Computers and the Law

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CLASS 10

Domain Names;
Semiconductor Protection;
Right of Publicity
DOMAIN NAMES

A domain name is a string of characters acting as an Internet identifier that simplifies the Internet location of an entity’s web site, such as MyWebsite.com.

http://www.yahoo.com is a uniform resource locator (URL) that includes a domain name, a server accessed at the domain name, and the protocol being used to access the domain name.
ESSENTIAL DEFINITIONS

- Registrar – a company that sells available domain names to end consumers pursuant to its relationship with one or more domain name registries
- Registry – an entity responsible for allocating unique domain names within a particular country code or top level domain
- WHOIS record – a record that provides detailed information for a particular domain name, which typically includes a registrant and an administrative contact

DOMAIN NAME AVAILABILITY

- The availability of a domain name may be determined by trying to obtain a WHOIS record for a desired domain name or by entering the domain name into the registration request page at a domain name registrar or an applicable registry.
- Certain registrars have automated tools to determine availability of domain names from gTLDs and ccTLDs

DOMAIN NAME OWNERSHIP

- Domain name ownership may be determined by accessing a WHOIS record for the domain name.
- Certain registrars have automated tools to create a report of domain names incorporating one or more terms and associated WHOIS records.
DOMAIN NAME OWNERSHIP

• The registrant is really the domain name owner, even if he/she/it is not the person using the domain name.

• The administrative contact has the power to modify the domain name, including changing registrant information and accepting change of registrars.

OBTAINING A WHOIS RECORD

• The WHOIS records for some domain name extensions (e.g., .com and .net) are decentralized.

• To obtain the WHOIS records for decentralized extensions, you may need to visit the registry to first identify the registrar associated with the domain name and then visit the registrar to obtain the WHOIS record.

• To obtain the WHOIS records for centralized extensions (.us, .info, and .biz), visit the registry.

• Several sites such as the WHOIS available at Network Solutions and ALLWhois.com contain a number of WHOIS records from a variety of registries and registrars.

REGISTERING A DOMAIN NAME

• First come, first served

• Select a registrar

• Access an established account or create a new account

• Identify the registrant, contacts, and hosting information

• Select any desired additional services

• Enter credit card information

• Print a receipt

• Print out a copy of the WHOIS record
DOMAIN NAME PORTFOLIO MANAGEMENT

• Determine what domain names your company owns
• Assess the need for registering additional domain names
• Consolidate the domain names with a single registrar
• Determine whether any conflicting domain names are owned by third parties

DETERMINING DOMAIN NAMES OWNED BY YOUR CLIENT

• Obtaining ownership information for a company that owns more than a few domain names may be impractical.
• Conduct a domain name term search to identify domain names that may be associated with your client (and possibly third parties)
• Conduct a reverse WHOIS search to identify domain names registered in the name of your company

DOMAIN NAME TERM SEARCH

• Domain name term searches provide a listing of domain names in at least the major domain name extensions that contain the term searched. The search can be a useful tool for locating potentially conflicting domain names that may not be otherwise uncovered.
• A key term or terms should be used to run one or more domain name term searches. In addition, variations and shortened versions of the terms should be used to locate domain names that have been registered with misspellings. A service that may be used for domain name term searches is provided by MarkMonitor.com (charge depending on plan, more advanced).
REVERSE WHOIS SEARCH

- A reverse WHOIS search on a term of interest (e.g., a trademark) may identify entities that have adopted the term as part of their entity name. Typically, a reverse WHOIS search is used to identify the domain names associated with a particular registrant.
- However, there are some limitations on the ability to conduct reverse WHOIS searches. First, there are no free tools to perform reverse WHOIS searches. In addition, the searches may be performed on some out-of-date and incomplete records.

