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The Legal Ramifications of Saving Face: An Integrated Analysis of Intellectual Property and Sport

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THE LEGAL RAMIFICATIONS OF SAVING FACE:
AN INTEGRATED ANALYSIS OF INTELLECTUAL
PROPERTY AND SPORT

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I. INTRODUCTION

For the athlete, "saving face" is a constant moral imperative. Every engagement in the athlete's particular field of endeavor calls into focus the issue of saving face. The athlete knows that if he loses his particular battle, he may forever be foreclosed from achieving his perceived level of personal worth. In some situations, it may mean he is forever banished from his chosen athletic field. In other instances, it can mean that the athlete, while attempting to save face, departs life itself.

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1. See CHARLES EARLE FUNK, HEAVENS TO BETSY! AND OTHER CURIOUS SAYINGS 162 (1986). The phrase "saving face" is traceable to ancient Asian origins. See id. The Chinese phrase is "tiu lien," means "to lose face." See id. The evolution of the phrase to "save" face is attributed to Englishmen residing in China during the height of the British Empire. See id. It is generally construed as the desire to maintain a certain level of dignity, prestige or esteem before others. See id.

2. THE 21ST CENTURY DICTIONARY OF SLANG, while not including the phrase "to save face," makes several related references such as "faced," in the active verb sense, "in-your-face," and "save the day," all of which use sports scenarios in their descriptive explanations of these terms. See 21ST CENTURY DICTIONARY OF SLANG (1994).

3. Recently, numerous incidents have claimed the lives of sports figures. For example, a rider in the Tour De France bicycle race fell, hit his head on a rock and died at the scene. See Matt Schudel, Past With a Punch, FT. LAUDERDALE SUN-SENTINEL, Oct. 15, 1995, at 12. Formula One, NASCAR and motorcycle racing have lost several drivers in crashes. See id. In 1995, two boxers died following championship fights and another was permanently disabled by a brain hemorrhage. See id. Also, several deaths followed the recent 1994 World Cup Soccer Championships, as a result of vengeful fans and questionable supporters. See also THE 1996 INFORMATION PLEASE SPORTS ALMANAC 33 (Mike Mesorole ed., 1996) (reviewing 1995 as test of boundaries of audacity in sports).

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The spectator also feels the competitive rush. There is shared anxiety for the athlete who is not faring particularly well at a given moment. The victorious sprint at race’s end is memorable yet, ironically, the sadness associated with the runner who pulls up lame, or falls to the tarmac, is likewise ingrained in our mind. It is the embarrassment we know from our own unsuccessful confrontations with desire.4 The boxer getting beaten mercilessly, the fallen skater, the bowler who rolls the gutter ball, the golfer who lips the tap in, all sense the inevitable questioning of their stature in a manner the average citizen truly empathizes with or despises, depending on for whom he is rooting for. The athlete’s feeling is magnified as he or she feels the pressure of the fans and the sensations tied to his or her own physical efforts.

Aside from the emotional overtones associated with these images, saving face can be taken quite literally. The nature of many sports often pose a great risk of disfigurement to their participants.5 In addition, the athlete is center stage as one of the most highly peddled images in the world. While the debate may rage over the athlete's status as a role model,6 it is beyond dispute that face ped-

4. This is not to say that confrontation always ends in an undesirable fashion. Rather, it is a recognition that every person, subculture and society have their own repertoire of face-saving practices. For a detailed analysis of “face-work” in an individual’s daily encounters, see ERVING GOTHMAN, INTERACTION RITUAL: ESSAYS ON FACE-TO-FACE BEHAVIOR (1967). An interesting recent pop cultural play on the meaning of saving face in sport and society serves as a plot device in the 1992 film MR. BASEBALL. See LEONARD MATLIN, 1996 MOVIE AND VIDEO GUIDE 883 (1995).

5. The broad spectrum of sports presents many risks of potential harm for the athlete. While this is obvious in direct contact sports where the participants get struck in and about the head, such as boxing, wrestling, football and hockey, it is also true in less direct contact events. Some of the worst mutilations have occurred in sports like auto racing, motorcycling and even bicycling. Thus a special premium is placed on protective gear for athletes, especially for their heads and faces. See, e.g., Patent No. 5,481,759, 1/9/96, Expandable Baseball Hat & Cover; Patent No. 5,384,914, 1/3/95, Sports Face Mask; Patent No. 5,216,758, 6/8/93, Sports Face Mask Attachment; Patent No. 5,402,188, 3/28/95, Athletic Racing Goggles; Patent No. 4,032,991, 7/5/91, Fire Resistant Face & Head Protective Device.

6. See Michael Hirsley, Barkley & Co. Refuse To Be Role Models, but . . . , Michael Delivers His Message, CHICAGO TRIB., Mar. 21, 1995, at Sports 1. Charles Barkley, one of the most highly marketed athletes in all of sports, holds the label of role model in great disdain. See id. One must agree that Barkley strikes a logical chord in refuting the role model status simply based on his athletic ability. Many argue, however, that these athletes, merely by being placed in the limelight (having their face plastered everywhere) have a certain duty to the children and others who look up to them. The newspapers are filled with debates on both sides of the ball. See, e.g., Stephen Edelson, Steelers' Lloyd Just a Football Player, ASBURY PARK PRESS, Jan. 24, 1996, at D2 (discussing Pittsburgh's intense linebacker's disinterest in being role model); Joseph H. Brown, Athletes Can't All Be All-Star Role Models, THE TAMPA TRIB- TIMES, Aug. 6, 1995, at 6; Hirsley, supra, at Sports 1 (discussing Michael Jordan's positive example).
dling has made the athlete one of modern history’s most recognized figures.  

This Article examines the sporting view of “saving face” from a legal standpoint. Literally and figuratively, saving face for the athlete often involves intellectual property issues. Intellectual property is a general description for the specialized subjects of patents, copyrights, trademarks and unfair competition. Unlike real or personal property, intellectual property deals with more intangible aspects of the law. Like sports, intellectual property has been with us since antiquity, yet as we approach the twenty-first century, few realize the scope and importance of intellectual property in the sports arena. The Article begins with a brief overview of the origins of both sports and intellectual property, highlighting the confluence of these two areas as intellectual property gains recognition as an integral part of sports law. The emphasis then shifts to current contested areas in the major disciplines of intellectual property law as they relate to both individual and team sports of the modern era. Finally, the Article ends with a criticism of the new developments as they relate to sports.

A review of intellectual property as it pertains to sports serves a dual purpose. First, it illustrates the basics of a legal area of great significance while highlighting the easy access available for practitioners of sports law. Second, this review provides an opportunity for speculation on how two new intellectual property developments may be treated by the sports law community: a proposed Model Privacy and Publicity Act and the new Federal Dilution Act. Additionally, publicity and dilution rights have special significance for athletes since these areas involve the ability of celebrities to protect their images beyond the boundaries of traditional intellectual property.

7. See Elliot J. Gorn & Michael Oriard, Taking Sports Seriously, Chron. of Higher Educ., Mar. 24, 1995, at A52. For example, Michael Jordan, a professional basketball player for the Chicago Bulls, is among the best known individuals in the world. Jordan took over the mantle from other sports figures who had dominated international news for several decades, Muhammad Ali, f/k/a Cassius Clay, who was the undisputed heavyweight champion of the world in three different decades. See id.

8. See Folsom v. Marsh, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841) (No. 4,901). Intellectual property approaches what may be called the metaphysics of the law, where the distinctions are sometimes almost effervescent. See id.

9. Each year the Sports Lawyers Association has an annual meeting which highlights the most recent developments in sports law. One of the most heavily attended sections is the practical guide to getting into the business of sports law. The discussion is usually very general and the moderators handout outlines that inevitably leave most individuals feeling like there is not much hope.
II. SPORT, LAW AND SOCIETY

Sport, law and society. These subjects tell the story of humanity's past, give valuable insight to mankind's present relationships and provide a basis for future predictions. Law and social studies are well respected in that vein, while sport is often taken less seriously. As a prelude to sports receiving its proper recognition, it is necessary to realize that physical activity goes through a variety of stages before it will ultimately classify as sport.

At birth, human beings understand nothing about the world they have entered. They do not realize that they are members of a society, which by definition, is a number of individuals voluntarily associating on the basis of a common adherence to a set of standards. Nor do they realize that these standards are both formal and informal. Some standards have the force of rules, regulations and ultimately law either by codification into written law or merely as a result of the consistency of human behavior. A baby does know that as long as its basic needs are satisfied, it is free to do whatever it desires. Indeed, the baby is encouraged to experience

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10. One of the newer movements in legal studies is "game theory." Applied, game theory takes slices of life from a number of varied situations, applies labels and corresponding mathematic computations to draw conclusions about the way mankind reasons. Game theory can be evaluated in purely theoretical terms, wherein no abstract model is applied to any circumstances of real life. The legal method, however, generally involves applied game theory and strives to draw conclusions about a wide range of legal topics, especially where bargaining is involved. Thus, parties involved in negotiating damages in personal injury suits, sentencing options in criminal proceedings, or relative competitive rights in potential antitrust actions can allegedly be predictably analyzed under this theory. See, e.g., Ken Binmore, I Game Theory and the Social Contract (1994); Martin J. Osborne & Ariel Rubenstein, A Course in Game Theory (1994); Manuel A. Ouset, Back to School with Coase: The Production of Information and Modes of Knowledge Within and Across Academic Disciplines, 75 B.U. L. Rev. 1063, 1064 (1995) (discussing use of problem solving mechanisms to "identify, manipulate, and solve problems," thereby changing one's "beliefs, comprehension, judgments, insights, and ways of acting"); Bruce Kahn, Applying the Principles and Strategies of Asian Martial Arts to the Art of Negotiation, 58 Alb. L. Rev. 223, 225 (1994) ("noting value of game theory to negotiators seeking "objective optimal result").

11. See Gorn & Oriard, supra note 7, at A52 (highlighting point by identifying several works and authors who toil to make academic masses realize important commentary that sport makes on society).


13. See Surya Prakash Sinha, Jurisprudence, Legal Philosophy in a Nutshell 1-2 (1993). Attempts to define the nature of law itself are the subject of legal philosophy, or jurisprudence as it is more commonly called. See id. Jurisprudence recognizes that although law is a central part of western society, many other cultures relate their actions to different principles which guide their lives, such as religion, harmonization with nature, or a passing ancestral pre-existing duty. See id. at 8. Yet all societies, past and present, have been able to indulge themselves in sports as a reflection of their particular culture.
as much as possible throughout its early years. This behavior is commonly known as play.

As the child develops, so does his or her skills related to play, advancing to the stage of true gamesmanship. Games by nature require the understanding of structure and rules. The game, a step beyond spontaneous play, requires a degree of discipline and a certain level of comprehension.\(^\text{14}\)

Ultimately, competitiveness is a part of our human nature.\(^\text{15}\) Once one goes beyond gamesmanship to organized sports, the contestants are primarily driven by their competitive nature. Play is simply for fun, gamesmanship is a mixture of fun and discipline, and true sports enjoyment arises from winning the competition. One competes in sport to relish the "thrill of victory" and avoid the "agony of defeat."\(^\text{16}\)

With athletic victory comes the spoils associated with society's recognition of its accomplishments including respect, dignity and often untold financial success. Society views superstars as celebrities, yet they are simultaneously heralded as physical freaks of nature.\(^\text{17}\) Taller, faster and stronger than the average citizen, athletes are vested with powers to which the normal laws of heredity seem-

\(^{14}\) While much of this Article is focused on the physical behavior of human beings, such behavior is not limited to mankind. It is well known that animals of varying species engage in behavior which is classified as play. Likewise, all games, contests or competitive sports do not necessarily involve physical interactions. For further discussion of this classification and the limitations involved therein, see ALLEN GUTTMANN, FROM RITUAL TO RECORD: THE NATURE OF MODERN SPORTS 1-14 (1978).

\(^{15}\) Research published in the January 1996 issue of NATURE GENETICS indicates evidence of a thrill-seeking gene. See Footnotes, CHRON. OF HIGHER EDUC., Jan. 12, 1996, at A6. Researchers have identified a section of the brain that has been tentatively characterized as a dopamine receptor. See id. Dopamine is known to stimulate euphoria. See id. It is possible that another part of the brain is responsible for the degree of competitiveness one feels, however, thrill-seeking, euphoria and competition are generally present when one is engaged in sport.

\(^{16}\) See Steve Rushin, How We Got Here, 1954-1994, SPORTS ILLUSTRATED, Aug. 16, 1994, at 38-39. The American Broadcasting Company (ABC) television network had no traditional sportscasts such as professional baseball and football at the time, but quickly became an innovation in sports telecasts with presentations on the Olympics, college football and sports exotica. See id. Television producer Roone Arledge changed the face of sports in 1961 as well by premiering the use of slow motion replays. See id. at 39.

\(^{17}\) The average man in America is 5'9" and 172 lbs. See Karen S. Peterson, Joe Average: His Sex Life, Salary and TV Habits, U.S.A TODAY, Feb. 13, 1996, at D1. The average height in the National Basketball Association is 6'7" with most teams featuring several members who are in excess of 7' and weigh at or near 300 pounds. The Dallas Cowboys, winners of the 1996 NFL Super Bowl, were given a lock on the championship before the game began because they had the biggest offensive line in Super Bowl history. Each member weighed in excess of 300 lbs. with some inching toward the 400 pound mark.
ingly do not apply. Athletes are celebrated by society because they can perform activities at a superior level than the average person. Our society's love affair with athletes, however, often leads to an abnormal and inconsistent application of the law. Prior to reviewing the extent to which the laws of intellectual property have fallen to this unfortunate predilection, it is helpful to review the historical evolution of these legal areas in conjunction with the development of sports.

A. The Origins of Sport

The term "sport" encompasses concepts of play, gamesmanship and competitiveness. Presumably, mankind has always engaged in some activity for the sake of frivolity. The type of activity has been shaped by many factors, including climatic, topographic and cultural influences.

1. The Dawn of Man

Individual play, organized games and team sports evolved in rough chronological order. Individual play and gamesmanship naturally centered on man's mastery of his physical capabilities. Walking, running, jumping and throwing, though subject to equipment supplementation and organized rules, have not changed much since man learned to stand upright. Globally, these "original" sports have maintained much of their popularity with little change in their particulars. Now collectively known as track and field, these activities are referred to by most of the world as "athletics." These sports maintain universal appeal because they are familiar to everyone. The Greek Olympics illustrate the international proportions

18. Stories permeate the airways featuring athletes participating in immoral acts. Murder, domestic abuse, sexual assaults and drug problems are just an unfortunate representative sample of the legal difficulties in which athletes seem to constantly find themselves involved. Even worse than the realities of their involvement is the fact that no one is exploring the reason for these occurrences. Instead the revelations seem to be matched with a contradictory response from legal authorities and most of the public continues their love affair with these individuals, rewarding them as opposed to ensuring they receive the punishment that normally awaits other citizens. See, e.g., Paul Levy, Studies Find More Violence by Athletes, MINNEAPOLIS-ST. PAUL TRIB., Jan. 9, 1996, at A1 (documenting several cases of abuse involving star athletes).


20. See id. There have been numerous philosophical efforts to define mankind as a species of players, or "homo ludens." See id. The most well known is JOHN HUIZENGA, A STUDY OF THE PLAY ELEMENT IN CULTURE (1949).

