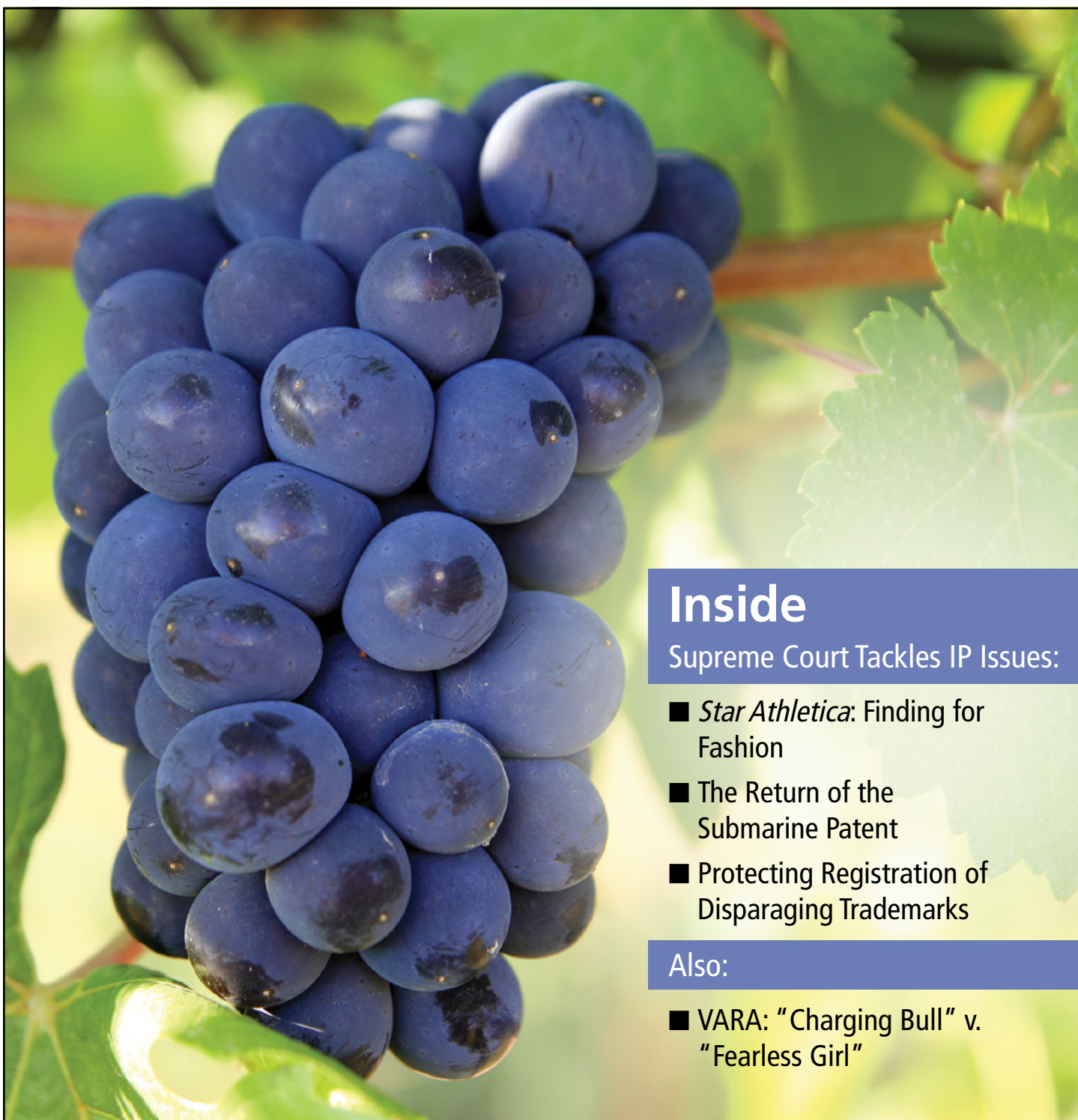


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Law Section of the New York State Bar Association



Inside

Supreme Court Tackles IP Issues:

- *Star Athletica*: Finding for Fashion
- The Return of the Submarine Patent
- Protecting Registration of Disparaging Trademarks

Also:

- VARA: "Charging Bull" v. "Fearless Girl"

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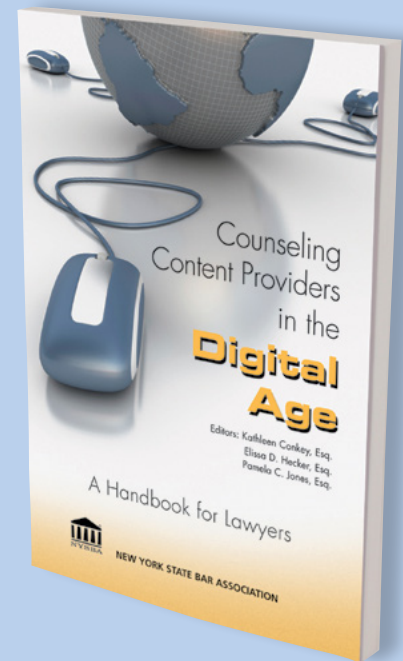
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Table of Contents

Introduction; Defamation; The Invasion of Privacy Torts; Right of Publicity; Other News-gathering Torts; Copyright Infringement; Trademark Infringement; Rights and Clearances; Errors and Omissions Insurance; Contracting with Minors; Television Standards and Practices; Reality Television Pranks and Sensitive Subject Matter; Miscellaneous Steps in Pre-Broadcast Review.



EDITORS

Kathleen Conkey, Esq.
Elissa D. Hecker, Esq.
Pamela C. Jones, Esq.

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Table of Contents

Page

Message from the Chair	4
<i>Erica D. Klein</i>	

Supreme Court Tackles IP Issues

<i>Star Athletica</i> : Finding for Fashion	5
<i>Craig B. Whitney and Rachel Santori</i>	

Inviting the Return of the Submarine Patent	9
<i>Doug Miro and Larry Rosenthal</i>	

Supreme Court Protecting Registration of Disparaging Trademarks	17
<i>Jonathan Bloom</i>	

Also Featured

Section Activities and Notices—15th Annual Women in IP.....	13
---	----

Copyright Corrida: Weighing in on the VARA Rights of Charging Bull” and “Fearless Girl”	21
<i>Irina Tarsis</i>	



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Message from the Chair

If your life is anything like mine, you're both wondering how summer flew by so quickly and finding it hard to believe that fall is sneaking its way in. Hopefully you enjoyed the sun (including when it hid behind the moon!), spent time with family and friends, and took advantage of the extra hours of daylight to do whatever you find valuable. As you wistfully grasp the last few nights outside, fear not. Fall has a lot to offer, not only in our beautiful state but also in our Section.



On October 3, the Section will be presenting *Slowing Down, Getting Ahead: Living Mindfully, Working Efficiently, and Obtaining Balance*. This program will be held at Viacom's headquarters in Times Square, thanks to co-chair of our Section's Diversity Initiative, Deborah Robinson, who is also co-chairing this program (thanks, Deborah!). As if having a chance to visit Viacom's offices was not enough of a draw, the program will feature health coach Tina Corrado (<http://www.tinacorrado.com>), who will lead a discussion around challenges faced by many men and women who lead busy professional and personal lives. Tina will introduce concepts of mindful living and eating, offering suggestions for managing career and family obligations while effectively preserving ourselves. The program will also offer a platform for attendees to share practical tips that assist their practice and/or save their sanity, including everything from how to most efficiently prepare expense reports, increase realization on client bills, run meetings effectively, and more. Working from the assumptions that we each have things to teach and learn and that many minds are better than one, the goal of this program is to crowdsource our collective success and repurpose it to benefit each of our individual experiences. This program should offer something for everyone, no matter what your area of practice and whether you're just starting your career or you've been practicing for decades. Start compiling your tips for sharing now, and don't forget to bring a pen!

We're also excited to be presenting our third annual all-day Fall CLE program on November 9, held again at the offices of Kramer Levin in New York City. Entitled *Around the Edges of IP*, the goal of this program is to provide intellectual property practitioners with an opportunity to learn about various legal issues outside of IP that may affect ownership or treatment of IP within a complex transaction. Topics will include monetizing and trading IP assets; taxation of intellectual property rights; franchising, with a focus on both the United States and Latin America; treatment of digital assets, copyright

rights, and other forms of IP in estate planning; and complexities presented by IP ownership and licensing in the context of bankruptcy. This program promises to increase IP practitioners' knowledge of legal issues that our clients likely think about regularly but that many IP specialists are unlikely to encounter regularly. In this complex and competitive legal world, being positioned to provide clients a sounding board, or at least having sufficient awareness to point them in the right direction, can offer significant value. In addition to substantive issue-spotting experience, the program will also offer informal opportunities to meet and network with people outside of the IP field who might serve as future resources, whether for ourselves or our clients. We're looking forward to presenting this unique and practical program and hope you'll enjoy participating in it.

Finally, given how quickly time seems to pass these days, there's no doubt that our Annual Meeting will be here again before we know it! Mark your calendars for Tuesday, January 23, 2018 for the Intellectual Property Law Section Annual Meeting MCLE Program & Luncheon, to be held (as in years past) at the New York Hilton Midtown in New York City. Our Annual Meeting program regularly offers exceptional programming and strong attendance, providing an excellent opportunity for both education and networking. If you've joined us previously, we'll look forward to seeing you again. And if you haven't yet made it to the Annual Meeting, hopefully we'll be your first plans made for next year! Look forward to seeing you soon.

Erica D. Klein

SAVE THE DATES!

October 3, 2017:

Slowing Down, Getting Ahead: Living Mindfully, Working Efficiently, and Obtaining Balance

November 9, 2017:

Around the Edges of IP

January 23, 2018:

Intellectual Property Law Section Annual Meeting MCLE Program and Luncheon

Star Athletica: Finding for Fashion

By Craig B. Whitney and Rachel Santori

I. Introduction

Copyright law can protect fashion designs. The Supreme Court confirmed this in its March 22, 2017 ruling in *Star Athletica v. Varsity Brands*,¹ in which the Court held that the cheerleading uniform designs at issue were copyrightable. The Court's decision established a single test for determining when a feature of an otherwise uncopyrightable useful article can be protected, resolving a split among many circuit courts. *Star Athletica* also marks the first time in the Court's over 200-year history that it has heard a case focused on fashion copyrights. By ruling 6-2 in the copyright owner's favor, the decision changes the tone of intellectual property protection in the design industry: one can no longer argue that U.S. copyright law does not protect fashion and industrial design.

II. Background

As a general matter, copyright law does not protect functional designs—known in copyright-speak as “useful articles.” Under the Copyright Act, clothing is considered a useful article, which is entitled to copyright protection only to the extent it incorporates pictorial, graphic, or sculptural (PGS) features that are conceptually separable from the functionality of the underlying article itself. For example, a garment's pockets, or the particular manner in which it is tailored, are considered inseparable and functional aspects of that garment.² Decorative fabric patterns, however, are usually separable, nonfunctional, and protectable PGS works.³ Over the years, courts have struggled with how to define functionality and, therefore, separability. Is every aspect of a garment functional? Or should the focus be on the garment's basic purposes such as covering the body? The beading on a prom dress, for example, could be defined as decorative and non-functional, but the Second Circuit previously held it to be utilitarian because it makes the dress more recognizable as a prom dress.⁴ This uncertainty led courts to adopt many different tests for conceptual separability.

