

Intellectual Property
Fall 2018
Final Sample Answer

Question 1: Making a Lawsuit (1,479 words)

To: C.T. Ip

Re: *Depraved Heart*

Here is a draft of a short memo to Ms. Ricciardi. I recommend that she obtain a release of his right of publicity from Durst; reject or modify the ads from Rx in a Box, Green Apron, and McLemore Industries; obtain licenses to “Get Off Your Ass and Jam” and “It Ain’t Me, Babe”; and register copyrights in the episodes and trademarks in the show name and logo.

1. Durst

Buddy Durst has a right of publicity in his name, photograph, and biographical facts. Reporting on the facts of his case probably does not implicate the right of publicity. *Depraved Heart* is an editorial product, and news reporting—even when the news is distributed commercially, as this podcast will be — does not implicate the right of publicity. The truth about a notorious triple murder

clearly qualifies as a matter of legitimate public concern. That said, the extensive use of Durst's photograph in the podcast logo and extensive use of his name may arguably go beyond the scope of what is allowed for news reporting purposes. These uses might be regarded as implying that Durst endorsed the podcast, rather than just being its subject.

I think you are unlikely to face a suit from Durst. His willingness to sit for interviews with the knowledge that they would be used in a podcast probably constitutes consent to that use, and to the reasonably ancillary uses of accurately promoting the podcast. *See Parks Institute*. I also understand that journalistic ethics make it problematic to give the subject of a story compensation or the right to object to how they are portrayed, and that asking for permission would create additional possibilities for conflict with Durst. Still, it would be best to get an explicit release from him.

Durst does not have a copyright in the biographical facts of his story: that consists of uncopyrightable fact.. He also probably does not hold a copyright in the audio of his interview: he does not appear to qualify as an author under *Thomson v. Larsen*.

2. “Get Off Your Ass and Jam”

I’m sorry to say that there is probably no worse song to have appear in background audio than “Get Off Your Ass and Jam.” This is the very song at issue in *Bridgeport v. Dimension*, where the court held that there is no *de minimis* exception to copyright liability for sound recordings. That case involved intentional sampling rather than an accidentally overheard sound recording, so it might be distinguishable on that basis. Also, the *Bridgeport* reasoning has been rejected by *VMG Salsoul v. Ciccone*. If ordinary *de minimis* reasoning implies, this case seems even less likely to involve infringement than *Gottlieb*, where the pinball machine in the background was held to be *de minimis*. If the *de minimis* defense to substantial similarity fails, you have a strong fair use argument. The amount used is not extensive, the use is transformative since the focus is on the interview, and there is little likelihood of market harm. Still the other bad news about this song is that its copyright owners are known to be litigious. It may be best simply to take a license.

3. Rx in a Box

The *less* problematic issue here is the obvious false advertising of claiming that Rx in a Box makes “miracles ... come true.” Since miracles are supernatural, this claim is literally false, and claims of medical benefits are highly likely to be material to consumers. The best response might be that this claim is puffery which no reasonable consumer would believe. This defense might or might not work for Rx in a Box, and Simpson Media might or might not be held contributorily liable for the false claims.

Still, that is not likely to be much consolation when the FDA shuts down Rx in a Box for blatant violations of its medical marketing rules. The first problem here is it is hard to imagine how mail-order prescribing of new medications each month is likely to be consistent with medical ethics or with state and federal regulation of drugs and prescribing. Marketing illegal activity is not going to endear Rx in a Box or Simpson Media to the FDA. The second problem is that Rx in a Box is offering FDA-regulated drugs to consumers without the FDA-required “brief statement” and it is hard to imagine how it could be added in the podcast format. (See the FDA’s action against Kim Kardashian’s Instagram marketing for Diclegis.) This ad must not run.

4. Green Apron

First, I am concerned about the truth of Green Apron's claim that it is good for the environment and Blue Apron is not. Given the name similarity, a claim that "the other meal kits" does not specifically refer to Blue Apron is likely to ring hollow. And if Green Apron is not actually more environmentally friendly, the claim is false *as a claim about Green Apron* even if it does not disparage Blue Apron. Again, Simpson Media might face secondary liability.

Second, there are trademark issues here. Comparative advertising by another meal-in-a-box company is fine. Indeed, it can refer to competitors by name if desired; it is a species of nominative fair use. But the name Green Apron itself may infringe on the trademark BLUE APRON even without the comparative reference. These are highly similar names (the only difference is substituting one color for another) for directly competitive products. This is not a nominative fair use, since it is not necessary to refer to BLUE APRON to describe an environmentally conscious meal-in-a-box service.

