

**COMMENT: THE *TIGER WOODS* CASE—HAS THE SIXTH
CIRCUIT ABANDONED TRADEMARK LAW? *ETW CORP.*
*V. JIREH PUBLISHING, INC.***

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I. INTRODUCTION

For more than fifty years, the United States Court of Appeals for the Sixth Circuit vigilantly protected the intellectual property rights of trademark owners and persons seeking protection of their privacy and rights of publicity. Less than two years ago, that changed. In a turnaround remarkable for its suddenness and completeness, the court veered away from protecting intellectual property rights. Perhaps the reason for the departure lies in the stinging reversals of two of its decisions by the United States Supreme Court,¹ or perhaps it lies in a string of admittedly questionable cases brought by overreaching plaintiffs. Regardless of the reasons, the new precedents are now out

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1. The Supreme Court's one-two punch at Sixth Circuit intellectual property decisions came in *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001) and *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003). In *Traffix*, the Sixth Circuit relied upon the Supreme Court's test in *Qualitex Co. v. Jacobson*, 514 U.S. 159, 165 (1995), for determining whether trade dress is functional, and therefore, not protectable. *Traffix*, 532 U.S. at 27-28. The Sixth Circuit found the two-spring device used on traffic construction signs to enable them to flex in the wind to be non-functional. *Mktg. Displays, Inc. v. Traffix Devices, Inc.*, 53 U.S.P.Q.2d 1335 (6th Cir. 1999). The Supreme Court reversed, informing the Sixth Circuit that it had "misinterpreted" the *Qualitex* language. *Traffix*, 532 U.S. at 32.

In *Moseley*, the Supreme Court reversed the Sixth Circuit's holding that Moseley's use of the term "Victor's Little Secret" on a retail store selling sex toys diluted the Victoria's Secret trademark. 537 U.S. at 434. Ignoring the legislative history of the Federal Trademark Dilution Act, and its reason for being (to prevent a famous mark from being weakened, diluted or tarnished by unrelated third party uses), the Supreme Court held that proving dilution requires a plaintiff to show that the diluting term has already caused actual harm to its trademark. *Id.* at 433.

there and plaintiffs everywhere must think twice about bringing a trademark case in the Sixth Circuit.

The Sixth Circuit should not be proud of its legal reasoning and analysis in the 2003 decision *ETW Corp. v. Jireh Publishing, Inc.*² (hereinafter “*Tiger Woods*”³). In a 2-1 decision, the Sixth Circuit held that it was perfectly acceptable for an “artist” to use Tiger Woods’ image and highly-marketable persona to generate 250 serigraphs and 5,000 lithographs featuring Woods in a pose that is strikingly similar to a poster of Woods that is licensed to and sold by Nike. The stated rationale for this decision was an inexplicable reliance on the First Amendment—and nearly no citation to the entire body of unfair competition, trademark or right of publicity law—to justify the defendant’s outright commercial misappropriation of Woods’ persona and right of publicity.

To truly appreciate the complete about-face represented by *Tiger Woods*, a review of prior Sixth Circuit precedent is necessary.

II. BACKGROUND

A. *The Sixth Circuit and the Law of Unfair Competition*

Even before the enactment of the Lanham Act⁴ in 1946, the common law of unfair competition was highly developed in the Sixth Circuit and elsewhere. As early as 1934, in *Chesebrough Manufacturing Co. v. Old Gold Chemical Co.*,⁵ the Sixth Circuit set out the basis for recognizing and distinguishing unfair competition from trademark infringement:

It is not contended that the [defendant] has so closely simulated plaintiff’s trade-marks as to amount to infringement The contention is that it has so simulated in coloring and marking the caps, cartons, and labels of the appellant as to mislead the purchasing public. Simulation amounting to unfair competition does not reside in identity of single features of dress or markings nor in indistinguishability when the articles are set side by side, but is to be tested by the general impression made by the offending article upon the eye of the ordinary purchaser or user. If the general impression which it makes when seen alone is such as is likely to lead the ordinary purchaser to believe it to be the original article, there is an unlawful simulation. . . .

2. 332 F.3d 915 (6th Cir. 2003).

3. *Id.* at 918 (showing that “ETW” stands for Eldrick (Tiger) Woods).

4. Lanham Trademark Act, 15 U.S.C. §§ 1051-1141 (2005).

5. 70 F.2d 383 (6th Cir. 1934), *cert. denied*, 293 U.S. 599 (1934).

It is true that [defendant] places on its article distinguishing marks by which it could be identified by a careful and discriminating purchaser, but this is not enough, for it is the casual or ordinary purchaser who must be protected⁶

1. The Moral Underpinnings of the Law of Unfair Competition

Cases from the early part of the last century emphasize the moral nature—in essence, the “unfairness”—of practices prohibited under the common law of unfair competition. For example, in the Second Circuit’s 1910 decision by Judge Coxe in *Florence Manufacturing Co. v. J. C. Dowd & Co.*,⁷ the Court reasoned:

It is so easy for the honest business man, who wishes to sell his goods upon their merits, to select from the entire material universe, which is before him, symbols, marks and coverings which by no possibility can cause confusion between his goods and those of his competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish between them.⁸