In the *Star Athletica* case, Varsity Brands, Inc., a cheerleading uniform manufacturer, sued Star Athletica for copyright infringement, asserting that Star's cheerleading uniforms too closely resembled Varsity's registered designs.⁵ The district court granted Star's motion for summary judgment, finding that Varsity's designs were not copyrightable because the designs were not separable from the uniforms' utilitarian aspects: the colors, stripes, and chevrons that Varsity sought to protect were utilitarian because they made the garment recognizable as a cheerleading uniform.⁶

On appeal, the Sixth Circuit identified *nine* different approaches courts and commentators had used to determine conceptual separability before creating its own,

tenth approach.⁷ Among the tests expressly considered by the court were: (1) the Copyright Office Approach, whereby a PGS feature is separable only if it and the utilitarian article can both exist side by side and both be perceived as fully realized, separate works; (2) the Primary-Subsidiary Approach, whereby a PGS feature is conceptually separable if the artistic features of the design are “primary” to the “subsidiary utilitarian function”; (3) the Objectively Necessary Approach, whereby separability is found if the artistic aspects of a PGS design are not necessary to its utilitarian functions; (4) the Ordinary Observer Approach, whereby a PGS feature is conceptually separable if the “design creates in the mind of the ordinary [reasonable] observer two different concepts that are not inevitably entertained simultaneously”; (5) the Design-Process Ap-

“As a general matter, copyright law does not protect functional designs—known in copyright-speak as ‘useful articles.’”

proach, which focuses on whether “design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences”; (6) the Stand-Alone Approach, which questions if “the useful article's functionality remains intact once the copyrightable material is separated”; (7) the Likelihood-of-Marketability Approach, which asks if “there is a substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities”; (8) Commentator Patry's Approach, which focuses on whether the PGS feature is dictated by form or function; and (9) the Subjective-Objective Approach, whereby conceptual separability is determined by balancing (a) “the degree to which the designer's subjective process is motivated by aesthetic concerns” and (b) “the degree to which the design of a useful article is objectively dictated by its utilitarian function.” The Sixth Circuit also noted that often courts combine multiple approaches, which it elected to do as well.⁸

Using its own unique “hybrid” test, the Sixth Circuit held that the uniforms' design elements were conceptually separable and therefore copyrightable.⁹ To determine functionality, the court focused on the utilitarian aspects

CRAIG B. WHITNEY is a partner and RACHEL SANTORI counsel at Frankfurt Kurnit Klein & Selz PC.

of the useful article. Once it identified the utilitarian aspects, the court asked whether the PGS features could be identified separately from and exist independently of those utilitarian aspects. For a cheerleading uniform, the court defined the utilitarian aspects as covering the body, wicking away sweat, and withstanding the rigors of athletic movement. A plain white uniform, the court reasoned, would perform as well as a decorated one.¹⁰ The chevrons, lines, and shapes that Varsity sought to protect did not enhance the uniform's capacity to function as clothing.

The fact that Varsity's designs could be customized and recreated on different uniforms and other types of clothing assisted the court's decision. The court reasoned that this established that the designs were transferrable and wholly unnecessary for the garment to perform functionally.¹¹

The decision illustrated, in the view of dissenting Judge David William McKeague, that the law in this area was "a mess" and had been "for a long time." In light of the multi-circuit split on determining separability, Judge McKeague wrote that it was "apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design."¹² The Supreme Court agreed and granted Star's cert petition.

III. The Supreme Court's Decision

The Supreme Court granted certiorari to resolve "widespread disagreement over the proper test" for separating artistic and functional elements.¹³ During oral argument, the Justices considered the broader implications of the case, including the potential anticompetitive consequences. That discussion led Justice Sotomayor to observe: "[Y]ou're killing knock-offs with copyright. You haven't been able to do it with trademark law. You haven't been able to do it with patent designs. We are now going to use copyright law to kill the knockoff industry. I don't know that that's bad. I'm just saying."¹⁴ The Justices also made several comments about the expressive nature of clothing. For example, Justice Breyer observed that people normally wear clothes to make a statement about themselves: "They're saying who they are. The clothes on the hanger do nothing; the clothes on the woman do everything. And that is, I think, what fashion is about," a comment Justice Kagan called "so romantic."¹⁵

Justice Thomas wrote the majority opinion. The Court began by stating the standard for separability found in the Copyright Act. Section 101 of the Act states that the PGS features of a useful article are eligible for protection as artistic works if those features "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."¹⁶ Throughout its opinion, the Court adhered strictly to this language, stating that its inquiry would "begin and end

... with the text."¹⁷ The Court sought to give the statutory language its ordinary, contemporary, and common meaning.¹⁸ This approach was reflected in the Court's response to Varsity's attempt to sidestep the difficult separability question by contending that it was not necessary to decide it. Varsity argued that its two-dimensional designs were protectable because they appeared *on* useful articles, but because they were not themselves designs *of* useful articles, separability analysis was not necessary. The Court rejected this as inconsistent with the statute: the Copyright Act states that it protects the "design of a useful article," which necessarily includes both its two-dimensional and three-dimensional aspects, such that separability had to be considered.¹⁹

Acknowledging the many different previously crafted tests, the Court explained that it would not be picking its favorite or undertaking a "free ranging search for the best copyright policy."²⁰ Looking solely at the statutory language and overruling the diverging circuit court interpretations, the Court held that a feature incorporated into the design of a useful article is eligible for copyright protection if it (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable PGS work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.²¹

The Court clarified that the first prong of its test—separate identification—is not difficult to meet. If, when "only looking" at a useful article, some elements can be "spotted" that *appear* to have PGS qualities, the first prong will be satisfied.²²

The Court recognized, however, that the second prong may be more difficult to satisfy. The Court stated that having the capacity to exist independently means that the element must be able to exist as its own PGS work once it is imagined apart from the useful article. In other words, would the element have been eligible for copyright protection if it had originally been fixed in some tangible medium other than a useful article?²³ The element also must not be a useful article itself, nor can it be a replica of that article in some other medium. For example, the cardboard model of a car would be copyrightable, but would not give rise to any rights in the car that inspired it.²⁴

The Court found it easy to apply its test to the designs at issue. In doing so, the Court affirmed the Sixth Circuit's result. First, the Court noted the PGS qualities of the uniforms. Keeping with its assertion that this prong is not difficult to meet, the Court merely stated that the PGS qualities could be identified, without any further analysis.²⁵ Second, the Court stated that if the colors, shapes, chevrons, and stripes on the surface of the uniforms were separated from the uniform and fixed in another medium—for example, a painter's canvas—they would qualify

as PGS works. The Court noted that the designs can be imagined separately without replicating the uniform itself.²⁶ And just as in the Sixth Circuit's decision, the fact that Varsity had itself applied the designs to other types of clothing assisted the Court in finding that the designs were separable.

In dissent, Justice Breyer, joined by Justice Kennedy, argued that the designs Varsity submitted to the Copyright Office were not eligible for protection. Varsity registered only pictures of cheerleader uniforms, Justice Breyer reasoned, and a picture of a useful article does not create rights in the underlying article itself.²⁷ Justice Breyer also criticized the second prong of the majority's test as being too easy to meet, as "virtually any industrial design can be thought of separately as a work of art."²⁸

have adopted a less designer-friendly view, in line with several lower courts.

Star Athletica nevertheless does not represent a sea change with respect to copyright protection for fashion and industrial design. The Court stated, more than once, that the only features of a cheerleading uniform eligible for a copyright in the case were the two-dimensional works of art fixed on the uniform's fabric.³⁰ This arguably was the law even before *Star Athletica*. Maintaining the status quo, the Court's test does not provide copyright protection for the shape, cut, and physical dimensions of a garment.

How lower courts apply the *Star Athletica* separability test will determine the lasting significance of the decision. As of this writing, at least one fashion copyright

"Star Athletica establishes a single, universal test to determine the copyrightability of fashion items and other industrial designs."

IV. Implications

Star Athletica establishes a single, universal test to determine the copyrightability of fashion items and other industrial designs. The many different approaches to separability that courts previously had applied are no longer relevant.

The Supreme Court's test takes an inclusive view of the copyrightability of PGS works incorporated into designs. The Court declined to adopt the position *Star* advanced that garments should be presumptively uncopyrightable.²⁹ In addition, under the Court's test, unless a PGS element is really imperceptible (not able to be "spotted" on a "look"), it should at least be eligible for protection.

The second prong of the test—whether the PGS work can be imagined separately—may lead to broad interpretations by lower courts. But the Court arguably endorsed an expansive reading of this prong. Per the Court, if one could imagine a PGS element on a painter's canvas or any other medium, the requirements for copyrightability are met. As the dissent posited, almost anything can be imagined as a work of art.

Ultimately, *Star Athletica* supports the copyrightability of PGS works incorporated into fashion designs, which may change the tone of fashion law in the United States. Refrains often heard in the industry—such as that there is no copyright protection for designers in the United States or that the United States is woefully behind other countries in terms of protecting designers—should be tempered. That this case—the first of its kind—came out favorably for the designer is notable; the Court could

infringement ruling had cited *Star Athletica*. In response to a motion to reconsider denial of summary judgment in light of *Star Athletica*, the court in *Design Ideas, Ltd. v. Meijer, Inc.*³¹ applied the new separability test to "Sparrow Clips," a clothespin with a silhouetted sparrow design on top. The court previously had found the PGS elements of the pins to be both physically and conceptually separable and therefore copyrightable. Under the new analysis, the court easily reached the same result: the bird portion of the Sparrow Clips, when identified and imagined apart from the useful article—the clothespin—qualified as a sculptural work on its own. Notably, the alleged infringer argued that the bird portion itself had useful applications because it could be hung from a rod or hang on a string by its beak. The court noted that *Star Athletica* required that a design must be a non-useful PGS work to be protectable, but it did not agree that hanging the bird portion on a rod or string made it a useful article.

In addition, plaintiffs have, not surprisingly, begun using *Star Athletica* as authority for bringing copyright infringement claims for fashion designs.³²

V. Conclusion

In *Star Athletica* the Supreme Court identified a single test for copyrightability of designs. It remains to be seen how protective of designers that test ultimately will be when applied by lower courts. But the ability of fashion and other industrial designs to obtain copyright protection can no longer credibly be disputed. As a result, designers should consider seeking to protect their designs at the outset. And users incorporating existing designs into

new works may need to examine whether the underlying designs are protected—or protectable.

