

RADIO ADVERTISING + IP: BEST PRACTICES IN AVOIDING INFRINGEMENT

with Claire Hawkins and Brad Deutsch



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NEW YORK

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Obligatory Initial Disclaimer

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Road Map: IP Issues in Radio Advertising (Overview)

▪ Cautionary Tales:

- Sports
- People
- Comparisons / Humor

▪ Related Issues:

- Music Licensing
- Contests
- Websites
- Formalities
- Contracts
- International
- Social Media
- Litigation
- Insurance

▪ Best Practices:

- Due Diligence
- Protective Measures
- Ask for Help

All Sports All the Time

Jan: Australia Open, Winter X Games, Special Olympics

Feb: Winter Olympics, Six Nations, Super Bowl

Mar: Winter Paralympics, World Cup, March Madness

Apr: Masters, Grand National

May: Kentucky Derby, World Aquatics, World Masters, IIHF, USPGA, French Open, UEFA Champions, Indianapolis 500

Jun: NBA Finals, Stanley Cup, US Open, Wimbledon

Jul: FIH Hockey World Cup, Tour de France, World Games, Summer X Games, British Open, IAAF World Championships

Aug: FEI World Equestrian Games, Islamic Solidarity Games, US Open

Sep: Rugby World Cup Sevens, Asian Games, World Rowing Championships, Presidents Cup, Grand Final, Ryder Cup

Oct: South American Games, NRL Grand Final, Womens World Cup, World Series, World Cup, ICC World T20

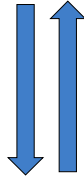
Nov: World Championships, Melbourne Cup, FIFA World Cup

Dec: FINA World Swimming Championships



Requirements for US Trademark Protection

- Indications of Origin
- Used in Commerce
- Rights based on use / registration
- Spectrum of Distinctiveness / Strength:
 - Fanciful
 - Arbitrary
 - Suggestive
 - Descriptive
 - Generic
- Lanham Act
- Enforcement



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Serious about Registration (--not a complete list--)

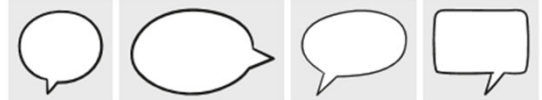
NCAA	PGA	IOC	NFL	FIFA
NCAA®	PGA®	OLYMPIC®	JERSEY FRIDAY®	WORLD CUP 2022®
MARCH MADNESS®	PGA CHAMPIONSHIP®	OLYMPIC GAMES®	TOMORROW STARTS TODAY®	UNITED 2026®
FINAL FOUR®	PGA TOUR®	FRIENDS OF THE GAMES®	NFL®	TO A GREATER GOAL®
THE BIG DANCE®	PGA WORKS®	JOURNEY TO GOLD®	BACK TO FOOTBALL®	FIFA CLUB WORLD CUP®
SPRING MADNESS®	PGA JR. LEAGUE®	OLYMPIC CITY USA®	THURSDAY NIGHT®	FIFA FOUNDATION®
SELECTION SUNDAY®	RYDER CUP EST. 1927®	OLYMPIANS MADE HERE®	FOOTBALL®	CUP FIFA®
MARCH IS ON®	WE ARE 13®	FOLLOW THE SUN®	LEGENDS BRUNCH®	LIVING FOOTBALL®
NCAA SWEET SIXTEEN®	PGA REACH®	TEAM USA®	SUPER BOWL®	FIFA QUALITY®
MARCH MAYHEM®	PGA CUP®	SAFESPORT®	NFL SUNDAY TICKET®	FIFA LIVE YOUR GOALS®
FIRST FOUR®	JUNIOR RYDER CUP®	RINGS OF GOLD®	PRO BOWL®	FIFA WOMEN'S WORLD CUP®
DON'T BET ON IT®	PLAY GOLF AMERICA®	LET THE GAMES BEGIN®	NFL PREDICT THE PICK®	FIFA WORLD CUP®
ONETEAM®	PGA NATIONAL®	GO FOR THE GOLD®	SHIELD GEAR®	FIFA®
BASKETBALL MADNESS®	RYDER CUP®	PAN AM GAMES®	NFL THROWBACKS®	
MAKE IT YOURS®	PLAY, STAY, LIVE AND LEARN®	GOING FOR THE GOLD®	NFL MAN OF THE YEAR®	
MARCH IS ON®		USA®	SUPER SUNDAY®	
NCAA SWEET 16®		FUTURE OLYMPIAN®	GAMEDAY®	
FROZEN FEST®		OLYMPIC SPIRIT®		
CHAMPIONS PLAY HERE®		JUNIOR OLYMPICS®		
FINAL FOUR FRIDAY®		PARALYMPIC®		
COLLEGE CUP®				

