

# Intellectual Property



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## Chair's Comments

By Bob Cumbow

In 2001 the Washington State Supreme Court adopted MCLE Regulation 103(g), which allows CLE credits for attorneys providing pro bono services through a "qualified legal services provider." Qualified legal services providers are defined as organizations that exist primarily for the purpose of providing legal services to low-income people. Specifically, up to six hours of credit per year are available to attorneys who take a training course from a qualified legal services provider and perform pro bono legal services or mentor a participating attorney under the legal services program. That's not just a way to bribe lawyers into doing pro bono work. It makes sense, because by counseling pro bono clients, lawyers hone their skills in particular areas of the law and bring their knowledge up to date—which is what CLE is all about.

Another good thing about this new regulation is that, for lawyers who work in law firms, it brings together three different activities that are normally budgeted separately. By performing pro bono work, the lawyer earns CLE credit, and builds her firm's reputation and goodwill in the community. So, a firm that has budgeted a certain amount for pro bono, a certain amount for CLE, and a certain amount for marketing will find itself saving money because a single pro bono activity covers pro bono, CLE, and marketing territory all at once. More detail on the regulation is available on the Bar Association's Web site, at <http://www.wsba.org>.

Note, however, that the MCLE regulation applies only to *qualifying* pro bono work, which is tied to serving low-income clients who can't otherwise afford legal services. The particular skills of intellectual property lawyers don't often lend themselves to providing legal counsel to the indigent. Not too many clients at poverty level (which is where the bar is generally set for qualifying pro bono work) need help prosecuting patents, protecting copyrights, or registering trademarks (although many of the qualified legal services providers offer extended training to volunteers unfamiliar with poverty law). So what is a public-spirited intellectual property attorney to do?

One particularly good way for intellectual property lawyers to do pro bono work is by counseling artists. Though few are truly indigent, many artists work at low income levels, and are unlikely to be able to afford the quality and quantity of sophisticated legal advice necessary to their vocation. And a few artists can afford such counsel, but simply don't know where or how to find it. If the work of such artists is chilled or stymied by a lack of knowledge of copyright law, a misapplication of fair use principles, a misunderstanding of how trademarks can and can't be used, or an unfamiliarity with rights of publicity, all of us are impoverished. Intellectual property lawyers are in a unique position to help.

Here in Washington we are fortunate to have the services of Washington Lawyers for the Arts, a nonprofit organization dedicated to providing affordable legal expertise to artists, the arts community, and lawyers who want to better understand the various regimes of law that apply to the multiplicity of issues that arise in the arts world. WLA achieves this goal through two major programs: a biweekly Arts Legal Clinic, which pairs volunteer lawyers with artists who have legal questions, for half-hour counseling sessions; and a Brown Bag program, in which knowledgeable lawyers share focused expertise with audiences of artists and lawyers who want and need to know more about copyright protection, gallery contracts, publishing agreements, use of famous names and

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trademarks in artworks, music licensing, and numerous other issues.

The Intellectual Property Section of the WSBA is proud to support WLA's Brown Bag program through an annual grant that helps both organizations meet the common goal of improving the quality of public and professional understanding of intellectual property issues. To learn more about WLA and its programs, consult their Web site at <http://www.wa-artlaw.org>.

WLA, and organizations like it, offer intellectual property lawyers a chance to put their unique skills to work for the public good. So if you always thought of pro bono work only in terms of helping the poor and disenfranchised handle oppressive legal and financial problems, think again. Well-placed legal service to creative artists enriches the entire community, and serves the general public good every bit as much as do legal services to the indigent.

We'd encourage the MCLE Board to consider allowing CLE credits for work that is in the public interest even if it does not specifically target the indigent. Providing free or low-cost legal advice to artists is squarely within that realm, and offers the community, the arts, artists, lawyers and the Bar Association all an opportunity that should not be ignored.

*Intellectual Property Law Section***Officers & Executive Committee - 2003-2004****Officers**

**Robert C. Cumbow, Chair**  
Graham & Dunn PC  
Pier 70  
2801 Alaskan Way Ste 300  
Seattle, WA 98121-1128  
206-340-9619  
fax 206-340-9599  
rcumbow@grahamdunn.com

**Alex Modelski, Secretary-Treasurer**  
*Business & Technology Law*  
14450 NE 29th Place, Suite 115  
Bellevue, WA 98007  
425-556-0500  
fax 425-867-3013  
[www.BusinessTechnologyLaw.com](http://www.BusinessTechnologyLaw.com)

**Elizabeth R. Holohan, Chair-elect**  
*University of Washington*  
206-769-4048  
eholohan@u.washington.edu

**Executive Committee** (including officers)

**Jerry A. Riedinger, Immediate Past Chair and CLE Co-Coordinator**  
*Perkins Coie LLP*  
1201 Third Avenue  
Seattle, WA 98101  
206-359-8664  
fax 206-359-9664  
jriedinger@perkinscoie.com

**Grace Han, Newsletter Editor and Web Site Contact**  
*Perkins Coie LLP*  
1201 Third Avenue, 48th Floor  
Seattle, WA 98101  
206-359-6483  
fax 206-359-7483  
ghan@perkinscoie.com

