

# DECISIONS & DEVELOPMENTS

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Patents • Trademarks • Copyrights • Trade Secrets • Antitrust • Government Contracts • Licensing • Litigation

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## BARBIE IS COMMON BUT PROTECTIBLE

Mattel is the creator of, and owns copyrights in, the world famous Barbie doll whose current sales exceed \$1 billion per year worldwide. Radio City operates the Radio City Music Hall theater in New York City which features the widely renowned Rockettes chorus line. To celebrate the millennium, Radio City created a doll, which it named "Rockettes 2000" doll. Mattel brought suit alleging that the Rockette doll infringed its copyrights in the facial features of two of the Barbie dolls. Radio City filed a motion for summary judgement and the lower court granted it concluding that when it comes to something as common as a youthful, female doll, the unprotectible elements are legion, including, e.g., full faces; pert, upturned noses; bow lips; large, widely spaced eyes; and slim figures.

Mattel appealed the grant of summary judgment, and the appeals court agreed with Mattel. The proposition that standard or common features are not protected is inconsistent with copyright law. To merit protection from copying, a work need not be particularly novel or unusual. It need only have been independently created by the author and possess some minimal degree of creativity. There are innumerable ways of making upturned noses, bow lips, and widely spaced eyes. Even if the record had shown that many dolls possess upturned noses, bow lips, and wide-spread eyes, it would not follow that each such doll, assuming it was independently created and not copied from others, would not enjoy protection from copying.

The protection that flows from such a copyright is, of course, quite limited. The copyright does not protect ideas; it protects only the author's particularized expression of the idea. Thus, Mattel's copyright in a doll visage with an upturned nose, bow lips, and widely spaced eyes will not prevent a competitor from making dolls with upturned noses, bow lips, and widely spaced eyes, even if the competitor has taken the idea from Mattel's example, so long as the competitor has not copied Mattel's particularized expression.

The appeals court vacated the grant of summary judgement and remanded for trial. Mattel Inc. v. Goldberger Doll Manufacturing Co., 70 USPQ2d 1469 (CA 2)

## TEMPORARY INFRINGEMENT?

National Steel brought suit against Canadian Pacific Railway charging that a Canadian Pacific Railway car now in the United States was constructed in violation of National Steel's patent.

Canadian Pacific put forth a defense based on the little used provision that the United States patent law allows entitled temporary presence in the United States §272. That section provides that the use of any invention in any vessel, aircraft or vehicle of any country... entering the United States temporarily or accidentally, shall not constitute infringement of any patent,....

One of the issues was: what was meant by temporarily? The court found that temporarily, as the word is used in §272, means entering for a period of time of finite duration with the sole purpose of engaging in international commerce. The expectation that Canadian Pacific Railways allegedly infringing car would spend more than 50% of its useful lifespan in the United States is not relevant to the interpretation of this section.

The court explained that if the cars are entering the United States for a limited time, that is, they are not entering permanently, and are entering only for the purpose of engaging in international commerce, that is, they are entering to unload foreign goods and/or to load domestic goods destined for foreign markets, they are entering "temporarily" for the purposes of §272 regardless of the length of their stay within the jurisdiction of the United States. National Steel Car Ltd. v. Canadian Pacific Railway Ltd., 69 USPQ2d 1641 (CA FC)

## BOOK REVIEWS

Trademark Law by Siegrun D. Kane is a complete guide to trademarks from selection to litigation and licensing. Initial efforts to secure trademark rights, such as searching, using, registering and maintaining a trademark as well as enforcing trademark rights, negotiation of settlements of trademark disputes, and defenses to charges of infringement are thoroughly covered. Related areas of trade dress, dilution, false advertising and internet and domain issues are also covered. 4th Edition, Practising Law Institute, New York, NY, 320 pages, \$245.00

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Patent Trademark and Copyright Laws, 2004 Edition is a handy collection of basic laws useful to a practitioner in intellectual property and is well organized and indexed for quick access.

In addition to the relevant section of the Constitution and the patent, trademark and copyright codes there are relevant portions of related statutes, recent amendments covering introduction of generic versions of potential pioneer drugs and provisions barring grants of patents on human organisms are also included. \$120.00 BNA Books, Washington, D.C.

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Claims are the most difficult and time consuming part of the patent application to write and one of the most important parts as well. Initially as filed they define the invention that the inventor sees as his own, finally, as issued, they define the exclusive area granted to the inventor as against the rest of the world. Landis on Mechanics of Patent Claim Drafting, by Robert C. Faber deals thoroughly and deeply with this most difficult form of legal expression. Covered are claim forms and formats, including independent and dependent, preamble and body; types of claims including apparatus, method, article of manufacture, and composition of matter; and biotechnology claims. Chapter 10, Thoughts on Writing a Claim, drills deep into the black art of claim drafting and the attorney's thought processes as it explores the goals of claim writing, the objects of the invention, the inventor's way of achieving those objects, claims to multiple embodiments, genus and species claims and the use of "means" language in claims, an issue currently highly litigated. The glossary of terms in Appendix B is a worthy reference for experienced claim drafters as well as newcomers to the field 5th Edition, Practising Law Institute, New York, NY, 320 pages, \$325.00.