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Cautionary Tales: Sports

- The NCAA objects to any unlicensed third-party advertising that refers to MARCH MADNESS®
 - ~~“Wishing the 2023 team success in the NCAA tournament!”~~
 - ~~“Buy in time for March Madness!”~~
 - ~~“Follow us for updates on March Madness!”~~
 - ~~“Join us for Markdown Madness!”~~
- Federal Judge / Court of Public Opinion options
 - Disclaimers not enough.
 - Congratulatory ads seen as insincere.
 - Fair use claims are still expensive.
 - Associations not always appreciated: APRIL MADNESS, FINAL 3, MARCH IS ON!

Cautionary Tales: People



Hypothetical Third-Party Issues in Ads



*“OUR
PRODUCT IS
TOUGH
ENOUGH TO
HOLD UP TO
THE ROCK!”*



*“I’M DANICA
PATRICK, AND I
RELY ON
THESE TIRES
FOR THEIR
SAFETY AND
QUALITY.”*



*“AFTER USING
THE PRODUCT,
MY PATIENTS
HAD AMAZING
RESULTS. - DR.
PHYLL”*



*“THIS IS ELVIS
PRESLEY. I
JUST CALLED
IN TO SAY HOW
MUCH YOUR
PROGRAM
ROCKS!”*



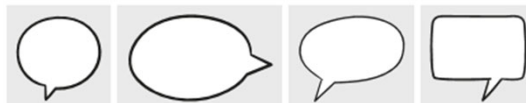
*“YOU DIDN’T ASK,
BUT WE THINK
YOUR SHOW HAS
JUST THE RIGHT
AMOUNT OF JAZZ.
SINCERELY, MAYOR
TORREZ”*

Publicity / Personality Rights



- The right to control the use of one's identity (name, voice, signature, photos, or likeness) for commercial purposes
- State-by-state / Lanham Act / FTC
- Generally, need consent of owner for commercial (including nonprofit, fundraising, or solicitation) purposes
- Possible Exceptions: fair use (factual, newsworthy, parody), 1st Amendment

Cautionary Tales: People + Analysis



Hypothetical Third-Party Issues in Ads

"Our product is tough enough to hold up to The Rock!"

- Advertisements: Approval? Defamation? International issues?

"I, Danica Patrick, rely on these tires for their safety and quality."

- Endorsements: FTC issues? Permission? Factual? Typical to consumers?

"After using the product, my patients had amazing results. - Dr. Phyll"

- Testimonial: Value received/disclosed? Name sound-alike/deception?

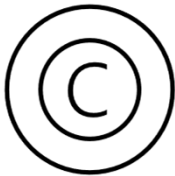
"I just called to say how much your program rocks! This is Elvis Presley."

- Calls / Recordings: Permitted recording? Permitted use? Personality rights after death?

"You didn't ask, but we think your show has just the right amount of jazz.
Sincerely, Mayor Torrez"

- Unsolicited Submission: Public persona or personal? Permitted use?

Cautionary Tales: Copyright issues in Comparisons / Humor



- Copyright protects any “original work of authorship fixed in a tangible medium of expression” (writing, designs, compilations, recordings, film, artwork, etc.)
- Copyright rights arise regardless of formal registration.
- Copyright rights are a “bundle of rights”: reproduction, distribution, performance, display, transmission, derivation
- 17 U.S.C. § 107: “the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting . . . or research, is not an infringement of copyright.”

Fair Use Exceptions

Fair use is an exception to the exclusive rights an intellectual property owner holds.

Trademark Fair Use

- Classic Fair Use: using a mark other than as a trademark and only to describe your own offerings
- Nominative Fair Use: using a mark to refer to the trademark owner’s offerings because it is necessary, minimal, and without implication of endorsement or sponsorship

Copyright Fair Use

Case-by-case considering:

- Purpose and character of the use (commercial, nonprofit, educational?)
- Nature of copyrighted work (published, unpublished?)
- Amount and substantiality of the portion used in relation to the whole
- Effect of the use on the potential market or value of the work



First Amendment considerations (certain laws apply only “where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Mattel v. MCA Records, Inc.* (9th Cir 2002))

Parody / Satire considerations (cannot use IP laws to “censor all parodies or satires which use [its] name or dress.” *New Kids on the Block v. News America Pub., Inc.* (9th Cir 1992))

Fair Use or No?