**James P. Donohue, CLE Co-Coordinator**  
*Heller Ehrman White & McAuliffe LLP*  
701 Fifth Avenue, Suite 6100  
Seattle, WA 98104-7098  
206-389-6111  
fax 206-447-0849  
jdonohue@hewm.com

**Al Richardson**  
*Black, Lowe & Graham*  
816 Second Avenue  
Seattle, WA 98104  
206-381-3300  
fax 206-381-3301  
al.richardson@blacklaw.com

**CLE CREDITS FOR PRO BONO WORK?****LIMITED LICENSE TO PRACTICE WITH NO MCLE REQUIREMENTS?****Yes, it's possible!**

Regulation 103(g) of the Washington State Board of Continuing Legal Education allows WSBA members to earn up to six (6) hours of credit annually for providing pro bono direct representation under the auspices of a qualified legal services provider.

APR 8(e) creates a limited license status of Emeritus for attorneys otherwise retired from the practice of law, to practice pro bono legal services through a qualified legal services organization.

For further information contact Sharlene Steele, WSBA Access to Justice Liaison, at 206-727-8262 or [sharlene@wsba.org](mailto:sharlene@wsba.org).

## Conflicting Canons of Patent Claim Construction: Into the Valley of Death

By Brian G. Bodine\* and Kaustuv M. Das†

The protection provided to the owner of a patent depends upon the scope of the claims, which is determined as a matter of law by the court. A court's construction of patent claims is relevant to both the infringement analysis and any potential invalidity challenge. The importance of claim construction cannot be underestimated because, as courts frequently recognize, "to decide what the claims mean is nearly always to decide the case."<sup>1</sup>

Over the years, the Federal Circuit has established numerous canons of construction to help guide patent practitioners, patentees, and the patentees' competitors to determine the scope of patent claims. Using these canons of claim construction, competitors are theoretically able to determine the scope of patent claims, model their conduct accordingly, and avoid riding into the valley of death. Much like the 600 riding into the valley of death, however, patent practitioners and their clients are faced with canons to the left, canons to the right, and canons in front of them.<sup>2</sup> Indeed, for many canons of claim construction, there seems to be an equal and opposite canon. Moreover, many of the established canons of construction are often less than helpful in determining just what claim terms mean: "Patent law is replete with major canons of construction of minor value which have seldom provided useful guidance in unraveling of complex claims."<sup>3</sup>

In the past few years, the Federal Circuit has issued a number of claim construction opinions that have led to increased uncertainty regarding the interaction between two major canons – "claims are to be interpreted in light of the specification" and "limitations from the specification are not to be read into the claims." Of course, there is a natural tension between these two canons: "there is sometimes a fine line between reading a claim in the light of the specification, and reading a limitation into the claim from the specification."<sup>4</sup> Commentators have suggested that the second canon is frequently being ignored by the Federal Circuit,<sup>5</sup> and, as discussed below, the Court's attempt to reconcile these two apparently conflicting canons of claim construction has led to some confusion.

### A. *Vitronics* and the Role of Intrinsic Evidence

The Federal Circuit explained the role of intrinsic evidence in claim construction in *Vitronics*: "It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence or record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history. Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language."<sup>6</sup> The Court also created a hierarchy of intrinsic evidence: "First, we look to the words of the claims themselves"; "second, it is always necessary to review the specification to determine whether

the inventor has used any terms in a manner inconsistent with their ordinary meaning"; and "[t]hird, the court may also consider the prosecution history of the patent, if in evidence."<sup>7</sup> This basic approach to claim construction is one that is still, for the most part, applied by the Federal Circuit. In its analysis, however, the *Vitronics* Court made other statements that have been interpreted and amplified in later decisions and that have heavily influenced claim construction.

### B. "Ordinary and customary meaning" and *Johnson Worldwide*

In its discussion regarding "the words of the claim themselves," the *Vitronics* Court noted that "words in a claim are generally given their ordinary and customary meaning."<sup>8</sup> Decisions both before and after *Vitronics* establish that the meaning attributed to claim terms is the "ordinary and accustomed meaning as understood by one of ordinary skill in the art."<sup>9</sup> In *Johnson Worldwide*, the Federal Circuit introduced another wrinkle to the analysis by creating a "heavy presumption" in favor of the ordinary meaning of claim language.<sup>10</sup>

None of the cases cited by the *Johnson Worldwide* Court in support of this presumption used the phrase "heavy presumption."<sup>11</sup> Yet, it is now well-established Federal Circuit law that there is a heavy presumption that claim terms have their ordinary and accustomed meaning as understood by one skilled in the art.<sup>12</sup> Thus, the *Johnson Worldwide* decision grafted the "heavy presumption" onto the claim construction approach of *Vitronics*.

