Intellectual Property and Domestic Relations: Issues to Consider When There Is an Artist, Author, Inventor, or Celebrity in the House

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INTELLECTUAL PROPERTY AND DOMESTIC RELATIONS: ISSUES TO CONSIDER WHEN THERE IS AN ARTIST, AUTHOR, INVENTOR, OR CELEBRITY IN THE FAMILY

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I. Introduction

Intellectual property is a term used to connote intangible yet legally protected products of human creativity. The three main varieties include patents, copyrights, and trademarks. A common law concept called the right of publicity is also an important intellectual property construct for individuals, and trade secret law may be important in the context of valuing businesses. Each category of intellectual property is unique and governed by an independent body of law.\(^1\) Patents, copyrights, and trademarks are all generally federal subject matter while the right of publicity and trade secrets are common law constructs, though in both contexts state statutes may also be important.\(^2\) The general theory underlying intellectual property law is that individuals will expend more time, energy, and resources in innovative, creative pursuits if the fruits of their endeavors are likely to lead to financial rewards. Giving creators limited monopolistic control over their creations is thought to enhance the potential for profitable exploitation.

This article articulates some of the special issues raised by intellectual property in the context of family-law-oriented concerns. It also necessarily explores the characteristics and properties of personal intellectual property in a broader sense. What follows is an overview of the special issues and concerns intellectual property might present in the context of divorce, estate planning, or probate. Please keep one important caveat in mind: Intellectual property has become a very dynamic area of the law. Governing federal patent, copyright, and trademark statutes are extensively amended with astounding frequency. Right of publicity and trade secret law are also constantly evolving. Legislative proposals that would significantly alter certain aspects of intellectual property law are constantly proposed and may be adopted by Congress (or by individual states) at any time. In addition, courts play a large role in delineating the scope of intellectual property protections, and the judiciary, through its role as adjudicator of intellectual property disputes, has (and will continue to have) a profound effect on the continually shifting landscape of rights, obligations, and privileges associated with intellectual property.

II. Patents
The governing Patent Act is found in title 35 of the U.S. Code. There are three types of patents: design, plant, and utility. Design patents protect ornamental components of useful objects. To qualify for a design patent, a design must be new, original, and ornamental. Because design patents are considered rather weak intellectual property protection, most people prefer to protect their designs using registered copyrights, which are much cheaper, faster, and altogether less onerous to obtain and which last much longer. Plant patents are available to inventors of new and distinct varieties of plants. When most people discuss patents, they are referring to utility patents, which will be the primary focus of the discussion below. Utility patents pertain to new and useful processes, machines, manufacturing techniques, or compositions of matter and to improvements on preexisting inventions.

A. Patent Rights

The defining characteristic of a utility patent is that it provides its owner with the exclusive rights to an idea. The idea may be very high tech and complex, or it may be quite simple and straightforward. The specific legal privilege conferred by a patent grant is the right to exclude others from making, using, offering for sale, or selling the invention in the United States or from importing the invention into the United States. A patent does not confer an affirmative right to make, use, sell, or import an invention, and patent owners are sometimes precluded from exploiting their patented inventions by laws, contractual obligations, or other adverse circumstances. Rather, the patentee owns a right to use the invention in the sense that she is the only one who can exploit the invention if indeed anyone can. As an illustration, a pharmaceutical company might patent a new drug but be unable to sell the drug until the drug's safety and efficacy are demonstrated to the U.S. Food and Drug Administration. Alternatively, the company may have previously agreed to license new drugs to another entity, making and selling the drug might infringe another patent owned by someone else, or the drug could be illegal.

Companies and sometimes individuals obtain patents to protect their ideas. A patent gives a patent owner the right to exclude others from use (or license others to use) the patented invention for a limited period of time, currently about seventeen years. This exclusivity enables a patent owner to charge monopoly prices for the invention. Competitors may be able to offer similar products or processes, but they cannot make or use a patented invention without being vulnerable to legal action by the patent owner. In theory, the monopoly prices a patent owner can charge allow the patent owner to recoup the research costs and resources that were expended when the invention was developed. Monopoly profits acquired by patent owners can also be invested in new research projects. However, not every patent generates monopoly profits. Some patented inventions are unsuccessful in the market place, and some patents are never commercially exploited at all. Because filing a patent application and advocating for the patentability of the claimed invention (that is, prosecuting a patent) can be time consuming and expensive. Most companies may not file patent applications for inventions unless they expect to either make a profit or prevent a competitor from commercially exploiting a product or process. Individual (or small) inventors will sometimes patent inventions for vanity reasons or in hopes of attracting investors.
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B. Procuring Patents

The first step in obtaining a patent, to state a fairly obvious point, is to develop a patentable invention. A patentable invention can be a product, such as a new machine to clean floors, or a process, such as an inventive method of removing impurities from water. Once an invention is operable, the inventor or anyone to whom the inventor has assigned rights can apply for a patent. A patent application must contain a full description that is adequate to teach others how to make or use the invention. Based on disclosures in the patent application, the Patent and Trademark Office (PTO) then makes a determination about whether the invention is sufficiently novel, useful, and non-obvious. In the patent context, novel means new, something that was never made or used before in public. The reason for the novelty inquiry is to ensure that no one patents a product or process that is already part of the public domain. A patent is a monopoly that must be earned. An inventor or her assignee earns a patent by publicly disclosing (in the patent application) a product or process that has never been made or used before and is thus deemed to advance scientific development for the benefit of society. The patent applicant must therefore be prepared to assert that the invention was never known or used by others in the United States before the applicant invented it and that it has never been patented or described in a printed publication in the United States or in any foreign country.

Useful means operable in the sense that the product or process achieves the result that it is supposed to. One could not patent a perpetual motion machine, for example, even if its design was highly novel unless the patent applicant could prove that the machine actually worked (a dubious prospect, at least according to current scientific understanding). At one time, patent applicants had to demonstrate some sort of beneficial usefulness for their inventions, but that is no longer required. Even if the invention is so expensive and inefficient that no rational person would ever make or use it, the invention is still eligible for a patent as long as it is capable of performing the function ascribed to it and meets the other requirements of patentability such as novelty and non-obviousness. Usefulness is mentioned in 35 U.S.C. § 101 but is not defined in the Patent Act.

The non-obvious requirement is the most difficult to describe, predict, or ascertain because it is subjective and rooted in relativism. To be deemed non-obvious, an invention must not only be new but must also reflect some degree of creativity and cleverness. A new invention that appears to be something anyone could have thought up without much effort would be considered obvious and therefore not patentable. If the invention was rather simple, like a uniquely shaped paperclip, the specific query would be whether people ordinarily skilled in the art of designing paperclips would find the new shape obvious or concede that the new paperclip shape was an unanticipated (and therefore non-obvious) advance in the art of using small pieces of metal wire to temporarily join sheets of paper. For a more sophisticated invention, the threshold question would remain the same, but the evaluative benchmark would be elevated. For a novel invention related to genetic engineering, the test of obviousness might be whether or not the invention was something that a Ph.D.-holding molecular biologist of ordinary skill might have stumbled across with little effort or imagination. Alternatively expressed, to be sufficiently non-obvious, an
invention must differ from the state of the pertinent art enough so that it would not have been obvious to a person having ordinary skill in that field. Inventions deemed obvious are said to represent mere technical tinkering or journeymen modifications of existing inventions and are not patentable. The PTO maintains an informational Web site at www.uspto.gov, which discusses its role in the patenting process in more detail.

Once the PTO determines that an invention is patent worthy, a patent is said to issue.\textsuperscript{18} The patent provides the invention owner with exclusive rights to make, use, and/or sell the invention for a set period of time. At present, a patent term lasts, by definition, for twenty years from the date that the patent application is filed.\textsuperscript{19} However, the patent is not enforceable (in other words, legal action cannot be taken against unauthorized users of the invention) until the patent issues.\textsuperscript{20} On average, it takes about three years for an application to be fully evaluated and to issue.\textsuperscript{21} n21 As a result, the monopoly created by a patent typically lasts about seventeen years.

\textit{C. Components of a Patent}

Each patent has a cover sheet, which lists the patent number, the date of issuance, the name of the inventor, and the title and provides an abstract (that is, a brief description of the invention). Following the cover sheet is a series of drawings that illustrate the invention\textsuperscript{22} n22 and a written specification. The specification has a particular format, which includes a title, an introductory paragraph disclosing any prior related patent applications, and a background of the invention, which sets forth the prior art and the purpose of the particular invention.\textsuperscript{23} Then there is a summary of the invention, a brief description of the drawings, and a detailed description of the invention. Following the detailed description of the invention are the claims, which are the most important part of the patent. The claims set forth the metes and bounds of what the government has granted to the patent owner and describe the scope of the invention and what the patent owner can prevent others from making, selling, or using. Patent claims generally use very specific language that appears stilted and difficult to comprehend to individuals who are unfamiliar with patent drafting practices and procedures. Even people familiar with an invention may have difficulty conceptualizing it from the claims. For example, the claims of a patent for a hairbrush read as follows:

\begin{quote}
    a handle portion; and a tubular brushing portion extending from said handle portion and having a plurality of longitudinal bristles projecting therefrom, at least some of said bristles being suitable elongated for penetrating through multiple layers of hair, said brushing portion having flock between said bristles for contacting the outer hair layer during movement of said bristles through said layers of hair, said flock comprising a plurality of fine filaments, each filament having a length of less than about 2.5 mm, the density of the flock being sufficient to prevent a substantial number of layers of hair from penetrating into the flock.
\end{quote}

(Excerpted from the claims of U.S. Patent No. 4486915.)

Claims that very generally describe an invention are referred to as broad claims and are used to try to construct a large scope of exclusivity. However, if claims are drafted too broadly,
they may overlap with knowledge and technology that already exists, beyond that which has been newly conceived by the patent inventor. Claims that do this are said to "read on the prior art" and are not enforceable. Narrowly constructed claims are less likely to read on the prior art, but because they carve out a more slender scope of exclusivity for a patent owner, they are usually viewed as less valuable.

