There were different legal theories asserted on behalf of ETW in the *Tiger Woods* case.<sup>231</sup> The two most important we have referred to here, but it’s important that you realize they are two different legal theories: (1) the right of publicity, which exists in some jurisdictions by statute, in some by common law—this was Ohio and it was common law; and (2) the false endorsement claim.<sup>232</sup> Mike talked about the notion of people thinking it is an endorsement.<sup>233</sup> That is as much, if not more, a Lanham Act claim under Section 43, false endorsement.<sup>234</sup> The survey on

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<sup>225</sup> *Id.* at 1467 (quoting *Am. Home Prods. Corp. v. Barr Lab.*, 656 F. Supp. 1058 (D.N.J.), *aff’d*, 834 F.2d 368 (3d Cir. 1987)).

<sup>226</sup> No. 97 C 1059, 1997 U.S. Dist. LEXIS 6020 (N.D. Ill. Apr. 23, 1997).

<sup>227</sup> *Id.* at \*15.

<sup>228</sup> 104 F. Supp. 2d 1033 (S.D. Ind. 2000).

<sup>229</sup> *Id.* at 1052.

<sup>230</sup> *See Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579 (1993) (establishing the standard for the admissibility of scientific evidence and testimony in federal court and the many state and local jurisdictions which have adopted its test).

<sup>231</sup> *See Jireh Publ’g II*, 332 F.3d 915 (6th Cir. 2003).

<sup>232</sup> *See id.* at 919.

<sup>233</sup> *See supra* notes 147–159 and accompanying text.

<sup>234</sup> *See Jireh Publ’g II*, 332 F.3d at 924; *see also* 15 U.S.C. § 1125(a) (2000) (listing the elements of a Lanham Act false endorsement claim).

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confusion—confusion is relevant to the Lanham claim, not really relevant to the publicity claim.<sup>235</sup>

And by the way, that’s a lousy survey for a number of reasons. One of them is that—since a survey is technically hearsay, you have to be very careful about how you conduct it if you expect a federal judge to let it in.<sup>236</sup>

I don’t think they should have been starting every question, or this one compound question, with the name Tiger Woods. You leave it as a blank question and say, “Do you think this was endorsed by someone? If so, by whom? Do you think it was authorized by someone? If so, by whom? Do you think someone was paid for it? If so, by whom?”

MR. NIERMANN: Or separate questions.

MR. FERBER: You don’t start off putting Tiger Woods’s name in the respondent’s head, in my opinion.

MR. PRINCIPE: I’d like to go back to a point that Dennis touched on. He said, “Well, athletes want to do away with the First Amendment.” Not at all.

Will artists basically not engage in any sort of art whatsoever unless they are going to get 100 percent of the fees generated from that, regardless of the situation? Is that what artists are saying?

Athletes aren’t saying: “We don’t believe in the First Amendment right.” They’re saying: “Paint whatever you want to paint. If it’s a newsworthy event, it’s a newsworthy event. But if you are going to use me in it in a way to make yourself

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<sup>235</sup> *See id.* “False endorsement occurs when a celebrity’s identity is connected with a product or service in such a way that consumers are likely to be misled about the celebrity’s sponsorship or approval of the product or service.” *Id.* at 925–26. Therefore, the survey is relevant to the question of whether the consumer is likely to be confused by defendant’s conduct. On the other hand, “[t]he right of publicity is . . . an outgrowth of the right of privacy.” *Id.* at 928. Therefore, the question becomes one of balancing the right of publicity and the right of freedom of expression under the First Amendment. *See id.* at 931. The survey, designed to assess confusion, does not directly address these conflicting rights.

<sup>236</sup> *See generally* FED. R. EVID. 407.

money”—and I know commercial speech is protected—“I want to be able to participate in that.”<sup>237</sup>

I don’t see how that is retarding First Amendment rights whatsoever. In fact, it could even enhance the First Amendment right of expression.<sup>238</sup> When you have a client’s willing participation—I think this is one of the reasons why LeRoy Neiman gives a piece back to the athlete or his subject—they are going to be engaged in the process, they are going to, hopefully, make the piece of art a better piece of art, more expressive, and more beneficial to society.<sup>239</sup>

When you’re doing an unauthorized piece of work, you are not getting the athlete’s cooperation, you are not going to know if they played with a cardboard glove back in the streets of Panama. The image will not be as accurate.

So we are not doing away with the First Amendment right whatsoever—we just want to participate if you are going to use us. And I think that we can enhance the First Amendment right by our participation.

MR. MEYER: As I said at the beginning, it’s all well and good to wave the First Amendment flag, because who doesn’t like the First Amendment? The First Amendment is wonderful. But we don’t live in an absolute First Amendment free speech world.<sup>240</sup> That’s not the law.<sup>241</sup>

We have this thing called intellectual property, the copyright laws. You cannot do per se anything you want. We are not talking about political speech here or anything like that.<sup>242</sup> Just from a commercial standpoint, we don’t live in the world that Dennis has

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<sup>237</sup> See, e.g., *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748 (1976) (holding that speech does not lose its First Amendment protection even if it is carried in a form that is sold for profit).

<sup>238</sup> See *id.*

<sup>239</sup> In an interview with ESPN’s Jeremy Schapp, Neiman said: “I think that anybody should get a percentage. I think one of the percentage of the original, and if I did it of an athlete or something, what’s the difference? Give them a percentage; give them a two-percent, three-percent, whatever they ask for.” See *Outside the Lines*, *supra* note 52.