Likewise, in *American Chiclet Co. v. Topps Chewing Gum, Inc.*,⁹ the Second Circuit restrained the defendant from using a package similar to plaintiff’s Chiclets. Judge Learned Hand wrote:

It would be absurd to see in this anything but a hope to bring to its own net just those buyers who are on the fringe of the plaintiff’s customers. . . . [A]s soon as we see that a second comer in a market has, for no reason that he can assign, plagiarized the ‘make-up’ of an earlier comer, we need no more; for he at any rate thinks that any differentia he adds will not, or at least may not, prevent the diversion and we are content to accept his forecast that he is ‘likely’ to succeed.¹⁰

Subsequent to passage of the Federal Trademark (Lanham) Act of 1946, cases from the Sixth Circuit continued to follow this line of reasoning, focusing on the intent of the alleged infringer. The court took businesses to task when their actions crossed over the line from fair to unfair competition. The sense of moral outrage continued. Courts everywhere looked to the legislative history of the Lanham Act to conclude that Congress intended to fashion a federal remedy against the

6. *Id.* at 384–85 (internal citations omitted).

7. 178 F. 73 (2d Cir. 1910).

8. *Id.* at 75.

9. 208 F.2d 560 (2d Cir. 1953).

10. *Id.* at 562-63.

kind of unfair competition that the common law had effectively protected. Thus, in *Federated-Mogul-Bower Bearings, Inc. v. Azoff*,¹¹ the Sixth Circuit noted that the purpose of the Lanham Act was to “eliminate deceitful practices in interstate commerce involving the misuse of trademarks, but along with this it sought to eliminate other forms of misrepresentations which are of the same general character even though they do not involve any use of what can technically be called a trade-mark.”¹²

In the important 1982 case of *Frisch’s Restaurants, Inc. v. Elby’s Big Boy of Steubenville, Inc.*,¹³ the Sixth Circuit found that § 43(a) “created a *sui generis* federal statutory cause of action for ‘false representation.’”¹⁴ In *Frisch’s*, the court enjoined a former franchisee of the Big Boy restaurant chain in Ohio from engaging in advertising which came across the West Virginia border into Ohio, finding that:

Frisch’s primary concern is that Ohio consumers will assume that all Elby’s restaurants, including the Ohio Elby’s, sell food which is sponsored by or originates from the Big Boy chain of restaurants. This court previously concluded that false representations about the origin of source or manufacture of goods are prohibited by the false designation of origin clause of § 43(a). (False) representations of the source of a product constitute the common-law tort of [‘]unfair competition,’ or, as it is otherwise known, [‘]passing off.[‘]¹⁵

One year later, Judge Rubin, of the United States District Court for the Southern District of Ohio in Cincinnati, also relied on § 43(a) to sustain a federal cause of action for the common law tort of passing off, and re-emphasized the moral underpinnings of the law of unfair competition. In *Kroger Co. v. Johnson & Johnson*,¹⁶ Kroger sought a declaratory judgment that their acetaminophen products did not infringe or compete unfairly with the Johnson & Johnson’s “Tylenol” name and trade dress. Kroger had adopted three different trademarks, Actenol, Suprenol and Hydranol, as well as similar color combinations to those of Tylenol, for its house brands. Moreover, and of crucial importance to

11. 313 F.2d 405 (6th Cir. 1963).

12. *Id.* at 409. It was not until the passage of the Trademark Law Revision Act of 1988 (hereinafter “TLRA”) that the definition of “trademark” was revised to clearly encompass trade dress. *Id.*

13. 670 F.2d 642 (6th Cir. 1982).

14. *Id.* at 646, (quoting *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 659, 702, 212 U.S.P.Q. 904, 910-11 (5th Cir. 1981)).

15. *Id.* at 646-47 (citations omitted).

16. 570 F. Supp. 1055 (S.D. Ohio 1983).

Judge Rubin's analysis, evidence was introduced that Kroger intentionally chose color combinations that were "reminiscent" of the famous Tylenol trade dress, and Johnson & Johnson also introduced a survey that indicated both likelihood of confusion and a belief that Kroger's products were manufactured by Tylenol.¹⁷

Not surprisingly, at least at that point in time, the court found Kroger's use of the Tylenol color combinations was not accidental, and that Kroger had intentionally traded off Tylenol's name and trade dress.¹⁸ Repeating a theme, Judge Rubin once again looked to the congressional intent of the Lanham Act, quoting the Act itself, "the intent of this Chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce . . . [and] to protect persons engaged in such commerce against unfair competition"¹⁹

Judge Rubin then concluded:

While nursery rhymes have no known precedential value, they frequently contain concepts of inherent wisdom. This case is somehow reminiscent of the plight of the Little Red Hen whose friends declined to plant, harvest or thresh the wheat; grind or bake the flour, but were all too ready to share with her the bread that resulted.²⁰

2. The Role of the Defendant's Intent

The *Kroger* decision also illustrates the continuing importance of intent in the courts' analyses of trademark infringement and unfair competition cases at this time. As discussed *infra*, the moral underpinnings of unfair competition law are well-established. Indeed, over the years, many district courts in the Sixth Circuit have found that an intent to trade off someone else's name, trademark, or investment should be prohibited—whether or not the activity strictly fell within the Lanham Act or common law of unfair competition.

