

ARTICLES

**Control of University Sponsored Sporting Events –
The Conflict Between Sport Artist's Freedom of
Expression and University Owned Trademarks**

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I. INTRODUCTION

Sport has been a part of American culture for centuries and has been communicated to the masses in a multitude of mediums, such as newspapers, radio, television, and most recently, via the internet. Recent disputes, however, have raised the question of who owns and controls the property rights to sporting events – the league, team, coaches, players, or the general public?¹

This article examines university sponsored sporting events and the ongoing lawsuit between University of Alabama and artist Daniel Moore who was sued for painting sporting events depicting Alabama football players and

1. In February 2006, the Ladies Professional Golf Association (LPGA) denied Associated Press reporter, Jaymes Song, from covering the LPGA Fields Open tournament in dispute over restrictions on use of LPGA stories and photos. Song was denied access on the Hawaiian course during practice rounds and in the media room to cover Michelle Wie's pre-tournament news conference after refusing to sign a credential form with restrictions on how and when images of the tournament and players could be used. *AP Won't Cover LPGA After Credential Dispute*, USATODAY.COM (2006), http://www.usatoday.com/sports/golf/lpga/2006-02-22-ap-lpga-fight_x.htm.

coaches without a university license. The central question addressed is whether sport artists must first seek permission to document or commemorate university sponsored sporting events or whether universities can use trademark law to not only limit access to sporting events, but also control what images can be released without prior consent.

II. BACKGROUND OF THE CASE

On March 18, 2005, the University of Alabama (UA)² sued sport artist, Daniel Moore, and his publishing company New Life Art, Inc.,³ alleging that Moore's paintings depicting the UA football program violated trademark law. Moore, who specializes in photorealistic paintings that document sport history,⁴ is an accomplished artist who was named the "2005 Sport Artist of the Year" by the American Sport Art Museum and Archives⁵ and was commissioned by the U.S. Postal Service to create the 1997 legendary Football Coaches Commemorative postage stamps featuring Vince Lombardi, "Bear" Bryant, George Halas and Pop Warner.⁶ Moore has also created numerous artworks for the NFL, MLB, the NBA, PGA, USGA and a number of universities.⁷

Moore received his Bachelors of Fine Arts degree from the UA in 1976⁸ and shortly thereafter began capturing historic moments in collegiate football in 1979. His earliest best-known piece is entitled "The Goal Line Stand," which depicts a critical play in the UA's national championship win over Penn

2. Recognized for its academic and athletic excellence, the University of Alabama consistently is ranked as one of the top of the public universities in the nation. Plaintiff's Complaint, *Bd. of Trustees of U. of Ala. v. New Life Art, Inc.*, No. 05-B-0585-W, at 3 (N.D. Ala. 2005).

3. Moore is the principal owner of New Life Art, Inc., which markets and sales art work created by the artist. *Id.* at 14.

4. One admirer viewed Moore's works and remarked, "Wow, I thought that was a photograph! It looks just like one. . ." DANIEL A. MOORE, *CRIMSON & WHITE AND OTHER COLORS 7* (1999). To achieve this style, Moore is said to paint more than mere color or the intricate details of a visual moment. "His eye. . . focuses the love of sports and the spiritual philosophy that run so deeply within him." *Id.* Because of this style Moore's realistic portrayals are said to bring sports history to life. *Id.*

5. The award is presented to an individual who captures the spirit and life of sport so that future generations can relive the drama of today's competition. *Sport Artist of the Year 2005*, Asama.org (2005), <http://www.asama.org/awards/SportArtists/Artist2005.asp>.

6. *Id.*

7. *Welcome to the Gallery of Daniel Moore*, Newlifeart.com (2006), http://www.newlifeart.com/detail_pencil/Daniel_A_Moore/daniel_a_moore.html.

8. Moore's wife and oldest daughter are also University of Alabama graduates and his middle daughter was enrolled at the University of Alabama when the University filed its lawsuit. Plaintiff's Complaint, *supra* note 3, at 14.

State in the 1979 Sugar Bowl. Since then, Moore continued to paint UA football scenes and over the years his ability to artistically document college sport history brought him wide acclaim and spawned a highly successful career in photorealistic sport art.

Initially, Moore's artwork was not only popular with the general public, but also with his alma mater because of his concentration on the UA athletics, particularly the football program. Recognizing the mutually beneficial relationship the University and New Life Art enjoyed for many years, the UA amicably granted Moore media privileges to research and create his artwork.⁹ In return, Moore adorned the public and university with images of one of college football's most prestigious programs.

