

## Chapter 9

# Intellectual Property

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### Learning Objectives

In this chapter, readers will:

- Understand the basics of copyright and trademark law
- Know how to establish a copyright
- Discern various types of works
- Recognize the rights that are protected by copyright
- Identify what constitutes infringement
- Find out how copyright holders license a work
- Consider how Creative Commons offers an alternative to copyright
- Differentiate trademark from copyright protection
- Know what is necessary to establish a trademark

### Introduction

Media industries sell stories, ideas, and information. Once created, others can easily appropriate the property. Intellectual property (IP) law defines the ownership rights for content produced through the creative labors of the mind, and in the digital age a good deal of money is spent, lost, and invested in “IP” by media organizations around the world. At the state level, the Louisiana Office of Entertainment Industry Development (Loren C. Scott & Associates, 2013) in 2012 reported nearly \$800 million in terms of media productions including \$11 million in the creation of infrastructure for state-based productions. Protecting media products is essential to this continuing investment and that requires some legal oversight. The state of Louisiana defines IP as an “incorporeal” (Incorporeal movables, LA Civ Code 473), which means that IP is regarded the same as stocks, bonds, and other financial instruments minus a tangible nature for the purposes of financial liabilities and control. IP law protects the creator by insuring a chance of profitability. There are generally three areas of IP protected by law—patents, trademarks, and copyright.

### Patents

Patentable inventions are beyond the focus of this chapter because they generally are not media products, but they are a form of IP. From the patent pools of early radio to the politicized maneuvering of digital television standards, patent disputes have shaped the media marketplace by defining the nature of home media inventions and their costs. Similar to copyright in this respect, patents protect the IP of inventions, processes, and useful adaptations of existing ideas. The intention of patent protection is to promote the creative process by allowing the inventor a limited period of exclusivity for profit making based on a registered patent for the original design and execution.

### Trademarks

While copyright and patents protect creative ownership rights, another set of IP rights affect market behavior. Laws that regulate branding through trademarks and service marks primarily exist to keep competitors from acting unfairly concerning product identification. Establishing a product identity (or brand) can be a complicated and expensive process that may involve icons, names and slogans such as “ONE LOVE,” the motto used by Raising Cane’s Chicken Fingers, or the iconic trademark of the black-and-gold fleur-de-lis used by the New Orleans Saints. Properly maintained, a product or organization’s trademark establishes a corporation’s image (or brand) in the marketplace. The intention of this marketed identification is to afford consumers a symbolic association between the product and its provider so that they can make a reasonable choice based on their preference for what the service mark or trademark represents. Trademark law is covered more completely at the end of this chapter.

## Copyright

Copyright protects original works of authorship such as literary, musical, pictorial, or graphic expressions including some forms of computer software (Copyright Act, 17 U.S.C. § 102 (1976)). The work must be original to the copyright holder and have a certain minimum amount of authorship that can be attributed to them. Names, titles, and short phrases do not qualify for copyright protection but may qualify for trademark protection. The goal is to protect the actual expression of the idea; the mere idea itself lacks protection of copyright. For example, *HBO's True Blood* copyright protects literary and cinematic elements associated with that television series—the script, music, and videos—but it does not protect any story idea about vampires living in a small town. Otherwise, the *Twilight* movie franchise using this narrative approach would have to answer to possible claims of infringement.

Once copyrighted, the 1976 Act grants at least five specific rights to the holder including the most important one – the right to *reproduce* (or control reproduction) the work. Second, the right allows the user to *prepare derivative* works, such as translations, or transpositions of the work into a different medium, and it also protects serializing the work as well. Third, the right grants control over the *distribution* of copies and makes the work available for sale by the owner. Fourth and fifth, public *performance* and *display* rights allow the copyright holder to control the venue, including the time of presentation and to what public it is shown beyond the circle of family and friends. Broadcasting involves rights to a public performance of copyrighted works, but stations must have a license to allow such use.

The IP chart below compares the various rights. You will note most of the legal authority resides with the federal government, but a state such as Louisiana can exercise its interest in trademark protection through the secretary of state's office and provides some protection to copyrighted works. It also is important to understand that different titles of law protect IP, including copyright, trademarks, and the patents. The duration period for the different areas of IP—copyright, trademark, and patents—also varies according to the terms of different statutes.

### Intellectual property law enforcement

	Copyright	Trademark	Patent
<b>Protects</b>	Original expression of an idea	Promotion material or corporate image that identifies an entity	Useful invention or method
<b>Protection Starts</b>	When fixed in tangible form	Use in commerce or registration of intent to use	On registration
<b>US Statute</b>	17 U.S.C.	15 U.S.C § 1123 35 U.S.C § 2	35 U.S.C.
<b>LA Statute</b>	14 LA R.S. § 73.2	51 LA R.S. § 211- 300	
<b>US Agency</b>	Copyright Office, Library of Congress	United States Patent and Trade- mark Office	United States Patent and Trademark Office
<b>LA Agency</b>		Louisiana Secretary of State	
<b>Current Length of Protection</b>	Author's life plus 70 years. Others 95 years from first publication or 120 years from creation (whichever ends first)	As long as used in commerce. Federal registration lasts 10 years, but is renewable	Utility and plant: 20 years Design patents: 14 years

### Legislative History

In 1556, the charter of the Stationers' Company in Great Britain created the process to regulate printing, and stamp out the Protestant Reformation. Queen Mary was intent on helping the Catholic

clergy put an end to the distribution of Protestant literature. The British Stationers' Company was empowered with royal backing to approve books and presses, plus search out illegal prints, and destroy non-approved books and presses. Following her reign, Queen Mary's successors turned the tables on the Catholic Church and used this tool of censorship to advance the Anglican cause. By 1710, protests over the despotism of the Stationers' Company prompted Queen Anne to adopt the world's first copyright law with parliamentary approval. The Act prescribed a copyright term of 14 years with the opportunity to renew it once amounting to 28 years of exclusive control before the copyright expired and the work entered the public domain. This copyright bill remained in effect in Britain until 1842 when the duration of copyright protection was extended to 42 years.

IP legislation became part of the foundation of the newly formed legal system of the United States. Even before ratification of the Constitution, twelve of the original 13 colonies approved copyright protection while the federal government operated under the Articles of Confederation (Patterson, 1993). In 1787, the U.S. Constitution prominently featured in the first article IP's foundation in law:

The Congress shall have Power ... To promote the Progress of Science and useful Arts, by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

—*United States Constitution, Article I, Section 8*

The “exclusive right” feature of IP rights eventually would come into conflict with the rights of free expression protected by the First Amendment of the Bill of Rights, and later guaranteed by the Louisiana Constitution in Article I, Sec. 7. On one side, copyright law creates a predictable media marketplace by defining rules and responsibilities. Creators gain the *right* to control the use of the content and the revenue it generates. On the other side, copyright law denies to others the right to express the same ideas in the same fashion, giving to certain authors the exclusive use of this IP. This exclusivity is understandable given that copyright law was, at its origin, a government sanctioned monopoly (Patterson, 1993).

Although the constitutional provision set down the basic principles of IP, the necessary regulations were implemented at several levels. The U.S. Congress acted swiftly to create the statutory protection necessary for its enforcement. The first Copyright Act of 1790 granted authors the basic protection of printed works for 14 years and this right was renewable for an additional 14 years. Congress approved revisions to the original copyright law in 1831, 1870, 1909, and 1976, by either creating new forms of protected expression, such as musical compositions, or extending the term of ownership. It was not long after the revision of 1831, the U.S. Supreme Court affirmed copyright policy. In 1834, *Wheaton v. Peters* (1834) confirmed that copyright was not a perpetual right, which was set at 28 years plus a 14-year extension.