<sup>240</sup> See, e.g., *Brandenburg v. Ohio*, 395 U.S. 444 (1969) (holding that speech causing incitement to imminent unlawful action is not protected by the First Amendment).

<sup>241</sup> See *id.*

<sup>242</sup> See *Buckley v. Valeo*, 424 U.S. 1, 14–15 (1976).

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posited, I think, where, “Hey, it’s a free country; you can say whatever you want.”<sup>243</sup>

I can’t go out and sell my own copy of—I don’t know, pick something.

MR. NIERMANN: *The Da Vinci Code*.<sup>244</sup>

MR. MEYER: I can’t go out and write *The Da Vinci Code* and sell it, or change a few words in it and say, “Hey, it’s a free country.”<sup>245</sup>

MR. NIERMANN: You are copying then.<sup>246</sup> This was a creation. This wasn’t a copy.<sup>247</sup>

MR. MEYER: I’m making a different point, which is just that intellectual property rights, like copyright, limit people’s right to do and say whatever they want.<sup>248</sup> The right of publicity is another—

PARTICIPANT: That is not the issue.

MR. MEYER: I’d appreciate it if you wouldn’t interrupt me.

MR. FERBER: I did want to cover one thing that is particularly important with respect to publicity rights as it affects athletes. I suspect that both Bruce and Mike are very well versed in this.

In professional sports, most athletes belong to players’ associations.<sup>249</sup> There is value, as Mike was just pointing out, in terms of the pie, in all different sorts of uses of the name and likeness of the athlete.<sup>250</sup>

I wonder if either or both of you gentlemen could address what licensing rights are retained by the athlete who belongs to one of

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<sup>243</sup> See *supra* note 73.

<sup>244</sup> DAN BROWN, *THE DA VINCI CODE* (Doubleday 2003).

<sup>245</sup> See *generally* 17 U.S.C. §§ 106–22 (2002).

<sup>246</sup> See 17 U.S.C. § 106(1) (2002).

<sup>247</sup> See *Jireh Publ’g II*, 332 F.3d 915, 918 (6th Cir. 2003).

<sup>248</sup> See, e.g., Tina J. Ham, Note, *The Right of Publicity: Finding a Balance in the Fair Use Doctrine—Hoffman v. Capital Cities/ABC, Inc.*, 36 U.C. DAVIS L. REV. 543, 549–51 (2003).

<sup>249</sup> See, e.g., NFL Players Ass’n (“NFLPA”), at <http://www.nflpa.org> (last visited Feb. 18, 2005); NHL Players’ Ass’n, at <http://www.nhlpa.com> (last visited Feb. 18, 2005).

<sup>250</sup> See *supra* notes 182–199 and accompanying text.

the major league players' associations, and what rights are given to the association and no longer controlled by the athlete?<sup>251</sup>

MR. KELMAN: And the teams. The teams have certain rights also.

MR. FERBER: That's correct.

MR. MEYER: Actually the best person to answer this is in the crowd. We have several lawyers with the MLB Players' Association. Over the years I have done cases involving this as well.

Generally, as I mentioned, the individual athletes in team sports retain the right to do individual deals however they want—total freedom to do that.<sup>252</sup>

On a group basis, though, the rights are generally given to the players' associations to license.<sup>253</sup> There are variations to some extent—the athlete has the right to opt out, sometimes not—but the individual athlete can still do any kind of deal that they want.<sup>254</sup>

For things like trading cards, video games, posters, those kinds of things, it is more efficient economically for it to be done as a group because obviously if you are a trading card company, it is not efficient to go out and individually sign up each player to do one trading card. So you go to one place, the players' association, which has the right to give licenses on a group basis.<sup>255</sup> Group basis is defined differently in different players' associations.<sup>256</sup> In football it's six or more players.<sup>257</sup> So that's generally how it works.

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<sup>251</sup> See Jon Morgan, *New Playbook Works for Union*, BALT. SUN, Jan. 25, 2003, at 1C.

<sup>252</sup> See, e.g., *Collective Bargaining Agreement*, at <http://www.nflpa.org/Media-main.asp?subPage=CBA+Complete> (last visited Feb. 18, 2005).

<sup>253</sup> See *id.* (requiring approval by the NFLPA for licensing agreements involving six or more NFL players); *Frequently Asked Questions*, at <http://bigleaguers.yahoo.com/mlbpa/faq> (last visited Feb. 18, 2005) (stating that “any company seeking to use the names or likenesses of more than two Major League baseball players in connection with a commercial product, product line or promotion must sign a licensing agreement with the MLBPA.”).

<sup>254</sup> See, e.g., Morgan, *supra* note 251 (“Members are free to make their own endorsement deals, hawking car dealers or mortgage brokers.”).

<sup>255</sup> *Id.*

<sup>256</sup> *Id.*

<sup>257</sup> *Id.*

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MR. FERBER: Baseball is how much?

MR. MEYER: Three.<sup>258</sup>

MR. FERBER: So does that mean that if a player is a member of the players' association, that whatever the threshold is for group pictures, he has given it away to the players' association exclusively to license it? Or is it nonexclusive, is it concurrent; does he keep that right too and the players' association has it?

MR. MEYER: Generally it's exclusive.

PARTICIPANT: Ours is exclusive. If six players individually went out and wanted to license to the same person, they can't do it.<sup>259</sup> We have had situations where the corporate entity will say, "But I got the rights from these six players," and you say, "But they don't have them to give."<sup>260</sup>

MR. MEYER: Right. Generally it is exclusive.

