

**LEGAL AFFAIRS**

**Sex, Lies, and Videotape: The First Amendment vs.  
The Right of Publicity for Expressive Works  
by Schuyler M. Moore**

Numerous cases in the last year have created a three-way split of authority on the common question of how to resolve the tension between the right of publicity and the First Amendment for entertainment (such as films), art, and other expressive works (all of which are referred to as “expressive works” in this article). Particularly as we enter the digital age, when a celebrity’s image can be incorporated into an expressive work with the touch of a button, the resolution of this tension is absolutely critical. Entertainment companies must be able to predict the legal result of their actions. This article examines these

recent cases in the context of prior case law and analysis.

### *In General*

A number of cases have held that the First Amendment protects expressive works against a right of publicity claim. When this approach is applied, it does not matter whether the work touches on a matter of public interest or indeed whether there is any written or other communicative element other than the work itself. Some examples of this approach are as follows:

- \* Realistic sculptures of Cheryl Tiegs were held to be protected.<sup>1</sup>
- \* A museum was entitled to display a collage (and sell merchandise with a picture of the collage) containing a silkscreen image of the plaintiff with words written

over the collage.<sup>2</sup>

\* An artist was permitted to sell prints of his painting of Tiger Woods with other famous golfers.<sup>3</sup>

\* A film that included video clips of the plaintiff kissing a rock star in a bathroom stall was protected.<sup>4</sup>

\* A photograph in a magazine of a couple in a romantic pose was protected.<sup>5</sup>

\* “Girls Gone Wild” was permitted to show video clips of a girl flashing her breasts in public.<sup>6</sup>

### *Works of Fiction*

The First Amendment defense for expressive works protects even fictional stories that use the plaintiff’s persona.<sup>7</sup> For example, one case involved a fictional story based around Valentino’s life,<sup>8</sup> and another case involved a fictionalized story based on a true event that referred to a ten-year old character

referred to as “Squints Palledorous,” which vaguely resembled the plaintiff, Michael Polydoros, thirty years earlier.<sup>9</sup>

Similarly, a purely fictional film titled “Ginger and Rogers” that loosely alluded to the actual Ginger and Rogers dancing duo (the characters used those nicknames and aspired to dance like Ginger and Rogers) was permitted to use the name of the plaintiff (Ginger) in its title.<sup>10</sup>

Los Angeles Magazine was permitted to digitally create and publish a photograph of Dustin Hoffman wearing a dress (and not the one he wore in “Tootsie”).<sup>11</sup> Although the court did not state the basis for First Amendment protection, the only logical basis was that the photograph qualified as an expressive work.

In most cases, the implied rationale is that the work is protected not because it is fictional, but because

it is an expressive work, notwithstanding that it is fictional. Unfortunately, some of the cases misinterpret prior cases and come up with the garbled logic that the work is protected because it is fiction.

### *Parodies*

The courts routinely hold that parodies are protected against right of publicity claims by the First Amendment,<sup>12</sup> even if the parody does not relate to a matter of public interest.<sup>13</sup> The only logical implied rationale for these decisions, particularly when the parody does not relate to a matter of public interest, is that parody qualifies for the First Amendment defense for expressive works.

### *Limits*

*In General*

The language in many of the cases is broad enough to be read as providing First Amendment protection against a right of publicity claim for all expressive works, without qualification. This approach basically protects all “speech” in the broadest sense against a right of publicity claim, other than advertising, and basically wipes out the right of publicity except for advertising.<sup>14</sup>

But there must be some limits on this defense, because to give absolute protection to expressive works is to eliminate the right of publicity. For example, if a film company creates a digital version of Harrison Ford without his permission and uses that image in a film (e.g., a sequel to “The Fugitive”), Harrison Ford should have a valid right of publicity claim, but the film might be protected as an expressive work under current case

law.

Not all courts protect expressive works, although several cases do not mention the defense at all, so it is not clear if the issue was raised. For example, Playgirl was liable for printing a highly stylized cartoon of Muhammad Ali,<sup>15</sup> and a company that produced and sold plastic busts of Martin Luther King was held liable to the holder of the rights to his persona.<sup>16</sup> Indeed, the U.S. Supreme Court has held that an unauthorized television news broadcast of an entire human cannonball act was not protected by the First Amendment as a report on a matter of public interest because it caused a substantial threat to the economic value of the performance.<sup>17</sup> It seems likely that this case would likewise apply to expressive works, since they are no more deserving of protection than reports on matters of public interest.

*Transformative Requirement*

In two extremely important decisions, the California Supreme Court held that the conflict between the First Amendment and the right of publicity required a “balancing of interests,” and in the face of a right of publicity claim, the First Amendment protects only “transformative” works that reflect “significant transformative elements” to the plaintiff’s persona.<sup>18</sup>

Under this analysis, the battles in California will now be waged over whether or not a work is “transformative.” The Court justified a number of prior cases under this rubric, including cases giving First Amendment protection to (a) reports on matters of public interest, (b) parodies, and (c) works of fiction (referred to in this article as “Per-se Transformative Works”).

Aside from Per-se Transformative Works, the



court held that expressive works are not protected by the First Amendment in the absence of some indefinable “transformative” element. For example, in one of the two cases, the court held that a realistic sketch of the Three Stooges on T-shirts was not protected.<sup>19</sup> The Court stated that Andy Warhol’s famous silkscreens of celebrities were examples of “transformative” works that would be protected. In one of the two cases, DC Comics was permitted to turn the Winter Brothers (two well known musicians) into half-worms in comic books.<sup>20</sup>

There are several problems with this “transformative” approach that make it unworkable:

First, to the extent that a work is Per-se Transformative, there is no further “balancing of interests,” and the right of publicity is wiped out. Of particular concern, the Court lumped fictional works in the Per-se Transformative Work category, so the sequel

to “The Fugitive” starring a digital version of Harrison Ford would be protected as a “transformative” work. This is a patently absurd result.

Second, the test is rather rudderless, as evidenced by application of the test by courts in other states to date.<sup>21</sup> In one, a totally realistic painting of Tiger Woods was held to be transformative because other famous - and equally realistic - golfers were beaming down at him.<sup>22</sup>

Finally, there is absolutely no logic for protecting “transformative” works while not protecting “non-transformative” works. What exactly is the First Amendment rationale justifying protection of the former but not the latter?

### *Predominant Purpose Test*

The Supreme Court of Missouri has held that

expressive works are protected against a right of publicity claim only if the predominant purpose of the use of the plaintiff's persona is to make an expressive comment about the plaintiff, such as a parody directly relating to the plaintiff, as opposed to a predominant purpose of merely exploiting the commercial value of the plaintiff's persona.<sup>23</sup> Applying this test, the court held that a comic book portraying the plaintiff (a famous hockey player, Tony Twist, known as "the Enforcer") as a fictional mafia don was unlikely to be protected, but remanded the case for a jury determination as to the intent of the defendant. This case expressly disagreed with the "transformative" approach applied by the California Supreme Court.

The "predominant purpose" test makes a lot of sense, would straighten out much of the mess to date, and would result in the plaintiffs prevailing in all of the following cases, since in each case there is no

expressive comment about the plaintiff:

- \* The hypothetical of a remake of “The Fugitive” using a digital version of Harrison Ford.
- \* Los Angeles Magazine’s portrayal of Dustin Hoffman in a dress (and not the one he wore in “Tootsie”).
- \* DC Comics’ portrayal of the Winter Brothers as half-worms in comic books.

However, there are some difficulties with this test. First, assuming that the work does make an expressive comment about the plaintiff, does it permit use of a private person’s persona, such as the girls caught flashing in the “Girls Gone Wild” videos? And what if the “expressive comment” is the image itself, such as a picture book of celebrities? How is the finder of fact supposed to distinguish a “predominant purpose” of making an expressive comment from that

of making a buck, when the two go hand in hand?

In any event, there is thus now a three-way split of authority on whether expressive works are protected by the First Amendment. An interesting example is the plaintiff that flashed her breasts in public and found herself prominently featured in one of the infamous “Girls Gone Wild” videos. A Florida court held that the video was entitled to *carte blanche* protection as an expressive work, as discussed above.<sup>24</sup>

Plaintiffs in similar situations are well advised to seek to apply California law (the video should not be “transformative,” because there was no alteration of plaintiff’s image) or Missouri law (it appears that the “predominant purpose” of use of plaintiff’s naked image was exploiting the commercial value of it). This split of authority is thus going to encourage careful forum shopping in the future.

*Conclusion*

The real problem with right of publicity cases is that merely to be sued is to lose, even if the defendant ultimately wins the case, because of the legal fees incurred to defend the case and the threat of almost limitless liability. Because of the muddy law in this area, these cases are rarely resolved at the summary judgment stage. The mantra of most publishers and film companies has thus become, “When in doubt, leave it out,” resulting in a real hit to the First Amendment.

*Notes:*

1 Simeonov v. Tiegs, 602 N.Y.S.2d 1014 (N.Y.City Civ.Ct. 1993)(ELR 15:10:17).

2 Hoepker v. Kruger, 200 F.Supp.2d 340 (S.D.N.Y. 2002) (ELR 24:5:12).

3 ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915

(6th Cir. 2003) (ELR 25:5:12).

4 *Daly v. Viacom, Inc.*, 238 F.Supp.2d 1118 (N.D.Cal. 2002) (ELR 24:12:9)(oddly, this case was based on California law and was decided after the California Supreme Court limited the protection of expressive works to “transformative” works, discussed below).

5 *Gill v. Hearst Pub. Co.*, 40 Cal.2d 224 (1953).

6 *Lane v. MRA Holdings, LLC*, 242 F.Supp.2d 1205 (M.D. Fla. 2002) (ELR 25:1:11)(applying Florida law).

7 *Ruffin-Steinback v. DePasse*, 267 F.3d 457 (6th Cir. 2001)(ELR 23:11:10)(fictionalized account of *The Temptations*); *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994) (ELR 16:6:22)(fictionalized story of police officer); *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996) (ELR 19:5:12)(fictionalized story of Black Panthers); *Hicks v. Casablanca*, 464

F.Supp. 426 (D.C. N.Y. 1978)(ELR 1:1:5); Rosemont Enterprises, Inc. v. McGraw-Hill, 380 N.Y.S.2d 839 (1975); Tyne v. Time Warner, 204 F.Supp.2d 1338 (M.D.Fla. 2002)(ELR 24:5:8); The Restatement (Third) of Unfair Competition § 47.

8 Guglielmi v. Spelling-Goldberg Productions, 25 Cal.3d 860 (1979) (ELR 1:18:1).

9 Polydoros v. Twentieth Century Fox, 67 Cal.App. 4th 318 (1997)(ELR 20:10:4).

10 Rogers v. Grimaldi, 695 F.Supp. 112 (S.D.N.Y. 1988) (ELR 10:4:13).

11 Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001)(ELR 23:4:10).

12 Cardtoons, L.C. v. Major League Baseball Players Association, 95 F.3d 959 (10th Cir. 1996)(ELR 19:1:7); San Francisco Bay Guardian, Inc. v. Superior Court, 17 Cal.App.4th 655 (1993) (ELR 16:1:22)(applying parody defense to defamation claim);



Hustler Magazine, Inc. v. Falwell, 108 S.Ct. 876 (1988) (ELR 9:10:3)(applying parody defense to an intentional infliction of emotional distress claim).

13 Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001) (ELR 23:4:10), as subsequently interpreted by Mattel, Inc. v. MCA Records, 296 F.3d 894 (9th Cir. 2002) (ELR 24:6:10).

14 Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001) (ELR 23:4:10) (permitting Los Angeles Magazine to create and publish a photograph of Dustin Hoffman wearing a dress - and not the one he wore in “Tootsie”); Simeonov v. Tiegs, 602 N.Y.S.2d 1014 (N.Y.CityCiv.Ct. 1993) (ELR 15:10:17) (realistic sculptures of Cheryl Tiegs were protected).

15 Ali v Playgirl, Inc., 447 F.Supp. 723 (S.D.N.Y. 1978) (ELR Preview:2)(expressive works defense not mentioned).

16 Martin Luther King Jr. Center for Social Change

v. American Heritage Products, 296 S.E.2d 697 (Ga. 1982)(ELR 4:22:4) (expressive works defense not mentioned).

17 Zacchini v. Scripps-Howard Broadcasting Co., 97 S.Ct. 2849 (1977).

18 Comedy III Productions, Inc. v. Gary Saderup, Inc., 106 Cal.Rptr.2d 126 (Cal. 2001) (ELR 22:12:5); Winter v. DC Comics, 30 Cal.4th 881, 134 Cal.Rptr.2d (Cal. 2003) (ELR 25:3:9).

19 Comedy III Productions, Inc. v. Gary Saderup, Inc., 106 Cal. Rptr.2d 126 (Cal. 2001) (ELR 22:12:5).

20 Winter v. DC Comics, 30 Cal.4th 881, 134 Cal.Rptr.2d (Cal. 2003) (ELR 25:3:9).

21 Hoepker v. Kruger, 200 F.Supp.2d 340 (S.D.N.Y. 2002) (ELR 24:5:12) (collage that included photograph of plaintiff was transformative).

22 ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915 (6th Cir. 2003) (ELR 25:5:12).

23 Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003)(ELR 25:6:\_\_\_).

