



COPYRIGHT AND THE FIRST AMENDMENT: DEFINING THE DELICATE BALANCE

Recent Legal Developments in Copyright and Related Intellectual Property Rights from a United States Art Lawyer's Perspective

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As an arts lawyer representing creators of works of visual art, I am often involved in the aggressive protection of their copyrighted expression. However, artists also incorporate and build on works created by others. For example, pop artists of the 1960s Andy Warhol and Richard Hamilton utilized the symbols and icons of pop culture in their work – a tradition carried on by artist such as Richard Prince, Sherrie Lavine and Jeff Koons in the 'appropriation art' of the eighties. A new generation of artists is also distinguishing itself by its engagement with the politics, popular culture and art of the late 1960s and early 1970s to explore concerns of today. Some documentary film producers opine that they would readily sacrifice stringent copyright protection which prevents others from copying their easily accessible and inexpensively reproducible digital product in order to be able themselves to freely use the music, images, and creative product of others.

As Judge Alex Kozinski of the Ninth Circuit presciently observed dissenting from an order rejecting the suggestion for a rehearing en banc in *White v. Samsung Electronics American, Inc.*:¹

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1 989 F.2 1512 9(9th Cir 1993).



Overprotecting intellectual property is as harmful as under protecting it. Creativity is impossible without a rich public domain ... Intellectual property rights aren't free ... This is why intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us.

This essay surveys several recent United States decisions and related legislation in the area of copyright, trademark, and related privacy/publicity rights with a view to how they may impact the creation, exhibition, licensing and merchandising of images both in the United States and worldwide. It is suggested that the tension reflected in evolving intellectual property jurisprudence to adequately balance intellectual property rights with the public access to a rich public domain essential to artistic expression is evident of a wider debate in the digital age that transcends US borders.

The advent of digital technology has transformed our concepts of materiality, originality and authorship and established the Internet as a dominant form of communication and exchange. In light of such developments, many view intellectual property concepts and enforcement systems either national or international as overly protective, flawed and an unjustifiable restraint on artistic expression, innovation, competition and trade.

Some commentators and users of intellectual property question the future of copyright law in the digital age. For this group, primarily U.S. scholars (often referred to as the 'Copy Left'), the argument is that legal protections of intellectual property are expanding to the detriment of creativity, shrinking the scope of the creative commons, threatening freedom of expression, putting obstacles in the way of important research and information and stifling important forms of democratic dialogue.²

2 See *Free Culture*, (Penguin Press, 2004). European scholars have tended to focus on the issue of the mandatory character of copyright exceptions as creating the breathing space required for intellectual and artistic creativity; however, such a focus may overlook the fact that other limitations to copyright law (such as the duration of protection or the requirement of originality) may be threatened in a world where contracts and technological protection measures might well replace copyright in the digital online environment.



COPYRIGHT AND THE FIRST AMENDMENT

Such broad-scale attacks on intellectual property law are unjustified and cannot find support in evolving intellectual property jurisprudence, which has shown itself flexible enough to meet the demands both of the new technologies and of artistic freedom. Traditional doctrines such as fair use have been reinvigorated with First Amendment values. So too, recent decisions have attempted to balance trademark law and state law rights of publicity with an artist or author's First Amendment rights, in particular by broadly defining the 'speech' protected by the First Amendment to include works of artistic expression, including baseball cards, and by adopting tests, which balance legitimate artistic freedom with intellectual property rights with a heavy thumb on the side of free expression.

During its 2003 term, the US Supreme Court decided two copyright-related cases that have relevance to those who create, protect, and license fine art images and to the wider philosophical debate set forth above. *Eldred v. Ashcroft*³ upheld the constitutionality of the Copyright Term Extension Act (the 'Sonny Bono Act' or 'CTEA'). *Dastar Corp. v. Twentieth Century Fox Film Corporation*⁴ held that section 43(a) of the Trademark Law (the 'Lanham Act') does not prevent the unaccredited copying of an un-copyrighted work in the public domain.

Eldred's battle cry was advocated by one of the leaders of the Copy Left Movement, Lawrence Lessig, a law professor at Stanford University.

In its 7-2 *Eldred* decision, the Supreme Court addressed the appropriate balance between copyright and the Free Speech Clause of the First Amendment and struck the balance in favor of Congress's power to enlarge the term of copyright. The Court determined that CTEA was constitutional and that the extension of existing copyrights did not exceed Congress's power under the Intellectual Property Clause of the Constitution. In placing existing and future copyright in parity in the CTEA, Congress acted within its authority and did not transgress constitutional limitations.

The Supreme Court rejected the appellate court's determination that copyright law was immune from First

3 123 S. Ct. 769 (2003).

4 123 S.Ct. 2041 (2003).



Amendment challenges. Justice Ruth Bader Ginsberg, writing for the majority, noted that copyright law and doctrine developed in response to concerns about the proper balance between intellectual property and free expression; thus, ideas and facts, as opposed to expression, are not copyrightable, and use of another's copyrighted work without authorization is protected from a claim of infringement if the use is considered 'fair' under Section 107 of the Copyright Law. "When, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."

The Court found, moreover, that CTEA supplements traditional First Amendment safeguards. CTEA gives libraries, archives, and nonprofit educational institutions, including museums, greater latitude in using copyrighted works during the extended twenty-year term. If a work is not obtainable at a reasonable price and not subject to normal commercial exploitation, libraries, archives, and museums may reproduce, distribute, display and perform the work for purposes of scholarship, research, or presentation.

In another challenge to CTEA, artists or purveyors of art material filed a complaint prior to *Eldred* seeking declaratory and injunctive relief regarding CTEA and § 514 of the Uruguay Round ('URAA'). They assert that these acts unconstitutionally remove from or staunch the flow of literary and artistic works into the public domain. While the CTEA challenge was dismissed on the basis of *Eldred*, the challenge to § 514 of URAA, which restores copyright to certain foreign authors who lost copyrights in works for failure to comply with US copyright formalities, has survived a motion to dismiss.⁵ Should the Court decide in favor of the plaintiffs, the United States would be in violation of its GATT TRIPS's obligations.

