

# ARTS Law Memo

## Trademark v. First Amendment

The naive might think that a constitutional provision as lofty as the First Amendment would generate equally high-minded litigation. In reality, though, free speech quarrels that reach the Supreme Court often seem better suited for the Jerry Springer Show. Especially two decisions handed down last month.

The first, *City of San Diego v. Roe*, involved a San Diego policeman who sold homemade videos on eBay showing himself stripping off his police uniform and, well, playing a vigorous solo on the baton nature gave him. The second case involved a brawl between two cosmetic companies over ownership of the words “micro color.” Nevertheless, both cases touch upon core First Amendment values.

In fairness to the San Diego police department, the Supreme Court decision upholding its firing of Sgt. Stripper is unsettling only to those who’ve seen innocuous passages in other weird cases transmute into grounds for repression in future cases. That’s because the lawsuit is really about a government employee fired for after-hours expression that his superiors deemed detrimental.

What if the next form of “detrimental” expression is a video documenting police abuse? Or an op-ed piece on lazy cops? Or an edgy stand-up comedy routine that the chief deems “detrimental” to department morale? One can only hope that this opinion, like the video performance it addresses, produces no offspring.

Fortunately, freedom of expression also received a boost last week in the trademark case of *KP Permanent Make-up v. Lasting Impressions I*. Trademarks are words or symbols used to indicate the source of products and to distinguish them from products of others.

We give companies rights in their trademarks in the hopes of preventing confusion in the marketplace. Thus no one but Apple can sell an MP3 player with the trademark iPod, and no one but Nike

can put the swoosh trademark on running shoes.

In *KP Permanent Make-up*, each party sold permanent makeup for injection under the skin to camouflage scars. The plaintiff owned the trademark Micro Colors for its product. It claimed that defendant’s use of the term “micro colors” in marketing materials violated that trademark. The defendant answered that its use was fair because it only used the words to describe its product.

The outcome hinged upon the burden of proof — an issue that makes lawyers perk up with everyone else yawns. But the crux of the decision was something we can all understand: trademarks are not monopolistic grants of rights in ordinary words in the English language. Others can use the words of your trademark to fairly to describe their own goods. And they can do so, the court ruled, even if that use causes consumer confusion.

Thus a company that chooses to make a trademark out of descriptive words — such as BEST BUY or LIGHT beer or DIEHARD — cannot prevent others from using those same words to describe their own products.

Bob’s Computer Store can advertise that it has “The Best Buy on Laptops,” and the local microbrewer can add LIGHT to the name of its low-calorie beer, and 20<sup>th</sup> Century Fox can call its Bruce Willis action flick “Die Hard” even if Sears proves that some consumers think it’s a documentary about car batteries.

The Supreme Court’s decision is important for artists as well, since it acknowledges that creativity is impossible without a rich public domain for all to draw upon. That is an important recognition in an era that has seen entertainment conglomerates use litigation tactics to terrorize file sharers, music samplers, and the like.

As Circuit Judge Alex Kozinski reminds us, “intellectual property rights are not

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- Matching volunteers with arts organizations seeking board members; and
- Providing access to the national volunteer lawyers for the arts network.

The lead article was written by Michael A. Kahn, a partner at the Blackwell Sanders law firm and the author of several novels. He serves on the VLAA board. VLAA Executive Director Sue Greenberg wrote the sidebars. Special thanks to Eugenia Cortez and David Friedman.

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free. They are imposed at the expense of future creators and the public at large. That is why intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us."

And that is why Mattel can't stop the rock group Aqua from naming their satirical song "Barbie Girl." And why Saturday Night Live and Shrek and countless other works of creative expression can enrich our culture

through their spoofs of celebrities and famous products.

Freedom of expression went one for two last month. Perhaps not the Best Buy, but certainly an outcome with True Value.

## "Barbie" artist wins fight with Mattel

David slew Goliath in a lengthy legal battle that forced a self-taught Utah photographer to defend a suit filed by the nation's No. 1 toy-maker. Mattel, Inc. sued artist Thomas Forsythe in 1999 for copyright and trademark infringement because the company did not like the way he photographed Barbie.