24 Lane v. MRA Holdings, LLC, 242 F. Supp.2d 1205 (M.D. Fla. 2002) (ELR 25:1:11).

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**IN THE NEWS**

**Random House and Joe Klein win dismissal of lawsuit filed by library worker who alleged that she was defamed by scene in novel “Primary Colors”**

The best-selling novel *Primary Colors* triggered at least two disputes. The first concerned the identity of its “Anonymous” author - a dispute that was settled years ago with the disclosure that it was written by political columnist Joe Klein. The second was whether

a minor character in the novel - a Harlem librarian named “Ms. Baum” - was a real-life Harlem library site advisor named Daria Carter-Clark. That dispute has come to an end just now, almost seven years after it was started by Carter-Clark when she filed a defamation lawsuit against Klein and the book’s publisher, Random House.

*Primary Colors* depicted the presidential primary campaign of a character named Governor Jack Stanton. Though the book was fiction, it was based on the 1991-92 presidential primary campaign of then Governor Bill Clinton, with Governor Stanton playing the fictional stand-in for real life’s Governor Clinton.

Early in *Primary Colors*, Governor Stanton visits a Harlem library where he meets a librarian named Ms. Baum. Soon thereafter, there is a scene in the novel where Governor Stanton and Ms. Baum come out of his hotel suite bedroom - he buttoning his open shirt, and

she “arranging herself” while trying “to maintain the appearance of propriety.”

In real life, Governor Clinton made a primary campaign appearance at a Harlem library where Carter-Clark worked as a site advisor. But in real life, Clinton and Carter-Clark “never had any intimate relationship.” Nevertheless, in her defamation lawsuit, Carter-Clark alleged that “some people whom she knows who have read the book believe that [the book’s librarian, Ms. Baum] is based on her,” and their beliefs have “caused damage to her reputation.”

The heart of Carter-Clark’s lawsuit was her claim that Klein and Random House had been negligent “in not adequately investigating and determining” whether readers would recognize her as being the novel’s “Ms. Baum.” Though not a trivial claim, it has not been successful. New York County Supreme Court Judge Richard Braun has granted Random House and

Klein's motion for summary judgment, and he has dismissed Carter-Clark's complaint.

In a brief but well-reasoned opinion, Judge Braun held that "An author of a book of fiction should not be held to the same investigatory standards as a writer of nonfiction." This is so, he explained, because "Although fiction writers often ground their works in part on people and experiences from their own lives, the essence of what they write is by definition fictional."

The judge observed that the author's note in *Primary Colors* and its jacket flap both emphasized that none of its characters was real and that it was fiction. These disclaimers were "not necessarily determinative," Judge Braun acknowledged. But, he said, "For a depiction of a fictional character to constitute actionable defamation, 'the description of the fictional character must be so closely akin to the real

person claiming to be defamed that a reader of the book, knowing the real person, would have no difficulty linking the two.”

Judge Braun found that was not so in this case, because the similarities between Carter-Clark and the novel’s “Ms. Baum” were superficial. “The reliance by [Carter-Clark] on minimal superficial similarities between her and Ms. Baum, and speculative gossip by some people who know [Carter-Clark], is not enough to create any issue of fact to be tried in this action,” the judge ruled.

The judge determined that Carter-Clark’s claim against Random House was even weaker than her claim against Klein. “A plaintiff raising a libel claim against the publisher of a novel should be held to an even higher standard than on such a claim against the book’s writer,” he said.

“Where a book is fiction,” the judge explained,



“the publisher must rely largely on an established writer’s investigation because to require publishers to do independent research regarding every possibly defamatory reference in a fictional book would likely create a prohibitory economic impediment to the book publishing industry, and thus a plaintiff must establish that the publisher had substantial reasons to question portions of the book or the good faith of the author.” In this case, the judge concluded, Random House had no reason to question the book or Klein’s good faith.

Carter-Clark was represented by Regina L. Darby in New York City. Random House and Klein were represented by Elizabeth A. McNamara of Davis Wright Tremaine in New York City,.

*Carter-Clark v. Random House, Inc.*, 2003 WL 22287461, 2003 N.Y.Misc.LEXIS 1228 (N.Y.Sup. 2003)[ELR 25:6:7]

**Disney defeats Caterpillar’s request for restraining order that would have blocked release of “George of the Jungle 2” video; court decides there is little likelihood that Caterpillar will succeed with unfair competition or trademark dilution claims complaining of video’s depiction of actual Caterpillar bulldozers and trademarks**

Walt Disney’s children’s video “George of the Jungle 2” is available for purchase now, because a federal District Court in Illinois has denied a request by Caterpillar for a temporary restraining order that would have barred the video’s release, in its present form.

“George of the Jungle 2” is a straight-to-video sequel to Disney’s very successful movie “George of the Jungle.” Caterpillar is a maker of heavy construction equipment, including bulldozers. Caterpillar bulldozers appear in four scenes in the

movie. They are actual Caterpillar bulldozers, not knockoffs, and were “procured” by the movie’s Australian production company from an “authorized Caterpillar dealer.” According to the production company, the dealer authorized it to use both the bulldozers and Caterpillar’s trademarks, though there is controversy about this authorization.

Caterpillar is upset, because in the video, the company’s bulldozers are driven by George’s adversaries. Worse yet, in one seven-minute battle scene, an offscreen narrator describes them as “deleterious dozers” and “maniacal machines.” Caterpillar’s objections to these scenes were formally expressed in an unfair competition and trademark dilution lawsuit filed against Disney shortly before the video’s scheduled release on October 21, 2003.

Following an emergency hearing, and the filing of post-hearing briefs by both sides, Judge Joe Billy

McDade has issued a 23-page written order denying Caterpillar's request for a temporary restraining order.

The judge noted that "Caterpillar's position seems to be simply that its products and trademarks appeared in *George 2* without authorization in four scenes and that the appearance of its trademarks and products should be sufficient to constitute unfair competition under § 43(a) of the Lanham Act." However, this caused the judge "discomfort," because "the appearance of products bearing well known trademarks in cinema and television is a common phenomenon. . . . Is the mere appearance of a Ford Taurus in a garden variety car chase scene sufficient by itself to constitute unfair competition?"

Though he stopped just short of answering that question, Judge McDade went on to emphasize that the purpose of trademarks is to help consumers select goods and to prevent others from taking a free ride.

Nothing indicated “that any consumer would be more likely to buy or watch George 2 because of any mistaken belief that Caterpillar sponsored this movie . . . [or to suggest that Disney] somehow took advantage of the fame of Caterpillar’s trademark to drive awareness or sales of George 2.”

This meant that Caterpillar had only a “slightly more than negligible likelihood of success,” and thus had the burden of proving that the “balance of harms” was in its favor - something it couldn’t do. Judge McDade said it would be “incredible . . . to imagine a consumer’s decision to purchase Caterpillar’s . . . heavy machinery and equipment, costing substantial sums of money, being affected after watching this film.” On the other hand, a restraining order would cost Disney and its retailers the benefits of the marketing they had already done for the video, and if Disney later won the case, would require a “potentially more costly

marketing campaign” for the video’s re-release.

Caterpillar fared no better with its trademark dilution claim. The judge agreed that the company’s marks were “famous.” The question was whether the video tarnished them. Judge McDade thought not. “There is nothing in *George 2* to even remotely suggest that Caterpillar products are shoddy or of low quality,” he found. He also rejected Caterpillar’s argument that the video casts its products “in an unwholesome or unsavory light.” “It is clear to even the most credulous viewer or child,” the judge found, “that the bulldozers in the movie are operated by humans and are merely inanimate implements . . . .”

Caterpillar was reprinted by Joseph Norvell of Brinks Hofer Gilson & Lione in Chicago, and by Timothy L. Bertschy of Heyl Royster Voelker & Allen in Peoria. Disney was represented by Matthew M. Neumeier of Jenner & Block in Chicago and by Roy G.

Davis of Davis & Campbell in Peoria.

*Caterpillar, Inc. v. Walt Disney Co.*, U.S.D.C., C.D.Ill. Case No. No. 03-1334 (Oct. 2003), available at [www.ilcd.uscourts.gov/search/McDade/catdisneytroord.pdf](http://www.ilcd.uscourts.gov/search/McDade/catdisneytroord.pdf) [ELR 25:6:8]

**Washington Redskins' win reinstatement of federal trademark registrations; court rules that cancellation proceeding was filed too late and that evidence did not support Trademark Board's finding that football team's "Redskins" marks disparage Native Americans**

The Washington Redskins can breathe a little easier, now that a federal judge has reinstated the registrations for the team's "Redskins" trademarks.

Redskins fans (and longtime readers of these pages) may recall that in 1999, the U.S. Trademark Trial and Appeal Board canceled the team's trademarks, on the grounds that the word "Redskins" may disparage Native Americans (ELR 21:1:10). The Trademark Board did so in response to a petition filed by seven Native Americans who relied on section 2(a) of the Trademark Act which provides that a mark should not be registered if it "Consists of or comprises . . . matter which may disparage . . . persons, living or dead. . . ."

The Redskins of course denied that their use of the word "Redskins" is disparaging. In fact, the team - which began business as the "Braves" - was renamed the "Redskins" in 1933, by its then-owner George Preston Marshall, in honor of the team's head coach, William "Lone Star" Dietz, who was himself a Native American. And the Redskins argued to the Board,



unsuccessfully, that its name “reflected positive attributes of the American Indian such as dedication, courage and pride.”

After losing before the Trademark Board, the Redskins filed suit in federal District Court in Washington, D.C., seeking a court order overturning the Board’s decision. In response to cross-motions for summary judgment, Judge Colleen Kollar-Kotelly has ruled in favor of the Redskins, on two grounds.

The judge ruled first that the evidence before the Board simply didn’t prove that the word “Redskins” - especially as used in connection with Washington’s NFL football team - was disparaging to a “substantial composite of Native Americans.” The Board had relied on a survey conducted by those who sought cancellation of the marks. However, Judge Kollar-Kotelly found the survey to be flawed for two reasons.

First, the survey asked participants their views

about the word “redskins” as used to describe Native Americans, but did not ask what they thought of the word as used in connection with a professional football team. The only relevant question was whether the Redskins’ use of the word was disparaging, and the survey didn’t answer that question.

Second, the survey asked participants their views as of the date the survey was conducted in 1996, while the relevant dates for cancellation proceedings were the dates the marks were registered. The Redskins had registered their marks between 1967 and 1990, and the survey did not even attempt to determine whether the marks were disparaging at those times.

The judge added that even if the survey results were relevant, they didn’t prove that a “substantial composite of Native Americans” viewed “redskins” as being disparaging. The survey showed that 36.6% of those Native Americans polled thought the term was

disparaging. But the judge said that the evidence did not support the Board's decision to extrapolate those results to the Native American population as a whole. What's more, the judge disagreed with the Board's conclusion that 36.6% amounted to a "substantial composite."

While these grounds would have been sufficient to reverse the Board's decision to cancel the Redskins trademark registration, Judge Kollar-Kotelly added an "alternative" ground as well. Early in the case, back in 1994, the Redskins asked the Board to dismiss the case on the grounds that the petitioners had waited too long to seek cancellation of the team's marks, and therefore their claim was barred by the doctrine of laches. The motion was based on the fact that the team began using its "Redskins" name almost 60 years before the cancellation petition was filed, and had begun registering its marks a full 25 years before the petition

was filed. Indeed, one of the petitioners' witnesses testified that he personally began complaining to the team about its "Redskins" name 20 years before the petition was filed.

The Board denied the Redskins' motion (ELR 16:5:29). But Judge Kollar-Kotelly ruled that it shouldn't have. She explained: "The best time to resolve this case was 1967 or shortly thereafter [when the Redskins registered its first mark]. The net result of the delay is that there is no direct or circumstantial evidence in the record that, at the times the trademarks were registered, the trademarks at issue were disparaging; even though the Native Americans contend that during this entire time period the trademarks were disparaging."

Those who sought cancellation didn't dispute that they had waited a long time to file their petition. The judge found that they had both constructive notice

(as a result of the registrations) and actual notice of the Redskins use of its marks. Finally, the judge found that the Redskins suffered prejudice as a result of the delay. “In 1967, the NFL was still a nascent industry,” the judge observed. “Had this suit been brought at that point, [the Redskins] may have acquiesced and changed the name. The twenty-five year delay, where [the Redskins] has invested so heavily in the marks, has clearly resulted in economic prejudice.”

Since the record showed both undue delay and economic prejudice, the judge ruled that the Redskins also were entitled to judgment on its laches defense.

Editor’s Note: Judge Kollar-Kotelly was well aware that this case is just one battle in a larger, ongoing war over the use of Native American names and symbols by sports teams and others. It is an issue that has generated other cases (ELR 15:7:19, 23:5:19, 24:5:17), and several law review articles. It was not,

however, an issue that Judge Kollar-Kotelly needed to grapple with, and she didn't. "This opinion should not be read as a making any statement on the appropriateness of Native American imagery for team names," she wrote. Instead, she based her decision solely on the failure of those who sought cancellation of the Redskins' marks to provide the Board sufficient evidence to meet their burden of proof, and on their delay in attempting to do so.