In 2002, however, Moore and the UA's relationship soured when UA informed Moore that any print featuring the UA football team would become subject to a licensing agreement.¹⁰ Despite his best efforts, Moore was unable to convince the UA Board of Trustees that his paintings did not require a license since he documents, reports, records and journalizes historic moments and events in Alabama football.¹¹ Shortly thereafter, Moore's media privileges were revoked, limiting him from gathering reference material for his paintings and prints.¹² The UA also forbade Moore from advertising his UA artworks within University football programs, radio broadcasts of games, coach's shows, and other University magazines and publications.¹³

The UA's lawsuit versus Moore and his publishing company, New Life Art, Inc., alleged trademark infringement and unfair competition under the trademark act of 1946, 15 U.S.C. §§ 1051; violation of the anti-dilution laws

9. Moore's artwork primarily focuses on University of Alabama's football program. Plaintiff's Complaint, *supra* note 3, at 14. The University's most famous athletic celebrity, Paul W. "Bear" Bryant, served as head football coach at the University from 1958-1982. Bryant retired in 1982 as the all-time winningest coach in college football. *Id.* During this time, Moore likened his association with the University as a "professional media relationship. . .which reflected well on the institution through the recording, reporting, depicting, commemorating and journalizing of many of the finest moments for the University of Alabama football history." *Id.* at 2. Moore has done other non-sport and sport art, but claims "a special pride in his [Alabama] art work," because he is a University of Alabama alum. *Id.*

10. *Id.* at 15.

11. *Id.* at 14. Moore claims that many Alabama players have enjoyed being preserved in posterity by his art and that many aspire to be a part of a moment recorded in a Daniel A. Moore painting or print. *Id.*

12. *Id.*

13. *Id.* According to Moore, he was "blackballed by his alma mater. . .to coerce him into licensing all art work depicting Alabama football. . ." *Id.*

of Alabama, Ala. Code § 8-12-17 and common law.¹⁴ The UA alleged that because of its loyal following there is a significant market among alumni for items such as T-shirts, coffee mugs, videogames, posters, commercial art prints, etc., and therefore Moore's artworks violated the UA's rights to commemorate the UA and its athletic successes.¹⁵ Specifically, the UA claimed that Moore's commercial prints capitalize and "trade on the identity and goodwill of the University of Alabama" because "they are entrenched in the University's color scheme."¹⁶ For example, the UA regularly uses the colors "crimson and white" in connection with its athletic uniforms, licensed apparel and merchandise, which contribute to the color scheme's power to serve as a university identifier.¹⁷

In its lawsuit, the UA also claimed the use of its colors and marks evoke an immediate association with the UA¹⁸ and the crimson and white color scheme, uniforms, and other protected marks are used by the UA "repeatedly in connection with [its] athletic teams. . . as well as in connection with goods sold by the University or its licenses."¹⁹ According to UA, the strong association of these marks, not Moore's artworks, are the triggering mechanisms for the sale of these products.²⁰ Moreover, the UA claimed that it has "an obligation to control uses of indicia that invoke its identity and call it to mind among alumni, fans, donors, and other potential purchasers of commemorative merchandise."²¹

III. TRADEMARK LAW & INFRINGEMENT

A university's right to control the commercial use of its logos falls under trademark law. Trademark law is governed by the Lanham Act which provides that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name,

14. *Id.* at 2.

15. *Id.* at 3-4.

16. *Id.* at 4.

17. *Id.* Other trademarked images by UA include its mascot, an elephant, and the words "CRIMSON TIDE," "BAMA," and "ROLE TIDE."

18. *Id.* at 5.

19. *Id.* at 5. The University of Alabama alleges that the revenue derived from the use of these marks is an important source of funds for scholarships and for educational and athletic programs of the University. *Id.*

20. *Id.* at 6.

21. *Id.* at 6.

symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which —

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.²²

Accordingly, the following are eligible for trademark protection: words, numbers, slogans, pictures, symbols, characters, sounds, graphic designs, and colors.²³ Product and packaging designs - typically referred to as trade dress - are also eligible for protection under the Lanham Act.²⁴

The earliest form of trademarks was the branding of animals in ancient Egypt. Images etched on ancient ruins depict field workers branding cattle.²⁵ Quarry marks and stonecutters' signs have also been found in structures estimated to have been erected as early as 4000 B.C. In addition, Roman signboards were discovered in Pompeii ruins and in 15th century England sword makers were required to use identifying marks so that defective weapons could be traced back to the maker.²⁶

Much has changed since the ancient origins of trademarks. Today, marks in the United States receive protection under both federal and state laws.²⁷ Congressional authority to draft laws granting and enforcing exclusive rights in trademarks derives from the federal legislature's power to regulate interstate commerce.²⁸ The current federal trademark statute, the Lanham Act, provides

22. 15 U.S.C. § 1125(a)(1) (2000).

