# IP SAVVY

*THE Newsletter for the Intellectual Property Community*

May 2013

## PRACTICE POINTER: U.S. IP ENFORCEABLE IN OTHER COUNTRIES?

IP rights are typically country specific. That is, if you have a trademark or a copyright only in the United States, you generally cannot stop a competitor from using your trademark or copyrighted material outside of the United States.

The internet, however, has changed how products and services are marketed. Thus, if a company outside the Untied States has a website which targets US consumers and that website advertises products or services which infringe your IP, recourse may be possible. But, you still have to be able to sue the foreign corporation in the United States (which can be difficult) and note too that this area of the law is still evolving. For a recent case law example see *Stevo Design Inc. v. SBR Marketing Ltd.* 105 USPQ 2d 1925 (D. Nev. 2013).

## CLARK ROCKEFELLER: GUILTY

How did "Clark Rockefeller" become the subject of an IP dispute? Freelance photographer Donald Harney photographed Rockefeller with his daughter on his shoulders outside of a church on Beacon Hill on April 1, 2007. Sony later produced a made for TV movie about "Rockefeller" and used a similar photograph in the movie. Harney sued for copyright infringement but lost at the US Federal District Court in Massachusetts and also on appeal before the 1st Circuit Court of Appeals because the two pictures were not substantially similar under the copyright laws. *Harney v. Sony Pictures Television, Inc.,* 105 USPQ 2d 1334 (2013).

## NO ©FOR YOGA

Can you copyright a yoga sequence? No – that's fact/idea; not expression and copyright protects only expression, e.g., the photographs of a model performing a yoga sequence but not the sequence itself. *Bikram's Yoga College of India LP v. Evolution Yoga LLC,* 105 USPQ 2d 1162 (CD Cal 2013).

## ® FOR PRODUCT CONTAINER

It can be difficult to stop private labelers from selling consumer products packaged and marked similar to yours. One way to stand out is to package the product in a way that the packaging is registerable as a trademark and then private labelers will not be able to copy your packaging. For example, the Scope "Outlast" bottle and cap were held registerable as a trade-

mark in the case *In re Procter & Gamble Co.,* 105 USPQ 2d 1119 (TTAB 2012). But, any aspect of the product packaging design which is functional is not registerable. Thus, in the case *In re Mars Inc.,* 105 USPQ 2d 1859 (TTAB 2013), several features of a pet food can were held not registerable because they were functional.

## NO ® FOR SWEARS

Vulgar marks are not registerable. So says a case of *In re Fox,* 105 USPQ 2d 1247 (Fed. Cir. 2012) where the mark was for a rooster-shaped (or cock) lollipop (or sucker). I have nothing else to say about that.

## STILL ANOTHER PORN CASE

ViaView's choice of "isanyoneup.com" for a domain name might have been an unfortunate choice for a website targeting bullying behavior. Still, when a porn site registered "isanyoneup.net," a Federal District Court in Nevada granted ViaView's request for a temporary restraining order. *ViaView, Inc. v. Blue Mist Media,* 105 USPQ 2d 1304 (D. Nev. 2012).

## LIFE IS JAKE

The "Life is Good" people won a case wherein an artist accused the "Jake" "Life is Good" character of being a knock off of the artist's "Penmen" characters. *Blehm v. Jacobs* 105 USPQ 2d 1312 (10th Cir. 2012).

## KEEP PAYING

Can a company which licenses a patent later proven invalid still have to pay royalties? Yes.

Cummins, Inc. licensed patents from TAS Distributing Co. regarding technology which controlled diesel engines. Cummings and TAS sued each other over the license agreement but Cummings never challenged the validity of the patents. During discovery in a second lawsuit, Cummings learned the patents were invalid – TAS has sold the patented technology more than one year before the patent applications were filed. But, TAS proved Cummings knew this fact before the first lawsuit. Accordingly, *Res Judicata* prevented Cummings from later challenging the patent. If you know of a defense in a lawsuit, you have to raise it or else you lose your right to raise it later. *Cummings, Inc. v. TAS Distributing Co.,* 105 USPQ 2d 1291 (Fed. Cir. 2012).