In addition to the U.S. Constitution, copyright protection was upheld by the authority of legislation and the courts. In addition, there are regulatory agencies charged with the day-to-day interpretation and enforcement of copyright law. As opposed to the “laws” created by the Constitution and the Congress, these agencies create “regulation,” but the term *regulation* reflects the guidance or control aspect of duties charged to government agencies overseeing IP rights briefly described below.

**Copyright Office in the Library of Congress.** Established in 1870, houses the Register of Copyrights. The Copyright Office examines applications, and records the registration of original and renewal claims. The Copyright Office administers compulsory and statutory licensing discussed below for public performances, transmission, and Internet connection.

**Copyright Royalty Board.** This board maintains a record of service providers for infringement cases, as well as the tools to find the owner of registered material. It is a part of the Library of Congress, and was created by the Copyright Royalty and Distribution Reform Act of 2004 (Proceedings by Copyright Royalty Judges, 17 U.S.C. § 8, 10: 801-805).

**United States Patent and Trademark Office.** This agency is part of the U.S. Department of Commerce. As its name implies, it grants to applicants patents and registers trademarks. It also maintains a searchable registry and advises the president and the Congress about the status of patent and trademark policy both in the United States and in global tribunals.

**World Intellectual Property Organization (WIPO).** The WIPO is the United Nations agency dedicated to the protection of IP through international trade. The WIPO created in 1970, following

the recommendations of the 1967 WIPO Convention. It replaced the *United International Bureaux for the Protection of International Policy*. The *United International Bureaux* created in 1893 was in response to the 1883 Paris Convention for the Protection of Industrial Property and the 1886 Berne convention for the Protection of Literary and Artistic Works (World Intellectual Property Organization, 2013). Together, the Paris and Berne Conventions established the rules for copyright protections between countries. The Paris Convention helped holders gain copyright protection in countries outside their own. The Berne Convention was the first multinational treaty protecting copyright for economic interests.

**Enforcement Bureaus.** While most IP enforcement actions come from owners, enforcement agencies work to control the more organized efforts. The Federal Bureau of Investigation, White Collar Crime Division and U.S. Customs and Border Protection work to discourage criminal copyright and trademark violations that include commercial operations and Internet distribution, specifically covering those items with a value of more than \$1,000 over 180 days (Criminal Infringement, 17 U.S.C. § 5:506). In addition, the Office of the Intellectual Property Enforcement Coordinator, part of the White House Office of Management and Budget, works with federal and international agencies to protect U.S. IP at home and abroad.

**Private and Non-Governmental Organizations.** There are private organizations integral to the protection of IP, especially copyright. Some of which operate through contractual arrangements with owners to collect payment. For example, the American Society of Composers, Authors, and Publishers (ASCAP) and Broadcast Music Incorporated (BMI) work with artists and broadcasters in order to manage licensing fees. The trade group Recording Industry Association of America (RIAA) is well known for actively pursuing copyright litigation against people and software systems that promote file sharing among consumers sharing music and movies on the Internet. Other groups such as the Harry Fox Agency and Copyright Clearance Center (CCC) identify content owners and negotiate the fair payment for specific uses of the recordings.

Trade groups such as the National Association of Broadcasters (NAB), National Cable & Telecommunications Association (NCTA), Consumer Electronics Association (CEA) and Motion Picture Association of America (MPAA) have helped shape policy for their industries. At the same time, groups such as American Library Association, Creative Commons and Electronic Frontier Foundation (EFF) aim from a consumer perspective to expand the rights of users. While the agencies and groups identified above are not an all-inclusive list of arbiters, they do represent major overseers of IP rights. Consider a scenario addressing some basic questions that arise in the legal process of copyright management.

### Establishing Ownership

Scenario: Two photographers with similar cameras independently walk up to Jackson Square in New Orleans. They produce nearly identical pictures. Who owns the copyright on the image? Both? Neither? Is it the first one to take it, or any one of the many photographers who had taken that picture before then?

The answer is that both photographers, along with many others, own the copyright to the Jackson Square pictures. Copyright protects the unique expression of an idea, but uniqueness is defined as “independently created.” The fact that the two photographers did not have a particularly novel idea is not as important as the fact that they did their own work. As a professional matter, publishers may demand something more imaginative, but that does not deny the photographer a right to claim personal ownership of the fixed expression of this visual idea.

It may seem strange that the law protects intangible IP when it is fixed (recorded) “in tangible form,” but that it is really not the idea; rather it is the tangible expression of the idea that specifies exactly what is protected in law. The tangible expression can be through the means of videotape, a script, a musical score, a recording, a painting, a book, or even a choreography notation. As of 1980, tangible forms would include electronic, or machine-readable records, software, and digital files, which are protected under federal law (Regarding Computer Programs, 17 U.S.C. §101 and §117 (1980)).

Once the work is fixed in its tangible form, two additional steps are needed to strengthen the protection, which are copyright *notice* and *registration*. Neither one is required, but both are useful in order to strengthen a claim of ownership by indicating the intent to protect the content, and by establishing the date of creation and location.

The city of Chicago discovered the trouble that occurs when these steps are ignored. Prior to 1976, a

copyright notice was required for protection. In 1967, an untitled model of a proposed grand sculpture by Pablo Picasso in Chicago's Daley Plaza was unveiled without any such notice. After his monumental sculpture was completed, Chicagoans discovered something about it: The city could not enforce its copyright ownership. Under the laws of the time, the lack of copyright notice on the model placed it in the public domain. The full size sculpture was considered a derivative or the original model. Since the model was in the public domain, the derivative monumental sculpture also entered the public domain (*The Letter Edged in Black Press, Inc. v. Public Building Commission of Chicago*, 1970). The 1976 revision to the Copyright Act removed the requirement of notice to afford some protections under law.

The Berne Convention Act adopted by the U.S. Congress in 1988 brought federal law into compliance with the Berne Convention—an international agreement from 1886 achieved in Berne, Switzerland. Works published after March 1, 1989 no longer required a visible copyright. As a result, three rules were authorized to guide copyright holders based on their publication date. Prior to January 1, 1978, a visible copyright notice is required, but after that time from January 1, 1978, to March 1, 1989, certain exceptions are allowed mainly for accidental omissions of the visible notice. The contemporary rule assumes someone owns title to the creative work, and that they do not have to sacrifice their copyright for lack of notice (Sheldon Mak Rose and Anderson, 2013). Unpublished works do not require a copyright notice.

Despite changes in the law, copyright notice is a good idea. The notice informs the public of an author's intent to protect copyright, identifies the author or owner, and the year of its creation. Works without notice are open to an "innocent infringement" defense, where the violator reasonably can claim they did not know the work was protected, which would mean a possible reduction in damages, or no compensation at all would be awarded if a dispute arose.

The visually perceptible notice contains three parts. First, the indication of copyright can be "Copyright," "Copr" or the © character. Second, the year of the current work's first publication—even if it a derivative, or compilation of previous works. Third, the name, or generally recognized abbreviation of the copyright owner's name or organization (e.g., ABC or NFL). The complete copyright notice would look something like, "©2014 Steven J. Dick," or "Copyright 2013 ABC Television." The notice should be clearly visible to the observer and normally at or near the title. Works published primarily in electronic form may place the notice with the credits at the end of the work in digital form, or at the end of printouts (US Copyright Office, 2013).