23. See generally RESTATEMENT (THIRD) OF UNFAIR COMPETITION 9, 13 (1995); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:1 (4th ed. 2003); Board of Supervisors of the Louisiana State U. v. Smack Apparel Company, 2006 WL 20006339 (E.D. La. 2006).

24. See MCCARTHY, *supra* note 23.

25. *Id.*

26. *Id.*

27. In addition to Lanham Act protection, under state common law, trademarks are protected as part of the law of unfair competition and registration of the mark not required.

28. See U.S. CONST. art. I, § 8, cl. 3.

for the national registration of distinctive marks used in commerce and for the enforcement of rights in distinctive marks regardless of registration.²⁹

Congress enacted the Lanham Act in 1946 to "mak[e] actionable the deceptive and misleading use of marks" and to "protect persons engaged in . . . commerce against unfair competition. . ."³⁰ According to the Supreme Court, federal trademark law has two objectives: (1) protection of the ability of consumers to identify and distinguish among the goods of competing manufacturers,³¹ and (2) protection of business goodwill symbolized by a mark.³² "By prohibiting competitors from utilizing a source-identifying mark, trademark law aids consumers who use trademarks in the marketplace to quickly and easily identify and distinguish a product."³³ In other words, "[t]rademarks. . . serve as the objective symbol of a business's good will and are a prime instrument in advertising and selling goods."³⁴ By prohibiting misappropriation of this symbol of goodwill, the Lanham Act protects the mark-holder's investment of time, energy, and money in advertising and selling a quality product under a source-identifying mark.³⁵

A word, name, symbol, or device is protectable as a trademark only if it is distinctive, i.e., if the alleged mark functions to identify a source of goods and distinguish those goods from the goods of competitors.³⁶ Thus, "it is the source-distinguishing ability of a mark-not its ontological status as color, shape, fragrance, word, or sign-that permits it to serve the basic purposes"³⁷ of trademark law.

29. See Federal Trademark Act, 15 U.S.C. §§ 1051-1127 (2006).

30. *Id.* § 1127; *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

31. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985); *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844 (1982).

32. *Park 'N Fly*, 469 U.S. at 198 ("The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.").

33. *Id.*

34. *Dakota Indus., Inc. v. Ever Best Ltd.*, 944 F.2d 438, 440 (8th Cir. 1991).

35. *Park 'N Fly*, 469 U.S. at 198 (stating that federal trademark laws "secure to the owner of the mark the goodwill of his business"); *Inwood Labs.*, 456 U.S. at 854 n.14 (noting that one goal of the Lanham Act is to protect the trademark owner's "goodwill which he spent energy, time, and money to obtain.").

36. 15 U.S.C. §§ 1052 & 1127.

37. *Qualitex*, 514 U.S. at 164; *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolus Inc.*, 228 F.3d 56, 62 (2d Cir. 2000) ("A mark's source-distinguishing ability allows it to serve those basic purposes that gave birth to trademark law in the first place; that is, to ensure that a product's maker reaps the rewards of the reputation it has built, and to enable consumers to recognize and repurchase goods with which they have previously been satisfied.").

The owner of a trademark may sue for infringement by filing a claim either under the Lanham Act's trademark infringement provision, 15 U.S.C. § 1114(1)(a), if the mark is registered, or under the Act's unfair competition provision, 15 U.S.C. § 1125(a)(1)(A), if the mark is not registered. Section 1114(1)(a) provides a cause of action for federal trademark infringement against anyone who uses a mark that is identical or similar to a registered mark when such "use is likely to cause confusion, or to cause mistake, or to deceive."³⁸ Section 1125(a)(1)(A) authorizes claims for infringement of trade dress and unfair competition.³⁹ Thus, unauthorized use of a mark is actionable if such conduct "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person. . ."⁴⁰

To prove trademark infringement under § 1114(1) or § 1125(a)(1)(A), the plaintiff must establish ownership of a valid and legally protectable mark and the defendant's use of an identical or similar mark is likely to cause consumer confusion.⁴¹ Courts have used eight⁴² factors to determine whether a likelihood of confusion exists: (1) strength of the mark, (2) relatedness or proximity of the goods, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) degree of care likely to be exercised by the purchaser, (7) defendant's intent in selecting the mark, and (8) likelihood of expansion of the product lines.⁴³

A licensed trademark, however, does not grant a monopoly property right in the mark. A trademark holder is limited in control over certain uses of the mark⁴⁴ and trademark law prescribes certain boundaries regarding the nature and scope of the rights of a trademark owner. In certain instances, a user legally may use a trademark without authorization from the trademark owner. The common query is to what extent one may use a third-party mark without permission of the trademark owner.

38. 15 U.S.C. § 1114(1)(a).

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

40. 15 U.S.C. § 1125(a)(1)(A).

