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## JUDGES AS CRITICS

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Almost 100 years ago, Justice Oliver Wendell Holmes wrote these often-quoted words in a copyright case: “It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation . . . . At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt.” *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903).

The issue in *Bleistein*—whether copyright protection should be extended to three simple lithographs designed as ads for a circus—appears quaint today. Yet Holmes’ decision sustaining the copyrights provoked a vigorous dissent by Justice John Marshall Harlan, who could not “discover anything useful or meritorious in the design . . . . The jury could not reasonably have found merit or value aside from the purely business object of advertising a show . . . .” *Id.* at 252.

Donaldson’s lithographs no doubt would be considered valuable antiques today, and no modern court would hesitate to find them sufficiently original to merit copyright protection. Yet, as some recent cases show, despite Holmes’ admonition, courts continue to make the protection of intellectual property hinge on subjective judgments about the value and content of the works at issue.

### **Depiction of Three Stooges deemed not ‘transformative’**

An outstanding example is the California high court’s April 30 decision in *Comedy III Productions Inc. v. Gary Saderup Inc.*, 25 Cal. 4th 387 (2001), finding, on the basis of a highly subjective test, that T-shirts decorated with a drawing of the Three Stooges infringed the rights of publicity of the Stooges’ heirs and were not entitled to constitutional protection.

Defendant Gary Saderup described himself as an artist with 25 years of experience in making charcoal drawings of celebrities. His business markets T-shirts with portraits of celebrities ranging from Abraham Lincoln to John Wayne to Patrick Swayze—and the Stooges. Plaintiff Comedy III, the owner of rights to the Stooges comedy act, sued Saderup under California’s right of publicity statute. As then in effect, the California statute prohibited the use of “a deceased personality’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, goods, or services, without prior consent” from the owner of those rights. The statute exempts, among other things, “single and original works of fine art.”

Saderup’s principal defense was that his work was entitled to constitutional protection and therefore could not be regulated under the statute. The court found this a

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“difficult issue,” requiring a balance between the First Amendment and the right of publicity, a right that, “like copyright, protects a form of intellectual property that society deems to have some social utility.” *Id.* at 399. Looking at the plaintiff’s publicity right, the court waxed poetic about the “creative labor” that went into the development of the Stooges’ public identity. Larry, Moe and Curly, the court found, “possess a kind of mythic status in our culture.” *Id.*

The court proceeded to balance these strong rights against constitutional interests. Borrowing an element of the fair use defense codified in § 107 of the Copyright Act, the court fashioned a test based on whether a work is “transformative”—whether it adds something new to previous creative expression: “When artistic expression takes the form of a literal depiction . . . of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.” Stated differently, “the inquiry is 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.” *Id.* at 405-06. Saderup’s drawings flunked that test.

Brushing aside Saderup’s argument that “all portraiture involves creative decisions,” the court could find no “significant transformative or creative contribution” in his work—he had simply drawn what the court called “literal, conventional depictions of the Three Stooges so as to exploit their fame.” *Id.* at 408-09. Sounding perhaps like Harlan, who had belittled Donaldson’s lithographs for their “purely business object of advertising a show,” the court concluded that Saderup’s “skill and talent” had been “subordinated to the overall goal of creating a conventional portrait of a celebrity . . .” 25 Cal. 4th at 408.

The court was quick to add, however, that not all “celebrity portraits” would fail to qualify for constitutional protection. The famous Warhol portraits, it said, would be protected. Warhol’s silkscreens “have as their subjects the images of such celebrities as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.” *Id.* at 408-09.

Most observers would have little difficulty distinguishing between a Saderup and a Warhol—price alone would suffice. But should constitutional protection turn on a judge’s view as to whether a work of art is simple-minded and imitative, or instead conveys “ironic social comment”?

