



REGIMES OF PROTECTION

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NYIPLA CLE: WHEN WORLDS COLLIDE
NEW YORK, NEW YORK

How Do Brand Owners Protect Characters, Events And Objects?

Copyright

Trademark

Right of Publicity/Privacy

Copyrightable



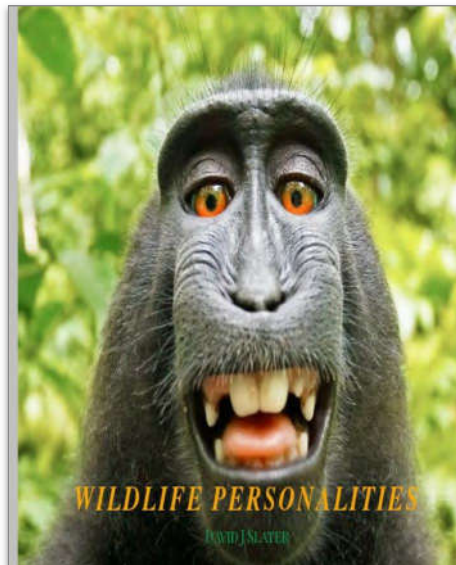
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Cute, But Not Copyrightable



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Is 2 Milly Too Silly? (or, Can You Copyright A Dance Move?)



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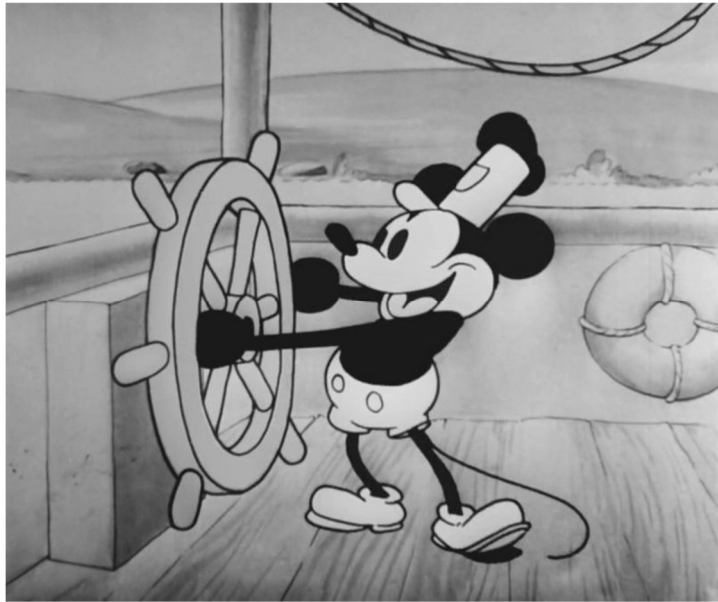
The "Carlton Dance" – Is There A Chance?



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This Mickey Is In The Public Domain



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This Mickey Is Not



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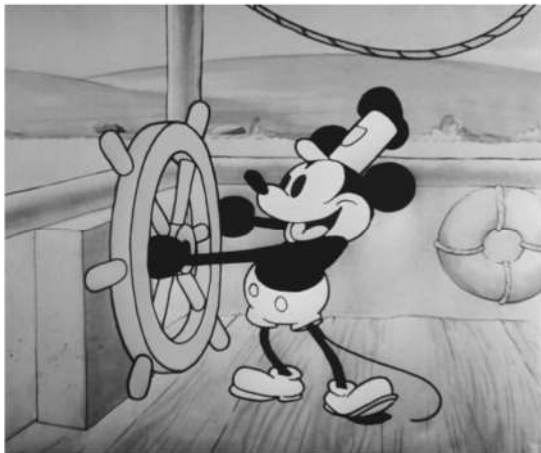
The Original Batman Will Also Soon Be In The Public Domain



Dastar Corp. v. Twentieth Century Fox Film Corp. (Sup. Ct. 2003)

- Does the Lanham Act prevent the unaccredited copying of an uncopyrighted work?
- Television series based on Dwight Eisenhower's WWII memoir; copyright in the TV series (owned by Fox) expired in 1977 and was not renewed (but the book remained under copyright); the TV series used footage from a variety of sources.
- Dastar released a video set including an edited version of the original TV series in 1995; among other things, it removed the original Fox credits and references to the book in the credits; and it copied substantial portions of the TV series verbatim.
- "Allowing a cause of action under Section 43(a) for [a misrepresentation of origin of an uncopyrighted creative work] would create a species of mutant copyright law that limits the public's federal right to copy and to use expired copyrights."
- Without a showing of secondary meaning that a product identifies the "source of the product rather than the product itself," a claim concerning "false origins" under the Lanham Act would be limitless. But a claim that the junior user misrepresented the "nature, characteristics or qualities" of the junior work is still available.