MR. KELMAN: Do you have to go back to the team to get the right for them to use the uniform?

PARTICIPANT: We don't, but the—

MR. KELMAN: The advertiser does?

MR. MEYER: Logos, uniforms, colors—those are owned by the leagues.<sup>261</sup> Generally, you get a joint license. If you want to do trading cards, you go to the league and—in basketball, just as a matter of negotiation, the NBA has both rights.<sup>262</sup> They have been assigned the player rights by the players' association, so there is, "one-stop shopping" in basketball.<sup>263</sup>

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<sup>258</sup> See *Frequently Asked Questions*, *supra* note 253.

<sup>259</sup> See *Collective Bargaining Agreement, App. C ("NFL Player Contract")*, at <http://www.nflpa.org/Media/main.asp?subPage=CBA+Complete#appc> (last visited Feb. 8, 2005).

<sup>260</sup> *Id.*

<sup>261</sup> See <http://www.nfl.com> (last visited Feb. 18, 2005) (On the bottom of the webpage, the copyright notice states that the "NFL and the NFL shield design are registered trademarks of the National Football League. The team names, logos and uniform designs are registered trademarks of the teams indicated.").

<sup>262</sup> See Nat'l Basketball Players Ass'n, *Collective Bargaining Agreement, Art. XXXVII*, at <http://www.nbpa.com/cba/articleXXXVII.html> (last visited Feb. 18, 2005).

<sup>263</sup> *Id.*

MR. FERBER: By the way, in connection with what Bruce just said, that's why sometimes when you're watching sports programs on television there will be commercials by entirely private entities using an athlete, a manager, whatever, and because that contract is only with the athlete or manager to do that commercial, you will frequently see that they are not really wearing the uniform.<sup>264</sup> Instead of, for instance, a Yankees cap, you will just see a solid midnight-blue cap with no logo on it, because that hasn't been authorized by either the league or the team, whichever controls the right to the logo in that case.<sup>265</sup>

Let's open the floor to questions.

QUESTION: You were saying that there was a loss almost. When I heard what you were saying initially about music, it seems to me that that argument is vital if there is essentially sampling going on. But even if there is a similarity of lyrics, once the music is reformatted, it then can conceivably create a new work.

MR. KELMAN: That's not the case, unless it's a new piece.

QUESTIONER: That's what I mean.

MR. KELMAN: If somebody wants to do an arrangement of an existing copyrighted musical composition, that arrangement is owned by the original copyright owner as a derivative work, and if it is prepared without permission of the copyright owner, it is a copyright infringement.<sup>266</sup>

QUESTIONER: No, but I'm talking about where someone—we had the issue with sampling where people weren't getting paid, which was just direct copying.

MR. MEYER: Right.

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<sup>264</sup> See, e.g., *National Hockey League Collective Bargaining Agreement, Art. 25: Endorsements; Licensing*, at [http://www.nhlfa.com/CBA/cba\\_agreement25.asp](http://www.nhlfa.com/CBA/cba_agreement25.asp) (last visited Feb. 18, 2005) (forbidding use of team logos in personal endorsements without team consent).

<sup>265</sup> See, e.g., *Celebrity Archive*, [http://www.whymilk.com/celebrity\\_archive.htm](http://www.whymilk.com/celebrity_archive.htm) (last visited Feb. 18, 2005) (showing professional baseball player Cal Ripken, Jr. wearing a generic uniform and hat in an advertising campaign).

<sup>266</sup> 17 U.S.C. § 106(2) (2002); see also Eric C. Surette, Annotation, *What Constitutes Derivative Work Under the Copyright Act of 1976*, 149 A.L.R. FED. 527 (2004).

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QUESTIONER: But it is conceivable—and this is what I’m interested in hearing more about in the context of this artwork, where somebody who is alive and viable, whether it be a human being, a building—if this were a building, would the architect be entitled, if it was famous, like the Sydney Opera House, to be paid?

MR. NIERMANN: Yes, they do. That case was decided by the Sixth Circuit in the *Rock and Roll Hall of Fame* case, where a photographer named Gentile took a picture, and he waited days and days for the right sunset.<sup>267</sup>

QUESTIONER: I’m not talking about a photograph. I’m talking about a creative painting.

MR. NIERMANN: He took a picture of a building.<sup>268</sup> I misunderstood your question.

QUESTIONER: I’m saying if you were to paint a famous building—the Eiffel Tower, the Leaning Tower of Pisa—and integrate it into a new work, should those instrumentalities receive a fee? Where does this stop?

MR. KELMAN: When a film company is doing a film and they’re filming it, let’s say, in New York City, and it’s focused in front of a specific building and you see the number on it and the whole thing, they get a property release from the owner of the building.<sup>269</sup>

QUESTIONER: That I understand.

MR. KELMAN: Sometimes you will see a building where it’s sort of fuzzy, you can’t tell which it is, and they do that for a reason.

QUESTIONER: Deliberately. Part of my practice is entertainment. But that’s why I’m talking about buildings that are so notorious. If you created something entirely different and

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<sup>267</sup> *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 751 (6th Cir. 1998).

<sup>268</sup> *Id.*

<sup>269</sup> *Cf. Location and Property Release Agreement*, at <http://www.documentarychannel.com/Contracts/Location%20Release%201.htm> (last visited Feb. 18, 2005) (sample location and property release agreement, not specifically for New York).

simply integrated them—that’s why I asked—should the architect then be entitled to a royalty?

