

Intellectual Property **UPDATE**

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Will Schwarzenegger "Terminate" Free Speech in Toy Design?

All the late-night mocking by Leno and Letterman has apparently pushed the Governor past his limit. In an effort to prove to the world that he has a firm head on his shoulders, Arnold Schwarzenegger sued a toy manufacturer for marketing bobbing-head dolls bearing his name, photograph, and likeness without his permission. The bobble-head dolls portrayed the California governor in a statesman-like business suit and military bandoleer, brandishing an assault rifle. The bobble-head packaging juxtaposed depictions of Schwarzenegger as a politician with depictions of him as a Hollywood action hero.



On April 30, Schwarzenegger's production company, Oak Productions Inc., filed a complaint in Los Angeles Superior Court alleging that doll manufacturer Ohio Discount Merchandise Inc. (ODM) misappropriated his name, photograph, and likeness for commercial purposes. The governor believed that by advertising, marketing, promoting, and selling the Arnold Schwarzenegger bobble-head dolls, ODM infringed on his publicity rights and committing the commercial tort of unfair competition.

ODM responded that under the First Amendment, the manufacture of Schwarzenegger bobble-head dolls is constitutionally protected. The company asserted that the bobble-head dolls are constitutionally privileged free speech and do not violate anyone's rights of publicity.

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Bowflex Obtains a Bull's Eye on its Preliminary Injunction Motion Against Crossbow

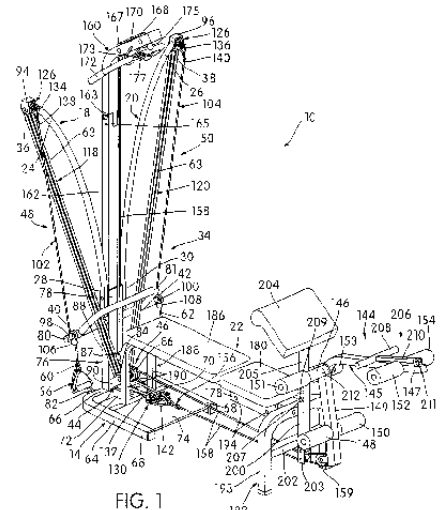
The Court of Appeals for the Federal Circuit (CAFC) recently reviewed the grant of a preliminary injunction in *Nautilus Group, Inc. v. ICON Health & Fitness, Inc.*, (CAFC, June 21, 2004). In this case, the plaintiff, Nautilus, owns the registered and commercially successful "Bowflex" brand for its patented vertical rod resistance exercise machine. Nautilus registered "Bowflex" in 1986 and has spent \$233 million promoting the machine since 1992, resulting in sales of 780,000 units.

In 2002, the defendant, ICON Health & Fitness, Inc. (ICON), introduced its horizontally ending rod resistance

machine under the trademark "Crossbow." ICON claims that the "Crossbow" brand is derived from the resemblance its inverted U-shape machine takes while in use to a medieval crossbow weapon. Nautilus sued ICON for trademark infringement.

Under Ninth Circuit law, a district court may grant a preliminary injunction in a trademark case when the plaintiff demonstrates "either (1) a combination of 'probable success on the merits' and 'the possibility of irreparable injury'

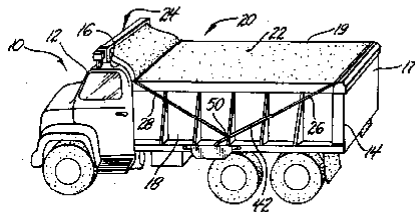
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Patent Claims Reciting Term “Connect” May Be Interpreted Narrowly

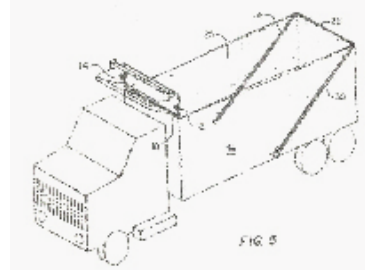
The Federal Circuit affirmed summary judgment of non-infringement in a dispute involving a cover assembly for a dump truck bed in *Searfross v. Pioneer Consol. Corp.*, No. 03-1606 (Fed. Cir., Jul. 6, 2004). As a result of the decision, future patent applications may need to explicitly define “connect,” given the court’s somewhat narrow interpretation of the term.