### C. The specification as "the single best guide" and *SciMed Life Systems*

The *Vitronics* Court also noted that "the specification is always highly relevant" to claim construction. "The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication."<sup>13</sup> Indeed, the *Vitronics* Court characterized the specification as "the single best guide to the meaning of a disputed term. Usually it is dispositive."<sup>14</sup>

Arguably, these comments were made concerning situations in which the patentee has acted as his or her own lexicographer. But the notion that the specification is the single best guide has been relied on in other circumstances, with the most frequently cited case being *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*<sup>15</sup> In *SciMed*, the Federal Circuit considered whether the lumens in a claimed catheter necessarily had to be coaxial or whether the claims also applied to side-by-side lumens.<sup>16</sup> The Federal Circuit relied on the specification and determined that the invention only covered catheters with co-

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axial lumens even though the claims were not restricted by their terms to coaxial lumens.<sup>17</sup> After discussing five cases in which the inventions had been limited to embodiments found in the specification, the *SciMed* Court turned to the patent at issue. In that patent, the inventor noted the advantage of the coaxial lumen over prior art catheters and the specification stated that the coaxial lumen arrangement “is the basic sleeve structure for *all embodiments of the present invention contemplated and disclosed herein*.”<sup>18</sup>

The words ‘all embodiments of the present invention’ are broad and unequivocal. It is difficult to imagine how the patents could have been clearer in making the point that the coaxial lumen configuration was a necessary element of every variant of the claimed invention.... This is ... a clear case of *disclaimer of subject matter* that, absent the disclaimer, could have been considered to fall within the scope of the claim language.<sup>19</sup>

In contrast to *SciMed*, in *Rexnord Corp. v. Laitram Corp.*,<sup>20</sup> the Federal Circuit relied on the ordinary and customary meaning of the claim term “portion,” to define it as both “separate” and “integral.”<sup>21</sup> The district court had relied on the embodiment disclosed in the specification to limit the invention to two-piece chain link structures.<sup>22</sup> The Federal Circuit noted that not only did the specification contain embodiments that supported both a one-piece and two-piece chain link, the specification explicitly stated that the invention was capable of other embodiments and the “inventor was careful to consistently use phrases ... such as ‘In one embodiment . . .’, ‘Before one embodiment . . .’, ‘of other embodiments . . .’, ‘of a preferred embodiment . . .’, or ‘In the particular embodiment . . .’”<sup>23</sup> This comparison between the *SciMed* and *Rexnord* opinions suggests that which of the two conflicting canons prevails is dependant on the language of the specification and can be determined only on a case-by-case basis.

#### D. Texas Digital Systems and Footnote 6 of *Vitronics*

The Federal Circuit’s decision in *Texas Digital Systems, Inc. v. Telegenix, Inc.*<sup>24</sup> seemingly turned the *Vitronics* analysis on its head by requiring that claim construction begin not with an examination of all of the intrinsic evidence, but instead with an analysis of claim terms in light of definitions found in dictionaries and treatises. In *Texas Digital*, the Federal Circuit stated that “categorizing [treatises and dictionaries] as ‘extrinsic evidence’ or even a ‘special form of extrinsic evidence’ is misplaced and does not inform the analysis,” and that “it is entirely proper for both trial and appellate judges to consult these materials at any stage of a litigation, regardless of whether they have been offered into evidence or not.”<sup>25</sup> Perhaps to blunt criticism of the

new analysis, the Court was quick to point out that “the intrinsic evidence must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor.”<sup>26</sup> However, “[i]f more than one dictionary definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all such consistent meanings.”<sup>27</sup>

The Court’s analysis in *Texas Digital* elevates a brief discussion from footnote 6 of *Vitronics* to the centerpiece of the claim construction analysis. In that footnote, the *Vitronics* Court noted that “[a]lthough technical treatises and dictionaries fall within the category of extrinsic evidence, ... [j]udges are free to consult such resources at any time in order to better understand the underlying technology and *may also rely on dictionary definitions when construing claim terms* ....”<sup>28</sup> While these statements are supported by a long-history of United States Supreme Court jurisprudence in non-patent cases,<sup>29</sup> this change in analysis predictably set off a firestorm of criticism.<sup>30</sup>

The *Texas Digital* Court noted one advantage of consulting dictionaries and treatises to determine the ordinary and accustomed meaning of claim terms prior to consulting the specification. “Consulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.”<sup>31</sup> Given the negative reaction that *Texas Digital* has engendered, it will not be the last word on the role of treatises and dictionaries in claim construction, but it is unquestionable that for now there is a fair amount of acceptance within the Federal Circuit that as a threshold step courts should consult dictionaries and treatises to determine the “ordinary and accustomed” meaning of terms.<sup>32</sup>

#### E. The Refined *Vitronics* Test

The test that is now being applied by the Federal Circuit is probably best elucidated in *CCS Fitness*. “Claim interpretation begins with an examination of ... the claims, the rest of the specification and, if in evidence, the prosecution history.”<sup>33</sup> “Generally speaking, we indulge a ‘heavy presumption’ that a claim term carries the ordinary and customary meaning.”<sup>34</sup> “[D]ictionary definitions may establish a claim term’s ordinary meaning.”<sup>35</sup>

According to *CCS Fitness*, claim terms may be given a definition other than their ordinary meaning in one of four circumstances. First, the claim term at issue may be interpreted to mean something other than the ordinary meaning of that term if the patentee acted as his own lexicographer and “clearly set forth a definition of the disputed claim