*Pro-Football, Inc. v. Harjo*, U.S.D.C., D.D.C. Civ. No. 99-1385 (CKK) (Sep. 2003), available at [www.dcd.uscourts.gov/99-1385a.pdf](http://www.dcd.uscourts.gov/99-1385a.pdf) [ELR 25:6:8]

**WASHINGTON MONITOR**

**Four-letter exclamation uttered by Bono during broadcast of 2003 Golden Globe Awards was not indecent or obscene, FCC determines; but in separate matters, FCC fines Infinity Broadcasting \$357,500 for indecent “Opie and Anthony Show” radio broadcast of “Sex for Sam” contest, and fines AMFM Radio \$55,000 for indecent “Elliot in the Morning” broadcasts of interviews about sex with Catholic high school students**

The First Amendment protects free speech, but not absolutely. The Supreme Court has drawn a line that allows the punishment of obscene speech. And federal appellate courts have drawn another line that allows the punishment of indecent speech by broadcasters between 6 a.m. and 10 p.m. So it was that

last month (October 2003), the FCC was called upon to respond to three separate complaints about broadcasts which some in the audience thought were indecent and obscene.

In a trio of rulings, the Chief of the FCC's Enforcement Bureau determined that a four-letter exclamation uttered by Bono during NBC's broadcast of the 2003 Golden Globe Awards was not indecent or obscene, and thus the FCC denied a complaint about the show filed by the Parents Television Council. But the Commissioners of the FCC determined that an "Opie and Anthony Show" radio broadcast of a "Sex for Sam" contest was indecent, and thus the Commission proposed to fine Infinity Broadcasting \$357,500. The Commissioners also determined that an "Elliot in the Morning" radio broadcast of interviews about sex with Catholic high school students was indecent, so the FCC proposed to fine AMFM Radio,



the owner of the station that carried the broadcasts, \$55,000.

Federal statutory law prohibits radio and television stations from broadcasting “any obscene, indecent or profane language.” FCC rules trim back that seemingly complete ban by prohibiting radio and television stations from broadcasting “indecent” material only from 6 a.m. to 10 p.m., in response to a Court of Appeals decision that held that a 24-hour a day ban on “indecent” material was unconstitutional (ELR 13:10:7). The constitutionality of the 6 a.m. to 10 p.m. ban was upheld (ELR 17:7:9). And all three offending broadcasts ruled on by the FCC last month were broadcast during those hours.

The Commission defines “indecent” speech - the kind that may not be broadcast between 6 a.m. and 10 p.m. - as language (1) that describes sexual or excretory activities or organs (2) in terms patently offensive as

measured by contemporary community standards for the broadcast medium.

*Bono/Golden Globes*

During NBC's broadcast of the 2003 Golden Globe Awards, Bono said "this is really, really, fucking brilliant," or "this is fucking great" - the FCC wasn't sure which. The Chief of the FCC's Enforcement Bureau, David H. Solomon, rejected the argument of the Parents Television Council that Bono's exclamation was obscene or indecent. "The word 'fucking' may be crude and offensive," Solomon acknowledged. But, he added, "in the context presented here, [it] did not describe sexual or excretory organs or activities. Rather, the performer used the word 'fucking' as an adjective or expletive to emphasize an exclamation."

As a result, Bono's exclamation was not

“indecent,” let alone “obscene.” And Solomon denied the complaint for that reason.

*Opie and Anthony/Sex for Sam*

In August 2002, the hosts of the “Opie & Anthony Show” held a “Sex for Sam” contest in which participants had sex in “risky locations” in New York City, including St. Patrick’s Cathedral, a zoo, Rockefeller Center, the Disney Store, and the FAO Schwarz toy store. The contest was a competition among five couples who earned points by having sex in as many of those places as possible. Each couple was accompanied by a station “spotter,” who assigned his couple points based upon the nature of the location and the activities in which the couple engaged. The show aired the contest for at least an hour, during which the hosts and the “spotters” engaged in descriptions and

discussions of the sexual activities of the five couples in publicly visible locations. One of the couples engaged in actual or simulated sex inside St. Patrick's Cathedral while the program hosts and "spotter" discussed their activity on the air - thereby triggering a complaint to the FCC from the Catholic League for Religious and Civil Rights.

Even Infinity's management was not amused by the show. It advised the FCC that the offending broadcast was "fundamentally unacceptable" and contrary to its own programming standards. And Infinity assured the FCC that as a result of the broadcast, it cancelled the "Opie & Anthony Show" suspended those responsible for the broadcast of the "Sex for Sam" contest. That, however, was not enough to get the company off the hook.

The FCC found that "those reporting over the air on the broadcast contest made graphic and explicit

references to sexual and excretory organs and activity.” And it ruled that the “sexual discussions and references were more than sufficiently dwelled upon and repeated to constitute patently offensive material as measured by contemporary standards for the broadcast medium,” especially because the show “set out to shock listeners to an even greater degree by imposing sexual conduct on unsuspecting people who were otherwise going about their business.” This meant that the show was “indecent” - though the FCC ruled that it was not “obscene.”

Federal statute authorizes the FCC to impose a fine of as much as \$27,500 of each violation, and under the circumstances, the Commission decided to fine Infinity that amount for each of the 13 stations that carried the broadcast - a total of \$357,500. Technically, the FCC’s ruling resulted in a Notice of Apparent Liability, to which Infinity may respond by filing a

statement seeking a reduction or cancellation of the fine. However, two of the Commissioners filed separate statements of their own, saying the proposed fine was too little, and a third Commissioner filed a separate statement reminding Infinity that the FCC could have treated each indecent statement within the broadcast as a separate violation subject to its own \$27,500 penalty.

### *Elliot in the Morning/student interviews*

In May 2002, WWDC-FM in Washington, D.C., broadcast an “Elliot in the Morning” show that featured an interview with two Catholic high school girls who had called the station seeking an opportunity to audition to be dancers in a cage at an upcoming rock music concert. The two girls engaged in sexual banter with the program hosts who asked the girls whether they were “kind of like an exhibitionist,” “flash[ed]

from time to time,” did occasional “little show[s] at parties” with their “boobies out,” “at school lined like two or three guys up against the lockers,” and had sexual encounters in the school’s stairwells and closets. As a consequence of the broadcast, the two girls were immediately suspended by their high school, and the following day, the hosts of “Elliot in the Morning” interviewed the girls’ classmates, again making repeated references to oral sex.

These broadcasts drew a complaint from the school’s assistant principal and 73 of its students. The FCC concluded that “the comments made by the program hosts during the broadcasts contained graphic and explicit references to sexual activities, including repeated references to ‘blow jobs.’” What’s more, “By goading these teenagers to discuss their sexual activities in a titillating and offensive manner, the program hosts set out to pander and to shock listeners,”

and for this reason, the FCC found that the “broadcasts were patently offensive as measured by contemporary community standards for the broadcast medium.”

As a result, the FCC fined WWDC-FM’s owner, AMFM Radio, \$27,500 for each day’s broadcast - a total of \$55,000. This fine too was technically a Notice of Apparent Liability, to which AMFM Radio may respond by filing a statement seeking a reduction or cancellation of the fine. But again, three Commissioners filed separate statements saying the fine was too little and could have been greater.

*In the Matter of Complaints against Various Broadcast Licensees regarding their Airing of the “Golden Globe Awards” Program*, FCC 03-3035 (Oct. 2003), available at [http://hraunfoss.fcc.gov/edocs\\_public/attachmatch/DA-03-3045A1.pdf](http://hraunfoss.fcc.gov/edocs_public/attachmatch/DA-03-3045A1.pdf); *In the Matter of Infinity Broadcasting*, FCC 03-234 (Oct. 2003), available at



[http://hraunfoss.fcc.gov/edocs\\_public/attachmatch/FCC-03-234A1.pdf](http://hraunfoss.fcc.gov/edocs_public/attachmatch/FCC-03-234A1.pdf); In the Matter of AMFM Radio Licenses LLC, FCC 03-233 (Oct. 2003), available at [http://hraunfoss.fcc.gov/edocs\\_public/attachmatch/FCC-03-233A1.pdf](http://hraunfoss.fcc.gov/edocs_public/attachmatch/FCC-03-233A1.pdf) [ELR 25:6:10]

## **INTERNATIONAL DEVELOPMENTS**

**Seller of computer chips that permitted Australians to play imported games on modified PlayStation consoles violated Australian Copyright Act's ban on "circumvention" devices, Australian appellate court decides**

A fellow in Australia named Eddy Stevens used to sell computer chips that enabled his customers to play imported games on PlayStation consoles they had

purchased in Australia. The imported games - which Stevens also sold - all were authentic games. No one suggested that Stevens sold counterfeits. But the imported games were designed by Sony to be used only on consoles sold elsewhere in the world, not on Australian consoles.

The design feature that distinguishes games intended for sale in Australia from those intended for sale elsewhere is an “access code.” PlayStation games contain access codes that differ from country to country. As designed by Sony, PlayStation consoles play only those games that have the proper access code for the country where the console was sold. However, the chips sold and installed by Stevens permitted Australian consoles to play games imported from elsewhere - games that did not have Australian access codes, and so would not have played on his customers’ consoles, if Stevens had not installed those chips.

One purpose of Sony's regional access codes is to ensure that its consoles can only play PlayStation games lawfully acquired in Australia (or Europe). The codes are, in other words, a technique for implementing Sony's world-wide marketing strategy. The codes have the effect of preventing Australians from importing games from other countries where they are less expensive than in Australia. Access codes also help to prevent piracy, because games that are copied without authorization usually do not have access codes at all, and thus they can't be played on consoles either.

Sony sued Stevens in Federal Court in Australia, and won. The trial court ruled that Stevens had infringed Sony's trademarks by selling imported games (ELR 24:6:7). But the trial court rejected Sony's argument on an important copyright issue, and so Sony appealed. That issue was whether Stevens' chips were devices used to circumvent technological protection

measures. If they were, then in addition to infringing Sony's trademark, Stevens also violated the anti-circumvention provisions of the Australian Copyright Act.

The trial court decided that Sony's access codes were not "technological protection measures," because they didn't prevent games from being copied. They simply made them unplayable. But playing games - even copied games - does not infringe Australian copyright.

That ruling has now been reversed by an Australian appellate court. In a very lengthy opinion, Judges Robert Shenton French, Kevin Edmund Lindgren, and Raymond Antony Finkelstein unanimously held that Sony's access codes are "technological protection measures," and thus Stevens' chips are prohibited circumvention devices.

The opinion is unusually lengthy for three

reasons. First, the question of whether access codes are technological protection measures required a detailed exploration of the legislative history of Australia's anti-circumvention provision, as well as an almost philosophical analysis of the techniques of statutory interpretation.

Second, Sony also argued that the copyrights to its games were infringed when they were played on consoles modified by Stevens, because the games were copied into the consoles' RAM while they were being played. The trial court rejected this argument, and Judges French and Lindgren affirmed that ruling. Judge Finkelstein sided with Sony on this issue.

Finally, since the judges did not agree with one another on the second question, each wrote his own decision about the entire case.

In any event, Sony is now clearly the winner in this case. The appellate court entered a declaration in

Sony's favor, an injunction against Stevens, and remanded the case to the trial court for further proceedings on damages.

Sony was represented by D.K. Catterns QC and R. Cobden, and Solicitors Blake Dawson Waldron. Stevens was represented by J. Nicholas SC and C. Dimitriadis, and Solicitors Gadens Lawyers. The Australian Competition and Consumer Commission (which intervened in the case on behalf of Stevens) was represented by M. Walton SC and M.S. White, and the Australian Government Solicitor.

*Kabushiki Kaisha Sony Computer Entertainment v. Stevens*, [2003] FCAFC 157, available at [www.austlii.edu.au/au/cases/cth/FCAFC/2003/157.htm](http://www.austlii.edu.au/au/cases/cth/FCAFC/2003/157.htm)  
1 [ELR 25:6:12]

**NEW LEGISLATION AND REGULATIONS**

**New California statutes make it a crime to record movies in theaters without theater owner's consent, and amend Coogan Law protecting earnings of child actors**

The State of California has enacted two new statutes for the protection of the entertainment industry and those who work in it. One makes it a crime to record a movie in a theater, without the theater owner's consent. The other amends the state's "Coogan Law" - a law designed to protect the earnings of child actors.

*Unauthorized movie recording*

The bill that became the statute making it a crime to record a movie in a theater was introduced by

Senator Kevin Murray. It adds a new section to the California Penal Code - section 653z - that makes it a “public offense” to operate a recording device in a movie theater, while a movie is being exhibited, for the purpose of recording the movie, without the written authority of the movie theater’s owner. The offense is punishable by imprisonment for as long as one year in county jail and a fine of as much as \$2,500.

The new law supplements an existing law that makes it a misdemeanor to refuse to stop operating a recording device in a movie theater “upon the request of the theater owner.”

These statutes became necessary, because many digital video recorders are now no bigger than paperback books, and can easily be smuggled into theaters. What’s worse, videos made by audience members are one of the sources of pirated movies now being circulated on the Internet.



*Coogan Law amendment*

The bill that amended California's Coogan Law was introduced by Senator John Burton. The Coogan Law was first enacted in 1939, after actor Jackie Coogan - for whom the law was named - found, when he became an adult, that his parents had spent the money he had earned as a child actor. Senator Burton's bill amends California Family Code sections 6750, 6752 and 6753, and California Labor Code 1308.9, in ways that are intended to enhance the Coogan Law's protection of performers who are minors.

The new law requires the parents of child performers to establish trust accounts for their children - to be known as "Coogan Trust Accounts." Employers of child performers are required to set aside and deposit 15% of their gross earnings into those accounts.

The statute contains detailed provisions

concerning the creation of the accounts, and the manner in which parents are supposed to notify their children's employers about the financial institutions in which the trust accounts have been established. The statute also provides that if employers do not receive this notification within a specified time, they are to send the set-aside funds to the Actors' Fund of America, a nonprofit organization with offices in Los Angeles, New York and Chicago. The Actors' Fund then has the obligation to locate performers' parents, notify them of their obligation to establish Coogan Trust Accounts, and then deposit the set-aside funds in those accounts.

