

## **CASE: ETW Corp. v. Jireh Publishing, Inc.**

99 F.Supp.2d 829

N.D.Ohio,2000.

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**PARTIES:** ETW is the exclusive licensing agent of Tiger Woods. Jireh is an art publisher based in Alabama, and the exclusive publisher of "sports artist" Rick Rush

**OVERVIEW and PROCEDURAL NOTES:** This is a very narrow trademark decision, and is almost entirely procedural, based on various summary judgment motions, rather than substantive on the issue of TM (let alone RoP). The case has virtually no precedential value on Right of Publicity at all, and it is a decision from Ohio which is not generally regarded as a leading jurisdiction on IP cases (that said, the famous human cannonball case, Zachini, originated in Ohio and is the only RoP decision that has gone to the US Supreme Court, where SCOTUS officially recognized the validity of the RoP, even as it outweighed the right of the broadcaster to broadcast the "news" of Zachini's cannon ball act). Back to Tiger Woods, while the original lawsuit pleaded violation of Ohio's COMMON LAW Right of Publicity (complaint filed before Ohio passed its statute later in 2000), by the time the summary judgments were in front of the court, plaintiff was not even pleading RoP anymore, banking on its TM position entirely. That said, the Court in this case respectfully got it wrong. They were swept in by the allure of First Amendment defenses, and issued a ruling that is deserving of criticism as it misapplies key Intellectual Property concepts.

**BASIC FACTS:** ETW owns numerous TMs for the mark "Tiger Woods" including categories of art prints, calendars, photographs, notebooks, pencils, pens, posters, trading cards--Class 16. Rush created an art print called "The Masters of Augusta" featuring Tiger Woods in the center, and a text that comes with the print (not on the print) said the print features Woods "displaying his awesome swing, flanked by his caddie." This work was sold as a limited edition print.

**TM RULING:** Court ruled on summary judgment that, while Woods owns various TM interests in his name, his image, as it appears in the print, is not used as a TM, and Woods and ETW were not able to show that they use the image of Tiger Woods as a TM. The court notes that the NAME Tiger Woods, which is a mark, does not appear on the print, only in the narrative insert. You should know that in the Tiger Woods case, the judge looks at the Pirone decision, and says the facts are similar in reaching the same conclusion the court did there. I wouldn't mention it, but the reporter might pick up on the fact that we represent Babe Ruth and Pirone was about Babe Ruth. The court overlooks the fact that the Lanham Act is supposed to also protect against the suggestion of false association and sponsorship, and a poster of this nature could easily convey the message to consumers that Tiger Woods was authorizing this use of his image. However, the decision underscores the importance of these celebrities to get broader protection of their name image and likeness. Tiger Woods really should have some TM registrations on his IMAGE, not just his name.

**ROP APPLICATION:** Had the court not issued a summary judgment ruling solely on the TM claims before the court, the court SHOULD have gotten into the "single and original" language that is included in most Right of Publicity statutes. In interpreting a statute, every word is to be given its plain meaning. There is a reason, then, that so many statutes designate "single AND original." Thus, it is plain logic that a "limited edition" is no longer single or original. Single means one. Limited Edition means numerous copies, and we all know that Limited Edition could be 5 or 500 or 5000. Original also means the actual work of art created by the artist. Here, the prints are mechanically reproduced. It is noteworthy that the Copyright Act of 1976 defines a "work of visual art" as "a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author." By applying the universally accepted logic of the Copyright Act, the Court's notion that 5000 prints constitute exempted art is ludicrous. So the defense of First Amendment, which DOES allow an artist

to create a single, original work of art, SHOULD NOT apply to mechanically reproduced, mass copied prints. Ohio's RoP law passed in 2000 (OH ST s.2741.01), does not even contain the usual list of exemptions. Those exemptions are contained in most state statutes and function to protect obvious First Amendment priorities, like newspaper reporting, the right to author books, create screenplays, and create single and original works of art.

**IMPORTANT NOTE:** This case is very similar to facts in the Comedy III case (Saderup/Three Stooges) out of California (appeal ruling issued Jan. 2000). In this case, the court got it RIGHT and went through an intricate weighing of First Amendment principles against the Right of Publicity. The Court there ruled that the artist had a right to create his single, original charcoal sketch. The First Amendment allows that. But when Saderup put his sketch on t-shirts, it was obvious then that he was simply trying to hawk Three Stooges goods. The First Amendment does not reach this far, and this is exactly what the Right of Publicity is supposed to prevent. And that is the perfect balance. Yes, the artist can create his work but the right of the celebrity to control the commercial use of his name, image or likeness outweighs the artist's right to reproduce his art for commercial gain. Thus, RoP does not impede the 1st Amendment rights in any way. But when the artist tries to sell t-shirts without authorization of the Three Stooges, he does not deserve 1st Am. protection, as he is now a common infringer.