Save Left Shark: Katy Perry, Intellectual Property, and 3D Printing

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There has been much interest in how intellectual property law, policy, and practice will adapt to the emergence of 3D printing and the maker movement.\textsuperscript{1} Intellectual property lawyers will have to grapple with the impact of additive manufacturing upon a variety of forms of intellectual property – including copyright law, trade mark law, designs law, patent law, and trade secrets. The disruptive technology of 3D printing will both pose opportunities and challenges for legal practitioners and policy-makers.

A performance by Pop Princess Katy Perry at the 2015 Super Bowl has sparked a public controversy over intellectual property, Internet Memes, and 3D printing.

In 2015, Katy Perry performed at the half-time entertainment during the Super Bowl. She presented a suite of hit songs – including ‘Roar’, ‘Dark Horse’, ‘I Kissed a Girl’ (with Lenny Kravitz), ‘Teenage Dream’, ‘California Gurls’, and an Missy Elliott medley: ‘Get Ur Freak On,’ ‘Work It,’ ‘Lose Control’, and ‘Firework’. Her performance was over-shadowed by one of her backup dancers, Bryan Gaw – who was wearing a shark costume. While the Right Shark performed the choreography as scripted, the Left Shark improvised, and performed somewhat differently. The broadcast audience warmed to the performance of Left Shark. The character of Left Shark quickly became an Internet sensation, and an Internet Meme.

Political artist and maker Fernando Sosa has developed a distinctive reputation as a ‘Political Sculptor’, selling his 3d-printed figurines on Shapeways. He decided to create a 3D figurine, ‘Left Shark’, in the wake of the Super Bowl. In response, Katy Perry’s lawyers sent a copyright take-down notice to Fernando Sosa and Shapeways. Moreover, Katy Perry’s lawyers also sought to make a trade mark application in respect of Left Shark – both in terms of an image mark and a word mark. Fernando Sosa’s lawyer Christopher Sprigman has objected to Katy Perry’s claims of intellectual property ownership in respect of Left Shark. The dispute highlights emerging conflicts, tensions, and pressure points in respect of intellectual property, 3D printing, and the maker movement.

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1. Copyright Law and 3D Printing

There has been significant interest in the impact of 3D printing on copyright law and the creative industries.\(^5\) There has been a use of open licensing models such as Creative Commons licensing to facilitate the sharing of designs.\(^6\) There has also been a moral panic\(^7\) about 3D printing facilitating copyright infringement and piracy – like peer to peer networks.\(^8\)

A. Complaint

On the 3\(^{rd}\) February 2015, Katy Perry’s lawyers sent a letter to Shapeways, complaining about the Left Shark Design. The lawyers warned: ‘Our client recently has learned that you

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\(^{7}\) William Patry notes that intellectual property owners often seek to advance economic interests under the guise of false moral imperatives: ‘ Conjuring up moral panics and folk devils occurs through metaphors casting the other side in an unfavourable light, in the case of copyright, by painting those who use works without permission as thieves, trespassers, pirates, or parasites’. William Patry, Moral Panics and the Copyright Wars, Oxford: Oxford University Press, 2009.

have been involved in the manufacture, sale, marketing and distribution of merchandise
featuring a shark sculpture which embodies and uses the IP, and that you have displayed this
product on your website, www.shapeways.com, in connection with such sale and
distribution.’9 The lawyers maintained: ‘As you are undoubtedly aware, our ‘client never
consented to your use of its copyrighted work and IP, nor did our client consent to the sale of
the infringing product.’10 The lawyers insisted: ‘Your unauthorized display and sale of this
product infringes our client's exclusive rights in numerous ways, including, but not limited to,
infringement of our client's exclusive rights to reproduce, display, and distribute its
copyrighted images under the United States Copyright Act as set forth in 17 U.S.C. §106.’11
The lawyers threatened legal action: ‘Your infringing conduct entitles our client to significant
legal relief against you, which may include actual damages, statutory damages, and punitive
damages, as well as immediate and permanent injunctive relief.’12 The letter was strange,
though, because it was not a take down notice in the form prescribed by the Digital
Millennium Copyright Act 1998 (US).13