Under existing California law, the California Labor Commissioner must issue a permit authorizing the employment of minors in the entertainment industry. The new law requires the application for a permit to show that a Coogan Trust Account has been established; if it doesn't, the permit becomes void after

10 days.

The Coogan Law applies to child performers of all types. It covers dancers, musicians, comedians, singers, stunt-persons, voice-over artists, songwriters, arrangers, writers, directors, choreographers, composers, conductors, designers and athletes, as well as actors. It even covers producers and “production executive[s].” It also covers children who sell or license literary, musical or dramatic properties, or life story rights, or the use of their likenesses or voice recordings.

*Unauthorized movie recording*, Cal. S.B. 1032 (Oct. 2003), available at [www.leginfo.ca.gov/pub/bill/sen/sb\\_1001-1050/sb\\_1032\\_bill\\_20031003\\_chaptered.pdf](http://www.leginfo.ca.gov/pub/bill/sen/sb_1001-1050/sb_1032_bill_20031003_chaptered.pdf); *Coogan Law amendment*, Cal. S.B. 210 (Oct. 2003), available at [www.leginfo.ca.gov/pub/bill/sen/sb\\_0201-0250/sb\\_210\\_bill\\_20031003\\_chaptered.pdf](http://www.leginfo.ca.gov/pub/bill/sen/sb_0201-0250/sb_210_bill_20031003_chaptered.pdf) [ELR 25:6:13]

**RECENT CASES**

**License agreement between Scholastic Entertainment and Fox authorized Fox to show “Goosebumps” on Fox Family Channel as well as on Fox Children’s Network, California trial court determines; in separate decision, federal appeals court agrees that case should be heard in state court rather than federal court, because dispute did not arise under Copyright Act**

Many years ago, Scholastic Entertainment and Fox Broadcasting entered into a contract pursuant to which Scholastic agreed to produce the television series “Goosebumps” and Fox agreed to broadcast the series and then distribute it to others. For a long time, the two companies performed the contract without dispute. Eventually, however, a serious disagreement arose

between them.

The disagreement arose out of what Scholastic alleged was Fox's underpayment of \$2.7 million in licensing fees, due, Scholastic claimed, as a result of Fox's showing of "Goosebumps" on the Fox Family Channel. The contract was an exhibition and distribution license, and it distinguished between "exhibitions" for which Fox would owe no additional licensing fees and "distributions" for which it would.

According to Scholastic, the license agreement authorized Fox to "exhibit" the series on the Fox Children's Network, but not on the Fox Family Channel. As a result, when "Goosebumps" was shown on the Fox Family Channel, Scholastic characterized the showing as a "distribution" that entitled it to a distribution fee. Fox interpreted the license agreement to authorize it to show the series on any Fox-related broadcast or cable outlet - including the Fox Family

Channel - after its initial showing on the Fox Children's Network, without the payment of additional license fees.

This disagreement degenerated into litigation in both state and federal courts in Los Angeles - litigation that Fox has ultimately won. Following a week-long trial, California Superior Court Judge Jane Johnson ruled that Scholastic had the burden of proving that when it entered into the license agreement with Fox, both of them mutually intended to limit exhibition of the series to its broadcast "only on" Fox Children's Network; and she ruled that Scholastic failed to prove that both of them "intended such a limitation."

Indeed, Judge Johnson interpreted the license to permit Fox to "exhibit" the series on all forms of television, including on the Fox Family Channel. If Scholastic had intended to limit Fox's exhibition rights to the Fox Children's Network only, it "could have

been handled in a straightforward manner, simply with the insertion of the words ‘on [Fox Children’s Network] only’ following the word ‘exhibit’ . . . ,” the judge reasoned.

The agreement, which is quoted at some length in Judge Johnson’s opinion, contained two provisions that went to the heart of the dispute. Fox relied on a provision that gave it the right to exhibit “Goosebumps” in “all media utilizing . . . television. . . .” Scholastic relied on a provision that gave the Fox Children’s Network the “exclusive” right to exhibit the series.

According to Scholastic, the grant of “exclusive” exhibition rights to Fox Children’s Network meant that no exhibition rights were granted to the Fox Family Channel. But Fox argued that the word “exclusive” simply meant that as between Scholastic and Fox Children’s Network, it was Fox Children’s Network

that would control the right to exhibit the series during the term of the agreement. Judge Johnson agreed with Fox. She did so, in part, because Scholastic's interpretation was incompatible with certain other provisions of the agreement, including, especially, the provision that gave Fox and its related entities - not simply its Children's Network - the right to "exhibit" the series.

As a result, Judge Johnson entered judgment in favor of Fox.

Though Fox ultimately prevailed in state court, Scholastic filed the case originally in federal court, where Fox went to some lengths to keep it, or at least part of it, without success.

At the beginning of their dispute, Scholastic sent Fox a letter that purported to terminate their agreement and that advised Fox that Scholastic planned to re-license "Goosebumps" to other companies. Fox



responded that Scholastic didn't have the right to do either. That prompted Scholastic to sue Fox in federal District Court for declaratory relief, as well as for copyright infringement based on Fox's post-termination use of the series. Fox counterclaimed for an injunction prohibiting Scholastic from re-licensing the series to others.

The District Court dismissed Scholastic's claims, on the grounds that the underlying dispute over whether Scholastic had grounds to terminate the agreement involved state contract law. Then, the District Court dismissed Fox's counterclaim too, again on the grounds that this was "simply" a "contract case . . . and the State Court can decide it."

Scholastic didn't appeal, but Fox did. That was the posture of the case when it got to the Court of Appeals. In an opinion by Judge Michael Daly Hawkins, the Court of Appeals agreed that the case

should be litigated in state court, because it involved a dispute over contract issues only, not copyright issues. Judge Hawkins emphasized that his court's decision involved only the issue of whether Fox's counterclaim "arose under" federal copyright law.

Judge Hawkins began by quoting Nimmer on Copyright for the proposition that whether "a case involving interdependent copyright and contract claims 'arises under' the federal copyright laws" is "one of the 'knottiest problems in copyright jurisprudence.'" After canvassing earlier cases that wrestled with this issue, Judge Hawkins concluded that Fox's counterclaim did not arise under copyright law. Instead, the judge said, "Scholastic's success in terminating the agreement is a pure question of state contract law appropriate for adjudication in the California courts." For that reason, Judge Hawkins concluded that the District Court had properly dismissed the case, because it lacked subject

matter jurisdiction to hear it.

Scholastic Entertainment was represented by Michael Bergman, David L. Burg and Anjani Mandavia of Weissman Wolff Bergman Coleman Grodin & Evall in Beverly Hills. Fox was represented by Robert C. Welsh of O'Melveny & Myers in Los Angeles, and by Jack D. Samuels of Fox Family Worldwide in Los Angeles.

Editor's note: The decision by California Superior Court Judge Johnson, though well-reasoned and instructive, is not precedential, even in California, because it is a trial court decision; California trial court decisions are not even published. The federal Court of Appeals decision by Judge Hawkins is precedential, at least in the Ninth Circuit, though it may not be useful in very many future cases, because it arose in an unusual procedural posture: Fox, the licensee and alleged infringer, wanted to keep the case in federal court,

while Scholastic, the licensor and copyright owner, was satisfied to litigate in state court. More often, copyright owners terminate licenses (or purport to) and then sue their former licensees for post-termination infringement (just as Scholastic originally did in this case). If Scholastic (rather than Fox) had appealed the District Court's dismissal of its case, it looks as though the result on appeal would have been different. Under those circumstances, it is likely that Judge Hawkins would have held that the case did "arise under federal copyright law" so the federal District Court would have had jurisdiction to hear it. This is so, because something similar occurred in *Vestron v. Home Box Office* (ELR 9:12:7). In that case, the Court of Appeals held that Vestron's claim that HBO infringed Vestron's copyrights in "Hoosiers" and "Platoon" arose under the Copyright Act, even though Vestron's claimed ownership of those copyrights was based on a disputed

contract. The Vestron case was distinguished by Judge Hawkins in his decision in this case.

*Scholastic Entertainment, Inc. v. Fox Entertainment Group*, California Superior Court, Case No. BC247349 (June 2003), available at [www.EntertainmentLawReporter.com/decision/250612.pdf](http://www.EntertainmentLawReporter.com/decision/250612.pdf); *Scholastic Entertainment, Inc. v. Fox Entertainment Group, Inc.*, 336 F.3d 982, 2003 U.S.App.LEXIS 14445 (9th Cir. 2003) [ELR 25:6:14]

**NHL player Tony Twist wins new trial in right of publicity lawsuit against publisher of comic book “Spawn” that featured villainous character named “Tony Twist,” because comic book is not protected by First Amendment and Twist’s name may have been used to obtain commercial advantage, Missouri Supreme Court holds**

In a lawsuit whose ebb and flow mirrors that of some hockey games, former NHL player Tony Twist has won the right to a new trial on his right of publicity claim against the publisher of the comic book “Spawn.”

The first trial ended with a resounding, even stunning, victory for Twist: a jury awarded him a verdict of \$24.5 million, because the comic book featured a “villainous” character named “Tony Twist,” without the hockey player’s consent. Though there were no physical similarities between the real Twist

and the comic book Twist, both of them had tough-guy personas, and the comic book's publisher acknowledged that the fictional Twist was named after the real Twist.

Twist's victory was short-lived, however. The trial judge set aside the jury's verdict and entered judgment in favor of the comic book publisher. The judge did so on the grounds that Twist had failed to prove that the comic book publisher had used his name for "commercial advantage" - an essential element of a right of publicity claim in Missouri.

The case has taken another turn, however, back in Twist's favor. In an opinion by Judge Stephen Limbaugh, the Missouri Supreme Court has reversed the judgment in favor of the publisher and has ordered a retrial of the case. Judge Limbaugh agreed with Twist that the evidence was sufficient to show that the publisher used Twist's name to attract consumers'

attention to “Spawn” and related products. That is, the evidence showed that the publisher made statements that created the impression that Twist was somehow associated with the comic book; and the publisher marketed products directly to hockey fans.

The only reason the Supreme Court ordered a retrial, rather than a judgment in Twist’s favor, is that under Missouri law, Twist had to prove the publisher intended to obtain a commercial advantage. If commercial advantage was obtained merely incidentally, that is not enough to prove a violation of the right of publicity. In this case, the publisher testified that he had reasons other than commercial advantage for using Twist’s name. And the jury had not been instructed to determine what the publisher’s actual intent was.

The publisher also asserted that its comic book was protected by the First Amendment, and thus the



judgment in its favor was proper for that reason too. Judge Limbaugh disagreed, however. He found that the “predominant” reason Twist’s name had been used was to sell comic books and related products, and “under these circumstances,” the judge ruled, “free speech must give way to the right of publicity.”

Tony Twist was represented by John E. Bardgett, Sr., of Blitz Bardgett & Deutsch in St. Louis. The comic book publisher was represented by Michael A. Kahn of Blackwell Sanders Peper Martin in St. Louis.

Editor’s note: If this case had been litigated in California, the comic book publisher may well have prevailed, based on its First Amendment defense. In a strikingly similar case, the California Supreme Court recently held that the First Amendment overcame a right of publicity claim by recording artists Johnny and Edgar Winter against a comic book publisher (ELR 25:3:9). Judge Limbaugh declined to follow the

California Supreme Court's decision in the Winter case, because he concluded there was a "weakness" in that decision's test - the so-called "transformative" test - for determining when the First Amendment applies. Instead, Judge Limbaugh concluded that the "predominant use" test is a "better" one. This means there are now three different tests for determining whether the First Amendment defeats right of publicity claims: the Missouri "predominant use" test; the California "transformative" test; and the Restatement of Unfair Competition's "relatedness" test. Schuyler Moore explores this split of opinion in his article "Sex, Lies, and Videotape" in the Legal Affairs section of this issue (ELR 25:6:4).

*Doe v. TCI Cablevision*, 110 S.W.3d 363, 2003 Mo.LEXIS 119 (Mo. 2003) [ELR 25:6:15]

**Archie Comics owns copyrights to “Josie,” “Sabrina” and “Cheryl Blossom,” rather than artist Daniel DeCarlo, because they were works made for hire or DeCarlo assigned their copyrights to Archie, federal District Court rules**

Archie Comics has prevailed in litigation with the estate of artist Daniel DeCarlo concerning ownership of the copyrights to the “Josie,” “Sabrina” and “Cheryl Blossom” comic book characters that DeCarlo once drew. In response to Archie’s motion for summary judgment, federal District Judge Lewis Kaplan has ruled that all of the characters either were drawn by DeCarlo as works made for hire, or DeCarlo assigned their copyrights to Archie.

In reaching this conclusion, Judge Kaplan’s task was complicated by three facts. First, the case involved three different sets of comic book characters, created at

different times under different circumstances. Second, DeCarlo drew some of the characters before 1978 and some after. This was significant, because the definition of a “work made for hire” changed in 1978, when the current Copyright Act took effect. Third, over the many years DeCarlo drew the characters, he signed several different agreements and check endorsements containing copyright ownership provisions, not all of which could be found by the time Archie’s motion for summary judgment was made.