Lessig and other public domain enthusiasts succeeded in having The Public Domain Enhancement Act ('PDEA') introduced in Congress (H.R. 2601) on 25th June 2003. PDEA is currently in the House Subcommittee on Courts. The bill is intended as a counter weight to automatic term extension of copyright protection. If the bill becomes law, copyright owners who desire an additional twenty years of protection

5 See *Lawrence Golan et. al. v. John Ashcroft* (U.S. Dist. Court, Colorado, 15 March 2004).



COPYRIGHT AND THE FIRST AMENDMENT

would simply pay a fee of one dollar fifty years after the work was published and every ten years thereafter until the end of copyright term. On the positive side, it is argued that more works will pass into the public domain sooner and the registration/renewal process outlined by the PDEA would make it easier to identify owners of copyrighted works. On the negative side, this reverses a trend to international harmonization: since US adherence to the Berne Convention in 1989, formalities to secure protection have largely disappeared and formalities with respect to renewal rights were eliminated in 1992. In addition, since the initial term is 50 years from publication, not the life of the author plus 50 years, the bill arguably violates the Berne Convention minimum of the life of the author plus 50 years (the Convention permits parties to provide for a longer term of protection, and the European Union provided protection for a term of the author's life plus 70 years).

It is almost impossible to analyze the Court's decision in *Dastar* without concluding that the Supreme Court was reacting to concerns of a shrinking public domain as a result of its decision in *Eldred*. In *Dastar*, the Court had to decide whether trademark law takes over when copyright protection ends. In 1948, Doubleday published Dwight D. Eisenhower's World War II book, *Crusades in Europe* (*Crusades*), registering the book's copyright and granting exclusive television rights to an affiliate of Twentieth Century Fox Film Corporation (Fox). By 1975, Doubleday still held the book's copyright, but Fox's copyright on the television series expired in 1977, leaving the series in the public domain.

In 1988, Fox reacquired the television rights, including the exclusive right to distribute the *Crusade* series on video and to sublicense that right to others. In 1995, Dastar Corporation released a video series entitled, *World War II Campaigns in Europe* (*Campaigns*). To make *Campaigns*, Dastar purchased tapes of the *original* version of the public domain *Crusades* television series, copied them, and then edited the series. Dastar's *Campaigns* series is slightly more than half as long as the original *Crusade* television series and was selling for substantially less than Fox's *Crusades*. Fox brought suit alleging *inter alia* that Dastar's selling of *Campaigns* without giving credit to *Crusades* constituted reverse passing off in violation of section 43(a) of the Lanham Act. The District Court and Ninth Circuit Court of



Appeals agreed, deciding that Dastar had made a 'bodily appropriation' of Fox's series.

On appeal to the Supreme Court, Amici supporting Dastar were quick to criticize the lower court holdings as undermining the Supreme Court's unanimous opinion in *Feist Publications, Inc. v. Rural Telephone Service Company*.⁶ *Feist* rejected the 'sweat of the brow' doctrine that bestowed copyright protection on the facts in a set of databases based solely on the effort the publisher expended to collect those facts. The Court stated that the 'sweat of the brow' doctrine flouted basic copyright principles and concluded that "only the compiler's selection and arrangement may be protected ...Originality is a constitutional requirement for copyright protection."⁷ Facts by definition are not original; they are discovered rather than created.⁸

6 *Feist Publications, Inc. v. Rural Telephone Service Co.*, 429 U.S.3 40 (1991).

7 *Id.* at 346.

8 Of some note, the Supreme Court of Canada recently rejected the *Feist* test in *CCH Canadian, Ltd. v Law Society of Upper Canada* (4 March 2004). The Court said for a work to have copyright protection in Canada, it had to only be the product of skill – even minimal creatively was not required. In *Bridgeman Art Library, Ltd v. Corel Corp.*, the Bridgeman Art Library, Ltd. (Bridgeman) claimed to represent a number of museums which had "entrusted plaintiff with the proprietorship of the copyright" to reproductions made from works of art, presumably the originals of which are owned by and/or on display in museums. Bridgeman claimed to be the sole and exclusive proprietor of all authorized photographic and lithographic reproductions, prints and digital images of works of art of numerous European master artists, including Michelangelo's Sistine Chapel Ceiling and Leonardo da Vinci's *Mona Lisa*. Thus, it claimed to have the exclusive rights in photographic transparencies of these works of art and to have transformed those transparencies into digital images in which it also claimed exclusive rights. Corel is a developer, manufacturer and distributor of a variety of consumer software products and a collection of CD-ROM titles containing digitized photographic reproductions of public domain works of a variety of European masters. Bridgeman contended that Corel's CD-ROM's contained digital images of the same works of art and must have been copied from its transparencies.

Bridgeman commenced an action for copyright infringement, Lanham Act violations, common law unfair competition, and tortious misappropriation of goodwill in August 1997, contending that Corel's distribution of its Masters CD-ROM violated Bridgeman's exclusive rights in its alleged reproductions. Corel moved for summary judgment, on the basis that, as a matter of law, reproductions of any work, let alone works in the public domain for hundreds of years, lack sufficient originality to be copyrightable subject matter.

In deciding in favor of Corel on its motion for summary judgment, Judge Kaplan applied English law to decide whether copyright subsisted in Bridgeman's transparencies since the photographs were published in the United Kingdom and the United Kingdom had the most significant relationship to the issue of copyrightability. The court held that the transparencies lacked the required originality under the Copyright, Designs and Patents Act, 1988. On this case, see the note by Simon Stokes in (2000) V *Art Antiquity and Law* 46.



COPYRIGHT AND THE FIRST AMENDMENT

The Supreme Court unanimously (Justice Breyer did not participate) reversed the lower courts' decisions and held that the phrase 'origin of goods' in the Lanham Act "refers to the producer of the tangible goods that are offered for sale", and not to the author of any idea, concept, or communication embodied in those goods. Justice Scalia noted that allowing an action under Section 43(a) for Fox's representation of itself as the producer of *Crusade* would create a species of mutant copyright law that limits the public's rights to copy and use expired copyright. The Court concluded its opinion by emphasizing that the purpose of the Lanham Act unlike copyright and patent laws, "is not to protect creativity".