17. See *id.* at 1057 n.4.

The following dialogue occurred during opening statement of counsel for the plaintiffs:

THE COURT: ' . . . you have selected intentionally the color combination of Tylenol. Is that correct?'

MR. DOOLEY [Counsel for plaintiffs]: 'That is correct. It is similar. It was definitely intended to be reminiscent'

Id. at 1057 n.4.

18. *Id.* at 1059.

19. *Id.* at 1058 (quoting 15 U.S.C. § 1127 (1983)) (emphasis added by the court).

20. *Id.* at 1060.

For example, in the 1983 case of *Wendy's International, Inc. v. Big Bite, Inc.*,²¹ Judge Duncan enjoined the defendant restaurant chain's TV commercials which featured a pigtailed, freckle faced girl who had been dressed and made up to look like Wendy's Restaurants' famous "Little Wendy."²² In the Big Bite commercial lampooning Wendy's, Big Bite's ersatz "Little Wendy" smiles and says, "ain't no reason to go any place but Big Bite."²³

Judge Duncan did not agree that this was an acceptable parody of Wendy's well-known advertising slogan. Rather, the court found that even though Big Bite's commercial did not misrepresent or make false statements, Big Bite failed to rebut the inference of consumer confusion created by its *intentional* use of Wendy's trademarks.²⁴ Thus, the court granted the injunctive relief sought.²⁵ In closing, referring to the issuing injunction, Judge Duncan said, "ain't no reason to do anything else."²⁶

Likewise, in the 1987 decision, *Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc.*,²⁷ the Court considered the defendant's intent as the primary element in its likelihood of confusion analysis:

Proof of intent to appropriate another's property may be comparable to an expression of opinion by an expert witness; a defendant who purposely chooses a particular mark because it is similar to that of a senior user is saying, in effect, that he thinks there is at least a possibility that he can divert some business from the senior user — and the defendant ought to know at least as much about the likelihood of confusion as the trier of fact.²⁸

Throughout the early 1990s, the Sixth Circuit continued to look to the defendant's intent as a critical factor in its analysis in determining both likelihood of confusion and whether the line between fair and unfair competition had been crossed. In the 1991 decision *Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts*,²⁹ the court found that the exterior design features of plaintiff's "Daytona Spyder" and "Testarossa" sports cars constituted trade dress which had acquired secondary meaning, which was further bolstered by the fact that the

21. 576 F. Supp. 816 (S.D. Ohio 1983).

22. *Id.* at 825.

23. *Id.* at 818.

24. *See id.* at 822-23.

25. *Id.* at 825.

26. *Id.* at 825.

27. 834 F.2d 568 (6th Cir. 1987).

28. *Id.* at 572.

29. 944 F.2d 1235 (6th Cir. 1991).

defendant had intentionally copied the designs.³⁰ The court therefore held that confusion was likely between plaintiff's cars and defendant's replica cars.³¹

In the 1996 case of *Champions Golf Club, Inc. v. Champions Golf Club, Inc.*,³² the Court once again found intent very relevant to its likelihood of confusion analysis.³³ In the *Champions* case, a group of golfers in Lexington, Kentucky built a world-class golf course and adopted the name "Champions Golf Club." They were sued for infringement by the well-known 30 year old Champions Golf Club of Houston, Texas. The Sixth Circuit reversed a lower court finding of no infringement, and remanded the case, focusing on the intent factor, and quoting its 1988 *Wynn Oil*³⁴ decision, "[a]lthough intentional infringement is not necessary for a finding of likely confusion, the presence of that factor strengthens the likelihood of confusion."³⁵

In 1997, the Sixth Circuit was presented with another case that suggested the defendant had knowledge of the plaintiff's registered BIG DADDY'S trademark when it adopted its similar mark. In *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center*,³⁶ the court looked at the evidence showing intentional copying and concluded, "[i]f a party chooses a mark with the intent of causing confusion, that fact *alone* may be sufficient to justify an inference of confusing similarity."³⁷

Thus, over fifty years of Sixth Circuit precedent demonstrated the court's recognition that trademark owners deserved protection in situations where the evidence showed the infringer's actions were intentional.³⁸

30. *Id.* at 1240.

31. *Id.*

32. 78 F.3d 1111 (6th Cir. 1996).

33. *See id.* at 1121.

34. *Wynn Oil Co. v. Thomas*, 839 F.2d 1183 (6th Cir. 1988).

35. *Champions Golf*, 78 F.3d at 1121 (emphasis added). On remand, the district court was directed to make a specific finding with regard to the intent factor. *Id.* A finding of intentional infringement would be significant in that it would show that the Kentucky club intended to capitalize on the mark that it did not own, and that the Kentucky club believed confusion was likely. *Id.*

36. 109 F.3d 275 (6th Cir. 1997).

37. *Id.* at 285 (quoting *Homeowners Group Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1111 (6th Cir. 1991)) (emphasis added).