21. See GUTTMANN, supra note 14, at 5. The term athlete comes from the Greek terms "athlos" and "athlon" which mean "contest" and "prize", respectively. See id.
of these activities and mark the historical point of official recognition of these activities as sports.\textsuperscript{22} Although civilizations predating the Greeks engaged in sports, no other society raised organized competition to such a widespread, grandiose level.\textsuperscript{23}

For many years, the Olympics consisted of only foot races. Gradually, other common sports were added to the festivities.\textsuperscript{24} The Olympics were the largest of a number of ongoing athletic festivals in the Greek world.\textsuperscript{25} Initially, athletes received wreaths and laurels. Soon, however, the prizes grew to include monuments and cash.\textsuperscript{26} The ancient world saw victors boast of success without distinction between the cash competitions and the sacred contests.\textsuperscript{27} Athletes were sponsored and there is even evidence of corporate chariots in some of the racing events.\textsuperscript{28}

Although the Greek Olympics ended in the fourth century, this did not signal the demise of competitive sports. Variations of competitive sport generally reflected the polity of the times. In the Roman empire, the view of sport as a matter of gaining great

\textsuperscript{22} See John Kierman & Arthur Daley, \textit{The Story of the Olympic Games, 776 B.C. to 1968} (rev. ed. 1973). Modern Olympics date from 1896, beginning in Athens, Greece. See id. at 21. The games were reestablished when Baron Pierre de Coubertin, a traveled, well educated Frenchman sought to promote better international understanding throughout the world. See id. at 19-21. Coubertin, who was also an avid sports enthusiast, seized the idea of reviving the Olympic games. See id. In 1894, during a meeting of nine nations at the Sorbonne in Paris, the idea was accepted and thus began the modern day Olympics. Many nations were enlisted to the cause of reviving the Olympic games. See id. at 27.

\textsuperscript{23} See id. at 11-18. The Olympic Games of Greece are traditionally dated from 776 B.C. to 394 A.D. See id. at 11, 17. Although these dates are popular with most historians, there is much support, based on dating the ruins uncovered in the nineteenth century, to indicate the games may have begun at least three centuries earlier. See id. at 12. It has been said that part of the Olympics' downfall was a change from amateur involvement to an infiltration by professionals who used the games to seek gifts and money. See id. at 16.

\textsuperscript{24} See generally Michael B. Poliakoff, \textit{Combat Sports in the Ancient World} (1987) (describing history of wrestling and boxing). A number of additional sports were involved, such as wrestling and boxing, which resulted in numerous deaths among participants. See id. These sports can be dated to early civilizations in approximately 3,000 B.C. See id. at 2.

\textsuperscript{25} See Guttmann, supra note 14, at 21. The other major Greek athletic festivals were the Python held at Delphi every four years, Isthmian held at Corinth every two years, and the Nemean held at Nemea every two years. See id. Each festival honored a different primary god, although other gods were given homage for various events and lesser celebrations. See id.

\textsuperscript{26} See Kierman & Daley, supra note 22, at 17.

\textsuperscript{27} The Olympics and other Greek festivals had some degree of religious significance as did many sporting events of the past. A number of societies are characterized as having been engaged in athletic activities for purely sacred purposes. Probably the most famous of these is the ancient Olmec/Mayan “basketball” game for which the loser was allegedly beheaded.

\textsuperscript{28} See Poliakoff, supra note 24, at 107.
recognition gave way to concerns of mere survival. Medieval jousting and similar “sports” involving activity akin to training for battle left many fatally wounded. While these sports of killing for the entertainment of the plutocracy seemed especially ghastly, mortality became an integral part of gamesmanship.

2. The Modern Era

The modern era of sport spans approximately less than two hundred years. Expert theories on the proper starting point of the modern era of sports are diverse. They generally agree, however, upon a starting point somewhere near the end of the nineteenth century. At that time, the world was basically resolved geographically, with governments focusing on issues of inner strength as nations and outer strength as recognized global economic powers. In the west, there was industrialization and capitalism. In the east, there was communism. Throughout the rest of the world, there were variations along the spectrum. A constant among societies was the growth of population, which was uniformly welcomed as providing a strong basis for the chosen governmental form. A second constant was the need to provide this expanding populace with enough comforts to dispel the likelihood of an uprising and therefore, to make the people willingly serve their greater societal purpose.

To fulfill the needs of the expanding populace, a more highly organized form of sport developed. Sport, once prized for its value as exercise or spontaneous frivolity, now became a tool of governmental control that offered citizens a way to creatively release energy. Official associations arose to give structure to national and

29. See Guttmann, supra note 14, at 23. Instead of offering opportunities for equal participation in sports, the Romans primarily used sports to entertain the aristocrats, featuring events pitting slaves against each other, as well as against wild animals. See id.
30. See id. at 47.
31. See generally Poliakoff, supra note 24 (commenting on variations of combat sports that have evolved with mankind since his existence and constant spectre of death that has accompanied their involvement).
32. See Guttmann, supra note 14, at 57.
33. See id. at 62-64 (discussing various influences of capitalism, Marxism and Protestantism on development of sports).
34. See Jacquetta Hawkes, The World of the Past 564 (1963). Many of the most ancient references in sport stemming from archeological excursions indicate that organized societal sport was often premised on motivating individuals to exercise. See id. (noting that children were encouraged to throw, catch, run and leap as soon as they were physically capable).
international competition. Man was no longer isolated but connected now through sports.

In addition to sport, the mid-nineteenth century witnessed the development of the telegraph, camera, movie camera and newsreel. Planes, trains and automobiles were not far behind. In less than one hundred years, mankind blossomed from primary provincialism to internationalism.

With unending explanations, theorists sought to discern how all the pieces fit together and how sports, law and society were to coexist. The nature of the activities provided the most viable explanation. Society required an acquiescence to laws in order to function, whereas sport provided an outlet for those wanting to escape from those laws and operate under their own rules and regulations. Though not permanent or extensive, citizens were able to operate within a sphere where, for at least a moment, they felt they were masters of their own destiny.

B. Tracking the Field of Intellectual Property

Early civilizations did not possess a legal mechanism to protect their ideas and the resulting products that flowed therefrom. Men and resources were scarce and so one can imagine an eagerness to share. There was a communal view of life where people were relatively uncompetitive in their treatment of new discoveries. A proprietary motive was fairly limited to dwellings, food and a small number of personal items. On the whole, new developments were shared. As the general populace grew and man's horizons ex-

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35. See GUTTMANN, supra note 14, charting:

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36. See ERIK H. ERIKSON, TOYS AND REASONS (1972); PLAY AND DEVELOPMENT: A SYMPOSIUM (Maria W. Piers, ed., 1972). Numerous renowned psychiatrists/psychologists have discussed the role games play in human development. A sort of pop psychology view has been espoused by some writers whose analysis is more focused on the effects of sports on society even though the writers are not credentialed in the professional sense. See HOWARD COSELL, WHAT'S WRONG WITH SPORTS (1991); MICHAEL ROBERTS, FANS! HOW WE GO CRAZY OVER SPORTS (1976).

panded, it became clear that these strange new places held promise for the explorer. By trading items with a relatively higher value in differing cultures, one held the key to great personal advancement.

By focusing on legal concepts, we catapult forward in time, past basic societal organization. While anthropologically speaking, structured legal systems have been present within some of the earliest recognized cultures, there was no need for intellectual property regulation until the exchange of goods and services. Early trade was primarily motivated by desires for personal profit, as opposed to simply raising the majority's standard of living.

1. **Patent Law**

Patent protection is one method available to protect an individual’s qualified inventions. These inventions may be protected by a number of patent designations, depending on the area in which the development occurs. Most often, one thinks of some type of mechanical contraption when the term “invention” is mentioned. Mechanical devices do define the traditional coverage of patent law. As society evolved, however, new disciplines have been

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at 2-5. Certainly greed often became the primary operative emotion leading to attempts at personal conquest, but history shows that wars and more civilized exchanges have always been simultaneously present. *See id.*

38. *See SINHA, supra* note 13, at 5. Basic societal organization can be seen as a relatively modern concept when compared to the dates, albeit disputed, of the origin of mankind. *See id.* at 2-3. Sumerian and Babylonian societies have only been dated back to 3500-3000 B.C., with recorded laws appearing about 2400 B.C. *See id.* at 4-5. Probably the most famous of ancient laws, the Code of Hammurabi, appeared during that King’s reign over Babylonia from 1792-1750 B.C. *See id.* at 5.

39. For a discussion of the development of intellectual property systems, see J. H. Reichman, *Universal Minimum Standards of Intellectual Property Protection Under the TRIPS Component of the WTO Agreement*, 29 INT'L LAW 345 (1995). More countries than not fail to grasp the need for intellectual property regulation. The only major intellectual property legal systems in the world exist in the most highly developed societies. *See id.* at 346. Recent attempts to standardize and stimulate global economic growth highlighted this fact, when the General Agreement on Tariffs and Trades (GATT) was stalled in its original implementation by the more highly developed countries demanding that satisfactory protection be granted for their intellectual property contributions. *See id.* at 351. These concerns were somewhat resolved by the Trade Related Intellectual Property Rights (TRIP), however a number of concerns still remain. *See id.* at 386-88.

40. The procurement of patent rights is regulated by 35 U.S.C. §§ 1-376 (1995). Of the three major areas of intellectual property, the Patent Act has seen the least amount of change. In the last decade, sections have been revised or added to reflect the globalization of society and therefore encourage businesses and investors to cross the world in seeking recognition and implementation of their various inventions.

produced never before imagined by the patent system originators. Computer technology, scientific developments in chemistry, biology, genetic research (including new types of foodstuffs, plants and animals), are just a small representation of sources for discoveries that now receive protection. There is also a patent protection available for particular designs. The patent system in its current state is akin to a governmental grant of a monopoly because one who secures a patent has the exclusive right to make, use and sell the patented item for twenty years.

To secure a patent, a development must be new, useful and not obvious. These terms carry much interpretive baggage based on the evolution of the discipline in which one seeks protection. Universally, however, one must truly "invent" something in order to garner the benefits of the system. This is a point of irony when reviewing the development of patent protection because it is much easier to identify situations where benefits akin to a patent were conferred without the structure of our present day proceedings.

42. The Design Patent statutory section has been the source of considerable controversy since the design must be ornamental and nonfunctional in order to acquire protection. Most patents are deserving of protection by virtue of the new use or function they exhibit. Design patents have been litigated in the sports context in a variety of areas. See, e.g., L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1121 (Fed. Cir. 1993) (shoe line); Brookfield Athletic Shoe Co., Inc. v. Chicago Roller Skate Co., 607 F. Supp. 241, 244 (N.D. Ill. 1984) (integral shoe sole and wheel mounting for roller skate).


45. Generally, one must meet the requirements regardless of whether the patent sought is of the traditional utilitarian type or of the design or plant variety. Due to the different nature of the subject matter, however, the jurisprudence behind the interpretation of how these elements are met in the latter two areas is much less developed. To the contrary, the issues of newness and nonobviousness are among the most highly contested in the history of contemporary patent law. For examples of the types of analysis which are engendered by the issues, see generally Kate H. Murashige, The Hilmer Doctrine, Self-Collision, Novelty and the Definition of Prior Art, 26 J. MARSHALL L. REV. 549 (1993) (discussing various approaches that can be taken); Dorothy Whelan, A Critique of the Use of Secondary Considerations in Applying the Section 103 Nonobviousness Test for Patentability, 28 B.C. L. REV. 357 (1987) (focusing on history of nonobviousness test).

46. See, e.g., BRUCE W. BUGBEE, GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW 6-8 (1967) (discussing early struggle to differentiate monopolies and patents). One of the interesting debates that dogged early patent law involved whether or not the granting of a patent was akin to giving one a monopoly as it related to a particular item. See id. Since the term monopoly was tainted with the impression of illegality, many argued that the granting of a patent did not equate to a monopoly, but instead a franchise or special privilege. See id. at 6. As the term monopoly
The cook, craftsman and artisan who were given franchise and monopoly rights in the past, under the label of patent protection, did not have to show "invention."\(^{47}\) Under our present system it seems unlikely that any of their contributions would garner them the award of a patent if they did not invent the food, artwork or clothing that was the subject of these older grants.\(^{48}\)

Historical records indicate that earlier civilizations did not place much emphasis on developments to ease an individual's lot in life. Indeed the opposite was often true. The elite would never give the lower castes hope for raising themselves up to any level of prominence, for fear of political or economic backlash. Thus, there was no true recognition for efforts. Likewise, the privileged class members were not in competition with each other, thus protecting new findings was not necessary.\(^{49}\)

The oldest, most thoroughly documented exclusive grant is a reference to the people of Sybaris,\(^{50}\) circa 600 B.C., when a cook was given the exclusive right to develop certain dishes.\(^{51}\) Men, for many years prior, mastered areas commonly known today as grew to encompass legal acts, it was more acceptably applied to patents. \(\text{See id. at 7.}\)

The irony of this debate was that the terms franchise, privilege and monopoly had extensive meanings beyond patent rights. \(\text{See id.}\) Thus, many who received some grant pursuant to that broader meaning often were perceived as having received patent rights, though they had no proof of invention. \(\text{See id.}\)

\(^{47}\) \text{See id. at 12-16. The present patent does grant a patent holder exclusive rights which courts do label as monopoly rights, but with the understanding that the more stringent requirements of patent qualification have been met. See 35 U.S.C. §§ 154, 271 (1995).}\n
\(^{48}\) \text{But see patents issued recently in these three areas such as: Patent No. 5,470,598, Nov. 18, 1995, Beta-prime stable, low-saturate all purpose shortening; Patent No. 5,134,726, Aug. 4, 1992, Sports pants with protective pads; Patent No. 4,961,503, Oct. 10, 1990, Condiment dispenser with pivotal arm. All of these patents obviously have utility for the true sports enthusiast.}\n
\(^{49}\) \text{Within the highly developed ancient societies there were often more slaves than not. This fact can be verified from census data available on Greece and Rome. A similar state of affairs existed in early American history when slavery was still an accepted practice.}\n
\(^{50}\) \text{See POLIAKOFF, supra note 24, at 12. The people of Sybaris, or Sibaris as it has also been referenced, were known as self-indulgent sloths, and the term Sybarite is still used today to characterize someone who shows those characteristics. During the development of the ancient combat sports, the Sybarites were loath to participate in the construction of the facilities or the sport itself. See id.}\n
\(^{51}\) \text{See BUGBEE, supra note 46, at 166 n.5. An early writer wrote of the Sybarites:}\n
\[\text{[I]f any caterer or cook invented a dish of his own which was especially choice, it was his privilege that no one else but the investor himself should adopt the use of it before the lapse of a year, in order that the first man to invent a dish might possess the right of manufacture during that period, so as to encourage others to excel in eager competition with similar inventions.}\]

\text{Id.}\n
\text{http://digitalcommons.law.villanova.edu/mslj/vol4/iss2/2}
mechanical engineering, construction, admiralty and husbandry (farming). The motivation and implementation of the resulting products were, however, directly related to either communal spirit, a sort of caste system or the fruits of conquests. None of these reasons were the type upon which one would base a financial reward system.

As humanity moved from the Middle Ages to the Renaissance, governments moved closer to the recognition of an explicit patent system. Initially, all the protections were issued for items now widely considered as basic requirements for human existence, namely clothes, food, comfort and security. The first general patent statute was established in 1474. By the end of the Renaissance, all the European nations had followed suit.

2. The Law of Copyrights

The copyright system rewards those who have developed some particular type of creative expression. Most associate copyright with some manifestation of this expression in terms of writings or drawings. If one is looking into the origins of writing and art, these developments are known to predate the development of paper and paint brushes. There are age-old stories of archeological digs which gave rise to new languages found etched in stone on cave walls. Much of what we know of early human development is directly linked to the findings of these pictures and other artifacts unearthed by scientists in search of man’s past.