What If The Junior User Says “This Product Is Not Affiliated With . . .”



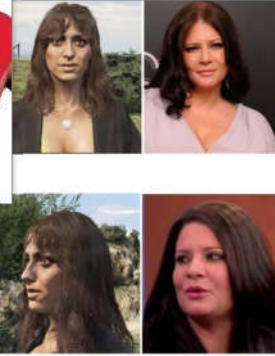
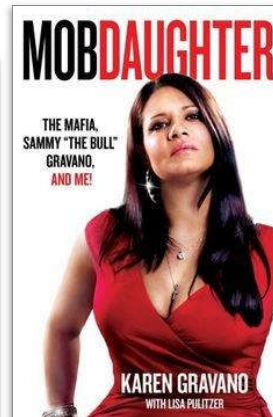
What Does The Right Of Publicity Protect?

- Economic value of creativity and efforts
- Protects against appropriation of that value where defendant trades on a celebrity's image for commercial use
- First Amendment defense where, even if unauthorized, use of another's identity is in public interest
- What about art?



EXHIBIT A

Grand Theft Auto: Theft or Free Speech?



The Transformative Use Doctrine

- Borrowed from Copyright "fair use" test

Supreme Court in *Campbell*

whether the new work "adds something new, with a further purpose or different character, *altering the first with new expression, meaning, or message.*"

Second Circuit in *Google Books*

where the new form of the existing work "communicates something new" or "expands its utility."

Providing a new way of accessing works or "information about" them is transformative; no alteration of the work necessary; no new expression, meaning or message required.

Transformative Use In Publicity Cases

- Difficulty in application
- Does it really fit?
- Some of the criteria courts look at:
 - Parody (but not “just a spoof”)
 - Distortions of the celebrity’s body, face and other elements
 - Addition of expressive content beyond the plaintiffs’ mere likeness; “fanciful”
 - Non-literalness
- Where is my case in the continuum?

Contrasting Cases

- Hurt Locker (*Sarver v. Chartier*): film protected by First Amendment because it dealt with issues of a public nature (Iraq War); private aspects are intertwined with narrative.
- Madden NFL/NCAA cases against Electronic Arts (*Davis; Keller; Hart; O'Bannon*): literal recreations of players’ physical characteristics in video game (Same jersey numbers, height, weight, biographical information, and performance characteristics). Purely for commercial purposes, so not protected by the First Amendment
- Art cases from NY State Courts – long line of confusing and conflicting cases

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After six NBA championships, scores of rewritten record books and numerous buzzer beaters, Michael Jordan's elevation to the Basketball Hall of Fame was never in doubt! Jewel-Osco salutes #23 on his many accomplishments as we honor a fellow Chicagoan who was "just around the corner" for so many years.

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Special Savings on just about everything!

Congratulations,
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Dominick's

Advertising vs. Art?



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Protecting Fictional Trademarks in the Real World

Can specific elements from television shows or movies—as opposed to the title of the show or movie itself—receive trademark protection?

Viacom Media Networks

The Battle For THE KRUSTY KRAB

Viacom International Inc. v. IJR Capital Investments, L.L.C., 891 F.3d 178 (5th Cir. 2018)



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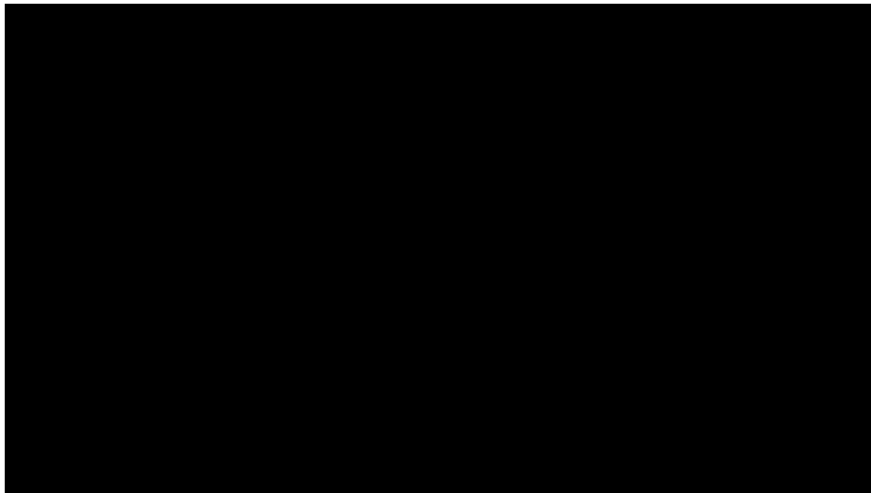
History of THE KRUSTY KRAB

