



# Arts Brief

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Left-Brain Support for Right-Brain People

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## Ninth Circuit Upholds Collective Registration

Copyright registration of a collective work registers the component works within it, the U.S. Court of Appeals for the Ninth Circuit ruled in March, reinstating a stock photo agency's copyright infringement action against a publishing company.

The Register of Copyrights had authority to prescribe a form and grant certificates extending registration to individual stock photographs within a collection where the names of each of the photographers, and titles for each of the photographs, were not provided on the registration applications, the court said.

Deferring to the Copyright Office's interpretation of the Copyright Act, the court said that where the photographers assigned copyrights in their images to the stock agency, and the stock agency registered the collection, both the collection as a whole and the individual images were registered.

Alaska Stock registered large numbers of photographs at a time, listing only some of the authors and not listing titles for each photograph. For example, on "Alaska Stock CD catalog 4," the application listed only three of many authors in the form: "1) Jeff Schultz 2) Chris Arend 3) Johnny Johnson & 103 others." This form of registration was prescribed by the Register of Copyrights and consistent with Copyright Office procedure for many years, the Ninth Circuit said.



## Legal Protection for Fashion Designs

By Nicholas B. Hawkins\*

Fashion designers seeking to protect their intellectual property may be surprised to learn that coverage is spotty. In the United States, it is illegal for someone to take a piece of clothing, stick a designer's name on it without authorization, and sell the garment. However, it is not illegal to reproduce that same article of clothing or fashion design without the designer's logo or name and sell it as your own.

Anytime a designer presents a line of clothing to the public, there is a risk that someone will copy it. Anyone with a smartphone can, in an instant, email images from a fashion show to a clothing manufacturer abroad who can replicate and sell knock-offs of the designer clothing faster and cheaper than the designer.

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Founded in 1985, Maryland Volunteer Lawyers for the Arts provides pro bono legal assistance to income-eligible artists and arts organizations, and educational workshops and seminars on topics affecting artists. MdVLA is funded by the Harry L. Gladding Foundation; the Holofcener Foundation; PNC Bank; the William G. Baker, Jr. Memorial Fund, creator of the Baker Artist Awards ([BakerArtistAwards.org](http://BakerArtistAwards.org)), and by an operating grant from the Maryland State Arts Council, an agency dedicated to cultivating a vibrant cultural community where the arts thrive.

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MdVLA Arts Brief aims to educate and inform Maryland artists about legal issues affecting them. It is not intended as a substitute for legal advice. Artists with legal issues should seek legal counsel to address specific questions.

Executive Editor: Marcia Semmes  
Design Director: Gina Eliadis

Maryland Volunteer Lawyers for the Arts  
1500 Union Ave., Suite 1330 | Baltimore, MD 21211  
410-752-1633 | [info@mdvla.org](mailto:info@mdvla.org) | [www.mdvla.org](http://www.mdvla.org)

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## (Alaska Stock from page 1)

Alaska Stock licensed Houghton Mifflin Harcourt Publishing Co. to use pictures it had registered, for fees based on the number of publications. Houghton Mifflin greatly exceeded the number of publications it paid for so Alaska Stock sued for injunctive relief, actual and statutory damages, attorneys' fees, and costs.

The lower court dismissed the claims on the ground that the registrations were defective because Alaska Stock had not provided the names of each of the photographers and the titles of each of the photographs in its registrations. The district court held that the Copyright Act unambiguously required titles and authors on the registrations.

Overturing that ruling, the Ninth Circuit noted that in 1995 the Register of Copyright and a trade association of stock agencies met to work out how to register large catalogs of images. The Register agreed that a stock agency could register both a catalog of images and the individual photographs in the catalog in one application if the photographers temporarily transferred their copyrights to the stock agency for the purposes of registration.

The Copyright Office provided a letter to the trade association stating that listing only three individual photographers by name, followed by the phrase "and x [number] others," was an acceptable form of registration for catalogs of photographs.