Endnotes

1. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).
2. *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996 (2d Cir. 1995).
3. *Folio Impressions*, 937 F.2d at 761, 763, 765.
4. *Jovani Fashion, Inc. v. Fiesta Fashions*, 500 F. App'x 42, 44 (2d Cir. 2012).
5. *Varsity Brands, Inc. v. Star Athletica, LLC*, 10-2508, 2014 WL 819422, at *2 (W.D. Tenn. 2014).
6. *Id.* at 8.
7. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484 (6th Cir. 2015).
8. *Id.* at 485-87.
9. *Id.* at 487.
10. *Id.* at 491.
11. *Id.* at 492.
12. *Id.* at 496-97.
13. *Star Athletica*, 137 S. Ct. at 1007.
14. *Star Athletica*, 2016 WL 6426437 at 35 (U.S. Oral Arg. 2016).
15. *Id.* at 42.
16. 16 137 S. Ct. at 1007.
17. *Id.* at 1010.
18. *Id.*
19. *Id.* at 1009.
20. *Id.* at 1010.
21. *Id.*
22. *Id.*
23. *Id.* at 1011.
24. *Id.* at 1010.
25. *Id.* at 1012.
26. *Id.*
27. *Id.* at 1030-31.
28. *Id.* at 1033.
29. *Star Athletica v. Varsity Brands*, 2016 WL 3923923, at *38 (U.S. 2016).
30. 137 S. Ct. at 1006, 1013.
31. *Design Ideas, Ltd. v. Meijer, Inc.*, No. 15-CV-03093, 2017 WL 2662473 (C.D. Ill. 2017).
32. *See Puma SE v. Forever 21, Inc.*, No. 2:17-cv-02523 (C.D. Cal. filed Mar. 31, 2017).

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Inviting the Return of the Submarine Patent

By Doug Miro and Larry Rosenthal

Introduction

Earlier this year, on March 21, the Supreme Court in *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*¹ reversed the Federal Circuit and eliminated laches as a defense to damages claims in patent cases. Seven of the eight members of the Court who participated in the case agreed that laches is incompatible with the six-year limitation on damages claims set forth in 35 U.S.C. § 286. The basis of the holding is that laches is “a gap-filling doctrine,” and where there is a statute of limitations, “there is no gap to fill.”²

With its ruling in *SCA Hygiene* the Supreme Court aligned patent law with copyright law with respect to the viability of a laches defense. Three years ago, the Court held in *Petrella v. Metro-Goldwyn-Mayer, Inc.*³ that the Copyright Act’s three-year statute of limitations precludes a laches defense in copyright cases. The Supreme Court used the same logic to arrive at its parallel conclusion in *SCA Hygiene* despite the arguments raised by amici as to the many differences between these two types of intellectual property.⁴

Justice Breyer (who also dissented in *Petrella*) was the lone dissenter, arguing that removing laches—and allowing a patent holder to sue at any time after infringement—creates a gap that puts an alleged infringer at a big disadvantage:

Because a patentee might wait for a decade or more while the infringer (who perhaps does not know or believe he is an infringer) invests heavily in the development of the infringing product (of which the patentee’s invention could be only a small component), while evidence that the infringer might use to, say, show the patent is invalid disappears with time. Then, if the product is a success, the patentee can bring his lawsuit, hoping to collect a significant recovery.⁵

Justice Breyer here foretells the return of the Submarine Patent.

History of the Submarine Patent

A. Former Patent Framework

Before the United States adopted the trade agreements included in the Uruguay Round Agreements Act in 1994, the term of a U.S. patent expired 17 years from the date the patent issued. This allowed a patentee to game the system and keep a patent family pending theoretically indefinitely because a new application in a patent family could claim priority back to the filing of the first application in the family so long as the new application

was filed before prosecution in all of the pending applications in the family ended (issued or were abandoned). As a result of this framework, an applicant could continue to file new patent applications years after the initial date of priority while still claiming this early priority date.

For example, if an applicant filed a patent application on January 1, 1950, and it issued on January 1, 1953, the applicant could file a continuation application on December 31, 1952 and claim priority to January 1, 1950. Before that second application issued, the applicant could file another continuation application, also with a claim of priority back to January 1, 1950. Look forward thirty years, and that patent family could still be alive, with new claims being drafted as technology continued to advance. An application that issued 30 years after the January 1, 1950 priority date would not have expired until 1997.

B. Lemelson

A legendary example of this practice involved the inventor Jerome Lemelson, who hamstrung companies in the machine vision technology (e.g., bar codes) field for years by tailoring claims to new technologies that were not even contemplated when his first application was filed in 1954. By taking advantage of the seventeen-year-from-issuance rule, Lemelson was able to keep his patent family open for about forty years.⁶ His game plan was to amend his continuing applications based on technology developed by other inventors over time, so that when these other inventors commercialized their inventions, Lemelson would be in a position to sue them.⁷ Initially, Lemelson sued smaller users of the infringing technology who tended to settle instead of challenging the patents in an expensive lawsuit, but after Lemelson died, the heir to his patents began suing bigger fish. This led to his patents being challenged in court, where they were eventually found invalid and unenforceable due to prosecution laches.⁸ Before this reversal of fortune, the strategy was so successful that the Lemelson patents raised over a billion dollars in licensing fees.⁹

Patents acquired under this scheme became known as “submarine patents” because they lay in wait, hiding until the right time to surface and torpedo unsuspecting companies that had invested time and money in developing their technologies and expanding their businesses without being aware of the lurking danger.

C. Death of the Submarine Patent

One of the provisions in the Uruguay Round Agreements Act of 1994, codified as 35 U.S.C. § 154, provided that the term of a patent would be changed to

DOUG MIRO is a partner and LARRY ROSENTHAL an associate at Ostrolenk Faber LLP.

a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, 365(c), or 386(c), from the date on which the earliest such application was filed.¹⁰

As a result, under current law, regardless of when a continuation application is filed, it now expires 20 years from the filing date of the first application in the family¹¹ to which it claims priority. In the example above, if the current 20-year term rule were in effect in 1950, any patent in the family that issued, no matter when it issued, would have expired by January 1, 1970 (subject to extensions). Lemelson's patents would not have reached past 1974 (plus an extension of up to five years).

The Submarine Patent was no more.

Laches Defense in the Real World

A. What Laches Protected Against

The laches defense in patent law, rooted in the seminal Federal Circuit case *A.C. Aukerman Co. v. R. L. Chaides Constr. Co.*,¹² protected an accused infringer from a patent holder who delayed suing for so long that the accused infringer was prejudiced.¹³ This prejudice generally came in two forms: evidentiary and economic. Evidentiary prejudice could arise "by reason of a defendant's inability to present a full and fair defense on the merits due to the loss of records, the death of a witness, or the unreliability of memories of long past events, thereby undermining the court's ability to judge the facts."¹⁴ The loss of evidence was not limited to now-hard-to-find prior art and inventor-witness testimony but also could include loss of the accused infringer's own documents. Not being aware of a looming infringement action, a company might not preserve documents necessary to defend itself, including business records and licensing agreements, and key witnesses may be hard to find.

Economic prejudice may arise "where a defendant and possibly others will suffer the loss of monetary investments or incur damages which likely would have been prevented by earlier suit."¹⁵ Companies could lose significant investments in infrastructure, inventory build-up, employee training, establishing supply lines, and goodwill in the accused products. For laches purposes there was no requirement, as with equitable estoppel, that the alleged infringer know about the patent or that it was led to believe it would not be sued.¹⁶

With laches as a permitted defense to patent infringement, a patent holder was required to bring suit within a reasonable amount of time after learning of the infringe-

ment in order to avoid causing such prejudice to the accused infringer. That is, the patent holder could not "intentionally lie silently in wait watching damages escalate, particularly where an infringer, if he had notice, could have switched to a noninfringing product."¹⁷

B. Laches in Practice

The laches defense was relied upon often to avoid injustice, including in the following cases.

1. Universal Remote Control

The authors recently represented the defendant in *Universal Electronics Inc. v. Universal Remote Control*¹⁸ (the "2012 URC Litigation"). Twelve years earlier, in 2000, UEI had sued URC on a few patents, including U.S. Patent 5,414,426 (the "'426 patent"); UEI thus was aware of URC's product lines since at least that time. After URC notified UEI in 2001 that the '426 patent was invalid due to prior art, UEI alleged that a quick fix to an error in the claimed inventorship would give the '426 patent an earlier priority date and that the '426 patent therefore was not invalid over this particular piece of prior art. In 2002, UEI dismissed its claims relating to the '426 patent instead of correcting the inventorship issue. Ten years later, UEI sued URC again on the '426 patent in the 2012 URC Litigation. In the intervening 10 years, URC had "continued to engage in open and notorious competition with UEI and expanded its product line with the allegedly patented feature, while UEI remained silent."¹⁹ In addition to this economic prejudice, URC also suffered evidentiary prejudice because the alleged co-inventor passed away during this waiting period, and UEI could not produce any emails prior to 2006. Moreover, other witnesses "could no longer recall the alleged inventor's role in the original invention twenty years earlier or why UEI waited ten years to correct inventorship."²⁰

As URC explained in its amicus brief to the Supreme Court in *SCA Hygiene*:

Had UEI asserted its claim in a timely manner, URC could have avoided any potential liability by removing the allegedly infringing feature, changing to another design, or seeking to attack the validity of the patent sooner Even if URC were ultimately unsuccessful in those attempts, URC's potential liability would have been significantly less before URC's significant investment in expanding its business.²¹

2. Altech

In *Altech Controls Corp. v. EIL Instruments, Inc.*²² the Federal Circuit upheld a laches defense where the defendant presented evidence of evidentiary prejudice due to a policy of shredding, after five years, relevant documents that it would have needed for its defense. The defendant

“also presented evidence of economic prejudice where it would have handled its significant financial restructuring in a different manner had it been aware of a potential lawsuit by the plaintiff.”²³

3. *Serdarevic*

In *Serdarevic v. Advanced Med. Optics, Inc.*²⁴ the Federal Circuit affirmed a finding of laches where three witnesses with knowledge of the plaintiff’s claim to be an inventor on certain patents “died during the period of her delay” and based on the “cumulative and inherent prejudice from the dimming memories of all participants.”²⁵ The court specifically noted the lower court’s reasoning that “their deaths prevent the defendants from fully investigating [the plaintiff’s] claims.”²⁶

4. *Adelberg Labs*

In *Adelberg Labs, Inc. v. Miles, Inc.*²⁷ the Federal Circuit held that “[m]aking heavy capital investment and increasing production can constitute prejudice.”²⁸ In that case economic prejudice was a basis for laches where the defendant built up its business by the seventh year of plaintiff’s delay and where it had reason to believe the plaintiff would not sue. The Federal Circuit noted that this activity “could have been costly to Cutter if [plaintiff] Adelberg had successfully sued and recovered lost profits or increased damages to compensate for the infringement. Thus, [defendant] Miles has shown adequate prejudice by [plaintiff] Adelberg’s delay in bringing suit.”²⁹

Effects of SCA Killing Laches as a Defense

A. Return of the Submarine Patent

With the Supreme Court’s decision in *SCA Hygiene*, the “submarine patent” appears to have returned to unfairly haunt alleged infringers, albeit in a slightly different form and perhaps for a somewhat shorter period of time. Previously, unissued patents would remain submerged indefinitely until a target was found. Today’s submarine patent takes the form of an issued patent that may be unknown to the industry at large. The Supreme Court has, perhaps unwittingly, unleashed a host of problems for innocent, unsuspecting companies that believe they are not infringing on anyone’s intellectual property. Because a patentee is now effectively able to collect damages for any six-year period prior to the filing of an infringement claim,³⁰ this new version of the submarine patent allows patent holders to lay in wait, even past the term of the patent, until a specific target, or even an entire industry, grows, and to profit from the accused infringers’ investments with little risk to themselves. It also places an unattainable burden on companies to learn about every relevant patent that exists.