38. In another setback for plaintiffs, the Sixth Circuit has also begun the retreat on intentional copying, by noting that "intentional copying . . . is not actionable under the Lanham Act absent evidence that the copying was done with the intent to derive a benefit from the reputation of another." *DeGidio v. West Group Corp.*, 355 F.3d 506, 514 (6th Cir. 2004) (citing *DeGidio v. West Group Corp.*, 191 F. Supp 2d 904, 917 (N.D. Ohio 2002)) (ellipsis in original). District Courts have

B. *Legal Recognition and Development of the Right of Publicity*

As early as 1953, the Second Circuit recognized the right of publicity in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*³⁹ In *Haelan*, the plaintiff claimed that the defendant, another chewing gum company, had induced professional baseball players to breach their contracts with plaintiff.⁴⁰ Although the defendant contended that any contract that the baseball players had with plaintiff was merely a release that protected plaintiff from liability for violating the players' right of privacy, the Second Circuit took a broader view in recognizing the commercial value of a famous person's persona:

This right might be called a 'right of publicity.' For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.⁴¹

Seven years later, William Prosser's breakthrough article *Privacy* organized the right of privacy doctrine into four torts, the last being "identity appropriation," or the appropriation of another's name or likeness.⁴² This cause of action protected both commercial and personal interests.⁴³ The commercial aspect of the tort of "identity appropriation" became known as the right of publicity.

In 1977, the United States Supreme Court acknowledged the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*⁴⁴ The Court held that defendant violated the common law rights of Hugo Zacchini, known professionally as the "Human Cannonball," by secretly taping his performance and then broadcasting it on the evening news.

interpreted this to mean that intentional copying alone is not sufficient to prove secondary meaning. *Carlton-Sud Indus. LLC v. Plastics Group, Inc.*, 72 U.S.P.Q.2d 1826, 1828 (E.D. Mich. 2004).

39. 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

40. *Id.* at 869.

41. *Id.* at 868.

42. William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960).

43. *Id.* The other types delineated by Dean Prosser are: (1) intrusion upon one's seclusion or solitude, (2) "public disclosure of embarrassing private facts," and (3) publicity which places one in a false light. *Id.*

44. 433 U.S. 562 (1977).

Significantly, the *Zacchini* Court noted that the defendant's reliance on the First Amendment did not trump *Zacchini's* commercial interests:

There is no doubt that entertainment, as well as news, enjoys First Amendment protection. It is also true that entertainment itself can be important news. But it is important to note that neither the public nor respondent will be deprived of the benefit of petitioner's performance as long as his commercial stake in his act is appropriately recognized. Petitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it.⁴⁵

The Ohio Supreme Court recognized in *Zacchini* that, under common law, "[o]ne who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy, and the use or benefit need not necessarily be commercial."⁴⁶ Thus, Ohio law prohibits the publication of another's name or likeness in a commercial use that draws from that person's "reputation, prestige, or other value associated with him, for purposes of publicity."⁴⁷

The Sixth Circuit subsequently acknowledged that a celebrity's identity can be valuable in the promotion of products, and that a celebrity has an interest that may be protected from the unauthorized commercial exploitation. In *Memphis Development Foundation v. Factors Etc., Inc.*,⁴⁸ a case involving the right of publicity of the late Elvis Presley, the Sixth Circuit acknowledged that, "[t]he famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality."⁴⁹

In 1983, the Sixth Circuit applied its intent-based unfair competition analysis to the common law right of publicity in *Carson v. Here's Johnny Portable Toilets, Inc.*⁵⁰ The suit was based on claims arising from the defendant's adoption of the phrase "Here's Johnny," a phrase undeniably associated with the well-known comedian and *Tonight Show* host Johnny Carson, to identify its portable toilets. The Sixth Circuit majority agreed that while there was no likelihood of confusion or infringement, Carson's right of publicity had been violated by use of "Here's Johnny" on a portable toilet because the defendant

45. *Id.* at 578 (citation omitted).

46. *Zacchini v. Scripps-Howard Broadcasting Co.*, 47 Ohio St. 2d 224, syllabus point 1 (1976), *rev'd on other grounds*, 433 U.S. 562 (1977).

47. *Id.* at 230 n.4.

48. 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 449 U.S. 953 (1980).

49. *Id.* at 957.

50. 698 F.2d 831 (6th Cir. 1983).

intentionally - and admittedly - appropriated his identity for commercial exploitation.⁵¹

C. The Tide Begins to Turn

Despite its longstanding tradition of recognizing and enforcing trademark rights, the Sixth Circuit, in 1998, began to swing in the opposite direction. In a 2-1 decision in *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Productions*,⁵² the Sixth Circuit reversed a trial court's holding that a photographer who took photographs of the Rock & Roll Hall of Fame, produced posters, labeled them as such, and sold them in competition with similar posters sold by the Hall, had not violated the Hall's trademark rights in its very distinctive building design.⁵³ There was evidence that the I.M. Pei-designed building had been arbitrarily designed for protection from imitation.

The *Rock & Roll Hall of Fame* majority attempted to justify the defendant's intentional use of another's property by stating that the building was fanciful, but not in a trademark sense.⁵⁴ The court then reasoned that because the entire building was not protected with trademark registrations depicting the structure from every imaginable angle, posters of the building from any angle were not protectable, and the use of the registered trademark "Rock 'N Roll Hall of Fame" on the poster was deemed "fair use."⁵⁵

The majority opinion in *Rock & Roll Hall of Fame* was poorly written and ignored not only a survey that indicated considerable confusion between identical products, but evidence of a clearly-demonstrated intent by the defendant to profit from its appropriation of the plaintiff's property. Rather than attempting to distinguish earlier Sixth Circuit precedent, it relied upon the Second Circuit's decision in *Pirone v. MacMillan, Inc.*⁵⁶ to argue that the defendant's photographs of the Rock & Roll Hall of Fame did not indicate origin.⁵⁷ However, as

51. *Id.* at 837.