D. Patent Infringement

Another entity that makes or uses a patented invention without the permission of the patent owner is an infringer. Patent owners can enforce their exclusive patent rights by asking courts for injunctive relief (typically a court order requiring the infringer to stop engaging in infringement activities), for monetary damages, and in exceptional cases, for attorney fees. Patent infringement suits tend to be very complicated and expensive. In addition to denying that she is infringing a patent, an accused infringer can attack the validity of the patent at issue. If she can convince a court that a patent is invalid, an accused infringer prevails whether its conduct was putatively infringing or not. Bringing an infringement suit therefore can put a patent at risk.

For many years, though computer hardware could clearly be patented, computer software programs were thought to be not patentable. Recently, several court decisions opened the door for computer software patents and also for patents on so-called business methods. As a result, many companies have begun patenting methods of doing business on the Internet, which may or may not implicate the computer programs these methods utilize. Whether (and how) these patents will be enforceable remains to be seen. As it has in the past, the patent law can be expected to undergo (sometimes radical) transformations in the future.

E. Patents as Personal Property

The person who comes up with an invention and figures out how to make it work is called an inventor and, in the absence of any contract to the contrary, is deemed to own the patent to her invention. An invention can have more than one inventor, but inventors must always be humans. Where there is more than one inventor, there can be joint ownership, which, in the absence of an agreement to the contrary, means each joint owner has the right to make, use or sell the invention without the consent of, and without accounting to, the other owners.

A corporation cannot claim to be an inventor, even if all of the inventors of an invention were employees of this corporation. However, most corporations require all of their employees to sign contracts called pre-invention assignment agreements, which require employee inventors to turn over the patent rights of anything they invent to the company that employs them. As a result, many inventors do not own the patents to their inventions.

Subject to the provisions of the Patent Act, patents have the attributes of personal property. As noted earlier, being a named inventor in a patent does not necessarily mean an
individual has any ownership rights (or any rights at all) with respect to the invention that the patent describes. A patent (or even a patent application) may have been sold or permanently licensed to others. Such transfers generally require a writing, a copy of which should be obtained and reviewed.

If the individual developed the invention during the course of his or her employment, rights to the invention probably belong to the individual's employer. A zealous attorney ought to confirm that the individual at issue has indeed signed an assignment agreement acceding ownership of all inventions to the employer, but it should be noted that even in the absence of a pre-invention assignment agreement, employers have been able to assert ownership of any invention developed by an employee during the course of his or her employment.

F. Valuation of Patents

In the event that a patent is an asset that is at issue in the context of divorce or probate, valuation may prove to be an enormous challenge. If the patent has been exclusively licensed to others, the royalties for the term of the license are a good starting place. However, there is always the possibility that a patent will be declared invalid, in which case the patent would immediately lose all of its monetary value. Of course, a patent is generally of no value once it expires, though at least the date of expiration is usually ascertainable and predictable.

If a patent is licensed on a nonexclusive basis, again, license royalties are a starting place for valuation purposes if careful attention is paid to the terms of these licenses. There is always the possibility that a patent can increase in value if additional nonexclusive licenses are issued, and, of course, there is always the risk that a patent could be declared invalid before the end of its term.

A patent that has not yet been commercially exploited is very difficult to accurately appraise and value, even by professionals who are skilled in the appropriate area of technology, because so many variables can affect the mercantile success of an invention. A patent poses all of the difficulties of the valuation of unique property with the added complication of intangibility and the added risk that it could disappear (by losing a validity challenge) at any time before expiration.

Other general factors that might be important to valuation include debts and expenses incurred in developing or marketing an invention, debts and expenses incurred to secure a patent or patents to the invention, any characterization or valuation of the patent by a party in another context (such as to secure financing), and whether personal services are a requirement for obtaining patent royalties.

III. Copyrights

A. Overview and Definitions
Copyright protection is available for original literary, dramatic, musical, artistic, and certain other intellectual works, both published and unpublished, including compilations of facts or preexisting works. Copyright law sets out the rights and responsibilities of copyright owners, who are individuals or entities that own intellectual property rights in various forms of creative expression. Copyright law in the United States is based on the Copyright Act, a federal statute found in title 17 of the U.S. Code.

In the context of copyright law, creators of copyrightable works (that is, works of authorship) are called authors. This is perhaps unremarkable when the creative work is a best-selling novel but somewhat counter-intuitive when the copyrightable work is a song, photograph, dramatic play, or painting since the originators of these sorts of works are popularly referred to as songwriters, photographers, playwrights, and painters. In any event, the human author of a copyrightable work is also the owner of copyright in the work unless the author has contracted otherwise, with one significant exception: If the creator of a copyrightable work is an employee, then the creator's employer may be deemed the author (and therefore the owner) of the pertinent copyright through operation of the work-for-hire doctrine.

Prior to March 1, 1989, obtaining an enforceable copyright in a creative work required compliance with certain formalities. However, since the United States amended the Copyright Act to become a signatory to the Berne Convention (an international treaty on copyright issues), copyrights became self-executing, vesting automatically in a copyrightable work upon the work's creation. There are still good reasons to formally register a copyright, and registration is strongly recommended for any copyrighted work that will be commercially exploited. Nevertheless, a copyrightable work is in fact copyrighted the moment it is created and fixed in a tangible medium of expression. Registration can be obtained any time during the term of a copyright in most cases.

Domestic copyright owners are required to register their copyrights with the U.S. Copyright Office prior to filing an infringement suit, but there is no requirement that registration occur prior to the alleged acts of infringement. However, statutory damages (as opposed to actual damages) and attorney fees are available to a copyright owner who prevails in an infringement suit only when the copyright at issue has been registered prior to the infringing activities. Statutory damages are monetary awards that a court can make to a copyright owner who proves her copyright has been infringed but has difficulty sufficiently assigning accurate or specifically quantifiable monetary losses to proven acts of infringement to support an award of actual damages.

Copyright protection encompasses the expression of a concept rather than the concept itself. To ascertain what elements of a work are protected, it is necessary to cognitively separate creative expression from the underlying idea that is expressed. The following is an illustration of this:
Two male police officers with very different backgrounds are forced to work together against their wishes. One is a bit of a screw up, with an unconventional approach to police work; the other does everything by the book. A gang of larcenous or terrorist criminals places large numbers of citizens in danger, including the girlfriend or family members of at least one of the partners. Working together in the face of adversity, the two cops come to respect and trust each other. Shots fire, cars crash, and buildings blow up, but eventually the criminals are brought to justice although one may escape to provide fodder for a sequel.

There are probably dozens of movies that follow this outline to some degree. The idea of a cop buddy movie is neither copyrightable, nor represents a monopoly at the level of abstraction outlined above. The unique creative elements of each individual cop buddy movie, however, such as the names, idiosyncrasies, and exact personal situations of each of the characters, the specific details of the criminal conspiracy, and the means by which it is thwarted constitute protected expression.

In the visual context, the idea/expression dichotomy can be illustrated as follows: A photographer may take a photograph of a mountain, turn the photo into a poster, and sell thousands of copies. She has a copyright on her photograph, which no one can copy without infringing her copyright unless she gives then permission to do so. However, she cannot use her copyright to prevent someone else from taking an independent photograph of the same mountain and making and selling competing posters featuring an alternate, competing photograph. Each photographer has a copyright on his or her own photographic work, but neither has any exclusive rights pertaining to the mountain itself, and neither can prevent the other from exploiting photographs of the mountain, even if photographs are similar (which they are bound to be, given that they depict the same subject).

Copyright laws protect creative expression only, and do not, as a matter of doctrine, provide exclusive rights with respect to facts or information. However, works compromised of facts are copyrightable. As an illustration, a newspaper story consisting exclusively of factual information is protected by copyright and cannot be copied without permission. However, all of the facts contained within the story can be extracted from the article and re-expressed by an independent party without permission and without infringing the copyright in the original story. The copyright protects the expression of the facts (such as word choices and the structure and tone of the piece), but the facts themselves are in the public domain and can be freely used by others. Biographies and histories can be copyrighted, but copyrights do not give anyone the exclusive right to the factual information contained therein. However, sometimes it is so difficult to separate information from expression, any use of information contained in copyrighted works carries with it the risk of being accused of copyright infringement. For this reason, some observers believe that aggressive protection of copyrights, particularly in informational works, effectively hinders the communication of facts and ideas. In a few notable cases, individuals have used copyright protection as a mechanism for severely limiting the use that others can make of their letters and personal papers.
A copyright owner has a range of exclusive rights with respect to the copyrighted work, including the right to reproduce the work, to distribute copies of the work, to perform or display the work publicly, and to make derivative works based upon the copyrighted work. The copyright owner can choose to exercise these exclusive rights herself, to license some or all of these rights to others, or to transfer ownership of an entire copyright altogether. Effective transfers of copyrights require written instruments and should be recorded with the Copyright Office.

Two people can work together on a single copyrightable work and still maintain separate copyrights. For example, one person could write the lyrics to a song while another individual composed the music, and each would own a copyright in the portion of the song they author. However, if two or more people prepare a work "with the intent that their contributions be merged into inseparable or interdependent parts of a unitary whole," the work is characterized as a joint work. Each joint author owns an undivided ownership interest in the joint work and may independently exercise the exclusive rights associated with a copyright subject to an accounting of profits to the other joint author(s).