The court concluded that the Copyright Office's interpretation of the statute was reasonable and persuasive. Noting that the Office has maintained its procedure for three decades, and that the livelihoods of photographers and stock agencies have long been founded on their compliance with that interpretation, the court ruled that: "Denying the fruits of reliance by citizens on a longstanding administrative practice reasonably construing a statute is unjust."

The suit is just one of a recent spate filed by stock photo agencies against textbook publishers, claiming that the publishers underreported the number of copies of books that were published. ■

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## (Fashion Design from page 1)

Unfortunately, there is presently no form of intellectual property that specifically protects the entire fashion design of an article of clothing. Absent specific fashion design protection, designers may nonetheless be able to obtain protection for certain aspects of their designs under current law.

While imperfect, copyright law probably provides the best protection available to fashion designers. Copyright protects original works of authorship that are fixed in a tangible medium of expression. Copyright is generally associated with works of art; fashion designs are not specifically protected.

Fashion designers currently have two ways to protect aspects of their designs using copyright: registering their new and original clothing pattern and registering any pictorial, graphic or sculptural elements that are separate and independent of their garment. Neither of these solutions protects the garment as a whole.

Copyright law does not protect functional items “including clothing” thanks to *Mazer v. Stein*, (1954). In that case, which involved lamp stands that were statuettes, the U.S. Supreme Court said it was not in the position to judge whether or not an object may be classified as “art.” After *Mazer*, the scope of protection for useful articles extended only to the sculptures and pictorial representations capable of being identified separately and existing independently of the useful article. In the field of fashion design, this means that only the pictorial, graphic or sculptural aspects of the clothing are copyrightable. For example, a designer who creates a shirt containing an original picture or even an original fabric pattern would be able to receive copyright protection for those elements, but not for the entire shirt.

Can patents protect fashion designs? The short answer is, it depends. Patents give inventors the exclusive rights to their creations. In order to get a patent, the invention must be an article of manufacture, a machine, a process, or composite matter, and be useful, novel, and non-obvious.

Clothing is certainly useful, but generally, it is not novel or non-obvious under the patent standard. Novelty means that the invention must be new while non-obviousness means that the invention cannot be obvious to a person having ordinary skill in the art.

Clothing fails both of these requirements for a utility patent because the public domain of clothing includes the foundation of what constitutes the main components of a garment.

A shirt requires holes for arms and a pair of pants most certainly needs two legs. Any deviation from the standard construction of a piece of clothing is mostly ornamental.

A designer could look to protect his or her design with a design patent, but design patents only protect the original and ornamental aspects of an article of manufacture. The ornamental features for a design patent must also be novel and non-obvious and they must exist separate from the functionality of the garment. Because most articles of clothing are created with functional considerations in mind, a design patent will be difficult to obtain for most articles of clothing. However, if a designer can prove that the aesthetic aspects of the garment have nothing to do with the way the garment operates, a designer might be able to get a design patent.

What about trademarks? Trademarks are distinct words or symbols used to indicate the source of goods in commerce. Trademarks can be either arbitrary (inherently distinct) or common, but if they are merely descriptive of the nature or characteristic or a component of the goods to which the mark is applied, the trademark must have “secondary meaning.” An inherently distinctive mark is one that, by itself, indicates the source of a good. Marks that are not inherently distinct must develop distinctiveness through the consumer’s association of the mark with the source of the good, rather than the good itself (consumer recognition or secondary meaning).

An example of a type of mark that must develop secondary meaning is color. In *Qualitex Co. v. Jacobson* (1995), the Supreme Court held that color might be protected if it obtains secondary meaning, which is needed because color does not automatically associate a product with its source. “Tiffany Blue” for instance, the light blue of Tiffany & Co.’s boxes and packaging, is by itself not something that is inherently distinct. However, over time, customers have associated the light blue color with Tiffany & Co.

