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Adventures in Librarianship -- A Passion for Public Television

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Cases of Note — Lanham Act Preempts State Claims — Ultra Sheen Model Falls Off the Legal Runway



by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

June Toney v. L'Oreal, The Wella Corporation, and Wella Personal Care of North America United States Court of Appeals for the Seventh Circuit, 2004 U.S. App. LEXIS 19576 (2004).

June Toney is a model — print, T.V. and runways — who authorized **Johnson Products Corp** to use her likeness for “Ultra Sheen Supreme,” a “hair relaxer” product. The term ran from November 1995 to November 2000.

Johnson sold Ultra Sheen to **Carson Products** which sold it to **L'Oreal** which sold to **Wella Corporation**. And in the process they used her photo beyond Nov. 2000.

Toney sued these companies in state court for using her likeness beyond the contract term relying on the **Illinois Right of Publicity Act**, 765 Ill. Comp. Stat. 1075/1, *et seq.* (2003) (**IRPA**), and the **Lanham Trademark Act** of 1946, 15 U.S.C. § 1125(a).

Fatally, she did not allege breach of contract. And this is where those law review brains in the big defense firms will outsmart and out-civil-procedure you in a flurry of motions.

First, defendants moved the case to federal court where the judge held the **Lanham** claim preempted the state one. Then defendants moved to dismiss Under Rule 12(b)(6) of the Federal Rules of Civil Procedure. **Toney** didn't take the pictures and didn't own the copyright!

Toney dropped her **Lanham** claim with prejudice and “the case was closed.” She appealed the preemption decision in a desperate bid to get back into state court where she could claim a cause of action under **IRPA**.

So what's up with IRPA?

IRPA as you've no doubt guessed gives Illinois the “right to control and to choose whether and how to use an individual's identity for commercial purposes.” 765 Ill. Comp. Stat. 1075/10. Anyone wanting to use your identity for commercial purposes must obtain written consent. 765 Ill. Comp. Stat. 1075/30.

But then there's this preemption thing.

Yes, indeed. **The Copyright Act** preempts

under § 301 if (1) the work is in tangible form, and it falls into the subject matter of copyright under § 102; AND (2) the state rights are the same as the federal ones under § 106.

Curiously, if the work is too minimal in its originality to qualify for federal protection, the states may not protect the right either. See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 676 (7th Cir. 1986).

Which sounds like pretty thorough pre-emption.

§ 102

“Original works of authorship fixed in any tangible medium” are the subject matter of copyright. 17 U.S.C. § 102(a). It's fixed when “sufficiently permanent ... to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101.

So, hair relaxer photos meet the requirement, but ... what do not? A hypnotic vision produced by a magician? Smoke signals? Morse code?

And if that isn't enough, § 101 flat says that photos are “pictorial works” covered by **Lanham**.

Toney gets creative.

Realizing she was up the creek without authority, **Toney's** lawyer got creative, arguing her **IRPA** claim is directed at Defendants' use of her “identity” rather than her likeness in the negatives and photo prints. But **Toney** had not stated this in her complaint, and in her response to Defendants' motion to dismiss she had stated the claim was limited to use of the

likeness. She can't just raise this on appeal. *Bell v. Duperrault*, 367 F.3d 703, 708 n.1 (7th Cir. 2004) (citing *Williams v. REP Corp.*, 302 F.3d 660, 666 (7th Cir. 2002)).

And *Baltimore Orioles supra* held no distinction between publicity rights and art — in this case, players playing a game and photos or broadcast of the same. Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.09[F] (1999).

Footnote 24 in *Baltimore Orioles* did say the question would not be preempted if a company used a player's **name** to advertise a product. But that's not what's going on here. The public doesn't know **Toney's** name and it wasn't used anyhow. It was a photo.

§ 106

For preemption, **IRPA's** rights must be the equivalent of any rights under § 106 which has six rights of which four are on point: (1) to reproduce in copies, (2) to prepare derivative works, (3) to distribute copies, (4) to display.

These were all **Toney's** rights under **IRPA**.

And **Toney** didn't hold copyright. That belonged **Carson Products**. Which as you recall was why **Toney's** case got dismissed.

The court rounds out by saying she should have brought a breach of contract action which would have avoided the preemption issue.

Ouch!

But of course now she can't because you're supposed to plead all theories that are available in the one action. 🐼

Adventures in Librarianship — A Passion for Public Television

by **Ned Kraft** (Ralph J. Bunche Library, U.S. Department of State) <kraftno@state.gov>

Voice over with still shot of town square: WETT 62 — Your Public Television. Bringing high school orchestral concerts, pictures of far away cities, our local poets, and what-not to the greater Farmington area.

Scroll: Two Minutes in the Library.

SA: Hello, I'm **Stratford Avon** bringing you Two Minutes in the Library.

[Music with montage of happy readers, young and old]

SA: Today we're going to talk to **Helen Bacque**, the children's librarian. Welcome, **Helen**. And, may I say, that's a lovely dress

you have on. And your shoes look incredibly comfortable.

HB: Well, thank you **Mr. Avon**.

SA: Tell me **Helen**... may I call you **Helen**?

HB: Certainly, **Stratford**, if I may be so bold.

SA: Indeed you may, **Helen**. Did I mention your lovely dress and comfy shoes?

HB: You did, **Stratty**. Thank you.