Though documentation exists regarding complaints of piracy of literary works from as far back as 100 A.D., there appears to have been no recognized system of copyright law until the fifteenth cen-

52. See Bugbee, supra note 46, at 166 n.5. The first traceable patent-like grant involved food. See id. The monopolistic rights that followed involved fabric colors and cloth-manufacturing methods. See id. at 14-16. Glass and wind-mill making followed in the next two centuries which also saw protection granted for flour mills, boats and the making of guns. See id. at 14-22.

53. See Bugbee, supra note 46 at 19. Enacted by the Florence woolen gild, it provided for a penalty for stealing others’ patterns. See id.

54. See Michael H. Hart, The 100: A Record of the Most Influential Persons in History 66-74 (1987). Tsai Lun invented paper in or about the year 105 A.D. See id. The emperor gave him a promotion, an aristocratic title and he became wealthy as a result of his invention. See id. Egyptians, Greeks, and Romans used papyrus. See id. This was replaced in the West by parchment or vellum, which was processed animal skin. See id. The Europeans learned papermaking from the Arabs in the 1100’s and the German, Gutenberg invented the printing press in the 1400’s.

55. See Hawkes, supra note 34.
This period was the Renaissance in Italy, where it is reported that the first granting of a right akin to our present copyright was to John of Speyer in 1469 to conduct all the printing in Venice for five years. The development of copyright systems in neighboring countries quickly followed. Interestingly, this did not lead to a common European copyright system, nor has one evolved at present. While we have certain recognized ways of giving individuals around the world notice that a particular expression is copyrighted, there is no universal copyright law.

Some have argued that the right given to John of Speyer was more analogous to a grant of monopoly than a recognition of copyright status. Similarly, other European statutes, such as the Licensing Act of 1662 which required new publications to carry a certification, might be said to have stopped short of clear recognition of copyright protection. Many point to England’s Statute of Queen Anne in 1709 as the first true copyright statute though it was

56. See Bugbee, supra note 46, at 13. The term “plagiarize” is traceable to the Roman epigrammatist, Martial, who complained of literary and intellectual piracy during the first century (A.D.). See id. Martial suggested that the creation of his work gave him a property right and accused those guilty of disrespecting this right to be encompassed by the group of individuals guilty of “plagium,” a term used to denote kidnapping or manstealing. See id.

57. See id. at 44.

58. See id. at 48-49.

59. See U.S. International Trade Commission, Foreign Protection of Intellectual Property Rights and the Effect on U.S. Industry and Trade (February 1988). There are two international copyright agreements in force, but neither are involved in granting rights. See id. Instead, they simply seek to protect those rights which a party has secured in her own country. See id. The Berne Union for the Protection of Literacy and Artistic Works originated in 1886 and has about ninety members. See id. The Universal Copyright Convention was ratified by the United States in 1955. See id. The United States only recently joined the Berne Convention in 1988. See id. Neither of the agreements have much enforcement power. See id. It was recently reported that piracy of domestic works resulted in losses exceeding seven billion dollars. See id.

60. See id. The Berne Convention does not require any insignia on a copyrighted work to indicate that it is protected. See id. Domestically, however, it helps one assure his rights if he uses some indicia of protection on the work created. See id. The most accepted form of notice is a ©, the word copyright or an abbreviation followed by the first year of publication and the copyright owner’s name. See Circular 1, Copyright Basics, United States Government Printing Offices 1993 (one of more than one hundred circulars, announcements, regulations and related information which copyright office will mail to individual as part of information kit on latest data required for compliance with copyright office in Library of Congress when seeking to procure copyright protection).

61. See Bugbee, supra note 46.

limited solely to the printing of books. The importance of books cannot be overemphasized, especially in relation to that era which was without alternative communication. England and the American colonies began to witness the newfound growth of libraries and newspapers early in the eighteenth century.

The first federal American copyright law was passed in 1790 and it was a fair reproduction of the Statute of Anne. Pirating of English works as well as new developments in printing led to constant amendments to the law through 1909. The Copyright Act of 1909, which remains very relevant, was comprehensively amended in 1976. The present Act represents another substantial recent change to assure our alignment with international trends in the law.

3. Trademarks and Unfair Competition

Trademarks are rights given to individuals and entities seeking to identify their goods and services. Particular marks, names or other methods of identification were common on pottery that has been retrieved in numerous archeological expeditions and is now preserved in a variety of museums throughout the world. Roman law serves as a basis for much of our property law and how trademarks evolved to include the recognition of proprietary rights. There is no indication, however, that a mark owner had the right to bring an action for the unlawful infringement of a mark during the Roman empire.

The first European statute that expressly created a protection for trademarks originated in England. Trademark protection began to take on traits similar to those afforded by our current system

63. See Ringer, supra note 62, at 121.
64. Since the 1790 statute, the Copyright Act was amended or overhauled in 1802, 1831, 1856, 1865, 1870, 1891, 1897, 1909, 1954, 1971, 1974, 1976, 1988, 1994 and 1995 with the last three changes significantly reflecting a domestic effort at becoming more international in scope.
65. Trademarks are protected at common law, by state laws and on a federal level by the Trademark Act of 1946. See Trademark Act of 1946 (Lanham Act), 15 U.S.C. §§ 1051-1127 (1992). A trademark is defined in § 1127 as including any "word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown . . . ." Id. § 1127.
66. See John Burrell, Q.C., Two Hundred Years of English Trademark Law 35, 38 (1976). Archeological digs from the Ur of Chaldees show that artists and family members placed household marks on their belongings to indicate a source of origin and quality. See id. In 1591, however, it is reported that a clothier in London suffered liability under an action for deceit due to placing the mark of a well known clothier from Gloucestershire on some goods of lesser quality. See id.
with the development of the guild system amongst craftsmen.\textsuperscript{67} Common law protections, which now encompass the law of unfair competition, began to arise. These common law actions, labeled as deceit, appropriation, or passing off, generally involved one individual causing the general populace to believe that his or her goods were the goods of another.\textsuperscript{68} As these questions became increasingly linked to the names and symbols associated with certain items, the judiciary instigated a separate system of analysis for trademark infringements.\textsuperscript{69}

The Trade Marks Registration Act of 1875, in England, was one of the earliest acts to provide for the cataloging of marks, although it lacked specificity with regard to enforcement.\textsuperscript{70} American trademark protection, which existed sporadically on the state and federal level, received official recognition by virtue of the Trademark Act of 1881.\textsuperscript{71} Modified shortly thereafter, the Trademark Act of 1881 gave rise to the Trademark Act of 1946, which serves as our foundation for trademark law today.\textsuperscript{72}

III. THE UNION OF INTELLECTUAL PROPERTY AND SPORT

A more detailed analysis of the merger between sport and intellectual property illustrates the principle considerations involved in analyzing the typical patent, trademark or copyright case. While all intellectual property law can be explained through the use of sports cases, it is important to note that here, as in other more traditional legal subjects, sports has caused us to alter our view of the status quo. Normally, the result has been positive and has supported the recognition of a new area nominally identifiable as "sports law."\textsuperscript{73} As in any new development, however, there are neg-

\textsuperscript{67} See id.

\textsuperscript{68} The common law of unfair competition remains relevant as a part of our intellectual property jurisprudence. For recent cases illustrating the modern status of appropriation and deceit relative to company employees and sport, see Universal Gym Equip., Inc. v. ERWA Exercise Equip. Ltd., 827 F.2d 1542 (Fed. Cir. 1987); K-2 Ski Co. v. Head Ski Co., 506 F.2d 471 (9th Cir. 1974).

\textsuperscript{69} See BURRELL, supra note 66, at 42.

\textsuperscript{70} See BEVERLY W. PAT1ISHALL, Two Hundred Years of American Trademark Law § 1 at 61.

\textsuperscript{71} See id.

\textsuperscript{72} See id.

\textsuperscript{73} See PAUL C. WEILER & GARY R. ROBERTS, Sports and the Law (1993). A popular issue of debate is whether there is any subject area called "sports law." See id. at subsection V. Some believe the term to be a misnomer and have gone so far as discussing topics as "Sports and the Law." See id. Others share the view that all law is dependent on a recognized core; however, societal developments cause us to focus this core in a concentrated fashion. See MATTHEW C. McKINNON ET AL., Sports Law (1995). This practice leads to the establishment of specific legal sub-
ative influences and opportunities for exploitation of the law. The mix of sport and intellectual property provide examples of both these extremes.

A. The Spectrum of Patentable Sports Items: Utility Patents

While most of the legal disputes surrounding face saving involve trademark and copyright law, patent law reigns supreme over concerns of literally keeping the face safe. Patents are regularly issued for sports devices designed for protection. In this last year, we have witnessed patent awards for items such as the baseball bat and cover, the protective helmet with transceiver, numerous variations of the face mask and several different types of sports goggles. The case law involving sports devices and patent law sometimes involve competitors' claims regarding these types of face saving devices.\(^7\)\(^4\) In analyzing sport utility patents, one is better served by reviewing cases involving a mechanical item with a number of large, easily recognizable moving parts.

Patents are exclusively regulated by the Federal Patent Act.\(^7\)\(^5\) The Act includes processes, machines, manufactures and compositions of matter as patentable subject matter.\(^7\)\(^6\) These items are generally classified as utility patents.\(^7\)\(^7\) Even within this grouping, it is common to characterize machines, manufactures and compositions of matter together as "products," to allow delineation between these types of claims and those involving "processes."\(^7\)\(^8\)

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\(^7\)\(^4\) See, e.g., Gargoyles, Inc. v. United States, 6 F.3d 787 (Fed. Cir. 1993) (involving dispute as to whether U.S. Army infringed on manufacturer's patent for protective sports eyeglasses).


\(^7\)\(^7\) This is due to the requirement of usefulness. Utilitarianism encompasses the use of the item. Often the type of usefulness becomes an issue, especially when the use contemplated may be illegal. In a sporting sense, this point becomes especially pertinent when "games of chance" are involved. See Chicago Patent Corp. v. Genco, Inc., 124 F.2d 725, 730 (7th Cir. 1941) (holding that coin-operated pinball game is entitled to patent protection). But cf. National Automatic Device Co. v. Lloyd, 40 F. 89, 89 (C.C.N.D. Ill. 1889) (refusing to grant patent for coin-operated "Toy Automatic Race-Course" because of association with gambling).

\(^7\)\(^8\) "Processes" were only added to 35 U.S.C. § 101 as protectable subject matter when the Patent Act was revised in 1952. See 35 U.S.C. § 101 (1995). Prior to this time it was debatable whether a process was protectable or whether the Act should be read as applying only to products, as many courts interpreted the prior act to imply.
1. Mechanical Inventions

The mechanical invention belies connotations of "products" with standard moving parts such as springs, wires, nuts and bolts. For these types of inventions, one of the primary concerns is whether the basic requirements for patentability are met. The threshold test for patentability is fairly constant, regardless of the subject matter for which a patent is being sought. Nevertheless, basic patentability is one of the more highly emphasized aspects of utility patent litigation.

An instructive series of sports cases involves an invention for assisting individuals in weightlifting. In *Universal Athletic Sales Co. v. American Gym, Recreational & Athletic Equipment Corp.*, the court surveyed the most common concerns raised by the average utility patent. The crux of the litigation involved a plaintiff asserting that the defendants weightlifting machine violated the rights secured by the patent holder. The defendant counterclaimed, calling into question the validity of the original patent grant. The determination of validity required the court to review the statutory requirements of the Patent Act, as well as the accepted judicial interpretation of the Act.

The plaintiff essentially claimed a machine for simulating the chest press exercise. The invention involved the interaction of a frame and lever wherein the weights could be mounted to the machine in a manner that allowed for flexibility in the amount of resistance the user wished to encounter. The defendant claimed

79. See 35 U.S.C. §§ 100-03 (1995). These basic requirements are that the subject matter be new, useful and nonobvious. See id.


82. See id. at 1065.

83. See id. This bench press machine was actually referenced to as a "Body Exercising Apparatus." See id.

84. See id. at 1066. The defendant contended that the patent was not a novelty and was only an "obvious improvement on prior art." Id.

85. See *Universal*, 397 F. Supp. at 1066-67. Thus the court needed to review the fundamental requirements of new, useful and nonobviousness. See id. The court found that the commercial success and safety related design features made the utility of the item apparent, and thus focused on whether the machine was new and nonobvious. See id. at 1066-67.

86. See id. at 1066.

87. See id. at 1065-66.
that the machine failed to meet the statutory requirements of novelty and nonobviousness.88

To properly evaluate the patent the court was forced to evaluate the prior art.89 The prior art dated back to 1871 with the most relevant apparatus being very similar to Zinkin's machine.90 The evaluation of the operative principles entailed both an examination of the invention as a whole and a more particularized review of the separate parts.91 The court concluded that despite the usefulness of the machine, the sum of the individual parts were of no greater value when ultimately combined.92 Quoting from an opinion on basic patentability, the Universal court noted that the machine is one about which it might be said, "[t]wo and two have been added together, and still they make only four."93

The appellate court disagreed with the district court's evaluation of the evidence.94 The court noted that the pertinent prior art evaluated by the lower court was limited and called for review by qualified experts in the field.95 The variance between the prior art and challenged claims was especially significant since the differences related to the design and use of the various machines.96 The

88. See id. at 1066.
89. See id. at 1067-68. Whether an item is new and nonobvious requires an examination of "prior art," which means inventions of a related type that have been disclosed to the public prior to the pending application. See id. at 1068. Thus, 35 U.S.C. § 102 bars one from securing a patent when, for example, the invention now seeking the grant has been described in a prior patent application. See id. at 1066-67 n.3. Likewise one is barred under 35 U.S.C. § 103 if the subject matter sought to be patented is not sufficiently different from the prior art as to prevent one skilled in the art from seeing the obvious nature of the newly claimed invention. See id. at 1066-68 n.3. For the foremost treatise on patent law, see DONALD CHISUM, PATENTS, A TREATISE ON THE LAW OF PATENTABILITY, VALIDITY AND INFRINGEMENT (1994).
90. See Universal, 397 F. Supp. at 1069.
91. See id. at 1070. Courts often look at the invention both separately and as a whole because it has been held that a synergistic effect can save a patent. See id. Thus, even though the independent parts of an invention may be old and obvious, the combination results in the sum being greater than its parts and the granting of patent rights deemed proper.
92. See id.
95. See id. at 537. The court seemed particularly perturbed that the defendant's expert had little familiarity with the design of weight-lifting machines. He was an attorney in the firm representing the defendants and had in fact represented those involved in the suit in the past. See id. at 537-38. Additionally, his prior education and experience involved electrical engineering as opposed to mechanical engineering. See id. at 538.
96. See id. at 542.
court said that, at least for purposes of non-obviousness, the lower court failed to select the proper prior art.97 Thus the original patent was restored.98

The *Universal* opinions illustrate the basic requirements for securing a utility patent, as well as the posturing of the vast majority of reported patent disputes. In *Universal*, the allegedly infringing defendant claimed that the plaintiff's invention was improperly granted a patent. This triggered a review of the patent holder's compliance with the basic statutory and judicial requirements. If the defendant sees that such a ploy will be unsuccessful, he or she will alternatively seek to differentiate his or her invention from the plaintiff's.

