

GET BACK, ROSA PARKS

By: Jim Astrachan

Legg Mason learned the expensive way that it pays to keep tabs on employees' activities, especially if they involve reproduction and circulation of copyrighted material. In Legg's case, its employees copied Lowry's subscription newsletters and sent them to other Legg employees, avoiding the cost of additional subscriptions. A federal jury decided that these actions will cost Legg \$20 million. That pays for a lot of subscriptions.

Many businesses do what Legg did, and the message should come across loud and clear that this is a dangerous practice. Even law firms have been nailed. Counsel and executives can take steps to stop this, or at least thwart the assertion that copying is willful. How? Adopt a policy prohibiting copying of copyrighted material and circulate the policy. Police employees' activities. Get placed on circulation lists and monitor receipts. Even if an employee violates the policy, the employer can assert that the action was not willful. Although an award of damages will not be avoided, it may be substantially reduced. Remember, also, that licenses to reproduce and distribute copyrighted materials are available.

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This month, United States District Court Judge Colleen Kollar-Kotelly properly reversed the Trademark Trial and Appeals Board's decision to cancel the REDSKINS trademark. Several Native Americans, it seems, were offended by the twenty-seven year old trademark registration and filed a petition asking the TTAB to cancel the mark on the grounds that REDSKINS is both derogatory and scandalous. The Lanham Act bars registration of marks that are scandalous or defamatory. After introduction of survey evidence and reams of literature, the TTAB concluded the mark was derogatory but not scandalous and ordered cancellation.

To score a touchdown, the petitioners had to establish that when the mark was registered twenty-seven years ago, REDSKINS was scandalous or derogatory. To do this they had to establish that the mark was scandalous to a segment of society, or that it was derogatory of an identifiable class of persons, in this case Native Americans. What are scandalous marks? Try O.J. SIMPSON and a BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND. The former was opposed on the basis that O.J. was scandalous to family values; the latter, a chicken restaurant's slogan, was opposed by several women who claimed it offended women in general.

The TTAB did not agree with petitioners that the REDSKINS mark was scandalous, but it did succumb to evidence showing that the mark was derogatory to Native Americans. Several surveys were conducted, both of the general population and Native Americans; each concluded that the mark was a derogatory reference to Native Americans. The surveys were flawed, but petitioners also presented prodigious amounts of examples from hundreds of years of literature in which REDSKINS was used in a demeaning way.

The football team defended on the grounds that REDSKINS has come to only mean football - that the term is not demeaning. The District Court ruled that while the mark might be offensive, there was insufficient evidence to establish that the mark was derogatory when registered, and that the petitioners had waited too long to bring their action. Could the Court not bear the thought of a team named the Washington CONGRESSPERSONS?

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ROSA PARKS recently made the news. Ms. Parks, as everyone knows, is the woman who refused a bus driver's order to move to the back of the bus almost 50 years ago. Her name has since been prominently connected to the Civil Rights Movement.

Enter Outkast, a group recognized by *The New York Times* as "the greatest hip-hop group of all times." When Outkast named a song ROSA PARKS and used that title to promote their new CD, Ms. Parks filed suit alleging the band had crossed the line and violated her publicity and trademark rights.

The right of publicity prevents persons from using another's name or identity without permission in a commercial fashion. And, celebrities such as Woody and Vanna have also been held to have trademark rights in their personas. Celebrities' rights, however, can clash with an author's First Amendment right to use the celebrity's name to write a book, make a movie, write a critical article, or...write a song. Courts have bent over backward, as they should, not to restrict these First Amendment uses, especially when art and literature are involved.

The United States District Court granted the rappers' motion for summary judgment on the basis that no reasonable person could conclude that the use of the Parks name was not relevant or related to the song. Therefore, the court concluded, the use was protected by the First Amendment.

The appellate court disagreed, holding that some folks might not see any relevance between the title and the song's contents.

Ah ha, hush that fuss
Everybody move to the back of the bus
Do you want to bump and slump with us
We the type of people make the club get crunk

The appellate court also decided that Ms. Parks might even have a viable claim for false advertising, as an appreciable number of consumers might believe that she sponsored or approved the song.

A celebrity can not avoid being portrayed in a non-pleasing manner. But, as one court wrote, "...poetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product."

Was Outkast's use of ROSA PARKS' name false advertising because it misrepresented the connection between Ms. Parks and the song, and was this use a violation of her right of publicity and trademark right? Was it a legitimate use protected by the First Amendment? These questions will be determined by the jury; not on summary judgment.

Relevance to content has always been required to defeat a right of publicity claim. It is hard to imagine that the case came this far. Perhaps a very conservative court, asking whether Outkast's music is "repulsive trash", contrasted its view with Ms. Parks' stellar reputation. I don't know what "crunk" is, but the Court might need some of it.

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