



Life is Not Fair – But Copyright and Trademark Use Might Be

*2021 Sports and Entertainment
Virtual Conference
Oct. 1 – 11:30 am*

Bobby Ghajar, Partner

bghajar@cooley.com

Marcus Peterson, Associate

mpeterson@cooley.com

attorney advertisement

Copyright © Cooley LLP, 3175 Hanover Street, Palo Alto, CA 94304. The content of this packet is an introduction to Cooley LLP's capabilities and is not intended, by itself, to provide legal advice or create an attorney-client relationship. Prior results do not guarantee future outcome.

Summary of Discussion

- Copyright Fair Use
 - Fair Use Factors
 - Hypotheticals
 - Fair Use in the News
- Trademark Fair Use
 - Traditional Fair Use
 - Nominative Fair Use
 - First Amendment
 - Hypotheticals

Summary of Discussion

- What is “fair use?”
- When is it triggered?
- Who decides it?

Copyright Fair Use

- “... the most troublesome in the whole law of copyright.” *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661 (2d Cir. 1939) (per curiam).

Four Fair Use Factors

- Under 17 U.S.C. § 107, courts look at the following four non-exclusive factors to determine fair use:
- **(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;**
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- **(4) the effect of the use upon the potential market for or value of the copyrighted work.**

Purpose and Character

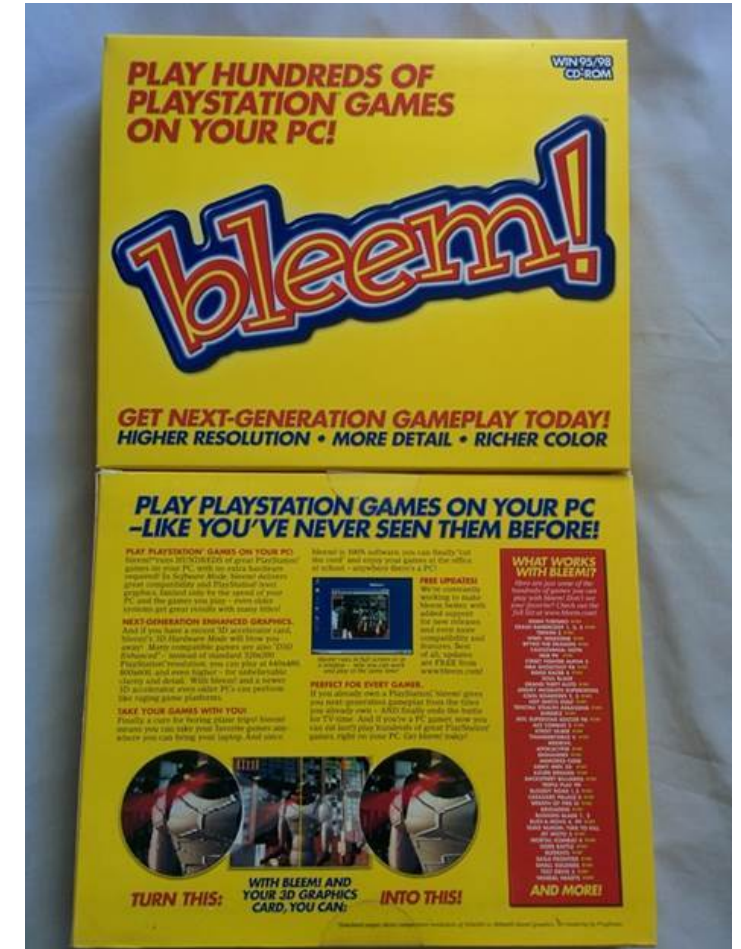
- “purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research”

Is this Fair Use?



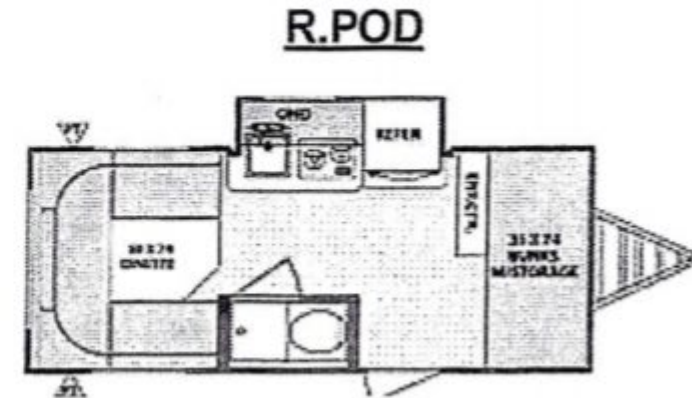
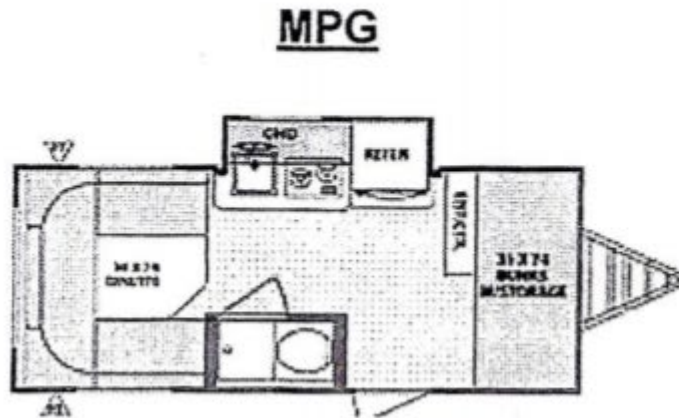
Is Comparative Advertising Fair Use?