Judge Kaplan’s decision with respect to the “Josie” characters involved procedural rather than copyright issues, because those characters had been the subject of a separately-filed case in which he already had ruled in favor of Archie, on statute of limitations and equitable estoppel grounds. That ruling was affirmed on appeal (ELR 23:1:15, 23:9:24) and is final. Evidence that was used in the newly-decided case

involving “Sabrina” and “Cheryl Blossom” allowed DeCarlo to argue that Judge Kaplan should reconsider his conclusions with respect to “Josie.” But the judge held that he would not, because the judgment in the earlier case had become final, and in any event, DeCarlo did not show why he hadn’t used that evidence in the “Josie” case.

The “Sabrina” characters raised the most significant issues in the case. DeCarlo drew some of those characters before 1978, when the law provided that works made for hire were those created at the “instance and expense” of the hiring party. The evidence showed that Archie had “induced” the creation of “Sabrina,” had retained artistic control over anything DeCarlo submitted, and had paid DeCarlo for his contributions. This meant that the “Sabrina” characters were works made for hire, unless DeCarlo showed that he and Archie had agreed that DeCarlo

would own their copyrights.

DeCarlo claimed that check endorsements proved just that, but the only checks he could find were those he had signed after 1978, and even he acknowledged that the endorsements on those were “similar” - but not necessarily identical - to the pre-1978 endorsements. In any event, Judge Kaplan held that even if the post-1978 endorsements were identical to the older ones, the language of the post-1978 endorsements did not show that Archie had agreed that DeCarlo retained ownership of the copyrights to the works for which the checks were issued. Instead, the endorsements simply provided that DeCarlo acknowledged Archie’s ownership of those copyrights; they didn’t even constitute an assignment of them by DeCarlo to Archie. Thus, DeCarlo could not prove that Archie had agreed he owned the copyrights to the pre-1978 characters, and that in turn meant that Archie

owns them.

The post-1978 “Sabrina” characters were covered by written agreements signed by DeCarlo in 1988 and 1996. In those agreements, DeCarlo assigned whatever existing copyrights he may have owned to Archie, and they provided that new works would be works made for hire. This meant that Archie owns those copyrights too, the judge ruled.

The “Cheryl Blossom” characters also were covered by the 1988 and 1996 agreements by which DeCarlo assigned whatever copyright he may have had to Archie, so Archie owns those as well.

The judge also declared that termination notices that had been sent by DeCarlo to Archie were null and void. These notices sought to terminate what DeCarlo said were his assignments of copyrights to Archie. But those assignments didn’t take place until 1988 and 1996, and are not eligible to be terminated until 35

years from those dates. As a result the termination notices were “premature,” the judge said.

Archie Comics was represented by Leora Herrmann of Grimes & Battersby. DeCarlo’s estate was represented by Whitney North Seymour, Jr., of Landy & Seymour.

*Archie Comic Publications, Inc. v. DeCarlo*, 258 F.Supp.2d 315, 2003 U.S.Dist.LEXIS 6678 (S.D.N.Y. 2003) [ELR 25:6:16]

**Dismissal of infringement suit filed against DC Comics by reader who submitted story idea for Superman comic books is affirmed, because story was unauthorized derivative work and thus not protected by copyright**

Marcel Walker is a comic book reader, as well as



a creative thinker in his own right. In 1997, Walker had an idea for DC Comics' "Elseworlds" series - a series that features the company's familiar heroes, including Superman, in unfamiliar settings and plots. Walker's idea, which he entitled "Superman: The Last Son of Earth," reversed the sequence of the Superman story and had Superman born on Earth and then sent to Krypton.

Walker sent a one-page version of his story to DC Comics, and three years later, DC Comics published a two-part "Elseworlds" comic book series entitled "Superman: Last Son of Earth" about a Superman born on Earth and sent to Krypton.

A coincidence? Walker thought not, even though the details of the two works were "substantially different." In fact, Walker sued DC Comics for copyright infringement. He wasn't, however, successful. A federal District Court granted DC

Comics' motion for summary judgment. And a Court of Appeals has affirmed, in an opinion marked "Not Precedential."

Writing for the appellate court, Judge Edward Becker held that Walker's story was not protected by copyright, because it was an unauthorized derivative work, based on earlier Superman stories. Walker acknowledged that his story was a derivative work, but argued that it was protected by copyright nonetheless, for three reasons.

First, Walker said that DC Comics gave him permission to use its Superman to create a new work. Indeed, DC Comics did have "Submission Guidelines" for unsolicited submissions. But those guidelines were issued in 1998, a year after he submitted his work. In any event, Judge Becker ruled, "it is not possible to interpret them as granting a license to create derivative works or authorization to use DC's copyright-protected

material.”

Second, Walker argued that his use of Superman was a fair use, rather than an infringing use. But the judge noted that the fair use doctrine permits certain specified types of uses. And he said that “Walker does not and cannot allege that his submission . . . to DC falls under any of these purposes.”

Finally, Walker argued that he has copyright protection for “whatever original elements he added to the Superman copyright” in his submission. Judge Becker acknowledged that generally, copyright protection is available for elements added to a derivative work. But, the judge added, “if the underlying work is itself protected by copyright, then he will receive no protection at all; on the contrary, he is a copyright infringer, because in order to create his work he has copied the underlying work.”

*Walker v. DC Comics, Inc.*, 67 Fed.Appx. 736, 2003 U.S.App.LEXIS 12307 (3rd Cir. 2003) [ELR 25:6:17]

**Former New York Post journalist established reasonable probability of prevailing against Disney in suit for libel and related claims, based on complaints Disney made to Post about accuracy of journalist's articles about Winnie-the-Pooh litigation that allegedly resulted in journalist being fired**

The Walt Disney Company has been involved in litigation for years over its merchandising rights to the Winnie-the-Pooh characters. The case has been hotly contested, and at one point, resulted in a court order that required Disney to pay \$90,000 in sanctions for attorneys fees and costs incurred by its opponent,

Stephen Slessinger, Inc. The case, in other words, invited press scrutiny, and the New York Post responded by assigning Nikki Finke, its entertainment business reporter, to write about the sanction order and other aspects of the lawsuit.

Now, Finke's articles in the Post have generated litigation of their own. Disney was so displeased with Finke's articles that it contacted the Post to complain about the accuracy of Finke's reporting. The paper asked Disney to put its position in writing, and Disney's president, Robert Iger, did so, in a letter to the Post's editor-in-chief. Shortly thereafter, the Post fired Finke, allegedly telling her "she was being fired because of the Pooh articles."

Finke responded by suing Disney in California state court for libel, slander, infliction of emotional distress, interference with contract relations and economic advantage, and unfair business practices.

California has a statute - called a SLAPP statute - that allows courts to strike causes of action that arise out of acts in furtherance of free speech. Disney asked the court to do just that. The trial court, however, decided that Disney wasn't entitled to the benefits of the SLAPP statute, because all of its complained-of actions weren't done to further the company's right to free speech.

Disney appealed, and technically won on one issue. But Finke won on more important issues, and so her case continues.

In an opinion by Justice Earl Johnson, the California Court of Appeal has held that the SLAPP statute did apply to Finke's suit against Disney, because at least one of its acts - even if not all - was done "in connection with" issues of public interest: the Pooh litigation; and fair, accurate and unbiased news reporting. This part of the appellate court's decision is

likely to benefit other defendants in the future, because it prevents plaintiffs from avoiding the SLAPP statute simply by alleging non-speech acts in combination with speech acts in a single cause of action.

On the other hand, this part of Justice Johnson's opinion did not help Disney dispose of Finke's case entirely, as it had hoped to do. It didn't, because the SLAPP statute permits plaintiffs to proceed, even with claims based on speech, if they are able to establish a reasonable probability that they will succeed. Finke wasn't able to make this showing with respect to her slander and unfair business practices claims. So Justice Johnson ordered the trial court to dismiss those. But, in portions of his opinion that are very helpful to Finke, the Justice also ruled that Finke has established a reasonable probability that she will prevail on her remaining claims.

Iger's letter to the Post accused Finke of

deliberately misrepresenting facts in order to injure the company - accusations which have “a tendency to injure [Finke] in [her] occupation” and thus would be libelous, if not true. Without detailing the evidence that made him think so, Justice Johnson concluded that “Finke has shown a reasonable probability of proving Iger’s allegations [that] she made false statements in her articles are themselves false.”

Disney argued that Iger’s statements were legally privileged, but Justice Johnson concluded otherwise. What’s more, the Justice concluded that Finke is not a public figure, and thus she does not have to show that Disney acted with reckless disregard for the truth in order for her to prevail with her libel claim.

Justice Johnson also concluded that the evidence supporting Finke’s libel claim demonstrated, as well, a reasonable probability that she will prevail on her claim for infliction of emotional distress.



Finally, the justice found that Finke had established a reasonable probability she will prevail on her claim for interference with contractual relations and economic advantage, because she established that she had a valid contract and economic relationship with the Post, that Disney knew this, and that the Post fired Finke after receiving Iger's letter.

Finke was represented by Pierce O'Donnell and Carole E. Handler of O'Donnell & Shaeffer in Los Angeles. Disney was represented by Patricia L. Glasser and Ronald E. Guttman of Christensen Miller Fink Jacobs Glasser Weil & Shapiro in Los Angeles.

*Finke v. Walt Disney Co.*, 2 Cal.Rptr.3d 436, 2003 Cal.App.LEXIS 1138 (Cal.App. 2003) [ELR 25:6:18]

**Cease-and-desist letter sent by Major League Baseball Players Association did not defame parody trading card company Cardtoons or interfere with its contractual relations, federal appellate court affirms**

A lawsuit between the Major League Baseball Players Association and a trading card publisher named Cardtoons has bounced up and down the federal court system for more than a decade. It's been considered from courtrooms of federal magistrate judges to the chambers of the United States Supreme Court and everywhere in between. If the lawsuit were a baseball game, it would be one of the most exciting ever played, because the lead has changed hands at least five times. As a result of the latest ruling, the Players Association has finally won. But since much of the case dealt with a routine cease-and-desist letter, it took a lot of effort to

reach that result.

The lawsuit actually began as an interesting right of publicity lawsuit - one that tested the extent to which parody is a defense to claims based on the unauthorized commercial use of celebrity names and likenesses. The Players Association is the licensing agent for its members. When it learned that Cardtoons intended to publish parody trading cards featuring recognizable caricatures of major league baseball players on the front and humorous comments that ridiculed them on the back, the Players Association sent two cease-and-desist letters asserting that Cardtoons' cards would violate its members' rights under the Lanham Act and state right of publicity law. One of the Players Association's letters was sent to Cardtoons itself, and another was sent to Cardtoons' printer.

The letter to the printer had its intended effect. Even though the Players Association had not sued it,

the printer decided not to print the cards. Cardtoons took a tougher stance; it responded by suing the Players Association for declaratory relief. The Players Association, rather than Cardtoons, took an early lead. A federal magistrate concluded that the cards would have violated the players' rights, and a District Court judge initially adopted that conclusion.

Thereafter, however, the United States Supreme Court decided the "2 Live Crew" parody case (ELR 15:12:18). Though the "2 Live Crew" case involved copyright rather than right of publicity parody, the District Court in the Cardtoons case thought the "2 Live Crew" decision was instructive. The District Court therefore set aside its earlier ruling in favor of the Players Association and instead entered judgment for Cardtoons. Moreover, that ruling was affirmed on appeal (ELR 19:1:7).

Emboldened by its success, Cardtoons returned

to the District Court where it sought to recover damages against the Players Association for two things: for interfering with Cardtoons' contract with its printer; and for defamation on account of the cease-and-desist letters' assertion that Cardtoons would be violating the law by making and selling its cards. However, the District Court held that the Players Association was immune from liability under the First Amendment, because its cease-and-desist letters were sent in connection with contemplated litigation. And that decision was affirmed by a three-judge panel of the 10th Circuit (ELR 21:7:10).

Cardtoons then petitioned the 10th Circuit for a rehearing en banc, where it succeeded once again. Sitting en banc, the Court of Appeals held that those who send cease-and-desist letters may be held liable because private threats of litigation are not immune under the First Amendment, because they do not

involve petitions to the government (ELR 22:2:15). The Supreme Court denied the Players Association's cert petition (ELR 22:4:22). And the case was then remanded to the District Court for further consideration of Cardtoons' interference with contract and libel claims.

However, the District Court once again granted summary judgment to the Players Association, this time on state law rather than First Amendment grounds. And that ruling has now been affirmed by the Court of Appeals (or at least a three-judge panel).

In an opinion by Judge Monroe McKay, the appellate court held that Cardtoons could not show that the Players Association had been malicious or wrongful in sending its cease-and-desist letter, nor could Cardtoons show that the Association was not justified or privileged to send it. This was so, Judge McKay explained, because the Players Association was not

precluded from threatening to protect its members' publicity rights, at a time when it appeared that Cardtoons' cards would violate those rights, even if the Association also sought to prevent the manufacture of cards it thought would be "unflattering." This meant that one of the elements of an interference with contract claim was missing; because under Oklahoma state law, interference must be malicious and without privilege.

Cardtoons' libel claim also failed, Judge McKay ruled, because in order to prevail, Cardtoons had to show that the Players Association was not privileged. Oklahoma law, however, recognizes a privilege granting immunity for relevant statements made in anticipation of litigation. Cardtoons argued that the privilege didn't apply in this case, because the Players Association never sued the printer. But Judge McKay noted that the facts indicated that the Players Association had a good faith belief that litigation was

seriously contemplated. And the judge added, “Requiring potential plaintiffs to bypass the post office on the way to the courtroom would undermine our longstanding policy favoring efforts to avoid litigation.”

