

September 2004

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Recommended Citation

Strauch, Bruce (2004) "Cases of Note -- Copyright -- When An Upturned Nose Can Be Owned," *Against the Grain*: Vol. 16: Iss. 4, Article 29.

DOI: <https://doi.org/10.7771/2380-176X.4410>

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Cases of Note

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

Copyright - When An Upturned Nose Can Be Owned

Mattel, Inc. v. Goldberger Doll Manufacturing Co. and Radio City Productions, LLC., United States Court of Appeals for the Second Circuit, 2004 U.S. App. LEXIS 7377 (2004).

Mattel is of course **Mattel**, the creator of and copyright owner of **Barbie**, the world's most famous anatomically impossible woman. Despite reports of a recent slump, sales exceed \$1 billion a year.

Radio City owns the famous **Radio City Music Hall** theater in the Art Deco **John D. Rockefeller, Jr.**-built Rockefeller Center. Hence Radio and not Television as it was a Depression era structure.

Its **Rockettes** are the last famous chorus line. I don't know what became of the **June Taylor Dancers** who were on **Jackie Gleason**. And I have no idea about chorus lines in Vegas.

To celebrate the millennium **Radio City** commissioned a "**Rockettes 2000**" doll. **Mattel** sued, claiming copyright infringement of "**Neptune's Daughter Barbie**" and "**CEO Barbie**."

My personal favorite has always been the "**Pat Nixon Barbie**." Yes, it does exist and is a rare collectible. And contrary to urban myth, **Mattel** never produced a "**Lady Bird Johnson Barbie**."

The District Court gave **Radio City** summary judgment, assuming for the purpose of the motion that the doll's eyes, nose and mouth were copied from **Barbie**. They found those to be unprotectible elements along with a legion of other features in a youthful, female doll. **Mattel, Inc. v. Radio City Entm't**, 2002 U.S. Dist. LEXIS 10517 (S.D.N.Y. June 12, 2002).

While I'm not particularly in awe of NYC, there's something about that S.D.N.Y. that always gets to me. You feel like something really important is going down.

Reversed

Yes, the Second Circuit reversed. Ka-wham. And talk about rubbing the judge's nose in it. They used that primary building block **Feist v. Rural Telephone** to explain to him that he didn't understand the most basic thing about copyright.

The poor district court relied on **Ideal Toy Corp. v. Fab-Lu Ltd.**, 360 F.2d 1021 (1966) in which the 2d Cir. found similarities as to full faces; pert, upturned noses; bow lips; widely spaced eyes; and slim figures, BUT...

... found **distinct differences in neck, hair style, chin structure, overall craftsmanship, and head design**. And the **head design** was the **gravamen** of the infringement claim. *Id.* at 1023.

Gravamen was one of those professor words that made them seem so brilliant.

In **Ideal Toy** the court described the doll fea-

tures as "standard" but did not say that put them outside of copyright protection.

Yes, as they told you in law school, read the entire case, not just the head notes.

A Feist Refresher

To receive copyright protection, a work need only be "independently created" and possess an itty-bitty bit of creativity. **Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.**, 499 U.S. 340, 345 (1991).

Feist reversed the "sweat of the brow" theory. That was the deal in **Jeweler's Circular** where a merchant went around the town gathering data on other merchants and the holding was he should be rewarded for his labor with copyright protection.

Which was the issue between **LEXIS** and **Reed-Elsevier's Westlaw** that resulted in a sealed settlement by which **LEXIS** came out sharing the core data **LEXIS** claimed **West** had monopolized.

There are a lot of ways of making upturned noses and bow lips, and if each is independently created, then it's protected by copyright. And it's protected notwithstanding "lack of creativity" (no, that's not lack of originality) **Thomas Wilson & Co. v. Irving J. Dorfman Co.**, 433 F.2d 409, 411 (2d Cir. 1970), "lack of artistic merit," **Rushton v. Vitale**, 218 F.2d 434, 435-36 (2d Cir. 1955), and absence of anything "strikingly unique or novel," **Alfred Bell & Co. v. Catalda Fine Arts, Inc.**, 191 F.2d 99, 102-03 (2d Cir. 1951) ("Originality in this context means little more than a prohibition of actual copying. No matter how poor artistically the author's addition, it is enough if it be his own.")