Copyright owners may strengthen their protection by registering the work with the U.S. Copyright office. However, registration is not required, unless the copyright holder is planning legal action against an infringer. Registration with the copyright office also may require the owner to deposit two of the copies with the Library of Congress. Notice with the U.S. Copyright Office creates a public record of the original work. It also provides a certificate of registration, and includes other advantages if registered in the first five years.

### Derivative Works

Creating a bestselling book may be profitable, but the movie version, a new edition, a translation, or even a spinoff can produce substantial additional profits. All of these are derivative works. The derivative work may claim a new copyright, but only for additional material. For example, the 1946 novel by Robert Penn Warren, *All the Kings Men*, gave the copyright holder benefits of the book until 2059 (author's death in 1989 plus 70 years). Yet a 2005 audio version of the same name carries a copyright title that will not expire until 2100. From 2059 to 2100, the text of the book will be in the public domain, but the audio performance will be covered by copyright for an additional 41 years assuming no future changes in the law.

The television producer must worry about accidentally creating a derivative work. Works of art, even published books that are visible in the background of TV scenes can leave a video producer open to a copyright complaint (Lyras, 1992). Second, digital editing capacity makes it easier to borrow sounds or pictures from copyrighted sources. The process called *sampling* lifts a phrase or sound from one song in order to make it a part of a new recording. Negotiating a copyright clearance for such a sample can be difficult and prohibitively expensive. There is no standard formula to calculate the terms of such an agreement. In addition, secondary users may want to negotiate for two copyright clearances—one from the writer of the song, and one from the performer of the sampled version.

### Compilations

A compilation is simply a collection of previous works, as in a body of known information. As such, the compilation copyright protects the work of creating/organizing the original material. Unlike a derivative work, which is considered a new product with its own copyright, the compilation copyright does not create a new copyright for that previous material—nor is it intended to protect the purely mechanical arrangement of information, such as the white pages of the telephone directory. The compilation copyright covers anthologies, some magazines, or other collections.

### Collective work

A similar concept is known as the *collective work*, where each separate contribution is new and added by a different creator. Individual contributions would then earn separate copyrights while the compilation, as a whole would be copyrighted for the original work held by the organizing owner. The owner of the collective work license then would only have the right to publish the individual contributions under detailed conditions. Consider this book, individual chapters were written by separate authors and the editors unified and arranged the content. Similarly, newspapers can enforce a collective work copyright on the newspaper as a whole, while individual stories carry their own copyright as well.

### Works for Hire

Much of the media depend on “works for hire.” A work for hire is a copyrightable product that is created as part of one’s employment. In such cases, the employer becomes the owner of copyright. This type of relationship between creator and owner falls into two broad categories—works prepared within the scope of employment (e.g., full time reporter) or those commissioned and ordered for a specific project (e.g., music for a motion picture). In *Community for Creative Non-Violence v. Reed* (1989) the Supreme Court outlined specific limitations based on the nature of the employee and contractor relationship. The Court set out specific rules to ensure that the relationship for creating a work for hire was an intentional one, and that it would prevent creators from losing copyright by mistaken oversight. An employer must exercise control over the employee’s work, workplace, and payments. The employee must be hired to do the type of work covered by the copyright, and ideally, the business would support that particular kind of work. Suppose a barista sketched an image of a coffee cup in her spare time, would she lose claim to copyright of her artwork? It depends on whether this was something she was expected to do as part of her job, and if the work was done during work hours and with employer resources.

An independent contractor relationship is legally defined by certain terms, and generally is limited to nine specific commissions: 1) collective works; 2) audiovisual works; 3) translations; 4) supplementary content to another work (e.g., illustrations, forward); 5) compilations; 6) instructional texts; 7) tests; 8) test answers, 9) atlases. New media content are likely to challenge these categories given the growing use of crowd-sourced materials where multiple authors submit an original work in digital format for use by others.

### Length of Protection

The duration of copyright protection is dependent upon when it was created, or first published, and who actually holds the copyright. Most works published after January 1, 1978 would be protected for the author’s life, plus an additional 70 years. Anonymous authors, pseudonym authors, or works for hire would be protected for 95 years from the date of first publication, or 120 years from the content’s creation, whichever ends first.

For works published prior to 1978, the rules regarding control become more complicated. The Copyright Act of 1909 established a duration of 28 years of ownership with an optional license renewal for a second 28-year term combined for a total possible holding of 56 years. The Copyright Act of 1976 automated the renewal to 47 years, or a total of 75 years for two terms (depending on the year of the original copyright). The 1998 Copyright Term Extension Act, named after U.S. Rep. Sonny Bono who was responding to the interests of Hollywood owners, added another 20 years, for 95 years in all (US Copyright Office, 2013). Before the passage of the 1976 Act, Congress passed nine interim extensions for copyrights that began with one starting in 1918. The effects of these term extensions were to allow the

earlier works to grandfather the prior holdings into the extended protection. One exception was granted to works that began their first term between 1950 and 1963, and that still required renewal after 28 years for continued protection.

### First Sale Doctrine

The first sale doctrine (Limitations on exclusive rights, 17 U.S.C. § 109) limits the control of a copyrighted work to the first time a copy of the original work is sold. In effect, once a book, CD, or DVD is sold to a consumer, the copyright owner no longer has the right to control later resale or loan of that work. This doctrine not only protects libraries, but marketing of used media and rentals as well.

As new media promote more creative works for online distribution, there is the question of copyright enforcement through digital rights management, which is where the *first sale doctrine* comes into play. It is unclear if digital copies enjoy the same rights under the first sale doctrine as analog versions (Asay, 2013), and the American Library Association (2013) suggests two other issues are at hand. First, digital rights management threatens the legitimate secondary transfer of IP. Second, there is the growing trend to rent/license content (for a limited time), so that most consumers never actually own a copy.

### Infringement

Anyone who violates the exclusive rights of the copyright holder commits infringement. The owner may go to court and seek a civil action, asking for relief within three years for civil infringement and five years for criminal infringement (Limitations on Actions, 17 U.S.C. § 507). Relief may come in the form of an injunction to halt the infringing use while the court decides the case. The next step in a successful claim would be to impound the infringing material, and safeguard those items used to create infringing copies (e.g., molds, masters, film negatives), and finally the destruction of the infringing content is required (Copyright Infringement and Remedies, 17 U.S.C. § 501-513).

In addition to the destruction of copies, a copyright holder can demand actual damages, in terms of lost revenue, and the infringer's profits or statutory damages. Recovering statutory damages relies on two steps in the process. First, the court must find that the infringement was intentional. Second, the judge must arrive at a just settlement. For non-intentional uses, statutory damages range from \$750 to \$30,000 per work that was infringed. If the copyright owner can show intentional infringement, statutory damages may increase to \$150,000 per work. Criminal infringement occurs when the reproduction of more than one copyrighted work occurs in a 180-day period, which has a total retail value of more than \$1,000. The remedies are the same for civil infringement, along with the addition of a \$2,500 fine for someone who intentionally removes, alters, or places a false copyright notice on someone else's work. In addition, the defeated party in a copyright trial may have to pay the cost of the court and attorney's fees (Copyright Infringement and Remedies, 17 U.S.C. § 501-513).

### Fair Use

Copyright was not intended to limit public criticism or to impede education through its restriction on uses. There is also the reasonable expectation that a person who has a legal copy can actually view it. Fair use is the section of the copyright law that defines the acceptable uses of a copyrighted work (Limitations on Exclusive Rights: Fair Use, 17 U.S.C. § 107). Unfortunately, fair use is not a bright line test but one determined by applying the criteria of four factors regarding the use of copyrighted material:

- (1) **Purpose** and character of the use, including whether such use is of a commercial nature or for non-profit educational purposes;
- (2) **Nature** of the copyrighted work. Does the work lend itself to commentary or is it purely factual material?
- (3) **Amount** and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) **Effect** of the use upon the potential market for or value of the copyrighted work.