B. Scope of Copyright Protections

Copyright protection does not provide an absolute monopoly. Even if a work is fact-free and comprised entirely of creative expression, sometimes the work (or at least small portions of the work) can still be used by others without the copyright owner's permission but without constituting an act of copyright infringement. This is because of the doctrine of fair use, which is explicit in copyright law. One can make fair use of someone else's copyrighted work if the use is scholarly, or for purposes of news reporting or criticism or for many other reasons as long as the use is deemed fair and reasonable, given the applicable circumstances. Whether or not an unauthorized use is a fair one (and therefore neither infringing nor monetarily compensable) is a subjective determination that is made by a court after the use has been made and after an infringement suit has been brought against the user by the copyright owner. As a result, fair use can be a very expensive right to assert, even if the user prevails.

For many years, computer programs could not be patented, and by default, copyrights were used to provide intellectual property protection for computer programs. Copyright legislation, originally and primarily intended for creative works, is not easily adapted to computer software, which leaves some uncertainty about how to define the scope of copyright protection in these works. Often, entities that develop or license computer software will try to imbue their computer source code with both patent and copyright-based protections.

Copyright is also the primary type of intellectual property protection that is currently available for databases. While an individual datum is information and therefore not copyrightable, compilations of data can be protected by copyright if the data have been selected, compiled, or arranged with some small amount of originality or creativity. Copyright protection is available for maps and guides and directories, but the scope of the copyright is narrow and does not extend
to the information embedded in these works. Entities have successfully asserted copyrights in
database documents such as customer lists, but uncertainties about the scope of copyright
protection has led many companies that own or license databases and other information products
or services to lobby the U.S. government for stand-alone intellectual property protection for
databases that is not bound by the copyright law and not subject to its limitations.62

C. Copyright Infringement

Unauthorized use of another's copyrighted work, particularly if it is large scale or
commercial use, is likely to be deemed a copyright infringement.63 Copyright owners can bring
successful infringement suits not only when their works are overtly, identically copied but also
when enough protected elements are appropriated from the copyrighted work such that an
accused work can be deemed substantially similar. Available remedies for copyright
infringement include injunctive relief, actual damages and profits, and statutory damages.64

The capabilities of the Internet to spread copyrighted works of any variety throughout the
world are extensive and unparalleled. Cyberspace poses benefits to copyright owners because it
offers wide exposure and broad distribution capabilities for copyrighted works. However, it also
poses dangers such as the risk that a copyrighted work will be copied without permission and then
extensively dispersed, ruining the market for the work and making it impossible for the copyright
owner to profit from the work or even recoup investment costs. In the fall of 1998, the U.S.
Congress passed (and President Clinton signed into law) the Digital Millennium Copyright Act
(DMCA).65 This legislation is intended to discourage the unauthorized use and copying of
copyrighted intellectual property in cyberspace. Some commentators believe that the DMCA will
courage the creating of new copyrighted works by reducing the risks of online infringement.66
Others are concerned that it restricts the free flow of information, which will hamper creativity
and protect currently existing copyrighted works at the expense of new works that now will never
be originated.67

D. Duration of Copyrights

The length of the term of copyright protection has been extended in recent years and, for
works created after January 1, 1978, lasts the entire life of the author plus an additional seventy
years.68 Where an employer rather than a person is the author of a copyrighted work, copyright
protection lasts ninety-five years from the date of publication of the work, or 120 years from its
date of creation, whichever time period is shorter.69 This means that ownership interests in
copyrights can be issues of concern for several generations of family members. The Copyright
Act specifically states that "the ownership of a copyright may be transferred in whole or in part by
any means of conveyance or by operation of law, and may be bequeathed by will or pass as
personal property by the applicable laws of intestate succession."70 The various exclusive rights a
copyright represents are divisible as well.71

Works published prior to January 1, 1978 (the effective date of the Copyright Act of
1976), are still subject to certain laws originally promulgated in the Copyright Act of 1909. The
specifics for determining exact expiration dates are set out in sections 303 and 304 of the
Copyright Act. Whether a work has ever been published has an impact on copyright duration as
does the date of the first publication (if any) since copyright protection was previously keyed to
publication rather than creation of a work. 72

E. Derivative Works

A derivative work is one that is based upon a preexisting work: Examples include
translations, musical arrangements, dramatizations, and fictionalizations.73 When a novel is
turned into a screenplay, the screenplay is a derivative work. If authorized by the owner of the
copyright in the novel, the screenplay can be copyrighted in its own right.74

F. Intangible Copyrights v. Material Objects

One concept that can be difficult for copyright authors or their heirs to understand is the
difference between ownership of a copyright and ownership of the material object(s) embodying
the copyright.75 The author of a novel who retains ownership of the copyright in the novel may
own her words in some sense, but she has no claim to the printed books containing her novel that
have been legitimately acquired by others. Purchasers may not photocopy the novel without
authorization, but they are free to keep, sell, or even destroy copies of the novel they have
purchased or been given.76

G. Special Considerations for Certain Works
of Fine Art

1. RETAINING COPIES OF ARTWORKS

The analysis increases in complexity when works of fine art are involved. A painter or
sculptor may sell one-of-a-kind pieces they have created but still retain ownership of the
copyrights in these works. This means that the purchaser of a painting cannot make reproductions
(prints, posters, etc.) of the painting without authorization by the copyright owner, and the painter
is the copyright owner unless she has transferred ownership via a written instrument (excepting
the somewhat unusual situation in which the painting was a work for hire, in which case the
employer is both author and owner of the copyright).77 The other side of the coin, however, is
that a painter or a painter’s copyright heirs may have a hard time commercially exploiting the
copyright in the painting if they do not have entree to the painting itself, which a bona fide
purchaser is not required to provide.78 If the artist has not recorded images of the painting in
some way before she loses possession and ownership, she (or her heirs) will have to negotiate
with owners of the actual material works to obtain access to the work if access is necessary to
benefit from the copyright. Similarly, sculptors that do not retain molds or maquettes of their
works may effectively lose the practical ability to exploit copyrights that they legally retain. The
same issues are likely to arise with any unique copyrightable works that are not easily
reproduced.
2. MORAL RIGHTS

Though a right of access is not among them, copyrights in certain works of fine art provide authors with certain moral rights that are not generally a part of copyright protections. If a work fits the Copyright Act definition of a work of visual art (for example, a painting, drawing, print, still photographic image, or sculpture existing in a single copy or in a limited edition of 200 or fewer that are signed and consecutively numbered by the author), the author of the work has a right of attribution of authorship and a right of integrity of the works, which requires owners of the works to abstain from modifying, damaging, or destroying them. An author may waive her moral rights, but moral rights in a work of visual art are not transferable and endure for the life of the author only.

3. STATE LAWS

There are also some state law-based rights and privileges available to authors of fine artistic works. For example, California provides artists with a percentage of the resale price of their works, and New York has legislation that assists in the recovery of stolen art works.

H. Valuation

As with patents, valuation of a copyright for divorce or probate may be difficult and uncertain and usually requires the assistance of an expert from the appropriate field. The long term value of a previously unexploited copyrighted work is exceptionally difficult to predict. A novel rejected by every mainstream publisher could ultimately win a Pulitzer Prize, but a seemingly attractive photograph may not have any monetary worth whatsoever.

A copyright that is the subject of an exclusive license may generate easily calculable royalties during the term of the license, but the license may expire or can be terminated well before the end of the copyright term, posing valuation complexities for the unlicensed interval. Copyrights that are nonexclusively licensed provide some clues to their pecuniary merit based on past royalty-generating performances, but valuing them is still fraught with uncertainties because of the likelihood of changing societal tastes and desires throughout the lengthy duration of a typical copyright. A copyrighted song, for example, may sell many records, fade to obscurity, and then re-emerge more popular than ever decades later on a trajectory impossible to accurately predict or easily plan for.

I. Termination and Recapture of Copyrights

1. LICENSES AND TRANSFERS OF COPYRIGHTS EXECUTED AFTER JANUARY 1, 1978

The copyright laws provide an escape valve for copyright authors who have sold or licensed away their copyrights before the full value of the works became apparent unless the work was a work
made for hire. Copyright authors have an unwaiveable right to terminate copyright licenses and transfers during a five-year window between the thirty-fifth and fortieth years from the date of execution of the grant.

Under section 203(a)(5) of the Copyright Act, termination interests in licenses and transfers of copyrights executed after January 1, 1978, will begin to vest in 2003 (for grants made in 1978) and the first wave of actual terminations under this statutory provision can be expected to occur in 2013. A termination requires affirmative acts by the copyright author as dictated by both the copyright statute and the Register of Copyrights, and if appropriate action is not taken during the mandated temporal interval, the author will lose the ability to recapture the copyright that had been granted as a matter of right. A properly effectuated termination restores ownership of a copyright to the author or her statutory heirs. The termination is sometimes characterized as "contract bumping" since it can be used by an author to extricate her copyright from almost any assignment or licensing agreement, regardless of its terms: Not even a specific, well compensated agreement by an author to forgo the termination right is binding on her. After the termination becomes effective an author is then free to commercially exploit the copyright herself or to license or transfer it to others. Sometimes the most lucrative option is to reassign or re-license the copyright (on more favorable terms) to the entity from which a termination has just been obtained. The picture is complicated somewhat when a work has two or more authors.

If an author dies prior to vesting of her termination rights, the Copyright Act specifies that termination interests are owned by the author's widow or widower, children, and grandchildren if there are any, and executors, administrators, or trustees if there are not. A careful parsing of the statute is necessary to correctly apportion termination interests among the proper parties. Where there is more than one statutory heir, the termination interest is divided and apportioned among the statutory heirs by the statute, with ownership of half of the termination interest given to a surviving spouse (if any) and the remaining interest divided among children and grandchildren born of deceased children (on a per stirpes basis).

To effectuate termination of a grant executed by one author, assent by persons "entitled to exercise a total of more than one-half of that author's termination interest" is required. Once copyrights are recaptured through termination, promulgating new licenses or assignments of the work necessitates consent by the same number and proportion of copyright interest owners as were required to terminate the grant.