Cardtoons was represented by James W. Tilly of Tilly & Fitzgerald in Tulsa. The Major League Baseball Players Association was represented by Russell S. Jones, Jr., of Shughart Thomson & Kilroy in Kansas City.

*Cardtoons v. Major League Baseball Players Association*, 335 F.3d 1161, 2003 U.S.App.LEXIS 14120 (10th Cir. 2003) [ELR 25:6:18]



**Recording artists Chad and Terri Sigafus lose defamation case against St. Louis Post-Dispatch, because they are public figures and did not show actual malice in publication of article reporting they are affiliates of organization of white supremacists and anti-Semites**

Recording artists Chad and Terri Sigafus performed in Branson, Missouri, in February 2000 at a conference called the “Gospel Gathering.” A week later, the St. Louis Post-Dispatch reported on the conference and on the Sigafus’ participation. Ordinarily, performers like their appearances to be reviewed. But the Sigafuses were not pleased with the Post-Dispatch article. Indeed, they were so displeased, they sued the newspaper for defamation.

The “Gospel Gathering” conference was held by an organization called the Christian Identity Movement

- an organization the Post-Dispatch said was “comprised of white supremacists and anti-Semites.” Worse yet, from the Sigafuses’ point of view, the Post-Dispatch listed them as “affiliates” of the Christian Identity Movement. And that is what triggered their defamation lawsuit in Missouri state court.

The lawsuit has not been successful. Even before the trial court determined whether the performers are affiliated with the Christian Identity Movement - an assertion about which “there exists a material issue of fact” - the trial court dismissed their case, in response to the newspaper’s motion for summary judgment. The Missouri Court of Appeals has affirmed

Writing for the appellate court, Judge Sherri Sullivan agreed with the trial court that the Sigafuses are limited purpose public figures, because of their success as recording artists and their ready access to the media.

Because they are public figures, they would have to show that the Post-Dispatch article was false and that the newspaper published it with actual malice, that is, with knowledge it was false or with reckless disregard for whether it was true or false. The Sigafuses say they are not affiliated with the Christian Identity Movement. The Post-Dispatch believes that they are. So the falsity of the article is still in dispute.

But since the Sigafuses did not offer evidence of actual malice on the part of the Post-Dispatch, the case was properly dismissed, Judge Sullivan held. The article did contain one mistake: it attributed the Sigafuses' affiliation to information obtained from the Southern Poverty Law Center, while in fact that information came from others. This mistaken attribution was nothing more than a "mistake," Judge Sullivan said, and negligence is not enough to find actual malice.

The Sigafuses application to the Missouri Supreme Court has been denied.

The Sigafuses were represented by Robert Chase Seibel of Seibel & Eckenrode in Clayton. The Post-Dispatch was represented by Benjamin Alan Lipman of Lew Rice & Fingeresh in St. Louis.

*Sigafus v. St. Louis Post-Dispatch*, 109 S.W.3d 174, 2003 Mo.App.LEXIS 478 (Mo.App. 2003) [ELR 25:6:20]

**Injunction may not be issued to prevent Montana State University's head football coach from doing program for radio station owned by Clear Channel, despite exclusivity clause in coach's contract with competing station, Montana Supreme Court affirms**

Mike Kramer is the head football coach at

Montana State University, and a radio personality too. In January 2001, Kramer signed an employment contract with Reier Broadcasting Company, pursuant to which Kramer agreed to be the announcer and talent on a one-hour “Cat Chat” program aired by Reier weekly during the MSU football season.

Reier Broadcastings owns several stations in Montana, and until 2002, it had the exclusive rights to broadcast MSU athletic events. That’s why Reier’s \$10,000 a year contract with Kramer made perfect sense. Indeed, according to Reier, it entered into a contract with Kramer “at the behest of MSU,” which is what made subsequent developments particularly galling to Reier.

Reier’s contract with Kramer lasted until November 2004. It also contained an exclusivity clause - that is, a clause by which Kramer agreed that he would “not perform on or permit his name to be used in

connection with any other radio . . . station or program.  
. . .”

Reier’s exclusive broadcasting contract with MSU expired during the summer of 2002, more than two years before Reier’s contract with Kramer expired. Instead of simply renewing Reier’s contract, MSU requested bids from other radio stations too, which it had a right to do. But MSU’s written request stated that the successful bidder would have to broadcast a commentary program with Kramer - something that Reier said would violate Kramer’s obligations under the exclusivity clause in its contract with him.

Reier therefore asked MSU to amend its request for bids, but MSU refused. Instead, it disqualified Reier from the bidding and awarded broadcast rights to Clear Channel Communications. MSU also told Kramer that he was expected to provide interviews to Clear Channel, despite the exclusivity clause in his contract

with Reier.

Reier responded by suing Kramer for breach of contract, and sought an injunction that would have prevented the coach from doing interviews or a program for Clear Channel. The trial court granted Reier a temporary restraining order, but subsequently denied its request for a preliminary injunction. Reier appealed, unsuccessfully.

In an opinion by Justice William Leaphart, the Montana Supreme Court upheld the trial court's decision to deny a preliminary injunction. Justice Leaphart noted that a Montana statute prohibits the use of an injunction "to prevent the breach of a contract the performance of which would not be specifically enforced," and another statute provides that personal service contracts "cannot be specifically enforced."

There was no dispute that Reier's agreement with Kramer was a personal service contract. Justice

Leaphart concluded that “the issuance of an injunction, preventing Kramer from working for Clear Channel during the period remaining on his contract with Reier, would result in the indirect specific performance of the Reier-Kramer employment agreement.” As a result, no such injunction could be issued, he held.

On the other hand, Justice Leaphart emphasized that the court did “not hold that the underlying contract was invalid.” The validity of the Reier-Kramer contract is potentially significant, because the Justice added that “The issue of whether Reier has other legal remedies for the alleged breach of contract is not before the Court.”

Justice Patricia Cotter dissented. She would have ruled that an injunction would “not run afoul” of Montana’s statutes. Reier “is not seeking to compel Kramer to perform under the contract,” she said. “It is simply seeking to prevent him from violating the non-



competition provision of the contract - provisions which were specifically bargained for by Kramer, at the encouragement and behest of MSU.”

Reier Broadcasting was represented by John M. Kauffman of Kasting Combs & Kauffman in Bozeman. Kramer was represented by Thomas Roberts of Roberts & Mahoney in Spokane. Montana State University was represented by Leslie C. Taylor of Montana State University in Bozeman.

Editor’s note: The Montana statute is quite similar to California Civil Code section 3423, as it read before 1918 or so. In 1918, the California Supreme Court held that a personal service contract could not be enforced by injunction, for reasons endorsed by the Montana Supreme Court in its decision in this case. The California statute has since been amended to permit injunctions to enforce personal service contracts, under some quite specific circumstances, including

minimum pay guarantees (ELR 15:8:3, 15:9:7). Justice Leaphart noted that the California statute now permits injunctions in some personal service contract cases, but said that the Montana statute is identical to the pre-1918 California statute, so current California practice “is of no consequence here.” Ironically, if Montana’s statutes were identical to California’s current statutes, the result in Reier’s case would have been the same: no injunction would have been issued, because Kramer’s salary did not measure up to the minimum now required by California law for an injunction (in the second and subsequent years of a contract).

*Reier Broadcasting Co. v. Kramer*, 72 P.3d 944, 2003 Mont.LEXIS 244 (Mont. 2003)[ELR 25:6:20]

**Appeals court reinstates jury verdict against Audi, and affirms judgment against advertising agency, in favor of artist/author whose work was copied in television commercial for Audi coupe; evidence supported judgment for some of profits of both, appeals court holds**

Artist and author Brian Andreas has won an \$850,000 judgment against auto-maker Audi and its advertising agency McKinney & Silver, on account of their use of Andreas' work in a television commercial for the Audi TT coupe. The judgment represents 10% of Audi's profits from sales of the coupe during the time the infringing commercial was being shown, an amount that came to \$570,000, plus 50% of the McKinney & Silver's profits for creating the infringing commercial, an amount that came to \$280,000.

Although a jury awarded him these amounts,

Andreas had to go to the Court of Appeals to get his judgment. This was so, because the District Court granted Audi's motion for judgment as a matter of law, a ruling that Andreas had to appeal; and McKinney & Silver appealed the judgment against it. In an opinion by Judge David Hansen, the Court of Appeals held that the District Court should not have granted Audi's motion, so it reinstated the jury's \$570,000 verdict against it. But Judge Hansen ruled that evidence supported the jury's \$270,000 verdict against McKinney & Silver, so it affirmed that part of the judgment.

What's more, Andreas also appealed a District Court ruling that had prevented him from introducing evidence concerning Audi's sales of models other than the TT coupe. But the Court of Appeals ruled against him on that issue.

Andreas' work was a drawing entitled "Angels

of Mercy” accompanied by text that read “Most people don’t know that there are angels whose only job is to make sure you don’t get too comfortable & fall asleep & miss your life.” McKinney & Silver created a commercial for the Audi TT coupe that featured a voice-over that said “I think I just had a wake-up call, and it was disguised as a car, and it was screaming at me not to get too comfortable and fall asleep and miss my life.”

Audi did not dispute the jury’s finding that the commercial infringed Andreas’ copyright. The car company did, however, argue that no connection had been proved between its sales of TT coupes and the infringement. The District Court agreed, but the Court of Appeals did not.

Judge Hansen introduced evidence, which even though circumstantial, was nevertheless enough for the jury to find that the infringing commercial contributed

to Audi's sales. That shifted the burden to Audi to show what effect factors other than the infringement had on its sales. The jury's \$570,000 award was 10% of Audi's after-tax profits from sales of the TT coupe. That meant, Judge Hansen explained, that the jury "found that 90% of Audi's profit was attributable to factors other than the infringement." Thus, the appellate court held that the evidence was sufficient to support the jury's verdict against Audi.

The evidence also was sufficient to support the jury's verdict against McKinney & Silver. It had argued that its total profits were earned by creating three Audi commercials, two of which were not infringing, so the jury should have awarded no more than a third of its profits, rather than half. Judge Hansen, however, noted that the ad agency had not kept time records on its projects, so "the jury was free to discount [its] estimates of how much of its profit was related to the

infringement.”

Finally, the appellate court ruled that the District Court had properly excluded evidence concerning Audi’s sales of models other than the TT coupe featured in the infringing commercial. Andreas had not proved that sales of other models were the result of the infringing commercial. “It is not enough to show an infringement and then seek all of the defendant’s profits, from whatever source,” Judge Hansen said.

Andreas was represented by S. Jerome Mandel in Santa Monica. Audi was represented by Sara Edelman in New York City. McKinney & Silver was represented by Howard R. Weingrad in New York City.

*Andreas v. Volkswagen of America, Inc.*, 336 F.3d 789, 2003 U.S.App.LEXIS 14562 (8th Cir. 2003) [ELR 25:6:21]

**Thumbnail images of photos created by Ditto.com visual search engine are fair use, appellate court reaffirms; but legality of inline linking and framing of full-size images is remanded because parties did not seek summary judgment on that issue, appellate court rules in response to Ditto.com's petition for rehearing**

Ditto.com - an Internet visual search engine - did not infringe copyrights owned by photographer Les Kelly by creating and posting thumbnail-size images of Kelly's photos on Ditto.com's own website, a federal Court of Appeals has held. In an opinion by Judge T.G. Nelson, the appellate court reaffirmed that Ditto.com's reproduction and display of the thumbnails was a fair use, because two of the Copyright Act's four fair use factors weigh in favor of Ditto.com, one factor was neutral, and only one factor weighed in favor of Kelly.



The two factors that favored Ditto.com were the purpose and character of Ditto.com's use, and the effect of the thumbnails on the value of Kelly's copyrights. The neutral factor was the amount and substantiality of Ditto.com's use. The factor that favored Kelly was the creative nature of his photographs.

The appellate court's fair use ruling concerning Ditto.com's thumbnail reproductions is a "reaffirmation," because this is the same conclusion it came to last year, when it issued its first opinion in this case (ELR 23:9:10). That opinion and its new decision both affirm an earlier District Court ruling that granted Ditto.com's motion for summary judgment, dismissing Kelly's copyright infringement complaint about the thumbnails (ELR 21:12:13).

Kelly's lawsuit also complained about Ditto.com's inline linking to and framing of full-size images of his photographs - images that Kelly himself

had posted on his website or had licensed others to post. This part of the case was of great interest to others, because linking is a key characteristic of the Web, so Kelly's challenge to the legality of Ditto.com's linking was perceived by some to be a challenge to the very operation of the Web itself.

However, the types of links most commonly used by websites are those that jump the user to the linked-to site entirely, or that open a new browser window (on the user's computer) in which the linked-to website appears. Those methods of linking were not involved in this case. Rather, Ditto.com's inline and framing linking methods made it appear that linked-to images were actually part of Ditto.com's own website, even though they weren't.

The District Court ruled that Ditto.com's inline and framing methods were a fair use too. But in the Court of Appeal's original opinion in this case, it

reversed that ruling and held that Ditto.com's inline and framing methods were not a fair use (ELR 23:9:10). Ditto.com petitioned the Court of Appeals for a rehearing on that issue. At least one of its arguments for a rehearing was procedural and irrefutable: neither side had moved for summary judgment on the legality of Ditto.com's inline linking and framing; thus the District Court should not have ruled on that issue; and the Court of Appeals shouldn't have either, one way or the other.