There also is a specific statutory license created by the Copyright Act (17 USC 112), which though it is not fair use does provide the right to the public performance of a copyrighted work and allow the recording of a copy to facilitate broadcasting. This provision means a broadcaster can place a copy of a copyrighted song on a server for later transmission, or hold one in its archives without violating the terms of its license.

### Plagiarism

Plagiarism extends the concept of copyright infringement to an ethical duty for creators. The term essentially defines the unethical representation of another person's work as one's own. An individual can infringe on a copyright without representing it as their personal work, such as selling pirated music, but plagiarism defines a misrepresentation made of another author's work without attribution to it creating a false impression that it belongs to the secondary user. Plagiarism protects moral rights rather than legal rights of ownership, and though not necessarily illegal, it can easily violate contractual relationships. In absence of agreements, organizational policies usually guide any determination of plagiarism. As in copyright violations, there are two broad areas of concern—the value and the amount of the misrepresented material.

**Value.** In almost all copyrighted material, there are some truly unique ideas, sounds, or images. It does not take much for secondary authors to violate the creator's rights; key concepts and novel interpretations should be properly attributed. Facts that are not generally available, or known, must be referenced. In academic or journalistic writing, the advantage of source citations is found in the validity and credibility given to a work by connecting it to existing experts and their authority.

**Amount.** A large volume extracted from a single source can easily raise suspicion of plagiarism even when partially cited. In 2003, Pulitzer Prize winning journalist, Rick Bragg covered the Southeast for *The New York Times*, while based in New Orleans. The national newspaper, still smarting from the sting of a national scandal involving admitted plagiarist Jayson Blair, suspended Bragg for two weeks when it came to light that a mostly unpaid reporter was sent to Apalachicola, Fla. in order to gather facts for a story about oystermen that appeared under Bragg's byline without acknowledgement of his help. Bragg admitted he had done little first hand reporting for the piece, and only flew into town to write and file the story under his name. His account of the reporting raised questions about whether another interviewer and fact collector should be given some byline credit for the article. Bragg was suspended for two weeks, but then he resigned his position in protest.

### Licensing Rights

Most of the time, a copyrighted product comes with restrictions. The process of carefully defining what a customer can do with copyrighted material is called "licensing." The limits placed on buyers insure the copyright owners' ability to maximize their revenue. It may sound sort of greedy but it is a necessary and practical reality of the media marketplace. There are a limited number of distribution opportunities for most media authors and composers. Most creators often expect only a single run of their work. Once an audience member has paid \$10 to see a movie, the willingness to pay again is substantially reduced. The cost of the license is based on the original value of the material, and the potential for a secondary market. The \$10 price of a DVD is based on the assumption that it will be used for home entertainment and nothing more. In order to have the right to exhibit the film publicly, it would reasonably cost more.

Licensing is the right, granted by the copyright holder that is necessary for the buyer (licensee) to be entitled to broadcast, recreate, or perform a recorded copy of the copyrighted work. Types of licensing contracts can include: 1) A flat fee for a defined period of usage, or 2) Royalty payments determined by the number of copies of the work sold based on the total revenues acquired. Most music licensing agreements include some form of compensation for the copyright owner — when and if the work becomes part of another creative production (i.e. movie, play, television show) according to the profits gained from the new product.<sup>14</sup>

Producers of video content may wish to include copyrighted works within a larger production, and so legally binding agreements are necessary to protect the original producer. Two specific licenses are common. The *synchronization* license allows the use of musical works as background in a motion picture, television program, video, DVD, or other video production. The *master use* license allows use of the musical work as a soundtrack, bumper, lead-in or background to a motion picture. In addition, a license might be limited by the duration of use, number of times performed/displayed, size of venue, and exclusivity.

Syndication, a common method for licensing rights, involves selling the product across several media outlets. Rather than charging the same cost for all outlets, the cost is calculated based on potential audience. A group of media outlets with each one licensed to present syndicated content to their audiences within a defined geographic area. Popular television programs, radio shows, and newspaper features

including editorial columns and cartoons, are syndicated today for distribution throughout parts or all of the United States. Suppose an outlet in Baton Rouge would be asked to pay more for the same syndicated content than it would have to pay in Alexandria, La. As cable television and the Internet expand the boundaries of the media marketplace, so too are syndication deals been adjusted accordingly. Cable television brings stations into markets outside the normal coverage area, and while this expansion not only increases the station's reach it also distributes syndicated content beyond the originating station's regional boundaries.

### **Compulsory licenses**

Certain media outlets, including broadcast stations, produce a compilation of so many copyrighted products and programs that it becomes nearly impossible for a reasonable market to do business without a standardization of payment. For some purposes, the U.S. Congress has enacted specific laws to create a standardized price for copyright payments. These are called compulsory licenses or sometimes, statutory licenses. In most cases, media companies record their use of the content and make a standard payment to an arbitration panel. The arbitrator assigns a payment to each copyright holder.

After years of battles between cable/satellite companies and traditional broadcast companies, a state of relative calm has been achieved through the use of a compulsory license scheme that allows cable and satellite television systems to rebroadcast terrestrial television (Limitations on Exclusive Rights, 17 U.S.C. § 111 and 119). This license allows cable and satellite operators to retransmit TV station programming into their local markets without negotiating for individual programs. There is no set rate for these "retransmission consent" agreements so broadcast stations (or groups) are pitted against cable/satellite operators for carriage fees. Problems arise when negotiations reach a stalemate and channel blackouts become the result.

Radio stations, both online and traditional broadcasters, play so many songs on a daily basis that negotiating with each copyright owner would become a practical impossibility. So three types of distributors and two methods of licensing are used in order to make it manageable. Distributors include traditional broadcasters, Internet broadcasters, and online jukeboxes. Traditional broadcasters include radio, television stations, and Internet networks, but the interactivity of online audio streams allows for even more options. First, there are web radio stations that may be Internet streams of traditional stations, or they may be Internet-only stations. Internet jukeboxes allow the user to select songs or create a custom audio stream by selecting and rejecting content and include popular services such as Pandora and Spotify.

Blanket licenses are private agreements between the distributor and the copyright owner; usually offered in bulk on behalf of several copyright owners. Traditional radio and television stations, and some Internet broadcasters prefer these private agreements made through companies such as ASCAP or BMI. However, a number of Internet broadcasters, and most Internet jukeboxes, prefer compulsory licenses from the Copyright Royalty Board (CRB). In January 2006, the Library of Congress established the CRB—three judges who oversee the copyright law's compulsory license by setting rates and distributing payment to the copyright owners. The process has been complicated by litigation and changing legislation but benefits both sides in the process. The music industry gains an automated payment system and users gain the interactivity of radio services that react to their music tastes (jukeboxes).

### **Internet**

IP on digital platforms like the Internet poses a challenge in terms of detecting stolen property and guarding against future abuses. Consider the petty theft that occurs when a person shoplifts a candy bar from a grocery store. The storeowner is no longer in possession of that item and therefore cannot profit from it. When a person takes an MP3 song without payment, the owner still has the song and can continue to sell it. The music industry admonishes consumers that they are purchasing digital music for personal use only, but it would be laughable for a candy storeowner to restrict when and how someone uses the candy purchased, or with whom they share it. The candy thief takes only one item, while anyone with a digital pirated copy can continue to distribute the recording with equal quality as the original version.