An author cannot quantitatively redistribute termination interests among her statutory heirs; she is barred by the statutory allocation schema. If there are living children or grandchildren, the author's widow is given a half interest, no more and no less, and the remaining votes are distributed per stirpes among children and grandchildren. Where there are only two statutory heirs (for example, a widower and child or two children), each can frustrate the other's wishes. Where there are three or more statutory heirs, one child (or the majority of a deceased child's children) must agree with the father (or stepfather) for a termination to go forward and also to re-license or reassign the copyright once a termination has been effectuated.
This interest allocation framework could encourage strategic behavior and gamesmanship on the part of the statutory heirs for either emotional or financial reasons.

The requirement that each deceased child's interest be voted by a majority of that child's children can lead to another peculiar twist: A termination or reassignment can potentially be either effected or blocked by less than fifty percent of the apportioned copyright interests. For example, if the author is deceased and her four children, A, B, C and D are deceased, and each child had four children of her own, each grandchild owns a one sixteenth interest in the copyrights author left behind. If just two of B's children and two of C's children refuse to sign on to a termination or reassignment, then both B's and C's entire interests are "no" votes, and there can be no majority vote sufficient to effect a valid termination or reassignment, even though twelve out of sixteen interest holders might approve of such action.

The only type of copyright transfer that cannot be terminated by the author's statutory heirs\textsuperscript{101} is one that a late author executed by will.\textsuperscript{102} Thus, if in her will an author designates outsiders as beneficiaries of copyrights she owns, neither her widower and children nor her executor can use termination rights to undo such a bequest. All other post January 1, 1978, transfers, however, are subject to termination rights vested in an author's statutorily specified relatives or executors\textsuperscript{103} pursuant to congressional intentions to keep some portion of the fruits of creative works within authors' families.

As with so many aspects of copyright law, this framework leads to some perhaps counterintuitive outcomes. Oddly, the timing of an author's death plays a large role in determining how much testamentary freedom an author has. If an author lives long enough to exercise (or decline to exercise) termination rights in a copyright, she can dispose of her copyright interests however she chooses. However, if she dies before termination rights vest,\textsuperscript{104} her licenses, assignments, gifts, and even certain attempted bequests can be thwarted or undone by her statutory heirs. Consider the following:

- If an author owns all her copyrights and makes an \textit{inter vivos} gift of them to a friend or charitable institution, and then passes away, her statutory heirs can terminate this gift and take ownership of the copyrights during the five-year termination window. Had the author held on to her copyrights during her lifetime but left them to a friend or charity in her will, the statutory heirs could not undo the gift.

- If an author permanently licenses or assigns some of the exclusive rights bestowed by a copyright to Corporation X but retains other exclusive rights and attempts to bequeath "all my copyright interests" to a friend or charity, after her death only the rights the author retained will pass to the intended beneficiary. Rights that are licensed or assigned to Corporation X will remain that way unless and until statutory heirs exercise termination rights. After terminating the assignment or license, the statutory heirs will own whatever rights Corporation X once did rather than the friend or charity the author may have hoped would be the beneficiary.
If an author assigns her entire copyright to Corporation X and then writes a will leaving a friend or charity "all my copyright interests," she has probably not bequeathed the friend or charity anything whatsoever. The author's termination interest is contingent upon her living long enough to exercise it. She cannot assign the termination interest to anyone, nor waive it before it vests. At the author's death, she does not own any copyright interests, and nothing therefore passes to the intended beneficiaries. During the termination window, the author's statutory heirs can still exercise termination rights and take ownership of the copyright despite the will provision.

If an author does not have a widow, widower, or surviving children or grandchildren, the author's executor, administrator, personal representative, or trustee inherits the author's termination interest. Presumably, an executor, administrator, personal representative, or trustee would exercise termination rights on behalf of beneficiaries to an author's will. An executor could terminate any copyright transfers and then convey ownership of the copyrights in accordance with the author's wishes. As a result, an author who dies without a surviving spouse, children, or grandchildren can, as a practical matter, bequeath her termination interest to a friend or charity (the executor exercises termination rights and the friend or charity receives the termination interest). An author who leaves behind section 203(a)(2)(A) or (B) statutory heirs (widow, widower, children, or grandchildren), however, cannot. Only copyright interests that the author owns outright at her death can be bequeathed free of any fear of termination.

One important limitation on the scope of copyright reversion rights is the derivative works exception. Authorized derivative works (for example, a movie based on a book or, for that matter, a book based on a movie) can lawfully be exploited by their owners even if the grants under which they were created are terminated.

2. LICENSES AND TRANSFERS OF COPYRIGHTS EXECUTED PRIOR TO JANUARY 1, 1978

a. Termination Rights

Licenses and transfers executed after January 1, 1978, are subject to termination rights as articulated above. However, termination rights with respect to licenses and transfers executed before January 1, 1978, can be exercised fifty-six years after the work was copyrighted and remain available for five years. These termination rights, effective against all licenses and transfers, except those effectuated by an author's will, also pass to the author's statutory heirs upon the author's death in shares dictated by the copyright statute, and effecting a termination requires participation by statutory heirs who own more than half of the termination interest. Works with two or more authors pose special challenges.
The same testamentary restraints pertaining to transfers executed after January 1, 1978, apply here: An author can effectively pass copyright interests she owns to anyone by will, but she cannot strip her statutory heirs of termination rights or alter the size of the interest that vests in any particular statutory heir. As a result, any inter vivos license or assignment (even a donative assignment) that an author makes can be terminated by her statutory heirs if she does not live long enough to exercise or ignore termination rights on her own, and contracts entered into by the author cannot be terminated by anyone other than a statutory heir, regardless of the author's wishes. As one court stated in the context of a termination dispute,

Section 304(c) is not necessarily a provision for the effectuation of the author's "intent." If the author's intent were the paramount concern of the statute, then no termination of any kind would be allowed because most authors presumably "intend" to make the assignment that is the very object of Section 304(c)'s termination provisions. Thus, there is a limit on the weight that courts should attach to the author's subjective desires, and it is in this sense that the "otherwise than by will" language should be understood. Granting supremacy to the author's intent as against the rights of the widow and children would obviate the reason that Section 304(c) is in the Copyright Act to begin with and distort the deliberate legislative choice made by Congress unless the grant of copyright renewals was made by will in the first instance.

Copyrighted works too old to allow an author or her statutory heirs to take advantage of the five-year termination window that begins in the fifty-sixth year of copyright protection may under some circumstances accrue an additional five-year termination period seventy-five years from the date the copyright was originally secured. In either event, it is important to pay attention to when termination rights vest. Notice of termination can be served upon a copyright grantee up to ten years before the start of the termination window. Once notice is served, termination rights vest, and an author can dispose of the reverting interests free of unwanted interference by statutory heirs. In addition, under section 304(c)(1), on transfers and licenses executed by persons other than the author, covering the extended renewal term, can be terminated.

b. The Derivative Works Exception

The scope and potential value of termination rights will in some cases be limited by the derivative works exception. While a license holder may, after termination, lose the ability to create additional derivative works based on the copyright at issue if her license is terminated, she could continue to exploit the derivative works she had created pursuant to the license when it was in effect.

c. Renewal Rights

Copyrights in works created on or after January 1, 1978, have a unitary copyright term designated according to the category of the work. The duration is simply life of the author plus
seventy years (unless it is a joint work, anonymous work, a work made for hire, etc.) However, the durations of works created prior to January 1, 1978, are calculated differently. Works copyrighted prior to January 1, 1978, have a first term of copyright that subsists for twenty-eight years and a renewal term that lasts sixty-seven years. Renewal is now automatic in the sense that no action is required to ensure that a copyright in this category lasts a total of ninety-five years. However, eligible parties who register a claim for renewal obtain some benefits.

The most important benefit involves grants for derivative works made during the original term of copyright: "If a timely renewal is filed, the author's first-term grants of renewal rights to exploit such derivative works are nullified if the author dies before the renewal term. . . . If no registration is filed, a derivative work made pursuant to the grant can still be exploited [by the grantee] during the renewal term, but no new derivative work can be made after the new term begins." Other incentives include the opportunity to lock in an early vesting date, the evidentiary weight accorded the registration, and the scope of remedies available in a copyright infringement case. The renewal process can function similarly to termination rights: An author retakes ownership of a copyright at the start of the renewal term, even if the copyright has been licensed or assigned, as long as the author has not specifically licensed or assigned rights to the renewal term. General assignments of copyright by an author do not assign rights in the renewal term, but a specific agreement to assign rights in the renewal term is enforceable against an author. However, if the author dies during the first term of copyright, upon renewal, the author's statutory heirs retake ownership of the copyright regardless of any agreement by the author to assign renewal rights. This means that if an author dies during the first term of copyright, her statutory heirs can take ownership of the copyright for the renewal term, license or assign the copyrights through the renewal term, and then exercise termination rights at the appropriate time to retake ownership of the copyrights again. One possible wrinkle is that some entities required an author's spouse to assign his/her contingent renewal expectancies as a condition of assignment, and this type of assignment is also generally enforceable.

In De Sylva v. Ballentine, the Supreme Court ruled that illegitimate children were "children for the purposes of the renewal provision." In a 1975 district court case, the court rejected an argument that a remarried widow was not a widow within the meaning of the renewal provision, finding that Congress had not shown any limiting intent with regard to the term widow.