And in terms of publicity and public figures, I had a case in New York in which a police officer who was a private citizen became the subject of a major feature in the *New York Times* on PMS. The court said she had no rights.<sup>270</sup> I mean, it talked about the psychological implications of PMS and how it affects women. And obviously it had a direct relationship on the possible perception by the public of how good she might be in her day-to-day work. And she didn’t have a lot of money at risk.

The court said no, that the importance of the exchange of ideas was such that she should have no right of privacy. She specifically told *The Times* when she knew the subject matter, “Don’t take my picture. I don’t want to be involved in this article in any way.”

MR. FERBER: The problem is that her only claim in that instance, as I understand you to be describing it, would be a claim for a violation of her right of privacy. But that only applies to purposes of trade or advertising.<sup>271</sup> An article in the *New York Times* doesn’t qualify as purpose of trade or advertising.<sup>272</sup> It’s complete First Amendment protection.<sup>273</sup> So she would not have a viable privacy claim.<sup>274</sup>

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<sup>270</sup> Cf. *Arrington v. N.Y. Times*, 55 N.Y.2d 433, 440–41 (1982) (upholding dismissal of complaint as against the New York Times by a private individual for the unauthorized use of his photograph to illustrate an article).

<sup>271</sup> N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 2004) (“A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait, or picture of any living person without first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.”).

<sup>272</sup> See, e.g., *Middleton v. News Syndicate Co.*, 295 N.Y.S. 120, 121 (Sup. Ct. 1937) (dismissing complaint where woman’s name and photograph were published in a newspaper for purposes other than trade or advertising).

<sup>273</sup> See, e.g., *Rand v. Hearst Corp.*, 298 N.Y.S.2d 405, 409 (App. Div. 1969) (“The words ‘advertising purposes’ and for the ‘purposes of trade’ were used as the means to carry out the law’s fundamental purpose—the protection of an individual’s right of privacy. They must be construed narrowly and not used to curtail the right of free speech, or free press, or to shut off the publication of matters newsworthy or of public interest, or to prevent comment on matters in which the public has an interest or the right to be informed.”).

<sup>274</sup> See *Middleton*, 295 N.Y.S. 120.

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QUESTIONER: Although it did affect her livelihood and it impacted quite directly on her ranking in the Department and the public perception of her.

MR. FERBER: You know, in other states where there are other branches of the tort invasion of privacy, it's possible that she would have a claim for publication of private embarrassing facts.<sup>275</sup> But New York State law does not recognize that branch of the privacy tort.<sup>276</sup>

MR. MEYER: Again it seems to me, with all due respect, you are really arguing against the concept of the right of publicity, that there shouldn't be a right of publicity. And again, we are beyond that. The law recognizes a property right in the commercial exploitation of your image.<sup>277</sup>

So the only question here is: Should the right of publicity apply here? If that's not a commercial exploitation of your image, then what is? Again, you can argue philosophically there shouldn't be a right of publicity, but its existence is well-settled.<sup>278</sup>

MR. NIERMANN: If you put Tiger's picture on the cover of *Sports Illustrated*, which it was a number of times, and I like Tiger, and as I walk by the newsstand I think to myself, "Look, there's Tiger. I'm going to buy this *Sports Illustrated* because I want to read this because I like Tiger Woods," does that mean you are exploiting his image?

MR. KELMAN: That's newsworthy.<sup>279</sup>

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<sup>275</sup> See, e.g., *Thomas v. Food Lion, L.L.C.*, 570 S.E.2d 18, 21 (Ga. Ct. App. 2002) (stating that an invasion of privacy claim may exist for public disclosure of embarrassing facts) (citing *Yarbray v. S. Bell Tel. Co.*, 409 S.E.2d 835, 836–38 (1991)).

<sup>276</sup> See *Howell v. N.Y. Post Co.*, 612 N.E.2d 699, 704 (N.Y. 1993) ("Balancing the competing policy concerns underlying tort recovery for invasion of privacy is best left for the legislature, which in fact has rejected proposed bills to expand New York laws to cover all four categories of privacy protection.").

<sup>277</sup> See Joan C. McKenna, 63C AM. JUR. 2D *Property* § 6 (2004).

<sup>278</sup> See *id.*

<sup>279</sup> See *Messenger v. Gruner + Jahr Printing & Publ'g*, 727 N.E.2d 549, 552–53 (N.Y. 2000) (discussing newsworthiness of any subject of public interest); see also *Stephano v. News Group Publ'ns, Inc.*, 474 N.E.2d 580 (N.Y. 1984) (holding that a wide variety of articles on matters of public interest, including those not readily recognized as "hard news," are newsworthy).

MR. NIERMANN: And this is a newsworthy event, it's expression.

MR. MEYER: Nobody's getting their news from Rick Rush.<sup>280</sup>

MR. NIERMANN: Well, people who appreciate golf and appreciate art are. People who don't understand golf or art are not.

MR. MEYER: I'll stipulate that I don't understand golf.

MR. KELMAN: There's a difference in that kind of situation where he's on the cover of a magazine and that individual painting over there.<sup>281</sup>

MR. NIERMANN: Why?

MR. KELMAN: Remember the Joe Namath case involving *Sports Illustrated*?<sup>282</sup> There was a claim brought there, and the court held that the cover was really just to show the content of the magazine and they're not selling the cover.<sup>283</sup>

MR. NIERMANN: But they're both expression.