The Searfross patent claims “a cover assembly for covering a vehicle load bed” that includes an “extension bail” for pulling the flexible cover over the bed of the truck, and a “tension bail” that pushes down on the front end of the cover to keep the truck bed covered without gaps. In analyzing infringement under the doctrine of equivalents, the court acknowledged that Pioneer’s assembly performed “the same function ... with the same result,” but not “in the same way.”



Searfross's Patented Assembly
No. 28 is the Tension Bail

Searfross patent claimed (see figures). Searfross alleged that Pioneer “indirectly connected” the two bails, and pointed to several dictionary definitions of “connect” (e.g. “to join, fasten or link together usually by means of something intervening.”), but the court limited its meaning because the patent used the term “connecting” as synonymous with “attaching,” and because “every pertinent figure depicts a direct connection between the legs of the tension bail and those of the extension assembly.” Ultimately, the court upheld the district court’s interpretation of “‘connecting’ as used in this patent to include only direct, rigid, pivotal connections.”



Pioneer's Allegedly Infringing Assembly
No. 12 is the Tension Bail

Although the court’s definition of “connect” appears to be somewhat fact specific, some practitioners may suggest adding language to patent applications stating that all connections need not be direct, but could also be indirect.■

The court focused on the language of Searfross’ claim, which includes “actuation means for connecting said tension bail to said extension assembly.” Pioneer’s vehicle had a tension bail to keep the cover down in front, but

it wasn’t directly connected to the extension bail as the

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“Intellectual Property: A Basic Overview” Now Available

The second edition of Banner & Witcoff’s “Intellectual Property: A Basic Overview” is now available. Composed by Banner & Witcoff attorneys Jon Nelson, Charles Shifley, Richard Stockton, Douglas Robinson and Holly Ford, the book serves as a guide to understanding United States patent, trademark, copyright, trade secret and related law.

To obtain a copy of the book, please visit www.bannerwitcoff.com or e-mail info@bannerwitcoff.com.





Patent Claim Construction at a Crossroad

In a move applauded by corporations, patentees and patent practitioners alike, the U.S. Court of Appeals for the Federal Circuit agreed to consider questions that are fundamental to patent claim construction and which will affect almost every patent case. Primarily, with respect to claim construction, issues involve the roles of dictionaries and the patent specification, as well as the roles of prosecution history, expert testimony, deference to trial court claim construction, and considerations for avoiding claim invalidity. The Federal Circuit raised these issues on July 21, 2004 in seven questions that it posed as part of an order granting a petition to hear *en banc* the case of *Phillips v. AWH Corp*¹ (Phillips).

Ramifications of the *Phillips* decision will be enormous, as virtually all enforceable U.S. patents could be affected by modifications to the way in which courts construe patent claims. However, few will argue against the need for clarification of these issues. Various opinions from the Federal Circuit over the past several years seem to conflict with each other on their approach to claim construction, which causes confusion for lower courts and interested parties.

Most of the confusion is based on lack of clarity regarding the roles of dictionaries and the specification of a patent, as well as its prosecution history, in determining the meaning of patent claims. In recent cases, the Federal Circuit seems to have relied heavily upon dictionaries to interpret claim language to the extent that many argue the Court has read the claims apart from the specification. In other cases, the Federal Circuit appears to have relied too heavily upon the specification, which many argue has unduly narrowed the claims to include limitations read from the specification. The now vacated three-judge panel decision

of *Phillips*² seems to have been more aligned with the second approach.

The seminal issue of the *Phillips* case is the meaning of the claim term "baffle," which a lower court found was limited by the specification to baffles positioned at a certain angle. The patent at issue is U.S. Patent No. 4,677,798 to Edward Phillips, which is directed to vandalism-resistant modular wall panels for use in security barriers, such as prison walls. The '798 patent describes a single embodiment having baffles angled less than 90 degrees from the wall face and having an interlocking pattern. It states that a purpose of the baffles is to provide impact resistance from bombs, bullets and other projectiles. Under the 'angled less than ninety degrees' meaning of "baffle" as determined by the lower court, Phillips conceded that the defendant does not infringe the claims at issue via its wall panels having baffles oriented perpendicular to the wall face.

