

OA 528

Oral Argument Dobbs Dec 1

WEIRD AL!

A) Trump-NYT/Trump lawsuit

Trump lawsuit

https://iapps.courts.state.ny.us/nyscef/ViewDocument?docIndex=_PLUS_bDGIVMFJitRHQjPDZd49Q==

Alina Habba

<https://habbalaw.com/alina-habba>

Birth Haven:

<https://birthhaven.org/about-birth-haven/>

B) Trump-Dominion letter

<https://int.nyt.com/data/documenttools/trump-campaign-memo/f7b2de7129fe91b2/full.pdf>

C) Trump-Eastman letter

<http://cdn.cnn.com/cnn/2021/images/09/20/eastman.memo.pdf>

OA 526 we told you he was a birther

D) SB8 lawsuit – wildcard – not getting there

A. WEIRD AL

3 types of copyright law: in the music, in the lyrics, and in the video (if there's a video)

In applying the laws of parody and fair use to specific instances of musical satire, it is also important to distinguish between the types of copyrighted musical works which may be subject to parody, and the differing rights bestowed by the U.S. Copyright Act upon the copyright owners of each respective type of work. The principal distinction in this regard is the differing rights granted by the Act to owners of copyrights in sound recordings, as opposed to those granted to copyright owners of musical compositions or audio visual works such as music videos. A.

Sound Recordings Section 106 of the Copyright Act grants to authors of copyrightable works several distinct rights, including the right to reproduce and distribute the work in copies or phonorecords, the right to prepare derivative works, and the right to publicly perform the work.⁸

17 USC 106

<https://www.law.cornell.edu/uscode/text/17/106>

- (1)** to reproduce the copyrighted work in **copies** or **phonorecords**;
- (2)** to prepare derivative works based upon the copyrighted work;
- (3)** to distribute **copies** or **phonorecords** of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4)** in the case of literary, musical, dramatic, and choreographic works, pantomimes, and **motion pictures** and other **audiovisual works**, to **perform** the copyrighted work **publicly**;
- (5)** in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, **including** the individual images of a motion picture or other audiovisual work, to **display** the copyrighted work **publicly**; and
- (6)** in the case of **sound recordings**, to **perform** the copyrighted work **publicly** by means of a digital audio transmission.

VERY WEIRD but now it makes sense

17 USC 114

<https://www.law.cornell.edu/uscode/text/17/114>

- (a)** The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106, and do not include any right of performance under section 106(4).
- (b)** The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of **phonorecords** or **copies** that directly or indirectly recapture the actual sounds fixed in the recording. The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of

section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording. The exclusive rights of the owner of copyright in a sound recording under clauses (1), (2), and (3) of section 106 do not apply to [sound recordings](#) included in educational television and radio programs (as defined in [section 397 of title 47](#)) distributed or transmitted by or through public broadcasting entities (as defined by section 118(f)): Provided, That [copies](#) or [phonorecords](#) of said programs are not commercially distributed by or through public broadcasting entities to the general public.

(e) AUTHORITY FOR NEGOTIATIONS.—

(1) Notwithstanding any provision of the antitrust laws, in negotiating statutory licenses in accordance with subsection (f), any copyright owners of [sound recordings](#) and any entities performing [sound recordings](#) affected by this section may negotiate and agree upon the royalty rates and license terms and conditions for the performance of such [sound recordings](#) and the proportionate division of fees paid among copyright owners, and may designate common agents on a nonexclusive basis to negotiate, agree to, pay, or receive payments.

(2) For licenses granted under section 106(6), other than statutory licenses, [such as](#) for performances by [interactive services](#) or performances that exceed the [sound recording performance complement](#)—

(A) copyright owners of [sound recordings](#) affected by this section may designate common agents to act on their behalf to grant licenses and receive and remit royalty payments: Provided, That each copyright owner shall establish the royalty rates and material license terms and conditions unilaterally, that is, not in agreement, combination, or concert with other copyright owners of [sound recordings](#); and

(B) entities performing [sound recordings](#) affected by this section may designate common agents to act on their behalf to obtain licenses and collect and pay royalty fees: Provided, That each entity performing [sound recordings](#) shall determine the royalty rates and material license terms and conditions unilaterally, that is, not in agreement, combination, or concert with other entities performing [sound recordings](#).