41. *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 210 (3d Cir. 2000) ("To prove either form of Lanham Act violation, a plaintiff must demonstrate that (1) it has a valid and legally protectable mark; (2) it owns the mark; and (3) the defendant's use of the mark to identify goods or services causes a likelihood of confusion.").

42. These eight-factors for evaluating likelihood of confusion are not exhaustive. *Cairns v. Franklin Mint Co.*, 292 F.3d. 1139, 1150 (9th Cir. 2002).

43. *Id.* at 1150 n.7 (quoting *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)).

44. *See Playboy Enters., Inc. v. Netscape Comm., Inc.* 55 F. Supp. 2d 1070 (C.D. Cal. 1999).

Specifically, the Lanham Act authorizes several statutory defenses to third-party use of marks. The U.S. Court of Appeals for the Ninth Circuit in *New Kids on the Block v. News America Publ'g, Inc.*, created the doctrine of "nominative fair use" to identify certain circumstances in which one may use a third-party mark without permission.⁴⁵ The *New Kids* court developed a three-prong test that a party must satisfy to benefit from the safe harbor created by the nominative fair use doctrine: 1) the goods or services must not be readily identifiable without use of the trademark; 2) only so much of the mark may be used as is reasonably necessary to identify the goods or services; and 3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.⁴⁶ Applying this test, the *New Kids* court concluded that the use of the musical group's trademarked name in connection with newspaper popularity polls was nominative only and not an infringement.

Unauthorized users are also free to speak about trademarks in noncommercial or commercial-but-nontrademark ways. A published novel, for example, in which a character specifically drinks Starbucks® rather than simply coffee is not infringing the trademark rights of the mark holder.⁴⁷ As one legal scholar noted:

What trademark law gets you is the exclusive right to make trademark use of a word on the products you sell in those markets in which you have actually done business. Dell Computers has an exclusive right to use the mark Dell as a trademark for computer hardware in connection with the sale of Dell-brand computer hardware. It can't stop Dell publishing from using the mark "Dell" on books, even books about computing. It can't stop Compaq computers from advertising that its machines are a better value than Dell's. It can't stop New Line Cinema from making a movie in which the bad guy is a pornographer who uses a Dell Computer as the server for his x-rated web site. What it can do is stop anyone from making commercial use of the word "Dell," or a word similar to Dell, in a way that is likely to confuse or deceive consumers.⁴⁸

Moreover, as one court has stated, "trademark laws exist not to 'protect' trademarks, but . . . to protect the consuming public from confusion,

45. 971 F.2d 302 (9th Cir. 1992).

46. *Id.* at 308.

47. Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721 (2004).

48. Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 153-54 (2000).

concomitantly protecting the trademark owner's right to a non-confused public."⁴⁹

While consumers need a source-identifying mark, society requires freedom for certain kinds of messages. Trademark law and the First Amendment, therefore, have an integrated body of laws to balance this potential conflict and to provide for source identification while protecting free communication.⁵⁰ For example, where trademark law, by its own terms, protects the unauthorized use of another's trademark, there is no need to turn to the Constitution to justify a judgment in the alleged infringer's favor.⁵¹ In some instances trademark law is sufficiently fashioned to protect free-speech interests that may justify uses of a trademark by persons other than its owner.⁵² In other words, if the free speech interests that are integral to the law of trademark dictate that the plaintiff cannot prevent the defendant's use of a mark over which the plaintiff claims exclusivity, then the judgment must be in the defendant's favor and there is no need for the court to consider whether the First Amendment would also reach the same result.

There are instances, however, when trademark law does not sufficiently address free speech issues. In *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, the Supreme Court recognized that the First Amendment offers protection to commercial speech.⁵³ Since then, defendants have attempted to raise First Amendment defenses for the unauthorized use of trademarks.⁵⁴

The type and use of speech, however, determines the amount of First Amendment protection provided to those who use another's trademark. Defendants have successfully invoked the First Amendment by alleging that the use of the plaintiff's trademark was meant to convey an important social or commercial message to the public.⁵⁵ The use of another's trademark in a parody, for example, regularly receives constitutional protection.⁵⁶

49. *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976).

50. *See Pierre N. Leval, Trademark: Champion of Free Speech*, 27 COLUM.-VLA J.L. & ARTS 187 (2004).

51. *Id.*

52. *Id.*

53. 425 U.S. 748 (1976) (holding that advertising of commercial products deserves the same constitutional protection as political speech or writing).

54. *See Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g. Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (holding that the defendant could parody Cliffs Notes based on the First Amendment).

55. *See MCCARTHY, supra* note 24 at 31:144 (discussing the use of someone else's trademark to convey a message).

56. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. i (1995).

