Against the Grain

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Cases of Note – Immoral Trademarks Useful Objects

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that the institutions had the right to “reproduce and share,” however this also pertains to the statement of sharing based on the statement, “that requires permission under the Licensed Rights.” Based on **Greater Minds’** argument the school districts acted as licensing agents between the copyright holders and **FedEx**. Based on the court decision, the possibility of further interpretation of public licensing may become an issue in reproducing and providing materials.

Of course, a major issue of OER is between the publishers and several OER organizations providing OER materials for students and educational institutions. In 2012, **Pearson Education, Inc., Cengage Learning, Inc., and Bedford Freeman & Worth Publishing Group, LLC d/b/a Macmillan Higher Education** filed suit against **Boundless Learning, Inc.** based on copyright infringement. The plaintiffs provide textbooks for higher education, which in this case produced introductory textbooks for economics, biology, and psychology for college courses. The defendant, **Boundless Learning, Inc.**, is an organization that provides electronic textbooks, which includes textbooks for the three introductory college courses.

The plaintiffs claimed in the document filed with the U.S. District Court for the Southern District of New York that **Boundless Learning, Inc.**, “The Boundless textbooks copy the distinctive selection, arrangement, and presentation of Plaintiffs’ textbooks, along with other original text, imagery, and protected expression of Plaintiffs and their authors, all in violation of the *Copyright Act*.” In 2013, all parties came to a confidential settlement, which **Boundless Learning, Inc.** changed how the materials were produced and accessed.

In this case, the issue is content used for the introductory type course was not the major issue, because the content is basic and standard. However, the materials used in the OER were similar to the information provided in the publishers’ works. Therefore, the information is primarily the same no matter the resource for certain subjects, yet the materials used to convey the subject content can be a legal issue.

Despite these legal issues, legislatures have taken notice of the rising costs of higher education that includes the cost of textbooks and other materials needed for students to complete their degree programs. In 2018, Congress approved a five million dollar pilot program to support funding for OER. On April 4, 2019, the U.S. House of Representatives introduced the H. R. 2107 Bill regarding OER, the bill is known as the **Affordable College Textbook Act**. The bill is designed “to expand the use of open textbooks in order to achieve savings for students and improve textbook price information.” The bill currently resides in the Committee of Health, Education, Labor, and Pensions.

According to the findings, students spend an average of \$1,240 annually on textbooks at a public four-year university, due to an 82% increase in textbooks from 2002-2012. Furthermore, Congress addressed the issue of U.S. taxpayers’ investment in education, by noting that the high costs of textbooks was a barrier for students obtaining a four-year degree and that the bill would allow for an efficient use of funds in supporting OER. The findings also noted that OER could save billions annually.

The bill is created to provide an Open Textbook Grant Program. For those institutions qualified, the grant program is designed “to support projects that expand the use of open textbooks in order to achieve savings for students while maintaining or improving instruction and student learning outcomes.” In addition to the U.S. Congress, several states are already investing in OER, which will place more pressure on textbook publishers to take legal actions regarding OER.

Based on the OER movement, educational resources will begin to change drastically, especially with the government initiatives to combat the rising cost of textbooks and materials for not only higher education, but primary and secondary educational institutions, as well. The change will also complicate the way publishers and authors create content for education, which may involve copyright laws.

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Cases of Note — Immoral Trademarks

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IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE V. BRUNETTI. SUPREME COURT OF THE UNITED STATES (June 24, 2019).

Following up from our insightful analysis of *Matal v. Tam*, 582 137 S.Ct. 1744 (2017)

(*ATG* April 2019, v.31#2) your esteemed column editor and retired scholar will be allowed to say “I could see this coming.”

Matal struck down the *Lanham Act’s* bar on “disparaging” trademarks (the band called “The Slants” if you recall) on the basis of viewpoint discrimination. Here we deal with “immoral or scandalous” trademarks.

Erik Brunetti pioneered an early brand of streetwear with the trademark FUCT. He says the brand name is pronounced one letter after the next: F-U-C-T. And of course, there is another way to read it as ... ahem ... profanity.

Brunetti says it is an acronym for Friends U Can’t Trust. He and a skateboarder pal founded

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the company in a one-bedroom apartment in Venice Beach, CA. They marketed through skateboarder magazines. It quickly became a market powerhouse and partnered via images with **Snoop Dogg**, **The Notorious B.I.G.**, and **Kate Moss**. Celebrities like **Leonardo DiCaprio**, **Rihanna**, and **Hailey Baldwin** have been seen out and about in FUCT wear.

Cultural impact? If **Rihanna** doesn't convince you, in 1999, *The Face* magazine named it one of the top forty iconic labels in fashion. And ... **Cornell University Library's** Rare Book and Manuscript Collection has a collection of FUCT clothing due to its cultural significance.

As he hit the big time, **Brunetti** wanted to register his trademark.