Ownership of the renewal term of one of the works of William Saroyan was disputed after he willed "all copyrights, rights to copyright, and literary property in published or unpublished work" to the William Saroyan Foundation (a trust charged with disbursing the income from his writings to charitable and educational activities). After expiration of the original twenty-eight-year term, Sayoyan's children, Lucy and Aram, renewed the copyright in the work (The Cave Dwellers) in their names, but this was challenged by the foundation. The foundation unsuccessfully asserted that the alleged estrangement of the children from their father foreclosed their claim to the renewal term as children within the meaning of the term used in the copyright
renewal provision. The court held that there was nothing in the language and structure of section 304(a) to provide a basis for denying rights to an author's surviving children and that the statutory provision required non-discretionary uniform treatment of them.141

Just as with termination rights, an author who dies during the first term of copyright can neither contract away nor will (or bequest) away her statutory survivors' rights to the renewal term of a copyright.142 As one commentator observed,

If the author lives to renew a particular work and dies in the work's renewal term, his will governs rights during the rest of the work's copyright life. However, if he dies during the work's first term, his will governs only for the balance of the first term. By renewing the copyright for themselves, the members of the statutory successor class, who enjoy a higher priority to renew than a mere testamentary devisee, succeed in their own right to ownership of the copyright.143

For estate planners, all works copyrighted before January 1, 1978, will be in their renewal terms by the end of the year 2005, so this is one testamentary problem posed by copyright law that will disappear in time.144

III. The Copyrights as Community Property
Controversy

The royalties and profits generated by copyrights during a marriage are clearly marital property, but ownership of the copyrights themselves is a bit murkier. In an infamous 1987 California case, Worth v. Worth, copyrights themselves were held to be community property.145 This case was harshly criticized by commentators who asserted that provisions in the federal Copyright Act, which vests sole ownership of copyrights in authors, preempted state community property laws.146 In a 1999 Louisiana case, Rodrigue v. Rodrigue, a district court contrarily concluded that copyrights were not community property and could not be deemed community property without improperly burdening copyright alienability.147 This decision was overruled by the Fifth Circuit, which held that spouses of authors could indeed retain sole management and control of their copyrights but could not deprive a non-author spouse of the "tangible benefits" of the copyrights.148 The court announced an allocation of the attributes of copyright ownership as follows:

The author-spouse alone holds the elements of usus and abusus—a combination that compromises the exclusive rights to posses, use, transfer, alienate, and encumber the copyright as he sees fit—free of any management, consent, or participation of the non-author spouse. . . . But the community during its existence (and the former spouses or other successors after its termination) holds the element of fructus, i.e., the right to receive and enjoy the economic benefits produced by or derived from the copyright. The exclusive right of the author-spouse to the abusus of the copyright, like that of the naked owner of property burdened by a usufruct, is nevertheless subject to the continuing fructus rights of the community so long as the copyright remains vested in the author-spouse, unless partition should modify the situation.149
The court expressly left for another day the question of whether the author-spouse had a fiduciary duty to the non-author spouse that would impact the manner in which the author-spouse could exercise and administer the copyrights in his paintings. One commentator characterized the holding as follows:

In *Rodrigue v. Rodrigue*, the Fifth Circuit concluded that no conflict exists between federal copyright law and state community property law relating to the vesting of copyright ownership, and thus, copyrights do not vest solely in authors domiciled in community property jurisdictions. To reach this conclusion, the court constructed a curious new regime for the vesting of ownership of federal copyrights. Under this regime . . . ownership of copyrights in community-property jurisdictions will be dismembered and divided, with the spouses jointly receiving the right to all "fruits" of copyrighted works and the author-spouse receiving the residual rights to "use" and to "alienate" his copyrights. Perhaps most surprisingly, a non-author spouse now may be able to compel an author-spouse to, among other things, create and distribute new works based on community copyrights if a "prudent administrator" would do so.

Controversy over how to characterize copyrights for divorce purposes will probably continue, and related questions will undoubtedly arise in the equitable distribution context.

**IV. Trademarks**

*A. Overview and Definitions*

A trademark is a word, short phrase, symbol, picture, design, or other feature that is used in trade in conjunction with specific goods to indicate the source of the goods and distinguish them from the commercial offerings of competitors. Trademark law in the United States is based on the Lanham Act, a federal statute in title 15 of the U.S. Code. Though often referred to as a form of intellectual property, trademarks are more accurately described as intangible commercial property. Trademarks need not be creative or useful in and of themselves except to the extent that they perform a source identifying function with respect to goods in commerce. Marks that identify the source of services (such as the name of a travel agency or dry cleaner) are most correctly denominated service marks but are treated virtually identically to trademarks as a matter of law. Trademarks usually appear on a product or on product packaging while service marks appear in promotional material for services. However, service marks are commonly incorporated within the general trademark rubric, and therefore *trademark* or *mark* will be used to denote both trademarks and service marks in this discussion, in conformity with common practice.

Trademarks can be owned, and may be federally registered by individuals, partnerships, corporations, or other organizations. Anyone who claims rights in a mark may telegraph this to the public by using the TM (trademark) or SM (service mark) designation, regardless of whether the mark is registered. The registration symbol ((R)) may only be used when the mark is federally registered.
B. Trademark Rights

Trademark owners have the right and ability under trademark law to prevent others from using confusingly similar marks. However, trademark rights do not provide any right of exclusivity with respect to the underlying products and services that are identified by the marks. Trademarks do not protect the outcomes of creative undertakings and are thus never substitutes for or alternatives to copyrights or patents. However, copyrightable or patentable designs that serve commercial source-identifying functions can be registered as trademarks or can serve as protected trade dress.

Though popularly referred to as a form of intellectual property, there is very little that is intellectual about trademarks in the sense that protected marks do not need to reflect any effort, uniqueness, or creativity whatsoever. Patent owners receive a finite term of monopolistic control over their inventions to reward them for inventing (or investing in the invention) of new, useful, and non-obvious products and processes and making the technology behind the inventions available to the public. Copyright owners also receive a finite term of monopolistic control over copyrighted works, though, of course, a copyright is enforceable far longer than a patent, and the nature of a copyright monopoly is somewhat different and narrower than the exclusivity conferred by a patent. Copyright owners are given their bundle of exclusive rights to reward them for creating original works of authorship. By contrast, trademark owners can assert and retain ownership of their marks in perpetuity (as long as they remain in commercial use) and are not even theoretically obliged to provide anything creative, unique, or of value to the public.

Part of the original justification for recognizing enforceable rights in trademarks was the idea that trademarks would protect consumers by performing source identifying functions. Because the Coca-Cola Company is the only entity allowed to use the Coca-Cola name and logo in commerce, consumers can be confident that when they buy a beverage bearing Coca-Cola marks, it will comport with Coca-Cola Company standards (whatever they are perceived to be) and that they can locate and contact the responsible party if they had questions about or experienced problems with a product or service associated with the Coca-Cola Company mark.

Companies also benefit from trademark protection to the extent that they enjoy a good reputation with consumers. Corporate interests often view protected trademarks as one mechanism for ensuring that they receive the full benefits of their investments in producing quality goods and services. Trademark protection also strengthens the ability of commercial advertising to promote brand identification. Sometimes effective advertisements will even substitute for investments in quality: Research has demonstrated that consumers often prefer one brand of a product over another (even though the underlying products are identical) based on their subjective feelings about a trademark.

C. Obtaining and Registering Trademarks
Trademark rights are obtained by either using the mark in commerce (and perhaps subsequently registering the mark with the PTO) or by filing an application to register the mark with the PTO and asserting (in the application) a bona fide intention to use the mark in commerce. Federal registration is not required to begin use of a mark, nor is it necessary to acquire rights in a mark, but it provides trademark owners with a host of significant advantages. Holders of federally registered marks are the presumptive owners of the marks on a nationwide basis and can use the machinery of the federal court system to defend their trademark rights. The term of a federal trademark registration is ten years with the ability to renew for a potentially unlimited number of subsequent ten-year terms. A United States trademark registration does not have extraterritorial effect, and if the owner of a mark wants to protect the mark abroad, she must seek available protection in each country separately under the relevant laws.

Most applicants search for conflicting marks prior to applying for trademark registration by either combing through a PTO public search library or hiring a private trademark search company or an attorney who deals with trademark law to perform the research. If search results indicate that someone else owns a similar or identical mark, an applicant has to make a decision about whether to proceed with the application or whether to adopt a different mark altogether if this is commercially feasible. The PTO will do its own search for similar or identical marks. Where there is a potential conflict between two marks, the PTO makes a necessarily subjective determination about whether the similarities between the marks would likely cause consumers to associate the goods or services of one mark holder with those of the other. If the PTO decides that confusion is likely, it can deny the application. It can also refuse to register a mark it perceives to be immoral or scandalous or otherwise in conflict with Lanham Act provisions.

Sometimes, the owner of one mark will challenge the ability of another entity to obtain (or maintain) registration for a similar mark. This challenge is called an opposition and will usually be resolved by a determination about the likelihood that consumers will be confused. Marks that are virtually identical may not be deemed confusing to consumers if the goods or services they identify are very different. This is how the Dell Publishing Corporation, which makes Dell books, and the Dell Computer Corporation, which makes Dell computers, can both assert trademark rights in the word Dell, and Apple Records can coexist with Apple Computers. However, if the goods or services represented are the same or comparable, similarity between the marks may be enough for the PTO to determine that consumer confusion would be likely. For this reason, the PTO is unlikely to award federal trademark registration to a McDonald's hamburger restaurant competitor that wants to register the word McDonald or even MacDonald in any food-related context. In fact, the McDonald's mark has been deemed so strong that even nonfood-related uses may be problematic. For example, the use by a chain of inexpensive motels of the name McSleep was held to infringe McDonald's trademark, even though the McDonald's Corporation was not in the motel business.

D. Trademark Infringement
Accusations of trademark infringement are generally made when one entity makes use of a mark that is the same or similar to a mark that is owned by another. If the competitor uses an intentionally confusing mark, such as putting a tan Levy's label on a pair of blue jeans to fool consumers, the Levy's Jeans maker is likely to be accused of trying to pass off its products as the goods of Levi Strauss & Co. and of trading on the Levi's trademark. If a competitor makes unauthorized use of another's exact trademark, such as by putting the Microsoft logo on boxes of computer programs that were not manufactured or licensed by the software giant, that rival may be accused of criminal counterfeiting as well as trademark infringement.