One of the more controversial attempts at differentiation involves a defendant's assertion that the claims do not in fact "read on" the disputed invention. In other words, the alleged infringer's application does not make the identical literal claims to invention that the plaintiff does. A plaintiff then responds that the offending invention remains guilty of infringement under the "doctrine of equivalents." Under this doctrine, an infringement occurs if it performs in substantially the same way to reach the same basic result of the patented device, despite variations in explanatory verbiage.99 Thus the claims of the patented device are constructively expanded to encompass those of the defendant, despite the lack of direct infringement.100 Variations on the attempted use of the doctrine have figured prominently in the area of sports.

97. *See id.* The appellate court noted that the trial court limited itself to two weight-lifting machine references which resulted in a narrow definition of the prior art. *See id.* at 541-42. This improper narrowing was exacerbated by the deficiency of the expert in the case. *See id.* at 541. The court stated that the pertinent art in the case should have been a body-exercising apparatus. *See id.* at 542.

98. *See id.* at 543-44.

99. 35 U.S.C. § 271 makes the unauthorized production, use or sale of a patented item during its period of production an infringement, subjecting the offender to substantial remedies. 35 U.S.C. § 271 (1995). In patent law a product is guilty of infringement if the claimant's protected claims "read on" the device of the accused. If, however, the claims do not read on the accuser's product, but are substantially equivalent, a defendant may still be liable, provided the two items in dispute perform equivalently similar functions.

In the recent litigation of *Nike, Inc. v. Wolverine World Wide, Inc.*, Nike was unable to successfully use the doctrine. The *Nike* case involved a shoe which, among its many parts, included a sole with a sealed inner member inflated with a gaseous medium. Nike sued Wolverine for infringement based on a Wolverine shoe which included a “heel insert containing 80-90% viscous silicone liquid and [10-20%] air at ambient pressure.” The court applied a basic two-step analysis to the question of infringement first construing the relevant claim of the invention to determine its scope and meaning, and secondly, comparing the claim as properly construed to the alleged infringing product. The court concluded that the Wolverine shoe did not infringe.

The court noted that the term “inflated” did not include air which was merely contained or trapped. The Wolverine shoe was not “inflated” with air or any other gas but instead simply contained air at ambient pressure. Due to the failure of Nike’s claim to exactly read on the Wolverine shoe, no literal infringement was present. Only through a more expansive interpretation of the claims would infringement be found. To succeed, Nike would have to argue that Wolverine’s product was the equivalent of the Nike shoe and persuade the court to read the claim language as broad enough to cover trapped air. Nike was unable to meet these requirements.

In *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, a new approach to the use of the doctrine of equivalents was tendered. This case involved the complicated theory of “dimple science,” which provides the backdrop for the very serious

101. 43 F.3d 644 (Fed. Cir. 1994).
102. *See id.* at 649.
103. *See id.* at 646.
104. *Id.*
105. *See id.*
106. *See Nike*, 43 F.3d at 647.
107. *See id.*
108. *See id.*
109. *See id.*
110. *See id.* at 649. Nike did not provide the defendants with any indication that a factual basis for a claim on the doctrine of equivalents existed. *See id.* at 648-49. The court noted that the defendants began selling the shoe in 1989 and that Nike did not file suit until 1993. *See id.* Thus, Nike had more than three years to investigate the prospects of proceeding on the doctrine of equivalents. *See id.* at 649. Because they waited until after the close of discovery to assert their claim, the court felt that a sanction preventing Nike from proceeding on the doctrine was proper. *See id.*
111. 904 F.2d 677 (Fed. Cir. 1990).
112. *See id.* at 684-85.
competition of developing the better golf ball. The dimples on the golf ball create the turbulence, lift and drag ratios responsible for the distance and flight paths of the balls. The court developed a hypothetical claim mechanism to assist it in evaluating the question of equivalency as it related to the prior art reviewed to justify the issuance of the original patent. In essence, the court suggested a theoretical claim, which encompassed the total range of equivalents, to determine whether such an invention would have been patentable at the outset. The court felt such an approach would help determine if a patentee was improperly seeking a broader reading of his patent, via equivalency, than entitled, relative to the prior art involved. This new approach to the doctrine of equivalents led to the defendant's ultimate success in the case.

Thus, it becomes evident that a sports scenario enables one to easily comprehend patent law fundamentals. As Wilson indicates, the sport context may also provide the backdrop for bold new judicial experiments. After all, each game utilizing something more than pure physical dexterity involves products, many of which are grounded in a scientific or technical discipline.

2. Nonmechanical Goods

Product patents include machines, manufactures and compositions of matter. Each of these subgroups can be further defined to arguably encompass every item, save those not literally "made by man." The protection of compositions of matter contemplates the mixture of two or more ingredients with properties which the ingredients singularly fail to possess. Thus, chemical compounds, alloys and mechanical or physical mixtures resulting in gases, powders, liquids and solids fall within this category.

113. See id. at 679.
114. See id.
115. See id. at 684-85.
116. See Wilson, 904 F.2d at 684.
117. See id. at 684-85.
118. See id. at 686. For another recent case involving the doctrine of equivalents in the sporting context, see Athletic Alternatives, Inc. v. Prince Manufacturing, Inc., 73 F.3d 1573 (Fed. Cir. 1996) (involving dispute over tennis racket patent).
120. See Chisum, supra note 89, at 1-32. See also 35 U.S.C.A. § 101 (West 1984). Natural laws and true products of nature are not within the classifiable range of patentable subject matter. An idea or theory is not patentable either. This is true even if the applicant is the first person to discover the item.
121. See Chisum, supra note 89.
The composition of matter category is of vast importance in the sports world. It is under this subgrouping that companies involved in drugs and nutrition seek protection. An example is the sports drink business. The sports drink business is a multi-billion dollar phenomenon which feeds off manufacturers’ claims that these various items will give the user some type of especially beneficial fluid replenishment. It used to be that water was enough for the athlete, a claim still supported by a large portion of the medical community. Water, however, was overshadowed by the sports drink companies’ promise to athletes that they will not only feel better, but that they will also perform better if they drink these supposedly high vitamin sports drinks. These sports drinks contain everything from amino acids to zinc metabolizers.

B. Copyright Law Tries to Keep Pace

Copyright law is the area most drastically affected by technological innovation. This is because technology has reflected itself most prominently in modern society by a continuing attempt to improve communication. We have moved toward a global community largely due to our ability to instantly engage each other from any point on earth. Communication entails expression and it is expression that copyright aims to protect.


125. A rather contentious debate surrounds the ingredients of many of the sports supplements. A patent application requires exacting standards, thus those seeking to patent their formulations are complete in their disclosures. The supplement makers, however, must only comply with the Dietary Supplement Health and Education Act of 1994. 21 U.S.C. § 501 (1994). This light regulation does not specify disclosure requirements, nor is there any testing required for these substances. See id. at 21 U.S.C. § 342(f),(g). The supplements are not “drugs,” thus they escape the exacting scrutiny of the Food and Drug Administration. See generally Yumiko Ono, Twin Lab Finds Itself a Lucrative Niche in Health-Food Pills, WALL ST. J., Aug. 8, 1995, at Al (discussing Twin Lab’s $100 million business).

126. Radio actually initiated the distribution of live sports broadcasts. Prior to this time, however, individuals were able to see movies of major sports events via newsreels. The dissemination of news and sports by newsreel actually predated the twentieth century.

127. It is often said that patents protect invention, copyright protects expression and trademark protects identification. The area of copyright law is solely regulated by federal law. See 17 U.S.C. §§ 101-810, 1001-1010 (1995) (comprising
The Copyright Act provides that original works of authorship fixed in any tangible medium of expression now known, or later developed, are protected.\textsuperscript{128} The Act lists items contemplated for protection.\textsuperscript{129}

Unlike patent law, the legal requirements to secure copyright protection are relatively simplistic.\textsuperscript{130} Protection is automatically bestowed on the author of the qualified expression at the moment of its creation.\textsuperscript{131} While direct copying of the work of another is expressly prohibited, there is no penalty associated with protecting a duplicate work as long as it is independently developed. It follows that if protection is available for works that are identical, those having a very subtle difference are even easier to protect. One court noted that a difference caused by a clap of thunder, bad eyesight or defective musculature was enough to satisfy the threshold of creativity required for copyright protection.\textsuperscript{132} With the criteria for protection seemingly so easily met, one may wonder why so many cases arise, especially in the sports context. As simplistic as the framework seems, the fact is that the claims are worth billions of dollars and carry the capacity to determine who holds the reins of power in the sporting world.\textsuperscript{133}


129. See id. listing: (1) literary works; (2) musical works; (3) dramatic works; (4) pantomimes and choreographic works; (5) pictorial, graphic and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.

130. The essence of copyright law is originality and creativity. There is no definite level of creativity mandated, and originality means little more than that it originated with the party seeking the protections of the statute. Because copyright and patent law emanate from the same constitutional provision, some have argued for a similar evaluation of their validity. Such an argument, however, has basically gone for naught and it is generally understood that a thousand replications of one idea's expressions may be copyrighted, as long as they were all independently created.

131. None of the intellectual property statutes require that one apply for protection unless one wants to avail him or her self of the exclusionary remedies included therein. See Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 232-33 (1964) (holding federal patent law forbids states from prohibiting copying of non-copyrighted articles); Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 238-39 (1964) (holding in absence of state law, states may not impose liability for sale of someone else's non-copyrighted article). Prior to the Sears and Compco decisions, state and common law protections were available for copyrights and patents. These protections remain available for trademarks and unfair competition.


133. In 1964 CBS paid $14 million to televise the National Football League (NFL). See Rushin, supra note 16, at 40. By 1982, ABC, NBC and CBS (the three
1. **Expressive Designs**

An exemplary case involving the basic requirements of copyright law in the sports context is *John Muller & Co. v. New York Arrows Soccer Team*. In that case, the artist responsible for designing the team logo sought copyright protection once a dispute arose between the two parties. Since there were no factual issues in controversy, the court was free to make a determination premised on the normal legal standards involved in a basic copyright case. The court noted that copyright protection is available only for works that show a minimum level of creativity and originality.

The court stated that the designer had failed to grasp the important distinction between the two areas and determined that the logo lacked creativity. The court did however, recognize the lack of any defining standard for determining the existence of an adequate level of creativity.

2. **The Prohibition Against Calculated Expressions**

Copyright findings against designs, descriptions and discussions of sporting rules have presented the sports aficionado with a dilemma in a closely related area; that is, whether sports statistics presented in a creative fashion are protectable. The case of major networks paid in excess of $2 billion to the NFL for a five year television package. See id. In 1990, five networks entered a new bidding fray driving the price up to $3.6 billion for three years. See id. See also Michael K. Ozanian, *The $11 Billion Pastime*, FIN. WORLD, May 10, 1994, at 50-59 (providing data on value of all sports franchises in professional baseball, basketball, football and hockey and indicating that they generally derive 50 to 70% of their total worth from media contributions); Eugene P. Trani, *The Distorted Landscape of Intercollegiate Sports*, CHRON. OF HIGHER EDUC., Mar. 17, 1995, at B1 (noting recent $1.75 billion contract between CBS and NCAA (National Collegiate Athletic Association) for right to broadcast seven years of collegiate basketball and decrying hyper commercialism that has become intercollegiate sports).

134. 802 F.2d 989 (8th Cir. 1986).
135. See id. at 990.
136. See id.
137. See id.
138. The term "logo" is Greek for word. Copyright protection, while dealing with expression in various forms, does not cover a word that can be characterized as a title, name, short phrase or slogan. Nor are variations of typographic ornamentation, lettering or coloring protectable listings of ingredients or contexts. See 17 U.S.C.A. § 102 (West 1994).
139. See *Muller*, 802 F.2d at 990.
Kregos v. Associated Press addressed this issue. The plaintiff developed a form for statistical references on the efficiency of certain baseball pitchers. The form was published in newspapers throughout the country. To Kregos’ dismay, the Associated Press began running a nearly identical form shortly thereafter. When Kregos sued for infringement of the copyright that he originally received for his stat sheet, the court denied him protection because “[a]ny curtailing of the right to use [the statistical] categories would exact a substantial limitation on competition.”

Thus, the prohibition was nearly complete where copyright of game related material was concerned. There was no protection for charts, instructions, rules or other writings concerning sports. Ironically, it was sport, and not the game itself which was deemed unworthy. Items associated with play, such as toys and games, were very likely to receive coverage. This remains true today.

142. See id. at 114.
143. See id.
144. See id. at 115.
145. Id. at 122. At trial AP was granted summary judgment upon proving that, despite the existing copyright held by plaintiff, the form developed by Kregos was not copyrightable. See id. The court was persuaded that the form lacked the necessary originality to fulfill the copyright requirements, as it found that Kregos simply selected certain readily available factual information for inclusion into his document. See id. at 120-21. The court also denied that the necessary elements of originality and creativity existed by virtue of Kregos’ selection and arrangement due to the merger doctrine of copyright. See id. at 119-20. This doctrine precludes protection when an idea, which is not protectable, merges with the expression of the idea to disallow protection for the expression as well, based on the belief that the idea can only be expressed in a limited fashion. See id. at 119. The court distinguished the modern horse racing cases, noting the forms at issue in those cases were copyrightable. See id. at 120. On appeal, in light of an interim Supreme Court decision on the copyrightability of factual compilations [Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991)], a divided court reversed the trial court’s decision on the ability to copyright Kregos’ form. See Kregos v. Associated Press, 937 F.2d 700 (2d Cir. 1991). The case was remanded for further consideration of infringement which was ultimately found nonexistent. See Kregos v. Associated Press, 795 F. Supp. 1325 (S.D.N.Y. 1992), aff’d, 3 F.3d 656 (2d Cir. 1993).
146. See Feist, 499 U.S. at 340. The decision in Feist on factual compilation was cause for a more liberal approach to be taken with statistical data forms. See id. In addition, items like programs, which were magazines filled with information for the team’s fans, were never disputed regarding their copyrightability. At the time of the decision, however, there was a questionable prohibition against charts, rules, systems and forms relating to sports. The application of the Feist doctrine remains an inexact science. Thus despite decisions like Kregos the potential still remains for a form to be denied protection or found to be infringing as to one already in existence.
3. Broadcast Technology’s Less Than Immaculate Reception

The print media, rather than television or radio, initially gave fans a face-to-face feeling of sports interaction during the earliest stages of organized sport.\(^{148}\) In addition to written descriptions of events, artists used to include their own renditions of the games. Black and white photography soon came of age, but was quickly followed by the perfection of the movie camera, which its inventor, Thomas Edison, used to film a boxing match.\(^{149}\) It was, however, the advent of live broadcast technology that facilitated the exponential involvement of the masses with the games.

Camping by the radio became a family ritual and sports broadcasters took notice. Federal regulations were deemed necessary to keep broadcasters in line and cases immediately arose to test the boundaries of the new law.\(^{150}\) For instance, in *Pittsburgh Athletic Co. v. KQV Broadcasting Co.*,\(^{151}\) the plaintiff owners of the Pittsburgh Pirates baseball team sued to enjoin the defendants, a local media outlet, from broadcasting its games.\(^{152}\) The Pirates claimed that KQV, despite knowledge of contracts between the Pirates and other broadcasting entities, broadcast Pirates games to public.\(^{153}\) The court said the radio station’s behavior violated established rules of intellectual property and the Communications Act.\(^{154}\) Interest-

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\(^{148}\) See, e.g., LAWRENCE RITTER AND DONALD HONG, *The Image of Their Greatness, An Illustrated History of Baseball from 1900 to the Present* (Crown Publishers 1979) (black and white pictorial of greatest players of sport from turn of the century until present); DAVID Q. VOIGT, *American Baseball* (1966) (baseball spread throughout the East Coast and to St. Louis and Chicago throughout 1860s).