It is not essential to register a mark. It can be used in commerce and enforced against infringers. But registration is *prima facie* evidence of validity and serves as constructive notice to infringers.

15 U.S.C. §1052(a) prohibits marks that "[c]onsist of or comprise immoral or scandalous matter." Historically, the **Patent and Trademark Office (PTO)** has asked whether a "substantial composite of the general public" would find the mark "shocking to the sense of truth, decency and propriety."

Of course, they don't actually run surveys or polls. They just pronounce. Perhaps they have in-office pow-wows.

PTO determined FUCT to be totally vulgar and unregistrable. They also did not care for images of "extreme misogyny, nihilism and violence" on the apparel.

Going to their website, I'm having trouble seeing this. Am I hardened by a coarse society to the point where I no longer recognize it? I see a \$125 t-shirt emblazoned with a skull and horned helmet. I see "Duct Tape It Can't Fix Stupid But It Can Muffle The Sound."

It is very much slacker skateboarder attire. Or maybe something you'd see on meth-heads on Breaking Bad.

Hmm. Here's "Cocaine Cool" with a crow leaning against a mound of flake. And two women wrestlers with bared breasts.

Brunetti sued, and the case made its way to the Supreme Court on certiorari.

In **Tam**, the Justices all agreed that government may not discriminate against speech based on the ideas or opinions it conveys. See **Rosenberger v. Rector and Visitors of Univ. of Va.**, 515 U.S. 819, 829-830 (1995). Being able to present ideas which offend are a bedrock First Amendment principle. Viewpoint discrimination is a no-no.

By the **PTO's** interpretation, the **Lanham Act** allows marks whose messages accord with society's sense of decency, but not when they

defy it. The **PTO** has refused to register marks expressing drug use and terrorism (positive) and religion (negative). **D.A.R.E. TO RESIST DRUGS AND VIOLENCE** (yes). **BONG HITS 4 JESUS** (no). **AGNUS DEI** for safes and **MADONNA** for wine were refused registration. Also **BABY AL QAEDA** on t-shirts.

The **PTO** knew they were on thin ice and argued the prohibition should be limited to lewd, sexually explicit or profane marks. They said the overbreadth in application by the **PTO** was not "substantial" relative to "the statute's plainly legitimate sweep."

The Court kind of shook its head at that and said the **PTO** was trying to fashion a new statute. Once viewpoint bias is found, it's all over. It would not compare permissible and impermissible applications if Congress banned "offensive" or "divisive" speech.

And the current mania about "hate speech" really takes you down a rabbit hole.

There are more immoral and scandalous ideas roaming the land than there are swearwords, and the **Lanham Act** is trying to forbid them all. So, big violation of the First Amendment.

And in celebration of their signal victory, there is an "I Fuct the Supreme Court" t-shirt. 🐰

Questions & Answers — Copyright Column

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QUESTION: *A Texas school librarian asks about a recent court decision in which the Houston Independent School District was ordered to pay \$9 million in damages for copyright infringement.*

ANSWER: In a case that was little publicized until the decision was rendered, the **Houston Independent School District (HISD)** was found liable by a federal jury and ordered to pay \$9.2 million in damages for allowing illicit copying and posting of the plaintiff **DynaStudy's** copyrighted works. **DynaStudy**, a small Texas company, repeatedly warned the school district that its actions violated copyright laws and that the company suffered lost sales and a devaluing of its work. The company produces course subjects with reference guides for various subjects and grade levels throughout the year along with study aids before unit tests and standardized assessments. Some teachers in the district had duplicated the materials and then

posted them on the web with the trademarks and copyright notices removed. **DynaStudy** presented evidence that the initial postings were reposted in various school districts across the state.

The 13-year-old company says that it provides supplemental materials that "fill the wide gap between large textbook publishers and teacher-created materials. It has sold its product **DynaNotes** to more than 650 Texas school districts and a few others outside the state.

HISD rejected four offers of settlement including one in 2016 for \$250,000 but it decided to proceed to trial. Both school districts and attorneys for districts typically issue warnings to teachers about illicit copying of materials.

HISD officials have now added training on copyright laws that is required annually for all employees of the district. It is unclear whether the district will appeal the jury verdict.

QUESTION: *A public librarian asks about copying book jackets for display or to be included in the library's calendar of monthly events. Is this permissible?*

ANSWER: Section 109(c) of the Copyright permits the display of lawfully acquired copyrighted works. So, if the library creates a display with original book jackets, there is no problem. Reproducing those book jackets is another issue since it involves making a copy of the book jacket. The artwork on the book jacket is copyrighted, and the book publisher may not own the rights to it but instead acquired only the right to use the art on book jackets. In fact, the publisher may acquire the right for reproduction on the jacket only for the hard cover book only. (Have you noticed that paperback editions of a book often have different cover art?) Making a copy of the book jacket is a reproduction for which permission is required. However, there seem to be no instances in which a copyright owner has complained about a library reproducing a book

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