The UA's lawsuit versus Daniel Moore calls into question whether trademark law or the First Amendment protects not only written and spoken words, but also a wide range of expression,⁵⁷ including artistic expression. Even though art is not explicitly mentioned in the First Amendment, the Supreme Court has characterized artistic expression as a protected form of symbolic speech.⁵⁸

Courts historically have been divided over how to balance the First Amendment and the Lanham Act because of the confusingly similar rights and the complex issues involved. The three most relevant tests to cases involving artists are: (1) the Likelihood of Confusion, (2) Alternative Avenues, and (3) Artistic Relevance tests. Each test builds upon its predecessors, and because these cases are brought under trademark law, the likelihood of confusion factors is a staple of each.⁵⁹

Traditionally, the Likelihood of Confusion Test applies the traditional trademark likelihood of confusion factors with very little regard for the free

57. Examples of protected expression include music, film, pictures, photographs, paintings, drawings, engravings, prints, and sculptures. *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003) (citing *Hurly v. Irish-American Gay, Lesbian & Bisexual Group of Boston*, 515 U.S. 557, 569 (1995)) (noting that "[t]he Constitution looks beyond written or spoken words as mediums of expression."); *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989) (holding that "[m]usic, as a form of expression and communication, is protected under the First Amendment."); *Kaplan v. California*, 413 U.S. 115, 119-120 (1973) (ruling that "[p]ictures, films, paintings, drawings, and engravings. . . have First Amendment protection[.]").

58. *Hurly*, 515 U.S. at 569; *Kaplan*, 413 U.S. at 119-20; *Jacobellis v. Ohio*, 378 U.S. 184 (1964); *Roth v. United States*, 354 U.S. 476 (1957). The Supreme Court has upheld the constitutionality of numerous federal, state, and local laws that limit expression. Examples include political advertising - *Lehman v. Shaker Heights*, 418 U.S. 298 (1974); draft card mutilation - *U.S. v. O'Brien*, 391 U.S. 367 (1968); unlicensed parades - *Cox v. New Hampshire*, 312 U.S. 569 (1941); the use of fighting words - *Feiner v. New York*, 340 U.S. 319 (1951); and various broadcasting restrictions - *FCC v. Pacifica*, 438 U.S. 726 (1978). Not every form of artistic expression, however, is protected by the First Amendment. Some works which depict the human body using graphic sexual themes, for example, are labeled obscene and thus fall outside the bounds of the First Amendment. *New York v. Ferber*, 458 U.S. 747 (1982) (holding that pornography shown to minors can be prohibited whether or not the images are obscene because of the state's interest in protecting children); *Miller v. California*, 413 U.S. 15 (1973) (ruling that pornography can be banned only if obscene); *Kaplan*, 413 U.S. at 119-20 (holding that pictures, films, paintings, drawings, and engravings are entitled to First Amendment protection unless they are obscene). See also *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726 (S.D.N.Y. 1978) (holding that a nude drawing of an African American male seated in a boxing ring evoked Muhammad Ali's marketable identity and violated his right of publicity).

59. See *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403-06 (9th Cir. 1997) (applying the likelihood of confusion factors in a Likelihood of Confusion Test analysis); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 774-75 (8th Cir. 1994) (applying the likelihood of confusion factors in an Alternative Avenues Test analysis); *Twin Peak Prods., Inc. v. Pub's Int'l, Ltd.*, 996 F.2d 1366, 1379-80 (2d Cir. 1993) (remanding the case for analysis of the likelihood of confusion factors in an Artistic Relevance Test analysis).

speech concerns of an artist.⁶⁰ The Alternative Avenues Test provides no First Amendment protection if the artist could have used alternate, non-infringing means to convey the same message.⁶¹ Finally, the Artistic Relevance Test denies First Amendment protection if the use of the mark has no artistic relevance to the underlying content of the work, or if it does have artistic relevance, if the use proves explicitly misleading as to content or endorsement.⁶²

IV. APPLICATION TO TRADEMARK LAW TO SPORT ART

Trademarks and service marks have frequently appeared in works of art. Arguably the most well-known example is Andy Warhol's images of Campbell's soup cans which are now a celebrated chapter of modern art.⁶³ As the Ninth Circuit aptly stated, "[T]he 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. . . . If we see a painting entitled 'Campbell's Chicken Noodle Soup,' we're unlikely to believe that Campbell's has branched into the art business."⁶⁴ Also, many photographers have included photos bearing trademarks in their works which are then displayed and collected as works of art. In fact, works of art depicting sporting events regularly illustrate stadiums blanketed with countless trademarks of corporate sponsors.

The law regarding trademarks and art is evolving. In *Pirone v. MacMillan, Inc.*,⁶⁵ the licensing agent for the daughters' of baseball legend Babe Ruth brought a trademark infringement and unfair competition lawsuit against the defendant who published a calendar that included a weekly page with a photograph of a famous baseball player, baseball field, or other image 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 held that the two photographs of Babe Ruth were used only to identify a famous baseball player and were not an indicator

60. Mitchell Greggs, *Shakin' It to the Back of the Bus: How Parks v. LaFace Uses the Artistic Relevance Test to Adjudicate Artistic Content*, 61 WASH. & LEE L. REV. 1287, 1291 (2004).