52. 134 F.3d 749 (6th Cir. 1998).

53. *Id.* at 756.

54. *Id.* at 754. Somewhat surprisingly, the Court did not even mention its prior decision in *White Tower System, Inc. v. White Castle System of Eating Houses Corp.*, 90 F.2d 67 (6th Cir. 1937) (holding that White Castle had exclusive rights to its style of building), even though the trial court in *Rock & Roll Hall of Fame* relied upon *White Tower* in issuing its preliminary injunction enjoining the defendant's sale of posters. *Id.* at 754-55.

55. *Id.* at 755-56.

56. 894 F.2d 579 (2d Cir. 1990).

57. *See Rock & Roll Hall of Fame*, 134 F.3d at 755.

will be seen, the *Pirone* case was completely distinguishable, as well as not on point with *Rock & Roll Hall of Fame* or *Tiger Woods*.

Pirone was a trademark infringement and unfair competition case brought by the licensing agent for baseball legend Babe Ruth's daughters. The defendant published *The 1988 MacMillan Baseball Engagement Calendar*, a weekly appointment calendar, in which each week's page included a photograph of a baseball player, baseball field, or other items of interest to baseball fans. Only two of the 52 weeks had photographs of Babe Ruth, and a third week was a photograph of a baseball bearing Ruth's signature. The Second Circuit found that the two photographs of Babe Ruth were used only to identify a great baseball player, and were not an indicator of source.⁵⁸ The overall theme was a baseball calendar—not a Babe Ruth calendar.⁵⁹ Thus, because there was no trademark use of Babe Ruth, the court concluded that there was no infringement.⁶⁰

The *Pirone* court noted that while the § 43(a) unfair competition claim was much broader than the trademark infringement claim, the two photographs of Ruth, like the calendar's back cover picture of Jackie Robinson, and the dozens of other baseball pictures were merely descriptive of the theme of the calendar, and in neither case would a consumer believe that Ruth or Robinson sponsored the calendar.⁶¹ Rather, the Second Circuit reasoned, the source of the publication was clearly indicated by the numerous, prominent references to its publisher, MacMillan.⁶² Nevertheless, even though the use of the photographs in *Pirone* was completely different than the use of the photograph to sell a poster in *Rock & Roll Hall of Fame*, the Sixth Circuit's unfortunate and improper reliance on the case set the court on the course that eventually lead to the even more unfortunate *Tiger Woods* decision.

D. *The Tiger Woods Decision*

1. Facts

In *Tiger Woods*, the defendant produced a painting depicting Eldrick "Tiger" Woods after his first Masters tournament championship entitled "The Masters of Augusta." In addition to the painting, however,

58. *Pirone*, 894 F.2d at 583.

59. *Id.* at 584.

60. *Id.* at 583.

61. *Id.* at 584.

62. *Id.*

the defendant also produced 250 serigraphs and 5,000 lithographs, all of which had the name “Tiger Woods” on the container, and were produced for commercial sale. The painting and prints were very similar to a poster of Woods sold by Nike under license from Woods.⁶³

Woods sued the artist Jireh for trademark infringement, unfair competition, deceptive trade practices, and violation of Ohio’s common law right of publicity.⁶⁴ Woods produced an unrefuted consumer survey that showed 62 percent source confusion as to the sponsorship of the poster, and the evidence was undeniable that defendant had intentionally reproduced Wood’s likeness for commercial profit.⁶⁵ Nevertheless, Woods lost on summary judgment.⁶⁶

2. The Court’s Analysis

The majority’s decision completely ignored long-standing Sixth Circuit precedent on intent, the survey showing actual confusion, and the Supreme Court’s *Zacchini* decision. Instead, the majority relied in part upon dissents from other circuits, it misstated the holdings of virtually every case it cited, and ignored the vast difference in the facts and law between the cases it cited and those in *Tiger Woods*.

First, the Sixth Circuit held, “as a general rule, a person’s image or likeness *cannot* function as a trademark. Our conclusion is supported by the decisions of other courts which have addressed this issue.”⁶⁷ As has been demonstrated, however, the primary case the court relied upon as support for this remarkable assertion, *Pirone*, simply does not stand for that proposition.⁶⁸

The Sixth Circuit also relied heavily on the Second Circuit’s decision in *Rogers v. Grimaldi*⁶⁹ to support its contention that a person’s

63. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 918-19 (6th Cir. 2003).

64. *Id.* at 919. While Ohio now has a right of publicity statute, Ohio Rev. Code Ann. § 2741, *et. Seq.* (2005), at the time the case was brought the statute had not been enacted and *Tiger Woods* relied upon the common law right of publicity that had been developed through such cases as *Zacchini* and *Carson*. *Id.*

65. *Id.* at 942.

66. *Id.* at 919.

