Intellectual Property

2008 WINTER BULLETIN

In This Bulletin

California's Amended Right of Publicity Statute (California Civil Code § 3344.1)

BY SONGMEE CONNOLLY

After unanimous approval by the California Assembly and the California Senate, Governor Arnold Schwarzenegger signed S.B. 771 into law on October 10, 2007, amending California Civil Code section 3344.1. The amended statute clarifies the scope of the statutory post-mortem right of publicity and expressly abrogates the summary judgment orders in *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, Case No. CV 05-2200 MMM (MCx) (C.D. Cal. May 14, 2007) and *Shaw Family Archives, Ltd. V. CMG Worldwide, Inc.*, Case No. 05 Civ. 3939 (CM) (S.D.N.Y. May 2, 2007). The law became effective January 1, 2008.

Brief Background on California's Right of Publicity

California recognizes both a common law and statutory right of publicity. The statutory right of publicity first originated with Civil Code section 3344, enacted in 1971, allowing recovery by any living person whose name, photograph, or likeness has been used for commercial purposes without his or her consent. The common law right of publicity, recognized eight years later in *Lugosi v. Universal Pictures*, 25 Cal. 3d 813 (1979), protects against the unauthorized use of one's name, likeness, or personality. However, because the common law right of publicity derives from the law of privacy, the right is not freely transferable or descendible, and thus expires by operation of law upon death.

In 1984, the California legislature enacted a statute creating a post-mortem right of publicity for "deceased personalities," meaning individuals whose names, voices, signatures, photographs, or likenesses have commercial value at the time of their death. This legislation was codified as Civil Code section 990 and became effective January 1, 1985. Under the California statute, this right of publicity is a property right that may be transferred by contract, trust, or other testamentary document. In the absence of such a transfer, the right is descendible to certain statutory heirs and their successors after the personality's death.

In 1999, the California legislature renumbered section 990 as section 3344.1 and amended the statute to extend the duration of the post-mortem right of publicity from fifty to seventy years after death, rephrase certain statutory exemptions for the media, and include a provision applying the statute to acts occurring directly in the state of California. These 1999 amendments were known as the "Astaire Celebrity Image Protection Act" because the bill was initiated by Fred Astaire's widow, following the adverse ruling in *Astaire v. Best Film & Video Corp.*, 116 F. 3d 1297 (9th Cir. 1997), *opinion amended*, 136 F.3d 1208 (9th Cir. 1998).

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The Marilyn Monroe Cases

Since its enactment, several cases have discussed the applicability of section 3344.1. However, S.B. 771's clarifying amendments to section 3344.1 were introduced as a direct response to two 2007 district court decisions concerning the publicity rights of Marilyn Monroe: *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, Case No. CV 05-2200 MMM (MCx) (C.D. Cal. May 14, 2007) and *Shaw Family Archives, Ltd. V. CMG Worldwide, Inc.*, Case No. 05 Civ. 3939 (CM) (S.D.N.Y. May 2, 2007).

In these cases, the courts interpreted section 3344.1 as prohibiting publicity rights from passing by will if the personality died prior to January 1, 1985. At issue was Marilyn Monroe's residuary estate, which she left to her former acting coach, Lee Strasberg. Because Marilyn Monroe died on August 5, 1962, before a transferable right of publicity existed in California, her rights of publicity did not form part of her residuary estate and therefore could not have been passed on in her will. The *Shaw Family Archives* court further noted that even if the publicity right had formed part of the Monroe residuary estate, a transfer by will would not have been effective because section 3344.1(b) requires the transfer take place "before" death; a transfer by will, however, occurs upon death. Moreover, having no eligible statutory heirs (*i.e.*, no surviving spouse, children, grandchildren, or parents), Marilyn Monroe's right of publicity effectively would have fallen into the public domain.