- Although Bleem is most certainly copying Sony's copyrighted material for the commercial purposes of increasing its own sales, such comparative advertising redounds greatly to the purchasing public's benefit with very little corresponding loss to the integrity of Sony's copyrighted material.
- Sony Computer Ent. Am., Inc. v. Bleem, LLC, 214 F.3d 1022, 1027 (9th Cir. 2000), amended on denial of reh'g (July 10, 2000)



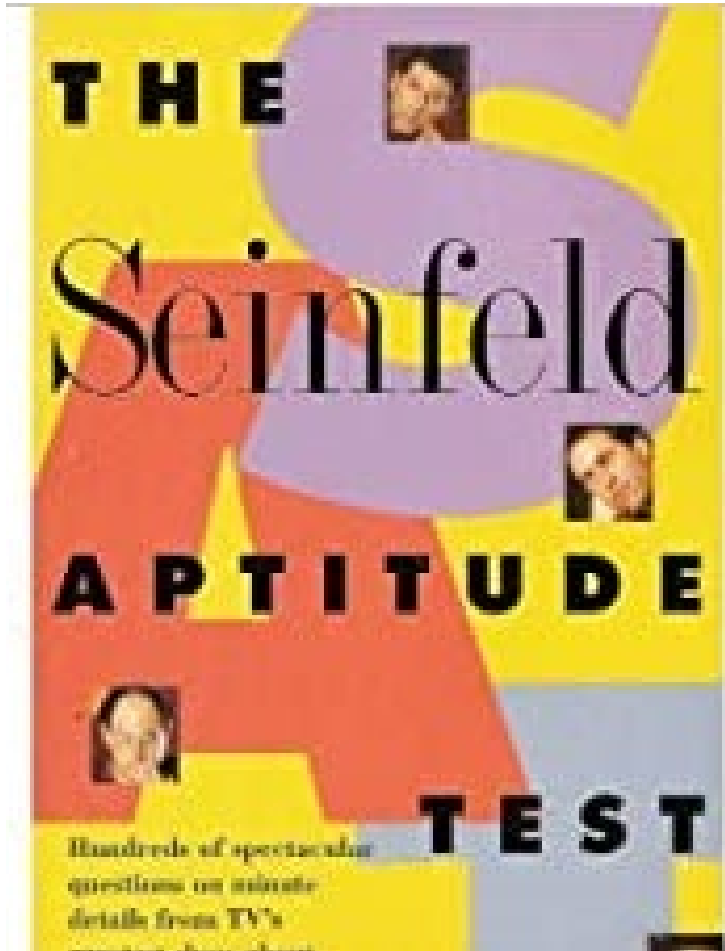
Is Comparative Advertising Fair Use?

MPG VS. R.POD

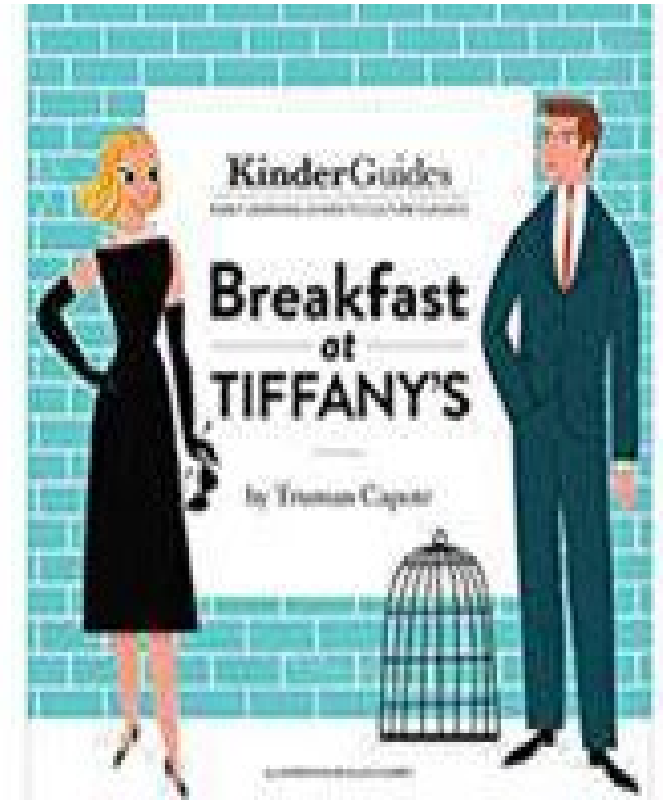


- “The Defendant cannot even argue that its use involves comment or criticism of the Plaintiff's Floor Plan because the Defendant used the same exact drawing to represent its own product. Moreover, the floor plan in the advertisement was a straight copy of the Plaintiff's Floor Plan.”
- *Forest River, Inc. v. Heartland Recreational Vehicles, LLC*, 753 F. Supp. 2d 753, 763 (N.D. Ind. 2010)

Is Commentary and Criticism Fair Use?



- “if a defendant's work describes the plot of a copyrighted work ‘briefly’ in order to add significant comment about the authors' plotting technique, then it may be protected by fair use. But if a defendant copies more than is necessary to facilitate ‘comment or criticism,’ then it will not be protected. *Penguin Random House LLC v. Colting*, 2017 WL 3977000, at *9 (SDNY 2017). ”
- The book does not contain commentary or analysis about Seinfeld, nor does it suggest how The SAT can be used to research Seinfeld; rather, the book simply poses trivia questions. The SAT 's plain purpose, therefore, is not to expose Seinfeld 's “nothingness,” but to satiate Seinfeld fans' passion for the “nothingness” that Seinfeld has elevated into the realm of protectable creative expression.” *Castle Rock Ent., Inc. v. Carol Pub. Grp., Inc.*, 150 F.3d 132, 142–43 (2d Cir. 1998)



Is Corporate Photocopying Fair Use?