1. Patent Holder Can Lay in Wait Until a Specific Target Grows or an Industry Develops

Laches previously prevented the selective targeting described above, but, as noted by Justice Breyer, a patent holder no longer has to bring suit soon after learning

of an alleged infringement of its patent.³¹ Instead, it can take a wait-and-see approach while the alleged infringer expends considerable capital to expand its business, including hiring and training employees, developing sales, establishing supply lines, building inventories, and investing in research and development. This may not be limited to a single company—it could pertain to an entire industry. A patented technology could even be unwittingly incorporated into a common standard and used by all manufacturers that wish to be in compliance for reasons of interoperability.

Not only are these companies putting forth a lot of effort during this waiting period, but the scope of the damages for which they may be liable increases day by day. Delay then becomes a strategic decision for a patent holder to the detriment of those unknowingly using the patented technology.

Although section 286 limits damages to the six years preceding the filing of the lawsuit, the patent owner can now select the six most profitable years to the accused infringers, as it takes time for companies to develop market share and to realize returns on their investments.

2. The Patent Holder Will Profit From Accused Infringers’ Investments at Little Risk

Companies face great risks when they build a business through substantial investment in a technology. By sitting on the sidelines, patent holders do not expose themselves to these risks. Instead, they have the benefit of hindsight and are afforded the convenience of being able to step in at any time once the target companies have succeeded. The more the companies invest in the technology and products (at greater risk), the greater the profits to be claimed by the patent holder.

If a patent holder were to sue an alleged infringer as it was just beginning to invest in a specific technology, the patent holder would not be able to recover much in the way of damages—perhaps only a future royalty. However, facing the prospect of having to share a portion of its profits, a licensee may choose to switch to an alternate technology. Therefore, by lying in wait, the patent holder not only essentially gets a free ride on the shoulders of the accused infringers, it also can obtain greater rewards.

3. An Unattainable Burden Has Been Placed on the Manufacturer

Before *SCA Hygiene*, once a patent holder became aware of a company using its invention, it had the burden to timely enforce its patent rights or have its claims possibly blocked or limited by laches. An alleged infringer’s position improved in a potential patent infringement action with an unreasonable passage of time. Now, since there is no such burden on the patent holder, companies do not have the luxury of “time healing all wounds.” Instead, time can now inflict the wounds.

As a result of *SCA Hygiene*, a much more onerous burden is now placed on companies to monitor patents that may be relevant to the technologies they use. This may not be an easy task. In certain cases, there are many patents that cover minute aspects of the technology. For example, there are tens of thousands of patents covering various aspects of cell phones, including for user interface, battery, antenna, substrate, data encoding/decoding, cell network topology, 4G and LTE standards, and many many more. For a company to go back 25 or more years to uncover any patent that may have a bearing on its technology could be a Sisyphean task depending on the incorporated technologies. Meanwhile, the patent holder, clearly in the better position to identify widespread use of its technology, now has no burden at all.

B. Prejudice to Alleged Infringers

As mentioned above, alleged infringers will face great prejudice if older patents are asserted against them. This is the “gap” that Justice Breyer noted in his prescient dissent.³²

1. Loss of Evidence

It becomes more difficult to defend against patents as time passes. Therefore, the longer a patent holder waits to assert a patent, the more advantage it has in court. As explained above, the memories of witnesses (if still alive) fade over time, and most email systems are designed not to keep old emails past a certain amount of time. Hard copies of documents are also harder to find, as they may be stored away or even discarded. There was clear evidentiary prejudice of this kind to the accused infringers in the *URC*, *Altech*, and *Serdarevic* cases, where documents had been properly destroyed or witnesses had died or had dimmed memories.

2. Economic

Most companies continue to invest over time in development and expansion of technology and of their product lines. Even if the technology has evolved, it may be based on older technology of the patent holder, whose broad claims still may read on the improved technology. Companies that have spent a lot of time and money thus may now find that their investments were not as profitable as predicted because now they owe a portion of revenues to a patent holder. What looked like a good investment with a solid ROI may not look so profitable in hindsight. Had the accused infringer known of the patent and the accusations many years earlier, it may have invested in alternate, more profitable technologies or changed its business model to reflect the extra costs.

3. Lock-In

As a corollary to economic prejudice, once a company has made investments in certain technology, there comes a time when abandoning use of the infringing technology or switching to new, non-infringing technology becomes more difficult or even impossible. As explained above, a company would have hired and trained employees, built

infrastructure and inventory, established supply lines, and developed goodwill with its customers. At this point, the accused infringer is “locked in”³³ to its chosen technology.

C. Trolls

At a time when it seems everyone else is united in an effort to eradicate trolls—the blight of the patent system—this decision empowers them in various ways. Trolls are entities that do not develop any technology of their own but instead use patents solely to extract money from legitimate companies.

1. Find Older Patents

As explained above, the longer the wait to file suit, the more advantages the troll has because of the increased prejudice to the accused infringer. Patent trolls therefore now have incentive to search through and purchase old patents (possibly even if recently expired) to find any that may apply to current products or services. This greatly expands the number of potential patents that could be asserted against companies that are just trying to continue with business as usual.

2. Increased Delay

A company that makes, uses, or sells its patented technology has the incentive to sue quickly to prevent competitors from using the patented technology to eat away at its market share and profits.³⁴ To the contrary, trolls are incentivized to delay bringing suit as they lie in wait, as explained above, since their primary reward is recovering settlement and damages rewards.³⁵ Because contesting patents becomes more expensive and uncertain as the patent ages due to evidentiary prejudice, trolls can also recover higher awards by waiting.³⁶

3. More Likely to Settle

Trolls are also encouraged to bring suit on older patents because the higher cost and uncertainty in defending against these suits plays right into their game plan of extracting a quick settlement instead of going to trial on the merits. Trolls are “disproportionately likely to bring suits on low-quality patents.”³⁷ Not only may the claims themselves be weak and possibly invalid, but an infringement read can afford to be somewhat questionable because the patents will not be held invalid or unenforceable without the accused infringer spending the money to see the litigation through.

4. Accused Infringers Are Left with Equitable Estoppel

With laches no longer being a defense to patent infringement, accused infringers still can rely on equitable estoppel, but this is usually more difficult to establish than laches. Where laches is based on the unreasonable passage of time, to establish equitable estoppel an accused infringer must prove that the patent holder “communicate[d] something in a misleading way, either by words, conduct or silence [; the alleged infringer]

Continued on page 16

Section Activities and Notices—15th Annual Women in IP

On June 7, 2017, the Section presented its 15th annual **Women in Intellectual Property Law** event. Hosted by Baker & McKenzie LLP, the program drew over 100 female attorneys who gathered to network, reconnect with colleagues, and glean advice from this year's distinguished panel of speakers. The evening began with an hour-long networking reception, where attendees were encouraged to get to know one another while enjoying wine and hors d'oeuvres. Section Chair Erica Klein began the program with a welcome message and a special tribute to Program Chair Joyce Creidy of CompuMark/Clarivate Analytics, whose hard work in organizing the event for the past 15 years was applauded by all and acknowledged with a gift from the Section.

Ms. Creidy reminded the audience to support and empower one another and, in the words of Mother Teresa, how important it is to "be kind anyway." Before introducing the panel, Ms. Creidy shared a list of recent achievements of several of the attendees and encouraged others in the audience to stand up and share their own successes and to celebrate the accomplishments of others.

Panelists Aileen Atkins (Cowan DeBaets Abrahams & Sheppard LLP), Nyasha Foy (VICE Media), Rashmi Raj (Nielsen), and Lisa Rosaya (Baker & McKenzie) then took turns sharing their experiences and advice for women in the legal field. The speakers also generously shared their personal challenges—coping with the loss of a loved one, balancing life as a new mother, struggling in school, facing overt discrimination—and offered inspiration for overcoming setbacks.

Ms. Rosaya advocated taking control of your career and, when setting goals, to "know your value and know your currency." She urged not becoming a victim or letting external factors define your goals, despite personal or professional hardships.

Ms. Raj stressed how simple yet significant it is when women support each other in the workplace. She expressed appreciation for the general counsel who—in front of a full room of employees—invited Ms. Raj to find a seat at her table. This proclamation of "she is mine, and I will support her" is something Ms. Raj encouraged all attendees to practice in their careers and mentoring relationships.

"Find your North Star and set your course" was the mantra urged by Ms. Foy. She cautioned that the path to success will never be straight, but it is crucial to set goals. Ms. Foy's story was colored by her experience not only as a female attorney but also as an African-American and as a self-proclaimed "millennial."

Ms. Atkins reminded us about the difference between diversity, which is being asked to a party, and inclusion, which is being asked to dance. Her experience in the

music industry as well as in the legal field taught her the importance of establishing a support network, and she encouraged others to "build your own boys club."

The program concluded with a dessert reception sponsored by Compumark/Clarivate Analytics and the much-anticipated prize raffle, with gifts provided courtesy of Brooks Brothers, Coty, Kramer Levin Naftalis & Frankel LLP, L'Oreal, Orange Theory, Physique57, Ralph Lauren, Revlon, Row House, Singer, Soul Cycle, and Steve Madden.

Danielle Maggiasco
Frankfurt Kurnit Klein & Selz



See pages 14-15 for more photos!





15th Annual Women in IP

June 7, 2017 | Baker & McKenzie LLP | NYC



Return of the Submarine Patent

Continued from page 12

relie[d] upon that communication [; and the alleged infringer] would be harmed materially if the [patent holder] is later permitted to assert any claim inconsistent with his earlier conduct.”³⁸ Equitable estoppel can, however, entirely bar a patentee’s claim rather than only barring damages incurred prior to suit (as with laches).³⁹

Recommended Actions

Unless Congress steps in to codify laches as a defense to a claim of patent infringement, companies will need to protect themselves from older patents. The best time to do this is before a company invests in its technology. It would be wise for companies to have far more extensive right-to-use (aka freedom-to-operate) searches performed to bring these new submarine patents to the surface early. This type of search examines patents in the same space as the technology in question and can reveal any patent coverage that a company should avoid or try to license. This is not just a search for patents; it usually includes a claim-by-claim analysis of any patents that may be close in subject matter to the technology at issue. If there are any patents of concern, the company then would understand the scope of the claims and how to design around them if necessary and if desired. The bottom line is that the company would be able to make an informed decision as to how to proceed and could take steps to protect itself, including considering a written opinion to safeguard against any future claims of willful infringement.

If a company receives a notice letter from a patentee threatening infringement, the company may want to consider responding not only with arguments of non-infringement, invalidity, or other defenses if available, but also with an affirmative statement bolstering a defense of equitable estoppel. For example, this statement could declare that the company will rely on the patentee’s future silence and failure to reasonably follow up on its allegations to justify the continuation of the accused activities. If a suit is then brought after some unreasonable passage of time, the company can then argue that it has been materially harmed.