The 3D Printing hub, Shapeways, was disturbed by the notice from Katy Perry’s letters:

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9 Signe Brewster, ‘Katy Perry’s Lawyers Demand Takedown of 3D Printable Left Shark’, Gigaom, 5
February 2015, https://gigaom.com/2015/02/05/katy-perrys-lawyers-demand-takedown-of-3d-printable-left-
shark/

10 Ibid.

11 Ibid.

12 Ibid.

13 Mike Masnick, ‘There’s Something Fishy with Katy Perry’s Left Shark 3D Printing Takedown’,
TechDirt, 6 February 2015, https://www.techdirt.com/articles/20150205/16305829921/katy-perry-claims-
copyright-over-left-shark-issues-takedown-over-3d-printable-version.shtml
It’s a shame because we love our community and always want to be able to support their designs. That’s part of the reason why our work with Hasbro is so fun! It’s allowing fans to create products truly inspired by the things they personally enjoy. We know these things can happen when you have a lot of user-generated content, but hopefully more brands (and celebrities!) will take note and want to work together with fans to create amazing products!14

Shapeways’ lawyer, Michael Weinberg, was ultimately sceptical of the copyright claims made by Katy Perry’s lawyers.15 In the end, Shapeways reinstated the design for the Left Shark by Fernando Sosa.

B. Response

In response, Fernando Sosa launched a campaign for his own legal fund. Professor Christopher Sprigman from New York University – the co-author of The Knockoff Economy16 represented Fernando Sosa in a dispute.17 The legal academic noted: ‘Mr. Sosa is not especially eager to be fighting over copyright, but the legal merits of your claim seem

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very weak. He also wondered about the wisdom of asserting an intellectual property action in respect of an internet meme.

First, Sprigman asked Katy Perry’s lawyers, ‘Can you tell me why you believe the costume of a shark that you claim Katy Perry owns is copyrightable?’ He observed: ‘As you likely know, federal courts and the United States Copyright Office have made clear that costumes are generally not copyrightable.’ Sprigman asked for a justification for copyright subsistence in respect of the Left Shark costume: ‘Please tell me why you think the Left Shark costume should be treated differently.’

Second, Sprigman asked Katy Perry’s the basis for her claim of copyright ownership in respect of the Left Shark costume: ‘What is the basis for your claim that Katy Perry, and not some other person, owns the copyright? Did Katy Perry design the Left Shark costume?’ He observed: ‘We ask about ownership not least because Katy Perry herself suggested that she didn't have control over the content of her halftime show, but rather the NFL did.’ Sprigman cited an interview by Katy Perry with Elle magazine, in which she said: ‘With the NFL, I have to be accountable to several levels of red tape.’ Moreover, Katy Perry commented: ‘So I am no longer the boss; I have to relinquish that control.’ Sprigman suggested: ‘At the very
least, Katy Perry's own account raises questions about what, if anything, she owns. If she wasn't the boss of her halftime show, she's also unlikely to be the copyright owner.\(^\text{25}\)

Sprigman suggested that Katy Perry’s lawyers should drop the action altogether: ‘My client wants to get back to his business, and he (and I'd wager pretty much everyone else) would be grateful if you'd just back off. Going ahead with these very dubious copyright claims will not benefit Katy Perry’.\(^\text{26}\) He suggested that, if Katy Perry wanted to continue with the lawsuit, she should answer the legal questions: ‘But if you're determined to press on, please do respond to my legal questions, and we can try to work it out from there.’\(^\text{27}\)

There has been much uncertainty about the status of copyright protection in respect of fashion in the United States.\(^\text{28}\) The Copyright Office has given guidance on the Registrability of Costume Designs. Famously, in a 1991 policy decision, Ralph Oman, the Register of Copyrights, said: ‘Costumes, by their very nature, exist at the boundary between works of imagination and works of utility.’\(^\text{29}\) The Register of Copyrights said: ‘Portions of some

\(^{25}\) Ibid.