67. *Id.* at 922. The Court’s finding that this is a “general rule” is perplexing as it has long been recognized that a person’s image, such as “Colonel” Sanders for food, beverages and restaurant services and Fred Rogers for publications, just to name a few, can clearly be registered and function as trademarks. *See* Federal TM Reg. No. 806,104 (issued Mar. 22, 1966); Federal TM Reg. No. 2,280,908 (issued Sep. 28, 1999).

68. *See supra* notes 59-63 and accompanying text (discussing *Pirone*).

69. 875 F.2d 994 (2d Cir. 1989).

likeness or name cannot function as a trademark.⁷⁰ In that decision, the Second Circuit concluded that the use of “Ginger and Fred” as the title of a motion picture about two fictional Italian cabaret performers did not constitute trademark infringement, because the film made no further reference to Fred Astaire and Ginger Rogers, and because there was no evidence that the film’s patrons were confused.⁷¹ As additional support, the Sixth Circuit then looked to the Ninth Circuit’s decision in *Mattel, Inc. v. MCA Records, Inc.*⁷² That case, brought by Mattel, owners of the Barbie trademark, alleged infringement based upon a song titled “Barbie Girl.” The song, an unflattering parody of the values the songwriter believed the Barbie doll represents, clearly was in no danger of being viewed as endorsed by Mattel, the Ninth Circuit concluded.⁷³

More importantly, however, both of these cases deal with using a third party’s trademark only as a *title* to artistic works that clearly do not suggest any endorsement by or association with the person (or icon) named. As Judge Kozinski, the author of the *Mattel* decision, noted,

If a pair of dancing shoes had been labeled Ginger and Fred, a dancer might have suspected that Rogers was associated with the shoes (or at least one of them), just as Michael Jordan has endorsed Nike sneakers that claim to make you fly through the air. But Ginger and Fred was not a brand of shoe; it was the title of a movie and, for the reasons explained by the Second Circuit, deserved to be treated differently.⁷⁴

Clearly, the cases involving titles to songs or films have no relevance to *Tiger Woods*, in which the defendant’s entire product was Tiger Woods, not just the title. And even though the courts in both the “Fred and Ginger” and “Barbie” decisions recognized the need to balance any claim of “artistic use” with the trademark owner’s rights and the need to avoid confusion, the Sixth Circuit ignored this basic principle of trademark and unfair competition law.⁷⁵

After determining that a person’s name or image could not function as a trademark, the Sixth Circuit then proceeded to decimate its longstanding precedents on unfair competition law. In the face of clear evidence that the defendant’s more than 5,000 copies of Tiger Woods prints were produced for commercial distribution,⁷⁶ the court nonetheless

70. *ETW Corp.*, 332 F.3d at 920, 926-27.

71. *See generally* *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

72. 296 F.3d 894 (9th Cir. 2002).

73. *Id.* at 902.

74. *Id.* at 901-02.

75. *See, e.g., Mattel, Inc.*, 296 F.3d at 906; *Pirone*, 894 F.2d at 583-94.

76. *ETW Corp.*, 332 F.3d at 919. The evidence showed that the serigraphs of the Tiger

determined that the defendant was entitled to the full protection of the First Amendment. The court did not even conclude that the Tiger Woods prints constituted only commercial speech.⁷⁷

For support, the Sixth Circuit looked to questionable California cases, starting with *Hoffman v. Capital Cities/ABC, Inc.*,⁷⁸ a Ninth Circuit decision in which, unremarkably, Dustin Hoffman failed in a right of publicity claim under state law against the monthly *Los Angeles Magazine* that had used a computer generated picture of Hoffman in an article that featured several famous movie stars in digitally-altered photographs. In that case, the Ninth Circuit held that the Hoffman picture was entitled to First Amendment protection because of the “significant transformative elements” of the photograph and because the article was not attempting to trade off the various celebrities depicted therein for commercial gain.⁷⁹

Continuing on with its inexplicable reliance on California case law, the Sixth Circuit then discussed *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,⁸⁰ a California Supreme Court case that actually supports Tiger Woods’ claim. In that decision, the California Supreme Court was asked to determine whether the sale of lithographs and t-shirts bearing the likenesses of the Three Stooges violated their heirs’ right of publicity under California law. The California court flatly rejected a claim that the doctrine of “fair use” be imported into the law of right of publicity, and the court then developed its own “transformative test,”⁸¹ which was approved by the Sixth Circuit in *Tiger Woods*.⁸²

The California court found that when an artist’s skill and talent is subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist’s right of free expression is outweighed by the celebrity’s right of publicity.⁸³ In finding that the artist had violated the rights of publicity of Larry, Curly, and Moe’s heirs, the court noted that the marketability and economic value of an artist’s work derives primarily from the fame of the celebrities depicted.⁸⁴ As the court noted:

Woods painting sold for \$700, and the lithographs were priced at \$100 each. *Id.*

77. *Id.* at 925.

78. 255 F.3d 1180 (9th Cir. 2001).

79. *Id.* at 1184 n.2, 1186.

80. 21 P.3d 797 (Cal. 2001)

81. *Id.* at 808.

82. *ETW Corp.*, 332 F.3d at 936.

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

84. *Id.* at 808-09.