Conclusion

With the demise of a laches defense in an action for patent infringement, accused infringers have lost a powerful and relatively easy-to-establish ally that barred patentees from strategically lying in wait for years to gain distinct advantages over accused infringers. Trolls have been emboldened, and patent holders can profit from accused infringers’ investments with little risk to themselves. Companies now have a formidable burden of being proactive in understanding the relative patent landscape in order to protect themselves and their investments from damaging lawsuits.

In stretching to conform patent law and copyright law, the Supreme Court has unwittingly resurfaced the Submarine Patent.

Endnotes

1. 137 S. Ct. 954 (2017).
2. *Id.* at 961.
3. 134 S. Ct. 1962 (2014).
4. See, e.g., Brief of Dell Inc. et al. as *Amici Curiae* in support of Respondents at 19-26, *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954 (2017) (No. 15-927).
5. *SCA Hygiene*, 137 S. Ct. at 968.
6. *Breaking the (Bar) Code*, IP LAW & BUSINESS, Mar. 2004, at 3.
7. *Id.*
8. Prosecution laches is not the same as the laches at issue in the *SCA Hygiene* case. Prosecution laches pertains to delay in acquiring the patents, not in any delay in bringing suit on an already issued patent.
9. *Breaking the (Bar) Code*, *supra* note 6, at 2.
10. 35 U.S.C. § 154(a)(2).
11. Subject to extension due to delay in examination by the patent office. 35 U.S.C. § 154(b).
12. *A.C. Aukerman Co. v. R. L. Chaides Constr. Co.*, 960 F.2d 1020 (Fed. Cir. 1992).
13. *Id.* at 1032.
14. *Id.* at 1033.
15. *Id.*
16. *Id.*
17. *Id.*
18. 8:12-cv-00329 AG (JPRx), C.D. Cal.
19. Brief Amicus Curiae of Universal Remote Control in Support of Respondents, *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, No. 15-927, at 11.
20. *Id.* at 12.
21. *Id.* at 13.
22. 8 Fed. Appx. 941 (Fed. Cir. 2001).
23. *Id.*
24. 532 F.3d 1352 (Fed. Cir. 2008).
25. *Id.*
26. *Id.* at 1361.
27. 921 F.2d 1267 (Fed. Cir. 1990).
28. *Id.* at 1272.
29. *Id.*
30. 35 U.S.C. § 286.
31. *SCA Hygiene*, 137 S. Ct. at 967-68.
32. *Id.* at 968.
33. *Id.* at 972.
34. Brief of Dell Inc. at 27.
35. *Id.* at 28.
36. *Id.* at 31.
37. *Id.* at 29.
38. *Aukerman*, 960 F.2d at 1041.
39. *Id.*

Protecting Registration of Disparaging Trademarks

By Jonathan Bloom

I. Introduction

In *Matal v. Tam*,¹ the Supreme Court considered a First Amendment challenge to a part of section 2(a) of the Lanham Act that for more than 70 years prohibited the registration of any trademark that “may disparage . . . persons, living or dead, institutions, beliefs, or natural symbols, or bring them into contempt, or disrepute.”² In striking down this facially viewpoint-based speech regulation as unconstitutional, the Supreme Court held that it could not be justified either on the ground that registered trademarks are government speech (and thus not subject to the First Amendment) or on the ground that the government has a substantial interest in shielding the public from offensive marks. The Court’s decisive rejection of the government-speech theory, which it described as “susceptible to dangerous misuse,” prevents the government from expanding its regulatory authority over intellectual property rights into a right to pass judgment on the expressive characteristics of material the government played no role in creating.

The Court made clear in *Tam* that trademark registration enjoys no immunity from well-established limits on the government’s authority to restrict speech, even if trademarks are assumed to be commercial speech (a question the Court declined to decide). As a result of the Court’s partial invalidation of section 2(a), even disparaging/offensive trademarks must succeed or fail on their merits, in competition with other marks and without government interference except to remedy traditional trademark-related harms, e.g., consumer confusion or dilution.

As a number of the briefs in the case, as well as the Federal Circuit opinion, highlighted, off-color and (at least to some) offensive registered trademarks abound notwithstanding section 2(a)—reflecting seemingly arbitrary (or, at least, inconsistent) enforcement of the law that did nothing to help the government’s case.³ The Federal Circuit, for example, called the PTO’s record of trademark registrations and denials “rife with inconsistency,” noting, *inter alia*, its rejection of HAVE YOU HEARD SATAN IS A REPUBLICAN on the ground that it disparaged the Republican Party, while finding the mark THE DEVIL IS A DEMOCRAT not to be disparaging, and its registration of FAGDOG three times and rejection of it twice, at least once on disparagement grounds.⁴ *Tam* eliminates the administrative basis for such varying results. It remains to be seen to what extent this leads to a spike in applications to register “offensive” marks, which would bear out the Federal Circuit’s view that section 2(a) has had a chilling effect. The first month or so following the Supreme Court’s ruling saw seven applications for versions of “the N-word” and applications for an epithet for people

of Chinese dissent, and a swastika.⁵ The applicant for the mark “The Piss Tape Is Real” reportedly was prompted by *Tam* to file the application,⁶ and more in this vein is sure to follow. However things unfold by way of practical impact, though, *Tam* stands as evidence of the Supreme Court’s willingness to vindicate First Amendment interests even when they clash with a longstanding regulatory regime.

II. Background

Simon Tam, lead singer of band called “The Slants,” attempted to register the name of the band as a trademark with the PTO. “The Slants” is a dance-rock band comprised of Asian-Americans. By calling themselves “The Slants,” a derogatory term for persons of Asian descent, the band hoped to “reclaim” and “take ownership” of the term in an effort to diminish the stereotypes associated with people of Asian ethnicity.⁷ The PTO rejected Tam’s trademark application, citing the disparagement clause of section 2(a).

Tam appealed unsuccessfully to the Trademark Trial and Appeal Board. He then appealed to the Federal Circuit, which, sitting en banc, ultimately held that because the disparagement clause targeted the expressive aspect of the marks, it was subject to strict scrutiny.⁸ The court further held that even if it were treated as a regulation of commercial speech, the law failed intermediate scrutiny because it was viewpoint discriminatory on its face, and the government offered “no legitimate interests” to justify it, disapproval of a mark’s message not being a sufficient government interest.⁹

As expected, the Supreme Court granted the government’s petition for certiorari.

III. The Supreme Court Decision

In an opinion by Justice Alito, joined in full by Chief Justice Roberts and Justices Thomas and Breyer and in part by Justices Kennedy, Ginsburg, Sotomayor, and Kagan, the Supreme Court affirmed, agreeing with the Federal Circuit that the disparagement clause violated the First Amendment.

After dispensing with *Tam*’s statutory argument that the disparagement clause does not apply to trademarks that disparage racial or ethnic groups (as opposed to individuals and entities), the Court turned to the government’s claim that the First Amendment does not apply to PTO registration determinations because registered

JONATHAN BLOOM is counsel at Weil Gotshal & Manges LLP and editor-in-chief of *Bright Ideas*.

trademarks (although not the trademarks themselves) are government speech. It is understandable that the government would make this argument because the disparagement clause is, on its face, viewpoint discriminatory. But the Court correctly, and unanimously, found it to have no merit. After noting that the government-speech doctrine is “susceptible to dangerous misuse,”¹⁰ the Court pointed out that “[i]f private speech could be passed off as government speech by simply affixing a government seal of approval, government could silence or muffle the expression of disfavored viewpoints.”¹¹

Viewed through this lens, the Court found the assertion that registered trademarks are government speech both “far-fetched”¹² and “a huge and dangerous extension of the government-speech doctrine.”¹³ The Court made the commonsense point that if all registered trademarks were government speech, it would mean the government has been “babbling prodigiously and incoherently,” saying “many unseemly things,” “expressing contradictory views,” and “unashamedly endorsing a vast array of commercial products and services.”¹⁴ In fact, as the Federal Circuit explained, “When the government registers a trademark, the only message it conveys is that a mark is registered.”¹⁵

The Court also distinguished the registration of trademarks from what it previously has held to be government speech, including a government-sponsored advertising campaign promoting beef products¹⁶ and, most recently, in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*,¹⁷ the messages on Texas specialty license plates. Observing that *Walker* likely demarcates “the outer bounds of the government-speech doctrine,”¹⁸ the Court concluded that trademarks are “vastly different” from the license plates because, unlike the plates, trademarks are not owned by the state, designed by the state, or a form of government identification, and they generally are not associated with the state.¹⁹ Indeed, the Court noted, the PTO has itself stated that a trademark registration “is not a government imprimatur.”²⁰ The Court further emphasized the “worrisome implication” of the government’s argument by asking rhetorically if copyright registration would similarly deprive books of First Amendment protection (obviously not).²¹ For all these reasons, the Court concluded that trademarks “are private, not government, speech.”²²

Having determined that registered trademarks are private speech, the fact that denial of federal registration does not prevent use of the mark, such that section 2(a) does not actually prohibit any speech, did not play any role in the Court’s analysis. Evidently, withholding the benefits of registration was so clearly a burden on speech—which is enough to trigger First Amendment scrutiny²³—that the Court saw no need to pause on whether section 2(a) impaired First Amendment rights.

Next, joined only by Chief Justice Roberts and Justices Thomas and Breyer, Justice Alito addressed (and rejected) the government’s argument that trademark

registration is a form of government subsidy and that the government is allowed to subsidize speech expressing a particular viewpoint. This theory did not apply, Justice Alito found, because the government does not fund the creation of private trademarks.²⁴ Finally, these Justices rejected the government’s theory that trademark registration is a “government program” pursuant to which the government may adopt certain content and speaker restrictions. Even if trademark registration were viewed as the creation of a limited public forum for private speech, Justice Alito wrote, the disparagement clause would not pass muster because it “denies registration to any mark that is offensive to a substantial percentage of the members of any group” and, therefore, discriminates on the basis of viewpoint²⁵—which is impermissible even in a limited public forum.²⁶

Having turned aside these efforts to evade First Amendment scrutiny, the Court turned to the appropriate level of such scrutiny. In its en banc ruling, the Federal Circuit had held that the disparagement clause regulated the expressive, rather than the commercial, aspect of marks and that it therefore was subject to strict scrutiny (although the court held that it was unconstitutional even under the *Central Hudson* intermediate scrutiny test for commercial speech).²⁷ The Supreme Court, ruling more narrowly, assumed, without deciding, that trademarks are commercial speech and likewise found the disparagement clause wanting under *Central Hudson* on the ground that it did not clearly serve a substantial interest and was not narrowly drawn to “extend only as far as the interest it serves.”²⁸

The government asserted that two substantial interests were served by the disparagement clause. First, it claimed an interest in “preventing ‘underrepresented groups’ from being ‘bombarded with demeaning messages in commercial advertising.’”²⁹ The Court rejected this argument out of hand, noting that it reduced to a claim that the government “has an interest in preventing speech expressing ideas that offend” —an “idea that strikes at the heart of the First Amendment.”³⁰

Second, the Government argued that the disparagement clause protects the “orderly flow of commerce” by barring “trademarks that support invidious discrimination.” The Court was not persuaded, finding that the clause was not narrowly tailored to drive out only invidious discriminatory trademarks but, rather, was a wholesale ban against “any trademark that disparages *any person, group, or institution.*”³¹ The Court found that this went “much further than is necessary to serve the interest asserted” and thus did not satisfy *Central Hudson*.