REGISTERING ADDITIONAL DOMAIN NAMES

- Existing holes
- New domain name extensions
- Defensive domain name registrations

EXISTING HOLES

- You may wish to verify that your company has registered its company name and trademarks (with and without relevant generic terms and variations thereof) in all desired extensions.
- MarkMonitor.com and other domain name service providers offer services that can prepare such reports.
NEW DOMAIN NAME EXTENSIONS

• When a new domain name extension is launched, you may wish to advise your company of the new extension and determine a strategy for domain name registrations.
• The strategy should contemplate the domain names currently being used by the company, a number of defensive domain names, and any desired generic domain names.

DEFENSIVE DOMAIN NAME REGISTRATIONS

• Domain names that are registered and will not be used are considered defensive domain name registrations.
• While an aggressive defensive domain name strategy may limit the amount of future domain name disputes, there is no effective way to eliminate such disputes because it is also possible to make character derivations, add additional generic terminology, or register domain names in additional extensions.

DEFENSIVE DOMAIN NAME REGISTRATIONS

• There are several reasons to justify company spending money to defensively register domain names.
• Domain name registrations are far cheaper than domain name dispute. While a typical domain name dispute can cost between $500-1,500 to resolve and a dispute with a UDRP proceeding can cost from dispute start to finish in excess of $10,000, domain name registrations typically cost $10-$35 a year.
• Beyond the economics, domain name disputes and especially UDRP proceedings run a risk of loss.
• In addition, nonconflicting domain names may be unrecoverable or recoverable only at a great expense.
DEVELOPING A STRATEGY

While contemplating a defensive domain name strategy for a particular company, consider the following:

• Current and previous domain name conflicts; what domain names were of interest to cybersquatters
• Desirability to a third party of a domain name consisting of a company’s trademark or domain name in combination with a geographic region associated with the company or a generic or descriptive word for the goods and/or services provided by the company
• Geographic areas in which the company operates
• Current cybersquatting problems based on extensions (e.g., most cybersquatting occurs in the .com domain name)

DOMAIN NAME CONSOLIDATION

The benefits of consolidation include:

• Ease of access to domain name portfolio
• Ease of modifying domain name contact information
• Reduced cost in managing domain names
• Advantageous and fixed pricing for domain name registrations and renewals
• Multiple user access to a single registrar account
• Customer service support
• Account customization
• Specialty services

Companies may not initially want to spend the time or incur the expense to consolidate domain names. However, once a company experiences a problem associated with renewing, transferring, or dispute ownership of a domain name it may then be able to justify consolidation. Other companies may wish to consolidate domain names as they come due for renewal. While this process may be more cost effective, it may not catch domain names due for renewal that have a problem with the administrative contact information (e.g., change in e-mail address, former employee, etc.)
CONSOLIDATION WITH A SERVICE PROVIDER

• Domain names may be consolidated with any registrar.
• However, when enhanced tools are desired such as customer service support, fixed pricing, multiple user access to a single account, specialty services, domain name service providers must be evaluated to determine the types, cost, and quality of services offered.
• Some domain name service providers may better meet the needs of clients with large portfolios based on an amount of services provided, discounts offered, and the like, while other domain name service providers may be better for small domain name portfolios because of a lower cost and ease of use.

DOMAIN NAME TRANSFERS

• Once a domain name service provider has been selected at which the domain names will be consolidated, existing domain names associated with your company should be transferred from other domain name registrars to the consolidated account.
• In addition, your company may ask you to transfer domain names recovered in domain name disputes.

DOMAIN NAME TRANSFERS

• The domain names must be unlocked in order to facilitate the transfer.
• If an electronic transfer of a domain name is not possible (or not desired), transfer requests may be submitted in writing. Contact a person in customer service from the registrar at which the domain name will ultimately reside to obtain the necessary documentation.
• Some domain name transfers, such as registrar transfers, incur a sixty day wait period where no further transfers are possible until the wait period has expired.
CONFLICTING DOMAIN NAMES

• Conflicting domain names are domain names that are not owned by your company and that potentially infringe on the rights of your client.
• Clients may wish to engage your firm to monitor for conflicting domain names on a regular or periodic basis.
• Your firm may be asked to advise your client on various conflict.