Nowadays popular activities like fan fiction, memes and AV sampling, can violate IP. Some of the harshest and possibly justified criticisms of IP policy emanate from the struggle to balance the competing

rights. For example, the length of copyright protection should be expansive enough to encourage and reward authorship, yet brief enough to fulfill the “for limited times” clause of Article 1, Sec. 8, which would grant public access after an interval of time. Over the years, legislators and courts have tried to strike a balance between these interests. Thus, an ongoing battle exists between technologies, licensing, and public mores to determine the shape of the future market for IP on the Internet.

### **Creative Commons**

There is recognition that some copyright holders profit greatly from someone else’s work, but the increasing trend toward sampling sounds of favorite music, fan fiction, group stories, and free software has created a general desire to establish a legal space for non-profit or low profit content.

In response to a number of factors such as lengthening copyright terms, the social nature of media production, more information sources, and digital technologies, one group has taken action to lighten the burden of copyright laws. The Creative Commons movement was an attempt to formalize this space for the free exchange of ideas and information. Content producers were encouraged to distribute their products with a mark that would define allowable low cost uses. Broad parameters were recommended, including adaptation with or without attribution, allowing adaptation for free distribution, and even offering works for commercial adaptation. Producers were encouraged to place this notice on their work or web pages: “This work is licensed under a Creative Commons Attribution 4.0 International License” (Creative Commons). Enforceability of the Creative Commons license is yet to be legally tested, but the innovation of such licenses is becoming more popular since it affords innovative space for IP development.

### **Branding and Trademark**

Identifying marks have been used over the millennia to distinguish the creative works of artisans and artists. Egyptian stonemasons, European potters, and printers have “signed” their products one way or another. These symbols and logos were especially important to the trade guilds of medieval England. The stronger the reputation the guild enjoyed, the better it was for the prosperity of the host towns and villages (McKenna, 2007). The concept of branding actually came from the cattle owners of the old American West, who with hot irons burned into the hide of their livestock an identifying symbol of possession. As the cattle grazed and traveled together, it became necessary to observe by brand which rancher owned which cattle. Today trademark law achieved the same goal, which is to make it clear for all to see which product comes from which supplier. The purpose of this section is to discuss how IP law protects the intangible assets of advertising through government oversight.

The reasoning behind trademark law is to provide consumers with information and protect the substantial investment made in the creation and promotion of brand names or trademarks. In one early case, *Coats v. Holbrook* (1845) the court’s ruling supported legal protection from an illegitimate diversion of trade (McKenna, 2007). Congress passed two trademark acts in 1870 and 1876, but the controlling legislation today is the Lanham Act of 1946 (Rules and Practice in Trademark Cases, 37 C.F.R. § 2). Congress introduced minor changes in 1988 in order to protect trademarks not yet offered in commerce, and then again in 1995 and 2006 in order to guard against trademark dilution.

In today’s interconnected world, the brand image may be the only thing that connects the consumer with the customer. For example, we can accept the Café Du Monde of New Orleans might be just as successful operating under a different name given its investment in advertising, customer service, and product quality. However, the Café Du Monde name itself is valuable due to its long-term investment in New Orleans, and it would be unfair for a rival business to disrupt its position by profiting from the confusion of brand identification.

Still, there are reasonable limits that do not affect the investment. Should the Café Du Monde be allowed to restrict the literal English translation of its name—“Coffee of the World”? Would protecting its brand integrity mean that *Le Café du Monde* in Quebec should change its name to avoid confusion? In some ways, it may depend on a business decision and a willingness to invest in the protection. While Café du Monde did not seek to protect its name against the Quebec company, Dominique Ansel, the creator of the *cronut* (promoted as a combination of a croissant and a donut), has aggressively protected his trademark (Collen, 2014) including one derivation in Louisiana. A Shreveport restaurant, Sevendipity Café, received

a cease-and-desist letter for its use of the name “creaux-nuts,” which Ansel felt was too similar to go unchallenged (Associated Press, 2014).

### Trademark Law

In just about any market, businesses operate with similar names or brand logos (e.g., Agave and Blue Agave restaurants). If these businesses choose to ignore the potential confusion created by a similar service or trademark, they can weaken their own identity. What if a similar logo indicates a business with a bad reputation and that impacts the original trademark holder, or suppose a third business chooses a similar sounding name (e.g., Wild Agave) that could convince the public it is a spinoff of the original? A protected service or trademark must be specific and unique to the trademark company.

Once established, it comes under the legal protection of federal law and that protection lasts for as long as the registered mark is used. There are four categories related to the legal concept of trademark. Strictly speaking, “trademarks” are names for tangible products only. Abita Beer has a *trademark* on its brand name while the telecommunications firm, *CenturyLink*, has a *service mark*. In the United States, there is virtually no difference in the protection provided, and trademark has become a generic term.

A third category covers the product brands managed by groups. These items include the *certification mark*, the *collective mark*, or the *collective membership mark*, and typically are owned by a group for the benefit of its members (Bitlaw, 2013). The certification mark does not protect a specific product, but the endorsement of a product (International Trademark Association, 2013), such as, the Louisiana Department of Agriculture and Forestry’s Certified Louisiana, Certified Cajun, and Certified Creole marks (Louisiana Department of Agriculture and Forestry, 2013). A collective mark is similar to a trademark, or service mark, except that its owner generally does not sell anything while the membership collectively uses it in commerce. For example, the Louisiana Association for Justice does not provide legal services, but its members may promote their services under the collective mark of its banner. The collective membership mark can create controversy though once others latch onto it. In 2011, the Zulu Social Aid and Pleasure Club sought to bar the Mardi Gras Beads Factory in Bridge City from selling items using the Krewe’s collective mark (Associated Press, 2013).

The fourth category is classified as *trade names*. The trade name is the official corporate name—anything other than the real name of the person. Registration of a trade name generally includes where and how you are going to use it. For example, the common corporate name “Cajun” is not helpful because there are more than 250 variations on that name in Louisiana. However, K-Jon Sewer and Septic Service in Lake Charles, Louisiana is far more specific. Registering the trade name establishes a record of the brand and corporation (Beesley, 2013). Many states record, and some even require, official corporate names as a matter of law. Louisiana requires government registration when trade names are used in communication and commerce.

Within the media, a corporate name is common and when media consolidate, one company may continue operating under the new name. In Shreveport Louisiana, KDKS joined *The Radio Group*, which became a part of *Access 1 Communications* (The Radio Group, 2013). The trade name may have evolved from KDKS, The Radio Group, to Access 1 Communications. At the same time, the service mark for KDKS was maintained; except for the lesser protection given to trade names, the concepts are substantially similar.

A corporation may have any of the above identifying marks and products to promote with it. Ampex, for example, provides AMPEX videotape and AMPEX Duplication Services. It may also contract with private companies for AMPEX certified repairs. The protection is similar across these brands in the United States but may appear to be quite different when protected in other countries.

The diversity of brands and their protected marks discourage infringement of the company’s name. In 2009, a version of Popeye entered the public domain and others like it eventually will reach that destination. In 2023, for example, the first of the popular Disney characters will lose copyright protection. There is a wrinkle though, while copyright ownership lasts for a fixed period, trademark law sustains a brand image so long as it is used in commerce. The question to consider then is: “What can be done to protect an image that is both part of the public domain and also in use as a corporate trademark?” Will the less familiar version of Mickey Mouse—Steamboat Willie—allow for more lucrative images to follow it

into the public domain, such as Disney's popular array of princesses?