\(^{149}\) See NORMAN HITZGES, *The Norm Hitzges Sports Almanac* 166 (1991). In his West Orange, New Jersey laboratory, Thomas Edison filmed a boxing match between Jack Cushing and Mike Leonard on June 14, 1894. See id.

\(^{150}\) See The Communications Act of 1934, Pub. L. No. 416, 48 Stat. 1064 (1934). The Act has been amended several times and is in the midst of reformulation even at this time. See generally ROBERT ALAN GARETT AND PHILIP R. HOCHBERG, *Law of Professional and Amateur Sports*, Chapter 18, Sports Broadcasting (Gary A. Uberstein ed. 1988) (establishment of Communications Act of 1934 was in part related to major league baseball teams broadcasting World Series, a practice that dated back to 1921).


\(^{152}\) See id. at 491.

\(^{153}\) See id.

\(^{154}\) See id. at 494. The court found that because the baseball team has acquired and maintained a baseball park and pays players, it has a legitimate right to capitalize on the news value of their games by selling exclusive broadcasting rights. See id. at 491.
ingly, the factual posture of the case gave rise to a review of both national and international precedent by the court.\textsuperscript{155}

The most dispositive factor in this decision was the availability of Supreme Court precedent explicitly recognizing the unlawful invasion of a property right when one takes another's work for public dissemination.\textsuperscript{156} The radio issue soon became secondary as television developed and enabled those in remote places to see the athletes' faces.\textsuperscript{157}

\textbf{a. Basic Coverage}

\textit{Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n (MLBPA)}\textsuperscript{158} is the ultimate case attempting to legally save face.\textsuperscript{159} In \textit{Baltimore Orioles}, the court was asked to determine whether ballplayers had ownership rights of their televised performances during their games.\textsuperscript{160}

The players said their performances were not the proper subject of copyright protection because they lacked artistic merit.\textsuperscript{161}

\begin{itemize}
\item \textsuperscript{155} See id. at 493. KQV sought to justify its position on the basis of an Australian case in which individuals broadcast horse racing from a tower which adjoined the race track. See id. (citing Victoria Park Racing v. Taylor, 37 New South Wales 322) (information broadcasted was obtained from tower adjoining race track). In \textit{Victoria Park}, the court refused to grant an injunction because there was neither a trespass on plaintiff's race track, or a nuisance created by defendant.

\item \textsuperscript{156} See Pittsburgh Athletic Co., 24 F. Supp. at 492. The court resolved the unfair competition issue by relying on the precedent of \textit{International News Serv. v. Associated Press}, 248 U.S. 215, 240 (1918). The Supreme Court held that permitting indiscriminate publication by anyone for purposes of profit in competition in the news industry would render publication profitless.

\item \textsuperscript{157} See \textit{GARETT and HOCHBERG}, supra note 150, at 18-19. The first sports event ever televised in the United States is reported to have occurred on May 17, 1939. See id. It involved the baseball teams from Columbia and Princeton Universities. See id.

\item \textsuperscript{158} 805 F.2d 663 (7th Cir. 1986).

\item \textsuperscript{159} See id. (holding that ownership of broadcast rights to baseball players' performances during major league baseball games belonged to baseball clubs). The court said (1) performance in baseball games is within the scope of players' employment; (2) statutory presumption that baseball clubs own copyright in telecast was not rebutted; and (3) players' state law rights of publicity in their game time performances were preempted by federal copyright law. See id. See also Shelley R. Saxer, \textit{Baltimore Orioles, Inc. v MLBPBA: The Right of Publicity in Game Performances and Federal Copyright Preemption}, 36 UCLA L. Rev. 861 (1989) (noting that decision precludes baseball players from retroactively claiming telecast revenues not bargained for in previous contracts with club owners). Saxer also argued that the decision will detrimentally impact all professional performers' bargaining power with respect to telecast revenues from live performances. See id.

\item \textsuperscript{160} See \textit{Baltimore Orioles}, 805 F.2d at 665. There was no dispute as to the copyrightability of the telecasts, since they were original and possessed a minimal level of creativity. See id. at 668.

\item \textsuperscript{161} See id. at 669 n.7. The modest level of creativity required by the law, coupled with the great commercial value attributable to their performance made
Relying on the statutory construction technique *expressio unius est exclusio alterius*,\textsuperscript{162} the players implied that the expression of these rights excluded all broader copyrights the owners may have.\textsuperscript{163} The players, however, did not prevail because this argument conflicted with the plain meaning of their collective bargaining agreement with the baseball owners.\textsuperscript{164} this premise implausible. See *id.* The players also tendered an alternative argument based on various sections of their uniform player's contracts, including a provision giving the clubs the right to take players' pictures for reasons other than game performances. See *id.* at 671. The players signed a league standardized form contract which included the following provision: The player agrees that his picture may be taken for still photographs, motion picture or television at such times as the Club may designate and that all rights in such pictures shall belong to the Club and may be used by the Club for publicity purposes in any manner it desires. *Id.*

\textsuperscript{162} See 3 ARTHUR L. CORBIN, CONTRACTS § 522 (Supp. 1992). "Expressio unis est exclusio alterus," or the expression of one is the exclusion of another. See *id.* Therefore, each word has a meaning that excludes different words and their meanings.

\textsuperscript{163} See *Baltimore Orioles*, 805 F.2d at 665-70. The Copyright Act clearly covers expressions of fine art such as the performances of dancers or similar choreographed material. See 17 U.S.C. § 102(4). For further discussion of the issue of choreography and copyright, see Anne K. Weinhardt, *copyright Infringement of Choreography: The Legal Aspects of Fixation*, 13 J. CORP. L. 839 (1988) (Copyright law exists to stimulate production of creative works). In *Baltimore Orioles*, it should have occurred to the players that athletic activity, which is much like an art form, would at least meet the threshold copyright requirements. *Baltimore Orioles*, 805 F.2d at 665-70. One of the most popular merchandising items for many of the major sports are videos which set the athletes' endeavors to music in a mimicry of ballet or some similar dance production. See generally Pittsburgh Athletic Co. v. KQV Broad. Co., 24 F. Supp. 490 (W.D. Pa. 1938). Furthermore, basic principles of agency should have indicated that a declaration that the requisite creativity for copyright protection was lacking would not have helped them resolve the issue of broadcast rights. See *id.* Employer/employee relations would have to be evaluated prior to reaching the broadcast issue. See *id.* Additionally, precedent existed predating sports television wherein athletic clubs ownership of players activities was recognized under general principles of property law without reference to copyright law. See *id.* Thus, it did not necessarily follow that a finding of lack of creativity meant the players would have a better claim to their performances. See *id.*

\textsuperscript{164} See *Baltimore Orioles*, 805 F.2d at 671. The existence of such an agreement contradicts another pertinent section of the Copyright Act. See *id.* Section 201 of the Act expressly states that the copyright of works made for hire belong to the employer. See *id.* at 670. The *Baltimore Orioles* court noted that 17 U.S.C. § 201 could be abrogated by specific agreement, however, no such agreement was found to either expressly or impliedly exist between the parties. See *id.* Unless there was no copyrightable subject matter involved at all, which would have precluded application of the Act, or the athletes were able to prove that they were not acting by virtue of their employment contracts, thus overriding the collective bargaining agreement, no real issue of fact was present regarding the ownership of the telecasts and the individual performances embodied therein. See *id.* at 671-72. The court thought as much, finding in favor of the MLBPA. See *id.* at 682.
b. Cable Extends the Field

Cable television provides access to a wide variety of sports telecasts. While cable television is nearly as old as commercial television, programmers have only recently realized its value in the sports arena. This newfound exploitation has expanded the range of problems beyond those normally involved under standard broadcast copyright issues.

In some instances, disputes arise due to cable's ability to transform traditional television stations into superstations. The National Basketball Association (NBA) has recently been involved in an ongoing controversy in this regard. In Chicago Professional Sports, Ltd. v. National Basketball Ass'n, the owners of the Chicago Bulls and WGN, the team's cable broadcaster, sued the NBA. The Chicago Professional Sports court found the league unlawfully suppressed competition. The court said that the league could not restrict

165. For a general discussion of cable television, see Barry D. Weiss, Barbed Wires and Branding in Cyberspace: The Future of Copyright Protection, 450 Pli/Pat 397, 409 (1996) (proposal for cable television and motion pictures would allow copyright holders to prevent copying of certain types of programming (e.g., pay-per-view or pre-recorded media), while preserving consumers' rights to make home recordings of broadcast or basic cable shows, as well as one copy of pay cable programming). See also David H. Horowitz and Peter J. Davey, Financing American Films at Home and Abroad, 20 Colum.-Vla J.L. & Arts 461 (1996) (increasing film production and marketing costs intensified vertical integration in entertainment industry; major studios now control television networks, cable systems, basic and pay cable networks, home video chains and theaters); Darryl C. Wilson, The Pay Cable TV-Sports Broadcasting Nexus, 8 Comm. Law 43 (1986); M.A.M. Phillips, CATV: A History of Community Antenna Television (1972).

166. For a discussion of superstations' evolution and the Federal Communications Commission, see, Garrett and Hochberg, supra note 150, at 18-19.


168. See id. at 1338. The NBA later sought a decision on the question of whether it was permissible for them to impose a superstation fee or tax on the transmission of Bulls' games by WGN. See Chicago Prof'l Sports Ltd. Partnership v. National Basketball Ass'n, 874 F. Supp. 844 (N.D. Ill. 1995). Although the case was principally brought under the Sherman Act due to antitrust issues, the court also had cause to discuss some interesting cable-related copyright matters. See id. For a hybrid analysis of antitrust and cable television, see Stephen F. Ross, An Antitrust Analysis of Sports League Contracts with Cable Networks, 39 Emory L.J. 463 (1990) (fans without access to cable are now deprived of opportunity to see games, which they previously could view at no charge; antitrust laws offer protection to consumers from efforts to exploit new technologies of pay and cable television).

169. See Chicago Prof'l Sports Ltd. 754 F. Supp. at 1336. In reaching its decision, the court suggested that the copyright provisions involved in the case could stand some modernization to help prevent similar problems from arising in the future. See id. at 1342-43. The league's ability to control the transmission rights of the games ensured the continued financial resurgence that was being enjoyed at that particular time. See id. at 1342. Furthermore, the superstation was thought particularly dangerous because sports clubs had no control over cable's distribution of games. See id. at 1342-43.
the number of games a team could broadcast nationally through its cable operator.170

While Chicago Professional Sports and the compulsory licensing provisions contained therein centered on cable television, this case alluded to problems created by satellite transmissions.171 Satellite dishes give the sports fan even greater access to athletic events, far beyond those accessible by normal broadcast television, cablevision and pay access television.172 Thus far, the satellite transmitters have

170. See id. The court’s discussion of cable and copyright primarily involved the compulsory licensing provisions of the Copyright Act. See id. (citing 17 U.S.C. § 111 (1995)). The problem of determining the scope of liability for cable television has been the subject of Congressional debate for more than thirty years. There have been constant amendments in response to the interests presented by various parties and a recent rewording of the Communications Act of 1934 incorporates much of the concerns raised by cable and other new broadcast technologies. Many of the recent changes and the legal ramifications following therefrom are analyzed in the symposium discussion of Volume 13 of the 1994 CARDOZO ARTS & ENT. L.J. The compulsory licensing scheme actually gave birth to the superstation as it provided for secondary transmissions of original telecasts without liability to the principal channel as long as certain royalty payments were made. The first cable superstation arose in 1976, when the FCC authorized the distribution of Ted Turner’s television station WTBS broadcast via satellite to cable operators throughout the country. See In Re Southern Satellite Systems, Inc, 62 F.C.C.2d 153 (1976). Other cable stations, including WGN and WWOR originated from Chicago and New York. See Jason S. Oletsky, Note, The Superstation Controversy: Has the NBA Slam Dunked the Superstations? 11 U. MIAMI ENT. & SPORTS L. REV. 173, 176 (1993). Collectively, these stations present more than 600 sports telecasts each season. See id. The compulsory license allows cable systems to retransmit conventional broadcasts from other area stations without first securing consent to do so as long as certain royalty payments are made. See id.

Furthermore, sports clubs have often disputed whether they were receiving adequate payment. See National Ass’n of Broadcasters v. Copyright Royalty Tribunal, 675 F.2d 367 (D.C. App. 1982) (Tribunal’s award of 3.5 percent of fees to commercial broadcasters was reasonable, and decision to give a group including professional sports leagues 12 percent of fund was supported by substantial evidence); Christian Broad. Network, Inc. v. Copyright Royalty Tribunal, 720 F.2d 1239, 1245 (D.C. App. 1983). The league also regulated the rights involving who could actually transmit these games. See Chicago Profl Sports, 754 F. Supp. at 1364. 171. See Chicago Profl Sports, 754 F. Supp. at 1346. Indeed the superstations involve the transmission of signals via satellite. See id. A popular device for securing more programming is the home satellite dish. See id.

172. The vast majority of sports broadcasts are broadcast and received by some form of satellite. See GARRETT AND HOCHBERG, supra note 150, § 18.04[3], at 23. This increased access has meant more trouble for certain sports entities, especially those with an interest in asserting the broadest range of control over the broadcast of their games. See id. at 23-29.

The sport with the most extensive set of rules is football, which, as you might expect, is also the sport that has been involved in a series of cases with sports-centered emporiums. See National Football League v. Alley, Inc., 624 F. Supp. 6 (S.D. Fla. 1985) (interceptions of transmissions on “C band” frequencies violated Communications Act of 1934); National Football League v. McBee & Bruno’s Inc., 792 F.2d 726 (8th Cir. 1986), aff’d in part, rev’d in part, 621 F. Supp. 880 (E.D. Mo. 1985) (finding that satellite dish antennae, by means of which restaurant owners picked up signals for “blacked out” football games, were not “commonly found in
been successful in maintaining their autonomy, but with the greater proliferation of satellite receivers among the populace and recent changes in the Communications Act, these victories may be short lived. This would once again empower entities including the National Football League, who desires control of their signal transmissions.173

c. Identify Is the Key — That Trademark Swing

Every professional athlete desires endorsement contracts. Therefore, trademarks and unfair competition, generally looked upon as having a synchronistic relationship, are subject to the greatest amount of litigation in the sports context. Unfair competition has been characterized by the courts as "fair play."174

private homes" within meaning of home-use exception of Copyright Act). For a discussion of several NFL cases that are not officially reported as well as the issues surrounding the copyright ramifications, see Pickin Up Blacked-Out Sports Events Via Satellite Dish Antenna: First Down and Goal to Go, COLUM. VLA J.L. & ARTS VOL. 11, No. 2 (1987); See also Alan M. Fisch, Compulsory Licensing of Blacked-Out Professional Team Sporting Event Telecasts (PTSETS): Using Copyright Law to Mitigate Monopolistic Behavior, 32 HARV. J. ON LEGIS. 403 (1995) (compulsory license for blacked-out telecasts should be considered as means of mitigating monopolistic behavior of professional sports leagues).