Trademark law also provides for the protection of “trade dress,” which is the packaging and appearance of a product. A product’s trade dress must also be either inherently distinct, or obtain distinctiveness through secondary meaning. In *Wal-Mart Stores v. Samara Bros.* (2000), the Supreme Court held that product design is not inherently distinct, and therefore must reach the level of secondary meaning to obtain trade dress protection. Fashion designs are product designs and as such have to acquire secondary meaning in order to be protected by trade dress. In any event, trademarks and trade dress do not protect the entire garment but only the nonfunctional elements of a product.

(Fashion Design from page 3)

A legislative solution to the problem may be necessary. In the last Congress, Rep. Bob Goodlatte (R-Va.) and Sen. Chuck Schumer introduced a pair of bills, both titled the “Innovative Design Protection and Piracy Prevention Act.” These bills would amend Chapter 13 of the Copyright Act to include fashion designs and specifically protect the entirety of a garment rather than its parts for three years. The designs would nonetheless have to be original and not the result of trivial differences from earlier designs. Designers who find a design substantially identical to their own would be able to institute an infringement action and request damages. Unfortunately both bills died in their respective houses.

Although new legislation protecting fashion design is likely to appear in the future, many questions remain on the implications of allowing protection for an art that is so closely associated with a functional article of manufacture. For now, fashion designers should maximize the legal resources available and turn to existing intellectual property methods to protect aspects of their fashion designs.

*\*Nicholas B. Hawkins is a 3L at the University of Baltimore School of Law and director of MdVLA’s Art Law Clinic. ■*

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**For more information, visit [www.mdvla.org](http://www.mdvla.org) or call 410.752.1633.**

## Limitations Statute Runs From Infringement Discovery

The U.S. Court of Appeals for the Second Circuit affirmed April 4 that the Copyright Act’s three-year statute of limitations begins to run when the copyright holder — in this case a photographer — discovers, or with due diligence should have discovered, the infringement.

The appeals court rejected the defendant textbook publisher’s argument that it should adopt an “injury rule,” under which the statute of limitations begins to run when the injury occurs.

Agreeing with its sister circuits, the appeals court said that the text and structure of the Copyright act demonstrate Congress’s intent to employ the discovery rule, not the injury rule. “Policy considerations also counsel in favor of the discovery rule in this context,” the court said.

Photographer Louis Psihoyos sued John Wiley & Sons for the unauthorized use of several of his photos in its textbooks. The trial court rejected the defendant’s argument that the claims were time barred, but ruled for it on several of the infringement claims on the ground that Psihoyos had failed to register the relevant photographs with the Copyright Office before instituting suit.

The case illustrates the impact of failing to register copyright in one’s work before filing suit. Psihoyos won \$100,000 and \$30,000 on two claims in which he alleged that his copyright in registered photos was infringed. He also tried to make the argument, however, that the mere act of submitting an application to the Copyright Office satisfied the Copyright Act’s requirement of copyright registration as a precondition to instituting an infringement action.

The court said it refused to get embroiled in the split in the circuits on the issue. Even assuming that a pending application constitutes a registration, it said, Psihoyos had not even filed the applications for registration of the relevant works before filing suit claiming infringement in those works. The district court acted within its discretion in refusing to allow Psihoyos to amend his complaint to add the unregistered photos, the appeals court concluded. ■

## Sherlock Holmes’s Public Domain Status Affirmed

Copyright protection of a fictional character cannot be extended beyond the expiration of the copyright on it simply because the author altered the character in a subsequent work, the U. S. Court of Appeals for the Seventh Circuit ruled June 16 in a suit involving Sherlock Holmes and his progeny.

The court said it could find no basis for extending a copyright beyond its expiration. “When a story falls into the public domain, story elements — including characters covered by the expired copyright — become fair game for follow-on authors,” it added.