LOCATING CONFLICTING DOMAIN NAMES

Conflicting domain names may be identified in a number of different ways including:
• By the company
• By a customer or associate of the company
• By an infringer
• From a watch service
• From a WHOIS record search
• From a domain name term search
• From a reverse WHOIS search
• From a web search
**DOMAIN NAME INVESTIGATIONS**
- Determine ownership of the domain name
- Retain copies of the WHOIS record and content
- Determine whether the entity is associated with additional domain names
- View prior versions of the domain name content
- Check metatags and keywords
- Perform a trademark search
- Check for prior UDRP and court decisions

**DOMAIN NAME DISPUTE RESOLUTION**
- Domain name expiration/snapping service
- Settlement
- UDRP proceeding
- ACPA proceeding

**SNAPPING SERVICES**
- Upon expiration, a domain name does not immediately become available for registration. Rather, an expiring domain name typically goes through a delete cycle by which an existing registrant can still renew the domain name while paying the registrar an escalating fee of the renewal. At the end of the delete cycle, the domain name is released (i.e., purged) and it becomes available for registration to anyone.
- Snapping is the process by which a service attempts to register a domain name immediately upon completion of the deleted cycle when the domain name becomes available for registration.
Pre-ACPA

• Trademark Infringement
  - Trademark owner must prove (1) ownership of a valid trademark; and (2) a likelihood of confusion between the registered mark and the alleged infringing use by the defendant.

• Trademark Dilution
  - To prevail on its federal dilution claim, Trademark owner must prove:
    1. the Mark was famous before the Defendant began use of the domain names at issue; and
    2. Defendant’s use causes dilution of the distinctiveness of the mark.

  See 15 U.S.C. § 1125(c). Dilution is “the lessening of the capacity of a famous mark to identify and distinguish goods or services.” Id. § 1127.

Minnesota Mining and Manufacturing Co. v Taylor, 21 F.3d 1003 (D.C. MN 1998)

The Anticybersquatting Consumer Protection Act (ACPA)

• The ACPA was enacted in 1999 to address “a new form of piracy on the Internet caused by acts of ‘cybersquatting,’ which refers to the deliberate, bad-faith, and abusive registration of Internet domain names in violation of the rights of trademark owners.” S. Rep. No. 106-140, at 4 (1999).

The Anticybersquatting Consumer Protection Act

• The ACPA provides a civil action in the U.S. court system against anyone who, with bad faith intent to profit, registers, traffics in or uses a domain name that is:
  - identical or confusingly similar to a mark that was distinctive when the domain name was registered;
  - identical, confusingly similar or dilutive of a mark that was famous when the domain name was registered; or
  - infringes marks and names protected by statute.

• Results from Successful Action: Entities proceeding under the ACPA can gain ownership or force deletion of the disputed domain name, costs (attorney’s fees, filing fees, etc.), damages and injunction.
ACPA - Statutory Damages

• In cases involving cyberpiracy, violations of 15 U.S.C. §1125(d)(1), section 1117(d) allows a plaintiff to elect statutory damages of an amount between $1000 and $100,000, to be determined by the court, per domain name pirated. Plaintiff's undisputed allegations establish cyberpiracy under section 1125(d)(1) and allow it the option under section 1117(d). The Court finds $ 100,000 to be a just award and grants statutory damages in that amount to Plaintiff.


ACPA – Attorney’s Fees

• Section 1117(a) gives the Court discretion to award reasonable attorney's fees in "exceptional cases." The term "exceptional cases" is generally accepted to mean cases in which trademark infringement is "deliberate and willful." See Playboy Enterprises, Inc. v. Baccarat Clothing Co., Inc., 692 F.2d 1272, 1276 (9th Cir. 1982) (citing Otkar State Oil Refining Corp. v. Kooltone, Inc., 649 F.2d 94 (2d Cir. 1981)). The Court finds Defendants' infringement deliberate and willful thereby making Plaintiff eligible to receive attorney's fees.