Section 114 of the Act, however, places limitations on these rights in regard to sound recordings: the copyright owner is denied both performing rights, and the right to limit "sound alike" recordings.^{8 4} Thus, unless the parodist duplicates portions of the original sound recording by converting the actual recorded sounds embodied on the original to his own use, there can be no infringement under the Copyright Act of the rights in the original sound recording. A parodist may therefore imitate a sound recording "note for note," exactly mimicking a performer associated with it in "sound alike" fashion, and perform such a parody or sell a recording of it, without infringing the original sound recording copyright.

COVERS

Without lyrics – go for it as part of fair use

WITH lyrics,

17 USC 115

Copyright royalty tribunal

9.1 cents

A compulsory license does not grant you a right to change the basic melody or fundamental character of the song, use any recording of the performance of the song such as the master recording, or to use your cover song in synchronization with video. Also, the compulsory licensing process only exists for "nondramatic musical works" and does not apply to "dramatic musical works", which is music created for incorporation and performance in dramatic performances such as an opera or theater musical. A separate license from the copyright owner of the recording or the composition is needed in those cases.

3) videos

The rights of the copyright owner of an audio-visual work such as a music video extend to performance, reproduction, distribution, derivative and all other rights set forth in Section 106 of the Copyright Act, and are not limited by a compulsory license scheme. 95 The parodying of audio-visual works, therefore, requires voluntary licensing by the copyright owner unless the use falls within the parameters of the fair use doctrine. In the case of music videos, the copyright owner of the work is often the record company which advanced the money for its production. Thus, when parodist Weird Al Yankovic parodied Michael Jackson's music video of the song "(I'm) Bad" as "(I'm) Fat" by nearly recreating it (replete with Weird Al imitating Jackson's dance steps in a subway environment, dressed up in a "fat suit" as a four hundred pound, leather clad version of the pop star), he licensed such use of the copyright in the "Bad" video from CBS Records, Inc., recognizing that his taking was too broad to qualify as fair use. CBS, in consultation with Michael Jackson, limited Weird Al's use to performance of his parody video on television, declining to permit home video sale. The particular terms of such licensing agreements will depend upon the bargaining power of each of the parties, and the potential profitability of the project

Weird Al's parodies generally consist of independently recorded, painstakingly accurate "sound alike" instrumental tracks of entire hit recordings, over which he records parody lyrics of the underlying musical composition, often sung in a style mimicking the performer which appeared on the hit recording. As noted above, Mr. Yankovic's "sound alike" re-recordings of the original records do not run afoul of the copyright owner's rights in such original recordings, pursuant to section 114 of the Copyright Act. Likewise, since there is no threat of "confusion" in the marketplace caused by his parodies, lampooned recording artists are unlikely to have a cause of action against Mr. Yankovic based on violation of the various unfair competition statutes. It is the rights of the copyright owners in the original underlying songs and music videos satirized by Weird Al, however, whose rights stand to be infringed by the performance and sale of his parodies.

Application of the "verbatim copying" threshold test would present an insurmountable hurdle to any claim of fair use by Mr. Yankovic. 7 His taking of the full chord structure, melody, and portions of the lyrics of the original underlying musical compositions which he parodies is clearly substantial enough to pre-empt a finding of fair use as a matter of law, regardless of any number of "mitigating" circumstances which might exist. The same is true of his near-verbatim takings of the accompanying music videos which he sometimes parodies along with the song and sound recording. Even assuming that Mr. Yankovic could survive application of the verbatim copying threshold test, and taking into account that there is no reason to suspect he would fail the "nexus" threshold test or run afoul of presumptions concerning obscenity, Mr. Yankovic would still not be able to satisfy the burden of proving fair use. Firstly, since his parodies are created for commercial sale, Weir d AI would have to overcome the Betamax presumption that such uses are unfair. Further, because Mr. Yankovic's parodies often so closely parallel the original underlying song and video, it cannot be concluded with confidence that the parodies will not at least partially supplant the original in the marketplace. **The parody and the original often get airplay on the same radio and television stations, and often cater to the same segment of the record-buying public.** Although Mr. Yankovic could claim that his recordings and video parodies actually revive sales of **songs which have fallen from the charts** by the time his parodies are recorded and released, there remains a strong

The first American case in which the issue of parody arose was Bloom and Hamlin v. Nixon. 125 F. 977 (E.D. Pa. 1903).