Summary Judgment

And so we view the evidence in the light most favorable to the moving party **Mattel**. **Barbie** was created by **Mattel** and that minimal creativity is certainly present.

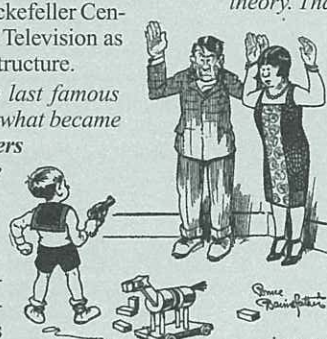
Expression but not ideas is protected. See **Peter Pan Fabrics, Inc. v. Martin Weiner Corp.**, 274 F.2d 487, 489 (2d Cir. 1960). Hence, anyone can produce a doll with upturned nose, bow lips and an impossible figure. That stuff is the "idea" of a type of doll face and in the public domain. See **Mattel, Inc. v. Azrak-Hamway Int'l, Inc.**, 724 F.2d 357, 360 (2d Cir. 1983).

The eight-year-old collector may adore one artist's expression of upturned nose and spurn another. The winner's work is protected by copyright from imitators reaping the reward from his design.

And of course you can't copy one portion and evade liability by changing others. See **Nat'l Comics Publ'ns, Inc. v. Fawcett Publ'ns, Inc.**, 191 F.2d 594, 603 (2d Cir. 1951 (L. Hand, J.)).

Hence, you could not put **Barbie's** head on the **Botero-inspired obesity doll**.

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Music Contract - Rap Wannabe Learns His Limitations

Clarence Holmes v. Willard Smith, Jr. aka Will Smith; Will Smith Enterprises; Jeffrey Townes; A Touch of Jazz, Inc.; Willesen Music Inc., aka Zomba Songs, United States Court of Appeals For the Third Circuit, 2004 U.S. App. LEXIS 7462 (2004).

Clarence Holmes claimed to have an oral recording contract with **Will Smith** and sued him on a *quantum meruit* theory.

How It All Began

Sometime before 1986 — *it's always hazy with these music types* — **Will Smith** and **Jeffrey Townes** formed "DJ Jazzy Jeff and the Fresh Prince." **Holmes** performed with them as "Ready Rock C."

Townes is Jazzy Jeff, and if you're thinking as I was that Fresh Prince was a trademark problem, read on.

On July 26, 1986 **Smith** and **Townes** signed an actual contract with Word Up Record Co. — *which is why we actually know the date.* **Smith** was a minor at the time so his father signed as his guardian.

At an unknown day in September, **Smith** and **Holmes** were walking towards the home of the CEO of Word Up when **Smith** allegedly promised **Holmes** to cut him in for an equal one-third share. And they executed an addendum to the Word Up contract to this effect.

Problem is, the undated hand-written "contract" doesn't really say one-third, does not refer to the original contract and — whups — neither **Smith** nor **Townes** signed it. And the name of the company is misspelled. Not what you'd call great evidence.

In 1990, **Holmes** dropped out. He ran into **Smith** in a Philadelphia auto shop (*all these details are of course designed to add verisimilitude*) and enquired about money owed him. **Holmes** claims **Smith** said "you gonna have to sue me." **Smith** says he denied owing any money.

Holmes' life began going downhill replete with financial problems and eviction. Running into **Smith** once more, he claimed **Smith** acknowledged the debt.

At this point — *incredibly* — **Smith** gave **Holmes** checks (!!) totalling \$26,000! **Holmes** of course claimed this was part of the debt owed while **Smith** said — you guessed it — it was a gift!

Yes, happy birthday!

So the parties were joined. The district court granted summary judgment to **Smith**.

Of course I'm Mr. Ignoramus when it comes to Rap Music. So at this point, I was thinking "who are these bozos?" But out of curiosity, I applied the magic of **Google** and it turns out **Will Smith** is indeed **Will Smith** of "Fresh Prince of Bel Air" and "I Robot" TV and movie fame.