Ford Motor Co. v. Catalanotte

- How did Ford learn of the domain name registration?
- Did Mr. Catalanotte have any previous success of selling domain names to trademark owners?

Ford Motor Co. v. Catalanotte

- "The ACPA applies to a person who registers, traffics in, or uses a domain name that is identical or confusingly similar to a distinctive mark or that is identical or confusingly similar to or dilutive of a famous mark. ... Liability under the ACPA requires a 'bad faith intent to profit,' and the ACPA provides a list of factors that courts may consider in determining whether a person acts in bad faith. ..."

Ford Motor Co. v. Catalanotte

- Remedies under ACPA
  - Injunctive relief,
  - Actual damages,
  - Statutory damages (1K-100K)
Ford Motor Co. v. Catalanotte

• What if the registration occurred before the ACPA?
  – “The ACPA applies to ‘all domain names registered before, on, or after the date of the enactment’ of the ACPA, but actual and statutory damages are not ‘available with respect to the registration, trafficking, or use of a domain name that [occurred] before the date of the enactment.’”

Ford Motor Co. v. Catalanotte

• “Registration, trafficking, and use of a domain name are separate acts upon which liability may be based. Although damages may not be awarded for pre-enactment registration, trafficking, or use, the fact that a domain name was registered before the Act's passage does not absolve the registrant from liability for post-enactment trafficking or use.”

Ford Motor Co. v. Catalanotte

• “We conclude that, when Catalanotte registered the domain name FORDWORLD.COM and later offered it for sale to Ford, he trafficked in the domain name for the purposes of the ACPA. Registering a famous trademark as a domain name and then offering it for sale to the trademark owner is exactly the wrong Congress intended to remedy when it passed the ACPA.”
Ford Motor Co. v. Catalanotte

• End Result
  – $5,000 in statutory damages pursuant to the Anticybersquatting Consumer Protection Act affirmed

Shields v. Zuccarini

Factual Background
• Joseph Shields (P)
  – Creator of Joe Cartoon
• John Zuccarini (D)
  – Cybersquatter
• Basis of Proceeding
  – ACPA

Shields v. Zuccarini

• What issues was the court addressing on appeal?
• What happened in the dispute prior to the lawsuit?
• What happened at district court?
Shields v. Zuccarini

• What must Shields show under the ACPA?
  – TM is a distinctive or famous mark
  – DNs are identical or confusingly similar to the TM
  – DNs registered with a bad faith intent to profit

Shields v. Zuccarini

• Why is typosquatting covered under the Act?
• D "[registered] a domain name in anticipation that consumers would make a mistake, thereby increasing the number of hits his site would receive, and, consequently, the number of advertising dollars he would gain."

Shields v. Zuccarini

• Are the bad faith factors exclusive?
• What about the first amendment?
• Why won’t Z’s argument of fair use work?
Shields v. Zuccarini

• What was the court’s conclusion?
• Can you get statutory damages for domain names registered before the ACPA was enacted?

The Uniform Domain Name Dispute Resolution Policy

• Who is ICANN?
• How does the UDRP work?
• What is the scope of the UDRP?