In sharp contrast to *Comedy III* is a recent Ohio federal court decision, now on appeal to the U.S. Court of Appeals for the 6th Circuit, dismissing Tiger Woods’ right of publicity claim against an artist who created a print featuring the famous golfer’s image. *ETW Corp. v. Jireh Publishing Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000). ETW, Tiger Woods’ exclusive licensing agent, sued Jireh, the publisher of the work of Rick Rush, a self-described “sports artist.” *Id.* at 835. Inspired by Woods’ tournament victories, Rush

created a “limited edition” (5,000 copies) “art print” titled “The Masters of Augusta,” featuring Woods and his Masters caddie.

The district court first dismissed ETW’s claim that Rush’s print constituted trademark infringement. The court found that ETW had failed to show that it used the image of Woods as a trademark. To the contrary, posters of Woods authorized by ETW used a variety of different images, no one of which was used as a trademark—an identifier of source.

ETW’s right of publicity claim, asserted under Ohio common law, met the same fate. While ETW called the prints “merely sports merchandise,” the court was more convinced by Rush’s claim that they are paintings that express “the majesty of a newsworthy moment.” *Id.* at 834. Rather than balancing constitutional concerns against the publicity right, as the *Comedy III* court had done, the ETW court instead simply considered whether Rush’s work was sufficiently expressive to merit First Amendment protection.

The *ETW* case has generated a great deal of interest on appeal. Several law professors have signed an amicus brief urging affirmance. Their brief argues that the print is “unambiguously fully protected speech over which ETW cannot exercise control,” and that the case presents “an opportunity to bring the law governing publicity rights into closer conformity with current understandings of constitutional law.” “Amicus Curiae Brief of Seventy-Three Law Professors in Support of Jireh Publishing Inc.,” reprinted in 22 *Whittier L. Rev.* 391, 403 (2000). In addition, amicus briefs urging reversal have been filed by representatives of celebrities as diverse as Jimi Hendrix and Elvis Presley.

### **Differing views led to ‘Gone With the Wind’ rulings**

Radically different views of the same work accounted for radically different outcomes, in the trial court and on appeal, in the *Gone With the Wind* case, *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357 (N.D. Ga. 2001), vacated, 2001 WL 567706 (11th Cir. May 25, 2001). In *Suntrust*, the estate of Margaret Mitchell, author of *Gone With the Wind*, sued under the Copyright Act to enjoin publication of *The Wind Done Gone*, a novel by Alice Randall that tells the story of *Gone With the Wind* (GWTW) from the perspective of the mulatto half-sister of Scarlett O’Hara, the protagonist of Mitchell’s novel. The district court entered a preliminary injunction, finding that Randall’s book “incorporated the characters, character traits, settings, plot lines, title and other elements” of GWTW. 136 F. Supp. 2d at 1363. As such, it was simply an unauthorized sequel to GWTW, constituting “unabated piracy.”

Supported by experts including Nobel Laureate Toni Morrison, who called Randall’s novel “an exuberant act of literary revenge,” Randall argued that she had done no more than make fair use of elements from GWTW. That argument was successful on appeal; just over a month after the district court acted, the 11th Circuit vacated the injunction. Although it reached the opposite finding, that court was just as certain as the lower court. Without waiting to write a “comprehensive opinion,” it issued a per curiam order declaring that “it is manifest that the entry of a preliminary injunction in this

copyright case was an abuse of discretion in that it represents an unlawful prior restraint in violation of the First Amendment.” 2001 WL 567706, at \*1.

While the appellate court ruled only on the propriety of a preliminary (not permanent) injunction, it is clear that the 11th Circuit panel had a different view of Randall’s book than did the trial court. Where the district court saw piracy, the 11th Circuit apparently saw poetry.

In light of these cases, who is right—Holmes, who warned judges not to be critics, or Harlan, who was unafraid to express his opinion? While many courts quote Holmes, more, perhaps, follow Harlan. Undoubtedly, subjective judgments will always play a large part in courts’ analyses of intellectual property.

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