MR. KELMAN: In this case they're selling that picture of him and there's nothing else there except the frame.<sup>284</sup>

MR. NIERMANN: So in other words, what you're saying is all you see when you look at that picture is a frame and Tiger Woods?<sup>285</sup>

MR. KELMAN: No. I see Tiger Woods. That's all I see.

MR. NIERMANN: That's all you see?

MR. KELMAN: Yes. That's the only reason anyone buys it.

MR. NIERMANN: I'll buy you a prescription.

MR. FERBER: We have another question down here.

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<sup>280</sup> See *Rick Rush: America's Sports Artist*, at <http://www.ktg2.com/arhtml/artist-rush.htm> (last visited Feb. 18, 2005) (discussing Rick Rush's career as a sports artist).

<sup>281</sup> See generally F. Jay Dougherty, *All the World's Not a Stooge: The "Transformativeness" Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM.-VLA J.L. & ARTS 1 (2003).

<sup>282</sup> *Namath v. Sports Illustrated*, 363 N.Y.S.2d 276 (Sup. Ct. 1975).

<sup>283</sup> See *id.*

<sup>284</sup> *The Masters of Augusta*, *supra* note 33.

<sup>285</sup> See *id.*

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QUESTION: I have a question, back to the *Woods* case.<sup>286</sup> Was summary judgment even appropriate here?<sup>287</sup> By that I mean don't you have to take a look at a work of art like that, and then isn't it a question of fact to be decided by a jury whether or not that really is an artistic impression or not? How can a judge pass on summary judgment decision on that?

I look, for instance, particularly in the background—the pictures, the caricatures, of Ben Hogan, Sam Snead, etc., and they are very faint.<sup>288</sup> I would consider that to be almost a planted diversion, so that the painter can say that this wasn't painted for the purpose to attract attention and market it for Tiger Woods. But the truth of the matter is I think the artist really did in fact do that. The artist put those faint pictures in the background perhaps anticipating that there could be a lawsuit.

MR. NIERMANN: He anticipated the transformative element decision that was going to be decided two years later? Is that what you're saying?

QUESTIONER: My point is shouldn't a jury really pass judgment on something like this?

MR. KELMAN: I have a quick question for Dennis: Is your position the same?

MR. FERBER: Poor Dennis.

MR. NIERMANN: I won. It's not "poor Dennis."

MR. KELMAN: Is your position the same if there was nothing else there but Tiger Woods?

MR. NIERMANN: Absolutely my answer is the same. But that's a hypothetical.

MR. MEYER: You asked a very good legal question. In other words, if the test is this transformative element test, why isn't that a factual issue rather than a legal issue?<sup>289</sup>

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<sup>286</sup> *Jireh Publ'g II*, 332 F.3d 915 (6th Cir. 2003).

<sup>287</sup> See FED. R. CIV. P. 56.

<sup>288</sup> *The Masters of Augusta*, *supra* note 33.

<sup>289</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 401 (2001) (citations omitted).

MR. NIERMANN: The California Supreme Court made the same decision about summary judgment and did not let it go to the jury.<sup>290</sup>

MR. FERBER: We have another question down in front here.

QUESTION: I share Dennis's opinion on the law, and I agree with him, but I just disagree with him about golf generally, because as Andy Rooney said, "To me golf is like watching grass grow."

But let's assume I go to a ballpark or I go to an arena and I paint a picture of some famous baseball player getting up at bat, like Alex Rodriguez for example, and I paint that and I sell it. There's no commercial thing that they're entitled to, is there? Or let's say I go to Madison Square Garden and I draw a picture of, Jason Kidd driving for the basket. I'm entitled to do that, aren't I?

MR. MEYER: You're talking about selling just the picture you paint?

QUESTIONER: Let's say I make a hundred copies of that picture.

MR. MEYER: That's the issue. That's what this case is all about.

MR. NIERMANN: The Supreme Court has decided over and over again that expression does not lose its protection by selling copies.<sup>291</sup>

QUESTIONER: How many copies of my painting can I sell?

MR. NIERMANN: ETW argued in front of the district court and the appellate court that the original is protected and the copies are not.<sup>292</sup>

I want to say one more thing about your comment about golf. My son Paul would agree with you. I caught him watching golf

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<sup>290</sup> *Id.*

<sup>291</sup> See *Jireh Publ'g II*, 332 F.3d at 924–25; see also *Smith v. California*, 361 U.S. 147, 150 (1959); *Buckley v. Valeo*, 424 U.S. 1 (1976); *Time, Inc. v. Hill*, 385 U.S. 374 (1967); *N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964). See generally *Dougherty*, *supra* note 281.

<sup>292</sup> *Jireh Publ'g II*, 332 F.3d at 925 n.8; see also *Jireh Publ'g I*, 99 F. Supp. 2d 829, 834 (N.D. Ohio 2000).

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one night and I said, “Paul, I didn’t think you liked golf.” He said, “Dad, I have insomnia.”

QUESTIONER: The answer is there was nothing else on.

MR. NIERMANN: Same thing.

MR. PRINCIPE: But you do have to be careful about the slippery slope in a situation like this, especially with the transformative element.<sup>293</sup> When you just talk about taking a photograph, that it’s just a photograph—well, a photograph can have transformative elements as well.<sup>294</sup> Ask any photographer. They’re going to say, “Oh, this is a unique picture. I got the right shutter speed. I got the right lighting. I got the right angle.”