### Registration

Registration is not required for protection but remains the best proof in legal disputes. The bad news

#### **The intellectual property of fried chicken: One Love?**

*Raising Cane's Chicken Fingers* is a fast-food restaurant headquartered in Baton Rouge, La. The popular chicken eatery has grown to operate dozens of restaurants in seven states following its debut in 2001 near the LSU campus. *Raising Cane's* discovered in 2013 that not everyone is a fan of its brand, or more exactly the terms used to describe its passion for fried chicken. For years, *Raising Cane's* labeled its passion for cooking fried chicken with the motto, "ONE LOVE." But the chicken franchise discovered that its registered motto was the subject of a trademark lawsuit from the estate of famed Jamaican reggae singer, Bob Marley.

In representing the deceased singer's widow and children, the Marley estate sought to trademark the phrase but *Raising Cane's* legally registered "ONE LOVE" eight years earlier. The trademark infringement suit was filed after the U.S. Patent and Trademark Office denied the estate's application, and Marley's legal counsel felt it necessary to sue the Louisiana restaurant chain in order to reclaim use of the phrase. The suit claimed that "ONE LOVE" was associated with a popular Bob Marley song of the same name, and charged *Raising Cane's Chicken Fingers* with "willful and deliberate" trademark infringement in creating a false association with the singer's recording, and intentionally interfering with the Marley estate's business relations.

It seems unlikely that *Raising Cane's Chicken Fingers* expected the Marley estate to register those two words and enter into restaurant business, but in trademark property law one key question concerns the likelihood of confusion in the consumer's mind regarding any slogan or symbols used by competing entities. In order to prevail in such a lawsuit, the plaintiff's attorneys would have to successfully show that consumers would confuse the fast-food restaurant's use of ONE LOVE with the reggae singer's song from 1977 with the same name. From the singer's perspective, it is valuable to show all potential infringers that it protects its trademark. Did the chicken restaurant define ONE LOVE well enough to be separate in the consumers' minds? In the end, it might have been safer to come to an out-of-court settlement than risk trial.

is that trademark registration can be difficult to obtain, and it is an expensive, complicated and time-consuming process. In the end, the applicant may not obtain the trademark desired. Beyond the local market it is risky to leave a prominent brand unregistered. The Louisiana Secretary of State's office registers businesses, and its trademark registration records the historic use of the trademark, but this office does not guarantee the exclusivity that is needed for legal protection. The registration may not be entirely effective but then it does not cost much either. In mid-2013, Louisiana's registration fee was only \$75 per mark, plus the cost of new or changed business registration. While legal assistance is not required, the help of a qualified attorney is recommended by major agencies regularly involved with securing or maintaining service marks and trademarks.

The secretary of state's database in Louisiana will check for the same, or similar names. Images are more challenging to find due to the difficulty of automatically differentiating images. Lutzker (2003, p. 100) noted how "trademark searching is like digging a hole looking for something that may not exist." Due diligence is difficult to achieve especially when similar icons and words are overlooked in the search process, which can cause problems later. An honest attempt to search for conflicting brands may show good faith, which will mitigate damages later, especially in cases of unintended infringement.

Applicants should perform their own search to identify anyone else using their desired logo or brand image. An overlooked contender to a trademark or service marks can set the process in reverse. Federal protection is obtained through the U.S. Patents and Trademarks Office, and registration with that office

gives pretenders a notice that the trademark is off limits. It increases penalties, affords some international and Internet protection. Organizations and businesses also may register an “intent to use” form for a trademark up to three years in advance. Federal registration also can be expensive. The base fee was \$375 at this writing (United States Patent and Trademark Office, 2013), and additional fees due to errors, or multiple filings in the process, will add up in terms of time and expense. The process easily can take more than a year and cost thousands of dollars. Despite the involved costs and risks, registration affords dividends once a brand mark establishes prestige in a particular market.

International protection is beyond the space available here necessary to detail each country’s legal system, particularly since not all countries recognize international protection, and fewer enforce it. It is a step though that should not be taken lightly or without assistance since it could mean an additional three years in the process. In domestic or global quarters, registration of a trademark is a good investment, given what it offers for the design, advertising, and promotion of the brand. As the company grows in reputation and goodwill, the value of the brand will outweigh the costs of registration.

### Strength

Some brands are easier to defend than others. The relative potential of a brand to be associated only with a corporation is referred to as the *strength* of the brand. For example, Kodak was long considered to be a strong trademark because it had no meaning outside of the product. Center City Television, on the other hand, is simply descriptive. Customers may know the *company*, but the *mark* would be harder to defend. The new company, Center City Radio, may successfully argue that it does not infringe on the earlier trademark. One way to think of trademarks is by considering their distinctive quality on a continuum from strongest to weakest:

*Fanciful names* are those terms of marketing devoid of meaning outside of the company. In Louisiana that would bring to mind, “Tabasco,” the famous hot sauce that is both trademarked and patented. Even though the etymology of the word *tabasco* has Hispanic and Native American origins describing the nature of soil, it is better known as the brand of hot sauce manufactured by the McIlhenny family of New Iberia, La. and placed on restaurant tabletops around the world. The principal advantage of fanciful trademarks is they have little or no meaning beyond the product itself, which gives them a stronger position in the marketplace.

*Arbitrary names* have meaning but that meaning is usually not associated with the product itself, such as *Zatarain’s* food and spice company of New Orleans. It is a family name, but one that is more associated with food than its founder. Emile A. Zatarain registered his trademark in 1889 in order to sell his brand of root beer in Gretna, La., and today the *Zatarain’s* brand is famous for pre-packaged Cajun and Creole seasonings and other food products.

*Suggestive names* have meaning somewhat associated with the product such as *Maison Blanche*, which refers in French to the “white house” chain of department stores that grew out of the first white house located on Canal Street in New Orleans.

*Descriptive names* simply state what the product offers in simple terms, such as *Community Coffee* or *Capital City Press*, both of which are firms based in Baton Rouge, La.

*Generic words*, such as Channel Six Television, cannot be trademarked and are considered weak product brands. Even a weak trademark can be defended though; it is just harder to do. The company must show that it has invested in the brand name and it has acquired secondary meaning in the public’s mind. If a TV station is using “Storm Team” to describe its weathercast for example, it would be a fairly weak trademark given its almost generic popularity. Stations must show that their audience understands that the “Storm Team” refers to the weather programming on Channel Six, rather than say the “Weather Friends” on a rival channel.

Television stations are in a unique position. Their call letters can become a descriptive brand, such as WXXX-TV 12, which would be unique to the nation. Normally the call letters summon that channel to the public’s mind without confusion. However, a problem could arise supposing a new station adopts call letters or a name similar to a station already broadcasting in the market, such as KISS-FM. The FCC stopped negotiating such disputes in the 1980s, which now are simply a trademark matter.

### Slogans and More

Disputes also can arise over similar slogans and jingles. Slogans are too short for effective copyright protection but are subject to trademark protection. The University of Louisiana at Lafayette registered “Geaux Cajuns!” as a trademark in order to associate the slogan with its university athletic sports programs and souvenirs. With slogans, applicants must understand why the trademarks are protected in the first place. Trademark law does not give ownership rights, only the exclusive-use rights. There is no problem with the fact that multiple Eyewitness News programs use that brand in this country, but there is a problem if two or more stations compete using that name in one market since it would tend to confuse the audience.