The appeals court affirmed the lower court’s ruling that authors and playwrights can use Holmes, Watson, and other Arthur Conan Doyle characters in works as long as they do not mention details or characters — like Watson’s second wife or Holmes’ retirement from his detective agency — introduced in 10 Sherlock Holmes stories released in the United States after Jan. 1, 1923 (*Arts Brief*, Vol. 7, Issue 1, p. 6, Spring 2014).

This case arose when plaintiff Leslie Klinger sought a declaratory judgment that the Holmes and Watson characters and characteristics were in the public domain. He needed the judgment in order to proceed with a collection of new and original short stories featuring various characters and story elements from the canon.

The Conan Doyle estate warned Klinger’s publisher that unless he obtained a license it would work with retailers to prevent distribution of his work.

At the appellate level, the estate argued as it had below that because the characters of Sherlock Holmes and Dr. Watson continued to be developed throughout the copyrighted 10 stories, they remain under copyright protection until the final copyrighted story enters the public domain in 2022.

“[I]t appears that the Doyle estate is concerned not with specific alterations in the depictions of Holmes or Watson in Holmes-Watson stories written by authors other than Arthur Conan Doyle, but with any such story that is published without payment to the estate of a licensing fee,” the appeals court said.

Calling the estate’s appeal “quixotic,” the court concluded that the “spectre of perpetual or at least nearly perpetual copyright...looms, once one realizes that the Doyle estate

is seeking 135 years (1887 – 2022) of copyright protection for the character of Sherlock Holmes as depicted in the first Sherlock Holmes story.” ■

## Ninth Circuit Amends Ruling in Fatwa Case

A federal appeals court July 11 amended its opinion holding that an actress had a copyrightable interest in her performance in the film “Innocence of Muslims.”

The U.S. Court of Appeals for the Ninth Circuit said in February that an actor’s performance, when fixed, is copyrightable if it evinces “some minimal degree of creativity... ‘no matter how crude, humble or obvious that might be” The court ordered Google Inc. to take the film down from YouTube.

At the time, observers warned that the “boneheaded” opinion could virtually halt the release of films as every disgruntled extra files suit to stop distribution. (*Arts Brief* Vol. 7, Issue 1, p. 1, Spring 2014).

The court appeared to have listened to those observers. Noting that the U.S. Copyright Office denied actress Cindy Garcia’s application for a copyright in her performance after its first opinion was issued, the court said, “Nothing we say today precludes the district court from concluding that Garcia doesn’t have a copyrightable interest, or that Google prevails on any of its defenses.”

On the other hand, the court said, the Copyright Office’s denial does not stop a determination that the performance is copyrightable.

Further, the court said, while it can’t address the issues raised by amici who filed briefs after its February opinion, Google may be able to prevail on the defenses they raised — like fair use — when the district court reconsiders the case. ■





## Banana Lady Loses Infringement Lawsuit

The U.S. Court of Appeals for the Seventh Circuit April 14 affirmed the dismissal of the “Banana Lady’s” copyright infringement suit against several credit unions that hired her to perform at a trade association meeting.

According to the opinion, Banana Lady Catherine Conrad is a self-employed singing and dancing entertainer who performs wearing a costume in the shape of a giant banana.

While some courts have recently found performances copyrightable, the Seventh Circuit said the Banana Lady’s was not because it was not “fixed in any tangible medium of expression.”

To comply with the requirement of fixity, the court said, Conrad would have either had to have recorded the performance or to have created a written “dance notation.”

The appeals court said that while Conrad has a registered copyright in her costume, “there is doubt (not necessary for us to resolve) about the validity of that concept because banana costumes quite similar to hers are, we are surprised to discover, a common consumer product.”

The court said that the meeting’s arrangers might have been sued for inducing violation of Copyright Act provisions forbidding unauthorized video or tape recording of a musical performance and unauthorized public display of copyrighted musical or choreographic works. Conrad, however did not invoke either provision and probably couldn’t, the court said, because one of the arrangers warned the audience against posting photos or video online at the end of the performance.