Eldred was called the challenge to the 'Mickey Mouse term extension law' (incorrectly, since Mickey Mouse presumably would have been protected even if the film *Steam Boat Willie* entered the public domain). Does *Dastar* limit Mickey's life more effectively? It is hard to see how *Dastar* alone can be read to limit Disney's trademark rights to control the commercial use of Mickey Mouse given the strength of the Mickey Mouse Mark, even if the Mouse enters the public domain. Can *Dastar* be used to prevent an action by an author to film credit under the Lanham Act? What impact, if any, does *Dastar* have on the protection of fictional characters? The holding of *Dastar* may be arguably much narrower than its broad *dicta* on copyright law suggest. Justice Scalia is correct in recognizing the economic potential of information distribution in the digital era and the chilling effect on the flow of information in commerce if each fact and public domain contribution required attributions by virtue of a Lanham Act claim turned into a species of mutant copyright law. The holding should not be expanded more broadly than the definition of 'origin of goods'.

Expansive public domain advocates have seized upon *Dastar* as ammunition for a constitutional attack on the recently introduced Database and Collections of Information Misappropriation Act of 2003 (H.R. 3261), which they see as an unconstitutional attempt to overrule *Feist*. Some have argued that the legislation may violate both the Intellectual Property clauses and the First Amendment by using the Commerce Clause as an end-run around the Intellectual Property Clause.



David Carson, general counsel of the Copyright Office, disagrees and argues that the narrow application of the law and its focus on misappropriation overcomes potential constitutional objections. The draft legislation of H.R. 3261 only covers acts that cause commercial harm to the database producer and only if ten specific criteria are met. The legislation follows the EU Database Directive, which establishes *sui generis* protection for databases.

The fair use doctrine from the infancy of copyright protection “has been thought necessary to fulfill copyright’s very purpose, which is ‘to promote the Progress of Science and useful Arts.’”⁹ Recognized at common law, the doctrine is now codified in section 107 of the Copyright Act 17 U.S.C. § 107 (1994). Section 107 provides an illustrative list of the purposes for which the doctrine may be invoked, including comment and criticism as well as a now-familiar list of factors that courts should consider in determining whether a use is ‘fair’. These factors are: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the amount and substantiality of the work used, and; (4) the effect of the use on the market for the original.

*Campbell v. Acuff-Rose Music, Inc.*¹⁰ clarified the fair use defense, its basis in the Constitution, and its particular application to parodies. Acuff-Rose Music, Inc. filed suit against the music group 2 Live Crew, claiming that 2 Live Crew’s *Pretty Woman* infringed Acuff-Rose’s copyright in singer/songwriter Roy Orbison’s rock ballad *Oh, Pretty Woman*. The District Court granted summary judgment for 2 Live Crew and the Court of Appeals reversed, holding the defense of fair use barred by the song’s commercial character and excessive borrowing.

Justice David Souter, speaking for the Supreme Court, held that a parody’s commercial character is only one element to be weighed in a fair use inquiry, and that insufficient consideration was given to the nature of parody in weighing the degree of copying. Parody like other comment or criticism could claim fair use under section 107.

The first factor in a fair use enquiry is “the purpose and character of the use ...The enquiry

9 *Id.*

10 510 U.S. 569, 575 (1994).



COPYRIGHT AND THE FIRST AMENDMENT

here may be guided by the examples given in the preamble to @ 107, looking to whether the use is for criticism, or comment, or news reporting and the like. The central purpose of this investigation is to see whether the new work merely ‘supersede[s] the objects’ of the original creation...or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative’.” (quoting Judge Pierre Leval).¹¹

Although often criticized both as overbroad and under inclusive and a result oriented label rather than a useful tool of analysis because of its lack of clarity and predictability, Justice Pierre N. Leval’s mandate to ‘query’ the ‘transformative’ nature of the use has continued to be the lynchpin of fair use analysis and as discussed below is seeping into other areas of intellectual property analysis.

Guided by *Campbell’s* mandate, lower courts have continued to provide broad protection for parody. Recent cases have created what is tantamount to a presumption of ‘fairness’ for parody and have responded to the demands of creativity with a robust articulation of the fair use doctrines and its First Amendment implications. In *Mastercard Int’l v. Nader 2004 Primary Comm.*,¹² the Court accorded wide latitude to an advertisement by Ralph Nader similar to the well known Mastercard ‘Priceless Advertisements’. The District Court in *Mastercard* stated that the “ultimate test of fair use ... is whether the copyright law’s goal of promoting the Progress of Science and the useful Arts [U.S. Const. art. 8, cl. 8] would be better served by allowing the use than by preventing it” and observed that “it has been found that once a work is determined to be a parody, the second, third, and fourth factors are unlikely to militate against a finding of fair use.”

Mattel, Inc. v. Walking Mountain Prods.,¹³ also allowed artistic creativity to trump copyright and trademark infringement

11 *Id.*

12 2004 U.S. Dist. Lexis 3644 (2004).

13 353 F.3d 792 (2003).



claims. Thomas Forsythe, a self-taught photographer a.k.a. Walking Mountain Productions, developed in 1979 a series of 78 photographs entitled 'Food Chain Barbie' in which he depicted Barbie in various absurd and often sexualized positions. Forsythe uses the word 'Barbie' in some of the titles of his works. While his works vary, Forsythe generally depicts one or more nude Barbie dolls juxtaposed with vintage kitchen appliances. Mattel filed an action in the Central District of California alleging that Forsythe's 'Food Chain Barbie' series infringed Mattel's copyrights, trademarks, and trade dress.

In his declaration in support of his motion for summary judgment, Forsythe described the message behind his photographic series as an attempt to:

critique the objectification of women associated with [Barbie], and to lambaste the conventional beauty myth and the societal acceptance of women as objects because this is what Barbie embodies.

Forsythe's market success was limited, but he produced 1,000 business cards that depicted 'Champagne Barbie.' His name and self-given title 'Artsurdist' were written on the cards, which he used at fairs and as introductions to gallery owners. Forsythe also had a website on which he posted low-resolution pictures of his photographs. The website was not configured for online purchasing.

The Ninth Circuit upheld the district court's grant of summary judgment:

Having balanced the four § 107 fair use factors, we hold that Forsythe's work constitutes fair use under § 107's exception. His work is parody of Barbie and highly transformative. The amount of Mattel's figure that he used was justified. His infringement had no discernable impact on Mattel's market for derivative uses.¹⁴

Although summary judgment is said to be a mixed question of law and fact, the court's willingness to dispose of the

14 *Id.*



COPYRIGHT AND THE FIRST AMENDMENT

claims on summary judgment has benefited those less able to spend time and money on litigation. Thus, the court's refusal to consider Mattel's survey evidence on the issue of parody because "the issue of whether a work is a parody is a question of law, not a matter of public majority opinion" can only benefit the artistic community.

