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Hot Topics in Copyright & Trademark Law

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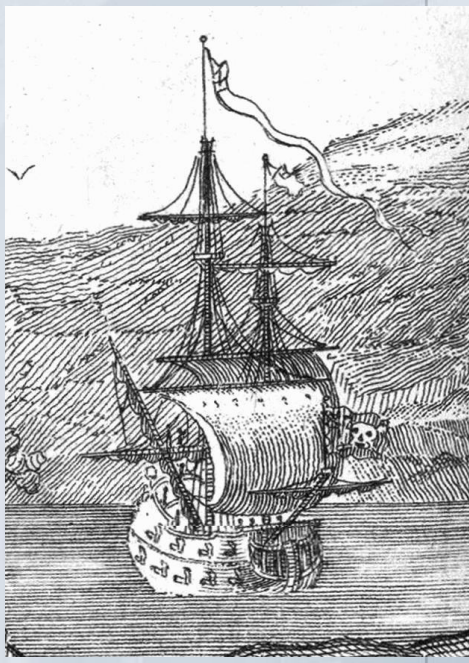
Copyright at the Supreme Court

- **Fourth Estate Public Benefit v. Wall-Street.com, 139 S. Ct. 881**
  - Copyright registration is prerequisite for lawsuit
- **Rimini Street v. Oracle, 139 S.Ct. 873**
  - Awardable "costs" do not include "expert witnesses, e-discovery, & jury consulting"
- **Certiorari granted:**
  - Allen v. Cooper. Q presented: "Whether Congress validly abrogated state sovereign immunity … in providing remedies for authors of original expression whose federal copyrights are infringed by States."
  - Georgia v. Public.Resource.org. Q presented: "Whether the government edicts doctrine extends to—and thus renders uncopyrightable—works that lack the force of law, such as the annotations in the Official Code of Georgia Annotated"



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Pending Copyright Legislation (Selected)

- **HR 2426/S.1273 = Copyright Alternative in Small-Claims Enforcement Act (CASE Act)**
  - HR 2426 passed House Judiciary Committee Sept 10
  - S.1273 passed Senate Judiciary Committee Sept 12
- **Main Features of House Bill**
  - Scope
    - 106 infringement/non-infringement or 512(f)
    - No in-person hearing & limited discovery
    - Appeal to Register of Copyrights for "abuse of discretion" or in district court for board exceeding authority or "fraud, corruption, misrepresentation, or other misconduct"
    - Register of Copyrights can create even more expedited procedures when damages <$5k
  - Damages
    - Actual damages, or
    - Statutory damages of up to $15k per work (timely registered) or $7.5k per work (untimely registered)
    - Total damages < $30k + attorneys' fees
    - Sanctions for bad faith litigation conduct
  - Defendant can opt-out within 60 days of service

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Who Owns Banana Costumes?

RASTA IMPOSTA

KANGAROO ITEM 10477

KANGAROO ITEM 10478

Silvertop Associates Inc. v. Kangaroo Manufacturing, Inc., No. 18-2266 (3d Cir. Aug. 1, 2019)

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Is There a Copyright Statute of Limitations?

- 1996: photo taken
- Oct. 2001: photo published
- Aug. 2004: NASA posts photo
- Nov. 2007: NASA last adjusts page
- Dec. 20, 2007: registration issued
- Dec. 3, 2018: photographer sues NASA
- Holding:
  - NASA reproduced work in 2004
  - NASA distributes work with every page access
  - NASA (maybe?) displays work with every page access

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APL Microscopic LLC v. United States, No. 18-1851 C (Ct. Fed. Claims Aug. 27, 2019)

Fun With Fee Shifting

- 17 USC 505: discretionary award of attorneys' fees & costs, but plaintiff eligible only if it made a timely copyright registration (17 USC 412)
- FRCP 68(d): "If the judgment that the offeree finally obtains is not more favorable than the unaccepted offer, the offeree must pay the costs incurred after the offer was made"
- Mango v. Democracy Now!, 1:18-cv-10588-DLC (SDNY July 24, 2019): "A copyright defendant is entitled to seek an award of costs, including attorney's fees, incurred following a Rule 68 offer where the plaintiff's recovery fails to exceed the offer"

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Copyright Odds-and-Ends

- 512 Agent Designations are coming up for 3 year renewals
- 512(f) claims preempt state claims, & bringing state claims could trigger anti-SLAPP laws (Complex Media, Inc. v. X17, Inc., 2019 WL 2896117 (C.D. Cal. March 4, 2019))
- 'Volition' is an element of direct infringement, but no one knows what it means (BWP Media USA Inc. v. Polyvore, Inc., 12 Civ. 7868 (2d Cir. Apr. 17, 2019))

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Trademark at the Supreme Court

- **Iancu v. Brunetti, 139 S.Ct. 2294**
  - Holding: First Amendment prohibits refusing registration of "immoral or scandalous" trademarks because it's viewpoint discrimination
- **Certiorari granted**
  - Romag Fasteners v. Fossil. Q presented: "Whether, under section 35 of the Lanham Act, 15 U.S.C. § 1117(a), willful infringement is a prerequisite for an award of an infringer's profits for a violation of section 43(a), § 1125(a)."
    - Currently require willfulness: 2d, 8th, 9th, 10th, DC, 1st (when not direct competitors)
    - Currently don't require willfulness: 3d, 4th, 5th 6th, 7th, 11th

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Pending Trademark Legislation (Selected)

- **HR 4164/S.2439: Trademark Licensing Protection Act of 2019**
  - Designed to curb franchisor liability
- **HR 1683/S.756: No Stolen Trademarks Honored in America Act**
  - Confiscated Cuban trademarks won't be enforceable

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Rogers v. Grimaldi and Expressive Works

- **Gordon v. Drape Creative (9th Cir. 2018): When defendant uses trademark in expressive works, trademark owner must additionally show "the mark is either not artistically relevant to the underlying work or explicitly misleading as to the source or content of the work"**
  - "a triable issue of fact as to whether defendants simply used Gordon's mark with minimal artistic expression of their own, and used it in the same way that Gordon was using it—to identify the source of humorous greeting cards in which the bottom line is "Honey Badger don't care.""