61. *Id.*

62. *Id.*

63. *Matell, Inc. v. MCA Records, Inc.* 296 F.3d 894 (9th Cir. 2002), *cert denied*, 123 S. Cut. 993 (U.S. 2003).

64. *Id.* at 900.

65. 894 F.2d 579 (2d Cir. 1990).

of source.⁶⁶ Thus, because there was no trademark use of Babe Ruth, the court concluded that there was no infringement.⁶⁷ 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.⁶⁸

Similarly, in *Rogers v. Grimaldi*, a pair of dancers reunited after a thirty-year separation for a revival of their dance numbers from the 1930s.⁶⁹ Their act had sought to evoke the Hollywood glamour of Ginger Rogers and Fred Astaire thereby labeling their act "Ginger and Fred." Ginger Rogers sued, alleging that the title implied her sponsorship and infringed her trademark rights.⁷⁰ The court, however, held that the name of a famous person in the title of a book or film in no way does not imply that person's sponsorship, nor had Roger's name been used deceptively.⁷¹ Hence, there was no consumer confusion and no false designation of origin.⁷²

In other words, unauthorized use of a trademark is not infringement if the unauthorized user uses the mark not as the identifier of its own goods or services, but to refer to those of the owner of the mark. For example, if an artist depicts a trademarked item as symbolizing or illustrating a facet of society, such a use is not an infringement since the artist is merely commenting on the mark and its place in society and not to identify his or her own goods or claiming association with the mark's owner.

In Moore's case, if the court applied the nominative fair use test, Moore legally can use the UA's registered trademarks to identify the UA's marks if: (1) Moore's works cannot be readily identified without pointing to the UA's marks;⁷³ (2) Moore only used as much of the mark as is necessary to identify the goods or services; and (3) Moore did nothing with the mark to suggest that the UA has given its approval to use the mark. In the art world, there is no

66. *Id.* at 581.

67. *Id.*

68. *Id.* at 584.

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

70. *Id.*

71. *Id.* at 1005.

72. *Id.*

73. At least one scholar contends that the fair use test may prove problematic for Moore since Moore must demonstrate that he is using the UA's marks to describe his goods. John Grady, *University of Alabama Case to Test Limits of Trademark Licensing in Sport Art Cases*, 14 SPORT MARKETING QUARTERLY 4 (2005).

other way to create a photorealistic painting of historic UA sporting events without using trademarks since the UA's color scheme and players are inseparable from the event. Second, Moore used the UA marks accurately and solely to convey information regarding the UA football games. Third, Moore's works did nothing to suggest that the UA has sponsored or endorsed the artworks. As the *Pirone* court noted the use of the marks is merely descriptive of the theme of the painting and it is highly unlikely that a consumer would believe that the UA sponsored the paintings.⁷⁴

As stated herein, a trademark claim exists under the Lanham Act "where the public interest in avoiding consumer confusions outweighs the public interest in free expression."⁷⁵ The UA, therefore, had to show that Moore's use of its trademarks are likely to cause confusion among consumers as to the "affiliation, connection, or association" between the university and the artist's paintings. The UA contended that Moore's paintings mislead consumers into believing that the paintings were affiliated with the UA or it has sponsored or approved Moore's artworks.

However, there is little risk of consumer confusion in Moore's work given Moore's reputation and style of art. Moore, the 2005 sport artist of the year, is a well-recognized artist. His works are recognized by Alabama alums and fans and by those patrons who regularly collect this style of art. Art collectors would also know that his works are distinct from the UA and are not affiliated or sponsored by the university. In addition, because of UA's rich football tradition, most of the patrons who would be most interested in an UA painting would not only recognize Moore's works, but are also keenly aware of the UA's lawsuit and that the UA does not sponsor Moore's works.⁷⁶ Therefore, to allege that art consumers are likely to be confused as to the source of works produced and signed by a nationally well-known artists is a stretch at best and no more illogical than to assert that a consumer reading the sports page in The Tuscaloosa News would conclude that an article and picture of UA's most recent football game was published by the university and not the newspaper itself.⁷⁷

74. *Pirone*, 894 F.2d 584. While some artists now incorporate disclaimers on their works or web sites that advise the consumer and acknowledge that the use of the trademarks is not licensed or authorized by the trademark owner this does not guarantee unlimited use of a mark.

75. *Mattel*, 353 F.3d at 807 (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)).

76. The UA's lawsuit has been well documented in local and statewide newspapers, aired via national media outlets, and even debated in national sport law conferences.