1999: SPONGEBOB SQUAREPANTS premiered on Nickelodeon and introduced viewers to THE KRUSTY KRAB



Viacom Media Networks

History of THE KRUSTY KRAB



Viacom Media Networks

2014: IJR filed ITU application for “restaurant services”

Key Question: Whether THE KRUSTY KRAB will be recognized in itself as a source indicator

Subject Matter Jurisdiction:

- Even though IJR’s application was based on ITU, there was an actual case or controversy because IJR had taken steps to begin using the mark
 - Developed a business plan
 - Designed a logo
 - Leased space in California
 - Procured restaurant equipment



Viacom Media Networks

When an element plays a more central role in a franchise, trademark protection is ordinarily granted

S.D. Tex. held that Viacom had established enforceable trademark rights in THE KRUSTY KRAB and 5th Circuit Court of Appeals affirmed

- Key Factors for Viacom:
 - THE KRUSTY KRAB
 - Appeared in over 80% of episodes
 - Featured in 2 movies
 - Grossed \$470M
 - Spent \$197M promoting
 - Featured in mobile app
 - 7M+ downloads globally
 - Featured in Broadway musical
 - Media coverage
 - Viacom’s advertisements / social media
 - Licensed to third-parties
 - Viacom’s subsidiary, Paramount Pictures, licensed trademark of fictional restaurant from Forest Gump—BUBBA GUMP SHRIMP CO.—for real restaurant

Viacom Media Networks

Lucasfilm Ltd. LLC v. Ren Ventures Ltd., 2018 WL 2392963 (N.D. Cal. Apr. 24, 2018)

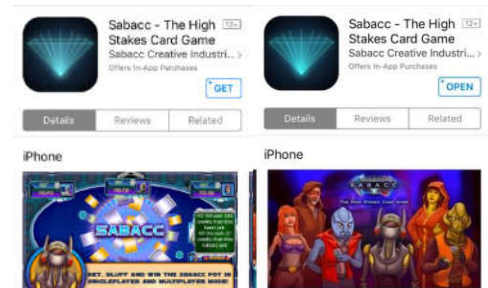


1980: STAR WARS fans first introduced to SABACC in *The Empire Strikes Back*

- Since then, SABACC licensed for use in connection with: (i) novels; (ii) tv episodes; (iii) magazines; (iv) comic books; (v) card games; (vi) mobile games; (vii) live theme park experience; (viii) movie

2015: Ren Ventures released mobile game titled SABACC and applied to register the mark

- Intentionally trading off goodwill from STAR WARS franchise
- Company named after character Kylo Ren
- Website and social media pages displayed copyrighted photos and quotes, and referenced STAR WARS trademarks
- App referenced events, places, and well-known phrases from STAR WARS
- App included misleading legal line: "© Sabacc trademark used under license"



Viacom Media Networks

Additional Examples Where TM Protection Found

- KRYPTONITE
 - *DC Comics v. Kryptonite Corporation*, 336 F.Supp.2d 324 (S.D.N.Y. 2004)
- THE DAILY PLANET
 - *DC Comics v. Powers*, 465 F.Supp. 843 (S.D.N.Y. 1978)
- GENERAL LEE Design
 - *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76 (2d Cir. 1981)
- DUFF BEER (in Australia)
 - *Twentieth Century Fox Film Corp. v. South Australian Brewing Co.*, [1996] 66 FCR 451 (Austl.)

Viacom Media Networks

Example Where TM Protection Not Found

Paramount Pictures Corporation v. Romulan Invasions,
7 U.S.P.Q. 1897 (T.T.A.B. 1988)

- TTAB dismissed opposition against application for THE ROMULANS for a band
- Use on dolls was very limited and PPC licensee let registration for THE ROMULAN lapse
- Reference to THE ROMULAN in show and comic books, as well as use in titles of single works not TM use



Viacom Media Networks

If you want to increase your chances of obtaining trademark protection over a fictional element – license it!