5. McLemore Industries.

Do not do this. Please do not do this. Although podcast advertisements typically suggest that the *podcast* endorses the *advertiser*, the opposite implication is also plausible (think about all of the fights around advertisements on politically controversial news programs). “Brought to you by ...” does not quite say “endorses” but it is close enough that McLemore would have a solid § 43(a) false endorsement claim if you air this ad. Even if you could win that lawsuit, why would you infuriate an advertiser like this? McLemore would never advertise again, and other advertisers would seriously mistrust *Depraved Heart* and Simpson Media. This is just a bad idea.

6. “It Ain’t Me, Babe”

The podcast implicates both reproduction (iTunes downloads) and public performance (Spotify streaming) rights, so you will need both types of licenses. Moreover, you will need licenses from the copyright owner of the musical work and of the sound recording. *If* DJ Adnan’s cover is licensed as a derivative work of the Bob Dylan musical work that allows him to issue sublicenses, or if it is a fair use, then you can seek a license only from him as . But it is hard to tell from

what you have told me if that is the case, and it is safest to assume that licenses will be required from separate parties.

On the musical work side, the Bob Dylan original is published by Special Rider Music and is in the SESAC repertory (SESAC # 514754). A blanket SESAC license would suffice for streaming, but you will probably need a direct license from Special Rider given that you also offer downloads and a podcast is outside the very limited scope of the § 114 mechanical license. On the sound recording side, I can start by trying to contact DJ Adnan to discuss licensing terms, since I have been unable to find any other information about the copyright in the sound recording. I do not think that you will be able to raise a fair use defense: the use of the song is not transformative in the podccast context, and this kind of use is one for which there exist well developed licensing markets.

7. Protecting Your Rights

Register a copyright in each episode of the podcast. This is inexpensive and quick, I can help you with the forms. This will protect you from direct imitation that involves copying the audio (including user-posted versions without ads). You can send DMCA notices to sites where unauthorized audio is posted. It

will not protect you from others also making podcasts about Durst: historical facts are not copyrightable.

You should also register a trademark in DEPRAVED HEART for podcasts, and in your logo, and register a copyright in your show logo (assuming it is sufficiently creative). You may need Durst's permission to register the show logo since it identifies him; this might be a good reason to use a different logo, or to register only a portion that includes the show's name in its distinctive style. The trademark may protect you against other true-crime podcasts on similar themes that also use DEPRAVED, and the copyright will protect you against unauthorized T-shirts (if you can find the infringers, always a challenge).

Question 2: Comic Book Movie (1,330 words)

1. Copyright Ownership

I assume that VDX owns the copyright in the *Teen Girl Squad* TV episodes. It is possible that Raymond Chapman has a copyright interest, but it is more likely that he was creating works made for hire or assigned his copyright interest to MetalMation and thus to its successor, VDX.

Carol Pazquel's drawings and stories pose a more difficult copyright ownership problem. If the original elements she added have a copyright owner, it is her. But because the drawings and stories are derivative works of *Teen Girl Squad*, it is possible that the infringing-derivatives rule of *Pickett v. Prince* applies and they are not separately copyrightable. I think it is more likely, however, that her drawings and stories are fair use. They are non-commercial and transformative, and especially because *Teen Girl Squad* had not been available for two decades, they did not significantly affect any market for the work. I do not think that Raymond Chapman's comments constituted a license (among other things, because he is not the copyright owner). But I do think the long history of tolerating

fansites like TheGreatestSquad.com tends also to show that no permission was required. Thus, under *Keeling v. Hars*, she owns a copyright in her incremental additions, most notably the detailed plots of her stories.

No one owns a copyright in the new names (e.g. “The Ugly One”): names and short phrases are not copyrightable. No one owns a copyright in the idea of having familiar cultural figures be superheroes: this is a familiar trope that is insufficiently detailed to be protectable expression.

2. Copyright Infringement

Teen Girl Superheroes is not substantially similar to *Teen Girl Squad*. Although there is a chain of derivative works connecting them, there are no longer significant similarities between the works at the beginning and the end of the chain. Hair color and basic hairstyles on fictional characters are not sufficient details to make the overall works the same in the eyes of the audience for these works.

