



Entertainment Law

COMMENT

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Bratz dolls return

by Elizabeth Holt
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The infamous childhood doll Barbie was challenged by a new, trendy and multi-ethnic collection of dolls called Bratz in 2001. The original sketches and sculpt of the Bratz doll was created by an employee of Mattel, Barbie's owner. The employee pitched his line of dolls to MGA, Mattel's competitor, in August 2000, while still employed by Mattel. Instead of disclosing and assigning his creation to his employer as required by his employment agreement, the employee returned to MGA with sketches and sculpts of the potential line. To create the sculpt, the employee used a head from the Mattel bin, a Barbie body and Ken's boots. These became the first generation Bratz's dolls. The employee still worked for Mattel while he entered into a consulting agreement with MGA to work on developing Bratz. When Mattel discovered what the employee had created, it claimed the employee was in violation of his employment agreement.

Mattel sued MGA in the U.S. District Court for the Central District of California for ownership rights and copyright of the Bratz creation. Mattel won in the trial court on every level and the jury found MGA liable for infringing on Mattel's copyrights. Mattel was granted \$10 million for the Bratz infringement, the court imposed a constructive trust over all trademarks, essentially transferring the Bratz trademark to Mattel, and granted an injunction prohibiting MGA from producing or marketing virtually every female Bratz doll, including future versions substantially similar to the original four Bratz. MGA appealed to the United States Court of Appeals for the 9th Circuit.

Constructive trust not equitable

A constructive trust transfers wrongfully held property to its rightful owner, but the person seeking imposition of the trust must show: (1) the existence of a property interest; (2) the right to that property; and (3) the wrongful acquisition or detention of the property by another party who is not entitled to it. However, even if the employee assigns his ideas, when a trademark acquires greater value because of wrongful owner's development efforts, marketing and investment, the acquiring benefits from the wrongful own-

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MOVIES

The Last Samurai not infringing

by Patrick Ogilvy
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According to the U.S. Court of Appeals for the 9th Circuit, the makers of the film *The Last Samurai* are not liable for copyright infringement to the writers of a screenplay with the same name and a similar premise.

Two writers wrote a screenplay called *The Last Samurai*, which their agent pitched and provided a copy to a production company. The production company passed on the screenplay, informing the agent it

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BASEBALL

Rooftop club sues over confusion

by Eugene Long
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The owner of a rooftop venue located next to Wrigley Field in Chicago was allowed to proceed with a claim for a violation of the Lanham Act when he alleged another rooftop venue used a picture of his venue to advertise itself.

Chicago's rooftop clubs

Chicago is home to several "rooftop clubs," which overlook Wrigley Field and are licensed by the City of Chicago to charge admission to view Chicago Cubs baseball games and other events at Wrigley Field.

The owner of Wrigley Done Right alleged the owner of a club called the Wrigley Rooftop Club was paying for a web advertisement that featured a picture of Wrigley Done Right adjacent to a link for the Wrigley Rooftop Club. Aside from being a direct competitor of the Wrigley Rooftop Club, Wrigley Done Right is situated in a well-known building that is twice as wide as and better located than the Wrigley Rooftop Club.

The owner of Wrigley Done Right filed a lawsuit alleging the owner of the Wrigley Rooftop club violated the Lanham Act by deliberately and willfully displaying images of Wrigley Done Right in an attempt to pass off that facility as the Wrigley Rooftop Club. The

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had a similar project in development. After the production company released a film called *The Last Samurai*, the writers filed suit. The production company contended it developed the film independently of the screenplay.

No infringement despite similarities

The court noted several similarities between the film and the screenplay. Both involved an American war veteran traveling to Japan in the 1870s, the training of the Imperial Army in modern Western warfare, and a samurai uprising. The protagonist in each meets the Emperor, engages a Japanese leader of the samurai rebellion, suffers a personal crisis, and is transformed after interacting with the samurai. Further, the film and screenplay each share certain settings, such as scenes in the Imperial Palace and on the Imperial training grounds, and various battle sequences. Although the film and screenplay featured the same basic plot premise, the court determined these elements were too broad to be protected.

Instead, the court found numerous and significant differences in narrative, characters, theme, setting, and mood. Whereas the screenplay is a revenge story,

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ers’ work is too broad for a trust. Although Mattel is entitled to enhancement of the property, when MGA profits from the wrong, it is necessary to identify the profits and recapture them without capturing the benefits of MGA’s own efforts. When a trust increases significantly because of wrongful owners’ efforts, it goes too far. As in this case, it is not equitable to transfer an entire brand of Bratz dolls to Mattel.

Permissible v. impermissible copying of expression


Mattel argued MGA’s dolls infringed on its copyrights in the sketches and sculpt, but copyrights in works cover only particular expression of an idea, not the idea itself. Mattel claimed MGA went beyond the idea by copying unique expression of the dolls. To determine whether similar elements are protected or unprotected the court looks at the similarities between the copyrighted and challenged work. When unprotected elements are excluded and only the particular expression of an idea is left, that expression is protected. If the expression is wide ranging, then copyright protections are broad and work will infringe if it’s substantially similar. However, if it is a narrow range, then copyright protection is thin and it must be virtually identical.