The now vacated panel decision ultimately agreed with the lower court as to the meaning of the term "baffle." However, the panel was split with Judge Dyk dissenting from the claim construction portion of the opinion, upon which Judges Newman and Lourie concurred. To support its interpretation of the term "baffle," the majority relied upon the single embodiment of baffles having an obtuse or acute angle from the wall face, the stated purpose of providing impact resistance to projectiles, and prior art that discloses perpendicularly oriented baffles.

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¹ *Phillips v. AWH*, __ F.3d __ (Fed. Cir. 2004) (03-1269,-1286)

² *Phillips v. AWH*, 363 F.3d 1207 (Fed. Cir. 2004) (Lourie, J.)

Upcoming Events and Presentations

December 7 Bradley Wright will speak at the DC Bar's Developments in Intellectual Property Law Program on the topic of "Recent Developments in Patent Law."

December 14 Brian Banner will present on "Hot Topics and Developments in Trademarks" for Part 2 of the District of Columbia Bar's 2004 Intellectual Property Law Year in Review Series.

January 4 Marc Cooperman will speak on "The Year in Review: Trademark Oppositions and Ex Parte Proceedings in the TTAB and Federal Circuit" at the Law Education Institute 2005 National CLE Conference in Aspen, Colorado.

January 26-28 Christopher Renk has agreed to speak at the AIPLA Mid-Winter meeting in Orlando, Florida.

February 24-25 Helen Hill Minsker will be speaking on "Petitions to the Commissioner and Ex Parte Appeals" for the Practicing Law Institute in New York City.

For further information on upcoming events and presentations, please visit www.bannerwitcoff.com or e-mail info@bannerwitcoff.com.



En Banc Decision from Federal Circuit Court of Appeals Changes Law of Willfulness of Patent Infringement

The law of willfulness of patent infringement has changed, in part. The change affects the conclusion to be drawn where a patent infringer (1) never obtained an opinion of counsel regarding the patent at issue or (2) obtained an opinion but refused to disclose it on grounds of privilege. In both situations, there is no adverse inference to be drawn against the infringer that the opinion was or would have been unfavorable. The duty to respect known patent rights, however, remains.

The change occurs because the Court of Appeals for the Federal Circuit recently overturned some of its past precedent. In *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, ___ F.3d ___ (Fed. Cir. Sept. 13, 2004) the Federal Circuit, *en banc*, initially addressed the question of whether an adverse inference of willful infringement should be drawn where a party invokes the attorney-client privilege or the work-product privilege and refuses to disclose an opinion of counsel. According to the Court: "The answer is 'no.' Although the duty to respect the law is undiminished, no adverse inference shall arise from invocation of the attorney-client and/or work product privilege."

The Federal Circuit next directly addressed the question of whether the failure to obtain legal advice regarding infringement created an adverse inference regarding willful infringement. Again, according to the Court: "The answer is 'no.' . . . The failure to obtain an exculpatory opinion of counsel shall no longer provide an adverse inference or evidentiary presumption that such an opinion would have been unfavorable."

As grounds for its first ruling, the Federal Circuit referred to the "public purpose" of encouraging clients to consult with their attorneys and to have "full and frank" discussions. Such discussions, according to the Court, promote the broader public interest in the observance of laws. Previous holdings establishing the adverse inference created a risk that clients would be disinclined to obtain opinions of counsel and created a risk that clients might temper their discussions with their counsel. The "social importance" of open and complete communication between clients and their attorneys could not bear this risk.

As grounds for its second ruling, the Federal Circuit referred to the burdens and costs on individuals and entities in performing an early and full study of every adverse patent of which they had knowledge. These burdens were too high in many cases. According to the

Court, it is not appropriate to require an entity to obtain an exculpatory opinion of counsel that fully addresses all potential infringement and validity issues on every adverse patent in order to avoid an adverse inference of willful infringement.

Although the Court eliminated the adverse inference, it did not eliminate the burden on parties to avoid patent infringement. According to the Court: "there continues to be an affirmative duty of due care to avoid infringement of the known patent rights of others." The Court provided no guidance as to how that duty can be met outside of obtaining an opinion of counsel, except that the existence of a substantial defense to infringement does not, by itself, automatically defeat liability for willful infringement. Judge Dyk dissented with respect to placement of a duty of care on potential infringers.