In that case, the defendant publicly performed portions of the plaintiff's copyrighted song without license, as part of her impersonation of a popular actress currently performing the same song in the stage version of The Wizard of Oz. The court ruled in favor of the defendant under the "fair use" doctrine, noting that she acted in good faith by singing just the chorus of the song as an incidental aspect to her mimicry of the actress, and did not attempt to usurp the plaintiff's market for his copyrighted song through such performances.¹ Thus was the precedent established in the United States that parody is an art form deserving of protection, under certain circumstances, from zealous copyright owners seeking absolute control over the uses of their works.

The Second Circuit view of parody has developed through a series of cases dating from the early part of this century, nearly all of which have involved musical satire. Within six years following the Nixon decision, district courts in the Second Circuit ruled on two cases with fact patterns nearly identical to it. In Green v. Minzenheimer⁹ (S.D.N.Y. 1909), the defendant prevailed against a copyright owner portions of whose song the defendant had sung incidental to his impersonation of a popular singer. Consistently, it was ruled in Green v. Luby[°] (C.C.N.Y. 1909) that the defendant's use of an entire copyrighted song as part of an impersonation did constitute copyright infringement, since the taking of the whole song was "hardly required" for an effective impersonation.

The next important parody decision in the Second Circuit did not occur until 1963, with the Court of Appeals decision in Berlin v. E.C. Publications Inc. (The Mad Magazine Case).¹² That case involved a suit by copyright owner Irving Berlin against Mad Magazine, which had published a book of parody lyrics to popular, copyrighted songs, many owned by the plaintiff. Mad Magazine did not reproduce the music or lyrics to any of the underlying copyrights, but simply noted next to each of the parodies the legend "to be sung to the tune of . . ." followed by the title of the particular song involved in the lampoon. Examples of the Mad Magazine brand of humor included the parody "Louella Schwartz Describes Her Malady," adapted to the tune of Berlin's "A Pretty Girl Is Like A Melody." In affirming the district court's ruling in favor of the defendant Mad Magazine, Circuit Judge Irving Kaufman stated "we believe that parody and satire are deserving of substantial freedom - both as entertainment and as a form of social and literary criticism."¹³ **The court then adopted the two-tiered parody test first set forth in Nixon, 14** focusing on the economic harm to the plaintiff and the substantiality of the defendant's taking. Judge Kaufman wrote, "where, as here, **[1] it is clear that the parody has neither the intent nor the effect of fulfilling the demand for the original,** and where the parodist **[2] does not appropriate a greater amount of the original work than is necessary to 'recall or conjure up' the object of his satire, a finding of infringement would be improper.**"^s

The Mad Magazine Case was followed by Walt Disney Productions v. Mature Pictures Corp. ¹⁶ (The Mouseketeer Case). In that case, the defendants had used the "Mickey Mouse March," the theme from the Mickey Mouse Club television program, as background music in their pornographic film. The particular scene involved women performing sexual acts "on or near a pool table" with three men wearing nothing but "Mouseketeer" hats, the background music under which consisted of continuous, repetitive use of the entire Mouse March.

Relying mainly on the Mad Magazine Case, Judge Duffy ruled in favor of the plaintiffs, stating that the defendants had taken far more of the musical composition than was necessary to "recall or conjure up" the object of the satire.¹⁷ Adding a new wrinkle to the Second Circuit parody test, however, he added that "[w]hile defendants may have been seeking in their display of bestiality to parody life, they did not

parody the Mickey Mouse March but sought only to improperly use the copyrighted material."¹⁹ Thus, Judge Duffy ruled that a parodist has less latitude in utilizing copyrighted music as a mere element of a larger parody than if the music itself was the object of the satire.

The Elsmere and Wilson Cases In 1980, the Second Circuit Court of Appeals ruled on the seminal case of *Elsmere Music, Inc. v. NBC*,²⁰ which concerned a parody of the New York State advertising theme "I Love New York" by the cast of the television show "Saturday Night Live" as "I Love Sodom." The district court held that even though the defendants' substantial taking consisted of the very heart of the plaintiff's musical composition, it was still permissible as fair use since the bonafide social parody did not usurp the market of the original, or make more extensive use of the song than was necessary to conjure it up. Thus, the trial court recognized that song parodies, in particular, often require a substantial taking from the original in order to simply "conjure it up."²⁰