If we take this slippery slope, then potentially I can take a picture of any athlete, just snap a photo, put it on a poster, and then market the hell out of that and sell 10,000 or 100,000 copies of it. This would flood the market and ruin an athlete’s memorabilia rights. Is that fair? I don’t think so.

I think where we are going to today, especially with the proliferation of digital technology and Internet capabilities—that we have to start, and the courts have to start, considering those impacts when we’re looking at copies, because the ease of making copies is just too prevalent now.

QUESTIONER: Forget the photograph. How about if I do a painting like that in Yankee Stadium or Shea Stadium and then I mass produce it? Somebody’s on third base, somebody’s on first base. There shouldn’t be any difference between that and this, should there?

MR. MEYER: I think there is.

MR. PRINCIPE: That’s what we’ve been talking about all day.

QUESTIONER: That’s the question, right?

MR. FERBER: It’s also not really a question of publicity right then. You arguably are getting into issues of Lanham Act

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<sup>293</sup> See generally Dougherty, *supra* note 281.

<sup>294</sup> *Id.*

litigation, maybe even copyright litigation.<sup>295</sup> It's not a publicity right because it's a building, not a person.<sup>296</sup> The question is whether, for instance, from the Lanham Act point of view, is that building in that particular depiction known so well that it has somehow acquired trademark rights?<sup>297</sup> I think it's got to be a case-by-case inquiry.<sup>298</sup>

QUESTIONER: Even though I'm just painting it?

MR. FERBER: Well, because you are just painting it—if it's a different perspective, for instance, there may be no trademark rights and you may be free to do that from the Lanham Act point of view.<sup>299</sup>

MR. FERBER: We have another question back there.

QUESTION: I have a question for Dennis.

But first I want to correct something about *Cardtoons*.<sup>300</sup> That case was the baseball parody trading cards.<sup>301</sup> What the court said there was not that the First Amendment trumped the right of publicity.<sup>302</sup> It was a very strange ruling. What he said was there is a parody exception to the right of publicity.<sup>303</sup>

In a deposition, someone who represented the players' association said, "We would never license those kinds of cards."<sup>304</sup> The judge was truly troubled by the fact: Well, if you need a license from the players association and they won't give it, and this is parody/satire expression, which the First Amendment holds very dear, I have to create an exception for that to the right of

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<sup>295</sup> Cf. *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753 (6th Cir. 1998) (holding that museum's inconsistent use of design to serve source-identifying function rendered claim unlikely to succeed on the merits).

<sup>296</sup> See *id.*

<sup>297</sup> See 17 U.S.C. §§ 102, 501 (2002).

<sup>298</sup> See *Rock & Roll Hall of Fame & Museum, Inc.*, 134 F.3d 749.

<sup>299</sup> See *id.*

<sup>300</sup> *Cardtoons, L.C. v. MLB Players Ass'n*, 335 F.3d 1161 (10th Cir. 2003).

<sup>301</sup> *Id.* at 1163.

<sup>302</sup> See *supra* notes 27–29 and accompanying text.

<sup>303</sup> *Cardtoons, L.C. v. MLB Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996).

<sup>304</sup> *Id.* at 972 ("Indeed, the director of licensing for MLBPA [Major League Baseball Players' Association] testified that MLBPA would never license a parody which poked fun at the players.").

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publicity.”<sup>305</sup> So in that particular case, because there wouldn’t be a license granted, I think the court came out the way it did.<sup>306</sup>

As Mike pointed out, you could go to Tiger Woods and get a license.<sup>307</sup> There’s nothing stopping you from doing that.

MR. NIERMANN: Unless he wouldn’t give it.

QUESTIONER: Let’s take something less expressive even than a bobblehead, a plaque, where people take a picture of Alex Rodriguez and they stick it on a piece of wood and they sell it. People do it all the time. Does liability turn on whether the person took the picture or whether they got the photo off the Internet and stuck it on a piece of wood? Which is expressive, or are both expressive? And how is that expressive, taking a picture and sticking it on a piece of wood?

MR. NIERMANN: I suppose it depends upon what it’s trying to express.<sup>308</sup> This painting obviously is expressing that Tiger Woods has done something phenomenal and put himself within the shrine of those fantastic golfers over the years who have been able to do that.<sup>309</sup>

I don’t know.

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<sup>305</sup> *Id.* at 972–73 (“Thus, elevating the right of publicity above the right to free expression would likely prevent distribution of the parody trading cards. This would not only allow MLBPA to censor criticism of its members, but would also have a chilling effect upon future celebrity parodies. Such a result is clearly undesirable . . .”).

<sup>306</sup> *Id.*

<sup>307</sup> 2 MCCARTHY, *supra* note 6, §§ 10:1–10:14.

<sup>308</sup> *Jireh Publ’g II*, 332 F.3d 915, 935 (6th Cir. 2003) (“When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity . . . .”) (citing *Comedy III Prods., Inc. v. Saderup*, 25 Cal. 4th 387, 405 (2001)).

<sup>309</sup> *Id.* at 919 n.1 (“In this unique work of art, America’s Sports Artist, Rick Rush has blended the charm and boastful beauty of nature with the magnificence of a gilded golfing history and unabashed power and confidence of youth to deliver a masterpiece: ‘The Masters of Augusta.’”) (citing the narrative accompanying the work); *see also The Masters of Augusta*, *supra* note 33.

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QUESTIONER: I'm just exploring your view that unless it's an advertising case. I think your view was—

MR. NIERMANN: It is.