- “The principal purpose of Texaco's copies is to supersede the original and permit duplication, indeed, multiplication. A scientist can make a copy, to be read subsequently and kept for future reference, without preventing the circulation of the journal among co-workers. This kind of copying contributes nothing new or different to the original copyrighted work. It multiplies the number of copies. This is the type of superseding copying that has been disfavored since the earliest discussions of the doctrine and was thought by many to preclude a finding of fair use prior to the Supreme Court's decision in *Sony*.” *Am. Geophysical Union v. Texaco Inc.*, 802 F. Supp. 1, 13 (S.D.N.Y. 1992)
- www.copyright.com

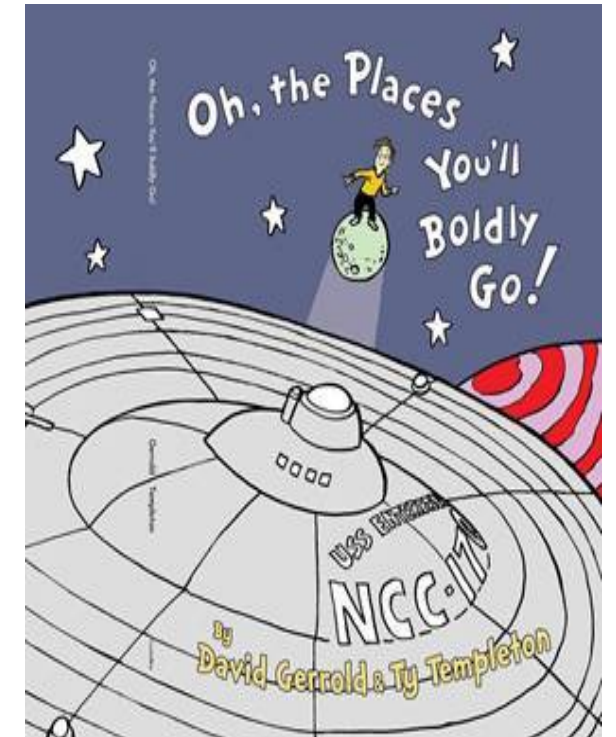
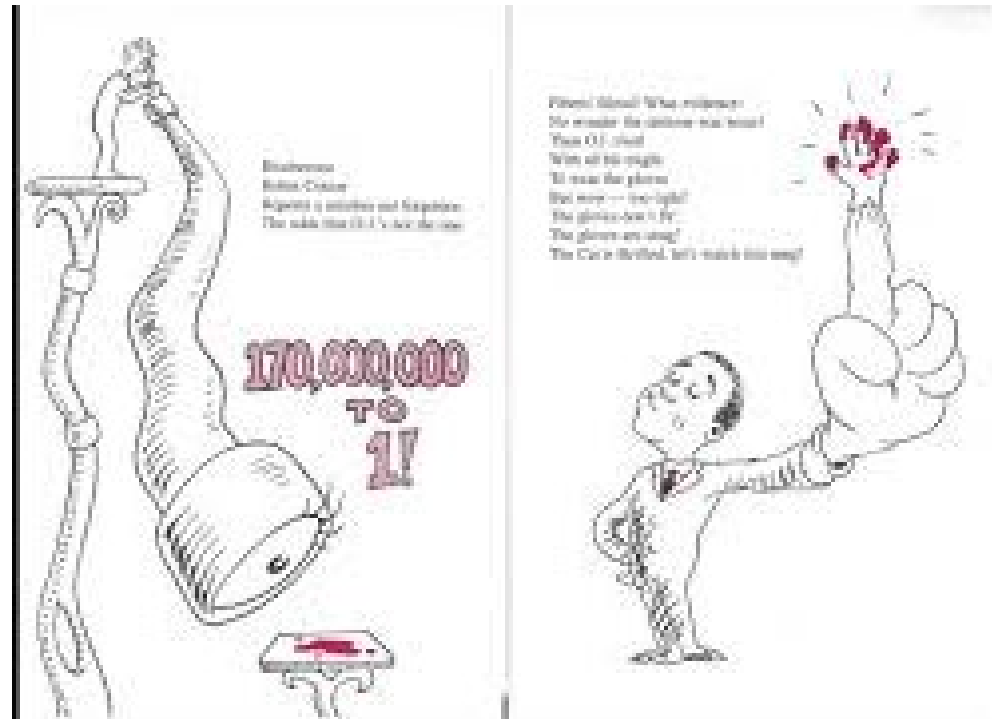
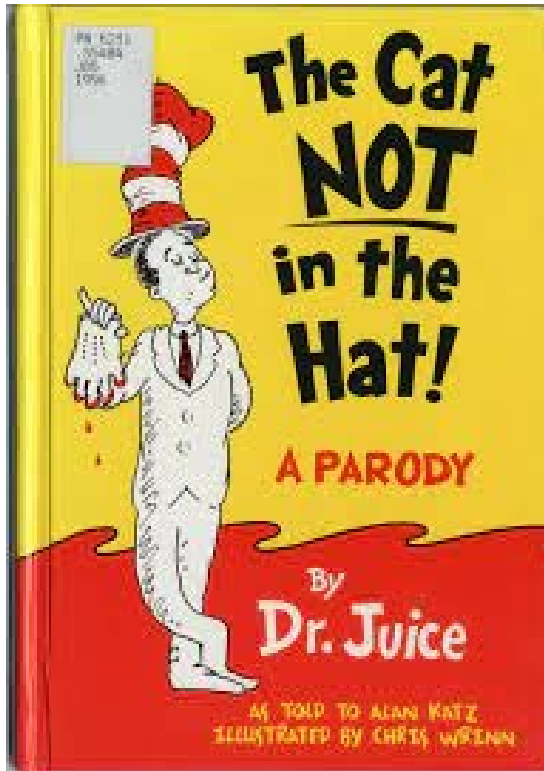


Purpose and Character of the Use

“Transformative”

- The “central purpose” of the first factor is to determine “whether and to what extent the new work is transformative.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577, 114 S.Ct. 1164, 127 L.Ed.2d 500 (1994).
- Transformative use “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message,” and a work that “merely supersedes the objects of the original creation” is not transformative.

What Does “Transformative” Mean?



Katz and Wrinn merely use the Cat's stove-pipe hat, the narrator (“Dr.Juice”), and the title (The Cat NOT in the Hat!) “to get attention” or maybe even “to avoid the drudgery in working up something fresh.” Because there is no effort to create a transformative work with “new expression, meaning, or message,” the infringing work's commercial use further cuts against the fair use defense.” *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997)

Transformative Compared

- “although Scream Icon is prominent, it remains only a component of what is essentially a street-art focused music video about religion and especially about Christianity...regardless of the meaning of the original, it clearly says nothing about religion. With the spray-painted cross, in the context of a song about the hypocrisy of religion, surrounded by religious iconography, Staub's video backdrop using Scream Icon conveys “new information, new aesthetics, new insights and understandings” that are plainly distinct from those of the original piece.” *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176 (9th Cir. 2013).