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Online Marketplaces and "Sales"

- **Redbubble is a print-on-demand service**
  - Artist uploads design
  - Third party manufactures design
  - Third party ships manufactured good
  - "[t]he products are delivered in Redbubble packaging, with a Redbubble invoice, with Redbubble stickers and care instructions, and a Redbubble tag attached to the product"
- **Court: no direct trademark infringement**

The Ohio State University v. Redbubble, Inc., 2:17-cv-01092-ALM-CMV (S.D. Ohio March 29, 2019)

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Keyword Advertising

- **NJ Ethics Opinion #735**
  - a lawyer may, consistent with the rules governing attorney ethics, purchase an internet search engine advertising keyword that is a competitor lawyer's name, in order to display the lawyer's own law firm website in the search results when a person searches for the competitor lawyer by name
  - A lawyer may not, however, consistent with the rules governing attorney ethics, insert, or pay the internet search engine company to insert, a hyperlink on the name or website URL of a competitor lawyer that will divert the user from the searched-for website to the lawyer's own law firm website
- **Florida Bar Rule 4-7.13**
  - An example of impermissible advertising would be including the name of a lawyer or law firm that is not part of the advertising law firm in an Internet advertisement or sponsored link that is displayed when the non-affiliated lawyer or law firm's name is used as a search term when the advertisement does not clearly indicate that the non-affiliated lawyer or law firm is not part of the advertising law firm. Another example of impermissible conduct is use of another lawyer or law firm name as an Internet search term that triggers the display of an advertisement that does not clearly indicate that the advertisement is for a lawyer or law firm that is not the lawyer or law firm used as the search term. The triggered advertisement would not be misleading if the first text displayed is the name of the advertising lawyer or law firm and, if the displayed law firm name is a trade name that does not contain the name of a current or deceased partner, the name of the lawyer responsible for the advertisement is also displayed as the first text.
- **1-800 Contacts v. FTC (on appeal to 2d Circuit): Beware of horizontal restrictions on keyword ads, even in settlements**

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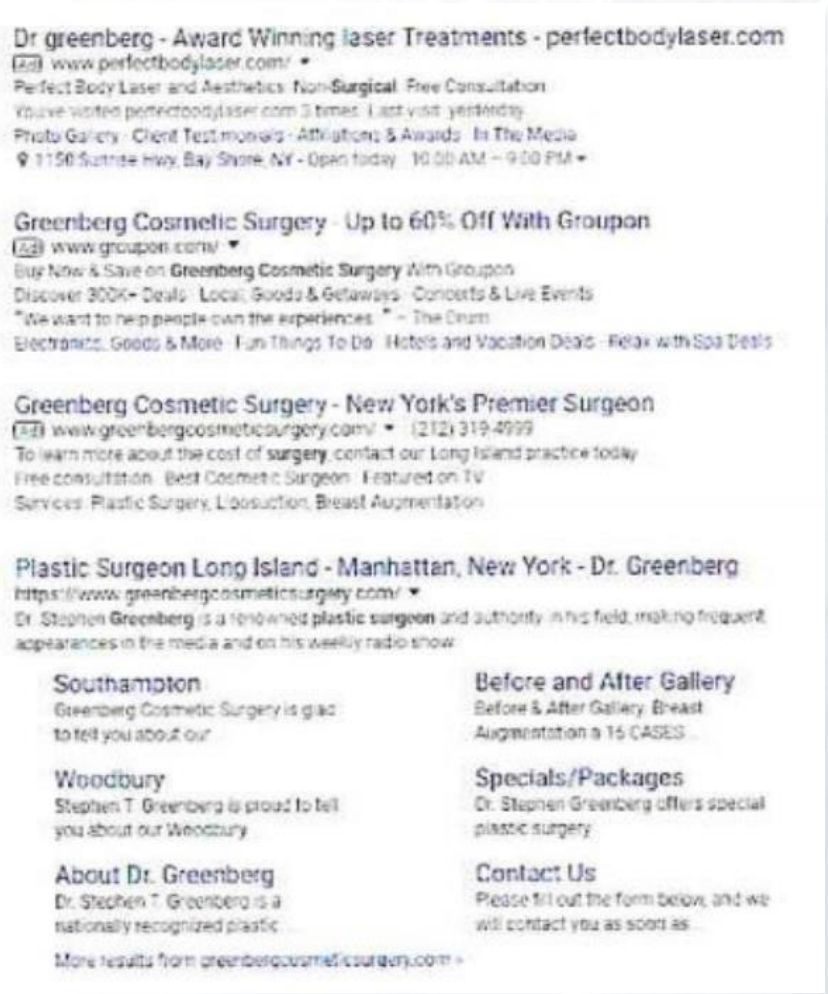
Keyword Advertising



Greenberg v. Perfect Body Image, LLC, 2019 WL 3485700 (E.D.N.Y. July 2, 2019).

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