In addition, the Court confirmed that the "totality of the circumstances" must be analyzed in determining whether infringement is willful. Factors considered in such an analysis include the existence of deliberate copying, whether the infringer had a good-faith belief that the patent was invalid or not infringed, the infringer's behavior in litigation, the closeness of the case, any remedial action taken by the infringer and any concealment by the infringer of its infringements. *See, Read Corp. v. Portec, Inc.*, 970 F.2d 816, 826-827 (Fed. Cir. 1992).

The Federal Circuit's decision can be read to encourage parties to obtain opinions of counsel, through the decision's elimination of a substantial potential litigation "cost" of obtaining such opinions. To avoid a finding of willful infringement, a party must meet its "duty of care." One of the best ways to meet this duty is to obtain an opinion of counsel. The Federal Circuit's decision simply permits clients and counsel to have "free and frank" discussions in obtaining this opinion without the fear that such discussions may create an adverse inference of willful infringement. If a client chooses not to disclose an opinion of counsel, because, e.g., they do not want to waive privilege, the client can meet its duty of care in some other manner. However, the client will not be weighed down in attempting to prove it met its duty by the previous adverse inference of willful infringement. ■

For a complete version
of the *Knorr-Bremse v.
Dana Corporation* decision,
please visit our website at
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Schwarzenegger vs. The First Amendment

Schwarzenegger's suit was premised on the common law right of publicity—that is, a person's right to control the commercial use of his own identity. Although the reach of the publicity right appears broad, it is limited to commercial contexts. Schwarzenegger has the right to prevent people from using his likeness to make money in a strictly commercial setting. For example, he could argue that a manufacturer of steroids cannot use his name, likeness, or photograph to advertise its products without infringing on his right of publicity. Where the governor/action hero probably does not have a case is where his name, likeness, or photograph is being used in the news or for any other noncommercial purpose. There the right of publicity is significantly constrained by the First Amendment privilege of free speech.

Unfortunately for Schwarzenegger, because of the political and "transformative" nature of ODM's bobble head, favorable precedent is in short supply. For example, in one case the California Supreme Court found that a publisher did not infringe on two aging rock stars' rights of publicity by including likenesses of the musicians in a comic book. The court ruled that the comic book transformation of Edgar and Johnny Winter into Johnny and Edgar Autumn contained "significant creative elements." The comic books did not depict the plaintiffs literally; instead, they distorted their images for the purposes of lampoon, parody, or caricature.

“ Even assuming that Schwarzenegger arguably had a viable right-of-publicity case as a celebrity, he essentially said ‘hasta la vista’ to such a claim when he took office. ”

Another court reached a similar conclusion concerning trading cards that featured the caricature and parody of prominent baseball players. Cardtoons produced trading cards that ridiculed many Major League Baseball players using a variety of themes. The cards violated an Oklahoma statute that prohibited the use of a person's name or likeness on commercial merchandise without consent. Nonetheless, a federal appellate court recognized Cardtoons' First Amendment defense—that the cards provided social commentary on public figures who were involved in a significant commercial enterprise. The court explained that the protections of the First Amendment have never been limited to newspapers, books, and comparatively more august outlets. Thus, even if the trading cards were not a traditional medium of expression, they were still subject to some First Amendment protection.

In reaching its conclusion, the Court balanced Major League Baseball's publicity rights with the privilege

of free speech. The court recognized that parody is a valuable form of self-expression and social criticism and a vital commodity in the marketplace of ideas. Restricting the use of celebrity identities for parody would restrict the communication of ideas. Elevating the right of publicity over the First Amendment right to free expression, the court concluded, would essentially allow Major League Baseball to censor criticism of its members. According to the Court, "the last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them."

Arnold Is a Bobble-Head

In other words, "Judgment Day" would not look promising for Schwarzenegger given his new political role. As in the cases described, the Schwarzenegger bobble-head dolls were not literal depictions of the governor. They included transformative elements that distorted Schwarzenegger's image for satire, parody, or caricature.

In particular, dressing the doll in a business suit while arming him with an assault rifle obviously juxtaposed Schwarzenegger's role as a governor with his celebrity career. But more broadly, the form of the expression itself—the toy with a disproportionately sized head that bobs in all directions—had something to say. The doll may have represented the artists' own self-expression, or it may have been a form of social criticism that allowed the artists to communicate their ideas.