And Smith and DJ Jazzy Jeff do have mu-

sic. A lot of it. So having a checking account with \$26,000 lying in it is not so absurd.

So What's This Quantum Meruit?

Right. Let's stick to what we supposedly know about. Quantum Meruit — "as much as he deserves" — is a common law remedy for an implied contract. Someone renders services or materials to another who accepts them and under normal circumstances would expect to have to pay for them.

Under our facts, provable services were rendered, but the "contract" as you've seen was an oral shambles.

The statute of limitations accrues on the date the relationship of the parties is ended and runs four years. 42 Pa. Cons. Stat. § 5525(a)(4); *Kenis v. Perini Corp.*, 452 Pa. Super. 634 (Pa. Super. Ct. 1996). And four years had run.

This case was in federal court due to diversity of citizenship, but the law of Pennsylvania — the place of the making of the contract — applies.

Holmes argued the statute was tolled by **Smith** acknowledging his debt. *See United States v. Hemmons*, 774 F. Supp. 346, 351 (E. D. Pa. 1991). This case dealt with a loan payment acknowledging an outstanding debt.

But you can see the catch. The loan was evidenced by a writing. And the payment was in the correct amount for a payment.

Huntington Finance Corp. v. Newtown Artesian Water Co., 442 Pa. Super. 406, 659 A.2d 1052, 1054 (Pa. Super. Ct. 1995) requires the acknowledgment "be plainly referable to the very debt upon which the action is based; and

also must be consistent with a promise to pay on demand and not accompanied by other expressions indicating a mere willingness to pay at a future time."

If the last bit is confusing you, remember we're reviving a debt that was absolved by the creditor's failure to sue within four years. So it's not enough that the debtor says "Gee, I'm sorry I stiffed you, and I'd sure like to pay you back if I could. But here's ten percent of what I owed."

One of those little balancing of equities between slothful creditor and deadbeat debtor.


The upshot of this is that *Huntington* requires precision which was not met. And the Third Circuit affirmed the summary judgment.

But of course you're flabbergasted. Someone hands out \$26,000 and the court assumes one logical interpretation is it's a gift! Or you're saying — oh! — RAP music. It could be a payment for something nefarious.

The court just sort of dumps the whole thing saying the district court — whose opinion is of course not reported — adequately provided the reasons for refusing to apply acknowledgment to the case.

So, your diligent researcher went to *Huntington Finance* and finds they really want an unequivocal acknowledgment. I mean really.

In *Huntington*, the four year limitation had run. Without legal obligation, debtor paid over principal but no interest. Creditor sued for the interest. The court held the payment not an admission of owing interest.

They say the public policy behind the acknowledgment doctrine is creditor gets some payment on an otherwise unenforceable debt, and debtor unburdens himself of a moral obligation and improves his credit. Because debtor is opening himself up to suit on what might be a staggering amount of interest, then his acknowledgment must be precise. Otherwise he wouldn't pay over anything at all. 

Questions & Answers — Copyright Column

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QUESTION: *A college library has offered electronic reserves for four years. Should it now revise its electronic reserves policies based on the TEACH Act?*

ANSWER: An amendment to the **Copyright Act of 1976**, the **TEACH Act** revised the section of the law that deals with distance education. It covers performances and displays in distance education that are transmitted in any form in which the course is offered or online, including online components of face-to-face courses. Institutions that wish to qualify for the exemptions offered under **TEACH**, must meet many requirements. Traditional reserves do not deal with performance or display — instead,

reserves deal with the reproduction of articles, book chapters, etc., to support the classroom. These works are copied and because of their nature are not performed or displayed. Works that are typically performed include audiovisual works, musical works and sound recordings; works that are generally displayed include slides, photographs, charts, etc. Thus, for printed works, the **TEACH Act** simply does not apply. Therefore, revising the e-reserves policy is not needed for printed works.

For a reserve collection that consists of sound recordings that are streamed, the **TEACH Act** is applicable since these works are performed.

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