That argument struck a cord with the Court of Appeals. And in its most recent decision, it withdrew its earlier opinion and replaced it with one that rules only on the fair use of Ditto.com's thumbnails. It also ruled that the District Court should not have ruled on the linking and framing issue, so it reversed that ruling and remanded the case for further proceedings.

Les Kelly was represented by Charles D. Ossola of Arnold & Porter in Washington, D.C., and by Steven

Krongold of Arter & Hadden in Irvine. Ditto.com was represented by Judith B. Jennison of Perkins Coie in San Francisco.

*Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 2003 U.S.App.LEXIS 13562 (9th Cir. 2003)[ELR 25:6:22]

**Nebraska Athletic Commission does not have jurisdiction to license “fight contests,” state Supreme Court rules; case is remanded for decision on whether they constitute “assault”**

Chad Mason promotes “fight contests” in Nebraska, and was perfectly willing to get a license from the Nebraska State Athletic Commission authorizing him to do so. The Commission licenses boxing and wrestling matches in Nebraska, pursuant to

a statute that makes it illegal for boxers and wrestlers to participate in matches organized by unlicensed promoters.

“Fight contests,” however, aren’t pure boxing or wrestling matches. Rather, they “involve mixed martial arts and include punching, striking, kicking, choking, kneeing, joint locks, throws, and takedown maneuvers.” The Athletic Commission therefore determined that it could not give Mason a license and refused to do so. What’s more, the police chief in Lincoln told Mason that even if he got a license, he would be subject to arrest for violating a state statute that makes fights - even by mutual consent - criminal “assaults.”

Mason therefore sued the City of Lincoln and the Nebraska State Athletic Commission, seeking a declaratory judgment that the Commission does have jurisdiction to license “fight contests,” and that

promoting fight contests does not amount to criminal “assault.”

At first, Mason had some success. A trial court ruled that the Commission does have jurisdiction to license “fight contests.” But it declined to rule on the “assault” question, saying it could be litigated if Mason were later charged with “assault” for promoting a “fight contest.”

On appeal, however, Mason may have suffered a setback. The Nebraska Supreme Court has held that “fight contests” are not boxing or wrestling, and thus the Athletic Commission does not have jurisdiction to license them. This means that Mason isn’t eligible for whatever mantle of protection against prosecution a license may have given him. But Mason hasn’t completely lost the case yet.

Though Mason asked the Supreme Court to rule that fight contests do not involve criminal assaults, the

Court declined to do so, for purely procedural reasons. In an opinion by Justice John Wright, it held that since the trial court had not ruled on the assault question, that issue was “not appropriate for consideration on appeal.” Justice Wright therefore remanded the case to the trial court, with directions that it decide the question of whether fight contests are assaults. Mason, in other words, has been awarded a rematch and may yet prevail.

Mason was represented by Mark T. Bestul of Vincent M. Powers & Associates in Lincoln. The City of Lincoln and the State Athletic Commission were represented by Don Stenberg, the Nebraska Attorney General.

*Mason v. City of Lincoln*, 665 N.W.2d 600, 2003 Neb.LEXIS 122 (Neb. 2003)[ELR 25:6:23]

**Workers' compensation claim filed by former New York Giants running back George Adams is barred by statute of limitations, because disabling hip injury suffered during practice scrimmage was result of "accident" rather than "occupational disease," appellate court affirms**

Former New York Giants running back George Adams is disabled as a result of a hip injury he suffered during a practice scrimmage in 1986. He won't receive workers' compensation benefits, though, because he waited too long to seek them. A New Jersey workers' compensation judge so ruled, and that ruling has been affirmed by the Appellate Division of the New Jersey Superior Court.

The statute of limitations for workers' compensation claims in New Jersey is two years. Adams acknowledged that he knew he was injured as



soon as it happened. And he acknowledged that he didn't file his workers' compensation claim until 1996, almost 10 years after he was injured. But that wasn't all there was to the case.

Adams testified that he waited as long as he did to file a claim, because he wasn't aware of the nature and extent of his injury until 1995, when a doctor diagnosed his condition and recommended hip replacement surgery. Adams' football career supported his testimony, because his injury didn't bring it to an immediate end. Though he was put on the Giants' injured reserve list for the 1986 season, he played for the team during the 1987 strike-shortened season, and he played for the Giants again for the full 1988 and 1989 seasons. When the 1989 season was over, Adams became a free agent and signed with the New England Patriots, for whom he played for the full 1990 season and again through the first game of the 1991 regular

season.

All of this was relevant, because although the statute of limitations for workers' compensation claims is two years, the New Jersey statute has two different standards for when the two-year clock begins to run. For an "accident," the statute begins to run on the date of the accident. But for an "occupational disease," it doesn't begin to run until the employee "first knew the nature of the disability and its relation to the employment. . . ."

This meant that if Adams' injury was the result of an "accident," his claim was barred by the statute of limitations. But if it was the result of an "occupational disease," he filed it on time.

In an opinion by Judge Donald Collester, the Appellate Division has affirmed that Adams' injury was the result of an "accident," not an "occupational disease." An "occupational disease," the judge

reasoned, is one that develops gradually over a long period of time, while an “accident” arises from a definite event, the time and place of which can be fixed.

Adams’ injury resulted from an accident, because he knew he suffered a serious injury right after the play during the 1986 scrimmage, Judge Collester concluded. And that conclusion was “underscored,” the judge said, by the fact that Adams didn’t play during the 1986 season.

Adams was represented by Stanley R. Bright in Jersey City. The New York Giants were represented by James F. Supple of Fitzpatrick Reilly Supple & Gaul in Providence.

*Adams v. New York Giants*, 827 A.2d 299, 2003 N.J.Super.LEXIS 241 (N.J.Super.A.D.LEXIS 2003)[ELR 25:6:23]

**Patent and Trademark Office properly refused to register “Jack-Off” as trademark for adult phone entertainment company, federal appellate court affirms**

Boulevard Entertainment provides adult entertainment services over the telephone, using telephone actors and actresses who offer adult-oriented conversations for a fee. Described in that fashion, it sounds a bit dull, but Boulevard says that it receives more than 1.2 million calls a year to its branded phone numbers. That of course would make the brand valuable. So like the owners of most other valuable brands, Boulevard attempted to register its brand for trademark protection with the Patent and Trademark Office.

Boulevard’s brand is “Jack-Off.” According to the dictionary - several, actually - “jack-off” is a

“usually vulgar” term that means “masturbate.” The Lanham Act doesn’t permit the registration of “immoral . . . or scandalous matter.” And for that reason, the Patent and Trademark Office denied Boulevard Entertainment’s application to register its brand.

The Trademark Trial and Appeal Board affirmed the denial. And now the Court of Appeals for the Federal Circuit has affirmed again. In an opinion by Judge William Bryson, the appellate court held that substantial evidence supported the conclusion that “the term ‘jack-off’ is an offensive and vulgar reference to masturbation and that Boulevard’s use of the [term] refers to that meaning. . . .”

Boulevard argued that refusing to register its brand “on grounds of vulgarity violates the First Amendment.” But Judge Bryson held that it doesn’t, because the Patent and Trademark Office’s refusal to

register a mark does not affect an applicant's right to use the mark.

Boulevard Entertainment was represented by David Gurnick of Arter & Hadden in Woodland Hills, California. The Patent and Trademark Office was represented by John M. Whealan, the Solicitor of the Patent and Trademark Office, in Arlington, Virginia.

*In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 2003 U.S.App.LEXIS 13784 (Fed.Cir. 2003)[ELR 25:6:24]

**Section of Illinois statute prohibiting virtual child pornography is unconstitutional, but remaining sections of child pornography statute are valid, Illinois Supreme Court holds**

Before the United States Supreme Court decided

Ashcroft v. Free Speech Coalition, a fellow in Illinois named Kenneth Alexander pled guilty to violating that state's child pornography statute. The Illinois statute prohibits child pornography, both real and virtual.

Virtual child pornography is created by computer, using software to alter the apparent ages of those depicted. Though virtual child pornography doesn't actually involve real children, it was banned by a federal statute, as well as the Illinois statute.

The federal statute became important to Alexander, because after he pled guilty to violating the Illinois statute, the United States Supreme Court held in Ashcroft that the federal statute banning virtual child pornography was unconstitutional (ELR 23:11:5). Alexander noted the similarities between the federal statute and the Illinois statute, and he withdrew his guilty plea. The trial court agreed that the two statutes were similar, and it held the Ashcroft decision meant

that the Illinois statute was unconstitutional too.

The state thought otherwise and appealed directly the Illinois Supreme Court. In an opinion by Justice Thomas Fitzgerald, that court has agreed in part with both parties. It agreed with Alexander that the section of the Illinois statute that bans virtual pornography is unconstitutional. But it agreed with the state that the rest of the statute is not - that the rest, in other words, is valid.

Justice Fitzgerald also held that the unconstitutional part is severable from the rest, thus leaving the rest intact. As a result, the case has been remanded to the lower courts for further proceedings, because so far at least, it hasn't been determined (at least not in print) whether the pornography Alexander is accused of distributing was virtual or real.

Illinois was represented by Joel D. Bertocchi, Solicitor General of Illinois, in Chicago. Alexander was



represented by Donald J. Morrison of Morrison & Morrison in Waukegan.

*People v. Alexander*, 791 N.E.2d 506, 2003 Ill.LEXIS 777 (Ill. 2003)[ELR 25:6:24]

**Previously Reported:**

**Captain America termination of copyright transfer case settles.** Marvel Enterprises and one-time Marvel Comics creator Joe Simon have announced that they have amicably settled their legal dispute surrounding the Captain America Super Hero. The specific terms of the settlement are confidential; however, the settlement included Simon's assignment to Marvel of all copyrights he has in Captain America. The settlement followed a federal Court of Appeals

decision last year, holding that a work-made-for-hire agreement between Simon and Marvel's predecessor, which was entered into after the Captain America character was created and in settlement of earlier lawsuits, did not prevent Simon from claiming he was Captain America's "author" and as such was entitled to terminate his transfer of the Captain America copyright after 56 years (ELR 24:10:9). [ELR 25:6:25]

## **DEPARTMENTS**

### **Entertainment Lawyer News:**

**George Gilbert and Bill Fitzgerald join Dreier LLP.** William F. Fitzgerald and George T. Gilbert have joined Dreier LLP as partners and will build the firm's Entertainment Practice. Prior to joining Dreier LLP,

Gilbert was a partner at Rudolph & Beer and Fitzgerald was in private practice. Dreier LLP has been a litigation-focused boutique, but with the addition of Gilbert and Fitzgerald, the firm now has a full-service entertainment practice. Gilbert represents recording artists, songwriters, producers, managers, record labels, talent agencies and agents, music publishers and film and television production companies. Fitzgerald focuses on entertainment, sports, fashion, music, film, television and publishing matters. Prior to forming his own practice, Fitzgerald was associated with Parcher & Hayes where he worked on intellectual property rights matters, right of privacy and publicity matters, breach of contract and sports litigation. He has practiced for more than 15 years, representing individuals and companies in the entertainment industry. As a litigator, he has been involved in music, fashion, sports and business litigation. He also works on transactional

matters in the entertainment industry including deals within recording, publishing, fashion, film, television and modeling industries. In addition, Fitzgerald has extensive experience with court approval of minors' contracts for child performers. Fitzgerald has an extensive international clientele, including relationships with Export Swedish Music, Swedish record labels and recording artists, managers and entertainment lawyers. He is fluent in Swedish. Among his current representations, Fitzgerald counsels model agencies, models, fashion designers, photographers and record labels. He successfully represented Harold Lima, p.k.a. Devin, a member of the group LFO, in a contract action involving a management agreement and production agreement in New York State Supreme Court that further established artists' rights and managers' responsibilities under New York General Business Law § 170. Fitzgerald received a B.A. from Bethany College

in 1969 and a J.D. from the City University of New York at Queens College School of Law in 1986, and also studied at Stockholm University School of Law. Gilbert's experience is in the music industry. He has practiced exclusively in the field of entertainment law for more than 20 years and has been involved in the music industry for more than 30 years. Gilbert has both legal training and extensive experience serving as the president of various entertainment companies. From 1986 to 1988, he was president of Upside Records, which released notable recordings by Charles Brown and Jonathan Richman, among others. He later served as president of Oracle Entertainment, a music artist management company representing Meat Loaf, Jack Bruce, O-Positive, and other well-known artists. Gilbert was also previously in private practice and later joined Marshall & Bomser (which merged into Solovay, Marshall & Edlin) and became a partner. There, he

worked with LL Cool J, and Mary J. Blige. In 1997, he moved with Paul Marshall to The Marshall Firm as partner. In 1999, he became president of Andy Hilfiger Entertainment and AH Records, a joint venture with Quincy Jones, Qwest Records and Warner Brothers Records. Gilbert is General Counsel for The Agency Group, the world's largest music talent agency, and continues to represent many successful entertainment industry individuals and companies. Gilbert received a B.S. degree from the Newhouse School at Syracuse University in 1976 and a J.D. from Benjamin Cardozo School of Law in 1983. He has been a guest lecturer in entertainment law at many academic institutions including Columbia Law School, Benjamin Cardozo School of Law and William Patterson College. He is also a frequent panelist and moderator at entertainment conferences including the New Music Seminar, the CMJ Convention and the FAE Conference. Fitzgerald

and Gilbert will be featured speakers on a panel at “Swedish Music Seminar 2003: Hooked on a Musical Partnership,” hosted by the Consulate General of Sweden in New York and Export Swedish Music.