The Court of Appeals (Circuit Judges Feinberg, Newman and Kearsse) affirmed, taking the opportunity to further expand the fair use doctrine regarding parody. Stating that "in today's world of often unrelieved solemnity, copyright law should be hospitable to the humor of parody," the court commented on the "substantiality" issue as follows: [The] [c]oncept of "conjuring up" an original came into the copyright law not as a limitation on how much of an original may be used, but as a recognition that parody frequently needs to be more than a fleeting evocation of an original in order to make its humorous point [A] parody is entitled at least to "conjure up" the original. Even more extensive use would still be fair use, provid[ed] [the] parody builds upon the original, using [the] original as [a] known element of modern culture and contributing something new for humorous effect or commentary.²¹

This ruling represented a high water mark in the Second Circuit's liberalization of parody as a fair use defense to copyright infringement. To what extent, however, the principles set forth in *Elsmere* have been altered by the subsequent decisions of the Second Circuit Court of Appeals in *MCA Music, Inc. v. Wilson*, *Tin Pan Apple, Inc. v. Miller Brewing Company, Inc.*, and *New Line Cinema Corp. v. Bertelsmann Music Group, Inc.* remains a somewhat open question. In *Wilson*, the plaintiffs, owners of the copyright in the song "Boogie Woogie Bugle Boy of Company B" (a song made famous by the Andrews Sisters in the 1940's and later covered by Bette Midler) sued the defendants for their performance of a takeoff entitled "Cunnilingus Champion of Company C" as part of the show "Let My People Come." Although the defendants insisted that they had taken very little from the plaintiff's song, and that they had engaged in parody of both the song and the contrast of sexual mores between the 1940's and the present, the district court ruled that the use was infringing. Claiming to follow the *Mouseketeer* case, the lower court erroneously stated that a legally permissible parody must be confined to directly lampooning the underlying song itself. As the facts indicated that this was not such a case, the court applied a general copyright infringement test resulting in a holding of substantial similarity and infringement.²² On appeal before Circuit Judges Lombard, Van Graafeiland and Mansfield, the Court voted 2-1 to affirm, with Mansfield dissenting. In a confused opinion, the majority first rejected Judge Cooper's finding below that a parodist must confine his satire to the song being parodied. The majority also, however, rejected the dictum in *Elsmere* that a parody need not have anything to do with the copied song,²³ and seeking to find a middle ground ruled that "a permissible parody need not be directed solely to the copyrighted song... [and] may also reflect on life in general... [but] if the copyrighted song is not at least in part an object of the parody, there is no need to conjure it up." (emphasis added).²⁴ After purporting to apply to the facts in the case the four factors established in section 107 Of the 1976 U.S. Copyright Act as guidelines for the determination of fair use questions, the majority eventually arrived at the

conclusion that the district court had correctly found that the defendant's parody of sexual mores had no connection with the plaintiff's song, and therefore could not be fair use. Judge Van Graafeiland stated: The district court held that defendants' song was neither a parody or burlesque of Bugle Boy nor a humorous comment on the music of the '40's (citation omitted). We are not prepared to hold that a commercial composer can plagiarize a competitor's copyrighted song, substitute dirty lyrics of his own, perform it for commercial gain, and then escape liability by calling the end result a parody or satire on the mores of society. Such a holding would be an open-ended invitation to musical plagiarism. 2