E. Trademark Dilution

Holders of famous federally registered trademarks can also assert a statutory right to prevent others from diluting their marks. Dilution means "the lessening of the capacity of a famous mark to identify and distinguish goods and services, regardless of the presence or absence of competition between the owner of the famous mark and other parties, or the likelihood of confusion, mistake, or deception." Trademark dilution is use of a mark by an unauthorized entity that does not fit traditional notions of infringing conduct because there is little risk that consumers will be confused or mislead by the use. For example, consumers viewing a blue bicycle bearing the word Kodak in silver might not assume that the bicycle was manufactured by the Eastman Kodak Company, which is famous for producing cameras and film and recognized by its yellow and red K logos and packaging. However, the Eastman Kodak Company could argue that unauthorized use of the word Kodak by the bicycle manufacturer diluted the mark, undermining the mark's uniqueness and unfairly usurping the goodwill associated with the mark that the Eastman Kodak Company had worked hard to generate. The right to enjoin trademark dilution is a fairly recent development because it was codified in the federal trademark statute in 1996.

By giving famous mark owners the ability to prevent dilution, some critics assert that these mark holders are given improperly expansive property rights in words and symbols. Customarily, a mark could not be registered unless it was in use or the registration applicant asserted an intention to begin using the mark in commerce shortly. Under anti-dilution principles, mark owners gain the ability to reserve marks for a wide variety of future uses, even if they have no intention of ever utilizing the marks in alternative ways. For example, the General Motors Corporation may have no interest in making or marketing Chevrolet ice cream but can bring a trademark dilution suit against any dairy company that attempts it.

F. Trademarks in Cyberspace

Entities that own trademarks have recently had a great deal of success arguing that their trademark rights extend to domain names on the Internet. For example, Panavision, a movie industry company, was deemed to have trademark-based rights in the panavision.com domain name, even though the domain name had been purchased by someone else (who was later dubbed a "cybersquatter"). The trend both nationally and internationally is for adjudicators to award trademark owners rights to domain names that comprise or incorporate their marks.
In some situations, the names of individuals (generally celebrities) have been accorded trademark-like protection in the domain name context.\textsuperscript{175} Names of people (living, dead, or fictitious) can actually function like, and be registered as, trademarks if they are used to identify goods and services in commerce.\textsuperscript{176} Additionally, the Lanham Act provides (with enumerated exceptions),\textsuperscript{177}

Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.\textsuperscript{178}

This creates a cause of action when entities register the names of living people as domain names and then either post material at these sights that might be objectionable or try to sell the cybersquatted domain names to the named individuals.\textsuperscript{179}

V. Right of Publicity

The right of publicity is characterized in the Restatement (Third) of Unfair Competition as an independent category of intellectual property law.\textsuperscript{180} The Restatement articulates the commercial dimensions of the right of publicity expressing the protected interest as "the commercial value of a person's identity."\textsuperscript{181} Individuals thus have some state law-based control over commercial exploitation of various aspects of their personas, though at present, publicity rights "differ widely in the approximately [twenty-five] states that recognize [such rights] either by statute or common law."\textsuperscript{182} Not initially intended to assist only celebrities per se, the common law right of publicity was originally grounded in the right to privacy,\textsuperscript{183} and it was the unauthorized use of a private person’s photograph that impelled the right-of-privacy decisions almost one hundred years ago that are now viewed as the origin of the right-of-publicity doctrine.\textsuperscript{184}

As modernly construed, the right of publicity theoretically protects individuals from misappropriation of their names and likenesses\textsuperscript{185} and has been judicially extended to nicknames, signatures, physical poses, characterizations, singing style, performance style, vocal characteristics, frequently used phrases, mannerisms and gestures, and body parts, providing they are distinctive and publicly identified with the pertinent individual.\textsuperscript{186} Personal attributes of the famous or notorious are thus treated as business attributes.\textsuperscript{187}

One observer has asserted that protection of the right of publicity is not a balancing “between the rights of the public at large and a fortuitously placed individual; the choice is between the individual to whom the associative value attaches and a stranger to the process who would make money out of it."\textsuperscript{188} "This associative value is derived from fame, and celebrity is exploited differently than the personal information of ordinary individuals. Celebrity generates economic value in three central ways: sales of information about the lives and activities of
celebrities (news stories, biographies, interviews, etc.), sales of merchandise bearing the names and identifiable characteristics of celebrities (clothing, posters, toys, etc.), and celebrity advertising and endorsements directed at selling collateral products\textsuperscript{189} — in other words, celebrity as it is used to sell goods and services to the non-famous.

Ironically, in some respects, the right of publicity does offer ordinary folks some protections that it does not provide celebrities. The newsworthiness privilege\textsuperscript{190} underpinning celebrity journalism and so-called tabloid television effectively negates a celebrity's right to personal privacy\textsuperscript{191} whereas the rest of us, when acting in non-newsworthy fashion, do have a cognizable if unsubstantial right to be free from disclosure of our most intimate affairs.\textsuperscript{192}

The right of publicity has been criticized on several grounds. The argument against the right of publicity that most resonates is the manner in which publicity rights facilitate ownership, censorship, and control of popular culture and the making of social meaning.\textsuperscript{193} Nevertheless, most states recognize some form of the right of publicity,\textsuperscript{194} and such rights are generally (but not always) descendible.\textsuperscript{195} Additionally, a few courts have found celebrity to be divisible property (somewhat analogous to business goodwill) in the context of a divorce.\textsuperscript{196}

VI. Trade Secrets

A trade secret is information (including a formula, pattern, compilation, program, device, method, technique, or process)\textsuperscript{197} used in commerce that gives its owner an opportunity to obtain an advantage over competitors.\textsuperscript{198} Trade secret protections are creatures of common law, but many states have adopted some formulation of the Uniform Trade Secrets Act.\textsuperscript{199} As a result, trade secret owners who take reasonable precautions to protect the confidentiality of their trade secrets generally have tort-based causes of action against parties that misappropriate the trade secrets or gain access to them by improper means.

A trade secret is generally construed as a business asset. Because trade secrets are intangible, valuing them can pose the same sorts of challenges and uncertainties that appraising goodwill or reputation might. Because they are, by definition, unique, valuation of trade secrets also raises the complexities inherent in valuing one-of-a-kind property. Because trade secrets lose their value (and, in fact, cease to exist) if they are publicly revealed, there is little against which a typical trade secret can be compared for purposes of ascertaining monetary value.

The patent potential of any valuable trade secret ought to be assessed and considered. It is also critical to use confidentiality agreements and other mechanisms to preserve the secrecy of a trade secret while it is being shopped around or during licensing negotiations.

VII. Conclusion

Intellectual property matters can pose many challenges for family lawyers. This article is intended to provide only an overview of the issues and is no substitute for topical treatise or consultation with attorneys who possess the appropriate expertise.
Assistant Professor of Law, University of South Carolina School of Law. The author thanks Liz Brandt for soliciting and editing this article, and Jay Dougherty, Llew Gibbons, Jessica Litman, Lydia Loren, and Roy Stuckey for exceedingly helpful comments and assistance. This article is dedicated to Casey Bartow-McKenney.

1. Though each major category of intellectual property is distinct, a single commercial product could simultaneously be comprised of an embodiment of a patented invention, contain copyrighted material, and bear a federally registered trademark. Consider, for example, a retail music compact disc or CD. The technology used to make and encode the compact disc itself may be patented. The box containing the CD itself could be constructed in a patented configuration. The performances fixed on the CD are undoubtedly copyrighted, and so too are the lyrics and musical compositions that comprise the songs. Most music CDs have a paper insert, or title page, visible through the translucent plastic on top of the CD box. This label insert usually contains the name of the recording artist or band, and the title of the CD, which identifies that particular grouping of musical works. Both the title of the work and the name of the person or group that recorded it could be trademarked as could a band logo. Artwork that is associated with a band or recording artist could be copyrighted as well as trademarked.

2. For example, many states have statutes pertaining to trade secrets; The Uniform Trade Secrets Act has been enacted in one form or another by 40 states and the District of Columbia. ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE, 34 (2d ed. 2000) [hereinafter MERGES ET AL.].


4. Id. § 171.

5. The term of a design patent is 14 years from the date of grant. 35 U.S.C. § 173. By contrast, a copyrighted work created after January 1, 1978, can last the life of the author plus seventy years, 17 U.S.C. § 302(a)(2000), or 120 years from the date of creation (or 95 years from the year of its first publication, if that causes an earlier expiration) if authored anonymously or by an entity rather than an individual. 17 U.S.C. § 302(c). Works created prior to January 1, 1978, are governed by 35 U.S.C. §§ 303-304.


7. See id. § 101.

8. Id. (This contrasts with copyrights, which protect only the expression of an idea.)

9. See infra p. 388.

11. *Id.*


19. See *id.* § 154(a)(2) (term of a patent). See also *id.* §§ 155-156 (Patent Term Extensions). Unless the invention is a pharmaceutical product or medical device or product that will be subject to testing and approval by the Food and Drug Administration, it is very unlikely that a patent will be valid enforceable longer than 20 years.

20. Recent Patent Act amendments give patentees some ability to bring suit based on intentional unauthorized use of an invention after a patent application is published but before the patent issues. However, this right cannot be exercised until after the affected patent issues. See the American Inventors Protection Act of 1999, Title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999, Pub. L. No. 106-113.


23. See *id.* § 112.

24. See *id.* § 271.


26. See *id.* § 282.
27. It is also possible for a party that has not been accused of patent infringement to challenge the validity of a patent by bringing an appropriate action for a declaratory judgment.


33. See id.

34. Bartow, supra note 31, at 692. If an employee is deemed by the court to have been "hired to invent," anything invented by the employee belongs to the employer regardless of the existence of a pre-invention assignment agreement. See e.g. Mark B. Herskovitz, "Unhitching the Trailer Clause: The Right of Inventive Employees and their Employers," 3 J. INTELL. PROP. L. 187, 194-95 (1995); Banks v. Unisys Corp, no. 98-70869, 1999 U.S. Dist. Lexis 22348 (E.D. Mich 1999).