Transformative Compared

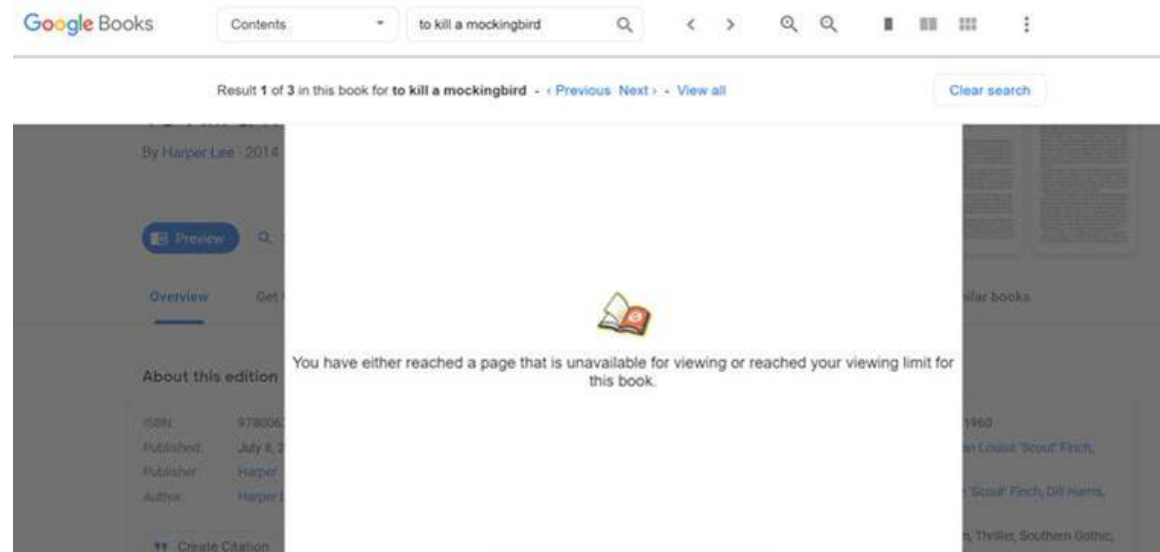


- “The Court agrees that the Scary Terry merchandise serves the purpose of identifying and connecting Defendant’s fans with Defendant’s Scary Terry persona, a significantly different use and purpose from that of the original work.”
Easter Limited, Inc. v. Rozier (EDNY 2021)



Transformative Compared (Cont'd)

- “The word “transformative” cannot be taken too literally as a sufficient key to understanding the elements of fair use. It is rather a suggestive symbol for a complex thought, and does not mean that any and all changes made to an author's original text will necessarily support a finding of fair use...Google's division of the page into tiny snippets is designed to show the searcher just enough context surrounding the searched term to help her evaluate whether the book falls within the scope of her interest (without revealing so much as to threaten the author's copyright interests). Snippet view thus adds importantly to the highly transformative purpose of identifying books of interest to the searcher.” *Authors Guild v. Google, Inc.*, 804 F.3d 202, 214 (2d Cir. 2015)



Is This Transformative?

Newstex is the easiest way to get authoritative content. Try it today!

With the **Newstex News & Commentary Blog Index** ("Newstex"), the web's best content is delivered to you in a neat, easy-to-use format. By connecting you with the latest material from thought leaders, industry insiders, and other knowledgeable experts, we make it easy for you to take the pulse of a field. Plus, working with us saves you time, money, and trouble.

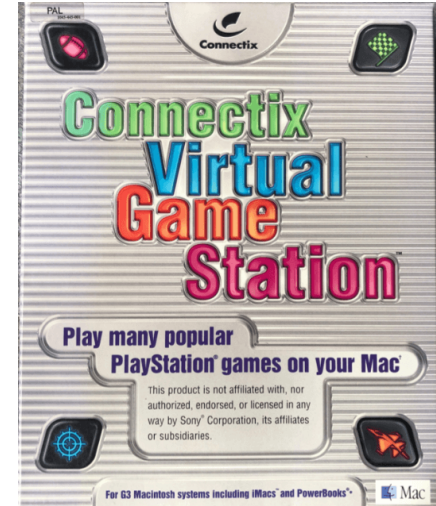


- “Market harm is a matter of degree, and so the importance of this factor varies with the relative strength of the other factors. We mostly concern ourselves with the adverse impact of market substitution. The central question ... is not whether the defendant's use of [the plaintiff's works caused the plaintiff to lose some potential revenue, but instead whether the defendant's use—taking into account the damage that might occur if ‘everybody did it’—would cause substantial economic harm.” *MidlevelU, Inc. v. ACI Info. Grp.*, 989 F.3d 1205, 1223 (11th Cir. 2021)

Are Video Game Emulators Fair Use?

- “Connectix reverse-engineered the Sony BIOS to produce a product that would be compatible with games designed for the Sony PlayStation. We have recognized this purpose as a legitimate one under the first factor of the fair use analysis.”

Sony Computer Ent., Inc. v. Connectix Corp., 203 F.3d 596, 607 (9th Cir. 2000)



Are Video Game Emulators Fair Use?

- “Therefore, there is no genuine issue of material fact in dispute that Defendant knew users of its website were engaging in infringing conduct by downloading the copyrighted files, and that Defendant induced, caused, or materially contributed to the infringing conduct by advertising and making the files available for download on his website.”

Nintendo of Am., Inc., Plaintiff, v. Matthew Storman, Defendant., No. CV197818CBMRAOX, 2021 WL 3556831 (C.D. Cal. May 26, 2021)



Fact or Fiction

- “If I do not charge to view the work, it is non-commercial and fair use”

INTERNET ARCHIVE
WayBackMachine

http://bustedcoverage.com/2014/11/04/cowboys-cheerleader-hacked-manziels-girlfriend-inks-deal-salma-hayek-time/ Go NOV DEC APR
8 captures
6 Nov 2014 ~ 3 Jan 2017


FOOTBALL CHEERLEADERS OTHER SPORTS GIRLS FEATURES VIDEO SHOP GOT A T

COWBOYS CHEERLEADER HACKED, MANZIEL'S GIRLFRIEND INKS DEAL & SALMA HAYEK TIME!