\(^{26}\) Ibid.

\(^{27}\) Ibid.

\(^{28}\) See, for instance, the debate over copyright and cheerleading designs in *Varsity Brands, Inc. v. Star Athletic, LLC* (2015), United States Court of Appeals for the Sixth Circuit, No. 14-5237, [http://www.ca6.uscourts.gov/opinions.pdf/15a0194p-06.pdf](http://www.ca6.uscourts.gov/opinions.pdf/15a0194p-06.pdf) The majority held that ‘because we believe that the graphic features of Varsity’s cheerleading-uniform designs are more like fabric design than dress design, we hold that they are protectable subject matter under the Copyright Act.’ In dissent, McKeague J observed that ‘it is apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design.’ The judge noted that the ‘law in this area is a mess – and it has been for a long time.’

costumes will be registrable under the separability test, and others will be unregistrable in all respects.30

C. Commentary

A number of intellectual property experts provided support for the position of Christopher Sprigman. Professor Rebecca Tushnet from Georgetown Law and the Organisation of Transformative Works commented on the controversy:

A costume is a useful article, and useful articles aren’t copyrightable unless there are elements that are ‘separable’ from the useful article itself. For example, anything necessary for a human to fit in the costume (and dance, badly or well) would not be separable. Some costumes may be copyrighted, and I think it’s possible Left Shark could be one of them, but further factual development would be required.31

She also noted that there could also be larger issues about the operation of copyright exceptions – like the defence of fair use: ‘Fair use might well be a significant issue, given the nature of the meme surrounding Left Shark.’32 In this context, a number of precedents in respect of copyright law, appropriation art, and fair use could be relevant.33

30 Ibid.
32 Ibid.
33 See United States Copyright Office Fair Use Index, http://copyright.gov/fair-use/ Gaylord v. United States 595 F.3d 1364 (Fed. Cir. 2010); Cariou v. Prince 714 F. 3d 694 (2d Cir. 2013), Seltzer v. Green Day, Inc. 725 F. 3d 1170 (9th Cir. 2013); For a summary, see Matthew Rimmer, 'A Fair Use Project for Australia: Copyright Law and Creative Freedom' (2010) 28 (3) Copyright Reporter 165-212; and Pamela Samuelson.
Parker Higgins, a researcher at the Electronic Frontier Foundation, commented: ‘I agree with Sprigman on this one: costumes are considered useful articles, so absent a separable design with a claim to it (like a print, usually) it doesn’t get copyright.’

Overall, there are concerns as to whether Katy Perry is engaged in copyfraud – making copyright claims in respect of a public domain work. There have been a number of other controversies about copyright subsistence involving 3D printing. A college sought to claim copyright over replicas of Michelangelo’s statues in a dispute over 3D printing. Obviously, such works were in the public domain, and did not enjoy any further copyright protection. There has also been an international fight over 3D printing Marcel Duchamp’s Chess Set.

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response to a cease and desist order, the designers have returned with a second set of Duchamp-inspired 3D printed chess pieces.\textsuperscript{38}

2. Trade Mark Law and 3D Printing

In addition to copyright conflicts over 3D printing, there has also been much controversy in respect of 3D printing and trade mark law. Such matters have included debates over trade mark registration, trade mark licensing and trade mark infringement.