QUESTIONER: —that all of this is okay unless you're using the image of the celebrity or the athlete to either imply an endorsement or to advertise a product.<sup>310</sup>

MR. NIERMANN: So what's the use of this piece of wood with the picture on it?

QUESTIONER: So where's expression on it?

MR. NIERMANN: If all the use is is to look at it and appreciate it, my position is it is protected.<sup>311</sup>

QUESTIONER: But how is that First Amendment expressive?

MR. NIERMANN: What's the use?

MR. KELMAN: This is a poster use. This pretty much to me is a poster use of Tiger Woods that your client—

MR. NIERMANN: What do you mean, a poster use?

MR. KELMAN: A poster use. It's the same thing.

MR. NIERMANN: What do those words mean, "a poster use?" It's a painting.

MR. KELMAN: It doesn't matter. When you duplicate it, it becomes like a poster.

MR. NIERMANN: You know, there are only about ten or twelve U.S. Supreme Court cases that say that selling copies of expression does not reduce the First Amendment protection. Now, I don't know how you are going to get by those cases.<sup>312</sup>

MR. FERBER: I think the question, though, has to do with the idea—we're not even getting into the disputed idea you have an artist with a paintbrush doing his interpretation of some pose. You literally have someone doing nothing more than taking a photograph, whether it was their own or they take it off the Internet, and they take a bunch of them, stick them on a piece of

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<sup>310</sup> See *supra* notes 86–91 and accompanying text.

<sup>311</sup> *Id.*

<sup>312</sup> See *supra* note 237.

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wood, and sell them as plaques. Is that also entitled to First Amendment protection, or have you now crossed the line and is that now a violation of the right of publicity?<sup>313</sup> Is that the question?

QUESTIONER: Yes, that's my question.

MR. NIERMANN: Why isn't a photographer taking a picture expression? Why is that not expression? There are things that a photographer needs to do—and this was brought out in the *Rock 'n Roll* case out of the Sixth Circuit, where Gentile, the photographer—I was mentioning this earlier—had waited for the right light, and it was artistic, and he took it, and they said, “The Rock 'n Roll Hall of Fame has a trademark in every image of itself, period.”<sup>314</sup> That was a loser as well.

QUESTIONER: What if you didn't take the photo and you're not the photographer? Should people be allowed to simply take a photograph that they didn't take, stick it on a piece of wood, and sell it?

MR. NIERMANN: Then, for those golfers in the audience who buy clubs, pretend you buy Mazonos and they look like Mizunos. If Mazuno is they're copying something, then I'd say it's a knockoff. The person from whom it was copied might have a claim, but the person who created it, I think he's protected.<sup>315</sup>

MR. FERBER: I think we are going to take one more question, in the back over here.

QUESTIONER: I'm going to do something verboten in law school and put two questions to the panel. Answer either one.

I'm looking at the *New York Times* over there, with its painting and text. Am I to understand the state of the law now is that Mohammad Ali would lose and Larry Flynt would prevail in the

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<sup>313</sup> See also *Jireh Publ'g II*, 332 F.3d at 928; *Haelan Laboratories, Inc., v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953). See generally *Cardtoons, L.C. v. MLB Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996).

<sup>314</sup> *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 755–57 (6th Cir. 1998).

<sup>315</sup> See generally *id.*

*Hustler* case?<sup>316</sup> And what if the athlete had an exclusive endorsement with some other company other than Titleist? What impact would that have?

MR. FERBER: Say that again, please.

QUESTIONER: The second one was actually out of left field. I was just concerned with an athlete who has an exclusive deal with a golf club company other than Titleist.

I'll go with the first question. Let's stick with that.

MR. FERBER: Which one?

QUESTIONER: The *Ali-Flynt* case. Because if this is the *New York Times*, why did *Hustler* lose?<sup>317</sup>

MR. FERBER: It's not the *New York Times*.

QUESTIONER: Well, that's the position.

MR. FERBER: What if that were put in the *New York Times*? Is that the question?

QUESTIONER: In other words, if I understand correctly, Dennis is stating that this is essentially free speech, just like the *New York Times*. *Hustler* puts in—albeit it's a nude painting, but it's clear that the boxer is Mohammed Ali.<sup>318</sup> Ali sues and prevails.<sup>319</sup> Am I to understand the state of the law is that that was artwork, there was text, so Ali's case should have gone south then?

MR. MEYER: I think that follows from this decision, which I wouldn't agree with.

MR. NIERMANN: I don't understand the question. I'm not going to comment.

MR. MEYER: When I said this is the state of the law, thankfully, I just want to reiterate, this is the law in only one circuit as of now.<sup>320</sup> There are statutes.<sup>321</sup> In fact, even in—Dennis I'm

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<sup>316</sup> The questioner is actually referring to *Playgirl Magazine* in the case *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978).

<sup>317</sup> *Id.*

<sup>318</sup> *Id.*

<sup>319</sup> *Id.*

<sup>320</sup> This is the law only in the Sixth Circuit. See *Jireh Publ'g II*, 332 F.3d 915 (6th Cir. 2003).

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sure knows more than I do about this—but even in Ohio, in the Sixth Circuit, just after this case was filed, there was a statute passed.<sup>322</sup>

MR. NIERMANN: Passed afterwards.<sup>323</sup>

MR. MEYER: But it's still subject to constitutional challenge, obviously.<sup>324</sup>

MR. FERBER: I think that the gentleman was referring to a case—it was like 1976—where Ali sued because there was a depiction of him—actually it was a little more than a silhouette, but it did say “the greatest” as a caption.<sup>325</sup> Is that right?