In the case of the Bratz-doll sculpt, the exaggerated features consisted of oversized heads and feet. The oversized features were not original ideas create by Bratz (the cartoon character Betty Boop has similar features for instance), so they are unprotectable. The Bratz sculpt falls into a narrow range of expression and is entitled to a thin copyright protection unlike the broad protection given by the District Court. However, unlike the sculpt, the

where the protagonist’s son is killed by the samurai leader, the film is a captivity story, where the protagonist spends much of the story in the confines of the samurai. The protagonist in the screenplay begins happily married and successful, while the film protagonist is an unmarried loner and drunk. Regarding theme, the court noted where the screenplay positively depicts the Americanized modernization of Japan, the film is nostalgic for disappearing Japanese traditions. Although there were similar settings between the screenplay and film, the court determined they flowed naturally from the basic premise, and pointed out differences such as scenes in samurai castles and an opium den in the screenplay, and scenes in a samurai village in the film. Finally, the court described the mood of the screenplay as a fast-paced adventure story, while the film was more reflective and leisurely. In short, though the screenplay and film share the same basic premise, the court determined their stories are substantially different. Accordingly, the court found *The Last Samurai* film did not infringe the copyright of the screenplay. ■

sketches consisted of a wide range of expressions for complete young, hip female dolls with exaggerated features, upon which many variations can exist. Therefore, the sketches are expressions that should be afforded broad protection against substantially similar works. Mattel cannot, however, claim a monopoly over dolls with bratty attitude. These are unprotected ideas that cannot meet the substantial similarity test for copyright infringement.

Even if one is in violation of an employment agreement that allows for the company to retain copyrights of employees, it does not mean copyright law can prohibit all production of similar products. The court of appeals remanded the case to determine whether the jury verdict and damages of \$10 million should be overturned. ■

“I Didn’t Know That”™
(Why We Say The Things We Say) by Karlen Evins 

“Deadbeat” - The first deadbeats were technically “debt beaters.” These were people who avoided their creditors by leaving their debts behind. In the early days of this country, there were two ways to shirk your financial obligations: (1) by declaring bankruptcy, or (2) by actually moving out of the colony where the debt was incurred. Those choosing the latter were known as debt beaters, which later was shortened and mispronounced as deadbeats.

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MUSIC

Kentucky University Wildcats' CD brings infringement claim



Danny Moskowitz

In describing the University of Kentucky's basketball tradition Hall of Fame basketball coach Al McGuire once piped, "They had it before you. They had it during you. They'll have it when you're gone." While fans of other schools around the country may disagree, the message resonated in a federal district court in the Eastern District of Kentucky, which was called upon to settle

an ownership controversy involving two music albums made specifically for "Big Blue Nation."

This ain't bluegrass

In 1996, a partnership created and produced a music album, "The Kentucky Wildcat Basketball Fan Experience/True Blue," and subsequently filed to register their copyright with the Library of Congress. The copyright registration was for a "compilation of sound recording of Kentucky Wildcat games and band [i.e. the University of Kentucky pep band] recordings." In describing the album's content, the court colorfully noted, "One track stood out from the others...br[inging] together the greatest of Kentucky lore." This track, the "Chandler remix," "mixed former Gov. Happy Chandler's *a cappella* rendition of 'My Old Kentucky Home' with recorded crowd noise from UK's Rupp Arena." The partnership peppered the album's cover with Kentucky basketball relics and artwork, including a basketball with the Kentucky logo.

In order to sell its album to the "Big Blue Mist" faithful, the partnership enlisted the marketing help of a record label. The partnership and record label executed a two-year contract that ended in 2000. In 2003, the record label produced a charity album, without the partnership's participation, whose content contained some of the same songs and cover artwork as the partnership's album. Despite these two parties' bond and affinity for Kentucky basketball, the partnership filed suit with an array of causes of actions, including copyright infringement, against a mass of parties all of whom were involved in the creation and marketing of its album.

As a preliminary matter, the court found that the record label had indeed copied songs from the partnership's album. Yet, the court, in an unusual move, found the partnership's copyright registration defective. On the partnership's copyright registration form, when prompted to "[i]dentify any preexisting work or work that this work is based on or incorporates," the partnership answered simply "some sound recording."

Clearly absent on the form was any mention of the contribution of Gov. Chandler, specifically in regards to the "Chandler Remix." The court held the application's description "some sound recordings" was inadequate because "[t]he Copyright Office, without knowing what the pre-existing work was and which track contained the remix, could never have determined whether...[the partnership's] contribution to the Chandler rendition qualified as a derivative work." As a result, the partnership's failure to identify derivative works on its application, made its copyright unenforceable against the record label's charity album. Thus, the partnership did not own the copyright to its music album.

It's why you play four quarters

Despite the partnership's initial setback, the court found the partnership owned the copyright for the album's artwork. The record label was unable to carry the burden of showing the copyright to the album's artwork was not valid.