• The UDRP provides a mandatory administrative proceeding against a domain name registrant where the domain name is:
  – identical or confusingly similar to a mark in which the complainant has rights;
  – domain name registrant has no rights or legitimate interests in respect of domain name; and
  – the domain name has been registered and is being used in bad faith.
• Results from Successful Action: Entities proceeding under the UDRP can only gain ownership or force deletion of the domain name.
Express Services, Inc. v. RealTime Internet

• Complainant Express Services – provider of employment and personnel services
• Respondent RealTime Internet – a person that registers domain names based on web traffic

Express Services, Inc. v. RealTime Internet

• Procedural History
  – Complaint
  – Response (untimely)
  – Additional Submissions

Express Services, Inc. v. RealTime Internet

• “While [Complainant’s registered mark] has design elements, when the mark is translated into typescript for use in a domain name, the identity or similarity cannot be disputed. Complainant contends that the <expresspersonel.com> domain name is confusingly similar to its federally registered EXPRESS PERSONNEL marks. The deletion of a letter and the misspelling of a mark still makes the disputed domain name confusingly similar to Complainant’s registered mark.”
Express Services, Inc. v. RealTime Internet

- Typosquatting = Bad Faith
- “Complainant further contends that Respondent registered and used the disputed domain names pursuant to Policy ¶ 4(b)(iv), where Respondent intentionally attempted to attract, for commercial gain, Internet users to Respondent’s websites by creating a likelihood of confusion with Complainant’s mark. This practice of “typosquatting” has been recognized as ... Given the number of registrations by the Respondent, as set out on the thirty-six (36) pages of Complainant’s Exhibit AA, a list which includes the names of colleges and universities, states, towns, athletic teams, businesses, airlines, misspellings of the same, and common words or names, the evidence of ‘bad faith’ is sufficient.”

Domain Name Tasting

- What is domain name tasting?
- What policy has ICANN added to combat domain name tasting?

New Extensions

- New Extensions are coming
- Must meet certain requirements
- Companies paid 185K to evaluate per extension
- List of applied for domain names to date is available online
Trademark Clearinghouse

- Register trademarks with clearing house
- Allow for sunrise registration into new extensions
- Warnings about nearly exact domain name registrations in all of new extensions for limited period

Donuts Blocking

- Availability for extensions associated with Donuts
- Must have a registered trademark
- Blocks exact domain name registrations
- Allows company to later register associated domain names as desired

New Extension Strategy?

- In-class discussion
Semiconductor Protection

• Semiconductor Chip Protection Act of 1984 (“SCPA”)
• Purpose
  – Fill gap between copyright and patent law
• Problem
  – “Pirate firms can strip the layers of a semiconductor chip and replicate the design at a cost substantially lower than the original firm’s investment.”

Brooktree Corp. v. AMD

• Brooktree (P)
• AMD (D)
• Causes of Action – Patent Infringement and Infringement of Mask Works
Brooktree Corp. v. AMD

What is a mask work?

- A series of related images, however fixed and encoded
  - Having or representing the predetermined, three-dimensional pattern of metallic, insulating, or semiconductor material present or removed from the layers of a semiconductor chip product; and
  - In which series the relation of the images to one another is that each image has the pattern of the surface of one form of a semiconductor chip product.

Brooktree Corp. v. AMD

- Why wasn’t Copyright Law extended to cover semiconductors?
  - Utilitarian protection not available
- Why wasn’t Patent Law extended to cover semiconductors?
  - Timing and coverage

Brooktree Corp. v. AMD

- What is Brooktree’s chip?
- What is the standard for infringement under the SCPA?
  - Made, imported or distributed in violation of exclusive rights
  - Substantially similar to a material portion of the registered work
Brooktree Corp. v. AMD

What defense is available to a violation of the SCPA?
• Reverse Engineering:
  • It is not an infringement of a registered mask work for:
    1) a person to reproduce the mask work solely for the purpose of teaching, analyzing, or evaluating the concepts or techniques embodied in the mask work or the circuitry, logic flow, or organization of the components used in the marks works; or
    2) a person who performs the analysis or evaluation described in paragraph (1) to incorporate the results of such conduct in an original mask work which is made to be distributed.

Brooktree Corp. v. AMD

• How can reverse engineering being proven?
  – Paper trail
• What was AMD’s defense?
  – Chips were independently designed after Brooktree chips were reverse engineered

Brooktree Corp. v. AMD

• Did AMD produce an original mask work?
• Ruling – “There was a legally sufficient basis whereby a reasonable jury could have found infringement of the mask work registrations.”
Altera Corp. v. Clear Logic, Inc.