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term in either the specification or prosecution history.”<sup>36</sup> Second, a claim term will be given a meaning other than its ordinary meaning if the intrinsic evidence establishes that the patentee expressly disclaimed the ordinary meaning by distinguishing over the prior art, expressly disclaimed certain subject matter, or described a particular feature as important to the invention.<sup>37</sup> Third, a claim term is not given its ordinary meaning if that meaning so deprives the claim of clarity that an examination of the intrinsic evidence is required.<sup>38</sup> Fourth, if the claim term is expressed in a “means-plus-function” format under 35 U.S.C. § 112, ¶ 6, the claim term will be limited by statute to the corresponding structure disclosed in the specification and equivalents thereto.<sup>39</sup>

The description of these four limiting circumstances does little to reconcile the tension between the competing canons of construction that “claims are to be interpreted in light of the specification” and that “limitations from the specification are not to be read into the claims.” Furthermore, the Federal Circuit’s application of this test has not always appeared to be consistent.<sup>40</sup>

## F. Conclusion

At first blush, it appears impossible to reconcile the canon “claims are to be interpreted in light of the specifica-

tion” with the canon “limitations from the specification are not to be read into the claims.” Indeed, as recognized by the Federal Circuit there is a fine line between these two canons. However, that is nothing unique to these two canons or decisions of the Federal Circuit applying these conflicting canons.<sup>41</sup> In many cases where the Federal Circuit interpreted claim terms to incorporate limitations from the specification, the outcome appears to be more a reflection of specific language used in the specification than a reflection of any desire to abandon the proscription against reading limitations from the specifications into claims. These cases remind us that patent specifications have to be drafted with as much care as the claims themselves. When considering these dueling canons of claim construction it is worthwhile to keep Professor Llewellyn’s recommendation in mind: “Plainly, to make any canon take hold in a particular instance, the construction contended for must be sold, essentially, by means other than the use of the canon: The good sense of the situation and a *simple* construction of the available language to achieve that sense, *by tenable means, out of the ... language.*”<sup>42</sup> For otherwise, as the Federal Circuit noted regarding another one of its canons of construction “as with much of our case law on claim construction, careless application of so ambivalent a standard can be a recipe for error.”<sup>43</sup>

\* Brian G. Bodine, a registered patent attorney, is a partner at Davis Wright Tremaine LLP, where he focuses his practice on intellectual property litigation, including patent infringement matters. In addition to his private practice, Mr. Bodine serves as an adjunct professor of law at Seattle University School of Law where he teaches Patent and Trade Secret Law. He currently serves as President of the Washington State Patent Law Association.

† Kautstuv M. Das is an associate at Davis Wright Tremaine LLP, where he focuses his practice on intellectual property matters. Mr. Das has a Ph.D. in mathematics from Caltech.

1 *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 989 (Mayer, J. concurring in the judgment).

2 With apologies to Alfred, Lord Tennyson.

3 *Autogiro Co. of America v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967).

4 *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998).

5 See generally Dave A. Ghatt & Timothy B. Kang, *Claim Interpretation: A Regression to Uncertain Times*, 84 J. Pat. & Trademark Off. Soc’y 456 (2002).

6 *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

7 *Id.*

8 *Id.*

9 *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001). *Accord Multifarm Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) (“The inventor’s words that are used to describe the invention ... must be understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology.”).

10 *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999).

11 James R. Barney, *In Search of “Ordinary Meaning,”* 85 J. Pat. & Trademark Off. Soc’y 101, 106-08 (2003).

12 See, e.g., *Resonate Inc. v. Alton Websystems, Inc.*, 338 F.3d 1360, 1364 (Fed. Cir. 2003); *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302 (Fed. Cir. 2003); *Prima Tek II, L.L.C. v. Polypap, S.A.R.L.*, 318 F.3d 1143, 1148 (Fed. Cir. 2003); *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003); *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002); *Teleflex, Inc. v. Ficoso North America Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

13 *Vitronics*, 90 F.3d at 1582.

14 *Id.*

15 242 F.3d 1337 (Fed. Cir. 2001).

16 *Id.* at 1340.

17 *Id.*

18 *Id.* at 1343 (emphasis in original).

19 *Id.* at 1344 (emphasis added).

20 274 F.3d 1336 (Fed. Cir. 2001).

21 *Id.* at 1348.

22 *Id.* at 1344.

23 *Id.* at 1345.

24 308 F.3d 1193 (Fed. Cir. 2002).

25 308 F.3d at 1203.

26 *Id.*

27 *Id.*

28 90 F.3d at 1584 n.6 (emphasis added).

29 *Nix v. Hedden*, 149 U.S. 304 (1893). In deciding whether a “tomato” was a fruit or a vegetable, the Court held “[o]f that meaning the court is required to take judicial notice, as it does in regards to all words in our own tongue; and upon such a question dictionaries are admitted, not as evidence, but only as aids to the memory and understanding of the court.” *Id.* at 306-07.

30 See, e.g., Ben Hattenbach, *Chickens, Eggs and Other Impediments to Escalating Reliance on Dictionaries in Patent Claim Construction*, 85 J. Pat. & Trademark Off. Soc’y 181 (2003).