77. It does raise the question, however, of whether consumers could eventually become confused if the UA contracted with an "exclusive" artist to produce images of UA sporting events. This is beyond the scope of this article and not the present case.

V. DISCUSSION

Art appropriately has received vigorous First Amendment protection.⁷⁸ The First Amendment, however, should not and does not permit anyone who cries "artist" to have carte blanche when using registered trademarks in their craft. Courts, therefore have adopted three approaches to balance First Amendment artistic expression and trademark concerns. The first approach, "the likelihood of confusion factors" in trademark cases, however, fails to differentiate adequately between those artists who choose works or titles for the purpose of legitimate artistic relevance and those who choose misleading marks or titles for the purpose of commercial gain.

The second approach, the "alternative avenues" test, is similarly problematic. This test is premised on the notion that a mark holder may prohibit use of his or her trademark as long as alternative ways exist for the artist to communicate his or her idea. To suggest, however, that other images can be used as well to express an artist's message is not a proper test for weighing First Amendment rights.⁷⁹

The most appropriate test for balancing the public interest in avoiding consumer confusion with the public interest in free expression is the third approach, developed by the Second Circuit in *Rogers*. Under that test, use of a mark should be protected unless it has "no artistic relevance" to the underlying work, or, if there is artistic relevance, the title "explicitly misleads as to the source of content of the work."⁸⁰

Trademarks are often used without authorization in parodies, artistic expression, and even on T-shirts to convey a political, social, or humorous message. The trademark ordinarily communicates information concerning source or quality. When the trademark is used as the subject of speech, rather than to propose a commercial transaction, it is entitled to full protection under the First Amendment.⁸¹ Courts balance the public interest in avoiding consumer confusion with the public interest in free expression.⁸²

78. See John D. McMillen & Rebecca S. Atkinson, *Artists and Athletes: Balancing the First Amendment and the Right of Publicity in Sport Celebrity Portraits*, 14 J. LEGAL ASPECTS SPORT 117 (2004).

79. *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003) ("To suggest, however, that other words can be used as well to express an author's or composer's message is not a proper test for weighing First Amendment rights.").

80. *Rogers*, 875 F.2d 994, 999.

81. See Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 219 (1998).

82. *Id.*

As courts have noted, even decorative art, which is commonly viewed as "merchandise" and not art, can be entitled to constitutional protection. In *Bery v. City of New York*⁸³ and the district court in *ETW Corp.*, both courts rejected the notion that only fine art can receive First Amendment protection stating, that "[s]uch myopic vision not only overlooks case law central to First Amendment jurisprudence but fundamentally misperceives the essence of visual communication and artistic expression."⁸⁴ In *Bery*, the plaintiff sought a preliminary injunction to enjoin enforcement of a city ordinance that prohibited visual artists from exhibiting or selling their street artwork without first obtaining a general vendor's license.⁸⁵ The Second Circuit held that the First Amendment's fundamental purpose is to protect expression "in all of its myriad manifestations."⁸⁶ Although the type of street art sold by Bery was amateur at best, the appellate court corrected the district court which equated these visual expressions with "the crafts of the jeweler, the potter and the silversmith who seek to sell their work."⁸⁷ The Second Circuit noted that even craft-like objects "may at times have expressive content,"⁸⁸ noting that "paintings, photographs, prints and sculptures. . . always communicate some idea or concept to those who view it, and as such are entitled to full First Amendment protection."⁸⁹ The appellate court also dismissed the notion that an expression must be "inseparably intertwined with a 'particularized message'" in order to receive any constitutional protection, noting that "visual artwork is as much an embodiment of the artist's expression as a written text."⁹⁰

Bery's decision reiterated the Supreme Court's holding in *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc.* which held that art is constitutionally protected even if it fails to convey a discernable message, "[A] narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expression conveying a 'particularized message,' [citation], would never reach the unquestionably shielded paintings of Jackson Pollock, music of Arnold Schoenberg, or Jabberwocky verse of

83. 97 F.3d 689 (2nd Cir. 1996).

84. *ETW Corp.*, 99 F. Supp. 2d at 836 (citing *Bery*, 97 F.3d at 695).

85. *Bery*, 97 F.3d at 689.

86. *Id.* at 694.

87. *Id.* at 695.