- **Parties**
  - Plaintiff – Altera
  - Defendant – Clear Logic
- **Causes of Action**
  - Infringement under the SCPA 17 U.S.C. §§901-14
  - Intentional inducement to breach software license agreements (state law)
  - Intentional interference with contractual relations (state law)

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Altera Corp. v. Clear Logic, Inc.

- Altera – PLDs
- Clear Logic – Asics
- **What is the difference between PLD and ASICs?**
  - “Programmable logic devices (’PLDs’) ... are chips that can be programmed to perform various logic functions.”
  - Application-Specific Integrated Circuits (’ASICs’) ... “are designed to perform one specific function and cannot be programmed by the customer.”
- **Why might a company use one type of chip or another?**

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Altera Corp. v. Clear Logic, Inc.

- Altera – Clear Logic copied layout of chips
- Clear Logic – defense of reverse engineering
Altera Corp. v. Clear Logic, Inc.

- Court rejects contention that placement of groups of transistors not entitled to protection under SCPA
- The groupings are part of the mask work, “…physically dictate where functions will occur on the chip and describe the interaction of parts of the chip.”
- Who determines whether it is material?

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Altera Corp. v. Clear Logic, Inc.

- "The second mask work must not be 'substantially identical to the original' and as long as there is evidence of 'substantial toil and investment' in creating the second mask work, rather than 'mere plagiarism' the second chip will not 'infringe the original chip, even if the layout of the two chips is, in substantial part, similar'".
- What did the jury find?

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Right of Publicity

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Right of Publicity

- The right of publicity protects the appropriation of name or likeness of a person for commercial advantage.

Cause of Action

- The elements that the plaintiff must prove in a right of publicity case are:
  1. defendant used name or likeness as a symbol of the celebrity's identity,
  2. without the plaintiff's consent, and
  3. with the intent to obtain a commercial advantage.

Appropriation of the Right of Publicity

- Appropriation can include:
  - Unauthorized testimonials
  - Endorsements
- Appropriation may be:
  - Name
  - Physical likeness
  - Voice
Exploitation

- Exploitation may include a variety of things that may implicate endorsement:
  - Photographs
  - Drawings
  - Phrases
  - Activities

Right of Publicity in MO

- "In Missouri, 'the elements of a right of publicity action include:
  (1) That defendant used plaintiff's name as a symbol of his identity
  (2) without consent
  (3) and with the intent to obtain a commercial advantage.'"

  C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir.)

Laws v. Sony Music Ent.

- How does the right of publicity and the Copyright Act overlap?
Laws v. Sony Music Ent.

- **Case History**
  - Superior Court of CA
  - D.C. – Copyright Acts preempts Right of Publicity Claims
  - 9th Cir – Affirmed
  - Supreme Court – Denied Cert

Laws v. Sony Music Ent.

- **Original Recording and Contract**
  - 1979 Debra Laws entered into a recording contract with Elektra
  - Elektra secured the right to use Laws’s name in conjunction with the master recording
  - 1981 Laws recording the song “Very Special” for Elektra

Laws v. Sony Music Ent.

- **New Recording**
  - 2002 Elektra grants Sony a non-exclusive license to use a sample of “Very Special” in “All I Have”
  - Elektra did not seek permission from Laws, and Laws was not compensated
  - “All I have” released by J-Lo
Laws v. Sony Music Ent.

• Claims at Issue
  • (1) a common law claim for invasion of privacy for the misappropriation of Laws's name and voice and
  • (2) a claim for misappropriation of Laws's name and voice for a commercial purpose under California Civil Code § 3344.

Laws v. Sony Music Ent.