31 Texas Digital, 308 F.3d at 1204.

32 See, e.g., *Kumar v. Ovonic Battery*, 351 F.3d 1364, 1367-68 (Fed. Cir. 2003); *Ferguson Beaugard/Logic Controls v. Mega Systems, LLC*, 350 F.3d 1327, 1338 (Fed. Cir. 2003); *Inverness Medical Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1378 (Fed. Cir. 2002).

33 *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) 288 F.3d at 1366.

34 *Id.*

35 *Id.*

36 *Id.* This conflicts with the suggestion in *Vitronics* that any such inconsistent definition be either explicit or implicit in the specification or prosecution history.

37 *Id.*

38 *Id.*

39 *Id.* at 1366-67 (internal citations and quotation marks erased).

40 *Compare Watts v. XL Systems, Inc.*, 232 F.3d 877, 883 (Fed. Cir. 2001) (restricting the claim term “sealing connected” to the one embodiment in the specification) with *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1372-74 (Fed. Cir. 2003) (refusing to restrict the claim term “boot selection flag” to the one embodiment disclosed in the specification).

41 For a general discussion of interpreting canons of statutory and legal interpretation, see Karl N. Llewellyn, *Remarks on the Theory of Appellate Decision and the Rules or Canons About How Statutes are to be Construed*, 3 Vand. L. Rev. 395 (1950). Although, somewhat dated much of Professor Llewellyn’s remarks are still very relevant.

42 *Id.* at 401 (emphasis in original).

43 *Altiris, Inc.*, 318 F.3d at 1369.

## Parody in Advertising: Just Think Carefully About It

by Ruth L. Walters\*

### I. Introduction: Parody, We Hardly Knew Ye

So, what is parody? For the purposes of this article, parody is defined as commentary, usually criticism, ridicule, or mockery—funny or otherwise—about a person, place, idea, trademark, or copyrighted work that already exists. What parody is not is free reign to use the intellectual property of others to make fun of them. Nor is it a separate defense to be pleaded when accused of infringing another's intellectual property. Said another way, the First Amendment is not an absolute defense against an accusation of trademark or copyright infringement. But of course, every time speech or expression occurs, the First Amendment is implicated. This article will focus on the intersection of parody, copyright and trademark in advertising.

### II. The First Amendment

As a general rule, there is greater First Amendment protection for so-called communicative speech (e.g., speech making a political point, creative speech, social critique, etc.) than there is for commercial speech (presumably everything else, although it has come to mean speech that is made primarily for making money). Leaving aside commercials for political candidates, advertisements will all fall into the latter category. Unfortunately, parody in advertising begins with at least one psychic strike against it. Not that making money is frowned upon by the judicial system, but using another party's intellectual property to do so can be and frequently is.

The First Amendment's role in parody in advertising is folded into standard analyses regarding the infringement of another party's intellectual property. Thus, when copyright infringement is asserted for an alleged parody, the defendant will reply that he is making fair use of the copyrighted material and the standard fair use analysis will follow. Similarly, parody that results in an accusation of trademark infringement will be defended through the standard factors considered in those cases. This being said, parody is considered to have social value apart from other types of speech, even parody in a commercial setting, and this may influence courts when deciding cases.

### III. One Man's Fixed Expression Is Another's Parody: Parody and Copyrighted Material

The law of parody is most developed in the area of copyright law. The underpinnings of judicial decisions and their balancing of First Amendment concerns with the rights of the property owner have flowed into similar trademark and right of publicity analysis. So it is important

to understand where parodies fit in the overall scheme of "fair use" as a defense to trademark infringement.

A copyright is not absolute—copyright owners cannot prohibit every use of copyrighted material. The most common defense to an assertion of copyright infringement is that the alleged infringer's use is protected under the fair use doctrine. All fair use assessments must consider each of the following factors, which are stated in the Copyright Statute §107 as follows:

1. The purpose and character of the use, including whether it is of a commercial nature or for nonprofit educational purposes.
2. The nature of the copyrighted work.
3. The amount and substantiality of the portion used in relation to the work as a whole.
4. The effect of the use upon the potential market for or value of the copyrighted work.<sup>1</sup>

Every time a defendant asserts a fair use defense, the adjudicating court will analyze and weigh these four factors to determine whether the defendant's use is permissible. It will come as no surprise that this is a complicated and fuzzy process, which leads to uncertainty in the area of permissible copying. Add to that a parodic use of copyrighted material in advertising and the analysis becomes even more uncertain. Although parody is not technically itself a defense to a claim of copyright infringement, courts have found that parodying an original work is functionally different enough from the original to justify a finding of fair use (see Factor 4 above). That is, a parody will not likely supplant the market demand for the original work.

As with many things, economic harm to the property owner is the fulcrum of the analysis. If use of copyrighted material is likely to cause economic harm to the copyright owner through supplanting of its original market, the last fair use factor will likely trump favorable findings on the first three and the fair use defense will fail. This last factor has been described as "undoubtedly the single most important element of fair use."<sup>2</sup> But the type of harm that might be created by a good critical parody is not the concern of the court. Rather, the courts are concerned with the possibility that a work, parodic or otherwise, will usurp or replace the demand for the original work. On this analysis, the fourth and most important factor will frequently swing in favor of the parody, as it is not likely that a parody of a work will supplant the market for the original work. However, this may not always be the case.