- SEX PANTHER (cologne; *Anchorman*)



- TRU BLOOD (drink; HBO Series)



- BUBBA GUMP SHRIMP CO. (restaurant, *Forest Gump*)



- STAY PUFT (caffeinated marshmallows; *Ghostbusters*)



Viacom Media Networks

Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989)



- Work at issue: title of film, *Ginger & Fred*, about a fictional cabaret duo in Italy named Pippo and Amelia who performed in Italy and imitated famous American duo Ginger Rogers and Fred Astaire and became known in Italy as “Ginger and Fred.” The Second Circuit characterized it as a fictional film that “only obliquely relates to Rogers and Astaire.”
- Plaintiff: Ginger Rogers, a famous actress whose name had “enormous drawing power in the entertainment world,” and whose “identit[y] was readily called to mind” by the phrase “Ginger and Fred.”
- Claims: False advertising; infringement of common law rights of publicity and privacy
- Rogers claimed the film’s title misled the public to think the film was about her or that she sponsored, endorsed, or was otherwise involved with the film.
- Rogers’ evidence of confusion: market research survey evidence and anecdotal evidence that studio publicists initially thought the film was about Rogers and began collecting photos of Rogers to promote film.

New York Intellectual Property Law Association
When Worlds Collide: Trademark Disputes Pitting Fictional
Entertainment Works Against 'Non-Fictional' Businesses

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Rogers: Balancing First Amendment vs. Lanham Act Rights



- Second Circuit acknowledges that “poetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.”
- Rejected district court’s view as “creat[ing] a nearly absolute privilege for movie titles, insulating them from Lanham Act claims as long as the film itself is an artistic work and the title is relevant to the films content,” which “unduly narrows the scope of the [Lanham] Act.”
- However, First Amendment rights must “inform [the Court’s] consideration of the scope of the [Lanham] Act.” Reasoned that titles, “like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. ... the expressive elements of titles require[] more protection than the labeling of ordinary commercial products.”
- Rejects Rogers’ argument that First Amendment is only implicated where author has “no alternative means” of expression as “provid[ing] insufficient leeway for literary expression.”
- Concluded that the Lanham Act “in general ... should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”

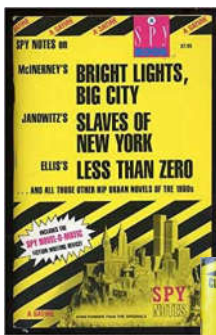
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The *Rogers* Framework

- Thus, the *Rogers* balancing test: “In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source of the work.”
- Allegedly infringing use must either be (1) artistic irrelevant, or (2) explicitly misleading.
- *Rogers* characterizes the “artistic relevance” requirement as “the appropriately low threshold of minimal artistic relevance.”
- Result: Second Circuit acknowledges that there is some potential risk of confusion, but that “Ginger & Fred” title was artistically relevant and not explicitly misleading.

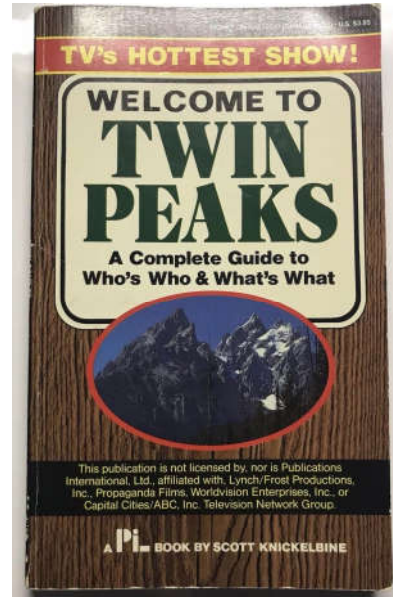
Development of *Rogers* Framework in Second Circuit *Cliffs Notes, Inc. v. Bantam Doubleday*, 886 F.2d 490 (2d Cir. 1989)



- Decided after, but same year as, *Rogers*.
- Work at issue: cover of book *Spy Notes*, a parody of *Cliffs Notes* providing satirical summaries of fictional novels. The cover allegedly infringed trademarked elements of *Cliffs Notes* cover: distinctive yellow color, black diagonal stripes, and black lettering.
- Claims: trademark infringement
- Again recognizes that “books are ‘sold in the commercial marketplace like other utilitarian products, making danger of consumer deception a legitimate concern...”
- “In deciding the reach of the Lanham Act in any case where an expressive work is alleged to infringe a trademark, it is appropriate to weigh the public interest in free expression against the public interest in avoiding consumer confusion.”
- “This approach takes into account the ultimate test in trademark law, namely, the likelihood of confusion “ ‘as to the source of the goods in question.’ ”
- Result: cover was artistically relevant and not explicitly misleading; preliminary injunction vacated.