Pazquel’s drawings and stories present a more difficult case. First, there is strong evidence of copying-in-fact. Even though the names are not copyrightable, they are distinctive enough that no one would adopt them as the names of char-

acters in the same roles (a foursome of teen superheroes) by coincidence. The public nature of TheGreatestSquad.com also plausibly establishes access (on these facts, affirmative evidence of access is probably not even needed). Similarity is more difficult. There are no resemblances between the Teen Girl Superheroes and Pazquel's drawings that are not based on similarities in the source material (*Teen Girl Squad*), so there is no similarity here to *her* protected expression. The plot about Blue Lazer/Blue Laser blowing up the ocean, however, is original to Pazquel. I need more information about her stories and the movie in order to assess how detailed the similarities are and whether they involve protected expression and not just ideas. I recommend obtaining a license from Pazquel or requiring Pom Pictures to indemnify Thorax against any associated copyright risk.¹

The action figures are useful articles: they are useful as toys. That does not prevent them from infringing (see 17 U.S.C. § 113(a)), so a similar analysis applies here. There are some minor visual similarities to *Teen Girl Squad* characters

¹ Pom's errors and omissions insurance coverage for *Teen Girl Superheroes* should cover this risk, so proper due diligence here would involve inspecting the policy. But we didn't discuss this in class.

and Pazquel's drawings, but since a plastic toy does not have a plot, there are no similarities to her stories. Infringement is unlikely.

3. Trademark: TEEN GIRL SQUAD

Metalmation probably had trademark rights in TEEN GIRL SQUAD. It is a suggestive mark for a TV show about a group of girls (since it is not literally a mark for a squad of teen girls). Titles of single creative works are not by themselves trademarks, but as a mark for a series, it is protectable. But since the show has not been commercially available to consumers since 1992 (indeed, the company that created it has been defunct since 1994), the mark has almost certainly been abandoned. It is possible that VDX has had some secret *bona fide* plan to resume use all this time, but I doubt it.

If the TEEN GIRL SQUAD mark were valid, there would be a more difficult infringement question. TEEN GIRL SUPERHEROES differs only in the substitution of one word, and that word also starts with an "S" and has a related, if not identical meaning. Both marks are being used on similar goods: video entertainment about the adventures of four teen girls. There is also a recognizable influence (see the proof of copying above), and at least one observer (Leonard-

Sportsinterviews) has noticed the connection. On the other hand, TEEN GIRL SQUAD is not currently available, and the actual movie is quite different in style (animation) and premise (superheroes). I think that there would be no likelihood of point-of-sale-confusion but I admit that the possibility of a § 43(a) false endorsement claim is harder to deny. TEEN GIRL SQUAD is not famous enough to qualify for dilution protection.

4. Trademark: TheGreatestSquad

TEEN GIRL SUPERHEROES also has some similarities to THE GREATEST SQUAD: notably, the same initials and that both are being used for highly similar media products. It is unclear who owns any trademark rights TheGreatestSquad.com has built up from its long-term use. The fact that it is not selling anything does not prevent the development of goodwill, since the name is being used to bring users back to the same community on a repeat basis. Fortunately, I think that the marks are not sufficiently close that consumers would be confused about the source of goods or about sponsorship and affiliation.

5. Right of Publicity

Raymond Chapman might try to argue that he is so identified with *Teen Girl Squad* that the new movie infringes his right of publicity. But such a claim would fail. First, creators are not in general identified with their creations: this would put a substantial article on the circulation of copyrighted works. Second, the reasons that Chapman objected to Pazquel's drawings are what made them and *Teen Girl Superheroes* transformative. (Chapman's claim is even weaker than the Winter brothers' claim against *Jonah Hex*, since he himself is not portrayed in *Teen Girl Superheroes*, only his creations.) And third, to repeat, *Teen Girl Superheroes* does not use Chapman's name, image, or other indicia of identity.

Marzipan Chapman and her friends are similarly not able to object to *Teen Girl Superheroes*. Their names were used in the original *Teen Girl Squad*, but *not* in *Teen Girl Superheroes*. Although the original characters were "based on" them, there is no indication that any member of the public would recognize them in any way in *Teen Girl Superheroes*.

6. Utility Patent

Homsar Longardeaux's utility patent is hard to assess without reading the claims. Is it a patent on an *actual* backpack-mounted rocket launcher? If so, then

it seems unlikely that it would read on a toy rocket launcher. It almost certainly would not read on the backpack in the movie,² not without raising serious subject matter and definiteness problems. If it is a patent on a toy, then the possibility of infringement is serious and I will need to read the claims closely.

7. Design Patent

Homsar Longardeaux's design patent is also hard to assess without seeing the claim. Here, however, there is a genuine risk of infringement if the claim drawings and the backpack on the So and So action figure are similar. An action figure is an article of manufacture and there is no requirement that the claim and the accused article have similar utilities (or any utilities at all). The movie is not an article of manufacture in the sense that design patent would control. *See AlSabah.*

8. Conclusion

I recommend obtaining a license from Carol Pazquel in an abundance of caution. Further research on utility patent 6,110,403 and design patent D400,107 is required. There are no other significant intellectual property risks.

² This should have been "movie" in the problem, rather than "show."