### Market

Active brand protection is a necessity if any infringement becomes a fact of the marketplace. If an introduced product brand resembles an existing company’s images or name, the owner is legally required to respond or risk losing their interest in the property. Disney is often put in the uncomfortable position of asking schools and pre-schools to remove unlicensed images, but the issue is not just corporate profits from use of the images, it is also the fact that poorly drawn infringing images distort or dilute the brand. Protection requires an awareness of the brand’s image and impression in the market that goes beyond competitor’s marketing.

Registration of a trademark is dependent on how a company defines its market. The investment would be lost if the trademark was not used in the registered area. Not only would it be a waste of money and time to register it, the protection provided by the registration would diminish the meaning for the brand actively used in commerce. If infringement occurs without complaint or challenge from the owner, it is lawfully considered to be abandonment, which is defined by the Lanham Act as the non-use of a trademark for three consecutive years (International Trademark Association, 2013).

Trademark protection can be difficult to maintain given such vagaries. A timid approach is ill advised, and yet it also would be unwise to exaggerate minor similarities in court. Trademarks are tools that are used and reused, but valuable ones must be vigorously defended. In the fast-paced world of competitive industry, market leaders are diligent in creating a trademark protection plan that would encompass at least four objectives.

1) market awareness; 2) business awareness; 3) audience awareness; 4) documented history; and 5) consistency.

**1. Market Awareness.** If a media outlet hopes to defend its service or trademarks, it must do so by not stepping on the rights of others. A good trademark policy begins by understanding the market. How do the customers differentiate products? How diverse are their products? What marks are being used and recalled? Because media markets differ the audience in one market may see things quite differently from those in other communities.

**2. Business Awareness.** Media companies tend to be full of creative people who create valuable products all the time. Smart competitors evaluate their media workers and content for exploitation. Are rivals stealing ideas from in-house authors and artists or vice versa? Media professionals must pay close attention to stringers, contractors, and part-timers. Have they taken something that does not belong to them? Do they own their creations? Successful firms identify media products for exploitation and evaluate how to protect them. In order to make the policy clear and avoid misunderstanding, they circulate internal memos and press releases to clarify it.

**3. Audience Awareness.** A trademark’s value also hinges on the audience’s awareness and understanding. Can the company show it has achieved that valuable “secondary meaning” of brand identification? Where, when, and how strong is this impression? This information not only helps in product recognition, but also supports the owner’s ability to defend the trademark as necessary.

**4. Documented History.** As in other forms of IP, creation details define the limits of protection. When was the brand created, by whom, and when it was first shown to the public are important elements under

the law. Continuous records use and consistent image can be essential to its protection. In 2013, a federal judge in Louisiana ruled against the New Orleans based firm *Action Ink* that sued Anheuser-Busch for its use of the phrase “Ultimate Fan.” *Action Ink* claimed to have coined and used the phrase since 1983, but the judge ruled that the company had abandoned its use of the phrase and lost trademark protection (Brown, 2013).

**5. Consistency.** The ideal trademark is immediately recognized and associated with the corporation or product. A trademark is strongest when the keepers are absolutely fanatical about expressing it exactly the same way on every occasion. It is easiest to make this association if there is rigorous consistency in the presentation of the brand. While it is always tempting and sometimes necessary to update corporate images, great care is necessary. Radical alterations or too many changes reduce the advertising power of the brand image, and may require new legal protection.

### The Internet

As the Internet expands its global reach to various corporate markets, it also increases the need to protect the brand online. Establishing a brand on the Internet expands the target market from a regional to international sphere. Companies hoping to build a campaign have to protect their investment. Otherwise, they open themselves up to challenges beyond their customary geographic market. For example, Blue Sky Foods of Franklinton, La., may eventually want to discuss a trademark agreement with Blue Sky Vineyard of Illinois to avoid any confusion.

The most common cause of an Internet trademark dispute is based on the universal resource locator or URL—commonly known as the web address. There have been a number of disputes involving the use of a trademark name in a URL, and one major threat was posed by “cybersquatting”—trafficking in web addresses for desirable trademark names to profit through intentional misspellings of web addresses resembling familiar products and services.

In 1999, the Uniform Domain Name Dispute Resolution Policy (UDRP) was introduced in order to manage such disputes. This policy was used to settle domain name disputes covering more than 31,000 URLs. The United States represented 42% of the claims (World Intellectual Property Organization, 2010). In addition, the U.S. Congress passed the Anticybersquatting Consumer Protection Act (False designations of origin, false descriptions, 15 U.S.C. § 1125(d)). The law directed the Secretary of Commerce to recommend to Congress the appropriate guidelines for resolving such disputes. By pointing in part to the UDRP, the Secretary of Commerce urged no action (United States Patent and Trademark Office, 2013).

The Internet Corporation for Assigned Names and Numbers (ICANN) established a procedure for actions brought by any person who filed a complaint for the following reasons:

- One domain name is identical, or confusingly similar, to a registered trademark or service mark in which the complainant has rights.
- One domain name owner has no rights, or legitimate interests in the domain name, and because the domain name has been registered, the filing was made in bad faith.

Once these circumstances are verified by ICANN, the URL registry will be transferred to the complainant but no financial penalties or fines are levied against the cybersquatter under this act. However, the Anticybersquatting Consumer Protection Act did create a means for a trademark owner to recover the use of the URL and possible damages from the cybersquatter in federal court. In order to achieve that end, the trademark holder must show the following in evidence:

- The domain name registrant acted in bad-faith with intent to profit from the trademark.
- The trademark was distinctive at the time the domain name was first registered.
- The domain name registered is identical to, or confusingly similar, to the trademark, and
- It qualifies for protection under federal trademark laws — that is, the trademark is distinctive and its owner was the first to use the trademark in commerce.

The last requirement poses the biggest obstacle to the media industry. If a cybersquatter learns of a program or production that has yet to be released, it can register the trademark name before it is used in public.

**Fair and Unfair**

Aggressive corporate marketing produces innovative efforts to expand trademark protection beyond

**Case in point: Who Dat?**

For the football fans of New Orleans, the phrase “Who Dat?” is a shorthand version of the chant, “Who dat say dey gonna beat dem Saints?” and a common cheer heard among team fans on certain Sundays in the Superdome. It also is a familiar sight to see the phrase on t-shirts around town. In 2010, the National Football League (NFL) sent letters to several t-shirt outlets demanding that they stop the unlicensed distribution of shirts with the phrase, “Who Dat”. The NFL claimed it owned the trademark of the name through the New Orleans Saints. Sports marketing is one of the few areas where trademark images create substantial revenue for a professional sports franchise, a university, and other teams. Thus, the battle over the phrase was waged more than just to protecting corporate symbolism, and the controversy clearly created outrage when the governor and other legislators began issuing public comments against the NFL. The question turned on the rights of the powerful NFL ownership versus small shopkeepers in New Orleans. Key issues were public domain ownership, and competing company ownership.

The phrase “Who Dat?” is nonstandard English, but it does have a long history in Louisiana, and especially in New Orleans sports. There is documented evidence of its use dating back a full century. The historic use of the phrase led several merchandisers to claim that “Who Dat?” was not owned by anyone and that the NFL should recognize its rightful place in the public domain. The alternative argument was that business corporations often use phrases that are in common use but register them for marketing purposes. It is the association with the business that makes them defensible as a trademark, and does not impose any ban on their common use. Neither the New Orleans Saints nor the National Football League represent unique terms, but both are trademarks. In all practicality, the tee shirts being sold would be of far less value without their association with the NFL’s Saints.