## MARLBORO MAN WINS THE SHOWDOWN

You might suspect that one cannot own the theme or motif of an advertising and promotion campaign but you would be wrong.

Philip Morris makes Marlboro cigarettes whose market share currently exceeds 35% of the U.S. cigarette market. Cowboy, a company organized in April of 2002 makes Cowboy cigarettes, a small local brand that entered the market in June of 2002.

Since 1963 the majority of advertisements for Marlboro cigarettes have prominently featured a cigarette-smoking cowboy integrated into a western motif. The advertisements of Marlboro are so saturated with such imagery that they came to be commonly referred to as the "Marlboro Man" and "Marlboro Country."

Since their entry into the marketplace in 2002, "Cowboy" cigarettes have been advertised using similar cowboy imagery. Such imagery also appears on the Cowboy cigarette pack, which is, like the Marlboro cigarette pack, red and white and prominently features a triangular wedge.

No surprise, Marlboro brought suit against Cowboy for trade dress infringement and sought a preliminary and permanent injunction.

In order to establish a secondary meaning in its trade dress in the nature of a trademark Philip Morris showed substantial advertising expenditures, unsolicited media attention, great sales success, and a long length of exclusivity of the trade dress.

The court permanently enjoined Cowboy from packaging, advertising, distributing or selling cigarettes or any other tobacco product by use of the word "Cowboy," or depicting a cowboy, cowboy on horseback, cowboy herding cattle or horses or similar motif. Philip Morris owns it. No other tobacco company can picture their products in a cowboy setting in order to garner good will from the more than century-long love affair of the public with the American cowboy. Philip Morris USA Inc. v. Cowboy Cigarette Inc., 70 USPQ2d 1092 (DC SNY)

## BUMBLE BEE GETS STUNG

Bumble Bee is a leading provider of tuna in the United States and owns several well established and widely recognized trademarks under which it has marketed tuna fish since 1940. Bumble Bee has created a Quality Assurance Program by which it authorizes tuna salad processing companies to manufacture and market tuna salad using its products and bearing its marks.

Bumble Bee and Sally Sherman discussed the possibility of Sally Sherman becoming a participant in the quality assurance program, thereby allowing Sally Sherman to

use the Bumble Bee mark on its tuna salad. As part of that application process, Sally Sherman completed and passed a Quality Assurance Survey designed to screen potential participants in the Quality Assurance Program. As the next step in the application process, Bumble Bee then scheduled an onsite inspection at Sally Sherman's facilities, but Sally Sherman withdrew its application one week later.

Subsequently, Sally Sherman purchased a substantial amount of Bumble Bee tuna for use in making tuna salad. Bumble Bee thereafter discovered that Sally Sherman distributed to delicatessens and supermarkets its five pound tubs of tuna salad, the lid of which stated: Sally Sherman Tuna Salad and it also stated: Made with Bumble Bee Tuna. Bumble Bee brought suit for trademark infringement and sought a preliminary injunction.

This court refused the preliminary injunction stating that they saw no likelihood of confusion of a trademark here because Sally Sherman did not simply repack-age Bumble Bee tuna and resell it in a new container. Rather, Sally Sherman mixed and blended Bumble Bee's tuna, with more than a dozen additional ingredients, including mayonnaise, celery, flour, spices, and preservatives. Any adverse inference to be drawn by a consumer from poor quality tuna salad, said the court, may fairly be directed toward the composite manufacturer, not the manufacturer of the ingredients. *[That hardly seems to be the case. If there was something unpleasant or even spoiled about the tuna salad, who do you think would get a bad reputation, not just Sally Sherman. Contrast this with the court's own inconsistent statement "the source of tuna fish could be the most important factor a delicatessen or supermarket would consider in purchasing tuna salad..." If the source of the tuna fish was so important to the delicatessen or supermarket don't you think the source of the tuna fish would have its name smeared along with Sally Sherman's if there were anything perceived to be wrong with the tuna salad?]* Bumble Bee Seafoods LLC v. UFS Industries Inc., 71 USPQ2d 1684 (DC SNY)

## WHAT WAS SHE THINKING?

Catherine Balsley, known in the reporting business as Catherine Bosley, previously worked as a TV news reporter for WKBN, a CBS television affiliate in Youngstown, Ohio. She was a news anchor there for approximately ten years, leading to her status as a regional celebrity.