36. See Wozniak, supra note 35.


38. See e.g., 17 U.S.C. § 106A, (Rights of Certain Authors to Attribution and Integrity).

39. Id. § 201(a).

40. An author who is an independent contractor (rather than an employee) can freely contract away ownership of a copyright, but effectively contracting away authorship requires an express writing, and that the work fall into one of the specific categories enumerated in § 101 of title 17, definition of work made for hire, sub point two. These categories include contributions to collective works, parts of motion pictures or other audiovisual works, translations, supplementary works, compilations, instructional texts, tests (including answer material), and atlases. A ninth category, sound recordings, was added briefly, and then removed amid great controversy. Large record companies lobbied Congress to have sound recordings added so that they could be deemed the authors as well as owners of songs written by the musicians they had under contract. Musicians objected to loss of authorship status, in part because without it they could not exercise termination rights with respect to copyright assignments they made to record companies, and successfully lobbied to have it removed from the statute. However, many of the contracts musicians have with record companies state that their songs are works for hire, and whether this designation is enforceable is expected to ultimately be the subject of intense litigation.

41. See 17 U.S.C. § 101 (definition of work made for hire) and § 201(2).

42. Merges et al., supra note 2.


44. Id.

45. Registration can be obtained during the subsistence of the first term of copyright for works copyrighted before January 1, 1978, and anytime during the copyright term for copyrightable works created after that date. See 17 U.S.C. § 408(a); see generally, id. §§ 408-412.

46. Id § 411.

47. Id § 412.


50. For example, the "Die Hard" series, the "Lethal Weapon" movies, the "48 Hours" movies, the "Beverly Hills Cop" movies, etc.

51. E.g., 17 U.S.C. § 103 (compilations of facts can be copyrighted).


55. Id. §§ 201, 204-205.

56. See id. § 201 ("copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution").

57. Id. § 101 (definition of "joint work").

58. Id. § 201(a).


61. See id. § 103.

62. MERGES ET AL., supra note 2, at 362-63.

64. See id. §§ 502-504.

65. The DMCA has been incorporated into the Copyright Act, 17 U.S.C., at § 512.


68. 17 U.S.C. §§ 302(a), 305. In the case of joint authorship, the copyright endures for 70 years following the death of the last surviving author. Id. §§ 302(b), 305. In the case of works copyrighted prior to Jan. 1, 1978, see id. §§ 303, 304-305.

69. Id. § 302(c).

70. Id. § 201(d)(1).

71. Id. § 201(d)(2).

72. See sections 303 and 304 of the Copyright Act.

73. See id. § 101.

74. Id. § 103.

75. See id. § 202.

76. This is known as the First Sale Doctrine, codified at 17 U.S.C. § 109.

77. See id.

78. In one case, CCNV v. Reid, 490 U.S. 730 (1989), a sculpture owner was required to give easement-like access to the sculptor after protracted copyright litigation that ultimately reached the Supreme Court. However, the facts of the case were somewhat unusual, and other copyright holders cannot count on obtaining court-mandated access to material objects they have sold.


80. See id. § 106A.

81. Id. § 106A(e)(1).

82. CAL. CIV. CODE § 986 (2001).

84. See e.g., A Confederacy of Dunces, for which author John Kennedy Toole was posthumously awarded the Pulitzer, when (after his suicide) his mother convinced Walker Percy to read the manuscript, and Percy subsequently persuaded a small academic press to publish it. John Kennedy Toole, A CONFEDERACY OF DUNCE (1980).

85. See infra Part III. I.

86. Congress deemed termination capability important because authors tend to be in unequal bargaining positions when they license or assign their copyrights to others, in part because the value of a work is generally not known until it is released to the public. See H. R. Rep. No. 94-1476, at 124 (1976).

87. Section 203 (a) expressly states that termination rights do not apply to grants made pertaining to works made for hire.


89. Id. § 203(a)(3). If the grant covers the right of publication of the work, the period begins at the end of thirty-five years from the date of publication of the work under the grant or at the end of forty years from the date of execution of the grant, whichever term ends earlier. Id.

90. See generally id. §§ 203(a)(4)(B), 203, 304(c)-(d); and CFR § 201.10.

91. See id. § 203(b)(6).

92. See id. § 203(b).


95. See 17 U.S.C. 203(a)(1) ("in the case of two or more authors . . .").

96. Termination rights vest when timely notice is served on a grantee (which can occur up to 10 years before commencement of the termination period per section 203(a)(4)(A) of the Copyright Act), and the other requirements of section 203 are complied with.

98. *See id.* §§ 203(a)(1)-(2) outline majority and *per stirpes* rules for exercises of termination with respect to grants by more than one author of a joint work as well as to grants by a deceased author.


100. *Id.* § 203(b)(3).

101. As proscribed in section 203 of the Copyright Act.

102. *Id.* § 203(a).


104. It is important to pay attention to when termination rights vest. Because notice can be sent up to 10 years early, *see id.* 203(a)(4)(A), if the author lives until 25 years after the grant and serves the required notice before death, the termination rights vest in the author and recaptured rights can be enforceably bequeathed by will to someone other than a statutory heir. *See id.,* (203(b)(2)). This would be the case even if the author dies the day after properly serving the termination notice in compliance with the requirements of the statute, more than 9 years before the actual termination date.

105. *Id.* § 203(a)(2)(D).


108. *Id.* § 203(b)(1).

109. *See id.* § 304(c)(3).

110. *See id.* § 304(c)(2).

111. *Id.*

112. *See id.* § 304(c)(1).

113. *See 17 U.S.C. §§ 304 (c) (1) and 304 (c) (6).*

114. *See id.* § 304(c)(2).


117. Id. § 304(c)(4)(A).

118. Id. § 304(c)(6)(B). These termination rights might be alternately described as a future interest in the copyright rights that will be recaptured when the termination occurs.

119. Note that under 17 U.S.C. § 203(a), pertaining to grants made after Jan. 1, 1978, only transfers and licenses granted by authors can be terminated.

120. Id. § 304(c)(6)(2). See also Fred Ahlert Music Corp. v. Warner/Chappell Music, 155 F.3d 17 (2d Cir. 1998) ("however, an author's termination rights are not unlimited. The 1976 Act's Derivative Works Exception permits a grantee or licensee who prepares a derivative work before termination to continue to utilize the derivative work during the extended renewal term 'under the terms of the grant.'" 17 U.S.C. § 304(c)(6)(A). A derivative work is "a work based upon one or more preexisting works, such as a . . . sound recording . . . . A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'" Id. at § 101. The exception seeks to protect public access to the derivative work as well as the rights of persons who have invested in creating the derivative work); Woods v. Bourne Co., 60 F.3d 978 (2d Cir. 1995); Burroughs v. MGM, 519 F. Supp. 388 (S.D.N.Y. 1981), aff'd 683 F.2d 610 (2d Cir. 1982); Donald A. Hughes, Jr., Jurisprudential Vertigo: The Supreme Court's View of "Rear Window" Is for the Birds, 60 Miss. L.J. 239, 251-52 (1990); Eileen Siegeltuch, Case Note, Fred Ahlert Music Corp. v. Warner/Chappell Music, Inc.--Post-Termination Licensing of Pre-Termination Derivative Works: Whose Song Is It Anyway? 6 VILL. SPORTS & ENT. L.J. 379 (1999); Virginia E. Lohmann, Note, The Errant Evolution of Termination of Transfer Rights and the Derivative Works Exception, 48 OHIO ST. L.J. 897 (1987); Jill I. Prater, When Museums Act Like Gift Shops: The Discordant Derivative Works Exception to the Termination Clause, 17 LOY. L.A. ENT. L. REV. 97 (1996); Kathleen M. Bragg, Comment, The Termination of Transfers Provision of the 1976 Copyright Act: Is It Time to Alleviate It or Amend It? 27 PEPP. L. REV. 769 (2000); Michael H. Davis, The Screenwriter's Indestructible Right to Terminate Her Assignment of Copyright: Once a Story Is "Pitched," a Studio Can Never Obtain All Copyrights in the Story, 18 CARDOZO ARTS & ENT. L.J. 93 (2000); Daniel A. Saunders, Comment, Copyright Law's Broken Rear Window: An Appraisal of Damage and Estimate of Repair, 80 CAL. L. REV. 179 (1992).


122. Id.

123. See id. §§ 303-304.

124. Works created on or after Jan. 1, 1950 were still in their first term of copyright on Jan. 1, 1978, and endure for a 28-year first term and a 67-year renewal term. Works created earlier than Jan. 1, 1950 would have been in their renewal terms on Jan. 1, 1978, and subsist for a total of 95 years from the date copyright was secured, per 17 U.S.C. § 304(b). Works that enjoy automatic
renewal are those first published between 1964 and 1977 (inclusive) under the Automatic

125. Id. § 304.

126. Under section 304(a) of the Copyright Act, there are incentives (pertaining to the moment of
vesting) to obtaining voluntary rather than automatic renewal rights, through registration of a
claim. An author or her statutory heirs can register a claim to the copyright for the renewal term
with the Copyright Office, within one year before the original 28-year term of copyright expires,
pursuant to the dictates of section 304(a).

127. Id.

128. JOYCE ET AL., COPYRIGHT LAW (5th ed.).

129. Id. at 365-66.

130. Unlike termination, the renewal is not inalienable and it is automatic (for works published
after 1964).

131. The copyright in works eligible for renewal on or after June 26, 1992, will vest in the name
of the renewal claimant on the effective date of any renewal registration made during the 28th
year of the original term. Otherwise, the renewal copyright will vest in the party entitled to claim
renewal as of December 31st of the 28th year.