Judge Van Graafeiland concluded his discussion of the case's copyright issues by noting that although the district court had found the defendant's use of "Boogie Woogie Bugle Boy" was so substantial as to be unfairly excessive, that he "might have reached a different conclusion on the same facts."²⁶ The judge continued, however, that since the district court's finding was not "clearly erroneous" on the substantiality issue, he was inclined to accept their finding as binding.²⁷ In his well reasoned dissent in *Wilson*, Judge Mansfield lambasted District Judge Cooper for the errors of fact and law in his lower court opinion, and criticized the majority's analysis of the facts under the fair use doctrine on appeal.²⁸ His dissent stated that the defendants clearly were engaged in parody, not only of contemporary sexual mores but of the innocent style of the plaintiff's song and of the Andrews Sisters' performance of it. As such, he argued, a fair use analysis was necessarily determinative. In this regard, Judge Mansfield stated that the defendant had used only enough of "Bugle Boy" to conjure up a recollection of the original in the mind of the listener, and that the majority had failed to focus clearly on the fourth fair use factor, economic harm to the plaintiff. He asserted that contrary to the majority's conclusions, there was no evidence that the parody caused any damage to the plaintiff, or that the defendant's parody, though it was released on phonorecord as part of a "cast album" from the show, threatened to usurp the market for the plaintiff's song. On balance, argued the dissent, the defendant's use of "Bugle Boy" was indeed fair use. In closing, Judge Mansfield made clear his belief that the majority opinion was based not so much on legal precedent as it was on the majority's distaste for the "dirty" nature of the parody. He stated: In my view the defendants' use of "dirty lyrics" or of language and allusions that I might personally find distasteful or even offensive is wholly irrelevant to the issue before us, which is whether the defendants' use, obscene or not, is permissible under the fair use doctrine as it has evolved over the years. We cannot, under the guise of deciding a copyright issue, act as a board of censors outlawing X-rated performances. Obscenity or pornography play no part in this case. Moreover, permissible parody, whether or not in good taste, is the price an artist pays for success²⁹ 26. *Id.* 27. *Id.* 28. *Id.* at 188-91 (Mansfield, J. dissenting). 29. *Id.* at 191. In defense of the majority's decision, it may be pointed out that it is established that "obscenity" is not protected speech under the First Amendment. *Roth v. United States*, 354 U.S. 476 (1957), *Miller v. California*, 413 U.S. 15 (1973). However, the *Wilson* majority did not engage in analysis of whether the lyrics of the defendants' songs were obscene. In regard to the general question of whether "distasteful" or "dirty" parodies 1990] 18 Entertainment, Media & Intellectual Property Law Forum [Vol. 1 The New Line Cinema and Tin Pan Apple Cases *New Line Cinema Corp. v. Bertelsmann Music Group*³⁰ (S.D.N.Y. 1988) involved a suit brought by the owners of the copyrights in the series of horror films known as *Nightmare on Elm Street*, featuring the murderous villain Freddy Krueger. During the latter part of 1987, the plaintiffs decided to authorize the production of a music video based on the *Nightmare* series in anticipation of the release of "*Nightmare IV*," and began soliciting the interest of rap music groups to appear in the video. Rappers "D.J. Jazzy Jeff and the Fresh Prince" composed a song based upon the film series entitled "*Nightmare On My Street*," which the record/music publishing company to whom they were under contract - the defendant Bertelsmann -

submitted to the plaintiffs. After protracted negotiations, no agreement was reached between the parties. Thereafter, Bertelsmann released a D.J. Jazzy Jeff record album containing the song "Nightmare On My Street." Subsequently, the plaintiff hired another rap group to produce the "Nightmare IV" music video. When the plaintiff learned that Bertelsmann had produced and was attempting to have broadcast a music video based upon the Jazzy Jeff tune which liberally incorporated elements of the Nightmare series and the Freddy Krueger character, it moved successfully for a temporary restraining order. In a well reasoned opinion, District Judge Robert Ward ruled in favor of the plaintiff on its motion for a preliminary injunction, enjoining the release or broadcast of the Jazzy Jeff music video. Bertelsmann's central defense was that the Jazzy Jeff video represented a parody of the Nightmare film series and Freddy Krueger and was thus protected by the fair use doctrine. This was rejected by Judge Ward after application of the four fair use criteria set forth have been accorded protection by the courts, it is important to take note of the decision by the U.S. Supreme Court in *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46 (1988). In that case, the nationally renown minister and political commentator Jerry Falwell sued *Hustler Magazine* to recover damages for libel and intentional infliction of emotional distress stemming from an advertisement parody published by the magazine which depicted Falwell as having had a drunken, incestuous rendezvous with his mother in an outhouse. The Court ruled unanimously that the state's interest in protecting public figures from emotional distress is not sufficient to deny First Amendment protection to speech that is patently offensive, even if intended to inflict emotional injury, when such speech is clearly satirical in nature and cannot reasonably be interpreted as stating actual facts about the public figure involved. It is difficult to ascertain what effect, if any, this decision will have in regard to the parodying of copyrighted works. The case undoubtedly will be raised, however, by future parodists defending against accusations that "dirty" satire is presumptively unfair. 30. *New Line Cinema Corp. v. Bertelsmann Music Group, Inc.*, 693 F. Supp. 1517 (S.D.N.Y. 1988). Stranger in Parodies in section 107 of the Copyright Act.³¹ After noting initially that Congress had not classified parody as a "presumptively fair use,"³² Judge Ward turned to the threshold question of whether the Jazzy Jeff video constituted parody at all. Citing the definition of parody set forth in *Dallas Cowboys Cheerleaders v. Pussycat Cinema, Ltd.* (S.D.N.Y. 1979)³³ - that "a parody is a work in which the language or style of another work is closely imitated or mimicked for comic effect or ridicule"³⁴ - Judge Ward also adopted the caveat added to the definition by the court in *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Cooperative Productions, Inc.* (N.D. Ga., 1979): [1]n order to constitute the type of parody eligible for fair use protection, parody must do more than merely achieve comic effect. It must also make some critical comment or statement about the original work which reflects the original perspective of the parodist - thereby giving the parody social value beyond its entertainment function. Otherwise, any comic use of an existing work would be protected, removing the "fair" aspect of the "fair use" doctrine and negating the underlying purpose of copyright law of protecting original works from unfair exploitation by others.³⁵ Unlike the decision of the Appeals Court in *Wilson*, however, Judge Ward was unwilling to decide, at least for the purposes of the preliminary injunction motion, that the defendant's work was not classifiable as "parody."³⁸ Recognizing that it was "undisputed that the [defendant's] music video contains some comic elements and 'pokes fun' at Freddy,"³⁷ Judge Ward found it necessary to apply the four fair use criteria. As to the "purpose and character of the use," the court concluded that the Jazzy Jeff video existed solely as a vehicle to promote the defendant's song and was "purely commercial." The "nature of the copyrighted work" - a work of fiction and fantasy as opposed to one of fact - was also found by the court to mitigate against a finding of fair use. Regarding the "amount and substantiality of the use," Judge Ward adopted a three prong test first announced in