November 4, 2014 10:03 am, By JOE KINSEY

DAILY DUMP

Comments f t g+ p Email




VIDEO OF THE DAY

SEARCH:

Fact or Fiction (Cont'd)

- “If I copy something only for my own private use, it is fair use.”

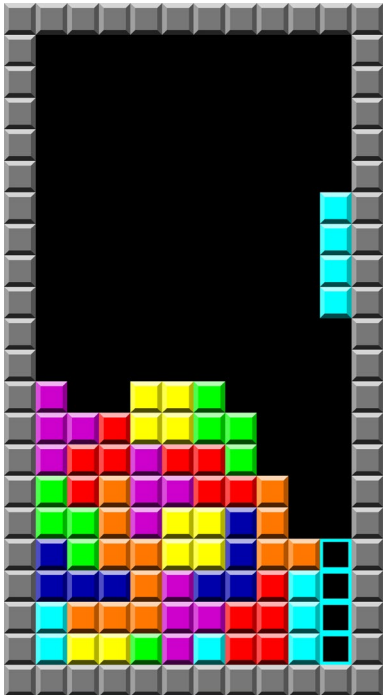


A screenshot of the Napster search interface. The search bar at the top shows 'Artist: METALLICA' and 'Max Results: 100'. Below the search bar is a table of search results. The table has columns for Filename, Filesize, Bitrate, Freq, Length, User, Connection, and Ping. The results list various Metallica songs, including 'The Unforgiven', 'Master of Puppets', and 'Enter Sandman'. A large Napster logo is overlaid on the table.

Filename	Filesize	Bitrate	Freq	Length	User	Connection	Ping
Music\Metallica-The Unforgiven.mp3	2,113,536	128	44100	2:15	aek2cool	Cable	30
Music\Primus - The Thing That Should Not Be (Metallica cover).mp3	6,463,892	128	44100	6:40	karouja	Unknown	41
Incomplete\Metallica - The Unforgiven.mp3	299,008	128	44100	0:24	sam258...	56K	50
Music\Metallica - Master of Puppets.mp3	8,268,331	128	44100	8:30	meekert...	Cable	80
Millenium\Metallica) No Leaf Clover.mp3	8,237,056	192	44100	5:41	ubung	Cable	100
Music\Metallica- Enter Sandman.mp3	5,312,512	128	44100	5:30	jdbjr	Unknown	100
Music\Metallica - Nothing Else Matters.mp3	6,415,888	128	44100	6:25	jdbjr	Unknown	100
Metallica - The Unforgiven II.mp3			44100	6:32	RedOX...	DSL	101
Music\Metallica - Until it Sleeps.mp3			44100	4:29	10sami	Unknown	121
Music\Metallica S&M - No Leaf Clover.mp3			44100	5:41	10sami	Unknown	121
Music\Metallica - The Unforgiven II.mp3			44100	6:32	10sami	Unknown	121
Music\Metallica - Master Of Puppets.mp3			44100	8:29	medicm...	Cable	130
Music\Metallica - And Justice For All.mp3			44100	9:40	meltonjeff	DSL	131
Music\Metallica - Whiskey in the jar.mp3			44100	5:03	meltonjeff	DSL	131
Music\Metallica - Turn the Page.mp3	5,714,792	128	44100	5:54	meltonjeff	DSL	131
Music\Metallica - Stone Cold Crazy.mp3	4,120,660	128	44100	4:17	meltonjeff	DSL	131
Music\Metallica - No Leaf Clover.mp3	8,237,056	192	44100	5:41	meltonjeff	DSL	131
Music\Metallica - Kill 'em All The Four Horsemen.mp3	2,212,124	192	44100	1:36	meltonjeff	DSL	131
Music\Metallica - (Mission Impossible2)I Disappear.mp3	2,461,696	192	44100	1:46	meltonjeff	DSL	131
Mission Impossible 2 - Metallica - I Disappear.mp3	6,557,858	192	44100	4:32	BigNana1	56K	140
Music\Metallica - The Unforgiven II.mp3	4,849,664	128	44100	5:02	shortinger	Unknown	140
Music\Metallica - Whiskey a jar.mp3	4,875,632	128	44100	5:03	upcydwn	Unknown	151
Music\Metallica) - Enter Sandman.mp3	5,316,022	128	44100	5:30	lghoth	Unknown	171
Music\Mission Impossible 2 - Metallica - I Disappear.mp3	6,557,858	192	44100	4:32	caseygrl...	Unknown	190
waves\Metallica - Ride The Lightning .mp3	6,350,848	128	44100	6:33	golfvw1	Cable	210
Music\Metallica - Whiskey in a jar.mp3	6,089,780	160	44100	5:03	Dieuwer...	14.4	210
Music\Metallica_EnterTheSandman.mp3	5,305,863	128	44100	5:29	jmeash	33.6	241
Music\Metallica - Nothing Else Matters.mp3	6,227,968	128	44100	6:26	mrlflatus	56K	241
Metallica - Whiskey In The Jar.mp3	4,886,183	128	44100	5:04	voodoo...	Cable	250
download\Metallica - The Unforgiven.mp3	6,131,096	128	44100	6:20	finewine0	56K	271

Fact or Fiction

- “Cloning and re-skinning a game is OK because I am only copying the idea of the game, but not the expression.”