Contrast *Mattel* with the well-publicized 1992 case involving the artist Jeff Koons' sculptural appropriation of photographer Art Rogers' *String of Puppies*. In *Rogers v. Koons*,¹⁵ the second Circuit refused to recognize a fair use defense where Koons ripped the copyright notice from the photographs and then sent the photographs to Italian fabricators to copy the work wholesale in the form of a ceramic sculpture as part of a claimed parody of society at large without comment on the photograph.

The Court in *Rogers v. Koons* held that:

It is not enough that the parody use the original in a humorous fashion, however creative that humor may be. The parody must target the original, and not just its general style, the genre of art to which it belongs, or society as a whole (although if it targets the original, it may target those features as well).¹⁶

Although *Rogers v. Koons* was decided prior to *Campbell*, it is not clear that the result would have been different since Koons's use was arguably not transformative and his claimed parodic purpose not evident.

The lack of a transformative use or critical comment explains the court's result in *Elvis Presley Enterprises v. Passport Video*.¹⁷ The Ninth Circuit there stated: "The king is dead. His legacy and those who wish to profit from it remain very much alive."

The court weighed the four factors and held that the film biographer Passport Video in this case did not use the copyrighted materials fairly. The court found the video was commercial, not scholarly, and that the producers used

15 960 F.2d. 101 (2nd Cir. 1992).

16 *Id.* 301, 310(CA2 1992).

17 357 F.2d. 896 (9th Cir. 2003).



many copyrighted works (ten percent of the series) and took the heart of the material.

However, satire and comment protected a national comedy show in *Sandra Kane v. Comedy Partners*.¹⁸ The court held that use of a brief clip from the plaintiff's public access television show on a national comedy show in a satirical manner was fair use under Section 107.

*Leslie A. Kelly v. Arriba Soft Corp., et al*¹⁹ is instructive with respect to the application of fair use in the digital environment and the flexibility of copyright law to adapt to technological demands. The defendant operated a visual search engine on the Internet which retrieved the plaintiff's photographs and made them available to users of the defendant's search engine. Kelly, a photographer alleged copyright infringement and violation of the DMCA.

The court acknowledged that Arriba's actions constituted a *prima facie* infringement of Kelly's exclusive right to reproduce and display his photographs; nevertheless, the unauthorized reproduction and display were not infringing because Arriba's activities constituted fair use. Most curious is the court's discussion of factor one (1). Although a verbatim copy of plaintiff's images for commercial purposes, the court nevertheless found the use transformative.

The most significant factor favoring Defendant is the transformative nature of its use of Plaintiff's images. Defendant's use is very different from the use for which the images were originally created. Plaintiff's photographs are artistic works used for illustrative purposes. Defendant's visual search engine is designed to catalog and improve access to images on the Internet. Joint Stip. PP 27-29, 32. The character of the thumbnail index is not aesthetic, but functional; its purpose is not to be artistic, but to be comprehensive.²⁰

As for the remaining fair use factors, the court found that the nature of the copyrighted work weighed in plaintiff's favor, as did 'slightly' the amount and substantiality of the

18 2003 U.S. Dist. Lexis 18513, (S.D.N.Y. 2003).

19 77 F. Supp. 2d 1116 (CD. Calif 1999).

20 *Id.*



COPYRIGHT AND THE FIRST AMENDMENT

portion used. Although the thumbnail images on the index reproduced and displayed plaintiff's photographs in full, their size was greatly reduced, and, at least in the later version of the index, the thumbnails could not be enlarged. The nature of the use, indexing images, required reproduction of the full image; partial reproductions would not capture the full indexed content. With respect to the earlier version of the index, however, the court found that displaying a full-sized version of the image without returning the viewer to plaintiff's website was more problematic because it was not necessary to the main purposes of defendant's search engine (as identified above - "to catalogue and improve access to images on the Internet").

Finally, the court held that defendant's index did not compromise the potential market for or value of plaintiff's works, based in part on the court's questionable identification of the relevant market as "Plaintiff's Websites as a whole" rather than the separate photographs. The court found the images were used to promote plaintiff's products sold on the sites, and to attract users to other advertisements on those sites. The court acknowledged that it was possible that some users might copy images from defendant's site, and further, that 'deep-linking' allowed users to by-pass the advertisements on plaintiff's site, but held that plaintiff did not present any evidence of harm or adverse impact from these practices. The court also failed to find a violation of the DMCA Copyright Management Information.

The appellate court held that Kelly established a *prima facie* case of copyright infringement by copying, but then upheld the district court's finding of fair use with respect to the use of the thumbnail images. The court's analysis of fact one is informative: "There is no dispute that Arriba operates its website for commercial purposes..." The court then went on to find Arriba's use transformative:

Arriba's use of Kelly's images in the thumbnails is unrelated to any esthetic purpose. Arriba's search engine functions as a tool to help index and improve access to images on the Internet and their related websites. In fact, users are unlikely to enlarge the thumbnails and use them



for artistic purposes because the thumbnails are of much lower resolution than the originals; any enlargement results in a significant loss of clarity of the image, making them inappropriate as display material.

Arriba's use of the images serves a different function than Kelly's use - improving access to information on the Internet versus artistic expression.

The thumbnails do not stifle artistic creativity because they are not used for illustrative or artistic purposes and therefore do not supplant the need for the originals. In addition, they benefit the public by enhancing information gathering techniques on the internet.²¹

The court relied on both a recent Ninth Circuit and First Circuit decision to re-emphasize the functionality distinction.²²

With respect to factor (4), the court held:

Arriba's use of Kelly's images in its thumbnails does not harm the market for Kelly's images or the value of his images. By showing the thumbnails on its results page when users entered terms related to Kelly's images, the search engine would guide users to Kelly's website rather than away from it.²³

This last factor as well as the right infringed explains the court's reversal of the District Court's holding of fair use with respect to Arriba's online linking to and framing of Kelly's full-sized images. This use does not involve reproduction of copyrighted works but the exclusive right to "display the work publicly."

Relying on *Playboy Enterprises, Inc. v. Webbworld, Inc.*,²⁴ and

²¹ *Id.*

²² See also *Worldwide Church of God v. Philadelphia Church of God* 227 F. 3d 1110 (9th Cir. 2000); *Nunez v. Caribbean International News Corp.* 235 F. 3d 18 (1st Cir. 2000).