88. *Id.*

89. *Id.*

90. *Id.*

Lewis Carroll."⁹¹ Thus, courts acknowledge that art does not lose constitutional protection even when its purpose is to entertain rather than communicate a particular idea or message.⁹²

In *New York Racing Ass'n v. Permuter Publishing, Inc.*⁹³ the defendant alleged that paintings of the Saratoga Race Track grandstands which were reproduced on souvenir goods, such as t-shirts infringed on its trademark rights. The court disagreed and found no infringement noting that the painting of a scene in which a trademark appeared served a valid First Amendment interest of accurately depicting the scene, i.e. realism.⁹⁴ Furthermore, the court noted that "the need to avoid consumer confusion... is negligible. . . because the average consumer viewing Defendants' t-shirts would realize that the shirts display reproductions of original paintings and their titles."⁹⁵ In reaching its decision, the court applied the balancing test set forth in *Rogers* which requires the Lanham Act be narrowly construed when applied to artistic works. "[O]nly where the public interest in avoiding consumer confusion outweighs the public interest in free expression"⁹⁶ should the trademark registrar prevail. As a result, the Court found that the need to avoid consumer confusion was negligible, as compared to the need to protect an artist's right to utilize a trademark of an artistic work.⁹⁷

Moore's artworks should also garner First Amendment Constitutional protection under freedom of the press. Moore claims his use of the UA's marks "appears. . . merely as the incidental byproduct of accurately documenting and/or rendering an historic event. . ." and his use of the UA's marks are clearly relevant to his work.⁹⁸ A "media" use of trademarks also calls into question whether they function as an identifier of the source of the product.⁹⁹ In Moore's case, the uses of the UA's marks are reasonably necessary to document the history and pageantry of Alabama football. Further, it would be virtually impossible for Moore to create a photorealistic

91. *Hurley*, 515 U.S. at 569.

92. *Comedy III*, 21 P.3d at 804 (citing *Guglielmi v. Spelling-Golberg Prod's*, 25 Cal. 3d 860, 867 (1979)).

93. 959 F. Supp. 578 (N.D.N.Y. 1997).

94. *Id.* at 582.

95. *Id.*

96. *Id.*

97. *Id.*

98. *Press Releases from Artist Daniel A. Moore*, Newlifeart.com (2005, March 2), <http://www.newlifeart.com/newsrelease2.htm>.

99. Grady, *supra* note 74.

scene that depicts the lore of college football without actually using Alabama colors, players, or scenes from actual football games.

VI. CONCLUSION

Under the Lanham Act, a trademark is not infringed by artistic representation that seeks to entertain or document history because of the free speech protections of the First Amendment. Trademark infringement should only apply to purely commercial speech. Moore's work does more than propose a commercial transaction. His work provides an historical, social, and visual commentary on historical events, namely college football.

Most Lanham Act cases involving art, however, boil down to whether the art buying public believes there is a relationship between the artist and the trademark owner. When a commercial trademark appears in a work of art, like Moore's, it is more likely to be considered infringement when the mark visually dominates or is the focal point of the art work. This is not the case in Moore's work. Moore uses UA marks to provide context of an historical event, not to sell his paintings. It would be entirely different if Moore's works were merely staged to reap profits of a single image bearing UA's marks with no real artistic creativeness or public or historical significance. Thus, even though Moore included registered UA marks in his works, Moore imbues these marks with a meaning beyond its source-identifying function. Most importantly, the UA has not produced sufficient evidence to suggest that Moore's works confuse consumers.

Until courts decisively rule on Moore's case, perhaps the only way for artists to avoid being hailed in court is: (1) not use university trademarks and therefore paint generic scenes of sporting events, or (2) seek permission in advance thereby chilling free speech. Both of these solutions seemingly run contrary to the purpose of the First Amendment. Protecting one's trademark certainly is a necessary and legitimate goal, but when an entity seeks to monopolize its marks at the cost of the betterment of society both trademark law and the First Amendment should prevail. Courts correctly have been willing to recognize that most creators of expressive works do not use others' trademarks in an attempt to mislead. Instead, artists have used these marks as part of their legitimate creative efforts. Despite courts' openness to First Amendment considerations, however, artists must be careful when incorporating trademarks into their creative works, making sure that they do not cross the line between homage or reference and infringement.

When cases, like Moore's, do reach the courts and pit claims of exclusive trademark right against interests of free expression, courts do not have to turn

unnecessarily to the Constitution. Where the terms of the trademark law adequately protect an alleged infringer's use as falling outside the scope of the trademark owner's exclusive right, the court has no need to seek redress via the First Amendment. If, however, trademark law is implicated and a First Amendment analysis is necessary, courts should remember that they have substantial discretion to construe the Lanham Act in a way to protect society-at-large and not to suppress the use artistic expression. Art is not only the expression of ideas, but also commemorates and records important cultural aspects of our society.

Finally, there is another compelling reason why courts should allow artists to capture college sporting events beyond a pen, camera, or computer. College sports are a unique American tradition rooted within the cultural fabric of our society. Each week in the Fall millions of people gather in stadia across the country to cheer their team's victories and losses. Capturing these events is worthy of First Amendment protection, not solely for the protection of artistic expression, but for the celebration of our culture.

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