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**PARODY IN ADVERTISING: JUST THINK CAREFULLY ABOUT IT** *continued from previous page*

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The social utility of parody in the advertising arena has not been explicitly considered. Nor, when considering the First Amendment distinctions between communicative and commercial speech, is a parodic advertisement likely to receive the benefit of the doubt other more standard parodies might receive. Still, not all commercial parodies are infringing and there are some guidelines in the form of a Supreme Court case and prior and subsequent cases.

Finally and perhaps fortunately for 2 Live Crew, parody does not have to be funny. Courts are unwilling to enter the social mire of determining what is or is not humorous. Rather, a court will look to whether a parody makes a “commentary” on the original, as opposed to just using a well-known or interesting copyrighted work to sell product.

#### **A. 2 Live Crew: Pretty, Hairy, Bald Woman Parody<sup>3</sup>**

The nation watched in breathless anticipation as the nine august members of the United States Supreme Court considered a case involving the creators of the great American cultural classic *Me So Horny*. In this case, a music group named 2 Live Crew was sued over another song on their *As Clean as They Wanna Be* album—a parody of Roy Orbison and Billy Dee’s famous love ballad *Oh, Pretty Woman*. The appeals court found that 2 Live Crew’s parody did not constitute fair use of the copyrighted material. By focusing on the first fair use factor, the court determined that 2 Live Crew’s speech was commercial and not communicative and therefore a fair use defense was not possible. The Supreme Court found that the appeals court had erred in making this presumption and analyzed all four factors to hold that 2 Live Crew’s version could make fair use of the original material. The Supreme Court remanded to the appeals court for additional fact-finding.

While this case did not involve an advertising parody, it is useful for a few reasons, not the least of which is a final word from the high court that commercial use does not immediately foreclose a fair use defense.

Two more important points from this case:

1. The Supreme Court did not draw any “bright line” rules as to what constituted permissible or impermissible parody and emphasized the fact-based nature of any such inquiry. Therefore, it is still useful to consider cases decided before *Acuff* in the field of advertising parody.
2. In its parody, 2 Live Crew used the opening bass riff of *Oh, Pretty Woman* throughout the song, and at the beginning of the first verse, used the same first line, “Pretty woman, walkin’ down the street.” In subsequent verses, 2 Live Crew covered all its bases by

substituting such phrases as “Big hairy woman, you need to shave that stuff” and “Bald headed woman, girl your hair won’t grow.”<sup>4</sup> The Supreme Court disagreed with the appeals court’s assertion that 2 Live Crew had used 2 Much, and stated that this issue was one to be considered on remand. The Court favorably cited cases establishing what is known as the “conjure up” standard as to how much of an original work should be used in a parody. Essentially, enough material to conjure up the original but not too much more than that. Put another way, in a case involving a Mickey Mouse doing un-Mickey-like things,<sup>5</sup> parodists should aim for using an amount of the original material that will allow them to create a *good* parody but not the *best* parody. The best parody will almost certainly use too much of the original for fair use.

#### **B. The Perfect Parody: Hire Leslie Nielsen**

In *Eveready*, Energizer sued Coors over an ad for Coors beer parodying the infamous pink Energizer bunny and Energizer’s ad campaign wherein the pink bunny appeared in the middle of advertisements for products like wine, sinus medication, and long-distance phone services. The Coors ad began much the same way as the Energizer ads, specifically, it appeared to be an advertisement for beer. In the Coors ad, the music then stopped and Leslie Nielsen, dressed in a conservative business suit with white bunny ears and tail and pink bunny feet, walked across the screen banging a bass drum with the COORS LIGHT logo. The ad wrapped up with a background voice saying, “Coors Light...is the fastest growing light beer in America. It keeps growing and growing and growing [voice fades out].” Finally, the Coors logo flashed across the screen.

Energizer sued for copyright infringement, trademark infringement and a state trademark dilution of the Energizer bunny trademark. Dilution claims, discussed more fully below, are available to owners of famous trademarks who can prevent use of their marks on goods and services unrelated to those provided in connection with the famous mark.

Energizer lost on all three claims. The court noted there were several points of difference between the two sets of advertisements, such as:

1. Leslie Nielsen is a well-known actor wearing bunny ears, tail, and feet, and is not a pink bunny or mechanical toy; nor did Coors use some guy off the street in a giant pink bunny suit.

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**PARODY IN ADVERTISING: JUST THINK CAREFULLY ABOUT IT** *continued from previous page*


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2. Mr. Nielsen's "character" did not appear in the characteristic sunglasses and beach flip-flops of the Energizer bunny.
3. In the Energizer ads, the bunny spins the drum a certain number of times; Leslie Nielsen spun it more times and differently.
4. In the Energizer ads, the bunny begins drumming "offstage" over the background music of the commercial, while the music in the Coors commercial grinds to a melodramatic halt before the drum starts.

Small differences to be sure, but such distinctions are indeed crucial in fair use analyses.