Forsythe's "Food Chain Barbie," a series of 78 photos, depicts the dolls in absurd and provocative poses next to vintage household appliances, such as sitting in a malt machine, sizzling in a wok, and wrapped in a tortilla baking in an oven. Forsythe says he used the Barbies to criticize "the materialistic and gender-oppressive values" that he believes the dolls embody. He also claims that, throughout the series of photographs, he attempts to communicate his serious message with an element of humor.

In a victory for free artistic expression over the interests of big business, a federal court not only ruled in Forsythe's favor but also characterized Mattel's claims as "groundless and unreasonable." In 2004, an appeals court brought an end to the case when it ordered the toy giant to pay Forsythe more than \$1.8 million in attorney's fees.

"I knew that I had every right to critique this overtly consumerist and impossible beauty myth," Forsythe told the *Photo District News*. "What I didn't know was much money it would take to prove it. Federal court is a boxing ring for the rich," he said.

Mattel, Inc. is the worldwide leader in the design, manufacture, and marketing of toys and family products, including Barbie, the most popular fashion doll ever introduced. During the last 45 years, more than one billion Barbies have been sold; annual worldwide retail sales exceed \$3.6 billion.

Forsythe's market success was limited. He showed the series at two art fairs — the Park City Art Festival in Utah and the Plaza Art Fair in Kansas City — and sold several hundred postcards depicting "Barbie Enchiladas." His total gross income from the "Food Chain Barbie" series was \$3,659.

To prevail in court, Forsythe convinced the judges that his artwork should be protected as parody, which is considered

a fair use under the copyright law. "The benefits to the public in allowing such use — allowing artistic freedom and expression and criticism of a cultural icon — are great," wrote Judge Harry Pregerson of the 9th U.S. Circuit Court of Appeals.

The court also made it clear that deciding whether or not a work is parody is matter of law, not of public majority opinion. Accordingly, the court declined to consider Mattel's survey, which was conducted at a mall.

Both the appellate court and the federal district judge were unconvinced by Mattel's claims of trademark and trade dress infringement and dilution. "It is highly unlikely that any reasonable consumer would have believed that Mattel sponsored or was affiliated with his work," Pregerson wrote.

Finally, Mattel tried to wield its considerable clout by going after Forsythe's expert witnesses, the curator of photography at the San Francisco Museum of Modern Art and the chief curator of the Guggenheim Museum. The appeals court concluded that Mattel engaged in "oppressive subpoena requests" that were "for the purpose of annoying and harassment and not really for the purpose of getting information."

In a statement posted on the National Coalition Against Censorship site, Forsythe notes that "it's the corporations that exercise their real censorship power over free speech. Corporation make their brands ubiquitous and then complain if anyone uses the brands to criticize the resulting crass consumerism. Unlike a public figure like New York Mayor Guiliani, corporations proceed quietly, below the radar of public scrutiny, merely by making a business decision to throw their intimidating wealth in the face of hapless artists."

Forsythe believes that his victory will make it easier for artists to find attorneys who are willing to defend them if they are sued and will give major corporations pause before they resort to lawsuits to silence their artistic critics. As Jonathan Zittrain, a Harvard law professor, told the *New York Times*, "Maybe now when an angry CEO picks up the phone and says 'sue this guy' the lawyer may say 'I have to warn you, this could boomerang.'"

# Legal-ease

*Copyright:* It is a principle of American law — as articulated in the Constitution — that artists and inventors should reap the economic benefits of their creative endeavors. Copyright law enables creators, producers, publishers and distributors of artistic works to control whether, how and when their works are used. Copyright protects “original works of authorship” that are “fixed in a tangible form of expression.” Copyright affords protection for literary, musical, dramatic, choreographic, pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works. The copyright law gives “authors” a bundle of exclusive rights in their work. These rights include reproduction, preparation of derivative works (e.g. the film version of a play), distribution, performance and display. Copyright protects the particular way an author has expressed himself. It does not protect the ideas, systems, or factual information conveyed in the work.