S.B. 771

In response to the holdings in the *Marilyn Monroe* cases, and at the behest of the Marilyn Monroe estate, the Screen Actors Guild lobbied heavily for the proposal and passage of S.B. 771. The bill was authored, introduced, and fast-tracked through the California legislature by Senator Sheila Kuehl (D-Santa Monica). S.B. 771 expressly abrogates the summary judgment orders in the *Marilyn Monroe* cases and clarifies the scope of California's post-mortem statutory right of publicity in several ways. First, the bill expressly grants retroactive rights of publicity to deceased personalities with a date of death on or after January 1, 1915. Second, the amended statute allows the disposition of publicity rights with the residue of a deceased personality's estate in the absence of an express provision in a testamentary instrument. Third, the amended statute clarifies that the right of publicity is freely transferable or descendible by contract, trust, or any other testamentary instrument by any subsequent owner of the right. However, the bill does not affect any decision before May 1, 2007 in which a court held that a deceased personality's transferable or descendible publicity right vested in a statutory heir.

Potential Challenges

The amendments to section 3344.1 affect many more deceased celebrities than just Marilyn Monroe. By retroactively granting publicity rights to already-deceased celebrities, the amended statute could generate litigation among the devisees and statutory heirs of deceased personalities, as wills are re-examined and probate matters reopened. It is unclear how courts will handle any potential conflicts that may arise between the amended statute and California's probate code. We might expect to see lawsuits challenging the amended statute in the coming year.

Ethical Limits on Investigations in IP Litigation

BY JEDEDIAH WAKEFIELD

Intellectual property cases often require extensive up-front investigation. California trade secret plaintiffs must identify misappropriated secrets with "reasonable particularity" before commencing discovery, and plaintiffs in patent cases must often identify preliminary infringement contentions at the outset of the case. To help analyze the strength of IP cases, and to obtain evidence of infringement, lawyers frequently retain private investigators. Others do so to avoid the agony of trying to enforce discovery requests.

While the need for early investigation in many IP cases is clear, the ethical limits on the use of private investigators are sometimes ill defined. The controversy surrounding the widely reported Hewlett Packard investigation — and the role played by lawyers in that matter — raised broader questions about the ethical limits on the use of private investigators by attorneys.

The following hypothetical illustrates some of the unsettled issues raised by the use of investigators. Your client, a software company, has heard rumors that a group of former employees have created a new company and are selling a "knock off" of your client's flagship product. Your client is concerned that its new rival has infringed its copyrights and misappropriated trade secrets. Word on the street also has it that the new company is infringing your client's trademarks, falsely identifying the new software as the "next version" of your client's product. Your client has sent a threatening letter, demanding assurances and access to the competing product. The response — from an outside lawyer — tells your client to pound sand. Your client has asked you to investigate potential trade secret misappropriation in the product, and to find out whether the competitor is engaged in trademark infringement.

One frequently used investigative technique in such cases is to have an investigator go "undercover," typically by posing as a customer. In this hypothetical, an undercover "customer" might be given infringing marketing material, and potentially purchase or obtain an evaluation copy of the product itself. While this technique does not involve the controversial issue of "pretexting" to gain personal information, it potentially implicates ethical prohibitions on the use of deceptive conduct and attorney contact with represented parties.

Can Attorney-Retained Investigators Gain Information Through Deception?

While the California Rules of Professional Conduct are silent on the issue, many other states and the ABA Model Rules of Professional Conduct prohibit lawyers from making material false representations to third parties. ABA Model Rule 4.1 bars attorneys from knowingly making false statements of material fact or law to a third person, and Model Rule 8.4 prohibits engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation. Lawyers are not shielded from the application of these rules by use of an investigator or other third party, since as a general matter, lawyers cannot do through their agents what they would ethically be prohibited from doing themselves.