²³ *Kelly v. Arriba*, 280 F. 3d 934 (9th Cir. 2002).

²⁴ *Playboy Enterprises, Inc. v. Webbworld, Inc.*, 991 F. Supp. 543 (N.D. Texas 1997).



COPYRIGHT AND THE FIRST AMENDMENT

Playboy Enterprises, Inc. v. Russ Hardenburgh, Inc.,²⁵ the court held

Although Arriba does not download Kelly's images to its own server but, rather, imports them directly from other websites, the situation is analogous to Webworld. By allowing the public to view Kelly's copyrighted works while visiting Arriba's website, Arriba created a public display of Kelly's works.

....Thus, by giving users access to Kelly's full-sized images on its own website, Arriba harms all of Kelly's markets. Users will no longer have to go to Kelly's website to see the full-sized images, thereby deterring people from visiting his website. In addition, users would be able to download the full-sized images from Arriba's site and then sell or license those images themselves, reducing Kelly's opportunity to sell or license his own images.²⁶

Courts have shown similar sensitivity to protecting artistic expression when such expression has encountered claims under Section 1114 15 U.S.C. for registered marks and Section 43(a) 15 U.S.C.S. § 1125(a) of the Lanham Act for unregistered marks.

Section 43(a) was discussed *supra* in the context of *Dastar* and the meaning of 'origin of goods'.²⁷ Producers typically invoke this federal counterpart to Section 1114 registered marks to protect intellectual property rights in unregistered marks. However, the Lanham Act extends beyond disputes between producers of commercial products and their competitors to permit celebrities to vindicate property rights in their identities against allegedly misleading commercial use by others and may serve to protect a variety of names and likenesses. In order to prevail on a false advertising claim under §43(a) of the Lanham Act, a celebrity must show that use of his or her name is likely to cause confusion among consumers as to the affiliation or sponsorship

25 Ref?
26 *Kelly v. Arriba, supra*, note 23.
27 At p. 000.



between the defendant and the celebrity's goods or services.

For example, courts have held that the image and name of an individual are protected under the Act. In *Allen v. National Video, Inc.*²⁸ and *Allen v. Men's World Outlet, Inc.*,²⁹ the actor Woody Allen successfully prevented the defendants from using his likeness in their advertisements. In *Waits v. Frito Law, Inc.*,³⁰ singer Tom Waits prevented the use of his voice in radio commercials and game show host Vanna White was able to prevent a female robot bearing a resemblance to her from being used in a TV commercial advertising electronics products.³¹ If the defendants' unauthorized use creates a false suggestion of endorsement or a likelihood of confusion as to the source of sponsorship, liability may be imposed for trademark or trade name infringement. In the ordinary false endorsement claim, the controlling issue is likelihood of confusion. The courts have applied an eight-factor test to determine customer confusion.

Recent cases, however, have rejected the 'likelihood of confusion' test as insufficiently protective of First Amendment values when the defendant has articulated a colorable claim that the use of the celebrity identity is protected by the First Amendment.

In *Rogers v. Grimaldi*,³² Ginger Rogers, the surviving member of one of the most famous duos in show business history, brought suit against the producers and distributors of a movie entitled *Ginger and Fred*. The film was not about Ginger Rogers and Fred Astaire, but about two fictional Italian cabaret performers who imitated Rogers and Astaire and became known in Italy as 'Ginger and Fred' Rogers asserted claims under §43(a) of the Lanham Act. The Second Circuit began its analysis by noting that "[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection."³³ The court concluded that "[b]ecause overextension of Lanham Act restrictions in the

28 610 F. Supp. 612 (S.D.N.Y. 1985).

29 679 F. Supp. 360 (S.D.N.Y. 1988).

30 987 F.2d 1093 (9th Cir. 1992).

31 *White v. Samsung Electronics American, Inc.*, 989 F.2d 1512 (9th Cir. 1993).

32 875 F.2d 994 (2nd Cir. 1989).

33 *Id.* at 997.



COPYRIGHT AND THE FIRST AMENDMENT

area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”

The Second Circuit court rejected Rogers’ argument that First Amendment concerns are implicated only where the author has no alternative means of expression. Noting that this test had been applied by several courts in the trademark context, the Rogers court rejected the ‘no alternative means’ test because it “does not sufficiently accommodate the public’s interest in free expression[.]”³⁴ The court concluded:

We believe that in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.³⁵

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

The survey evidence, even if its validity is assumed, indicates at most that some members of the public would draw the incorrect inference that Rogers had some involvement with the film. But that risk of misunderstanding, not engendered by any overt claim in the title, is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act.³⁶

The Second Circuit affirmed the district court’s decision granting summary judgment to the defendants.

In *Mattel, Inc. v. MCA Records, Inc.*,³⁷ the Ninth Circuit adopted and applied the Rogers test where the plaintiff asserted

34 *Id.* at 999.

35 *Id.*

36 *Id.*

37 296 F.3d 894 (9th Cir. 2002).



Lanham Act claims against the producer of a song entitled 'Barbie Girl' which evoked the image of plaintiff's famous doll. The court held that in the case of expressive speech, its traditional likelihood of confusion test "fails to account for the full weight of the public's interest in free expression."³⁸ After expressly adopting the Rogers standard as its own, the court set forth the following analysis: "We conclude that MCA's use of Barbie is not an infringement of Mattel's trademark."

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

Mattel was also unsuccessful in its trademark claim against Forsythe. The Ninth Circuit again invoked *Rogers* extending it to uses beyond titles.

When marks "transcend their identifying purpose" and "enter public discourse and become an integral part of vocabulary," they "assume a role outside the bounds of trademark law." Where a mark assumes such cultural significance, the First Amendment protections come into play. In these situations, "the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function."...Mattel's "Barbie" mark has taken on such a role in our culture....³⁹

Applying the *Rogers* test developed in the Second Circuit,⁴⁰ the Ninth Court held Forsythe's use of the Barbie mark

38 *Id.* at 900.

39 2004 U.S. Dist. Lexis 3644 (2004).

40 *Rogers v. Grimaldi* 75 F. 2d 994 (2nd Cir. 1989).