Amanda Scardamaglia from Swinburne Law School provides an overview of some of the flashpoints in respect of 3D printing and trade mark law.\textsuperscript{39} She charted the tensions and conflicts in the field:

While there are some uses to which 3D printers can be put which may infringe the rights of trade mark owners, this is mostly at the perimeters. So although some commercial uses may impinge on the rights of trade mark owners, personal uses are less controversial. That is not to say that such uses are not objectionable to trade mark owners, who are concerned not just with consumer confusion but with the dilution of their brand and controlling all corners of their market.\textsuperscript{40}

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\textsuperscript{40} Ibid.
Amanda Scardamaglia comments: ‘When it comes to the intersection of trade mark law and 3D printing, there is no reason to expect anything different. 3D printing therefore, is shaping up to be the next battleground for intellectual property law overreach, with trade mark law set to play a pivotal role.’ She observed that ‘if 3D printing does become our reality, a reality where consumers become makers, then trade mark owners will eventually have little choice but to embrace the new model of doing things.’

The International Trademark Association (INTA) held a conference on 3D Printing and additive manufacturing in March 2015 in New York to explore both the business and intellectual property implications of the topic.

**A. Trade Mark Application for Left Shark**

Trade mark offices and courts have sought mediate disputes in respect of trade mark law and 3D Printing. Michael Weinberg has noted that the ‘Supreme Court has been protective of the public’s interest in competition in the face of requests from trade mark holders to increase the scope of protection.’

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41 Ibid.
42 Ibid.
In February 2015, Katy Perry’s lawyers filed for a trade mark application in respect of Left Shark. Trade mark applications were filed in respect of ‘Basking Shark’, ‘Drunk Shark’, ‘Right Shark’ and ‘Left Shark’, and various designs of a shark. The applications suggested that the goods to be used with the trade marks included stickers, T-shirts, plush toys, action figures, costumes, figurines, and live musical and dance performances.

There was controversy over Katy Perry’s lawyers using Fernando Sosa’s image of Left Shark in their trade mark application. Mike Masnick considered the irony of the situation. He commented that while ‘you could argue that, while Perry has no copyright (or trade mark) in Left Shark, it's conceivable that Perry's lawyers could have violated Sosa's copyright in the image of his 3D printed item in using it as part of their trade mark application’. He commented: ‘When you're arguing that the model is infringing on a potentially non-existent copyright, it seems to be quite a show of hubris to use the image created by the guy you're threatening and use that in your own trade mark application.’

B. United States Patent and Trademark Office

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45 Killer Queen LLC, ‘Left Shark’, United States Trade Mark Application Serial Number 86526826, Filing Date, 6 February 2015.


47 Ibid.

48 Ibid.
In April 2015, United States Patent and Trademark Office examiner, David Collier, questioned the trade mark applications by Katy Perry. The examiner said that the Left Shark image ‘identifies only a particular character; it does not function as a service mark to identify and distinguish applicant’s services from those of others and to indicate the source of applicant’s services.’ The examiner was also concerned by the disparities between the photograph of Katy Perry with Left Shark, and the drawings submitted as a design:

Specifically, the [photograph] displays the mark as a stylized depiction of a forward leaning shark in nearly a front profile with a portion of a dorsal fin, two pectoral fins and two legs and feet substituted for the caudal fin on the tail,” he wrote. "The shark has five gills, a full mouth with teeth and round eyes with eyelids; however, the drawing displays the mark as a stylized depiction of an upright shark in full front profile with no dorsal fin, two full pectoral fins and two legs and feet; the shark has three gills and the shark's mouth appears without teeth; the shark also has oval eyes without eyelids.51

The trade mark examiner was somewhat more sympathetic to the trade mark application in respect of the word mark for ‘Left Shark’. The examiner has sought to gain greater clarification over the identity of the goods that are the subject of the trade mark application.