In March of 2003, while on vacation with her husband in Florida, Bosley appeared in a wet t-shirt contest. During the participation Bosley removed her clothing. Bosley now asserts that, without notice or consent, Dream Girls Inc. videotaped her performance for publication and

reproduction in the form of videos and DVDs. Since the incident, images of Bosley have been displayed on the internet through a series of web sites advertising pictures and videos of the naked anchor woman. Subsequently, Marvad Corporation d.b.a. SexBrat.com obtained a license of the video of Bosley's performance from Dream Girls.

Prior to posting Bosley on their site they received 9,457 hits. After Bosley was posted, they received 111,663 hits. Marvad and Dream Girls used depictions of Bosley as an advertisement to promote the sexually-related materials marketed by them.

Due to the publicity generated by the incidents, Bosley resigned from her position as an anchor at WKBN and asserts that she was compelled to do so because of the unauthorized use of her image. In addition, she says that the continued display of her image prevents other employment in the television news field, the only career she has ever had.

After considering a number of defenses offered by Dream Girls and Marvad including arguments that the images were not used for commercial purpose, that they were subject to the public affairs exception, and that they were commercial speech and first amendment issues, the court considered the issue of consent.

Dream Girls alleged that Bosley consented to the commercial use of her likeness or image because there were signs posted around the dressing room, stage, entrances, and exits notifying participants about the future commercial use of their image:

NOTICE: The event you have entered is being filmed by a video production company. By entering the 'stage' beyond this sign, you are hereby consenting and agreeing to your picture and image being used for any reproduction of any type and sale without any further compensation.

Dream Girls also claims that the emcee of the contest announced over the loudspeaker that the event was being filmed for a Dream Girls production. In addition, Dream Girls produced strong evidence that Bosley impliedly consented to being photographed. Dream Girls showed a large number of pictures with Bosley positioned within feet of Dream Girls' camera and looking directly into the camera's lens. Given the relatively large size of the camera, Dream Girls argues that this is evidence that Bosley impliedly consented to being photographed.

However, the court said, this doesn't constitute a defense under the law. The Florida law requires express written or oral consent and that was not obtained from Bosley. Dream Girls *et al.* were enjoined from selling, distributing, promoting or placing on web sites any and all images of Catherine Bosley in the form of videotapes,

DVD recordings, pictures, photographs, or other likeness or depiction. Chivalry lives on.

But subsequently, Dream Girls et al. appealed, requesting a stay of the imposition of the injunction on the grounds that it was a prior restraint on speech and violation of the First Amendment and the appeals court agreed. The preliminary injunction was stayed pending a decision on the merits. Bosley is back. Bosley v. WildWetT.com, 70 USPQ2d 1520 (DC NOhio, 2004), Bosley v. WildWetT.com, 70 USPQ2d 1537 (CA 6 )

## 19 MILLION AWARD FOR INTERNAL COPYRIGHT INFRINGEMENT: LAYING DOWN THE LAW IS NOT ENOUGH

Legg Mason paid for and received a single authorized copy of the weekly and daily report published by Lowry's. Legg Mason acknowledged however that its employees posted a copy of all registered weekly Reports on its firm-wide intranet. Hundreds of Legg Mason brokers and other employees, at over a hundred Legg Mason offices accessed or downloaded the intranet-posted Reports over 16,000 times. They also made and distributed copies on paper and e-mail. Lowry brought suit for copyright infringement.

The Court pointed out that unauthorized electronic transmission of copyrighted text, from the memory of one computer into the memory of another, creates and infringing copy under the copyright law.

Legg Mason however, denies liability for the infringing acts of its employees. However, vicarious copyright liability reaches anyone who has the right and ability to supervise the infringing activity and also has an obvious and direct financial interest in exploitation of the copyrighted material.

Legg Mason asserts, however, that the copying contravened express company policy. It offered in evidence several memoranda from its legal and compliance department, e.g., "...material published by an independent third party is subject to copyright laws and requires appropriate authorization and approval prior to being used.... It is extremely important that these procedures be followed to avoid violating applicable regulations and Firm standards as well as copyright laws."

But the Court said that Legg Mason's reliance on company policies and orders is misplaced. The fact that Legg Mason's employees infringed Lowry's copyrights in contravention of policy or order bears not on Legg Mason's liability, but rather on the amount of statutory and punitive damage and the award of attorney's fees. It is not enough to lay down the law, you have to hire a cyber-cop to police your employees as well.

Legg Mason's estimate of \$59,000 in damages was totally overshadowed by the jury's award of over \$19,000,000. Lowry's Reports Inc. v. Legg Mason Inc., 69 USPQ2d 1754 (DC Md)



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