In closing, the Court noted that the marketplace is “well stocked with merchandise that disparages prominent figures and groups” and that “the line between commercial and non-commercial speech is not always clear.”³² Accordingly, the Court opined, allowing commercial speech to be “cleansed of any expression likely to cause

offense” would endanger free speech by “permitting the suppression of any speech that may lead to political or social ‘volatility.’”³³

Justice Kennedy, joined by Justices Ginsburg, Sotomayor, and Kagan, filed a concurring opinion in which he explained that the proscription against viewpoint discrimination applies even to commercial speech. Citing his majority opinion in *Sorrell v. IMS Health Inc.*, Justice Kennedy wrote that the First Amendment “requires heightened scrutiny whenever the government creates a regulation of speech because of disagreement with the message it conveys”³⁴ and that the disparagement clause reflected “the Government’s disapproval of a subset of messages that it finds offensive,” which is “the essence of viewpoint discrimination.”³⁵ Justice Kennedy further observed that, to the extent they are commercial in nature, trademarks are a “tangible, powerful” manifestation of the (viewpoint-neutral) marketplace of ideas metaphor that “make up part of the expression of everyday life.”³⁶ He noted that while the law can protect consumers against confusing or misleading trademarks, those legitimate objectives of *other* portions of the Lanham Act “do not alter the speech principles that bar the viewpoint discrimination embodied in the [disparagement clause].”³⁷

Justice Thomas filed a short concurring opinion in which he noted his longstanding position that strict scrutiny should be applied even to commercial speech.³⁸

IV. Discussion

Tam represents an important addition to the Supreme Court’s First Amendment jurisprudence as well as a significant alteration of longstanding PTO practice with respect to trademark registration (and cancellation). In broad terms, the Court reaffirmed its commitment to protecting the “marketplace of ideas” against government intervention (although only Justice Kennedy in his concurrence explicitly used that term), no matter how offensive the content. The Court held that even in the realm of commercial speech, the government may not engage in viewpoint discrimination on the basis of perceived offensiveness. In this regard, the decision extends a line of Supreme Court rulings rejecting offensiveness as a valid ground for restricting speech. In *Snyder v. Phelps*, for instance, which involved an anti-gay funeral protest, Chief Justice Roberts stated in his majority opinion that speech “cannot be restricted simply because it is upsetting or arouses contempt,”³⁹ while in *Texas v. Johnson*, which involved a state law against flag burning, Justice Brennan, writing for the Court, famously wrote: “If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”⁴⁰ This powerful principle carried the day in *Tam*.

As important as the Court’s unanimous rejection of offensiveness as a basis for policing commercial speech

was the Court’s unanimous rejection of the government-speech theory. The Court noted correctly that allowing expansion of this doctrine to government approval of private speech could empower the government to “silence or muffle the expression of disfavored viewpoints.”⁴¹ By describing *Walker*—the Texas specialty license plate case—as likely marking “the outer bounds” of the government-speech doctrine,⁴² the Court shut the door on what would have been an incongruous extension of a potentially powerful censorship to speech created with no government involvement.

In its ruling, the Federal Circuit majority opined that “[t]he importance of the benefits of federal trademark registration,” including exclusive nationwide use, *prima facie* evidence of ownership and validity, and the ability to stop importation of goods bearing the mark, provided a strong disincentive to adopt marks that could potentially run afoul of the disparagement clause.⁴³ That disincentive is now removed. Notably, however, section 2(a) also prohibits the registration of “immoral” or “scandalous” marks—criteria seeming to be no less vulnerable under the First Amendment than the disparagement clause. As noted, the Court in *Tam* made clear that offensiveness is not a permissible basis for government regulation of speech.⁴⁴ The constitutionality of these other portions of section 2(a) will be tested at the Federal Circuit in an appeal of the PTO’s refusal to register “Fuct” as a trademark for clothing on the ground that it is scandalous.⁴⁵ In that case, *In re Brunetti*, the government is taking the position that a vulgarity, unlike a disparaging term, is not viewpoint based.⁴⁶ That dubious claim, even if true, is not likely to salvage the government’s ability to regulate trademarks according to subjective moral standards.

On the other side of the coin, the Court has relieved the PTO of the burden of continuing to make seemingly arbitrary viewpoint-based distinctions between marks under the disparagement clause, thereby eliminating a significant, longstanding source of conflict between the Lanham Act and the First Amendment.

V. Conclusion

The Supreme Court in *Tam* squarely rejected the government’s attempt to justify its regulation of disparaging trademarks as an exercise of its own speech prerogatives. The Court correctly found that registration does convert private speech (whether commercial or not) into government speech. Although the government still technically can rely on its power under section 2(a) to refuse to register “immoral” or “scandalous” marks, under *Tam* any such reliance is questionable, as those standards are no less infected by viewpoint discrimination and no more justifiable under *Central Hudson* (let alone under strict scrutiny).

The Court in *Tam* held, in effect, that it is for consumers, not for the government, to shun (or embrace) goods identified with disparaging trademarks. As John C. Conner of Archer PC, who argued for The Slants at the Su-

preme Court, put it: “The debate over socially appropriate language will continue . . . in the proper forum, which is the arena of public discourse, not in a setting refereed by the government.”⁴⁷

Endnotes

1. *Matal v. Tam*, 137 S. Ct. 1749 (2017).
2. 15 U.S.C. § 1052(a).
3. See Sarah Jeong, “A Supreme Court Ruling Has Opened the Floodgates to a Stream of Gross Trademarks,” *theverge.com*, July 25, 2017, <https://www.theverge.com/2017/7/25/16020666/us-trademark-law-disparaging-the-piss-tape-is-real> (accessed July 27, 2017) (noting registration of “Dangerous Negro” in 2010, “Stinky Gringo” in 2006, and “Celebretards” in 2009).
4. *In re Tam*, 808 F.3d 1321, 1342 n.7 (Fed. Cir. 2016) (en banc). The court also noted the PTO’s registration of marks such as TAKE YO PANTIES OFF, MURDER 4 HIRE, and CAPITALISM SUCKS DONKEY BALLS. *Id.* at 1346.
5. Andrew Chung, “Supreme Court ruling leads to offensive trademark requests,” *Reuters*, July 23, 2017, <http://www.reuters.com/article/us-usa-court-slur-idUSKBN1A80L6> (accessed July 24, 2017).
6. Jeong, *supra* note 3.
7. 137 S. Ct. at 1754.
8. 808 F.3d at 1339.
9. *Id.* at 1328.
10. 137 S. Ct. at 1758.
11. *Id.*
12. *Id.*
13. *Id.* at 1760.
14. *Id.* at 1758.
15. 808 F.3d at 1346.
16. *Johanns v. Livestock Marketing Ass’n*, 544 U.S. 550 (2005).
17. 135 S. Ct. 2239 (2015).
18. 137 S. Ct. at 1760.
19. *Id.*
20. *Id.* at 1759 (quoting *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1220 n.3 (TTAB 1993)).
21. *Id.* at 1760.
22. *Id.*
23. See, e.g., *Simon & Schuster v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991) (“the government’s ability to impose content-based burdens on speech raises the specter that the government may effectively drive certain ideas or viewpoints from the marketplace”).
24. 137 S. Ct. at 1761.
25. *Id.* at 1763.
26. *Id.* (citing *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 831 (1995)).
27. *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980).
28. *Id.* at 1764 (internal quotation marks omitted).
29. *Id.*
30. *Id.*
31. *Id.* at 1765.
32. *Id.*
33. *Id.*
34. *Id.* at 1767 (citing *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011)).
35. *Id.* at 1766.
36. *Id.* at 1768.
37. *Id.*
38. *Id.* at 1769.
39. 562 U.S. 443, 458 (2011).
40. 491 U.S. 397, 414 (1989).
41. 137 S. Ct. at 1758.
42. *Id.* at 1760.
43. 808 F.3d at 1341.
44. 137 S. Ct. at 1764 (citing, *inter alia*, *Texas v. Johnson*, 491 U.S. 397, 414 (1989) (“If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”)).
45. Anandashankar Mazumdar, “Designer’s ‘Fuct’ Clothing Trademark Case Goes to Appeals Court,” *Patent, Trademark & Copyright Journal (BNA)*, July 28, 2017.
46. *Id.*
47. Bill Donahue, “Postgame: Slants Attys Talk High Court Victory,” *Law360*, June 26, 2017.

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Copyright Corrida: Weighing in on the VARA Rights of “Charging Bull” and “Fearless Girl”

By Irina Tarsis

I. Introduction: Guerrilla Antics

Long before the CowParade¹ came to the Big Apple in 2000, another bovine had already become a prominent fixture in New York City. Inspired by the 1987 stock market crash, it was an homage by an Italian-born American artist, Arturo Di Modica, to his new country. In 1989, Di Modica placed his now iconic bronze sculpture of a bull in front of the New York Stock Exchange buildings at the intersection of Wall and Broad Streets as a gift to New Yorkers, a symbol of the “strength and power of the American people.” Di Modica reportedly spent over \$350,000 of his own money and three years of his life to create the three-and-a-half ton bronze, which he installed surreptitiously without permission from the city.² The first installation was short lived; the police removed the work to a storage facility in Queens. Later, it returned to the Financial District, renamed “Charging Bull” (hereinafter, the “Bull”) and lawfully installed in a prominent location in Bowling Green Park. Today the Bull stands facing north on special pavers demarcating the boundaries of the artwork, a “unique embodiment of the power and vigor of New York’s and the nation’s financial markets”³ and a reference to the “bull market” that Di Modica was conjuring for New York after the financial crisis.

Fast forward to 2017: Di Modica’s internationally renowned “Bull” indisputably has become a work of recognized stature, having appeared in countless guidebooks and textbooks, not to mention tourist photographs, souvenirs, and films about New York. It is displayed “under the auspices of the New York City’s Department of Parks and Recreation.”⁴ While ownership of the Bull is unclear, intellectual property rights in the work remain with the artist. Di Modica registered it with the U.S. Copyright office in 1998.⁵ However, although registration is a prerequisite to most copyright infringement actions, it is not a prerequisite for the type of action Di Modica threatened recently over the Bull.⁶

On March 8, 2017, another bronze statue, this one weighing only about 250 pounds, made an appearance in vicinity of the Bull. Resting on the same cobblestones, it depicted a pre-teen—“Fearless Girl”—facing and leaning toward the Bull, posed with her hands on her hips. Standing in the path of a charging bull is fraught with danger; even experienced matadors risk being gored to death. The face-off between two bronzes is not a matter of life and death, but it is a standoff between public and private interest, a juxtaposition of past and present, a mixing of messages and a tug of war between commerce and expression.