Noting that the litigious Banana Lady has filed eight cases in federal court in 2009 — and nine cases in state court since 2011 — the court said the trial court should consider enjoining her from filing further suits until she pays her litigation debts. ■

## Prince on ‘Fusion’ of Images He Created

Photographer Patrick Cariou and appropriation artist Richard Prince settled their copyright infringement dispute in March, with Cariou agreeing to drop his case against Prince, who along with his gallery was declared the legal owner of the works at issue, free and clear of any copyright or moral right claims by Cariou (*Arts Brief* Vol. 7, Issue 1, p. 1, Spring 2014).

The settlement followed the U.S. Supreme Court’s refusal to grant review of the Second Circuit’s landmark decision upholding Prince’s right to appropriate Cariou’s photos of Rastafarians for his own use.

Prince’s statement about “Canal Zone,” the show in which the works recently appeared, provides a fitting coda to the case. As he says on the Gagosian Gallery’s web site:

“I don’t want to talk about where the Rastas came from. Like most images I work with they weren’t mine. I didn’t know anything about Rastas. I didn’t know anything about their culture or how they lived. I had plenty of time to find out. What I went with was the attraction. I liked their dreads. The way they were dressed... gym shorts and flip-flops. Their look and lifestyle gave off a vibe of freedom. Maybe I’m wrong about the freedom but I don’t give a shit about being wrong.”

“When I pasted the guitar onto the first Rasta... that was my way in. It was my CONTRIBUTION. It was like a new fig leaf. (I was reading a bio of the Beatles. The first guitar I pasted on was George Harrison’s Rickenbacker that came from one of those pictures they put in the middle of bios. Inside information.) I think this light bulb went off when I was staying on St. Barts in 2006. Maybe when I was sitting there looking out into the ocean, staring at one of those big-ass cruise ships.

“I like iconic images. I thought the Rasta and the oversized collaged guitar looked like it belonged. It looked as if I knew what I was doing. The two images fused and ‘married’ into one new image and made up a whole new story.” ■

## New Online Handbook for Public Domain Status

The Samuelson Clinic at the University of California’s Berkeley Law School announced the publication May 27 of a new book that will help users tell if a work is in the public domain and can be used without permission from or payment to a copyright owner.

“Is it in the Public Domain?” aims to help readers evaluate the copyright status of a work created in the United States between January 1, 1923 and December 31, 1977 — those works that were created before today’s 1976 Copyright Act. Many important works — from archival materials to family photos and movies — were created during this time, and it can be difficult to tell whether they are still under copyright.

The handbook walks readers through a series of questions — illustrated by accompanying charts — to help readers explore whether a copyrighted work from that time is in the public domain. As the clinic points out: “Knowing whether a work is in the public domain or protected by copyright is an important first step in any decision regarding whether or how to make use of a work.”

The handbook was originally developed for the Student Nonviolent Coordinating Committee Legacy Project (“SLP”), a nonprofit organization run by civil rights movement veterans that is creating a digital archive of historical materials.

The handbook is available at: [www.law.berkeley.edu/files/FINAL\\_PublicDomain\\_Handbook\\_FINAL.pdf](http://www.law.berkeley.edu/files/FINAL_PublicDomain_Handbook_FINAL.pdf). The accompanying flow charts are available at: [www.law.berkeley.edu/files/FINAL\\_PublicDomain\\_Flowcharts\\_FINAL.pdf](http://www.law.berkeley.edu/files/FINAL_PublicDomain_Flowcharts_FINAL.pdf). ■

## BURNING QUESTIONS

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### Is there an income requirement?

Yes. Individuals must make less than \$40,000. Arts organizations must have an annual budget of less than \$150,000. Proof of income is required.

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### Is there a fee?

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