Fisher v. Dees (9th Cir. 1986), discussed *infra*, to be applied in conjunction with the "liberal" principle set forth in *Elsmere* that the parodist may – at

minimum - 'conjure up' the parodied work. The three factors to be considered in determining whether a taking is excessive are: "(1) the degree of public recognition of the original work; (2) the ease of conjuring up the original work in the chosen medium; and (3) the focus of the parody."⁸ Judge Ward concluded that because Freddy is a widely recognized character in the *Nightmare* series, far less than the amount taken by the defendants, would have sufficed to conjure him up. Moreover, he added, since both the parody and the parodied work were produced in the same "audio-visual" medium, there was no mitigating circumstance requiring the excessive taking. Finally, even assuming the purpose of the parody was to poke fun at Freddy, Judge Ward found the defendants took much more "from the original than [was] necessary to accomplish reasonably [their] parodic purpose."⁹ Turning to the fourth and most important factor - the effect of the use upon the potential market of the underlying work - Judge Ward determined unequivocally that the *Jazzy Jeff* video, if released, would harm the value of the derivative use of the *Nightmare* series in the music video market, "a market in which *Nightmare* has reasonable potential to become commercially valuable."⁴⁰ This fourth factor served to distinguish the instant case from the holding in *Elsmere*, wherein the appeals court ruled that the "I Love Sodom" parody "has not affected the value of the copyrighted work. Neither has it - nor could it have - the 'effect of fulfilling the demand of the original'."⁴¹ As such, Judge Ward issued an injunction. *Tin Pan Apple, Inc. v. Miller Brewing Co.*⁴² arose after the broadcast of a television commercial advertisement for the defendant's beer in which comedian Joe Piscopo allegedly parodied the physical attributes as well as the performing style, recordings, and copyrighted songs of the musical group known as "The Fat Boys." The defendants had previously attempted to hire the group to appear in the commercial, but the rappers had refused. Thereafter, Piscopo was hired to perform the parody, in which he was depicted as a rotund rapper supported by obese background vocalists. The group asserted several claims against the defendants, including copyright infringement of its songs and sound recordings, false

advertising, unfair competition, unfair business practices, violation of privacy and publicity rights, and libel. In analyzing the *Fat Boys* case, it is of central importance to note that the opinion addressed a motion to dismiss the complaint for the failure to state a claim. As such, Judge Haight was obliged to construe all facts in favor of the plaintiffs, including the extreme allegation that by "rapping" the words of the commercial, Piscopo had copied the plaintiff's songs, which admittedly consist mainly of percussion and lyrics devoid of melody.⁴³ Judge Haight first applied a threshold test in order to determine if the defendant's work constituted a "valid parody." Quoting language in the *Elsmere* opinion which provided that in order to gain more leeway than the right to merely conjure up a protected work a parodist must "[build] upon the original... contributing something new for humorous effect of commentary," (emphasis omitted), Judge Haight concluded restrictively that "building upon the original" is a threshold criterium which must be satisfied in order for a parody to qualify as "valid." Unless such criteria is satisfied, he wrote, the parody "[does not] qualify even for consideration as an example of fair use under 107."⁴⁴ In *D.C. Comics, Inc. v. Crazy Eddie, Inc.*, the district court held, upon a threshold inquiry, that the defendant's unauthorized use of the copyrighted "Superman" introduction ("Look ... up in the sky ... it's a bird., it's a plane., it's Crazy Eddie!") in its commercials was not parody but merely "unjustifiable appropriation of copyrighted material for personal profit."⁴⁶ Citing to that case, Judge Haight concluded flatly that the use of appropriated copyrighted material to promote the sale of commercial products "simply [does] not qualify as parody."⁴⁷ Judge Haight, however, expressed