Despite the ethical prohibition on attorney misrepresentations, several courts have noted that using investigators to pose as customers is an appropriate investigative technique in IP cases and have declined to exclude evidence obtained through such investigations. For example, in *Gidatex S.r.L. v. Campaniello Imports, Ltd.*, 82 F. Supp. 2d 119 (S.D.N.Y 1999), counsel for plaintiff, a furniture manufacturer, had private investigators secretly tape conversations with a terminated distributor's salespeople in an effort to gain evidence in a trademark infringement suit. The court held that this conduct did not violate New York's rule against attorney misrepresentations, noting that "hiring investigators to pose as consumers is an accepted investigative technique, not a misrepresentation." The Court concluded that ethical rules "should not govern situations where a party is legitimately investigating potential unfair business practices by use of an undercover posing as a member of the general public engaging in ordinary business transactions with the target."

A similar conclusion was reached in *Apple Corps Ltd. v. Int'l Collectors Society*, 15 F.Supp.2d 456 (D.N.J. 1998), a trademark, copyright, and right of publicity case. There, the court found that use of undercover investigators posing as customers to identify ongoing violations of a consent decree did not violate New Jersey's prohibition on attorney misrepresentations, observing that "[t]he prevailing understanding in the legal profession is that a public or private lawyer's use of an undercover investigator… is not ethically proscribed, especially where it would be difficult to discover the violations by other means."

Despite these authorities, courts have not been uniform in their approved use of investigators who obtain information under false pretenses. In *Upjohn Co. v. Aetna Casualty and Surety. Co.*, 768 F.Supp. 1186 (W.D. Mich. 1990), for example, the court disapproved of interviews conducted by investigators of plaintiff's former employees without identifying themselves as agents of defense counsel. The Court noted that under Michigan's rules governing contact with unrepresented persons, if the lawyer knows or should know that an unrepresented person misunderstands the lawyer's role in the matter, the lawyer shall make "reasonable efforts to correct the misunderstanding." Under these rules, the court found that it was improper for investigators retained by counsel to misrepresent their identity or purpose in gathering information.

Contact with Represented Parties

The hypothetical above is further complicated by the fact that the new company is now represented by counsel in its dispute with your client. Accordingly, any contact with the new company potentially implicates the prohibition on contact with represented parties.

Various state professional responsibility rules restrict an attorney's *ex parte* contacts with employees of a party. This no-contact rule is intended to prevent disruption of the attorney-client relationship and to prevent a represented party from being taken advantage of by opposing counsel. See ABA Formal Opinion 95-396 (1995). As adopted in most states, including California, the no-contact rule prohibits a lawyer, when representing a client, from directly or indirectly communicating about the subject of the representation with a party the lawyer knows to be represented by another lawyer in the matter. While different jurisdictions utilize various tests to determine when an employee of a corporate party is off limits, most, including California, prohibit direct or indirect communications with (i) managerial employees, and (ii) low-level employees if the communication involves the employee's "act or failure to act in connection with the matter" which may bind the corporation or be imputed to it, or constitutes an admission of the corporation for purposes of establishing liability. Cal. Rule Prof. Conduct 2-100 (B)(2).

The no-contact rule applies not only to direct communications by counsel, but to indirect communications, as well. ABA Formal Opinion 95-396 clarifies that lawyers are responsible for contacts with represented parties by investigators acting under the lawyer's instructions. While the formal opinion observes that "there is no doubt that the use of investigators in civil and criminal matters is normal and proper" the opinion concludes that when the investigators are directed by lawyers, the lawyers may have ethical responsibility for the investigator's conduct.

In the hypothetical above, the investigators have been asked to determine the extent to which employees are infringing your client's trademarks, and to obtain a copy of the product in question. Arguably, such contacts with non-managerial employees are not prohibited by Rule 2-100. If an investigator posing as a customer observes a sales person making misrepresentations about the source of the product, the subject of the communication would not be an "act or omission of the employee in connection with the matter." Rather, the investigator would merely be observing conduct. In contrast, a communication concerning whether the employee was intentionally misrepresenting the source of the product or had misappropriated your client's intellectual property to create it would be prohibited.