### C. *Leibovitz v. Paramount Pictures Corp.*<sup>6</sup>: Leslie Nielsen—Great With Child

One of the first post-*Acuff* cases decided in the field of advertising parody, *Leibovitz* involved a poster advertisement for the movie *Naked Gun: The Final Insult 33 1/3*, which featured Mr. Nielsen's face superimposed on a very pregnant woman's body below a caption reading "Due This March." This ad parodied the famous (or infamous) nude photograph of actress Demi Moore in her eighth month of pregnancy, taken by renowned photographer Annie Leibovitz, which appeared to much publicity in *Vanity Fair* magazine. The court upheld the advertisement as a parody (and therefore fair use), noting that a "photographer posing a well known actress in a manner that calls to mind a well known painting [Botticelli's *Birth of Venus*] must expect, or at least tolerate, a parodist's deflating ridicule."<sup>7</sup>

## IV. Trademark Parodies

A trademark can cover something simple like a word (APPLE computers), a design (the Nike "swoosh") or a slogan (YOU'RE IN GOOD HANDS WITH ALLSTATE). Trademarks can also involve more complicated identifiers such as sounds (the NBC three-tone tune is a federally registered trademark), colors (pink for Owen's Corning insulation), or the look and feel of a place or the design of a package (both referred to as trade dress). Theoretically, anything that acts to designate the source or origin of a product or a service, if used appropriately, is a trademark.

Since the purpose of a trademark is to designate the origin of goods or services, the key concept in analyzing trademark infringement claims, including those relating to parodies, is whether the allegedly infringing trademark is likely to create confusion in the consumer's mind as to the source, origin, affiliation, or sponsorship of the company or its products with the trademark owner or its products.

The interests at issue are those of the consuming public—to be protected from lesser quality goods—and the trademark owner—to protect its own good name and the investments it has made to create it. In short, trading on the good name of others for commercial gain is frowned upon.

As with copyright above, parody is not a separate defense to a claim of trademark infringement but is folded into the overall likelihood of confusion analysis, which varies from Circuit to Circuit, but generally consists of the following factors:

1. Similarity between the marks.
2. Similarity among the goods and services.
3. Target markets.
4. Sophistication of consumers.
5. Actual confusion.
6. Strength of the mark.
7. Intent to palm off one's goods as another's.

When considering trademarks, the best statement regarding parody is that a good parody will not cause any likelihood of confusion. A good parody will make it patently obvious that the entity producing the parody is not at all connected with the trademark or company or product being parodied. Trademark parody must convey two separate messages—on the one hand, that it is the original and, on the other hand, that it is not.

In addition, these two statements must be made simultaneously. In *People for the Ethical Treatment of Animals v. Doughney*,<sup>8</sup> the plaintiff successfully sued the defendant for trademark infringement. Mr. Doughney registered the URL <peta.org> and created a Web site parodying PETA entitled "People Eating Tasty Animals." Although Mr. Doughney's speech was in this instance purely political and parodic, the court ruled against him because the URL in and of itself did not convey the parody. And, since the URL could and did appear separately from the content, individuals looking for PETA might actually arrive at Mr. Doughney's site. The legal term of art for these situations is "initial interest confusion," and it is also impermissible. End result—do not use another entity's trademark in a domain name, unless the parody is also conveyed there.

One perhaps obvious but still essential requirement is that the trademark use must be a parody of the trademark itself or the company that owns the trademark. As with copyrighted material, it is not permissible to use another's trademark merely for the purposes of, say, satirizing a

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**PARODY IN ADVERTISING: JUST THINK CAREFULLY ABOUT IT** *continued from previous page*

particular aspect of society. By the same token, there must be parody involved, or the junior user is simply trading on the name of another. Finally, the copyright “conjure up” standard has been applied by federal circuit courts to judge how much of the original trademark can and should be used for a parody.

**A. Leslie “Bunny” Nielsen Redux**

Eveready also brought a trademark infringement claim against Coors, based on their trademark application for the following bunny design mark:



The court also found against Eveready on this claim, stating that the only factor in favor of Eveready was the strength of the trademark. The goods of Coors and Eveready did not overlap, and there were clear differences between the two “marks.”

**B. The Important Exception: Famous Trademarks**

Owners of trademarks adjudicated “famous” can prevent use of their marks on goods or services entirely distinct from the ones provided by the trademark owner on the basis that such use “dilutes” or occasionally “tarnishes” its famous trademark. Thus, it is unlikely anyone will be selling Nike brand radial arm saws or Rolls Royce brand paprika any time within the foreseeable future. Unfortunately for advertisers, it is precisely these instantly recognizable marks that appear so ripe for parody. Perhaps to compensate for this fact—that the most effective parodies will often involve famous marks—the standard likelihood of confusion or dilution analysis is sometimes mitigated by the courts’ belief that parody can be socially useful.

Further, a recently decided Supreme Court case has held that dilution—meaning an evidentiary showing that the ability of a famous mark to identify goods or services has been lessened—must be shown to stop use of a mark similar to a famous mark.<sup>9</sup> This decision may be helpful for advertisers who want to lampoon famous marks, particularly if courts adopt the copyright theory above, namely, that the economic harm that results from a good parody is

not at issue. Rather, economic harm is the extent to which the use of the famous mark is supplanting the market for the original goods.