“Fearless Girl” (hereinafter, “Girl”) was created by Delaware-based artist Kristen Visbal, reportedly on commission from the investment firm State Street Global Advisors (SSGA),⁷ with a role attributed to the advertising agency McCann New York.⁸ Visbal first learned of the project on November 30, 2016. Apparently McCann needed a female sculptor who worked in bronze to create a sculpture of a child. The work needed to be done quickly for temporary installation in time for International Women’s Day. After producing almost a dozen preliminary drawings, Visbal began sculpting Girl around December 29, 2016. SSGA has said that the work, which it owns,⁹ was meant to celebrate “the power of women in leadership and the potential of the next generation of women leaders.”¹⁰ It was intended to interact with Bull, and the juxtaposition of the two works has arguably dramatically changed Bull’s message. Girl stands close enough to lock gazes with Bull and issues a challenge: “I am here, what are you going to do about it?!”

On August 12, 2017, Di Modica, now in his seventies, held an emotional press conference during which he explained that his sculpture stands for “freedom in the world, peace, strength, power, and love” and stated his belief that Girl changed this meaning by making Bull symbolize something negative.¹¹ The standoff raises the question of what legal protection is available to the two artists whose bronzes have locked gazes near Bowling Green.

II. Authorization to Display Works of Art in Public Places

In order to install anything semi-permanently or permanently, such as a work of art, in New York City, the owner of the work or its agent must apply for and obtain a license from the New York City Department of Parks and Recreations Services. The process for determining how authorization is granted to works of art in public spaces, where the works of art interact with one another, is unclear. While it is also unclear whose idea it was to commission and install Girl so as to incorporate Bull into an ensemble composition, it is undisputed that Girl was installed with permission from the city.

IRINA TARSIS is an art historian and an attorney who focuses on copyright and property dispute cases. She is the founding director of the Center for Art Law in Brooklyn, New York. The author wishes to thank Courtney Doagoo and Wylie Rechler for their assistance with this article.

The initial duration of the license issued for *Girl* by the New York City Department of Parks and Recreation was only four days.¹² However, the license has been extended until International Women's Day in 2018. Typically, the Department, which encourages "the creation and installation of temporary public art in parks throughout the five boroughs," reviews proposed projects to determine whether any given piece of temporary art "may be displayed in prominent flagship parks, neighborhood parks and playgrounds, and traffic islands."¹³ Temporary installations typically last from two weeks to one year. The controversy concerning Di Modica's copyright rights in *Bull*, discussed below, could have an effect on state or municipal authorization for display of artwork in public spaces.

III. Visual Artists Rights Act

Under the Copyright Act, in addition to their economic rights, artists have some limited protection of their "moral rights" under the Visual Artists Rights Act of 1990 (VARA), codified in section 106A of the Copyright Act. VARA narrowly incorporates the moral rights provision of Article 6bis of the Berne Convention for the Protection of Literary and Artistic Works, which deals with moral rights such as the right to object to certain modifications and other derogatory actions toward artistic works.¹⁴ VARA protects "works of visual art," which are defined in section 101 of the Copyright Act to include "a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author."¹⁵ The definition excludes site-specific works on the theory that location may not be an integral part of the work, and the rights of property owners are implicated.¹⁶

The passage of VARA came on the heels of the controversy surrounding the removal of Richard Serra's site-specific sculpture "Tilted Arc," which was commissioned by the United States General Services Administration Arts in Architecture program in 1979. It was a solid 120-foot long curved steel wall that bifurcated Foley Federal Plaza in lower Manhattan. The sculpture ultimately was removed on the ground that it disrupted the public space. The removal prompted Serra to sue, claiming that the removal was tantamount to destruction of his work. Serra lost that battle,¹⁷ but his plight may have paved the way for the passage of VARA, which was signed into law the year after the Second Circuit rejected his claim.

VARA reflects a reluctant incorporation of moral rights into the U.S. property right-focused legal system. It purports to protect sculptures and other visual artworks from being intentionally destroyed, distorted, or modified in a way that would prejudice the author's honor or re-

putation. Specifically, section 106A(a)(3) provides that the author of work of visual art has the right

(A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and (B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.¹⁸

Notably, the statute does not expressly require that the distortion or modification involve physical alteration of the work. Indeed, a physical distortion is much harder to bring about than a contextual or metaphysical one. Among the questions raised by the placement of *Girl* is whether it infringes Di Modica's rights under VARA. Or is Visbal's work merely commenting permissibly on *Bull* in a manner akin to fair use?

Di Modica's rights fall within the scope of VARA because he held the rights to *Bull* when VARA went into effect in 1990. He believes the message he incorporated into *Bull* is negatively affected. But does the message and placement of Visbal's *Girl* in a way that distorts the message of *Bull* give rise to a 106A claim? The answer seems to be no because there is no physical damage¹⁹ being done to *Bull*, and merely placing *Girl* in a way that affects the perception of *Bull* does not violate VARA. Moreover, section 106A may excuse SSGA's incorporation of the *Bull* into its "SHE" marketing campaign because under section 106A(c)(3), no portrayal of a work of art can be characterized as a destruction, distortion, mutilation or other modification. Thus, Di Modica cannot prevent *Bull* from being portrayed in a negative light by SSGA or anybody else.

According to SSGA, *Girl* was meant to "send a message" about workplace gender diversity and to encourage companies to recruit women to their boards. In fact, it was a publicity stunt by an investment firm that has managed the SPDR SSGA Gender Diversity Index ETF on the NASDAQ with the ticker symbol "SHE." The plaque installed at *Girl*'s feet reads "Know the power of women in leadership. SHE makes a difference." According to a video on SSGA's website, *Girl* was placed "in a spot that made her impossible to ignore." The video juxtaposes images of the artist working in her studio, sketching, molding and tooling clay, and casting and chiseling bronze statue with quotes such as "Studies show companies with women in leadership perform better than those without" and "This International Women's Day, we created a symbol of female leadership for today and tomorrow . . . and put her somewhere no one could ignore." SSGA thus has admitted that the location of *Girl* was carefully chosen, but it (coily or shrewdly) makes no reference on its website to Di Modica or *Bull*. (Of course, if it did, it potentially would be guilty of copyright infringement.) *Girl* is depicted looking into

the distance, but the informed viewer knows where her gaze is fixed. The website states that the “bronze statue of a confident young ‘Fearless Girl’ was installed in the heart of New York City’s financial district,”²⁰ but this suggests a location at the intersection of Wall Street and Broad Street or near the Federal Reserve Bank of New York on Liberty Street, or in Times Square near the NASDAQ Market Site that lists SSGA Gender Diversity Index ETF SHE shares—not the actual site near Di Modica’s Bull.

In April 2017 Di Modica reportedly threatened to bring a copyright claim based on the placement of Girl. He was not alone in objecting to how his message had been usurped—and the popularity of Bull harnessed—for marketing purposes. Academics, lawyers, and journalists commented on the dispute and on whether Di Modica had a viable legal claim.²¹ For example, a Boston-based art lawyer, Nicholas O’Donnell, wrote that “the elements of VARA rights are not implicated by the installation of ‘The Fearless Girl’ because nothing has actually happened to ‘Charging Bull,’” and “none of the arguments [Di Modica] advances would bestow on him the kind of right to be asked first that he proposes.”²²

Although Di Modica has not filed a lawsuit as of August 2017, this author believes that while Bull can continue to succeed as a work of art without Girl and could be moved elsewhere in the Financial District without harming Di Modica’s reputation, the message of Girl would be greatly diminished if she and Bull were to be separated (whether by court order or otherwise). The license granted to Girl is due to expire in the winter of 2018. However, like the temporary permit originally bestowed on Bull, which became permanent, it is possible that Girl also will not be temporary. If she is removed, however, Bull will do just fine on its own (as it did before), whereas Girl will have relatively little to say for herself in isolation.

IV. Conclusion

While Di Modica may be contemplating legal action for perceived violation of his moral rights, the images and the commentary that followed the installation of Girl have already generated a healthy amount of discussion about art and law. Similar to the controversy involving the Renoir painting and a kimono dress-up debacle at the Museum of Fine Arts in Boston²³ and protests directed at the painting by (white artist) Dana Schutz of Emmett Till’s open casket that was exhibited in the 2017 Whitney Biennial,²⁴ the symbolism conveyed by art transcends the law, which has a limited role to play in regulating artistic meaning.

At Bowling Green, for example, the positive message imparted by Bull has been co-opted by a financial investment firm and diminished as a positive symbol of American corporate culture. Slipping in the little girl that challenges the iconic work of art can be seen as either a symbol of feminism and changing times or an opportunistic move by a corporation willing to take a calculated risk of copyright infringement for PR purposes. Either way, Di

Modica will not know for sure whether copyright law provides relief unless he files (and pursues) a complaint.

SSGA’s decision to capitalize on Di Modica’s iconic sculpture to promote its financial product, SHE, the SSGA Gender Diversity Index, is arguably more clever—and legally less risky—than appropriation à la Jeff Koons or Richard Prince.²⁵ Instead of copying Bull and using it in (or presenting it as) a new work, SSGA decided to interact with it, casting Girl as a matador. It can be argued that Girl is not taking anything from, or incorporating, Di Modica’s work, but copying is not the only form of taking. If nothing else Girl challenges the negative connotations one may see in Bull, a stand-in for male-dominated financial sector that is unfriendly to female participants.

In May 2017, Alex Gardega, a New York City artist, installed a papier-mâché sculpture on the same Bowling Green meridian.²⁶ Named “Sketchy Dog/Pissing Pug,” the sculpture depicted a small dog, lifting its leg to urinate. The sculpture was installed briefly and without a permit from the city. Despite its brief appearance on the Bowling Green arena, the message was clear: copyright is a spectator sport, and everyone is a critic.


Endnotes

1. CowParade is one of the largest and most successful public art events in the world. CowParade events have been staged in 79 cities worldwide since 1999 including Chicago (1999), New York City (2000). CowPARADE, <http://www.cowparade.com/> (last visited Aug. 7, 2017).
2. Sarah Cascone, Wall Street’s Bronze Bull Celebrates 25th Anniversary, *artnet News* (Dec. 16, 2014), <https://news.artnet.com/art-world/wall-streets-bronze-bull-celebrates-25th-anniversary-198768>; Sarah Cascone, Anti-Capitalist Golden Cow Piñata Sculpture Rains Cash in Brooklyn Cash cow offers capitalist critique and \$1,000, *artnet News* (May 27, 2014), <https://news.artnet.com/exhibitions/anti-capitalist-golden-cow-pinata-sculpture-rains-cash-in-brooklyn-27270>.
3. *Di Modica v. North Fork Bancorporation, Inc, et al.*, 1:06-cv-07210-RJS at 2 (S.D.N.Y. filed Sept. 20, 2006).
4. On his website, Di Modica wrote that “Thanks to then Parks Commissioner Henry Stern, Mayor Ed Koch and Arturo Piccolo of the Bowling Green Association, a permanent home was found for the Charging Bull close by at Bowling Green.” Jill Reilly, *A load of old bull: 25 years on, the incredible Christmas story of the guerrilla gift Wall Street didn’t want—but which became one of NYC’s best-loved mascots anyway*, *DailyMail*, (Dec. 17, 2014), www.dailymail.co.uk/news/article-2878088/The-Christmas-gift-Wall-Street-didn-t-want-famous-bronze-bull-secretly-dropped-guerrilla-artist-middle-night-25-years-ago.html.
5. Certificate of Registration No. VAU-422-325, *see* Complaint, Case No. 1:06-cv-07210-RJS, at 3. Di Modica also holds registered copyright in UAE Bull, Shanghai Bull and the Bund Bulls. According to the Copyright Office Online Catalog, Di Modica has three registrations for visual materials entitled “The Bund Bull” (Registration No. VA0001710960 / 2010-04-07), Shanghai Bull (Registration No. VA0001667717 / 2009-05-04) and UAE Bull (Registration No. VA0001820826 / 2012-05-01), *see* <http://cocatalog.loc.gov>.
6. Section 411(a) of the Copyright Act, 17 U.S.C. § 411(a), expressly exempts actions brought under section 106A from the registration requirement.
7. Founded in 1978, State Street Global Advisors is an investment management division of State Street Corporation, a major world asset manager with more than \$2 trillion in assets.