• "We have adopted a two-part test to determine whether a state law claim is preempted by the Act. We must first determine whether the "subject matter" of the state law claim falls within the subject matter of copyright as described in 17 U.S.C. §§102 and 103. Second, assuming that it does, we must determine whether the rights asserted under state law are equivalent to the rights contained in 17 U.S.C. §106, which articulates the exclusive rights of copyright holders."

Laws v. Sony Music Ent.

• First Cause of Action
  • "A claim for protection of her voice, name and likeness under California's common law right of privacy. To sustain this action, Laws must prove:
    • (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise;
    • (3) lack of consent; and
    • (4) resulting injury."
      …
Laws v. Sony Music Ent.

• Second Cause of Action
• Statutory misappropriation or “right of publicity” claim under California Civil Code § 3344(a),
• “Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person’s prior consent . shall be liable for any damages sustained by the person or persons injured as a result thereof.”

Laws v. Sony Music Ent.

• Are the rights of publicity preempted in the facts of this particular case?
• What happened in some prior cases?
  – Nancy Sinatra
    • Use of song
  – Bette Midler
    • Use of Voice Imitation
  – Tom Waits
    • Use of Voice Imitation

Laws v. Sony Music Ent.

• From Sinatra
  • “In Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir.1970), Nancy Sinatra filed suit against Goodyear Tire on the basis of an advertising campaign that featured ‘These Boots Are Made for Walkin’,’ a song that Sinatra made famous. Goodyear Tire had obtained a license from the copyright proprietor for the use of music, lyrics, and arrangement of the composition. Goodyear Tire subsequently used the music and lyrics in its ads, which were sung by unknown vocalists. She alleged the song had taken on a ‘secondary meaning’ that was uniquely injurious to her. We rejected her claim.”
Laws v. Sony Music Ent.

- From Midler
- "Copyright protects ‘original works of authorship fixed in any tangible medium of expression.’ A voice is not copyrightable. The sounds are not fixed.” What is put forward as protectible here is more personal than any work of authorship.”
- "What Midler sought was relief from an unauthorized vocal imitation for advertising purposes, and that was not the subject of copyright."

Laws v. Sony Music Ent.

- From Waits
- The voice of Tom Waits, a professional singer, songwriter, and actor, was imitated and then broadcast in a commercial for Frito-Lay. Waits filed a right of publicity claim under California law. We held that the claim was not preempted by copyright law because it was for infringement of voice, not for infringement of a copyrightable subject such as sound recording or musical composition.” … Thus, the issues in Waits were “whether the defendants had deliberately imitated Waits’ voice rather than simply his style and whether Waits’ voice was sufficiently distinctive and widely known to give him a protectible right in its use. These elements are ‘different in kind’ from those in a copyright infringement case challenging the unauthorized use of a song or recording.” Id.

Laws v. Sony Music Ent.

- Case Analysis
- Present case involves use of copyrighted material with permission, and not vocal imitation.
- “Although California law recognizes an assertable interest in the publicity associated with one’s voice, we think it is clear that federal copyright law preempts a claim alleging misappropriation of one’s voice when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium.”
Discussion Questions

• 1 – Can you use a celebrity’s name on your website?
• 2 – What if the use of the celebrity’s name on the website is only incidental?
• 3 – Can Coca-Cola use a picture of Lady Gaga on its website drinking its product?
• 4 – What types of commercial advantages could occur through the exploitation of the right of publicity of a celebrity on a website?
• 5 – Will negative comments cause a right of publicity cause of action to occur?
• 6 – Does the person have to be “damaged” in order to recover under the right of publicity?
• 7 – Can an artist properly sue someone for infringement of copyright and right of publicity for copying a DVD including a performance of the artist?

Right of Publicity

• Hot areas & cases
  – Gossip website’s posting of celebrity photos
  – Fantasy Sports: C.B.C. Distribution and Marketing v. MLB Advanced Media
  – Like Ads: Fraley v. Facebook
  – Rights After Death in some states
  – Michael Jordan case

Program Completed