Development of Rogers Framework in Second Circuit

Twin Peaks Prods., Inc. v. Publications International Ltd., 996 F.2d 1366 (2d Cir. 1993)



- Work at issue: title of book, *Welcome to Twin Peaks: A complete Guide to Who's Who and What's What*
- Claims: trademark infringement (of unregistered TM "Twin Peaks"); copyright
- Nature of Claim: book about television show *Twin Peaks* was misleading as to show's involvement with book
- The title was clearly artistically relevant.
- Thus, "the question is then whether the title is misleading in the sense that it induces members of the public to believe the Book was prepared or otherwise authorized by [plaintiff]. This determination must be made, in the first instance, by application of the venerable Polaroid factors. *See Cliffs Notes*, 886 F.2d at 495 n. 3. However, the finding of likelihood of confusion must be **particularly compelling** to outweigh the First Amendment interest recognized in *Rogers*."
- Therefore clarifies that likelihood of confusion is assessed as part of the balancing test, but requires a "particularly compelling" likelihood of confusion.
- Result: remand. "It is a fair question whether a title that might otherwise be permissible under *Rogers* violates the Lanham Act when displayed in a manner that conjures up a visual image prominently associated with the work bearing the mark that was copied."

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Ninth Circuit View

Twentieth Century Fox v. Empire Distribution, Inc., 875 F.3d 1192 (9th Cir. 2017)



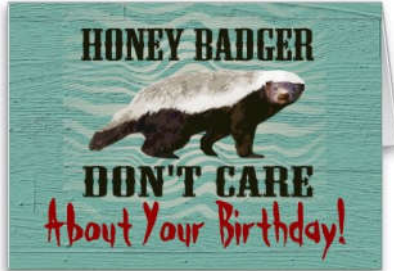
- Work at issue: title of TV show, "Empire," about a fictional hip-hop record company named Empire, also used for soundtracks and on merchandise.
- Plaintiff: a hip-hop record company named Empire, a registered trademark.
- Defendant's artistic relevance argument: the show is set in New York, the empire state, and the record company-itself an "empire"-is appropriately named Empire.
- Ninth Circuit acknowledged that while Fox's uses of "Empire" to market and sell music and other products "technically fall outside the title or body of an expressive work, it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name."
- Held: "If the use of a mark is artistically relevant ... the Lanham Act does not apply unless the title explicitly misleads as to the source or the content of the work. ... Empire Distribution argues that the 'relevant inquiry ... is whether the defendant's use of the mark would confuse consumers as to the source, sponsorship or content of the work.' But this test conflates the second prong of the *Rogers* test with the general Sleekcraft likelihood-of-confusion test, which applies outside the *Rogers* context of expressive works."
- Thus, under Ninth Circuit application of *Rogers*, explicitly misleading is a concept distinct from likelihood of confusion.

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Ninth Circuit View

Gordon v. Drape Creative, Inc., 909 F.3d 257 (9th Cir. 2018)



- Work at issue: greeting cards using “Honey Badger” catchphrases
- Claims: trademark infringement
- Plaintiff: creator of popular YouTube video known for catchphrases “Honey Badger Don’t Care” and “Honey Badger Don’t Give a S---”
- “Although on every prior occasion in which we have applied the test, we have found that it barred an infringement claim as a matter of law, this case presents a triable issue of fact. Defendants have not used Gordon’s mark in the creation of a song, photograph, video game, or television show, but have largely just pasted Gordon’s mark into their greeting cards. A jury could determine that this use of Gordon’s mark is explicitly misleading as to the source or content of the cards.”
- Clarifies that, under *Rogers*, defendant must make a threshold showing that the use is a First Amendment protected expressive work; if so, then plaintiff “bears a heightened burden ... [to] satisfy not only the likelihood-of-confusion test but also at least one of Rogers’ two prongs.”
- The focus of the “explicitly misleading” prong is “the nature of the [junior user’s] behavior” rather than on “the impact of the use.”