The court in *Gidatex* held that the no-contact rule did not prohibit counsel from having investigators engage in discussions with the adverse party's sales people in an effort to gain evidence in a trademark suit. The court reached a similar conclusion in *Fair Automotive Repair, Inc. v. Car-X Service Systems, Inc.*, 471 N.E.2d 554 (Ill. App. Ct. 1984). There, investigators posing as customers made references to a lower estimate for services from the plaintiffs' auto repair shops. In response, the defendant's employees made disparaging remarks about the plaintiff. The court concluded that this did not violate the no-contact rule: "Plaintiffs' investigators did not seek statements from the employees at the Car-X shops for their information or impeachment value. Rather, when the investigators heard the statement, it was a form of observing conduct."

Conclusions

Given the uncertainty regarding the ethical limits on investigative techniques, the ABA and state bar associations should provide more guidance on permissible use of investigators. Until then, lawyers in IP cases must balance their obligation to conduct a reasonable investigation of the facts with current ethical rules. As the widely varying outcomes of cases like *Upjohn* and *Gidatex* illustrate, it is important for lawyers to be familiar with the ethical rules of their home state and anywhere an investigation may occur. Moreover, while in theory one can distinguish between permissible and impermissible investigative techniques, as a practical matter there is a risk that an investigator may cross the line from permissible techniques to prohibited communications. Lawyers who choose to retain investigators should clearly communicate expectations and boundaries to avoid surprises down the road.

Finally, even when lawyers are convinced that an investigation will survive legal scrutiny, they must bear in mind how those techniques will play to a jury and the press. Sometimes, even a technically "legal" investigation can cause far greater harm to a client than the underlying IP dispute.

Quick Updates

Exclusive "Field of Use" Patent Licensees Lack Standing to Sue Alone

In October, the Federal Circuit held that a patent licensee to an exclusive "field of use" license has no standing to sue in its own name without joining the patentee. *Int'l Gamco, Inc. v. Multimedia Games, Inc.*, 504 F.3d 1273 (Fed. Cir. 2007). Applying this new rule, the Federal Circuit reversed a district court decision denying Multimedia's motion to dismiss an infringement suit brought by Gamco, the sole contractor for lottery games in New York State.

Gamco was granted an exclusive license, "within the Territory," to U.S. Patent No. 5,324,035, which is directed to gaming system networks generally. "Territory" was defined as "the lawful operation of lottery games authorized by the New York State Lottery in the state of New York." The district court characterized this as a hybrid between a territorial license and a "field of use" license because the '035 patent covers games other than lottery games. Presupposing that licensees with exclusive rights within a territory and licensees with exclusive rights within a field of use would have standing to sue in their own name, the district court denied Multimedia's motion to dismiss Gamco's suit.

The Federal Circuit reversed. The court acknowledged the longstanding rule that an exclusive territorial licensee need not join a patent licensor to maintain a suit for infringement, citing *Waterman v. Mackenzie*, 138 U.S. 252 (1891). In contrast, it found no precedent unequivocally determining the standing of an exclusive field of use licensee. Although *dicta* from a prior Federal Circuit decision, *Textile Productions, Inc., v. Mead Corp.,* 134 F.3d 1481 (Fed. Cir. 1998), suggested that an exclusive "field of use" license confers standing, the court looked instead to an 1892 Supreme Court decision to reach the opposite conclusion.

In *Pope Manufacturing Co. v. Gormully & Jeffery Manufacturing Co.*, 144 U.S. 238 (1892), the Supreme Court held that a licensee with exclusive rights lacked independent standing to sue where the licensee's rights were limited to a particular embodiment of the invention. In *Pope*, the licensed embodiment was set forth in just one of the patent's several claims. The Court observed that even exclusive licenses to specific embodiments or claims of a patent engendered the threat of multiple suits for any given act of infringement. Citing prudential considerations, the licensee was not entitled to sue in his own name.