Another way of stating the inquiry is whether the celebrity likeness is one of the “raw materials” from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness. And when we use the word “expression,” we mean expression of something other than the likeness of the celebrity.⁸⁵

Undaunted by the fact that the Woods lithographs were, like the Three Stooges, “the very sum and substance of the work in question,”⁸⁶ the Sixth Circuit concluded that the defendant’s knock off lithographs fit within the test—they were transformative and the First Amendment totally and completely obliterated any claim of unfair competition.⁸⁷

3. The Dissent

Judge Clay wrote a stinging dissent to the majority opinion that not only questioned the majority’s reasoning, but called to task its sweeping and incorrect holding that a person’s likeness could not function as a trademark.⁸⁸ Judge Clay also expressed his dismay at the majority for its failure to even consider Woods’ survey showing significant source confusion, even though the majority had cited Second Circuit law that *required* a balancing of the likelihood of confusion factors when artistic works are involved.⁸⁹ The dissent also noted that while the majority had relied heavily on the California Supreme Court’s “transformative” test set forth in the Three Stooges decision, it had completely ignored the fact that the California court had specifically cited to *Zacchini*, the Ohio human cannonball case, to emphasize that:

85. *Id.* at 809. The California Supreme Court also questioned the decision of the lower court in the *Tiger Woods* decision, *ETW Corp. v. Jireh Publ’g., Inc.*, 99 F. Supp 2d 829, 835-836 (N.D. Ohio 2000), stating:

[T]he court held that a painting consisting of a montage of likenesses of the well-known professional golfer Eldridge [sic] “Tiger” Woods, reproduced in 5,000 prints, was a work of art and therefore protected under the First Amendment. We disagree with the *ETW Corp.* court if its holding is taken to mean that any work of art, however much it trespasses on the right of publicity and however much it lacks additional creative elements, is categorically shielded from liability by the First Amendment.

Id. at 809 n.11.

86. *Comedy III*, 21 P.3d at 809 (Cal. 2001).

87. *ETW Corp.*, 332 F.3d at 938.

88. *See id.* at 922.

89. *Id.* at 945, 945 n.1.

[T]he state's interest in preventing the outright misappropriation of such intellectual property by others is not automatically trumped by the interest in free expression or dissemination of information; rather, as in the case of defamation, the state law interest and the interest in free expression must be balanced, according to the relative importance of the interests at stake.⁹⁰

The dissent further noted that “[t]he majority’s failure to [allow a jury to decide if the evidence of confusion is sufficient to find liability] is in complete contravention to the intent of Congress, the principles of trademark law, and the well-established body of jurisprudence in this area,”⁹¹ and succinctly concluded that “. . . the majority’s analysis not only fails in its disjointed approach but in its outcome as well.”⁹²

III. DISCUSSION—HOW DID WE GET HERE?

Why did it happen? In the words of Pogo, we have met the enemy and he is us! After the Supreme Court’s 1992 decision in *Two Pesos* that trade dress should be treated like any other type of trademark,⁹³ and its 1995 decision in *Qualitex* that a color could be protected as a trademark,⁹⁴ the lower courts were deluged with trademark claims seeking to protect arguably functional products and features that clearly did not function as trademarks.

Judge Posner expressed his frustration in *Publications International, Ltd. v. Landoll, Inc.*,⁹⁵ a case where the plaintiff claimed trade dress rights in the paper, binding and gilding of a cook book:

[A] seller should be encouraged to make his products recognizable by consumers at a glance as *his* product and not that of another seller. . . . On the other hand, a seller should not be allowed to obtain in the name of trade dress a monopoly over the elements of a product’s appearance that either are not associated with a particular producer or that have value to consumers that is independent of identification.⁹⁶

Every circuit was seeing its own *Landoll* case and they did not like what they were seeing. Many of these cases were brought by companies whose patents were expiring. In an effort to extend the life of the patent,

90. *Comedy III*, 21 P.3d at 806.

91. *ETW Corp.*, 332 F.3d at 960.

92. *Id.* at 951-52.

93. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 763 (1992).

94. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 166 (1995).

95. 164 F.3d 337 (7th Cir. 1998).

96. *Id.* at 339.

trade dress claims were made near the end of the patent term with little or no evidence that the product design was promoted as a trademark. Not surprisingly, the courts were not amenable to lawyers attempting to misuse trademark law to prevent competition.

Perhaps in response to this new wave of questionable trademark cases, Congress passed the Trademark Law Treaty Implementation Act (hereinafter “TLT”) in 1998 without any real debate. The TLT amended the Lanham Act so that: (1) incontestable registrations are subject to cancellation at any time on the grounds of functionality; and (2) functionality may be asserted as a defense to an infringement suit, even as to an incontestable registration.⁹⁷ Then, in 2000, the Supreme Court decided *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*,⁹⁸ in which the court held unanimously that in an action for infringement of unregistered trade dress under § 43(a), a product’s design is distinctive, and therefore protectable, *only* upon a showing of secondary meaning.⁹⁹

The Supreme Court was certainly sending a message in 2000 with the *Wal-Mart* decision: it would no longer countenance reliance on *Two Pesos*¹⁰⁰ and *Qualitex* for plaintiffs alleging trade dress protection under the Lanham Act for product features that had never been promoted as trademarks, and had never been recognized by the public as being indicators of source.