174. See Water Gremlin Co. v. Ideal Fishing Float Co., 401 F. Supp. 809 (D.C. Minn. 1975) (plaintiff's trademark 'Rubbercor' was not infringed by defendant's use of words 'rubber center' to identify its fishing line sinkers). Many courts have used similar "game" related language to give some meaning to the nebulous concept. For further discussion of trademarks and unfair competition, see J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (3d ed. 1992); See also RESTATEMENT (THIRD) OF UNFAIR COMPETITION (1988-1993). The law focuses on whether individuals are dealing honestly in their commercial relations and makes parties liable for behavior such as deceptive marketing, appropriation of trade values and other activities that may not fall squarely within traditional trademark law. See id. Past characterizations of these activities sounded in commercial tort and were addressed by various provisions of the RESTATEMENT (SECOND) OF TORTS, such as § 768, which prohibits interference with contractual relationships. See id. The RESTATEMENT OF UNFAIR COMPETITION has replaced many of the prior tort sections, but some remain viable. See id. In addition, the RESTATEMENT OF UNFAIR COMPETITION recognizes that it is limited by the preemptive scope of federal laws. See id. It remains, however, instructive in a number of areas which lack consistency of treatment where state regulation is permitted. See id.
I. Calling Names

It is said that a picture is worth a thousand words, and the name accompanying the picture cannot be far behind in value.\(^{175}\) For the various major sporting entities, the value of the name and its associated imagery is measured in the billions of dollars attributable to the sale of merchandise emblazoned with the team or player's moniker, nickname or insignia.\(^{176}\)

Often, a team or city will attempt to use another city or team's logo. This action of unfair competition is commonly called false advertising, palming off, deceit or misappropriation.\(^{177}\) Many common law protections remain viable today, which is important because not all teams have the means or desire to obtain a federally


There are literally thousands of teams that share names across the country. \text{See Ted Curtis and Joel H. Stempler, So What Do We Name the Team? Trademark Infringement, the Lanham Act and Sports Franchises, 19 COLUM.-VLA J.L. & ARTS 23, 44 n.23 (1994-95). College teams using the nickname "Wildcats" include the University of Arizona, Kansas State University, the University of Kentucky, Northwestern University and Villanova University. See id. "Tigers" is used by Auburn University, Clemson University, the University of Memphis, the University of Missouri, the University of the Pacific and Princeton University, among many others. See id. (citing THE SPORTS ILLUSTRATED 1994 SPORTS ALMANAC 738-50 (1994). See also University of Georgia Athletic Ass'n. v. Laite, 756 F.2d 1535 (11th Cir. 1985) (disallowed fact that cans contained a disclaimer disassociating beer from University of Georgia as remedy to illegal confusion). One only need consider the little leagues, local high schools and colleges in addition to the professional sports clubs to realize how many teams share remarkably few names.}

Interestingly, even phrases have been shared. The popular phrase "Lions, tigers and bears, oh my," while popularized as a line from the classic movie, \text{The Wizard of Oz}, could likewise serve as an exclamation by a neophyte's exposure to popular sports in America. Animals are the most popular designations for teams of all types, followed closely by names which may have a relationship to the city. Lions and Tigers are the names of the professional football and baseball clubs in Detroit, Michigan. \text{See John Burns, The Arizona Diamondbacks Win a Trademark Dispute, SPORTS LAW, Sept./Oct. 1996, at 6.}

\(^{176}\). \text{See Ozanian, supra note 134. See also Mark Albright, What's In A Name? Cold Hard Cash, ST. PETERSBURG TIMES, Sept. 18, 1994, at H1 (collegiate licensing of marks is multi-billion dollar business, with top schools earning in excess of $2 million annually from royalties).}

\(^{177}\). \text{See RESTATEMENT (THIRD) OF UNFAIR COMPETITION TENTATIVE DRAFT NO. 4 (1993) CHAPTER 4 APPROPRIATION OF TRADE VALUES.}
registered trademark.\textsuperscript{178} While there are numerous examples of sports cases that have used the common law of unfair competition, plaintiff teams and cities often base their claims on existing statutes.

a. The Statue of Liberty Formation

The body of law concerning unfair competition has periodically experienced growth resulting in a shrinkage of its apparent coverage.\textsuperscript{179} Various federal and state laws have been passed to clarify the scope of several common law doctrines. When the circumstances outlined by the statutes are not present, however, plaintiffs are often left without remedies they may have enjoyed prior to the statutes' passing. Congress adopted the Federal Trade Commission Act (FTCA) to establish a comprehensive regulatory scheme for advertising.\textsuperscript{180} Since the FTCA made no provision for state

\textsuperscript{178} See generally 15 U.S.C.A. §§ 1051-1127 (West 1995). To obtain a federally registered trademark you must complete an application and send it along with certain specimens to the Trademark Office of the United States. See id. You must designate which class you are seeking to have a mark registered in and the cost of filing for federal registration is $245.00 per class. See id. This filing fee, however, does not assure that your application will be approved. See id. To increase the probability of approval it is wise to engage in a pre-filing search of the marks currently in use. See id.

The most efficient way of doing so is through the use of commercial search services which generally charge from $300-500 per mark searched. To the average citizen this sounds like a daunting process which is probably best handled by an attorney who may charge from $100-500 per hour. Even after the application is filed, the trademark examiner or other parties may object to the proposed mark. The attorney will then have to engage these parties in order to secure the results sought. After the mark is registered, you have to “police” the mark in order to assure that your rights are protected. This will entail the use of a commercial monitoring service which costs several hundred dollars annually. Finally, maintenance fees are due to the Trademark Office for continued protection over the lifetime of the mark’s usage.

Local teams seldom know what a trademark is, much less engage in an exhaustive search on the availability of names, colors and related indicia of unity. Even the most innocent use can fall prey to legal action. See Little League Baseball, Inc. v. Daytona Beach Little League, Inc., 193 U.S.P.Q. 611 (M.D. Fl. 1977) (Daytona Beach baseball association enjoined from use of term “little league baseball”).

\textsuperscript{179} See \textit{McCarthy}, supra note 174. Such a predicament directly can be traced to lawmakers’ varied responses to capitalism’s growth. See id. Communication is used here in a more literal sense as opposed to the technological references inherent in broadcasting and the copyright issues raised by the same as discussed elsewhere. See id. Trademarks and unfair competition unquestionably involve regulation of our free enterprise system. See id. Specifically the laws regulate how competitors can market their goods to consumers in hopes of maximizing their relative profit ratios at each other’s expense. See id.

forecement, separate laws commonly known as little FTC Acts were developed to augment the federal legislation. Additionally, each state established its own trademark laws and related legislation to provide a broad safety net. The Federal Trademark Act does not expressly preempt these state laws. Thus, while federal legislation is fairly straightforward, state and common law have proven most likely to be abused by sporting concerns.

2. **Image Is Everything**

   a. Blurring and Tarnishment

   If image is everything, then it will not do to have it tarnished or diluted. In an effort to protect their citizens from this potential

   Merger Analysis?, 90 Nw. U. L. Rev. 720, 733 (1996) (noting that section 5 of Act gave FTC authority to enforce ban against unfair competition); Danny Abir, Monopoly and Merger Regulation in South Korea and Japan: A Comparative Analysis, 13 INT’L TAX & BUS. L.AW. 143, 147 (1996) (Congress enacted FTC Act in 1914 to strengthen and clarify authority of government to proceed against business practices that pose threat to free competition).

   181. See, e.g., Deceptive and Unfair Trade Practices Act, FLA. REV. STAT. §§ 501.81 to 501.213 (1995). For a comparison of the differences between state and federal protection for deceptive practices, see A. Best, Controlling False Advertising: A Comparative Study of Public Regulation, Industry Self-Policing and Private Litigation, 20 GA. L. Rev. 1, 71-72 (1985) (arguing private enforcement cannot be expected to produce range of imaginative remedies equivalent to those obtained by FTC in its administrative litigation and consent settlement procedures). Uniform acts regulating deceptive trade practices and trade secrets also were developed to provide remedies for private citizens. See id. The Uniform Deceptive Trade Protection Act was promulgated by the National Conference of Commissioners on Uniform State Laws in 1964 and revised in 1966. See id. Twelve states presently adhere to one of the two versions of the Act. See id. Those states are Delaware, Illinois, Maine, Oklahoma, Colorado, Georgia, Hawaii, Minnesota, Nebraska, New Mexico, Ohio and Oregon. See id.

   The Federal Trademark Act also experienced a more expansive interpretation. See 15 U.S.C. § 1125(a) (1995). This provision of the Trademark Act was added to protect unregistered marks and designs. See id. The section is also reworsted to where one seeks to recover for false advertising against a competitor. See id. The falsity complained of may result from misleading claims, implied sponsorship or questionable characterization of the qualities of the complaining parties’ products. See National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651 (D. Wash. 1982) (stating that plaintiff Seattle Seahawks was granted injunction enjoining sportswear company from manufacturing or selling “Seattle Seahawk — Jim Zorn” NFL football jersey replicas because such jerseys had secondary meaning).

   182. Although this statement has known recent popularity as a slogan espoused by the famous tennis player Andre Agassi, it is actually regulated in the copyright office as an unpublished musical work. See Copyright Office Reg. No. PA1u1049024. The holder is Matt Iddings. See id.

   183. See Rosemary J. Coombe, Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue, 69 TEX. L. REV. 1853, 1867 (1991) (discussing extension of state trademark laws beyond concern for deception and confusion is questionable; incorporation of dilution rationale limits cultural re-
harm, states have responded with anti-dilution statutes. \(^{184}\) Anti-dilution statutes extend the coverage of normal trademark laws, despite the lack of competition between the original and the offender, by making actionable certain references to recognized goods. \(^{185}\)

For instance, in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, \(^{186}\) the plaintiffs asserted that their protected mark was infringed and diluted by the defendant’s advertisement and exhibition of the film “Debbie Does Dallas.” \(^{187}\) Although the defendant asserted that the public did not believe that the Dallas Cowboys football team or its cheerleaders produced the movie, the court found the statute was satisfied if it can be implied that the offending item was sponsored or approved by the plaintiffs. \(^{188}\) The

sources available for opposition arguments because cultural resources will be limited.)


\(^{185}\) See id. § 24.13(1)(b). An action lies even where there is clearly no likelihood that consumers would be confused by the goods. See id. The doctrine is directed at goods which do not directly compete with each other. See id. In fact whether competing goods can take advantage of the doctrine is highly debatable. See id.

\(^{186}\) 604 F.2d 200 (2d Cir. 1979).

\(^{187}\) See id. at 202.

\(^{188}\) See id. at 204-05. The court did not differentiate between the trademark confusion test and the dilution reputation test. See id. The court did not differentiate between the trademark confusion and the dilution reputation test. See id. The court held that a combination of white boots, white shorts, blue blouse and white star-studded vest and belt worn by plaintiff's cheerleading group was worthy of a trademark and a likelihood of confusion was sufficiently established to entitle plaintiff's cheerleading group to a preliminary injunction prohibiting defendants from distributing or exhibiting “Debbie Does Dallas.” See id. See also DC Comics, Inc. v. Unlimited Monkey Business, Inc., 598 F. Supp. 110, 118-19 (N.D. Ga. 1984) (discussing how Monkey Business singing telegram company's use of “Super Stud"
fact that the plaintiff held no registered trademark in the items complained of did not fail to bar recovery.189

The Second Circuit's decision in Dallas Cowboys sets the stage for a concurrent reading of the federal unfair competition clause of the Lanham Act and various state laws, in a manner that substantially broadens the claims of entities with officially protected status.190 If the recognition is strong enough, a team can now simply argue that a new product's advertising may be bad for the team's image and seek to enjoin the marketing of the new product, regardless of how remote the goods or services are from those of the plaintiff.

In Jaguar Cars, Ltd. v. National Football League,191 a car maker sought to enjoin one of the new expansion franchises in the National Football League (NFL), from using the name "Jacksonville Jaguars."192 The case was settled after the team agreed to change its mark to an enlarged jaguar head instead of a partially pouncing jaguar that the car company felt was too close to their own bounding feline logo. Jaguar Cars is illustrative of the blurring subgroup in dilution law.193 No general guidelines, however, have been created such as those available to test standard trademark claims.


189. See generally Restatement (Third) of Unfair Competition, supra note 175, at 25. A prior user, to prove a case of tarnishment, must demonstrate that the subsequent use is likely to undermine or damage the positive associations evolved by the mark. See id.

190. As goods become more unrelated, there is a shrinking zone of likelihood of confusion. This is one reason behind the class designation system of trademark law. When one applies for a mark, it is not intended to cover all potential products, but instead the applicant chooses from one or more of the areas that have been distinguished by the trademark office over time.

Theories such as dilution take advantage of the original zone of protection as well as expand the zone to sections running far beyond the class(es) designated by the original applicant. An applicant gets to save the dollars on searching other classes as well as the per class payment fee but yet may enjoin the activities of others seeking to enter the market whether they are competitors or not.


192. See id. The plaintiff alleged a Lanham Act infringement by the defendant, Jacksonville Jaguars, Inc., for the team's use of the name Jaguar. See id.

193. See generally Frank I. Schechter, The Rational Basis of Trademark Protection, 40 Harv. L. Rev. 815 (1927). Schechter advocates protection against the "gradual whittling away of a famous mark." Id. at 825. The doctrine was established for the purpose of extending the traditional scope of trademark law. See id. at 819-22. Instead of focusing on any alleged denigration that might exist by virtue of recall or proximity, the claimant asserts that the mere presence of the offending new mark will cloud the public's recollection of the senior mark's eminence. It is not always clear where the line exists between blurring and tarnishment. See id. at 829-
Indeed, the likelihood of confusion standard has been rejected as a hindrance to assuring that the coverage intended by the dilution laws is extensive enough.\(^{194}\) Broad unspecifically defined limitations on words, marks and similar subjects naturally heighten the risks of conflicting with constitutionally guaranteed principles of free speech.\(^{195}\) A consistent response to the constitutional issue has yet to evolve; however, there are numerous hurdles that have been erected to try to block litigants before they reach this point. 

*Dallas* and *Jaguar* highlight the ineffectiveness of the blocking scheme even though the posture of the respective cases is opposite. The normal inquiry in instances involving dilution is an analysis of the strength of the plaintiff’s trademark. If the mark is not very distinct, there can be no dilution. Thus, many claims are dismissed after this initial investigation. The nature of sport in society reduces that line of inquiry to perfunctory at best, since it is taken as a given that, by virtue of the mark’s use in professional sports, society is at least aware of the mark.\(^{196}\)

\(^{30}\) Even more troubling is the lack of clarity regarding the boundaries of dilution as a whole. See *id.* at 826-29.

\(^{194}\) See *Lesportsac, Inc. v. K Mart Corp.*, 617 F. Supp. 316 (E.D.N.Y. 1985) (holding that trademark holder is not required to give advance notice of its rights to alleged infringer prior to seeking damages for injunctive relief for infringement). The *Lesportsac* court acknowledged the separateness of the dilution and confusion doctrines and said that K Mart labeling “di paris sac” in similar style and placement as plaintiff’s name LeSportsac does not avoid confusion between similar luggage patterns. See *id.* at 318. The new federal dilution statute picks up on the suggestions of several past cases and risk factors similar to those used in likelihood of confusion determinations. See *id.* For further discussion of dilution, see notes 183-197 and accompanying text.


