Against the Grain

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Cases of Note-Nominative Fair Use

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LEGAL ISSUES

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Cases of Note — Nominative Fair Use

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New Kids on the Block v. News Am. Pub., Inc., 971 F.2d 302 (9th Cir. 1992).

Ah, the music of the '80s, a time of boy bands. And **New Kids on the Block** were the heartthrobs of millions of teen girlz.

Maxing out the product line is important to the bottom line, and the **New Kids** had more than 500 products and services bearing their trademark. You could even call a 900 number and be charged to listen to them talk about themselves. Or to leave a message!

Not to be left out, **USA Today** had a 900 number where for a mere fifty cents you could vote on which was your fav.

The Star had a 95-cent call where you could vote on which was the sexiest!

The things teenz did before Facebook.

Fearing loss of control, **New Kids** filed in federal court trademark infringement, ***Lanham Act*** false advertising, commercial misappropriation and seven other things.

USA/Star argued First Amendment and got a summary judgment. And of course there was an appeal or else we wouldn't be reading this.

Ninth Circuit

Since the Middle Ages trademarks have identified the source of goods and the law thereof is designed to prevent free-riders on another's labor and toil. The ***Lanham Act*** put it in federal statutory form. ***Taylor v. Carpenter,*** 23 F.Cas. 742-44 (C.C.D.Mass. 1844).

So how are we allowed to talk about something that is under the protection of a mark? Do we say "the professional basketball team from Chicago" or "The Chicago Bulls?" Of course we name the team. It would be impossible to discuss a product without naming it. We can't say "a big auto manufacturer in Michigan" because there are three of them.

Volkswagenwerk v. Church, 411 F.2d 350 (9th Cir. 1969) held that a VW repair shop was allowed to use the mark to show what it specialized in repairing.

WCVB-TV v. Boston Athletic Ass'n. 926 F2d 42,46 (1st Cir. 1991) allowed a TV station to use the words "Boston Marathon" so the viewer would know what he was about to see.

Why would anyone bring such a suit?

This sort of "nominative use" falls outside of trademark as fair use if it does not deceive the public. ***Prestonettes, Inc. v. Coty,*** 264 U.S. 359, 368 (1924).

All of the **New Kids'** causes of action hinged on the claim that the newspaper polls somehow implied the **New Kids** were sponsoring it.

But how is one to anoint the sexiest of the gang without naming him? And nothing in the poll suggested joint sponsorship or endorsement by **New Kids**. It is a nominative fair use.

But, argued **New Kids**, the newspapers weren't just reporting news; they were making money off this. They should have used an 800 number.

Their fans aren't made of money. 95-cents spent on a call might have gone to **New Kids'** product line.

The court just kind of gave this argument a back-hand, saying **New Kids** had no right to channel fan money into products sold by them. They could not prevent an unauthorized biography or censor parodies that used the name, all of which might bring the authors money.

The citation for their position is ***International Order of Job's Daughters v. Lindeburg & Co.,*** 633 F.2d 912 (9th Cir. 1990).

Well, I had certainly never heard of Job's Daughters. Perhaps you have.

It's a masonic order for girls 10 to 20. And the case, a bit astonishingly, allowed a jeweler to put their seal on pins and sell them.

But the mark was unregistered. And Lindeburg never claimed it was "official" jewelry of Job's Daughters.

Hmmm.

Anyhoo, the court signs off with a flippant "all's fair in love, war and the free market."

Not that the 9th Circuit seems to believe in a free market.

But the reasoning is that an author of an unauthorized biography could beat **New Kids** to fan money by coming up with the idea and publishing the book first.

Questions & Answers — Copyright Column

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QUESTION: A school librarian asks how the first sale doctrine applies to the performance of movies, documentaries, music, and Internet materials in class.

ANSWER: The first sale doctrine does not apply to the performance right at all. The first sale doctrine is found in section 109(a) of the ***Copyright Act***. It states, "the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord." So, first sale applies to the transfer of a tangible copy of a work. It does apply to the transfer of a lawfully acquired copy of a film, a music CD, etc., but not to performance.

The performance of films, documentaries, music and Internet materials in a classroom in a nonprofit educational institution is covered by sections 110(1)-(2) of the ***Copyright Act***. For motion pictures and other audiovisual works, the copy used must have been lawfully acquired.

QUESTION: What does the recent U.S. Copyright Office study on section 1201 of the Copyright Act mean for libraries?

ANSWER: Section 1201 was added to the ***Copyright Act*** in 1998 as part of ***Digital Millennium Copyright Act***. It prohibits "access controls," the circumvention of technological measures that copyright owners have employed to protect access to their works. Additionally, the provision prohibits the trafficking in technology or services that facilitate such circumvention or facilitating circumvention of technological measures that protect the exclusive rights granted to copyright owners under the ***Act*** (known as

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