second thoughts about drawing such a conclusion on a threshold inquiry without application of the section 107 criteria, especially in light of the Supreme Court's consideration of the "commerciality" issue as part of its fair use analysis in both its *Betamax* (1984) and *Nation* (1985) opinions." Without reaching a conclusion on the issue, Judge Haight wrote: I do not think it makes any difference here, since in either event defendants' commercial does not qualify as parody. The commercial's use is entirely for profit: to sell beer. Even if the concept of parody is impermissibly stretched to include this commercial, it does not qualify as fair use, since accepting the pertinent allegations of the complaint as true, the commercial in no manner 'builds upon the original,' nor does it contain elements 'contributing something new for humorous effect or commentary.' 49 Clearly, the meandering opinion of the district court in *Tin Pan Apple* will not alter the methods of analysis in parody cases established by the Second Circuit Court of Appeals in *Elsmere* and *Wilson*, and refined by Judge Ward's insightful opinion in *New Line Cinema*. Confined to their facts, the *Tin Pan Apple* and *Crazy Eddie* cases merely establish that in the Second Circuit, the parodying of copyrighted works in a commercial advertising context raises a nearly irrebuttable presumption against fair use.

Thus, a restatement of the current law as it exists today in both Circuits can be formulated to facilitate analysis of the various forms of musical parody: 1. So long as the parodist does not engage in excessive, near verbatim copying, and as long as there is at least some nexus between the subject of the parody and the copyrighted work utilized by the parodist, the parody is subject to a fair use analysis under section 107 of the U.S. Copyright Act. 2. In such fair use analysis, the court must presume that commercial uses - especially in the advertising of products - are unfair. But such presumptions may in some cases be overcome by proof that the parody does not supplant or fill the demand in the marketplace of the original, and that the parodist did not intend that it do so (illustrating good faith). The Court must also consider, but accord less importance to, the substantiality of the parodist's taking. A parodist may utilize enough of an original to, at minimum, conjure it up. Somewhat greater leeway is afforded musical parodists who often have a special need for accuracy, the amount depending upon the familiarity of the public with the original, the extent to which the original work is itself the subject of the parody and the nature of the parody in relation to First Amendment considerations. 3. There is a noticeable judicial trend that parodists who engage in the use of "obscene," "immoral," or "dirty" elements in their parodies are often given less leeway to take from original works.

LISTENER Q's

General Contact Unit Problem Child

There's a pizza place in Gibraltar called "Papa Luigi's" and there's cartoon Italian guy on the sign with a mustache and a green outfit. Could Nintendo sue them if they cared to?

Gibraltar, Kentucky. US law.

Plaintiff Dan Tana is a self-described former Yugoslav soccer star, prominent restaurateur, film producer, and actor. He opened his Italian-themed restaurant, Dan Tana's, in West Hollywood, California, in 1964. Since that time, the restaurant has enjoyed a storied history, attracting Hollywood celebrities and insiders to the restaurant's intimate and romantic setting. Dan Tana's serves traditional Italian fare, and it resembles an old-world Italian trattoria with red-and-white checkered table cloths and straw-colored wine flasks hanging from the ceiling. Plaintiff, who has been the sole owner of the restaurant since its inception, figures prominently into its ambiance, personally greeting and welcoming his patrons. The Press has referred to Dan Tana's as a "legendary Hollywood hotspot" and the ultimate "LA hangout," and the restaurant has been featured in numerous newspapers, magazines, and books. The name "Dan Tanna" received significant publicity in the 1970s when producer Aaron Spelling asked Plaintiff for the use of his name for the lead character in his television series "Vega\$."

Despite the notoriety of Plaintiff's restaurant, Plaintiff did not attempt to register the name "Dan Tana's" with the Patent and Trademark Office ("PTO") until June 2005, forty-one years after his restaurant's opening. The PTO denied his application in December 2005 on the basis of the existing registration of the trademark "Dantanna's" in the same category of restaurant services sought by Plaintiff. Defendants had opened the first of two Dantanna's locations in Atlanta in 2003, applied for a federal registration in June 2003, and obtained federal registration of the name "Dantanna's" in March 2005, claiming a date of first use of September 30, 2003.