**1. Porno: No-No!**

A brief statement about pornography: the use of another’s trademarks, famous or otherwise, in connection with pornography or sexually explicit materials will almost certainly result in a ruling against the parodist. This is based on the legal theory of “tarnishment,” namely, that the parodist is ruining the good name of the trademark owner by associating it with unseemly material. Illegal drugs are also off-limits. For commercial speech such as advertising, the property owner’s rights in her property will almost always outweigh any First Amendment concerns. A good way to get sued is to make a parody of a famous cartoon character engaging in unseemly behavior.

**2. John Deere<sup>10</sup>: Not a Weak Deere to be Found Here**

MTD, a competitor of John Deere’s, produced a series of commercials demonstrating the superiority of its tractors and agricultural products by parodying the famous Deere deer logo:

MTD’s commercials showed the logo “come to life,” but in unfortunate circumstances; being chased by a small dog and being chased by an MTD Yard-Man® tractor. Thus, the stag, a symbol of strength, virility, and grace in numerous cultures, was transformed into a scaredy-cat Bambi baby, looking over its shoulder fearfully at somebody’s little pup. The court noted that this use did not qualify as tarnishment (no sex, no drugs, no deer breaking and entering), but MTD’s use diluted the value of the Deere logo:

The commercial takes a static image of a graceful, full-size deer—symbolizing Deere’s substance and strength—and portrays ... a deer that appears smaller than a small dog and scampers away from the dog and a lawn tractor ... [thus diluting the strength of Deere’s logo] because they risk the possibility that consumers will come to attribute unfavorable characteristics to a mark and ultimately associate the mark with inferior goods and services.<sup>11</sup>

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**PARODY IN ADVERTISING:****JUST THINK CAREFULLY ABOUT IT** *continued from previous page***V. Conclusion**

The best conclusion would summarize this paper by providing the best hypothetical parody imaginable. However, somewhat like the best parody, the best conclusion would almost certainly venture too far.<sup>12</sup> Hence, the pretty good conclusion.

Underlying the cases, statutes and commentary discussed above are two larger themes for the creation of a successful parody. A successful parody must be precise and it must be obvious. A successful parody will call to mind the specific piece of intellectual property being parodied, but will leave no doubt in the mind of the viewer that it is in fact a parody and not the original property. The distinction between parody and satire addressed above is perhaps one way to describe the need for a successful parody to have a precise aim, and to use only the amount of the original property necessary to call up the original, and then move on from it. So the pretty good conclusion is like the pretty good parody—it gets the point across quickly and doesn't create confusion or mistake itself with the original.

Well ... this is the author's fervent hope at any rate.

\* Ruth Walters is an associate at Perkins Coie LLP, where she focuses her practice on trademark and intellectual property matters.

1 17 U.S.C. § 107.

2 *Eveready Battery Co. v. Adolph Coors Co.*, 765 F. Supp. 440, 448 (N.D. Ill. 1991) (quoting *Fisher v. Dees*, 794 F.2d 432, 437 (9th Cir. 1986) (internal quotation marks omitted).

3 *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

4 *Id.* at 595-6.

5 *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978).

6 137 F.3d 109 (2d Cir. 1998).

7 *Id.* at 114-15.

8 263 F.3d 359 (4th Cir. 2001)

9 *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 434 (2003).

10 *Deere & Co. v. MTD Prods. Inc.*, 41 F.3d 39 (2d Cir. 1994)

11 *Id.* at 45. While this case was decided before *Moseley* and also under New York state instead of federal dilution laws, it does present an excellent case study for the analysis of the theory of what constitutes dilution of a famous mark.

12 Beyond the skills of the author, that is.

## Law School Student Meet-and-Greets

*by Elizabeth Holohan*

WSBA has adopted outreach to law students as one of its goals for the upcoming year. The Intellectual Property Section has led the charge in fulfilling that goal, by hosting "Meet & Greets" at Washington's law schools. These meetings offer students a unique opportunity to meet intellectual property practitioners and Section members in an informal environment.

The events have been a huge success for the Section. We kicked off the 2003-2004 year by visiting Gonzaga School of Law in December. Six Section members fielded questions from students and members of the newly formed IP Section of the Spokane Bar Association, and then mixed with attendees over appetizers. It was a great opportunity to connect with our Eastern Washington colleagues and students interested in IP.

More recently, the Section returned to the University of Washington to host an event in the beautiful new law school, Gates Hall. Fifteen attorneys from several area firms and companies greeted students, providing them with practice insights on a diverse range of specialties, including publicity rights, patent litigation, opportunities for work with arts clients, and the day-to-day reality of a working IP practice.

The Section will finish the year with a Meet & Greet at Seattle University School of Law on April 21. We look forward to again bringing attorneys from a broad range of practice areas and firms. Please consider attending. For more information, or to sign up to attend, please send me an email: [eholohan@u.washington.edu](mailto:eholohan@u.washington.edu).

Students have raved about the opportunities these meetings present, and Section members attest to the value of this way of reaching out to the lawyers of tomorrow. Thank you to all the Section members who attended these events and were so generous with their advice!!

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2101 Fourth Avenue, Suite 400  
Seattle, WA 98121-2330

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