132. See, e.g., Fred Fisher Music Co v. M. Witmark & Sons, 318 U.S. 643 (1943); Corcovado

133. Id. See also, Music Sales Corp. v. Morris, 73 F. Supp. 2d 364, 371 (S.D.N.Y. 1999) ("the
policy underlying the creation of renewal rights influences the extent to which the author is free
to contract away those rights or bequeath them. Under the 1909 and 1976 Acts, the author may,
during the first term of the copyright, assign his or her expectancy of the renewal rights to a third
party by contract. If the author survives until the time the renewal copyright vests, then the
assignment to the third party is binding (although terminable through exercise of the termination
right)."

134. Statutory heirs under section 304(a)(C) of the Copyright Act differ slightly from statutory
heirs under section 203, and in addition to widow or widower and surviving children and
grandchildren, include "the author's next of kin, in the absence of a will of the author."

135. Miller Music Corp. v. Daniels, Inc., 362 U.S. 373 (1960); see also, Music Sales Corp. v.
Morris, 73 F. Supp. 2d at 371 ("should the author die while the work is in its first term, the rights
to future renewal copyrights do not follow contractual or testamentary dispositions made by the
author. Instead, regardless of prior assignments by the author, the expectancy of the renewal
rights vests in the categories of persons enumerated by the Copyright Act"); see also, Francis M.
Nevins, *Little Copyright Dispute on the Unbumping the Will of Laura Ingalls Wilder*, 44 St. Louis L.J. 919 (2000) ("if you are entering into a contract with an author, what can you do to keep the contract from being bumped? The only feasible strategy is to require the author's spouse and children at the time of the deal to execute contingent assignments of the relevant rights in the work during that work's renewal term. If the author lives to renew, he is bound by his contract under *Fred Fisher* and there can be no bumping. If he doesn't live to renew and those who signed the contingent assignments make up the entire statutory successor class, they too are bound under *Fred Fisher* and there can be no bumping. But if the successor class turns out to include someone who didn't execute a contingent assignment--for example, if the author remarried or had one or more new children after the movie deal was completed--at the beginning of the renewal term the contract is pro tanto bumped. In other words, the threat of contract bumping can be reduced but never completely eliminated").


141. *Id.*


143. *See Nevins, supra* note 135.

144. *See, e.g., id.* at 930 ("the days of copyright law's meddling with authors' testamentary freedom are drawing to a close. Each year until the end of 2005, authors run the risk that their testamentary bequest of pre-1978 works entering their renewal term that year will be bumped. But at the close of business on December 31, 2005, the last date on which any pre-1978 copyright can conceivably begin its renewal term, most, if not all, of the will-bumping phenomenon will have faded forever into history").

145. Worth v. Worth, 241 Cal. Rptr. 135, 139-40 (Ct. App. 1st Dist. 1987); *see also*, Range Road Music, Inc. v. Stoller, 76 F. Supp 2d 375 (S.D.N.Y. 1999) (If couple married before issuance of copyrights at issue, copyrights may be community property).

146. *See, e.g.*, Dane S. Ciolino, *Why Copyrights Are Not Community Property* 60 L.A. L. REV. 127 (Fall 1999); Peter J. Wong, *Asserting the Spouse's Community Property Rights in Copyright,*


148. Rodrigue v. Rodrigue, 218 F.3d 432 (5th Cir. 2000).

149. Id. at 437.

150. Id.


152. See, e.g., Tom Clancy's Cold War: The Author's Divorce Involves a Custody Dispute Over a Fictional Character, GREENSBORO NEWS & REC., Aug. 9, 1990, at D16 (dispute over who gets custody of Tom Clancy's literary alter ego, Jack Ryan, arose in Maryland, an equitable-distribution jurisdiction, but highlights the way in which many related issues arise in allocating copyrights and copyright revenues can arise during termination of an author's marriage).


154. Id. § 1053.

155. See id. §§ 1127 (definition of person), 1051.

156. Id. § 1111.

157. See id. § 1114.

158. See id. § 1125.

159. See id. § 1051.

160. Id. § 1053.
161. U.S. registration may provide an early priority date that is useful when a mark owner pursues registration in other nations.


163. One can use the databases available at the PTO Web site, www.uspto.gov, to perform certain trademark searches.


165. \textit{Id.} § 1052(a).

166. \textit{Id.} § 1063.

167. Jessica Litman provides these examples in \textit{The DNS Wars: Trademarks and the Internet Domain Name System}, 4 J. SMALL & EMERGING BUS. 149, 153 (2000).


169. \textit{Id.}


172. \textit{Id.} § 1127 (definition of the term dilution).


174. \textit{See} Panavision Int'l v. Toeppen, 141 F.3d 1316 (9th Cir. 1998).


176. See e.g., MERGES ET AL., supra note 2, at 654-57.


179. Id.


181. Restatement (Third) of Unfair Competition § 46 (1995). See Sudakshina Sen, Fluency of the Flesh: Perils of an Expanding Right of Publicity, 59 Alb. L. Rev. 739, 740 (1995): Commentators have advanced three general justifications for the right of publicity. First, the celebrity's right of publicity is justified in terms of John Locke's labor theory of property. In his Second Treatise, Locke posits that an individual has "a property [right] in [her] own person" and thus in "the labor of [her] body." Melville Nimmer's influential 1954 article takes Locke's "moral" argument further, stating that a famous person who has "long and laboriously nurtured the fruit of publicity values" should benefit from those values herself. According to this modern application of Locke's labor theory of property, since the celebrity spends time, money, and energy in developing a commercially lucrative persona, that persona is the fruit of the celebrity's labor and entitles her to its rewards. Moreover, in line with the labor theory of property, it is often argued that advertisers who appropriate celebrity personas without permission, much like "pirates" or "free riders," improperly reap what others have sown.

The second justification of the right of publicity is the economic incentive argument, which holds that protection of the celebrity's economic interest in her identity fosters creativity. The assurance that the celebrity will be able to gain from what she produces will encourage artistic creation that enriches our culture. Because society "encourages socially valuable activities and achievements," the celebrity's legal entitlement provides the necessary motivation to produce work.

The third justification is the unfair trade practices rationale, which stems from a consumer protection perspective. The advocates of this rationale contend that, in
the context of advertising, the celebrity should have exclusive control of her right of publicity in order to protect consumers from possible misrepresentation, deception, and false advertising.


186. Coombe, supra note 185, at 1226.


188. Halpern, supra note 187 at 872.


190. At present the First Amendment offers some protection to "authors without authorization" who write about celebrities, but is less likely to shield those who use images of famous people, because a non-permissive utilization of words gets more First Amendment protection than an unauthorized use of pictures or sounds, especially when digital technologies have been employed. When Dustin Hoffman sued Los Angeles Magazine for merging an old photograph of him with a contemporary photograph of a fashion model, the judge found that the photographs contained in the disputed feature, which also featured the merged visages of other entertainers, "were manipulated and cannibalized to such an extent that the celebrities were commercially exploited and robbed of their dignity, professionalism and talent. To be blunt, the celebrities were violated by technology. Hoffman v. Capital Cities/ABC Inc., 33 F. Supp. 2d 867 (C. D. Cal. 1999).


192. See Madow, supra note 189, at n.12.

193. Michael Madow provides the (lengthy but worthwhile) example: A few years ago, a bill was introduced in the New York Legislature to create a broad and descendable right of publicity. During hearings on the bill, some of the testimony referred to a greeting card, said to be sold chiefly in gay bookstores. The card bears a picture of John Wayne, wearing a cowboy hat and bright red lipstick, above the caption "it's such a bitch being butch." Wayne's children, among others, objected to the card not only on the ground that its sellers were making money from The Duke's image — money that should go to them, or, in this case, to the charity of their choosing. They objected also, indeed primarily, because in their view the card was "tasteless" and demeaned their father's (hard-earned) conservative macho image. To his children, as to most of his fans, John Wayne epitomizes traditional America's mythic and idealized view of itself, its history, and its national character. What Wayne stands for —what his image means in the mainstream cultural grammar—is rugged individualism, can-do confidence, physical courage, and untroubled masculinity. That is the "preferred meaning" of John Wayne. It was on this preferred meaning that [then] President Bush drew easily and effectively in communicating his military plans in the [Persian] Gulf. It is on that meaning, too, that Wayne Enterprises drew when it licensed the Franklin Mint to sell (for $395) a "serially numbered, non-firing" replica of the .45-caliber automatic pistol that Wayne "carried in so many great military films." Nevertheless, against-the-grain readings of John Wayne are also possible. For instance, in a course on how to survive as a prisoner of war, the U.S. Navy uses the term "John Wayning it" to mean trying foolishly to hold out against brutal torture. The particular greeting card that Wayne's children
and others objected to so strenuously represents an even more subversive inflection of Wayne’s image. The card uses his image to interrogate and challenge mainstream conceptions of masculinity and heterosexuality. It re-codes Wayne’s image so as to make it carry a cultural meaning that presumably works for gay men, among others, but which Wayne’s children (and no doubt many of his fans) find deeply offensive. If the New York Legislature were to make John Wayne’s right of publicity descendable, however, it would confer on Wayne image is “illegitimate,” and to enforce that determination by denying a license to the greeting card maker. Wayne Enterprises would henceforth have the power to fix, or at least try to fix, the meaning that “John Wayne” has in our culture; his meaning for us. Madow supra note 189, at 129.

194. See, e.g., Goodman, supra note 182.


197. See UNIFORM TRADE SECRET ACT at section 1 (4).

198. See RESTATEMENT OF TORTS section 757 comment b (1939).

199. UNIFORM TRADE SECRETS ACT section 5 (1985), “In an action under this [Act], a court shall preserve the secrecy of an alleged trade secret by reasonable means, which may include granting protective orders in connection with discovery proceedings, holding in-camera hearings, sealing the records of the action, and ordering any person involved in the litigation not to disclose an alleged trade secret without prior court approval.”