## PAY IT BACK

Janet Murley worked for Hallmark for three years and was let go under a severance agreement whereby she was paid $735,000.00 and agreed to keep Hallmark's trade secrets confidential. Later, while on a consulting job for another company, Murley divulged Hallmark's trade secrets. The jury awarded Hallmark all the severance money paid Murley plus more. *Hallmark Cards, Inc. v. Murley,* 105 USPQ 2d 1519 (8th Cir. 2013).

## BAD MUSIC STILL PROTECTABLE

"The Village People" is the registered trademark for a musical and vocal group. Karen Willis sought to cancel the trademark registration because the "Village People" do not actually write or perform music nor do they play any musical instruments. A vocal group can lip sync, held the Federal Circuit in *Willis v. Can't Stop Productions, Inc.,* 105 USPQ 2d 1577 (2012).

## APP STORE SAGA CONTINUES

Does Apple own "App Store"? It remains to be seen. In *Apple Inc. v. Amazon.com, Inc.,* 105 USPQ 2d 1660 (N.D. Cal. 2013), Amazon knocked out one of Apple's causes of action in a lawsuit which may ultimately decide whether "App Store" is protectable as a trademark.

## SUPREME COURT WATCH

The Supreme Court decided the patent case *Gunn v. Minton,* 105 USPQ 2d 1665 (2013) but the decision doesn't have much of an effect on the IP community. Briefly, a claim for legal malpractice in litigating a patent infringement action is a state rather than federal matter so the legal malpractice claim has to be brought in a state court as opposed to a federal court.

## LOUIS VIUTTON HANGOVER

In the movie the Hangover Part II, while in the airport, the Teddy character moves Alan's bag and Alan say "careful, that's a Lewis Vuitton." In fact, the bag was a Louis Vuitton knock off. So, Louis Vuitton sued Warner Brothers for "false designation of origin." Trademark law only protects against consumer confusion, here there was none, and as a result Louis Vuitton's case was dismissed. *Louis Vuitton Malletier S.A. v. Warner Brothers Entertainment, Inc.,* 105 USPQ 2d 1806 (SDNY 2012).

## CAN'T PATENT NATURE

I previously reported the case of *Mayo v. Prometheus* wherein the United States Supreme Court held patent process claims for a medical diagnostic test were held invalid as covering a patent ineligible law of nature. In a recent case, Boston based PerkinElmer, Inc. challenged a patent claim covering a method of estimating the risk of a fetus having Down's Syndrome and succeeded in invalidating the patent using the Mayo decision as precedent. *PerkinElmer, Inc. v. Intema Ltd.,* 105 USPQ 2d 1960 (Fed. Cir. 2013).

## FIRST SALE DOCTRINE

The Supreme Court has now decided the copyright first sale doctrine case of *Kirtsaeng v. John Wiley & Sons, Inc.,* 106 USPQ 2d 1001 (2013). Under copyright law, if you purchase a book, you cannot copy it but you can resell your physical copy of the book at will. Previously, the Supreme Court held that if the book was initially manufactured in the United States, then sold abroad, a purchaser of the book could resell it back into the United States without liability under the "first sale doctrine".

But, what if the book was manufactured abroad? Can someone outside the United States buy the book and then sell it to someone in the United States, again without liability? Here's why it matters factually.

John Wiley manufactures textbooks overseas and sells them overseas at a much cheaper price than the same textbook are sold in the United States. So, one enterprising Cornell and later USC student had his relatives in Thailand buy Wiley's textbooks there and mail them to him in the United States where he resold them to other students at a price less than the US versions of the same textbooks.

Held the Supreme Court: the first sale doctrine protects such activities.

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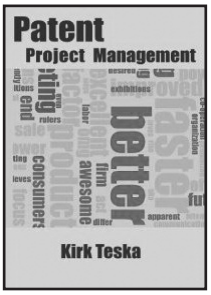


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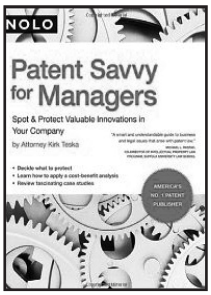


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