- A book titled *The Cat NOT in the Hat! A Parody*, by Alan Katz and Dr. Juice summarizing the O.J. Simpson trial. *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997)
- A comparative advertisement put out by Bleem (PlayStation emulator product) declaring “*Play hundreds of PlayStation games on your PC!*” and contrasting Sony’s capabilities and content. *Sony Computer Ent. Am., Inc. v. Bleem, LLC*, 214 F.3d 1022, 1027 (9th Cir. 2000), amended on denial of reh’g (July 10, 2000)
- A children’s book simplifying the novel *Breakfast at Tiffany’s*. *Penguin Random House LLC v. Colting*, 2017 WL 3977000 (SDNY 2017).

Fair Use or No?

- An ad that states, in Dunkin’ Donuts’ font and colors: “*Friends don’t let friends drink Starbucks*” with “*dunkinbeatstarbucks.com*” as a URL.
- An ad showing a Progresso soup can with many stylized people next to it, and a Campbell’s Select Home Harvest soup can depicted with only a few stylized people next to it.
- A comparative advertisement put out by Sega that starts off by saying “*Genesis does what Nintendo’t*” - along with a detailed description and several screen shots.

Cautionary Tales: Fair Use Tips

- Summarize rather than quote; if quoting, quote only a small portion of the work. Excerpting for comment/criticism can be fair use, but only to the extent necessary to make the comment/criticism.
- Make the comparative purpose explicit. Comparative advertising is favored in law (transformative nature can be assumed to a certain extent), but not immune from consequences.
- To the extent possible, avoid literal copies of pictures, photographs, etc. that others authored.
- Check for copyright registrations to be aware of possible claims of statutory damages.
- Incorporate copyright, trademark, and other fair use and infringement considerations into your risk analysis. Cases do go both ways, and because it takes a federal judge to tell you for sure (and they can be expensive), it is best to consider the risks before proceeding.

Parody? 1st Amendment? Fair Use?

- **Jack Daniel's Properties Inc. v. VIP Products**
 - Sold since 2014
 - Demand Letter
 - Declaratory Judgment (Jack Daniel's prevailed)
 - Appeal (VIP Products prevailed)
- Mimics the shape of the Jack Daniel's Old No. 7 bottle and the label's reference to the whiskey's Tennessee origin.
- Front of the Bad Spaniels toy reads "The Old No. 2 on your Tennessee carpet."
- The wording replaces the Jack Daniel's notations of 40% ABV with "43% Poo by Vol." and "100% Smelly."
- *Rogers v. Grimaldi* (875 F.2d 994 [2nd Cir. 1989]): The Lanham Act does not bar "a minimally relevant use of a celebrity's name in the title of an artistic work where the title does not explicitly denote authorship, sponsorship, or endorsement by the celebrity or explicitly mislead as to content."
- Industry standards? *Louis Vuitton v. Haute Diggity Dog* ("Chewy Vuiton"; Haute Diggity Dog prevailed)

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 - **Websites**
 - **Formalities**
 - **Contracts**
 - **International**
 - **Social Media**
 - **Litigation**
 - **Insurance**
- **Best Practices:**
 - Due Diligence
 - Protective Measures
 - Ask for Help

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Related Radio + IP Issues



Music Licensing – copyright rights and licensing obligations



Contests – personality rights, trademark issues, US/international rules



Websites – Privacy Notices, Web Terms, domain names, keyword advertising



Formalities - ADA compliance, DMCA filing, IP registrations

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General Radio + IP Considerations

Contracts – IP
licensing, liability,
ownership of IP

International –
worldwide scope,
overlapping or
conflicting laws,
contracts

Social Media –
account access,
third party
comments, dispute
procedures

Litigation – risks
and costs vs
marketing success

Insurance – review
for business
coverage and any
additional needs

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 - **Due Diligence**
 - **Protective Measures**
 - **Ask for Help**

Radio Advertising + IP Checklist

Due Diligence - Consider:

Trademark Rights

Personality/Publicity Rights

Fair Use

Related Issues

Protective Measures:

- Don't use others' content without permission or analysis of risks
- Know and follow relevant rules
- Protect your own IP
- Ask for help with questions

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