\(^{196}\) See generally Richard Hoffer, *Cowboys For Sale*, *Sports Illustrated*, Sept. 18, 1995. In professional football, the Dallas Cowboys are the number one merchandising team in the league. See *id.* at 66. Team owner Jerry Jones has tried to take advantage of the team’s reinvigorated popularity by making several deals on behalf of his team without the permission of his partners, the other 29 NFL owners. See *id.* See also NFL Properties, Inc. v. Dallas Cowboys Football Club, Ltd., 922 F. Supp. 849, 851 (S.D.N.Y 1996) (finding that plaintiff’s allegations were sufficient to state claim for tortious interference with contract).
b. The Right of Publicity

Another area of trademark-related law in which sports take center stage involves the right of publicity.197 While not as old as the dilution theory, it shares dilution's goal of providing protection beyond that accorded by conventional trademark coverage.198 The term “right of publicity” arose from a 1953 New York sports case, Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.199 In Haelan, rival chewing gum manufacturers fought over the right to use photographs of leading baseball players on cards which were packaged with the gum.200

Prior to Haelan, courts analyzed disputes of this type under traditional concepts of privacy. The Haelan court, however, coined the phrase “right of publicity” as being far more descriptive of the matter at issue.201 The Haelan court had substantial precedent directly on point both statutorily and at common law to support its finding under principles of unfair competition.202 Yet the court


198. See McCarthy, supra note 174 §§ 24.13(1)(b) - 24.14(2). McCarthy argues against likening the right of publicity to anything else in existence, including the right of privacy. See id. The continued mixing of the publicity rights analysis with other more established rights may, however, indicate a lack of a truly cognizable distinction by the right itself. See id.

199. 202 F.2d 866 (2d Cir. 1953).


201. See Haelan Laboratories, 202 F.2d at 868. The court believed that failure to recognize and recompense the right to publicity could lead to unnecessary monetary deprivation for these individuals. See id. This exploitation can be seen in many of the sports cases that followed which did not involve issues of advertisement or endorsement, but instead extended to situations where the public might recall some attribute or characterization of an individual from the past.

202. Id. at 868-69.
took an activist role in identifying a new right due to the sporting nature of the suit. 203

IV. UPON FURTHER REVIEW, NO FACE GUARDING

Dedicated sports fans know that, in many sports, guarding or blocking an opponent's face is illegal. The offender is penalized for going beyond the rules of the game. 204 Within intellectual property, guarding the face by inventive means and other expressive channels is well within the traditional scope of the law. When, however, the normal boundaries of the law are stretched for athletes and other celebrities, the law should also cry foul.

To understand the few advantages and many disadvantages associated with the development of dilution and publicity rights, one must first realize that the variegated pattern of laws for both these subjects has been uniformly criticized. 205 The perpetual critiques have led to a variety of responses suggesting federalization or some like standardized approach as the key to complete acceptability of these laws.

A. Proposals for Standardization

1. Dilution

On January 16, 1996, the latest version of the Federal Trademark Dilution Act (FTDA) was signed into law. 206 This version,
which does not differ greatly from similar proposals dating back almost a decade, amends the present trademark law.\textsuperscript{207} Thus, the Trademark Office or courts making findings regarding trademark infringement are bound by the traditional standard of likelihood of confusion, but may also use the dilution statute as a federally-oriented basis for trademark actions.

Those who oppose the federal measure generally agree that it simply attempts to codify, without clarification, the indefiniteness associated with common concepts of fame and distinction.\textsuperscript{208} Due to the synergetic workings of the law of trademarks and unfair competition, opponents assert that knowingly going beyond the customs of the former implies an endorsement for ignoring the limitations of the latter. One engages in unfair competition by providing a method for enjoining other competitors attempting to enter the market on the basis of the expanded view of trademark protection. It follows that a wholesale embrace of these circumstances can have a deleterious effect on society since the principles of competitive fairness are the underpinnings of our free enterprise economy. This subtle restraint on prospective competitors moves instead toward an oligopoly of the powerful. As other goods are prevented from entry, the few established companies can then fill the void with products of their own.

Supporters feel that the concerns of the opposition have been adequately addressed by the adoption of a factor approach to potential violation that somewhat mimics the accepted formula for determining conventional trademark issues.\textsuperscript{209} Traditional protections center on the concept of whether the public is likely to be confused by the alleged offender. Since normal trademark disputes are largely resolved on an ad-hoc basis, supporters believe it will be no stretch to ask a factfinder to go one step further in its analysis to make the dilution decision.


\textsuperscript{208} See generally Milton W. Handler, \textit{Are the State Antidilution Laws Compatible with the National Protection of Trademarks?}, 75 Trademark Rep. 269 (1985).

Almost all cases have linked a prayer for relief on dilution with the more standard claims of infringement. This has certainly been true in sports. For instance, in *Augusta National, Inc. v. Northwest Mutual Life Insurance Co.*, the plaintiffs were able to prevent the defendants from establishing an outing known as the “Ladies Masters at Moss Green Plantation” on the basis of likelihood of confusion and a loss in value and distinctiveness of the championship. The court awarded permanent injunctive relief pursuant to the Federal Trademark Act and the state anti-dilution statute.

In sports cases, as previously noted, it is easy for the complainant to dodge the dilution inquiry on the distinctiveness of the mark. It is as if there is judicial notice that sport marks are inherently strong. Sport marks’ ability to race between dilution and Lanham Act standards seeking the most favorable remedy, is not cause for alarm since the remedies are consolidated. There is, however, nothing to prevent a party from seeking the remedies of the trademark statute and additional remedies under a more beneficial dilution statute.

While sports cases may not be the best indication of determining whether states should standardize dilution laws, they deserve attention. Sports leagues constantly face claims of illegal monopolies and when laws are automatically construed in favor of teams or athletes, it is a situation that calls for the investigation of potential reforms.


211. *Id.* (stating use of “Masters” by accused infringer is likely to cause confusion among millions of people world-wide by leading them to believe that accused infringer’s tournament and real estate development are sponsored by or are affiliated with owner of “Masters Tournament”).

212. *See id.* at 222.

213. *See Jaguar Cars, Ltd. v. National Football League, 886 F. Supp. 335* (S.D.N.Y. 1995). The Jacksonville Jaguars filed a competing suit in Florida seeking a ruling under the state’s dilution statute. *See id.* at 337. The team undoubtedly felt that the local judges would be willing to view the case more favorably for them in essence looking for a home court advantage. *See id.*

214. 1995 was an “ugly” year for sports in America, with professional baseball, basketball and hockey all involved in labor disputes. *See Laura Mirabito, Picking Players in the College Draft Could Be Picking Trouble with Antitrust Law, 36 SANTA CLARA L. REV. 823* (1996) (discussing how on August 12, 1994, Major League Baseball (MLB) players went on strike; National Hockey League (NHL) instituted lock-out on September 30, 1994; NBA locked out its players from summer of 1995 until September 18, 1995). *See also Shawn Treadwell, An Examination of the Nonstatutory Labor Exemption from the Antitrust Laws, in the Context of Professional Sports, 23 FORDHAM URB. L.J. 955, 961* (1996) (stating professional sports teams within same league are not economic competitors; this interdependence necessitates joint labor provisions among teams that would be unacceptable restraint on trade in other industries).
2. **The Right of Publicity**

A Model Right of Privacy and Publicity Statute (Model Act) has recently been drafted to serve as an example for state statutory reform.\(^{215}\) This reform can take the form of amendments to current acts or could be adopted in conjunction with a scheme involving the Commission on Uniform State Laws.

The Model Act draws heavily on a combination of different state laws, as well as the mix of the formal areas of trademark and copyright law. The states chosen as primary resources for the model were California and New York which are recognized as the entertainment centers of the United States.\(^{216}\) One of the shared characteristics of both jurisdictions is that the impetus for development of the right was the result of cases involving sports figures.\(^{217}\)

For instance, in *Ali v. Playgirl, Inc.*,\(^{218}\) professional boxer Muhammad Ali was successful in an action against Playgirl, despite there being no showing of his face or any other recognizable body parts.\(^{219}\) An image of a nude African-American man in a boxing ring corner, captioned “the Greatest” and alternatively “Mystery Man” gave rise to a finding of liability due to the plaintiff’s fame and the media’s regular reference to him as “the Greatest.”\(^{220}\) Alternatively, a half-time performer during a televised football game, was denied the remedy he sought for commercialization of his routine on the grounds that he was part of the whole football spectacle which was public in nature and entitled to be broadcast.\(^{221}\)

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\(^{216}\) See McCarthy, supra note 174, at 6-65. One might believe that these two states had quite a developed body of jurisprudence in the publicity area and that there would be great similarities between them. The contrary, however, is true. See id. The two states have been very cautious in their acknowledgment of the publicity right. See id.

\(^{217}\) See id. at 6-65. Of the states that are known to recognize the right, many have saved their most supportive opinions for sports cases. This would not be so appalling, but for the fact that normal citizens in often analogous situations have had their claims rejected. See generally McCarthy, supra note 174, at 6-65.


\(^{219}\) See id. at 723 (enforcing preliminary injunction restraining publisher from publishing likeness of boxer would extend to restrain publisher’s magazines containing disputed portrait in England as well as New York). See also Carson v. Here’s Johnny Portable Toilets, 698 F.2d 831 (6th Cir. 1983) (stating “Here’s Johnny” portable toilets is not a trademark infringement, but violate’s former late night entertainer’s right to publicity).

\(^{220}\) See Ali, 447 F. Supp. at 723.

\(^{221}\) See Gautier v. Pro-Football, Inc., 107 N.E.2d 485 (N.Y. App. 1952) (holding that while public figure may be proper subject of news or informative presenta-
wise, another fully recognizable individual pictured at a Pittsburgh Steelers football game was denied recovery in an action against SPORTS ILLUSTRATED when the magazine did an article on fans. Yet a shadow of a car with a silhouetted individual gave rise to a successful claim against a tobacco company by a racing car driver.

Courts are more comfortable with protecting less ephemeral imagery and look to established privacy principles to do so; hence the suggested combination of privacy and publicity in the Model Act. A visual overview of the features of the new act compared with the laws of some equally viable states highlight some of the more important aspects at issue. Especially relevant to sports are the provisions for “face in the crowd” exceptions and the First Amendment considerations. The former provision seeks to prevent an opening of the proverbial floodgates by restricting suit when crowd shots are taken without any focus on a particular individual. The latter prevents actions of the right for publicity in the face of particularly newsworthy events. Thus, sports broadcasts or similar written commentary will almost always fall within the provision, making it, theoretically at least, more difficult for the athlete being pictured or broadcast for noncommercial purposes to file suit. Likewise, individuals singled out during photos of team activities are most likely to be deemed a face in the crowd and therefore are without standing to proceed on a “model” cause of action.

See also Amiel B. Weisfogel, Fine Art’s Uncertain Protection: The New York Right of Privacy Statute and the First Amendment, 20 COLUM.-VLA J.L. & ARTS 91, 112 (1995) (noting newsworthy exemption to right of publicity was applied to Gautier, an animal trainer, who objected to televised broadcast of his halftime performance at professional football game).

See Neff v. Time, Inc., 406 F. Supp. 858 (W.D. Pa. 1976) (discussing photograph taken with plaintiff’s active encouragement and participation at football game with zipper of his trousers open who had knowledge that photographer was connected with publication). See id. at 858. See also George Vetter and Christopher C. Roche, The First Amendment and the Artist - Part II, 44-APR R.I. B.J. 9, 45 (1996) (noting courts have found disclosure of private facts not actionable where disclosure is related to matter of legitimate public concern, including photograph of spectator with zipper of his pants open).

See Motschenbacher v. R. J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) (stating that despite fact that likeness of driver was unrecognizable, number of racing car was changed from ‘11’ to ‘71,’ and spoiler was added to racing car defendant still violated plaintiff’s right to publicity). See also Goodenough, supra note 201, at 756 (discussing distinctive colors, pinstriping and unusual oval shape encircling car’s number were sufficient to warrant relief because knowledgeable people would recognize Lothar Motschenbacher and presume rest).

See McCarthy supra note 174, at 1-5 (indicating how “publicity” rights evolved from “privacy” rights).

For further discussion of the Model Act, see infra Appendix A.
Whether the Model Act will ultimately be adopted as law in the same manner as the federal dilution rules is a question that can only be answered in time. Unless the implementation of the Model Act, or even the continued use of state acts, show marked improvement in remedying the losses of the common man, the opposition to these types of statutes is sure to remain. The Model Act has yet to be tested, but there is nothing in it that seems to explicitly assure that it will not also be a tool primarily available for the rich and famous, including athletes, since it is based on California and New York statutes.

B. Modification or Termination

With the passage of the Federal Trademark Dilution Act, a call for modification or termination of the existing dilution statutes throughout the country has been temporarily silenced. The new act seems to have taken “the worst of both worlds” to reach its final form. Critics of the state dilution statutes often find it problematic that key terms such as “distinctiveness” or “fame” were left undefined and unaddressed by policy. They will not be mollified by the language of the new act, as this void remains.

Even supporters felt that the suggested remedial limitation of injunctive relief was wholly inadequate, yet this is a key feature of the federal legislation.\footnote{See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996). New Act amends § 43 to become new subsection (c) which at (c)(1) states “the owner of a famous mark shall be entitled ... to an injunction.” \textit{Id.}} Some allowances are made for additional remedies if a party “willfully” dilutes the mark of another.\footnote{\textit{Id.} § 43(c)(2).} But how can one avoid willfully acting in an offensive manner when he or she has little or no direction on what behavior constitutes offensiveness? In the sports context, the aforementioned judicial recognition of the fame associated with athletes means that such a plaintiff will almost always be successful in attributing willfulness to the average defendant. A successful showing of willfulness grants a party damages normally reserved for standard findings of trademark infringement.\footnote{See \textit{id}.} As previously indicated, however, sports oriented cases have always run past barriers directly to this reservoir of broader remedies. If anyone is to be limited to injunctive relief, it is the common citizen. Thus, critics of the movement were prescient in their allegations that, at some level, supporters wanted to place dilution on par with normal standards of intellectual property pro-

\footnote{226. See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996). New Act amends § 43 to become new subsection (c) which at (c)(1) states “the owner of a famous mark shall be entitled ... to an injunction.” \textit{Id.}} 

\footnote{227. \textit{Id.} § 43(c)(2).} 

\footnote{228. See \textit{id}.}
tection, but without adequate protective measures for the closely related rights of freedom of speech and competition.229 The most glaring faux pas of the new legislation is its refusal to preempt the existing state laws. The only value of the act is to provide roughly half of the states in the country who were wary of dilution theory, as exhibited by their refusal to pass legislation in this area, with a federal option. Claimants in states with more developed jurisprudence, broader coverage and stiffer penalties, such as Illinois, Florida and Georgia, will continue to use the available state law. Parties who have the means will continue to engage in forum shopping and lobbyists can still entice a state to pass new legislation.

To have true consistency and useful application, the federal act must be modified to expressly preempt the state laws. Without taking this additional step, the next best resolution is complete termination of this area of jurisprudence. Almost every successful claimant has pleaded dilution as an alternative to standard principles of trademark law. It is highly probable that the courts only referred to dilution as an additional basis for reaching their results because the opportunity was there for them to do so. Dilution has become something of a plaything among courts choosing to use it. The fact that almost a century after dilution’s origins, it still has few judicial and statutory adherents, further buttresses a call for total eradication of the concept. Its availability for use only to protect those marks that are truly strong or distinctive smacks of the type of elitism that makes one question whether this law is truly in the spirit of equal justice for all.

The Model Right of Privacy and Publicity Statute is too new to silence the critics calling for modification or termination. The statute notwithstanding, there should be no recognition beyond that normally granted by the laws of privacy and unfair competition. The distinction between appropriation of trade values and appropriation of the commercial value of one’s persona is primarily semantical in nature and certainly only a matter of perspective or degree.230 The states that had recognized a personal right in one’s commercial identity had no trouble offering remedies to offended parties prior to the explicit recognition of this right.231 Further-

229. McCARTHY, supra note 174, at 8.20 (discussing the delicate balance between publicity, privacy, and the First Amendment).