On the other hand, even if the phrase is associated with the Saints, who rightfully should own the phrase (if anyone)? Did the NFL, or the Saints, invest sufficiently in the phrase to justify the exclusive profits? It could be argued that the tee shirt shop identified the importance of the phrase and risked their effort and money to create the tee shirt market. While “Who Dat” is far less valuable without its association with the Saints, the NFL had not solely made the investment to market it successfully. Yet this case did not go to trial, and a court will probably never make a final determination on the competing claims. As often happens, the trademark dispute was settled out of court, and the NFL’s registration of the phrase remained intact.

simply controlling infringing competitors. New means of protection have achieved limited success and include the following noteworthy activities:

- Apple computer designs attempted to control its “look and feel” (Jack Russo, 1993).
- Harley Davidson attempted to trademark the sound of its engine (O’Dell, 2000).
- T-Mobile attempted to trademark magenta (Techdirt5, 2008).

Other means to aggressively manage a branded look are generally for more advanced companies and include two main protections trade dress and trademark dilution. Trade dress attempts to establish protection for the overall look of a product. It essentially protects the presentation and design of a brand, such as the famous Tabasco bottle’s barrel shape topped by a long thin neck and cap. Trade dress can protect the unique exterior and interior design of a store or restaurant such as the wooden porch of Cracker Barrel Old Country Store and Restaurant or the familiar golden arches of McDonald’s. In such cases, the customer instantly recognizes the product from its trade dress without having to read the name of the store. Trade dress protection requires that the design element not be functional but aesthetic (Borghese Legal, LTD, 2011). For example, the overall shape of the Tabasco bottle can be protected by trade dress but the

regulating lip at the top of the bottle is functional and not protected by trade dress.

One of the strongest measures to prevent competitors from infringing on a trademark emanates from the Federal Trademark Dilution Act of 1995 and 2006. Dilution takes two forms in trademark law. First, there is the “blurring” of a trademark name that causes the quality of the brand product to become unclear in the mind of the consumer. Imagine if a power company called *Entergy* suddenly becomes aware of a new firm titled *Entergy Fitness*. There is little reason to believe that customers might be confused into thinking that there is a partnership between the two companies, and yet the use of the name in terms of fitness would tend to blur the association between the name Entergy and its electricity service.

The second form of dilution is called tarnishment, which occurs when a second company uses the brand name in such a way that its association with the trademark becomes an embarrassment. Suppose that another group calling itself Entergy Nights uses this name to promote an adult nightclub featuring erotic dancers. Local residents are not likely to confuse the club with the electric service company but the association might prove objectionable to the power utility. Nonetheless, Entergy, the electric service company, would have to establish that its trademark deserves the same order of protection that more famous brands such as Starbucks and Disney require in law. The test for defending such a brand under law is based on these criteria:

- The duration and extent of use of the mark
- The duration and extent of advertising for the mark
- The geographic area in which the mark has been used
- The degree of distinctiveness of the mark (either through the nature of the mark itself, or through acquired distinctiveness)
- The degree of recognition of the mark
- The method by which the product was distributed and marketed (the “channels of trade”)
- The use of the mark by third parties
- Whether the mark was federally registered (False designations of origin, false descriptions, 15 U.S.C. § 1125(d))

The three areas of *nominative use*, *fair use*, and *parody* are widely recognized exceptions in trademark protection law (Trademark Education & Information, 2013). Nominative use protects nonfiction authors, including journalists, in their ability to comment on the products, or services, offered under a trademark within the limits of libel law. Thus, competitors, reviewers, and even angry consumers are allowed to use brand names in order to provide fair and honest comment. In order to qualify as a nominative use, three conditions must be met (*New Kids on the Block v. News America Publishing, Inc.*, 1999):

- The owner’s product and service cannot be easily identifiable without the use of the trademark.
- The author uses as little of the trademark as possible to identify the trademark owner’s products or services.
- The author does nothing that suggests to the reader, sponsorship or endorsement of the nominative use by the trademark owner.

Fair use for trademarks normally refers to the passing use of trademarks such as the incidental or original use of a trademarked word. For instance, it is fair to write about apples when not referring to Apple Computer (Trademark Education & Information, 2013). It will be more difficult to determine the protection for books, such as *Because of Winn-Dixie* (using the trademark Winn Dixie) in the era of trademark dilution suits. The most important element remains that the person using the protected name NOT appear to be associated with the company, speaking for the company, or in business with the company.

### Transformative Value

One area where the First Amendment protects use of trademarks or service marks comes in the form of parody or satire especially if it involves political speech. Gov. Bobby Jindal of Louisiana joined forces with several other Republican governors in refusing to accept the federal expansion of Medicaid found in President Obama’s affordable health care act. In response, the liberal political action group, MoveOn.Org, leased billboards in several states including Louisiana, posted YouTube videos and took out TV spots criticizing the partisan refusal to accept this form of health care on behalf of poor residents. Drawing on the state’s tourism campaign featuring a plate of crawfish and the capitalized red spelling of the state’s names

with exclamation marks, the moveon.org billboard read: “LOU!SIANA Pick your passion! But hope you don’t love your health. Gov. Jindal’s denying Medicaid to 242,000 people.” The question of Service Mark infringement was raised when Louisiana elected leaders decided to file suit.

Lieutenant Governor Jay Dardenne filed against MoveOn.Org for service mark infringement claiming the licensed and proprietary interests of the state Department of Culture, Recreation and Trade were at stake, but the liberal group whose billboard campaign was only contested in Louisiana felt the transformative value of political parody and satire took precedence over this IP issue cited. That constitutional viewpoint was affirmed by U.S. District Court Judge Shelly Dick (no relation to the chapter author), who sided with MoveOn.org in affirmation of the organization’s rights to freedom of expression in political discourse. “The State has failed to demonstrate a compelling reason to curtail MoveOn.org’s political speech in favor of protecting of the State’s service mark,” Dick held in her ruling. She added that Louisiana’s tourism campaign would not suffer “irreparable injury” if the billboard remained on the highway (McGaughy, NOLA.com). Third-party use of a service mark or trademark is lawful for the transformative purposes of commenting through parody, satire, or just simple statement.

### Conclusions

IP law defines the rules by which media professionals treat each other in terms of inventions, product brands, and their original creativity. In some ways it defines the rules of the media marketplace. The two major areas covered in this chapter—copyright and trademark—represent the types of IP most used by the media. Anyone studying this area should be able to identify what is protected, when that protection starts, how to secure protection, and how to profit from their newly created products. In the realm of original creative content such as a song or photograph, it is important to understand that copyright occurs at the moment the author or artist fixes their work in a tangible medium, but for the purposes of commercial protection and to guard against infringing uses, it is best to register the work with the U.S. Copyright Office that is easily online at [www.copyright.gov](http://www.copyright.gov). The law has amended several times over the years to protect various types of works from music to plays, from maps to poetry. Expressions that cannot be protected by copyright are generally ones that are simply factual and functional like a weight chart, a business form, or a telephone book.

Media practitioners need to be able to identify what constitutes infringement, a broad legal term that encompasses uses without permission, pay, or in the case of plagiarism, clear attribution. Plagiarism can be either an ethical and/or legal issue depending on the nature of the content and possible fair use, which is determined by assessing the secondary use’s purpose, nature, amount and effect on the market for the original work.

It is not difficult for copyright holders to license a work for others in either music industries or media entertainment, but in the digital age, alternatives have been recommended through the use of Creative Commons for those who prefer not to register with a federal agency. In the business world, service marks and trademarks may seem like copyright, but actually are protected more for reasons of product identification than to reward creativity and the progress of the useful arts. In all three areas of IP, there is an ongoing legal struggle between the forces of free expression and access in opposition to proprietary uses by copyright holders and trademark owners, which is why the rule of law is so important.

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