COPYRIGHT AND THE FIRST AMENDMENT

clearly was relevant to his work. The BARBIE mark in the titles of Forsythe's works and on his website accurately described the subject of the photographs, which, in turn, depicted Barbie and targeted the doll with Forsythe's parodic message. Accordingly, the court found that the public interest in artistic expression greatly outweighed the interest in protecting against potential consumer confusion over Mattel's sponsorship of Forsythe's works.

In yet a further victory for artists, in *Mattel, Inc. v Walking Mountain Productions et al.*,⁴¹ the Court granted Tom Forsythe's motion for attorney's fees and costs. The court found that Forsythe was entitled to fees under 17 U.S.C.S. § 505 of the Copyright Act since he validly asserted a defense for fair use protection and his claim furthered the purposes of the Copyright Act. In support of its fee award, the court found that Mattel's arguments had been completely rejected and that the parodic character of the artist's work was clear. Moreover, the court found that the corporation's claims were frivolous and not brought in good faith. The court found that the artist's request for fees under the Lanham Act was also warranted because the case presented the exceptional circumstances that allowed for fees. The artist's parodic intent was clear: the titles of the photographs did not mislead and the Barbie mark was clearly relevant to the artist's work.

In *Rosa Parks v. La Face Records*,⁴² civil rights icon Rosa Parks sued the rap duo OutKast and its record producers for using her name in the title of a song, *Rosa Parks*. Parks is known for refusing to give up her seat to a white passenger and move to the back of the bus, thus beginning the challenge to segregation in the South. Parks sued the defendants in a Michigan state court, alleging, *inter alia*, that this unauthorized use of her name in the song's title infringed her right to publicity, defamed her, and interfered with an ongoing business relationship. After the defendants removed the case to the District Court for the Eastern District of Michigan, Parks added a false advertising claim under section 43(a) of the Lanham Act.

41 2004 U.S. Dist. Lexis 12469.

42 2003 U.S. App. Lexis 8835 (6th Cir. May 12, 2003).



Parks claimed that the *Rosa Parks* title misled consumers into believing that the song was about her or that she was affiliated with the song. The risk of confusion, she argued, was heightened, because her authorized Tribute album was in the marketplace alongside the defendants' album featuring the *Rosa Parks* single. OutKast responded that even if Parks demonstrated some likelihood of consumer confusion, the defendants' First Amendment rights of artistic expression trumped that concern. The District Court granted OutKast's summary judgment motion.

On appeal, the panel began its analysis by broadly interpreting the scope of the First Amendment noting that music has long been a way in which people express ideas and thus is 'firmly ensconced' within the protections of the First Amendment. It then evaluated the three tests that courts have adopted to balance First Amendment interests with the protections of the Lanham Act; (a) The 'likelihood of confusion' test; (b) the 'alternative avenues' test; and (c) the *Rogers v. Grimaldi* test.

Parks urged the court to adopt the alternative avenue test endorsed by the Eight Circuit panel: a title will not be protected from a false advertising claim "if there are sufficient alternative means for an artist to convey his or her idea."

The court found that neither the 'likelihood of confusion' approach nor the 'alternative avenues' test accorded sufficient weight to First Amendment interests and instead settled on the approach developed by the Second Circuit in *Rogers*. Despite adopting the approach of the Second and Ninth Circuit, the Court reversed the decision of summary judgment and remanded to the district court with a strong suggestion that Parks should prevail.⁴³

In *ETW Corp. v. Jireh Pub'g, Inc.*, (Tiger Woods),⁴⁴ the Sixth Circuit held that the Lanham Act section 43(a) should be applied to artistic works only where the public interest in avoiding confusion outweighs the public interest in free expression, adopting the *Rogers* test discussed above.

⁴³ The author believes that the Court misapplied *Rogers*.

⁴⁴ 99 F. Supp 2d 829 (N.D.Ohio 2000) aff'd 332 F. 3d 915 (6th Cir. 2003).



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Jireh Publishing, Inc. ('Jireh') of Tuscaloosa, Alabama, is the publisher of artwork created by Rich Rush ('Rush'). Rush, who refers to himself as 'America's sports artist', has created paintings of famous figures in sports and famous sporting events. A few examples include Michael Jordan, Mark McGuire, Coach Paul 'Bear' Bryant, the Pebble Beach Golf Tournament, and the America's Cup Yacht Race. Jireh has produced and successfully marketed limited edition art prints made from Rush's paintings. In 1998, Rush created a painting entitled *The Masters of Augusta*, which commemorates Tiger Woods' victory at the Masters Tournament in Augusta, Georgia, in 1997.

The Court held that the print was protected by the First Amendment as a work of artistic expression. The presence of Woods in the print had artistic relevance to the print's subject matter and did not explicitly mislead as to source.

The dissent criticized the majority's sweeping holding and dismissed it point by point. The dissent was also critical of the majority's failure to meaningfully consider plaintiff's survey evidence on the issue of consumer confusion. Sixty-two percent of respondents thought Woods was affiliated with the poster. "Rush's work consists of much more than a mere literal likeness of Woods. It is a panorama of Woods' victory ... A piece of art that portrays a historic sporting event communicates the value our culture attaches to such..." The cogent written dissenting opinion can only be viewed as adopting an approach which provides greater weight to a celebrity's commercial interest in his name.

What if a museum or photo archive publishes a poster of a celebrity? What if a museum, film or photo archive reproduces works in its collection, which include an image of the celebrity on a calendar or tee shirt? What if the museum or archive either holds the copyright to or is licensed to use the photograph embodying the image? What if an artist uses the celebrity image in a painting? When do artistic uses of celebrity identities become commercial exploitation beyond the protection of free expression and the First Amendment?

Unlike Great Britain where there is virtually no protection for the right of publicity, the prospect of a successful claim is much better in the United States, where the right of



publicity is widely recognized and is a matter of the statutory and common law in twenty-eight states. The right of publicity is an intellectual property right, which has been defined as the inherent right of every human being to control commercial use of one's identity.

Second Circuit Judge Jerome Frank explicitly recognized the right as an independent action in 1953 in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,⁴⁵ holding that New York's common law protected a baseball player's right in the publicity value of his photo.

Somewhat paradoxically, the right of publicity originally developed from the common law right of privacy – the right to be left alone.⁴⁶ Under privacy law, the dividing line between First Amendment protection and privacy was public communication of accurate, newsworthy information. Expression that was not newsworthy (i.e. commercial) did not raise constitutional concerns.⁴⁷ Although the right of publicity grew out of the right of privacy, it has within it other rights; thus, it has been described as a *sui generis* mixture of personal rights and property rights and rights of unfair competition. While a majority of states recognize some protection against the commercial exploitation of a person's name, likeness and, in some cases, other aspects

45 202 F.2d 866 (2nd Cir.).