*Free Speech:* The First Amendment applies to artistic expression, verbal as well as non-verbal, just as it applies to political and other speech. It is a shield that protects against government restriction or punishment of expression, particularly when the government discriminates on the basis of content or viewpoint. The Supreme Court has handed down several decisions limiting free expression. The First Amendment does not protect speech that creates a “clear and present danger” of violence or injury, such as falsely shouting “Fire!” in a crowded theatre. Under some circumstances, time, place, and manner restrictions are permissible. In 1978, for example, the Supreme Court upheld the Federal Communications Commission ruling that George Carlin’s “seven dirty words” monologue could not be broadcast during hours when children are likely to be listening to the radio. There also are limits in special settings such as prisons, the military, and public schools. Libel and slander are generally not protected by the First Amendment. Commercial speech — such as advertising — enjoys less protection than other speech does. Finally, expression that depicts sexual conduct in an offensive way and lacks any serious artistic, political, or scientific value is not protected.

*Moral Rights:* These rights, which have been in place in many European countries since the 19th century, are based on the premise that an artist’s honor and livelihood are dependent upon the presentation of his work as created and that alteration can damage his reputation. Moral rights fall into three categories: 1) the right of an author to receive credit as the author, to prevent others from falsely being named author, and to prevent use of his name for works he or she did not create; 2) the right of an author to prevent mutilation of a work; and 3) the right of an author to withdraw a work from distribution if it no longer represents his views. Under the Visual Artists’ Rights Act of 1990, some works of art are protected from being altered or destroyed without the consent of the artist.

*Trademark:* A word, name, symbol, or device used by a manufacturer or merchant to identify his goods or services and distinguish them from other goods or services. Examples include logos and phrases such as Hallmark’s “when you care enough to send the very best.”

*Trade Dress:* The total visual image of a product including features such as size, shape, color or color combinations, texture, and graphics. Examples are Campbell’s distinctive red and white soup cans or the exterior design of McDonald’s buildings. Trade dress law may offer recourse when a fine or commercial artist’s style is replicated without pirating any particular work.

*Patent:* Patents provide an inventor with the exclusive right to make, use or sell a new, useful, and not obvious invention for a limited period of time. Utility patents have been granted for everything from airplanes to zippers. Design patents protect new, original ornamental designs for articles of manufacture.

*Right of Privacy:* The right of a person to be free from intrusion into matters of a personal nature is known as the right of privacy. The underlying premise is that some facts about people are so intimate, so embarrassing and private, or so misleading and offensive, that they should not be made public without the person’s permission. Although not explicitly mentioned in the U.S. Constitution, the right of privacy has been held to be implicit in the Bill of Rights.

*Right of Publicity:* An individual’s right to control and profit from the commercial use of his name, likeness, and persona is called the right of publicity. This right varies from state to state, but most states protect public figures and celebrities from the unauthorized commercial exploitation of their identity. The laws attempt to strike a balance between an individual’s right of publicity and free speech rights. The greatest protection is provided for news. Lesser protection is provided for entertainment and fiction, and the least protection is available for advertising where the portrayal is used to sell a product or service.

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## BOOKS

Borchard, William M. *Trademarks and the Arts. How Performers, Visual Artists & Other Creators Can Benefit from the Trademark Law*

This short book includes instructions on obtaining and retaining trademarks, information on protecting artistic elements as trademarks, and advice on creating a merchandising licensing agreement.

Elias, Stephen and McGrath, Kate. *Trademark: Legal Care for Your Business & Product Name*

This book explains (in the easy-to-understand fashion associated with Nolo Publishing) how to choose trademarks and then how to protect them. Revised to reflect changes that have come about because of the advent of cyberspace, it offers clear instructions on initial selections, searches to ensure availability, state and federal registration procedures, correct use, and adjudication of any disputes that result.

Shapiro, Michael and Miller, Brett I. *A Museum Guide to Copyright & Trademark*

Published by American Association of Museums, this guide introduces the legal regimes of copyright and trademark in a museum context and offers museums a series of best practices for identifying and administering intellectual property.

Wilson, Lee. *The Trademark Guide*

A highly accessible and updated resource to help readers maneuver through the intricacies of trademark law.

These books and many others on arts law and business practices are available at the St. Louis Volunteer Lawyers and Accountants for the Arts library, located within the Regional Arts Commission office, 6128 Delmar. The collection's catalogue is searchable on the Web, [www.vlaa.org](http://www.vlaa.org).