**Loeb & Loeb Opens Chicago Office.** Loeb & Loeb LLP has announced a major expansion of its intellectual property practice with the addition of a lateral group from Pattishall, McAuliffe, Newbury, Hilliard & Geraldson. Joining as partners are Edward G. Wierzbicki, Daniel D. Frohling, Mary E. Innis and Douglas N. Masters, who will anchor the firm’s new Chicago office. The group’s practice includes litigation and counseling in domestic and international trademark, copyright, unfair competition, and advertising and promotions law. They have represented such clients as Anheuser-Busch; Borders Group; Caterpillar; Dell; The Quaker Oats Company; Sears,

Roebuck and Company; Thermo Electron Corporation; and various advertising agencies. National advertisers currently represented by Loeb & Loeb include Avon Products, Citibank, Cadbury Adams, Pfizer, Yahoo and Visa. Edward Wierzbicki practices in the areas of trademark, copyright, unfair competition, advertising, e-commerce and right of publicity. He has litigated cases throughout the country. He has long been active in the Brand Names Education Foundation, and was recently National Chair of that organization's highly regarded Saul Lefkowitz Moot Court Competition. Daniel Frohling facilitates clients' goals in a variety of intellectual property areas, including trademark, copyright, advertising, unfair competition, trade secret and right of publicity. He uses litigation, alternative dispute resolution, deal-making and counseling to achieve those goals. Frohling also taught trademark law in the LLM program at John Marshall Law School.



Mary Innis handles trademark, copyright, unfair competition and advertising and promotions related litigation and transactional work. She is experienced in trademark clearance, and prosecution with the United States Patent and Trademark Office; negotiating and drafting intellectual property license agreements; clearance of copy and drafting of agreements for clients in the advertising and promotions industries; and other forms of counseling on trademark, copyright and advertising and promotions matters. Douglas Masters concentrates his practice on litigation and counseling in areas of domestic and international trademark, copyright and unfair competition law. He teaches at the University of Chicago Law School and Northwestern University School of Law and has been named one of the 40 lawyers under 40 to watch in Illinois.

**Peter M. Eichler moves from Century City to**

**Phoenix.** Peter Eichler, who, as a worldwide trademark and licensing attorney, has represented numerous entertainment companies and properties over his 42 years of practice in New York and Los Angeles, on December 1, 2003 becomes a partner at Jennings Strouss in Phoenix, leaving Reed Smith Crosby Heafey's Century City office. Prior to joining Reed Smith, he was at Baker Hostetler, Jeffer Mangels and Troop Steuber. In 1975, was a founding partner of Cooper Epstein & Hurewitz. Eichler has represented/represents such properties as Star Wars, Star Trek, Rambo II, Rambo III, Terminator 2, Terminator 3, Baywatch, Cathy, Woody Woodpecker and Alf and such celebrities as Arnold Schwarzenegger, Michael Jackson, Cher, and Elizabeth Taylor, in the protection of their intellectual property rights. Eichler received his B.A. from Wesleyan University and his J.D. from Columbia University

School of Law.  
[ELR 25:6:26]

**In the Law Reviews:**

Adverse Possession for Intellectual Property: Adapting an Ancient Concept to Resolve Conflicts Between Antitrust and Intellectual Property Laws in the Information Age by Constance E. Bagley and Gavin Clarkson, 16 Harvard Journal of Law and Technology 327 (2003)

Indirect Liability for Copyright Infringement: An Economic Perspective by Douglas Lichtman and William Landes, 16 Harvard Journal of Law and Technology 395 (2003)

The Columbia Journal of Law & the Arts has published Volume 26, Numbers 3 and 4 with the following articles:

Open Source and Copyleft: Authorship Reconsidered? by Severine Dusollier, 26 The Columbia Journal of Law & the Arts 281 (2003)

Why Moral Rights Matter: Recognizing the Intrinsic Value of Integrity Rights by Burton Ong, 26 The Columbia Journal of Law & the Arts 297 (2003)

Keep on Rockin' in the Free World: A First Amendment Analysis of Entertainment Permit Schemes by Trey Hatch, 26 The Columbia Journal of Law & the Arts 313 (2003)

The Anticybersquatting Consumer Protection Act and

the Uniform Dispute Resolution Policy: New Opportunities for International Forum Shopping? by Zohar Efroni, 26 The Columbia Journal of Law & the Arts 335 (2003)

Staying Alive: Can the Recording Industry Survive Peer-to-Peer? by Jennifer Norman, 26 The Columbia Journal of Law & the Arts 371 (2003)

A Trifle Worthy of Concern: The De Minimis Defense Applied to the Use of Art in Film by Wendy Szymanski, 26 The Columbia Journal of Law & the Arts 411 (2003)

Fordham Intellectual Property, Media & Entertainment Law Journal has published Volume 13, Number 4 with the following articles:

Filled Milk, Footnote Four & the First Amendment: An Analysis of the Preferred Position of Speech After the Carolene Products Decision by Elizabeth J. Wallmeyer, 13 Fordham Intellectual Property, Media & Entertainment Law Journal 1019 (2003)

Victor's Little Secret: Supreme Court Decision Means More Protection for Trademark Parody by Jordan M. Blanke, 13 Fordham Intellectual Property, Media & Entertainment Law Journal 1053 (2003)

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Making a Run for the Border: Should the United States Stem Runaway Film and Television Production

Through Tax and Other Financial Incentives? by Heidi Sarah Wicker, 35 The George Washington International Law Review 461 (2003)

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Caging the Bird Does Not Cage the Song: How the International Covenant on Civil and Political Rights Fails to Protect Free Expression Over the Internet by Antoine L. Collins, 21 The John Marshall Journal of

Computer & Information Law (2003)

Silent Voices: Analyzing the FCC “Media Voices” Criteria Limiting Local Radio-Television Cross-Ownership by Loy A. Singleton and Steven C. Rockwell, 8 Communication Law and Policy (2003) (published by Lawrence Erlbaum Associates, Mahwah, New Jersey)

The Canadian Journal of Law & Jurisprudence: An International Journal of Legal Thought, published by the University of Western Ontario, [www.registrar.uwo](http://www.registrar.uwo), has issued Volume 16, Number 2 with a symposium on Intellectual Property including the following articles:

Copyright’s Modest Ontology-Theory and Pragmatism in *Eldred v. Ashcroft* by Graeme W. Austin, 16 The Canadian Journal of Law & Jurisprudence (2003) (for



website, see above)

Theoretical Underpinning of Intellectual Property: “I am a Pragmatist But Theory is my Rhetoric” by Brian Fitzgerald, 16 The Canadian Journal of Law & Jurisprudence (2003) (for website, see above)

Intellectual Property: Theory, Privilege, and Pragmatism by Adam D. Moore, 16 The Canadian Journal of Law & Jurisprudence (2003) (for website, see above)

The Illusive Search for Justificatory Theories: Copyright, Commodification and Capital by Samuel E. Trosow, 16 The Canadian Journal of Law & Jurisprudence (2003) (for website, see above)

The Internet Guide to Sports Law, 8 Internet Law

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Researcher (2003) (published by Glasser Legal Works, [www.internetlawresearcher.com](http://www.internetlawresearcher.com))

Is There a Global Sports Law? by Ken Foster, 2 Entertainment Law 1 (2003) (published by [www.frankcass.com/jnls](http://www.frankcass.com/jnls))

Explaining the Absence of the Media in Stories of Law and Legal Consciousness by Lieve Gles, 2 Entertainment Law 19 (2003) (for website, see above)

Government Sponsored Professional Sports Coaches and the Need for Better Child Protection by Yvonne Williams, 2 Entertainment Law 55 (2003) (for website, see above)

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Catherine Russell, 2 Entertainment Law 114 (2003)  
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Affairs as Internet Defamation Beckons by James R.  
Pielemeier, 35 Arizona State Law Journal (2003)

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Stephen G. Nesbitt, 30 Northern Kentucky Law Review  
229 (2003)

Copyright As Tort Law's Mirror Image: "Harms," and

“Benefits,” and the Uses and Limits of Analogy by Wendy J. Gordon, 34 McGeorge Law Review: University of the Pacific (2003)

The EC Directive on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Age-A Short Comment by Michael Lehmann, 34 IIC International Review of Industrial Property and Copyright Law 521 (2003) (published by the Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich, [www.ip.mpg.de](http://www.ip.mpg.de))

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Concurrent Use of Trademarks on the Internet:

Reconciling the Concept of Geographically Delimited Trademarks with the Reality of the Internet by Robert Nupp, 64 Ohio State Law Journal (2003)

Childproofing the Internet by Ronald J. Krotoszynski, Jr., 41 Brandeis Law Journal University of Louisville 447 (2003)

Child-Pornography and Regulation of the Internet in the United Kingdom: The Impact on Fundamental Rights and International Relations by Katherine S. Williams, 41 Brandeis Law Journal University of Louisville 463 (2003)

The Entertainment Law Review, published by Sweet and Maxwell, [www.sweetandmaxwell.co.uk](http://www.sweetandmaxwell.co.uk), has published Volume 14, Number 7 with the following articles:

Altered Image Rights? by James Hennigan, 14 Entertainment Law Review 161 (2003) (for website, see above)

Have We Got a Deal?: Two Recent Cases in the Film and Music Industries by Alexander Ross, 14 Entertainment Law Review 164 (2003) (for website, see above)

How Sacred is the Rule against the Disclosure of Journalists' Sources? by Timothy Pinto, 14 Entertainment Law Review 170 (2003) (for website, see above)

Mediation Point: What is the Future for ADR in the Media? by Sean McTernan, 14 Entertainment Law Review 173 (2003) (for website, see above)

The Ongoing Evolution of Reynolds Privilege in Domestic Libel Law by Ian Loveland, 14 Entertainment Law Review 178 (2003) (for website, see above)

Arsenal Football Club plc v Matthew Reed in the Court of Appeal by Simon Miles, 14 Entertainment Law Review 184 (2003) (for website, see above)

R v Johnstone [2003] UKHL 28 Bootlegging and Legitimate Use of an Artiste's Trade Mark by Rico Calleja, 14 Entertainment Law Review 186 (2003) (for website, see above)

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The European Intellectual Property Review, [www.sweetandmaxwell.co.uk](http://www.sweetandmaxwell.co.uk), has published Volume 25, Issues 7-11, with the following articles:

EU Regulation of Processing of Personal Data by Wholly Non-Europe-Based Websites by Dov H. Scherzer, 25/7 European Intellectual Property Review 292 (2003) (for website, see above)

Requirement of Use of Trade Marks by Jens Jakob Bugge and Peter E. P. Gregerson, 25 European Intellectual Property Review 309 (2003) (for website, see above)

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“Creativity” As an Aspect of Originality: Copyright in Works that are Included in Other Works by William Hayhurst, 25/7 European Intellectual Property Review 326 (2003) (for website, see above)

Digital Copyright: The End of an Era by Martin Kretschmer, 25/8 European Intellectual Property Review 333 (2003) (for website, see above)

International Domain Name Disputes: (Rules and Practice of the UDRP) by Anri Engel, 25/8 European Intellectual Property Review 351 (2003) (for website, see above)

New Copyright Contract Legislation in Germany: Rules on Equitable Remuneration Provide “Just Rewards” to Authors and Performers by Karsten M. Gutsche, 25/8 European Intellectual Property Review 366 (2003) (for website, see above)

Trade Marks: What Constitutes Infringing Use? by Paul Garland and Victoria Wilson, 25/8 European Intellectual Property Review 373 (2003) (for website, see above)

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Political Exhaustion: The European Commission's Working Paper on Possible Abuses of Trade Mark Rights within the EU in the Context of Community Exhaustion by Christopher Stothers, 25/10 European Intellectual Property Review 457 (2003) (for website, see above)

Copyright and the Reproduction of Artistic Works by Simon Stokes, 25/10 European Intellectual Property Review 486 (2003) (for website, see above)

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Turning Your Intellectual Property Assets into Cash by Gary M. Hoffman, 20 The Computer and Internet Lawyer 1 (2003) (edited by Arnold & Porter, published by Aspen Publishers)

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United States v. KPMG: Does Section 6103 Allow the IRS to Put Taxpayer Names on the Front Page of the Wall Street Journal? by Beckett G. Cantley, 50 Cleveland-Marshall College of Law Cleveland State Law Review (2002-2003)

The Sense and Nonsense of Web Site Terms of Use Agreements by Sharon K. Sandeen, 26 Hamline Law Review (2003)

Intellectual Property, Innovation, and Social Progress: The Case Against Incentive Based Arguments by Adam D. Moore, 26 Hamline Law Review (2003)

A Dangerous Step Toward the Over Protection of Intellectual Property: Rethinking *Eldred v. Ashcroft* by Caren L. Stanley, 26 *Hamline Law Review* (2003)

How Creative are the Creative Industries? A Case of the Music Industry by Peter Tschmuck, 33 *The Journal of Arts Management, Law and Society* 127 (2003) (published by Heldref Publications, 1319 18th St NW, Washington, DC 20036-1802)

Building Stronger National Movie Industries: The Case of Spain by Victor Fernandez-Blanco and Juan Prieto-Rodriguez 142 *The Journal of Arts Management, Law and Society* (2003) (for publisher, see above)

Free Speech and Fair Use: The DeCSS Dilemma Resolved? 71 *University of Cincinnati Law Review* (2003)  
[ELR 25:6:27]