8. While there seems to be some confusion about the background of Kristen Visbal she has told the authors that she was the daughter of a Foreign Service diplomat born in Montevideo, Uruguay. Email to author from Kristen Visbal (Aug. 8, 2017); *Kristen Visbal*, Wikipedia, https://en.wikipedia.org/wiki/Kristen_Visbal (last visited Aug. 1, 2017). Margie Fishman, "'Fearless Girl' Artist Shirks Spotlight," USA Today (Apr. 21, 2017), <https://www.usatoday.com/story/money/nation-now/2017/04/21/fearless-girl-artist-shirks-spotlight/100746236/>.
9. According to Visbal, SSGA owns the first and at present only casting of the sculpture. Visbal has the right to make more castings and intends to create a limited edition of the full-sized sculpture. Email to author from Kristen Visbal (Aug. 8, 2017).
10. State Street Global Advisors, *Fearless Girl Sends Powerful Message*, <https://www.ssga.com/global/en/our-insights/viewpoints/enhancing-gender-diversity-on-boards-emea.html> (last visited Aug. 7, 2017).
11. Mr. Di Modica declined to be interviewed for this article. However, excerpts from his April 2017 press conference are available at <https://www.thestar.com/news/world/2017/04/12/sculptor-of-wall-streets-charging-bull-wants-fearless-girl-statue-removed.html>.
12. Email to author from Kristen Visbal (Aug. 8, 2017). According to the Department's website temporary public outdoor art license can be granted to applicants who submit specific documents and descriptions to the Public Art Coordinator so that a panel made up of the New York City Parks Commissioner or his or her representative and others may review proposals and concerns related to durability, safety, sustainability and other issues. Apparently applicants are encouraged to submit materials at least six months in advance to the installation date; therefore, if the SSGA followed the recommendations, the application was submitted to the Department no later than September 2016. See guidelines here <https://www.nycgovparks.org/art-and-antiquities/temporary-guidelines>.
13. NYC Parks' Art in the Parks Program, <https://www.nycgovparks.org/art-and-antiquities/art-in-the-parks> (last visited Aug. 7, 2017).
14. World Intellectual Property Organization, *Berne Convention for the Protection of Literary and Artistic Works (as amended on September 28, 1979)*, available at http://www.wipo.int/treaties/en/text.jsp?file_id=283698#P123_20726.
15. 17 U.S.C. § 101.
16. See for example, *Phillips v. Pembroke Real Estate, Inc.*, 459 F.3d 128 (1st Cir. 2006).
17. See *Serra v. US General Services Admin.*, 847 F.2d 1045 (2d Cir. 1988).
18. 17 U.S.C. § 106A.
19. Even imminent threat of physical destruction of a work of art of "recognized stature" is not necessarily enough to achieve VARA protection. See, e.g., *Cohen v. G & M REALTY LP*, 988 F. Supp. 2d 212 (E.D.N.Y. 2013) (involving a building in New York City called 5Pointz on which aerosol mural artists displayed their works between the 1990s and 2013).
20. State Street Global Advisors, *Strategy: Fearless Girl Sends Powerful Message*, (July 24, 2017) <https://www.ssga.com/global/en/our-insights/viewpoints/enhancing-gender-diversity-on-boards-emea.html>.
21. See, e.g., Nicholas O'Donnell, "Charging Bull" Sculptor Articulates VARA Complaint, but "Fearless Girl" Still Standing Firm, *Art Law Report* (Apr. 13, 2017), <http://blog.sandw.com/artlawreport/charging-bull-sculptor-articulates-vara-complaint-but-fearless-girl-still-standing-firm>; Nicholas O'Donnell, "Fearless Girl" Sculpture Near Wall Street Prompts Copyright Allegation That Is More Bull than Bear, *Art Law Report* (Mar. 29, 2017), <http://blog.sandw.com/artlawreport/fearless-girl-sculpture-near-wall-street-prompts-copyright-allegation-that-is-more-bull-than-bear>.
22. O'Donnell, *supra* note 21.
23. See Malcolm Gay, *Kimono controversy erupts anew at MFA panel*, *Boston Globe* (Feb. 8, 2016) (<https://www.bostonglobe.com/arts/2016/02/08/kimono-controversy-erupts-anew-mfa-panel/olduJEpYVqUyTM3wunRUM/story.html>).
24. Calvin Tomkins, *Why Dana Schutz Painted Emmett Till*, *The New Yorker* (Apr. 10, 2017), <http://www.newyorker.com/magazine/2017/04/10/why-dana-schutz-painted-emmett-till>.
25. See, e.g., RFI, *Artist Jeff Koons and Centre Pompidou convicted in plagiarism case* (Mar. 2017), available at <http://en.rfi.fr/france/20170309-artist-jeff-koons-and-centre-pompidou-convicted-plagiarism-case>; *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006); *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992).
26. Valerie Richardson, *Artist makes statement by placing peeing-dog statue next to Wall Street's "Fearless Girl,"* *The Washington Times* (May 30, 2017) <http://www.washingtontimes.com/news/2017/may/30/artist-makes-statement-placing-peeing-dog-statue-n/>.

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Advertising Law

Brooke Erdos Singer
Davis & Gilbert LLP
1740 Broadway
New York, NY 10019
bsinger@dglaw.com

Copyright Law

Alexandra Goldstein
380 Riverside Drive
Apt. 4K
New York, NY 10025
alex@alexandragoldstein.com

Diversity Initiative

Joyce L. Creidy
4617 6th Avenue
Brooklyn, NY 11220
joyce.creidy@thomsonreuters.com

Deborah Robinson
Viacom Inc.
1515 Broadway
New York, NY 10036-8901
deborah.robinson@viacom.com

Ethics

Philip Furgang
Furgang & Adwar, LLP
1325 Avenue of the Americas, 28th Fl.
New York, NY 10019
philip@furgang.com

Rory J. Radding
Locke Lord LLP
3 World Financial Center, Ste 2001
New York, NY 10281-2101
rory.radding@lockelord.com

In-House Initiative

Joseph John Conklin
Coty Inc.
350 5th Avenue
New York, NY 10118
Joseph_Conklin@cotyinc.com

International Intellectual Property Law

Stacy Lynn Wu
CBS Corporation
51 West 52nd Street
New York, NY 10019
stacywu@gmail.com

Internet and Technology Law

Richard L. Ravin
Hartman & Winnicki, PC
115 West Century Rd
Paramus, NJ 07652
rick@ravin.com

Legislative/Amicus

Charles Eric Miller
Eaton & Van Winkle LLP
3 Park Avenue, 16th Floor
New York, NY 10016
cmiller@evw.com

Litigation

Marc A. Lieberstein
Kilpatrick Townsend & Stockton LLP
1114 Avenue of the Americas, 21st Fl.
New York, NY 10036-7709
mlieberstein@kilpatricktownsend.com

Paul W. Garrity
Sheppard, Mullin, Richter
& Hampton LLP
30 Rockefeller Plaza, 39th Fl.
New York, NY 10112-0015
pgarrity@sheppardmullin.com

Membership

William Robert Samuels
W.R. Samuels Law PLLC
280 Madison Avenue, Ste. 600
New York, NY 10016
bill@wrsamuelslaw.com

Robin E. Silverman
Golenbock Eiseman Assor Bell
& Peskoe LLP
437 Madison Avenue
New York, NY 10022
rsilverman@golenbock.com

Patent Law

Douglas A. Miro
Ostrolenk Faber LLP
1180 Avenue of the Americas, 7th Fl.
New York, NY 10036
dmiro@ostrolenk.com

Michael A. Oropallo
Barclay Damon LLP
One Park Place
300 South State Street
Syracuse, NY 13202-2078
moropallo@barclaydamon.com

Trademark Law

William Robert Samuels
W.R. Samuels Law PLLC
280 Madison Avenue, Ste. 600
New York, NY 10016
bill@wrsamuelslaw.com

Andrew Ashford Tucker
Fross Zelnick Lehrman & Zissu
866 UN Plaza
New York, NY 10017
atucker@fzllz.com

Trade Secrets

Victoria A. Cundiff
Paul Hastings Janofsky & Walker, LLP
75 East 55th Street
New York, NY 10022
Victoriacundiff@paulhastings.com

Andre G. Castaybert
Castaybert PLLC
830 Third Avenue, 5th Fl.
New York, NY 10022
acastaybert@ac-counsel.com

Transactional Law

Robin E. Silverman
Golenbock Eiseman Assor Bell
& Peskoe LLP
437 Madison Avenue
New York, NY 10022
rsilverman@golenbock.com

Danielle Ella Maggiasco
Frankfurt Kurnit Klein & Selz PC
488 Madison Avenue, 10th Floor
New York, NY 10022
dmaggiasco@fkks.com

Young Lawyers

Nyasha S. Foy
IILP
185 West Broadway
New York, NY 10013-2921
nyasha.foyesq@gmail.com

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BRIGHT IDEAS

Editor-in-Chief

Jonathan Bloom
Weil, Gotshal & Manges LLP
767 Fifth Avenue
New York, NY 10153-0001
jonathan.bloom@weil.com

Executive Editor

Rory J. Radding
Locke Lord LLP
3 World Financial Center, Ste 2001
New York, NY 10281-2101
rory.radding@lockelord.com

Section Officers

Chair

Erica D. Klein
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036-2714
eklein@kramerlevin.com

Vice-Chair

Robin E. Silverman
Golenbock Eiseman Assor Bell & Peskoe LLP
711 Third Avenue, 17th Floor
New York, NY 10017
rsilverman@golenbock.com

Treasurer

Michael A. Oropallo
Barclay Damon LLP
Darclay Damon Tower
125 East Jefferson Street
Syracuse, NY 13202
moropallo@barclaydamon.com

Secretary

Brook Erdos Singer
Davis & Gilbert LLP
1740 Broadway
New York, NY 10019
bsinger@dglaw.com

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INTELLECTUAL PROPERTY LAW SECTION
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