Regrettably, and in a remarkably tone-deaf decision, given the overall climate of the courts, the Sixth Circuit then decided the *Traffix* case.¹⁰¹ In that decision, the Sixth Circuit found that springs on a road construction sign, which were once the subject of patent protection, could be source identifying and thus be eligible for trademark protection.¹⁰² The Supreme Court granted certiorari and in 2001 resoundingly reversed the Sixth Circuit’s decision 9-0.¹⁰³

More significantly, however, the Supreme Court’s decision created an incredibly expansive definition of functionality that had originally appeared in a footnote in the 1982 decision, *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*: “[i]n general terms, a product feature is functional [and cannot serve as a trademark] if it is essential to the use or

97. Trademark Law Treaty Implementation Act of 1998, PUB.L. NO. 105-330, 112 Stat. 3064 (amending various sections of 15 U.S.C. §§ 1051-1126) (Oct. 30, 1998).

98. 529 U.S. 205 (2000).

99. *Id.* at 216.

100. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

101. *Mktg. Displays, Inc. v. Traffix Devices, Inc.*, 200 F.3d 929 (6th Cir. 2000), *rev’d*, 532 U.S. 23 (2001).

102. *See id.* at 938-41.

103. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

purpose of the article or if it affects the cost or quality of the article.”¹⁰⁴ Thus, in overruling the Sixth Circuit’s decision in *TrafFix*, the Supreme Court found that once it had been established that the dual spring design of the road sign was functional, the Sixth Circuit was wrong to continue with further analysis – the design could *never* be protected as trade dress.¹⁰⁵

Then in March 2003, the Supreme Court again reversed the Sixth Circuit 9-0 in *Moseley v. V Secret Catalogue*,¹⁰⁶ a dilution decision that can charitably be described as superficial, particularly when contrasted with the Sixth Circuit’s thorough analysis of the Federal Trademark Dilution Act in its overturned decision of *V Secret Catalogue, Inc. v. Moseley*.¹⁰⁷ In light of these two Supreme Court decisions reversing Sixth Circuit decisions 9-0, could there have been discussion among the *Tiger Woods* panel about whether the Sixth Circuit wanted a third trip in three years to the Supreme Court on a trademark case? If so, that is regrettable. But it is wrong to lay the blame for the Sixth Circuit’s caution solely on the marble steps of the high court. We lawyers must take part of the blame for the Sixth Circuit’s skepticism in its current approach to trademark and right of publicity law.

Even after *Tiger Woods* was handed down in September of 2003,¹⁰⁸ lawyers appeared before the Sixth Circuit to argue that the spine cover of a scrapbook album with a dual strap hinge design that permitted pages to lie flat when turned, a spine cover concealing a dual strap hinge and a laminated padded album cover with ribbed edges for reinforcement were trademarks entitled to trade dress protection under § 43(a).¹⁰⁹ In affirming the United States District Court for the Southern District of Ohio, the Sixth Circuit was compelled to re-state the obvious — that purely functional items that were neither promoted nor recognized as trademarks are not eligible for trademark protection.¹¹⁰ The larger issue, however, is why this case was even appealed to the Sixth Circuit in light of the *TrafFix* and *Wal-Mart* decisions, as well as the 1998 amendment

104. 456 U. S. 844, 850, n.10 (1982). *Inwood* was a case that did not even decide functionality. *Id.* The footnote “test” came back out of the closet in *TrafFix*. See *TrafFix*, 532 U.S. at 32.

105. *TrafFix*, 532 U.S. at 32-33.

106. 537 U.S. 418 (2003).

107. 259 F.3d 464 (6th Cir. 2001), *rev’d by* 537 U.S. 418 (2003).

108. Interestingly, the *Tiger Woods* decision was released three and one-half months after the Supreme Court’s *Moseley* decision, even though it had been argued in September 2001. The delay is noteworthy, and not unexpected under the circumstances.

109. See *Antioch Co. v. W. Trimming Corp.*, 347 F.3d 150 (6th Cir. 2003).

110. *Id.* at 154.

to the Lanham Act. Whatever the reason, such questionable cases gave the Sixth Circuit and our district courts reason to be cautious in enforcing our clients' legitimate trademark rights.

So has the Sixth Circuit abandoned trademark and right of publicity law? Unfortunately, at least for now, the answer is yes. With *Tiger Woods* not having been appealed, and with the Supreme Court having thoroughly repudiated the Sixth Circuit's view of trade dress in *TrafFix*, it appears unlikely that this court has any interest in having another trademark or trade dress case reviewed by the Supreme Court. And with the Supreme Court's 9-0 reversal of the Sixth Circuit in the spring of 2003 in the *Moseley* dilution case, it is not surprising that our circuit is now very wary of trademark cases and any related cases protecting such rights.

All is not lost. Perhaps some lawyers will hesitate before they bring suits that attempt to use trademark law to stop lawful competition. Indeed, perhaps it is even time to again consider another substantive review and amendment of the Lanham Act. While Congress cannot overrule the First Amendment, it can restate its belief in strong trademark law, and even consider a Federal Right of Publicity Statute. Whatever means we choose, we have the ability to begin the debate. Unquestionably, this is a subject that now needs to be thoroughly discussed, and lawyers have a responsibility to conduct their practices in a way that moves the courts and/or Congress to protect legitimate trademark and publicity rights.