# ONCE TIGERS WERE PAINTED ON VELVET

By: Jim Astrachan

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Aggressive courtroom play landed Tiger Woods and his licensing arm ETW in the rough when they sued the sports artist, Rick Rush. Rush, they claimed, had violated the golfer's right of publicity and infringed his trademark.

Tiger's suit, which went all the way to the Sixth Circuit Court of Appeals, came about because Rush had painted a picture of Tiger to commemorate his first Masters' victory. The painting, titled *The Masters of Augusta*, depicted five views of Tiger and his caddy, Mike "Fluff" Cowan. From the original painting, Rush, who is known for painting other famous sports personalities, such as Arnold Palmer, Bear Bryant and Michael Jordan, sold limited edition serigraphs and lithographs. 250 serigraphs were sold for $750 each, and 5,000 lithographs were sold for $100 each. That's $875,000, not including postage and handling! Rush's windfall at Tiger's expense had him swinging over the top.

One basis of Tiger's trademark claim under the Lanham Act was his ownership of a trademark registration for the mark TIGER WOODS for use in connection with art prints, calendars and photographs. The basis of Tiger's right of publicity claim was that the artist had painted Tiger's portrait and was selling it for hundreds of thousands of dollars.

Rush, famous in his own right, refers to himself as "America's Sports Artist." He was very careful to brand his Tiger painting by signing it with his name and adding his logo, PAINTING AMERICA THROUGH SPORTS. The artist claimed it was necessary to use Tiger's name to identify the contents of the print package, so Woods' name was printed on the envelope in which each print was packaged in letters only 1/4-inch high. Not to forget the real star, Rush's name was printed in letters 4 inches by 10 inches. History in the body copy mentioned Tiger's name two times.

Tiger sued when the prints hit the market, asking for injunctive relief. In response, Rush conceded several things: That Tiger's picture *was* the subject of his art; that he sold his art for lots of money; and that he printed Tiger's name on the packaging containing the prints. Did Rush's concessions kill his defense to Woods' charges?

How would you have ruled if you were the judge? Would you have enjoined sale of the prints, allowed their sale but awarded Rush's profits to Woods, or would you have ruled that Rush had not violated any of Woods' rights? Well, the trial court dismissed the case, holding that Rush had not violated any of Tiger's rights. Tiger sliced into the woods, threw his driver into the ground and appealed.

<u>The Trademark Claim</u>. The inclusion of his TIGER WOODS mark in the marketing and packaging materials, Tiger asserted, violated his trademark rights. Not so, held the court noting that the mark TIGER WOODS does not appear either on the face of the prints or the title of the art. Although Woods' name did appear it was only on the envelope in which the prints were packaged and two times in the narrative that came with each print. The Lanham Act provides a defense to the use of a registered mark where the use is not in the trademark sense - in other

words, a descriptive use. Following a line of similar cases, the court held that a celebrity's name can be used in the title of a movie, book or painting as long as the use is relevant to the work. Fred Astair couldn't sue over the use of his name in a movie called *Fred and Ginger* as long as the title was relevant to content and not merely a gratuitous attracter. Nor was there any confusion as to source of the art. Rush was clearly identified as the artist, and it was unlikely that any consumer, based on packaging, would believe that Tiger was associated with the production of the art.

The Other Trademark Claim. Following Woody Allen's and Vanna White's success in establishing trademark rights in their identities, Tiger asked the court to do the same for him. "This is an untenable claim," held the court. ["Plaintiff] asks us, in effect, to constitute Woods himself as a walking, talking trademark. Images and likeness of Woods are not protectible as trademarks as they do not perform the trademark function of designation." I guess they do things differently in California and New York where the Vanna and Woody cases were decided in favor of the two actors.

The Right of Publicity Claim. Rush used Tiger's image in his art, and sold the prints for big bucks, but the court properly balanced the artist's First Amendment rights. Triple boogey, Tiger. As long as the art was not used as an advertisement or endorsement of a product the work was considered expressive and protected. Just because the original art became a part of a commercial enterprise designed to make money for the artists through the sale of multiple reproduction does not strip away those protections of free expression. Here's what the court said about the line between violation of publicity rights and free expression:

> When artistic expression takes the form of literal depiction or limitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that

> trespass, the state law interest in protecting the fruits of artistic labor outweigh the expressive interests of the imitative artist.

On the other hand, where works, such as Rush's, contains significant transformative elements, they will be protected as expression under the First Amendment. Andy Warhol learned this lesson as he earned millions selling limited edition prints made from his celebrity paintings.

Interesting case, but I would like to let the Supreme Court decide whether a celeb has a trademark right in his or her persona. Perhaps the lesson to be learned is not that the artist has the right to sell his prints, but that he will have to defend that right in court.

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