Xio is correct that one cannot protect some functional aspect of a work by copyright as one would with a patent. But this principle does not mean, and cannot mean, that *any and all expression* related to a game rule or game function is unprotectible. Such an exception to copyright would likely swallow any protection one could possibly have; almost all expressive elements of a game are related in some way to the rules and functions of game play

Tetris Holding, LLC v. Xio Interactive, Inc., 863 F. Supp. 2d 394, 404–05 (D.N.J. 2012)



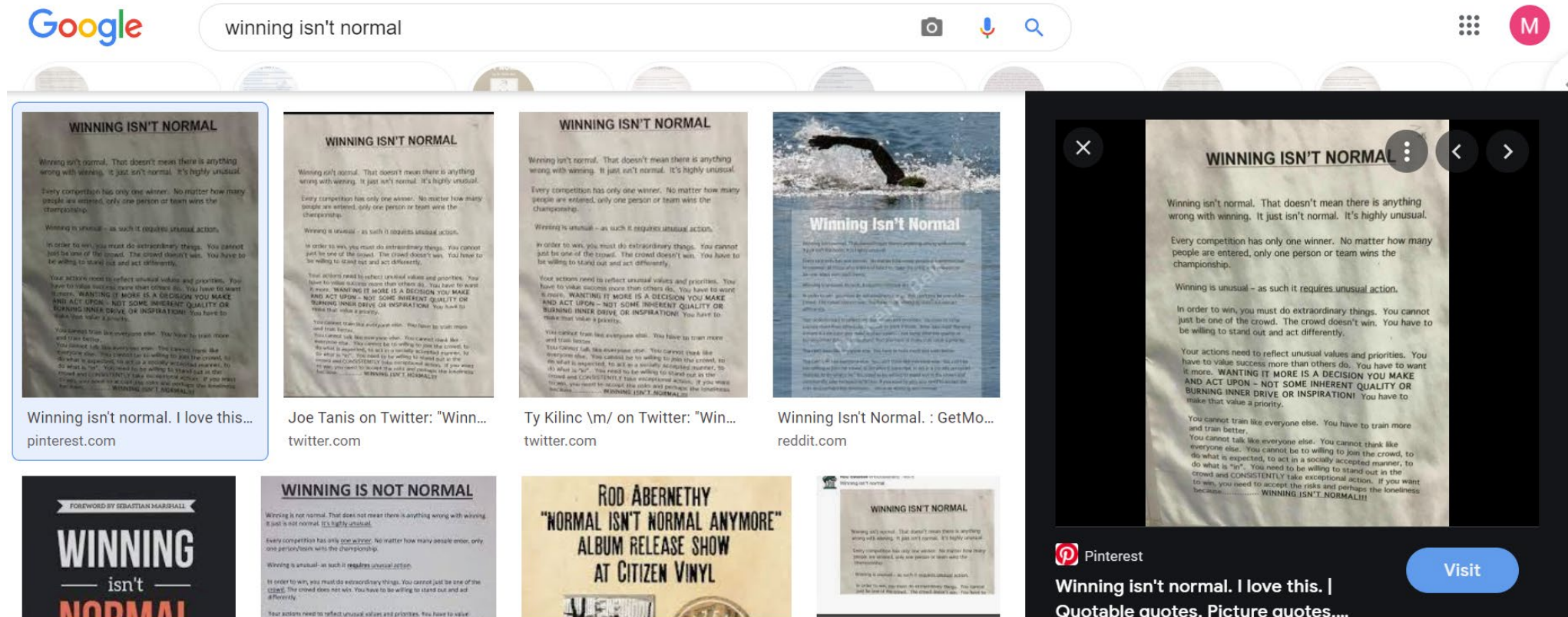
Fact or Fiction (Cont'd)

- “It’s OK for me to take something and change it 30% to avoid infringement”



Fact or Fiction (Cont'd)

- “I got it off of the internet and there was no copyright notice or marking on it, so it's OK to use”



Fact or Fiction (Cont'd)

- “I got the photo from a website in another country and will use it in the US, that’s OK because the owner in that country has no rights in the US.”
- **(a) UNPUBLISHED WORKS.**—The works specified by sections 102 and 103, while unpublished, are subject to protection under this title without regard to the nationality or domicile of the author.
- **(b) PUBLISHED WORKS.**—The works specified by sections 102 and 103, when published, are subject to protection under this title if—**(1)**on the date of first publication, one or more of the authors is a national or domiciliary of the United States, or is a national, domiciliary, or sovereign authority of a treaty party, or is a stateless person, wherever that person may be domiciled; or
- **(2)**the work is first published in the United States or in a foreign nation that, on the date of first publication, is a treaty party; or
- **(3)**the work is a sound recording that was first fixed in a treaty party; or
- **(4)**the work is a pictorial, graphic, or sculptural work that is incorporated in a building or other structure, or an architectural work that is embodied in a building and the building or structure is located in the United States or a treaty party;
- <https://www.copyright.gov/circs/circ38a.pdf>

Fact or Fiction (Cont'd)

- “I put a disclaimer saying that no infringement is intended, so it is OK to use, right?”



Fact or Fiction (Cont'd)

- “I can share stats and information from sporting events, even though the league licenses out broadcast rights to the game, right?”