SA: Well... yes, then.... Tell me, **Helen**, is

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written agreement among copyright holders; the default is tenants in common.

A library should contact one author or his or her heirs to seek permission to put the work on the Web. Often joint owners are considerate of each other and will not grant permission without contacting the other owner, however. 🐼

Acquiring Minds Want to Know — Institutional Repositories

by **Ann Lally** (University of Washington Libraries) <alally@u.washington.edu>

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Column Editor's Note: *The interest in institutional and digital repositories is heating up. Ann Lally, Head of the Digital Initiatives Program at the University of Washington Libraries, has crafted a great up-to-date summary of the definitions, origins, software, content, and metadata support. You may be hearing that there is little interest on the part of faculty in contributing to local digital repositories — here at the University of Washington the interest is growing, so don't believe everything you hear in the news! — JLO*

Institutional Digital Repositories and Your Library

With the publicity surrounding the development of the **DSpace Institutional Repository** software and its subsequent release as open source software in March of 2002, institutional repository services have been thrust into the forefront of academic library issues. This column will define institutional repositories, discuss some of the current developments in institutional repository software, and the purposes for which they are being used by academic and national libraries around the world.

As librarians began their advocacy for the use of institutional repositories, a couple of definitions have arisen. For example, in his *Digital Libraries* column, **Roy Tenant** of the **California Digital Library** refers to an institutional

repository as a system that facilitates the discovery, management and preservation of the research output of an institution.¹ Published some six months later, a lengthy article in the *ARL Bimonthly Report* article by **Clifford Lynch** of the **Coalition for Networked Information** amplifies this definition by writing “a university-based institutional repository is a set of services that a university offers to the members of its community for the management and dissemination of digital materials created by the institution and its community members. It is most essentially an organizational commitment to the stewardship of these digital materials, including long-term preservation where appropriate, as well as organization and access or distribution. ...an effective institutional repository represents a collaboration among librarians, information technologists, archives and records managers, faculty, and university administrators and policy makers.”²

The genesis for the idea of institutional repositories grew out of the phenomenal success of e-print repositories such as the high energy physics e-print repository **arXiv**, and the need by libraries to develop alternative publishing mechanisms as a response to the increasing costs of serials subscriptions by publishers and aggregators such as **Elsevier**. As **Raym Crow** says in *The Case for Institutional Repositories: A SPARC Position Paper*, “Institutional repositories represent the logical convergence of faculty-driven self-archiving initiatives, library dis-

satisfaction with the monopolistic effects of the traditional and still-pervasive journal publishing system, and availability of digital networks and publishing technologies.”³

It is also possible that in the near future, institutions which receive funding from the **National Institutes of Health** will be required by law to provide public access to articles published as a result of the research conducted with this funding. While Congress is still debating this measure as this issue goes to print, if it becomes law, then the institutional repository movement may have an additional high-profile initiative to drive further development.

Software Options

There are a growing number of software options available for those who wish to use an institutional repository. These can be divided into two types: those that are supported by a vendor and those that require local institutional support.

BEPress is a repository software system currently being supported by a vendor. **BEPress** was developed by the **Berkeley Electronic Press** in cooperation with the **eScholarship Initiative** at the **California Digital Library**, and is currently the software platform of the **ProQuest Digital Commons Service**. The **ProQuest** service offers to host an institutional repository and take responsibility for migration and preservation of the data contained within the repository as well. They also provide around the clock support for the hardware and software should the need arise. As opposed to most repository systems that are installed locally, the **Digital Commons** repository is managed centrally by **ProQuest**.

Other systems, such as **DSpace** and **Fedora** are open source and require a greater level of institutional resource allocation than a vendor supplied service. Someone within the institution needs to install and troubleshoot the software, and hardware must be purchased. Each repository system is designed to handle ingest, presentation and preservation differently. It is essential for those who wish to install a system to carefully analyze the different systems available and to choose the one most relevant to your institutional needs.

The need for an institutional infrastructure to support the service component of such a system should not be overlooked either. In order for a repository system to be effective it is necessary to develop a robust service to market the use of the repository. In addition, policies need to be developed, preferably in

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it true that every Saturday the library offers “story hour” to the local children?

HB: We do. Saturday mornings from ten 'til eleven, we welcome all the local children. Parents should feel free to...

SA: And you do the reading yourself, **Helen**?

HB: That's right, and....

SA: I can imagine that with your mellifluous voice, your poise, and your... stirring presence, it must be quite hypnotic. The children must leave the reading nearly intoxicated.

HB: Well, I can't say that....

SA: Can adults actually sit in on the read-



ings, **Helen**? Would that be against library rules?

HB: Yes, of course, I mean....

SA: Because if one could sit in on such a... tableau, one would I'm certain, be forever transformed, enriched both intellectually and....

HB: **Stratford**, my, my. You're embarrassing me. The Saturday readings are just simple....

SA: Simply astonishing, I'm sure. Have I mentioned how much I admire your taste in clothing, **Helen**?

HB: Yes, you did.

SA: And am I right in remembering that “**Helen**” is the Latin word for spectacular?

HB: I think it's actually from the Greek, **Stratford**.

SA: I... I... We're out of time. Thanks everyone for tuning in to Two Minutes in....

Scroll: Two Minutes in the Library.

[Music with montage of happy readers, young and old]