230. See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION, TENTATIVE, DRAFT NO. 4 (March 25, 1993) (outlining appropriateness of trade values at § 38).

231. See supra note 247 (indicating state coverage under right of privacy in many jurisdictions).
more, after almost fifty years since its development, the right still finds itself on the outside of accepted mainstream jurisprudence. 232

The Model Act attempts to serve as a place of respite among the hodgepodge legal framework in which the right currently exists throughout the country. In ambitiously resorting to use of the more standard intellectual property areas when convenient, however, it begs the question as to why those areas cannot serve as an adequate source of recompense on their own.

For example, in *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 233 the court intersected the First Amendment, trademark and copyright laws with the right of publicity. 234 A manufacturer produced trading cards with cartoon caricatures of various baseball players. 235 The court overturned a lower court finding in favor of the athlete’s right of publicity. In reaching its ultimate decision for the card manufacturer, the court was forced to review the possibility of applying standard trademark and copyright analyses to the circumstances. 236

It is undeniable that celebrities like the superstar athlete have a recognizable commercial value while the rest of us carry a rebuttable presumption that such value is lacking. In *Hirsch v. S.C. Johnson & Son, Inc.*, 237 an ex-football player was able to stop a company from using his old “nickname” in reference to women’s leg cream. 238 Elroy “Crazy Legs” Hirsch, once a prominent football star, successfully pursued an action which focused on his popularity. 239 The court held that under the common law tradename-in-

232. *See supra* note 247 (indicating several states have yet to recognize publicity or even apply privacy law relative to alleged appropriation of an individual’s commercial identity. At this time only twenty-five states have recognized the publicity right in some form. California, Connecticut, Florida, Georgia, Hawaii, Illinois, Indiana, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania and Texas have fairly explicit statutes while one might read in the right in Kentucky, Massachusetts, Nebraska, Nevada, New York and Oklahoma. *See McCarthy, supra* note 174, at 6-6.


234. *Id.* at 1267 (recognizing parody exception the right of publicity, in light of First Amendment concerns).

235. *See id.* at 1267.

236. *See id.* at 1269-1272. While the finding ultimately rested on constitutional grounds, the court’s dictum can be viewed as an opportunity to remain within our traditional framework. *See id.*

237. 280 N.W. 2d 129 (Wis. 1979).

238. *Id.* at 131 (enjoining defendant’s use of “Crazy Legs” for shaving gel product where plaintiff, a famous football player, was nicknamed “Crazy Legs”).

239. *See id.* at 132. Interestingly while the court acknowledged *Haelan* and the “right of publicity,” the statute involved in *Hirsch* characterized the issue as a right of “privacy.” *See id.*
fringement theory, a jury must decide whether "Crazylegs" is indicative of plaintiff's occupation and whether there is a likelihood of confusion which would lead the public to think he sponsored the shaving gel.240

Like the Copyright Act, the Model Act provides a haven for innocent infringers, including those in the potential distribution chain of the offending item who might otherwise be viewed as contributory infringers. There is a race statute to resolve conflicts between numerous claimants to consensual uses of another's image, a fair use provision, attempts at resolving the First Amendment concerns in this area and a factor approach to damage determination.241 Yet many of these provisions still hold potential for circumvention by the famous, since their images are so heavily marketed. The Model Act has extended itself farther than most state laws in terms of protecting individuals from improper findings of liability.

At the very least, the mistake of not expressly preempting state law should be avoided if strong sentiment for standardization comes about. Another measure that should be taken is a strong presumption against the famous when it comes to damages. Unless the typical superstar athlete can show substantial or actual damages above a certain threshold, he or she should receive no monetary remedy. To the contrary, a presumption in "favor" of the average citizen should exist. Whenever some nonconsensual commercial use extends beyond the identifiable figures in a crowd setting, the citizen should be entitled to greater damages than the celebrity. These damages should include royalties, profits and attorney's fees.

VII. FUTURE PROSPECTS

Sport, law and society are irrevocably bound in a manner that requires us to earnestly study the ongoing interactions among them. Sport cannot be marginalized, but instead demands that it take its rightful place among the more time honored subjects in the academy. Sport gives us a different view of the traditional and is often the source for new, unusual treatments of ongoing issues in society. Such a departure from the ordinary can be found in the collusion of sport and intellectual property. Every traditional area

240. See id. at 140 (citing availability of common law trademark analysis).

241. The term race statute indicates that the right goes to the first party to win the race to the office of registration. Thus, if two parties have both received consent from an individual, the conflict will be resolved in favor of the first registrant even if that registrant was secondary in securing permission.
of intellectual property has a basis for application in the sporting arena. This has been the case from humanity's genesis. Thus, it behooves those wishing to seriously consider venturing into the nebulous world of "sports law" to acquaint themselves with these nexus of intellectual property and sport.

The connectivity of the subjects can be highlighted in terms of the literal and figurative attempts of athletes to save face. Face saving measures are mandatory for the athlete's physical safety, and inventions that speak to that need are necessarily covered by the concerns of patent law. Mass media help market the faces of athletes as does merchandising and the areas of copyright law and trademarks help maintain the proper balance of interests. When, however, the imagery of the celebrated athlete begins to command more protection than the average citizen's, unbridled progress along these legal lines should be immediately thrown for a loss. Although society freely admits that athletes are deserving of certain exceptional accolades due to their physical abilities being above the norm, we cannot extend this level of accommodation to the point that their images relative to those of the average citizen are treated as above the law.

This is life and all there is of life; to play the game, to play the cards we get; play them uncomplainingly and play them to the end. The game may not be worthwhile. The stakes may not be worth the winning. But the playing of the game is the forgetting of self, and we should be game sports and play it bravely to the end.242

## APPENDIX A

### COMPARATIVE STATUTORY CHART

<table>
<thead>
<tr>
<th></th>
<th>California</th>
<th>New York</th>
<th>Florida</th>
<th>Nevada</th>
<th>Model</th>
</tr>
</thead>
<tbody>
<tr>
<td>• Present Version Motivated by A Sports Case</td>
<td>Y</td>
<td>Y</td>
<td>N</td>
<td>N</td>
<td>N</td>
</tr>
<tr>
<td>• Cases Involving Athlete Being Protected Where Citizen Is Not</td>
<td>Y</td>
<td>Y</td>
<td>N</td>
<td>N</td>
<td>N</td>
</tr>
<tr>
<td>• Damages Awarded and Extent of Coverage</td>
<td>Statutory &amp; Punitive Damages &amp; Attorney fees $750 Damage Minimum</td>
<td>Injunction and punitive damages available</td>
<td>Injunction actual and punitive Damages and Reasonable Royalty</td>
<td>Injunction Stat. &amp; Punitive Dams. $750 minimum</td>
<td>Injunction and $750 damage minimum, atty. fees, profits, punitive damages, any available equitable remedies</td>
</tr>
<tr>
<td>• First Amendment Considerations</td>
<td>Y</td>
<td>Y</td>
<td>Y</td>
<td>Y</td>
<td>Y</td>
</tr>
</tbody>
</table>

243. Florida has been referred to as "Hollywood East" due to the state's association with certain big screen actors such as Burt Reynolds and Sylvester Stallone, popular television shows like Miami Vice and a number of movies. See, e.g., Roberta Klein, FLA MAG., July 1, 1994, at D3.

244. Nevada has a long history as an entertainment mecca and recognizes individuals' rights of publicity through findings under the common law theory of appropriation. See, e.g., People for Ethical Treatment of Animals v. Bobby Berosini, Ltd., 895 P.2d 1269 (Nev. 1995). The RESTATEMENT (THIRD) OF UNIFORM COMPETITION § 38(b) (1995), recognizes a cause of action where appropriation is tied to the commercial value of another's identity. Many states have yet to recognize an invasion of privacy tort relating to misappropriation of a person's name or likeness nor an explicit publicity right.

245. Ironically though the model mixes in copyright law, no seizure provisions are present such as those found in the federal trademark and copyright acts.
What's Name, Like-Name, Like-Name, Like-Name, Like-Name, Nick-
ness, Photos, ness, Photos ness, Photos, name, Signature,
Voice Voice, Monogram, Face, Any Aspect of
Physical Appearance.

246. This presumably encompasses silhouettes such as the flying Michael Jordan, or jump shooting Jerry West, the latter being one of the official insignias and registered trademarks of the National Basketball Association (NBA).

247. A recent review of the states in terms of privacy and publicity indicates that a significant number of the states have yet to face these issues. Of those who have developed jurisprudence, nearly fifty percent stem from cases involving athletes.

Alabama: Birmingham Broadcasting Co. v. Bell, 68 So. 2d 314 (Ala. 1953). The privacy of a public person may not be lawfully invaded by the use of his or her name or picture for commercial purposes without his or her consent, if such use is not incidental to an occurrence of legitimate news value and such rule applies to radio broadcasting.

Alaska: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person's name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Arkansas: Olan Mills, Inc. v. Dodd, 353 S.W.2d 22 (Ark. 1962). Photographer liable for using photo of plaintiff, on postcards mailed for advertising purposes and for enlargements used by door-to-door salesmen, without consent of plaintiff.

Arizona: Godbehere v. Phoenix Newspapers, Inc., 746 P.2d 1319 (Ariz. Ct. App. Div. I-B 1989). Plaintiff may recover for false light invasion of privacy even in the absence of a reputation damage, as long as the publicity is unreasonably offensive and attributes false characteristics, but the publication must involve a major misrepresentation of plaintiff's character, history, activities, or beliefs, and not merely minor or unimportant inaccuracies.

California: Motschenbacher v. R. J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974). Under California law, legal protection is afforded to an individual's proprietary interest in his own identity.

Colorado: Golf Shots, Inc. v. Time Warner, Inc., 1991 U.S. Dist. Lexis 19375. Colorado recognizes right of privacy as to the tort of misappropriation; however, such is preempted if rights asserted are equivalent to those granted by the federal Copyright Act.

Connecticut: Steding v. Battistoni, 208 A.2d 559 (Conn. Cir. Ct. 1964). Defendant's commencement of action in name of plaintiff, without plaintiff's consent, was actionable invasion of privacy where defendant appropriated use of plaintiff's name, personality and standing in his community.


Florida: O'Brien v. Pabst Sales Co., 124 F.2d 167 (5th Dist. Ct. App. 1941). The publication of football player's photograph on football calendar with picture of beer bottle and beer advertising did not violate player's "right of privacy" and did not indicate that player used or endorsed the beer.

Hawaii: Fergerstrom v. Hawaiian Ocean View Estates, 441 P.2d 141 (Haw. 1968). Defendant liable for appropriating plaintiffs’ name and personalities for advertising, without plaintiffs’ permission, regardless of whether plaintiffs were public or private figures.

Idaho: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Illinois: Smith v. WGN, Inc., 197 N.E.2d 482 (Ill. App. Ct. 1964). Defendant’s use of plaintiff’s pictures for advertising without plaintiff’s consent was invasion of right to privacy and plaintiff was entitled to recover more than nominal damages.

Indiana: Continental Optical Co. v. Reed, 86 N.E.2d 306 (Ind. App. 1949). Defendant’s unauthorized use of photo of likeness of plaintiff for commercial purposes was an invasion of plaintiff’s right of privacy.

Iowa: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Kansas: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Kentucky: only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Louisiana: Tooley v. Canal Motors, Inc., 296 So. 2d 453 (La. Ct. App. 1968). Radio broadcasting station invaded privacy of plaintiff when it continued to broadcast radio commercial mentioning used car salesman having same name as practicing attorney after receiving notice of similarity of names.

Maine: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Maryland: Lawrence v. A.S. Abell Co., 475 A.2d 448 (Md. 1984). The Maryland court recognized in dicta that there was a possible action in tort for misappropriation for commercial exploitation, but the facts of this case did not warrant such a finding.


Michigan: Pallas v. Crowley, Milner & Co., 33 N.W.2d 911 (Mich. 1948). A person may have a right of privacy in a photographic likeness, giving rise to an action for damages.

Minnesota: House v. Sports Films & Talents, Inc., 351 N.W.2d 684 (Minn. Ct. App. 1984). There is no action for invasion of privacy in Minnesota. Even if Minnesota adopted invasion of privacy as actionable tort, action for appropriation did not extend to protection of individuals who were not celebrities, because “celebrity’s property interest in his name and likeness is unique.”

Mississippi: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.
Missouri: Cepeda v. Swift & Co., 291 F. Supp. 242 (E.D. Mo. 1968), aff'd, 415 F.2d 1205 (8th Cir. 1969). In an action by professional baseball player against meat processor and sporting goods manufacturer for alleged unauthorized use of plaintiff’s name, photograph, reputation and signature for advertising purposes, plaintiff was required to give effect to licensing contract, between player and sporting goods manufacturer.

Montana: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Nebraska: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Nevada: People for Ethical Treatment of Animals v. Bobby Berosini, Ltd., 895 P.2d 1269 (Nev. 1995). Common law appropriation tort involves unwanted and unpermitted use of name or likeness of ordinary person for advertising or other commercial purposes.

New Hampshire: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

New Jersey: Palmer v. Schonhorn Enter., Inc., 232 A.2d 458 (N.J. Super. Ct. Ch. Div. 1967). Although publication of biographical data of a well-known figure does not constitute an invasion of privacy, the use of that same data for capitalizing on the name by using it in connection with a commercial project other than the dissemination of news or articles or biographies does constitute such an invasion.

New Mexico: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.


North Carolina: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.


Oklahoma: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person’s name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Oregon: Hinish v. Meier & Frank Co., 113 P.2d 438 (Or. 1941). Store maintaining an optical department had no legal right to appropriate the optical department's
manager without manager's name, personality and whatever influence he may have possessed.


Rhode Island: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person's name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

South Carolina: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person's name or likeness- only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

South Dakota: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person's name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.


Utah: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person's name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

Vermont: Staruski v. Continental Tele. Co., 581 A.2d 266 (Vt. 1990). Employee could recover for invasion of privacy, upon showing that employee suffered damages from employer's act of running ad without consent of plaintiff, displaying her name and photograph and text, falsely attributed to her, that praised employer.

Virginia: Town & Country Properties, Inc. v. Riggins, 457 S.E.2d 356 (Va. 1995). Real estate brokers used name of professional football star for advertising purposes, in violation of his statutory right to privacy, by producing and distributing 1,610 copies of real estate flyer to brokers in area, advertising house as one which was player's former home, distributing flyer and ordering printer to make player's name larger than surrounding words. These factors established that flyer had been designed to enhance probability of ultimate sale through use of plaintiff's name.

Washington: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person's name or likeness; only recognizes false light, libel/slander/defamation, and invasion of privacy and seclusion branches of the privacy tort.

West Virginia: Crump v. Beckley Newspapers, Inc., 320 S.E.2d 70 (W. Va. 1984). For invasion of privacy, publication of person's name or likeness is not enough. Defendant must take for his own use the value associated with the name or likeness published.

Wisconsin: Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129 (Wis. 1979). Right to be compensated for the use of one's name for advertising or other commercial purposes is distinct because it protects property interest in publicity value of one's name. Therefore a cause of action for appropriation of a person's name exists as matter of Wisconsin common law, despite prior decisions rejecting a common-law right of privacy.

Wyoming: has not yet recognized an invasion of privacy tort as it relates to misappropriation of a person's name or likeness; only recognizes false light, libel/slan-
der/defamation, and invasion of privacy and seclusion branches of the privacy tort.