QUESTIONER: Yes.

MR. FERBER: He asserted a right of publicity violation.<sup>326</sup>

I have one thought for you, for what it's worth. Of course, no one can answer this question. I posit the notion that the outcome of that case might be very different, given the almost three decades of case law between then and now. There has been quite an evolution in the law.

By the way, rightly or wrongly, you will find a number of intellectual property areas where First Amendment defenses have been offered, from the *Debbie Does Dallas* case in the Second Circuit and many others like it.<sup>327</sup> Somehow, when judges find something unsavory about a depiction of a celebrity, it's remarkable how they find ways to afford a little bit less First Amendment protection to it.<sup>328</sup> This is just one man's opinion, but that is a kind of view of the law that I have watched evolve over the last couple of decades.

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<sup>321</sup> Approximately half of the states have adopted some form of the right of publicity either at common law or by statute. *See supra* note 7.

<sup>322</sup> OHIO REVISED CODE ANN. § 2741 (West 1999).

<sup>323</sup> *Jireh Publ'g II*, 332 F.3d at 929 n.15.

<sup>324</sup> *See* U.S. CONST. amend. I.

<sup>325</sup> *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726–27 (S.D.N.Y. 1978).

<sup>326</sup> *Id.* at 725 (alleging violation of N.Y. CIV. RIGHTS LAW § 51).

<sup>327</sup> *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979).

<sup>328</sup> *See, e.g., id.*

I think that, because of how notions of transformative use have very much entered our analysis today, especially since the Supreme Court in 1994,<sup>329</sup> the outcome of the *Ali* case might be different, and I think the analysis would certainly be different.<sup>330</sup> But that is, in part, an explanation for the outcome in that case.

MR. PRINCIPE: Tom, can I say two things? One, I know we are done with the Q&A, but this gentleman has had his hand up the entire time.

MR. FERBER: Then we've got to give him a break?

MR. PRINCIPE: Can we do that?

MR. FERBER: Mike, is that okay?

MR. PRINCIPE: Before you do so, let me just say that our colleague over here brought up, I think, actually an interesting issue in his second question—and this is another reason why I am a little tight about the impingement of the right of publicity. What if Mr. Rush decided to portray Tiger with a huge Big Bertha driver, and he's got a tremendous deal with Nike right now, and Nike got exclusivity, and now Rush is showing Tiger for the world to see with a big Callaway Big Bertha driver?

MR. KELMAN: Then he would lose. There is a case called *Perlmutter v. New York Race Track*, whatever, and it says as long as the depiction is accurate you're okay.<sup>331</sup>

MR. NIERMANN: Actually, Ed, that depiction is accurate. There's a Nike swoosh and a Titleist.<sup>332</sup>

MR. MEYER: It's artistic. Let's just say his message is that "Tiger Woods would be even better if he was using Big Bertha." Once you start saying any message is enough—

MR. NIERMANN: No, but then it's a commercial endorsement.

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<sup>329</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

<sup>330</sup> *See id.*

<sup>331</sup> *N.Y. Racing Ass'n v. Perlmutter Publ'g, Inc.*, 959 F. Supp 578, 582 (N.D.N.Y. 1997) (holding that defendants' use of plaintiff's marks served the "artistically relevant purpose" of describing the scene depicted in the paintings).

<sup>332</sup> *See The Masters of Augusta*, *supra* note 33.

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MR. FERBER: Let's let this gentleman over in the corner back here have the last question.

QUESTIONER: My question is along the same lines actually. What if Tiger Woods has a contract with Nike, which I'm sure is exclusive?

MR. NIERMANN: Which he does.

QUESTIONER: What if Reebok contacted your client and bought that picture and said, "I want rights to reproduce this and I'm going to put it on all Reebok boxes." Now the picture doesn't change, but they are using Tiger Woods's image to endorse Reebok products.

MR. NIERMANN: That was argued in this case. The exact example that you just gave was argued in this case at the district court level.<sup>333</sup> The district court didn't address it.<sup>334</sup> I didn't address it. You need to think about putting that picture on a pair of gym shoes. I mean, are you going to be able to see it? I don't understand the question.

QUESTIONER: It could be on the packaging.

MR. MEYER: In defense of Dennis, I think Dennis was pretty clear that that kind of use, where clearly you are using the image to sell a product, would not be subject to a First Amendment defense.<sup>335</sup>

MR. NIERMANN: Absolutely. That would be wrong and that would be a violation.

MR. MEYER: We're all agreed on that.

MR. NIERMANN: Yes, we agree.

QUESTIONER: Who owns the rights?

MR. NIERMANN: Nike would sue Reebok.

QUESTIONER: Does Reebok have the rights to use that picture on their boxes?

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<sup>333</sup> *Jireh Publ'g I*, 99 F. Supp. 2d 829 (N.D. Ohio 2000).

<sup>334</sup> *Id.*

<sup>335</sup> *See, e.g., Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749, 790 (1985) ("Our cases do permit some diminution in the degree of protection afforded one category of speech about economic or commercial matters.").

MR. NIERMANN: Then he would be using the image to endorse a product. Then Reebok would be sued for using Tiger's image. Why would they ask this artist to use Tiger's image when they could just go ahead and violate the law and use Tiger's image to begin with?

MR. FERBER: Unfortunately, I'm being told our time is up. I'd like to thank all the panelists and the audience.