46 Warren and Brandeis, 'The Right to Privacy' 4 *Harv. L. Rev.* 193 (1890).

47 Samuel Warren and Louis Brandeis introduced the concept of the common law right of privacy into American law more than a century ago. The authors expressed the need to protect individuals from the undesired exploitation of their personal anonymity. The concept of privacy in American law developed into a tort that protects against four distinct but interrelated invasions of personal privacy: "(a) unreasonable intrusion upon seclusion of another...; or (b) appropriation of the other's name or likeness...; or (c) unreasonable publicity given to the other's private life...; or (d) publicity that unreasonably places the other in a false light before the public..."

Normally, the right of privacy offers public figures less protection than it does to non-public figures. False light privacy cases in the U.S. jurisprudence have tended to be confused with defamation: as a result, the false light privacy claim has been so limited as to be virtually extinct in U.S. jurisprudence.

In New York, the right of privacy is governed solely by sections 50 and 51 of the New York Civil Rights Law, which prohibit the unauthorized use of an individual's portrait or picture for advertising or trade purposes without his written consent. New York courts have held, however, that the law does not apply to the use of a person's image in connection with the reporting of newsworthy items. The law prohibits otherwise newsworthy items only when they are advertisements in disguise or when the use of a person's image bears no real relationship to the story.



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of persona, state law varies widely in terms of whether protection is limited to living persons, the extent and nature of the protection, and the conflict of laws principles used to determine the applicable substantive law.

Indiana, to cite the most extreme example, includes protections against the unauthorized taking of 'distinctive gestures and mannerisms', name, voice, signature, photograph, image, and likeness, and provides protection for 100 years after death irrespective of the domicile of the claimant.

It is generally agreed that the Lanham Act cannot provide a federal vehicle for the assertion of infringement of the state law right of publicity since Section 43(a) is limited to some form of falsity, while infringement of the right of publicity involves no element of falsity.

In order to state a cause of action based on the right of publicity, a plaintiff generally must demonstrate that she or he has a valid and enforceable right in the identity in issue, and that the defendant has infringed upon that right through the unauthorized appropriation of the identity for commercial purposes. When the right of publicity of a deceased individual is asserted, the inquiry is whether the right survives death, and for how long. Several states, including New York, Illinois and about seven others, have rejected the concept of the right of publicity after death. A growing number of states, in addition to Indiana, notably California (50 years) and Florida (40 years), however, now recognize this *post-mortem* right, for a set period of years following death. (Publicity claims may, therefore, extend longer than privacy claims which do not survive a person's death.)

The easiest cases for the right of publicity are those involving a person's image in advertisements. In nearly every state, it is not permissible to use without consent the name or likeness of a living person to advertise a product. This protection for the right of publicity exists even if it is clear from the advertisement that the celebrity is not endorsing the product. For example, the use of Spike Lee's image in an advertisement for Sal's pizza restaurant would violate these laws, even though it is unlikely that anyone would think that Spike Lee is endorsing the restaurant.



There is an inherent tension between the right of publicity and the right of freedom of expression under the First Amendment. In a series of recent cases, several circuits have been called upon to establish the boundaries between the right of publicity and the First Amendment.

In *Cardtoons, L.C. v. Major League Baseball Players Assoc.*,⁴⁸ the Tenth Circuit held that the plaintiff's First Amendment right to free expression outweighed the defendant's proprietary right of publicity. The plaintiff in *Cardtoons* contracted with a political cartoonist, a sports artist, and a sports author and journalist to design a set of trading cards, which featured readily identifiable caricatures of major league baseball players with a humorous commentary about their careers on the back. In striking the balance between the players' property rights and the defendant's First Amendment rights, the Court in *Cardtoons* commented on the pervasive presence of celebrities in the media, sports and entertainment. The Court noted that celebrities are an important part of our public vocabulary and have come to symbolize certain ideas and values.

In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,⁴⁹ the California Supreme Court determined that only sufficiently 'transformative' art was entitled to First Amendment protection against right of publicity claims. The Court made two important and cautionary observations. First:

the rights of publicity cannot, consistent with the First Amendment, be a right to control the celebrity's image by censoring disagreeable portrayals. Once the celebrity thrusts himself or herself forward into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope.

Second:

in determining whether the work is transformative, courts are not to be concerned

48 95 F.3d 959 (10th Cir. 1996).

49 25 Cal. 4th 387, 21 P.3d 797 (Cal. 2001), cert. denied, 151 L. Ed. 2d 692, 122 S. Ct. 806 (2002).



with the quality of the artistic contribution – vulgar forms of expression fully qualify for First Amendment protection...⁵⁰

The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.

The Court also cautioned against the wholesale importation of copyright's fair use doctrine into the right of publicity albeit incorporating one of its most troublesome strands. Despite the apparently broad protection set forth in the Court, applying the transformative test to the charcoal sketch into lithographs the Court found the work unprotected noting the artist's skill subordinate to the overall goal of creating a conventional portrait to exploit his fame. Particularly troublesome is the Court's standardless subsidiary test: "Courts may find it useful particularly in close cases to inquire, 'Does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted?'"

In *Winter v. DC Comics*,⁵¹ the California Supreme Court applied the *Comedy III*? balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant transformative elements to the celebrity likeness. Unlike *Comedy III*, where the Court concluded that the lithographs on t-shirts bearing the likeness of The Three Stooges were not sufficiently transformative, in *Winter*, the comic books containing characters that evoke musician brothers Johnny and Edgar Winter contain something more than mere celebrity likeness:

The artist in *Comedy III* essentially sold, and devoted fans bought, picture of The Three Stooges, not transformed expressive works by the artist. Here, by contrast, defendants essentially sold, and the buyers purchased, DC Comics depicting fanciful, creative characters, not pictures of the Winter brothers. This makes all the difference.

⁵⁰ *Id.*

⁵¹ 69 p.3d 473 (Cal 2003).



In *Hoepker v Kruger*,⁵² the plaintiffs, an artist and his/her subject, alleged copyright infringement and unfair competition as to the artist's photographic image, and violation of the subject's right of privacy. The defendants, a public art gallery and private individual, moved to dismiss.