Eriq Gardner noted that ‘a "Left Shark" trade mark would allow Perry to attack those who would mislead the public into thinking she's behind their "Left Shark" endeavors.’52

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50 Ibid.
51 Ibid.
52 Ibid.
In March 2015, Katy Perry launched a character merchandising campaign in respect of the ‘Left Shark’, with a Onesie, and T-Shirts.\textsuperscript{53} Mary Ward noted: ‘Fans of the \textit{Dark Horse} singer can now dress as the freestyling shark from Perry's halftime show, by purchasing a Left Shark onesie from her website.’\textsuperscript{54} The cost of the Onesie was an exorbitant $US129. The singer also released a Left Shark T-Shirt, which cost $25. In a further twist to the saga, the trendy hipster company Bonobos asked Katy Perry to let it make the suit.\textsuperscript{55}

The dispute raises interesting questions about trade mark infringement. There has been interest amongst lawyers in bringing about trade mark action in respect of 3D printing and counterfeiting.\textsuperscript{56} There could be complex issues involved in respect of trade mark law, 3D printing, and intermediary liability.\textsuperscript{57}

C. Collaborative Licensing Agreements


\textsuperscript{54} Ibid.


\textsuperscript{56} Jane Bird, ‘Lawyers Focus on Short Cut to Riches for Counterfeiters’, \textit{Financial Times}, 24 June 2014, \url{http://www.ft.com/cms/s/0/622d782c-f316-11e3-a3f8-00144feabdc0.html#axzz3m3iPHhUA}

For its part, Shapeways prefers to enter into trade mark licensing arrangement with trade mark holders. The collaborative deal with toy-maker Hasbro shows the advantages of a co-operative approach to dealing with issues surrounding 3D printing and trade mark law. In the wake of the partnership, Hasbro filed for a 3D printing related trademark.

There have also been significant trade mark licensing deals with Coca-Cola and Hershey’s.

Conclusion

The skirmish between Katy Perry and Fernando Sosa is symptomatic of the growing conflicts in respect of intellectual property law, and 3D printing in the United States. The maker movement’s celebration of remix culture will test the boundaries and limits of intellectual property regimes – such as copyright law, trade mark law, designs law, and patent law.

There are significant issues in respect of 3D printing surrounding copyright subsistence, copyright licensing copyright infringement, and copyright exceptions. There are also major issues in respect of 3D printing and rules about trade mark registration, trade mark licensing, and trade mark infringement. In other fields of intellectual property, there have also been

significant issues in respect of 3D printing and its impact upon designs law, patent law, and trade secrets law. Thinking about the emergence of 3D printing, Professor Mark Lemley of Stanford Law School has warned that there will profound challenges to intellectual property law in a post-scarcity economy:

The Internet is a harbinger of things to come—of a raft of new technologies that offer the promise of separating creativity from production and distribution, and reducing the cost of all three. Those technologies challenge the basis for our IP system, and indeed the basis for our economy as a whole.

The battle over who owns Left Shark foreshadows fundamental conflicts between intellectual property owners, the manufacturers of 3D printing, and the maker movement. There will be a need to revise and reform intellectual property law, so that it is well-adapted to meeting some of the challenges presented by 3D printing, the maker movement, and the Internet of Things.

There are significant lessons from the conflict over Left Shark for Australia. 3D Printing, the maker movement, and the sharing economy will pose major challenges for Australia’s intellectual property laws. Australian courts will have to consider the boundaries between what is protected under copyrightable subject matter and what is the province of the public domain. Unlike the United States with its broad defence of fair use, Australia has only a

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limited defence of fair dealing under copyright law. As such, makers will be exposed to a wider array of copyright infringement actions. Similarly, Australia’s trade mark regime is very much focused upon the rights of trade mark holders. There are limited exceptions and defences to claims of trade mark infringement. The Advisory Council of Intellectual Property declined to recommend reforms to Australia’s designs regime in light of 3D printing, saying that it was premature to take action. Australia’s patent laws, though, do have flexibilities for makers, tinkerers, and inventors. The statutory defence of experimental use should provide protection for a range of activities undertaken by the members of the maker movement.

The 3D Printing community should play an active part in the policy debate over intellectual property law reform. Michael Weinberg has emphasized that ‘it is critical for today’s 3D printing community, tucked away in garages, hackerspaces, and labs, to keep a vigilant eye on these policy debates as they grow.’ He recommended that ‘the community must work to educate policy makers and the public about the benefits of widespread access.’

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67 Ibid., 15.
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