The Federal Circuit found Gamco's exclusive "field of use" license indistinguishable from the "claim-by-claim exclusive" license of *Pope* because, in each case, patent rights were divided by subject matter. Since this division creates the same risk of multiple suits against one defendant based on a single act of infringement, the court concluded that the "prudential standing requirement compels an exclusive licensee with less than all substantial rights, such as a 'field of use' licensee, to join the patentee before initiating suit."

It should be noted that even an exclusive licensee of an undivided patent right cannot independently pursue infringement claims without possessing "all substantial rights" with respect to the patent. *Gamco* makes it clear that field of use restrictions alone can destroy a licensee's claim to independent standing.

Illinois Court Reaffirms Importance of Carefully Adhering to Non-Disclosure Agreement Terms

Recently, a jury in the Northern District of Illinois sent a strong message to corporate America that abiding by non-disclosure agreements is not only important, but essential to avoid liability for trade secret misappropriation. The jury awarded $21 million, with

$8 million in punitive damages, to Roto Zip Tool Corp. ("Roto Zip") against Sears, Roebuck and Co., finding that Sears stole a power tool invention in violation of a non-disclosure agreement. *RRK Holding Co. v. Sears, Roebuck & Co., No. 04 C 3944 (N.D. Ill. Nov. 19, 2007).* The details of the case were set forth in the court's earlier opinion denying Sears's motion for summary judgment arguing that no trade secret misappropriation had occurred.

The lawsuit arose when family-owned Roto Zip, now RRK Holding Co., met with Sears to discuss a potential business deal involving a Roto Zip spiral saw converted into a plunge router. Roto Zip disclosed its combination saw design to Sears under the protection of a non-disclosure agreement. Sears ultimately passed on the manufacturing deal for Roto Zip's saw, and Roto Zip continued its development of the saw independently. However, Sears then worked with a Chinese manufacturer that designed a combined spiral saw/plunge base router similar to the Roto Zip design. Sears began selling this as the Sears Craftsman All-in-One Cutting Tool around the same time that Roto Zip began selling its combination saw. Roto Zip sued in the Northern District of Illinois, alleging trade secret misappropriation, among other claims.

The Illinois Trade Secrets Act requires that the information argued to be a trade secret be sufficiently secret to impart economic value to its owner and competitors because of its relative secrecy, and that reasonable affirmative measures have been taken to maintain the secrecy. Sears argued in its summary judgment motion that the combination saw was not a trade secret since it was within the general knowledge of the power tool industry. However, the court found that a jury could decide that although a spiral saw and a plunge base router were known and marketed as separate products, the combination into a single product was not on the market. The court pointed to the Seventh Circuit's holding that "a trade secret can exist in a combination of characteristics and components, each of which, by itself, is in the public domain, but the unified process, design and operation … is a protectable secret."

The court also found that there was a genuine issue of material fact regarding whether the saw held economic value because it was not generally known. Both Sears and Roto Zip had success in selling their combination saws, indicating economic value in the design not being public. Roto Zip also had made reasonable efforts to maintain the secrecy of its design (*e.g.*, by the non-disclosure agreement, marking drawings confidential, and using other confidentiality agreements). Further, there was a dispute between the parties about whether Sears had disclosed the design to the Chinese manufacturer. So there was a genuine issue of material fact regarding potential misappropriation.

The court ultimately denied Sears's summary judgment motion, stating that a reasonable jury could find that trade secret misappropriation occurred; and in fact, the jury did, awarding $21 million to Roto Zip.

Roto Zip also moved for summary judgment for breach of contract for the non-disclosure agreement on the same grounds as the trade secret misappropriation count. The court denied this motion for summary judgment as well, because a genuine issue of material fact existed as to whether the combination tool concept was independently developed.