© Oliver Rudkin/Rex Features

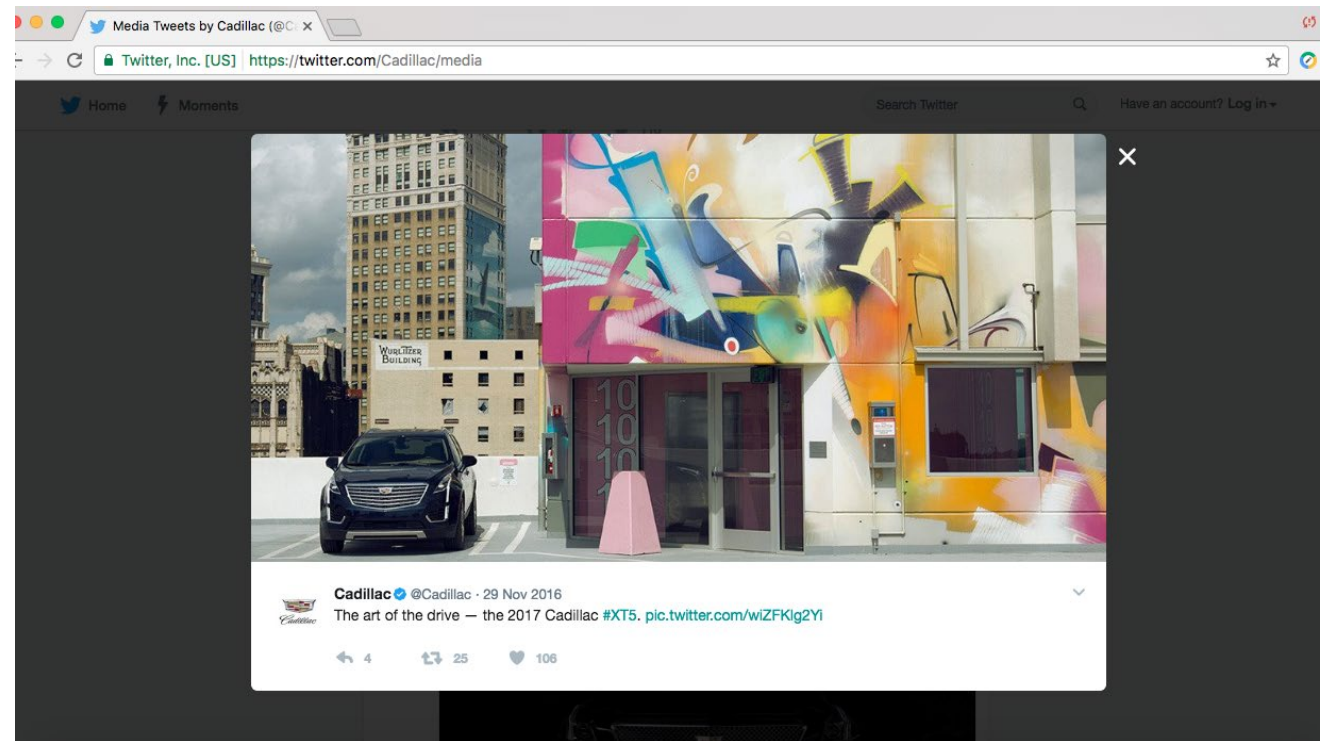
Fact or Fiction (Cont'd)

- “We got the picture from Instagram, and the owner posted it there and Instagram has the right to use it, and I’m using it”



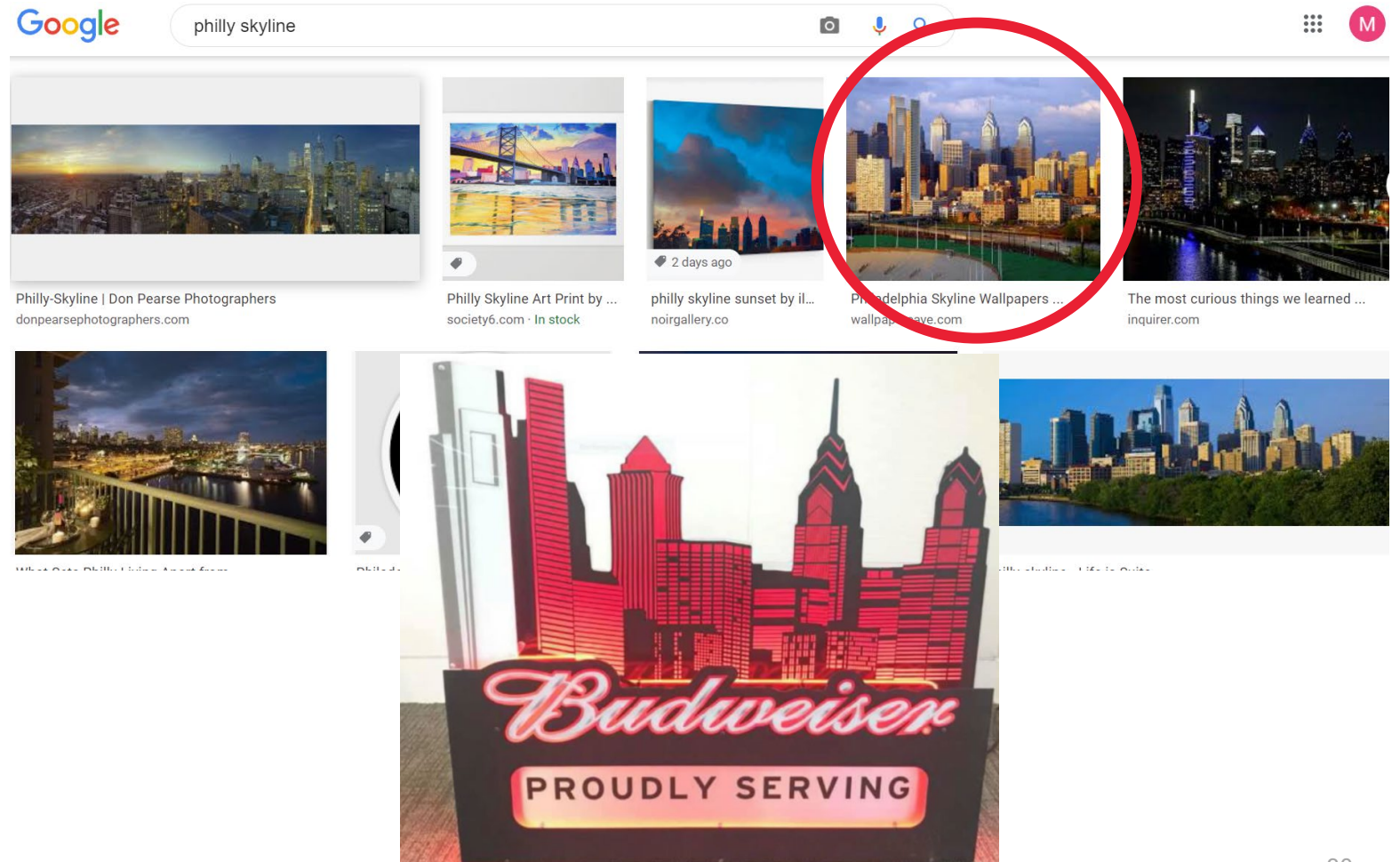
Fact or Fiction (Cont'd)

- “There’s a really cool looking mural with street art, and a company does a photo shoot of their product with the mural in the background, and posts it to Instagram”



Fact or Fiction (Cont'd)

- “I want to make a neon sign featuring a city skyline, so I go on Google and search for images of the skyline, and use one as the basis for the outline of the neon lights. That's OK.”