The Court concluded that

We believe that in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.⁵³

The artist let the copyright lapse on the image issue for a period of time before it was restored. When the image was in the public domain, the defendants used the image in a variety of ways. The court held that the defendants were reliance parties and, as such, were able to engage in acts that infringed the artist's restored work until, and for twelve months after, the artist gave formal notice. The artist never gave the requisite notice. The court also held that the composite piece created and sold by the defendants was shielded from the subject's right of privacy claim. The composite image made by the artist Barbara Kruger was pure First Amendment speech in the form of artistic expression, with sufficiently transformative elements to satisfy case law. The court observed that New York and California courts have taken a different approach to privacy/artistic expression issues:

New York courts have taken the position in the right of privacy context that art is speech, and accordingly, that art is entitled to First Amendment protection vis-à-vis the right of privacy.

The California courts recently took a slightly different position on the issue in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 21 P.3d 797 (Cal. 2001), cert. Denied, 151 L. Ed. 2d 692, 122 S. Ct. 806 (2002), determining that only sufficiently 'transformative' art was entitled

52 200 F. Supp 2d 340 (S.D.N.Y. 2002).

53 *Id.*



to First Amendment protection against right of publicity claims...⁵⁴

The court went on to hold that whether the New York standard or the ‘transformative’ requirement from the California courts was applied,

... the Kruger Composite should be shielded from Dabney’s right of privacy claim by the First Amendment. The Kruger Composite itself is pure First Amendment speech in the form of artistic expression (with sufficiently transformative elements to satisfy *Comedy III*) and deserves full protection, even against Dabney’s statutorily-protected privacy interests...⁵⁵

Museums will benefit from the court’s conclusion that the Whitney also could no be held liable for publishing the Whitney’s display of the Kruger Composite in the Exhibit Catalog since “is pure speech, made to further discussion and commentary on Kruger and her body of work...”⁵⁶

Parks and Woods discussed *supra*⁵⁷ each involved a publicity claim. The Court in *Woods* in resolving the claim stated:

We conclude that in deciding whether the sale of Rush’s prints violate Woods’ right of publicity, we will look to the Ohio case law and the Restatement (Third) of Unfair Competition. In deciding where the line should be drawn between Woods’ intellectual property rights and the First Amendment, we find ourselves in agreement with the dissenting judges in *White*, the Tenth Circuit’s decision in *Cardtoons*, and we will follow them in determining whether Rush’s work is protected by the First Amendment. Finally, we believe that the transformative elements test adopted by the Supreme Court of California in *Comedy III Productions*, will assist us in determining where the proper balance lies between the First Amendment and Woods’

54 *Id.*

55 *Id.*

56 *Id.*

57 *Supra*, text accompanying notes 43 and 45.



intellectual property rights...

In regard to the Ohio law right of publicity claim, we conclude that Ohio would construe its right of publicity as suggested in the Restatement (Third) of Unfair Competition, Chapter 4, Section 47, Comment d., which articulates a rule analogous to the rule of fair use in copyright law. Under this rule, the substantiality and market effect of the use of the celebrity's image is analyzed in light of the informational and creative content of the defendant's use. Applying this rule, we conclude that Rush's work has substantial informational and creative content which outweighs any adverse effect on ETW's market and that Rush's work does not violate Woods' right of publicity...

Finally, applying the transformative effects test adopted by the Supreme Court of California in *Comedy III*, we find that Rush's work does contain significant transformative elements which make it especially worthy of First Amendment protection and also less likely to interfere with the economic interest protected by Woods' right of publicity. Unlike the unadorned, nearly photographic reproduction of the faces of The Three Stooges in *Comedy III*, Rush's work does not capitalize solely on a literal depiction of Woods. Rather, Rush's work consists of a collage of images in addition to Woods' image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods' achievement in that event. Because Rush's work has substantial transformative elements, it is entitled to the full protection of the First Amendment. In this case, we find that Woods' right of publicity must yield to the First Amendment.⁵⁸

What is important is that in both *Cardtoons* and *Woods*, the facts that commercial use was made of the baseball trading

58 *ETW Corp. v. Jireh Pub'g, Inc.*, 99 F. Supp 2d 829 (N.D.Ohio 2000) aff'd 332 F. 3d 915 (6th Cir. 2003).



and posters did not deprive defendants of the protection of the First Amendment. Remarkably different from earlier cases, the court deemed it irrelevant to full First Amendment protection that *Jireh* is a profit making entity and that 5,000 posters had been created. “Speech is protected even though it is carried in a form sold for profit.”

The dissent in *Woods* applying the test of *Comedy III* arrived at the opposite conclusion, at least so as to require a full evidentiary hearing. Not surprisingly, the transformative elements test of *Comedy III* has come under intense criticism, in part (correctly in the opinion of this author), because the California Supreme Court has failed to create a clear standard by importing part of an ‘already confused’ paradigm from copyright law.

One has only to contrast the application of the tests and the results in *Parks* and *Woods* and *Comedy III* and *Winters* to recognize the lack of predictability in outcomes and, despite protestations by the judiciary to the contrary, ample room for subjective value judgments in deciding when an artist has overstepped the limits of First Amendment protection in naming and advertising his work. Such subjectivity and lack of predictability can only chill legitimate artistic expression.

Concepts such as *droit moral*, fair use and fair dealing, free speech, and rights of publicity differ from jurisdiction to jurisdiction. In this essay, I have argued that judicial decisions and legislation have created doctrines such as ideas/expression, fair use and the non-protectability of fact to create breathing space within intellectual property law to protect the values of free expression as embodied in the First Amendment. Currently there is no international standard for fair use, but efforts to develop such a standard through harmonization would benefit both the creator and user of intellectual content within the current global distribution system. Similarly, recent decisions in Europe have recognized a right of privacy, apparently broader than in the United States. Recent decisions can prove to be instructive to the evolution of such jurisprudence.

Efforts to harmonize must strive to achieve the sensitive and delicate balance required to avoid over-protection and under-protection. In seeking to achieve such balance, a



careful weighing of the interests involved in each doctrine is critical to providing adequate protection for artistic expression at the same time that the public's right to a rich public domain is respected.

As a cautionary note, the development of vague and subjective tests and the blending of tests of one doctrine with that of another should be avoided.