In June 2006, Plaintiff filed a Petition for Cancellation of Defendants' mark with the PTO's Trademark Trial and Appeal Board, alleging that Defendants sought to mislead the public into believing their restaurant was associated with Dan Tana's Hollywood. Subsequently, Plaintiff filed a federal trademark infringement suit in United States District Court for the Central District of California, which was ultimately dismissed for lack of personal jurisdiction over one of the Defendants. After Plaintiff filed his federal lawsuit, he moved to suspend the trademark cancellation proceeding pending before the PTO. The PTO stayed the proceeding in September 2007.

Plaintiff then filed this lawsuit in the Northern District of Georgia in March 2008, pleading the federal and Georgia trademark infringement, fraud, and tort claims at issue in this appeal. Plaintiff's complaint seeks a permanent injunction enjoining Defendants from all future use of the "Dantanna's" mark and the cancellation of Defendants' federal trademark registration, among other relief. Defendants moved for summary judgment arguing *772*772* that, as a matter of law, Plaintiff could not establish the likelihood of confusion necessary to subject them to liability under § 43(a) of the Lanham Act, Georgia's Uniform Deceptive Trade Practices Act, or fraud under Georgia law, nor could Plaintiff establish the intentional appropriation of likeness required to impose liability under Georgia tort law. The district

court agreed, granting summary judgment in favor of Defendants as to all counts. This appeal ensued.

In evaluating whether there is a likelihood of confusion between two marks, our court applies a multifactor test, evaluating the following seven factors: (1) ⁷⁷⁵*⁷⁷⁵ strength of the mark alleged to have been infringed; (2) similarity of the infringed and infringing marks; (3) similarity between the goods and services offered under the two marks; (4) similarity of the actual sales methods used by the holders of the marks, such as their sales outlets and customer base; (5) similarity of advertising methods; (6) intent of the alleged infringer to misappropriate the proprietor's good will; and (7) the existence and extent of actual confusion in the consuming public.

-copyright vs trademark

-Dan Tana v. Dantanna's, 611 F.3d 767 (11th Cir. 2010)

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Geographic considerations are also particularly relevant where a plaintiff holds only common-law trademark rights in a mark because it is well-established that the scope of protection accorded his mark is coextensive only with the territory throughout which it is known and from which it has drawn its trade. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 416, 36 S.Ct. 357, 361, 60 L.Ed. 713 (1916), *superseded by statute in irrelevant part as stated in Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 105 S.Ct. 658, 83 L.Ed.2d 582 (1985). The owner of a registered mark, in contrast, enjoys the unlimited right to use the mark nationwide, and federal registration affords the registrant priority over all future users of confusingly similar marks. 15 U.S.C. § 1057(c); *Coach House Rest.*, 934 F.2d at 1564. Therefore, a Lanham Act plaintiff asserting common-law trademark rights under § 43(a) against the owner of a registered mark, as here, bears the burden of establishing the right to use its mark by actual use in a given territory. *Emergency One, Inc. v. Am. Fire Eagle Engine Co.*, 332 F.3d 264, 269 (4th Cir.2003). And because registration constitutes constructive nationwide notice of the registrant's priority of use of a mark, 15 U.S.C. § 1072, only actual use occurring *prior to* such registration gives rise to enforceable common-law trademark rights, 15 U.S.C. § 1065. Thus, federal registration has the practical effect of freezing a prior user's enforceable ⁷⁸¹*⁷⁸¹ trademark rights thereby terminating any right to future expansion beyond the user's existing territory. *Allard Enters., Inc. v. Advanced Programming Res., Inc.*, 249 F.3d 564, 572 (6th Cir.2001) ("In the case in which a junior user applies for registration,... the extent of the senior user/nonregistrant's territory is frozen as of the date of actual registration to the junior user.").^[10]

Accordingly, because Plaintiff continued to operate only a single location of Dan Tana's at the time Defendants registered their mark, his trademark rights in the "Dan Tana's" name are limited to the Los Angeles market. Furthermore, the record also establishes that Defendants currently operate restaurants only in the Atlanta area and that the mark of neither party is known by the customers in the other's market. Thus, at present, the parties' restaurants coexist in remote markets, geographically and otherwise.