The record label argued the artwork was owned by another party, the original artist. Yet, the partnership countered that it had received a valid assignment from the original artist. Although, the partnership was unable to produce a copy of the original agreement evidencing the assignment, the record label failed to establish the partnership had destroyed it in bad faith. Consequently, the court granted the record label judgment for the music album infringement claim and the partnership judgment for the artwork infringement claim. ■

Daniel B. Moskowitz is an attorney in the Litigation and Entertainment departments of King & Ballow in Nashville, Tennessee. Danny's practice focuses on complex litigation and representation of record labels, artists and other parties to the music and entertainment industries. Prior to joining King & Ballow, Danny was an attorney with a firm in Baltimore, Maryland, where he practiced civil and white-collar defense litigation. Danny received his law degree from University of Kansas School of Law, and he earned his undergraduate degree from Tulane University, graduating *cum laude*. Before beginning his career as an attorney, Danny was a participant in the Virginia Governor's Fellows Program, where he was a speech writer in the Virginia Office of Technology. Currently, Danny has been appointed to a two-year term as co-chair of the American Bar Association's Criminal Justice Section White Collar Crime Committee Young Lawyers Subcommittee. Danny is also a member of the Community Relations Committee of the Nashville Jewish Federation.

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TRADE DRESS

Anti-snoring device trade dress causes unrest

by Patricia Porter Kryder
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A company manufactured, marketed and sold an anti-snoring prescription mandibular repositioning device (MRD) called PureSleep. An MRD is an FDA-regulated medical device that may only be obtained by prescription from a medical doctor or dentist.

The company developed a business model, the “PureSleep Method,” which allowed consumers to purchase a “PureSleep Method” device without visiting a dentist. The “PureSleep Method” consists of, among other things, a screening questionnaire, website, telephone ordering system, and television commercials. The company implemented and marketed the PureSleep device through the PureSleep Method.

Method as trade dress

The company had not publicly displayed the Pure Sleep Method when it engaged a dentist to review the PureSleep Method and the PureSleep device after he signed a non-disclosure agreement. The dentist suggested some refinements to the PureSleep Method, and then ceased all communications with the company. The company launched its website and began marketing the PureSleep device through its website.

The company claims the PureSleep Method is a way to sell the MRD. The dentist referred two Vermont residents to the website for the purpose of ordering the MRD in order to test its functionality and to copy the website, which contained terms and conditions prohibiting its reproduction or transmission.

The Vermont residents then registered a domain name and registered Sleeping Well as a limited liability company in Vermont. Sleeping Well entered into a contract with a media buying company to purchase television advertising air time from the company’s exclusive television media buyer, allegedly copying even their marketing plan of the air times and television stations

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owner of the Wrigley Rooftop club moved to dismiss the lawsuit.

Club owner allowed to proceed with lawsuit

In the context of this case, the owner of Wrigley Done Right alleged that the owner of the Wrigley Rooftop club was attempting to pass-off the Wrigley Done Right facility as his own.

The court found the allegations were sufficient to defeat a motion to dismiss. The complaint alleged the owner of the Wrigley Rooftop Club had sponsored an advertisement that was likely to cause confusion and that the owner of Wrigley Done Right was likely to be injured by such advertisement. The court found the

resulting in the most profitable way to market the PureSleep device.

When Sleeping Well launched its television commercial, website, and ordering system, PureSleep claimed that Sleeping Well had misappropriated its website, which contained the same form, design and feel as for PureSleep. In addition, the company maintained that Sleeping Well directed the marketing company to target the same television stations and air times that it used to advertise the PureSleep device.

The company maintained that Sleeping Well committed trade dress infringement because PureSleep has a unique website, including user interface, telephone ordering system and television commercial. Trade dress protection applies to a combination of product elements including the shape and design of a product. Trade dress involves the total image of a product and may include features such as size, shape, color or color combination, texture, graphics, or even particular sales techniques.

Sleeping Well pointed out that in order to prove trade dress infringement, PureSleep must establish the trade dress has acquired a secondary meaning and there is a substantial likelihood of confusion between the products. The court reasoned it must not focus on individual elements, but rather on the overall visual impression that the combination and arrangement of those elements create. The court reviewed the fact that PureSleep seeks trade dress protection of its website, telephone ordering system and television commercial, but noted the company failed to define its trade dress as these three marketing components taken in combination, nor that the three components created a visual impression. As such, PureSleep had not properly alleged a trade dress infringement claim, and was permitted by the court to replead its claim. ■

arguments that the photograph was too small to influence buying decisions and that the advertisement was a mistake were fact-based arguments that were not appropriate to consider in ruling on a motion to dismiss. A motion to dismiss assumes the facts alleged in the complaint are true and only tests the sufficiency of those allegations. For these reasons, the court denied the motion to dismiss the false designation claim.

The Lanham Act prohibits the use of false or misleading advertisements, to include false designation of goods or services. Clearly, when it is alleged the owner of a product or service is passing off a competitor’s product or service as his own, the complaint has alleged facts sufficient to survive a motion to dismiss. ■