To Use SPAM or Not to Use SPAM, That is the Trademark Question

In November, the Trademark Trial and Appeal Board thwarted the efforts of Hormel to prevent software maker Spam Arrest from using the word *spam* as part of its "SPAM ARREST" trademark. *Hormel Foods Corp. v. Spam Arrest, LLC*, Cancellation No. 92042134 (TTAB November 21, 2007). The Board confronted the problem that the word *spam* is a famous mark for a meat product and at the same time is also a generic word for unsolicited commercial email. Ultimately, the Board found no likelihood of confusion and no dilution because, although the marks contain an identical word, the meanings of the marks are very different in connotation and commercial impression. Until now, Hormel has successfully kept the United States trademark registry free from other spam-based trademark registrations. Spam Arrest is now the only other company to register a trademark that contains the word *spam*.

Hormel coined the term SPAM in 1937 in connection with its well-known processed meat product. Hormel actively objects to and polices others' use of the word as a trademark, but does not object to the use of *spam* to describe unsolicited commercial email.

Spam Arrest registered the mark SPAM ARREST for computer software designed to eliminate unsolicited commercial electronic mail, and disclaimed the word *spam*. Hormel moved to cancel this registration based on likelihood of confusion and dilution of its SPAM trademark.

For likelihood of confusion purposes, the parties and the Board agreed that the SPAM mark for Hormel's canned meat and related products is famous. They also agreed that *spam* is a generic word for unsolicited commercial email. Although the Board considered all of the likelihood of confusion factors, a unique analysis applied to the generic use of a word that is also a famous mark.

The Board determined that the fame of the SPAM mark entitles Hormel to broad protection, but not a monopoly on use. Specifically, SPAM's fame does not extend to computer software. The use of the word *spam* in SPAM ARREST is derived from the generic meaning, not from the famous meaning. Therefore, there is no likelihood that consumers are going to be confused into thinking that Spam Arrest computer software is related to SPAM meat product.

Hormel's dilution claim focused on dilution by blurring. To succeed on a claim of dilution, among other things, a mark must be found to be famous and distinctive. Hormel's dilution claim failed because, the well-recognized alternative meaning of *spam* diminishes the distinctiveness of SPAM. The Board found that "when a trademark has an alternative generic meaning, and it is being used in a second mark to project that generic meaning, there can be no dilution of the original mark … because that mark is not distinctive with respect to the goods which the generic term describes." In the field of email filtering, SPAM ARREST does not dilute Hormel's rights because it projects the generic meaning of *spam,* describing unsolicited commercial email. While this is good news for companies that make spam filtering software, it remains to be seen how this dilution principle will be applied to other terms that are famous for one meaning and generic for another.

The Trademark Trial and Appeal Board's decision in this cancellation action is not precedential. Given Hormel's aggressive defense of its SPAM trademark rights, Hormel will likely appeal the decision and continue its efforts to stop others from using *spam* as a part of their trademarks. Nonetheless, Hormel's failure in this cancellation action opens the door for others to use marks containing the word *spam* in connection with email filtering software. Whether or not that door gets slammed shut remains to be seen.

Canada Struggling with Copyright Reform

A very hot topic in Canada in early 2008 has been copyright reform. Many Canadian law and technology commentators suggest fearfully that Industry Minister Jim Prentice will introduce legislation that contains provisions similar to the Digital Millennium Copyright Act in the United States. One such Canadian commentator, Professor Michael Geist, observed, "U.S. Ambassador to Canada David Wilkins has been very vocal, repeatedly, if misleadingly, claiming that Canada's copyright laws are the most lax among the G7 nations." Opposed to such stronger protections, grassroots support for a "fair" approach to copyright in Canada is growing and becoming more vocal. On February 11, 2008, the president of the Canadian Association of Broadcasters, which for months had been advocating care in copyright reform, characterized the current state of debate as indicating a "breaking point" rather than a "tipping point." We will be tracking the developments in Canada closely and will report on the extent to which Canada chooses to adopt a U.S. model in its approach to copyright reform.

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