Fact or Fiction (Cont'd)

- “So, it’s OK to copy a photograph of a city skyline and post it on my website, right?”



Fair Use in the News



- *Oracle v. Google*
- Did Google's use of Java declaring code and implementing code to develop the Android operating system constitute fair use?

Fair Use in the News



- *Oracle v. Google* – Fair Use Found
- Google's use was transformative – "Google took and transformed the Java APIs "to expand the use and usefulness of Android-based smartphones" which "creat[ed] a new platform that could be readily used by programmers"
- Google only took 0.4% of the Java API code – "It copied them because programmers had already learned to work with [Java SE], and it would have been difficult ... to attract programmers to ... Android ... without them."

Fair Use in the News

Where Cariou's serene and deliberately composed portraits and landscape photographs depict the natural beauty of Rastafarians and their surrounding environs, Prince's crude and jarring works, on the other hand, are hectic and provocative. Cariou's black-and-white photographs were printed in a 9 1/2" x 12" book. Prince has created collages on canvas that incorporate color, feature distorted human and other forms and settings, and measure between ten and nearly a hundred times the size of the photographs. Prince's composition, presentation, scale, color palette, and media are fundamentally different and new compared to the photographs, as is the expressive nature of Prince's work

Cariou v. Prince, 714 F.3d 694, 706 (2d Cir. 2013)



Patrick Cariou, Photograph from *Yes Rasta*, p. 118



Richard Prince, *Graduation*

Fair Use in the News

- “Warhol created the series chiefly by removing certain elements from the Goldsmith Photograph, such as depth and contrast, and embellishing the flattened images with loud, unnatural colors....they are much closer to presenting the same work in a different form, that form being a high-contrast screenprint, than they are to being works that make a transformative use of the original. Crucially, the Prince Series retains the essential elements of the Goldsmith Photograph without significantly adding to or altering those elements.” *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 992 F.3d 99 (2d Cir. Mar. 26, 2021).



Trademark Fair Use



“Classic” Fair Use

- 15 USC 1115(4) – That the use of the name, term, or device charged to be an infringement is a use, **otherwise than as a mark**, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, **or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party**, or their geographic origin

“Nominative” Fair Use

- Use the Plaintiff’s mark to refer to *Plaintiff’s* goods and services
 - “We repair FORD cars and trucks!”
- Not an affirmative defense (except in 3rd Circuit)
- 9th Circuit test: (1) not readily identifiable without use of the trademark; (2), only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and (3), must not suggest sponsorship or endorsement by the trademark holder.
- 2nd Circuit: consider fair use factors in connection with typical likelihood of confusion factors

First Amendment Considerations

- Not “Fair Use,” but permitted use of another’s trademark in an expressive work, like a movie or video game
- *Rogers v. Grimaldi* Test
- Two Prongs:
 - The use of the mark has some artistic relevance to the underlying work
 - It does not explicitly mislead as to the source or the content of the work.

Is This Fair Use?

- SportFuel, Inc. v. PepsiCo, Inc., 932 F.3d 589, 599 (7th Cir. 2019)



FAIR USE

Is This Fair Use?

ESS Entertainment 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095 (9th Cir. 2008)



FIRST AMENDMENT NOT A FAIR USE

Is This Fair Use?

Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc., 74 F.Supp.3d 1134 (N.D. Cal 2014)



FIRST AMENDMENT

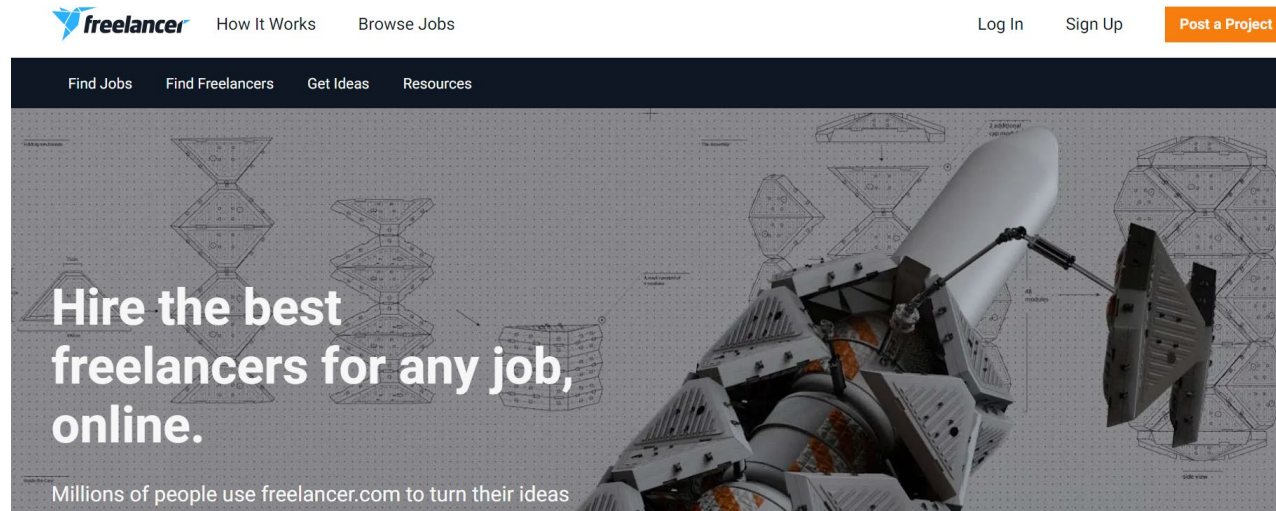
Is This Fair Use?

Louis Vuitton Malletier S.A. v. Warner Bros. Entm't , 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012)



FIRST AMENDMENT

Is This Fair Use?



Development & IT Design & Creative Sales & Marketing Writing & Translation Admin & Customer Support Finance & Accounting

Find the best freelance jobs

Browse jobs posted on Upwork, or jump right in and create a free profile to find the work that you love to do.

Find Work

▶ Watch a demo

FAIR USE

Comments/Questions?



Thank You

Cooley