And what exact ideas did they want to communicate? Given the added First Amendment protection afforded ODM because of the core "political speech" included, it doesn't really matter. The message could have been as simple as, "Arnold is a bobble head." Whether or not the artists were poking fun at the idea of "The Terminator" as governor, ODM is likely protected under the First Amendment. Indeed, it can be argued that the bobble-head dolls express both the artist's and the purchaser's views of Schwarzenegger as a public figure. The fact that the message is conveyed in a non-traditional form of expression—i.e., a toy—does not eliminate the First Amendment's protections.

Say 'Hasta La Vista'

The limited cases on point illustrate that the First Amendment may outweigh the rights of publicity for all public figures, including celebrities who sell their own image. However, Schwarzenegger is not just any celebrity—he is also the governor of California. As a politician, Schwarzenegger does not get to play by the same rules as other movie stars. Specifically, the law has long protected the public's right to subject politicians to unbridled, unrestrained commentary and criticism. The strength of our democracy and the First Amendment is rooted in Americans' freedom to criticize their political system in any way they please.

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Even assuming that Schwarzenegger arguably had a viable right-of-publicity case as a celebrity, he essentially said “hasta la vista” to a claim when he took office. This is not to say that he has literally waived all his publicity rights, but in the context of commentary on his political aspirations, the First Amendment protects the commentators. Just like he has to put up with ridicule on the “Tonight Show” and the Internet (have you seen the new proposed seal for the State of “Kahlifoania,” which depicts Arnold as a muscular Conan the Barbarian?), the Governor must put up with being treated as a bobble-head.

Avoiding ‘Collateral Damage’

Fortunately for Arnold, ODM has apparently agreed to settle the dispute. ODM announced in early August that it intends to continue to market the Schwarzenegger dolls; however, the 8-inch tall bobble head will be stripped of its assault rifle and military bandoleer. Additionally, a

portion of the proceeds generated from Schwarzenegger dolls will be donated to Arnold’s All-Star school program.

ODM’s decision to end its battle is understandable, though disappointing. Arnold Schwarzenegger the celebrity, chose to become Arnold Schwarzenegger the political figure. He is naturally and intentionally the focus of political free speech. If he can’t accept the public’s right to make fun of him through toys or otherwise, he should look for another starring role. ■



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Brian C. Kwok, a summer associate with Banner & Witcoff in 2004, co-authored this article. A version of this article originally appeared in the July 19, 2004, issue of Legal Times’ supplement, “IP” (www.legaltimes.com).

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or (2) the existence of ‘serious questions going to the merits’ and ‘that the balance of hardships tips sharply in his favor.’” Probable success on the merits requires a showing that the similarity of the marks, among other factors, has created a likelihood of confusion as to the source or origin of the goods. If a likelihood of confusion is found, irreparable injury to the plaintiff may be presumed.

The district court granted the plaintiff’s motion for a preliminary injunction, basing the decision on its application of the Ninth Circuit’s law in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) for measuring likelihood of confusion using (1) the similarity of the marks, (2) the relatedness or proximity of the two companies’ products or services, (3) the strength of the registered mark, (4) the marketing channels used, (5) the degree of care likely to be exercised by the purchaser in selecting goods, (6) the accused infringers’ intent in selecting the mark, (7) evidence of actual confusion, and (8) the likelihood of expansion in product lines, for a preliminary injunction.

The district court concluded that the two marks are somewhat similar, but not necessarily confusing, and that there is some evidence of actual confusion. It further found that ICON might have intentionally created potential confusion by adopting “Crossbow” in an attempt to unfairly capitalize on the plaintiff’s successful marketing of “bow” in the exercise equipment market. Its analysis of these factors favored Nautilus and demonstrated probable success on the merits. ICON disagreed and requested a stay of the preliminary injunction pending the outcome of an appeal to the CAFC.

On appeal, ICON made three arguments, namely, 1) the district court’s failure to make a specific finding on whether any resulting likelihood of confusion was directly caused by the similarity of the marks amounts to reversible error; 2) setting aside the marks’ shared component, “bow,” the remainder of the marks, “flex” and “cross,” are entirely dissimilar so a claim of trademark infringement must fail; and 3) if any likelihood of confusion does exist, it stems from (i) the similarity of the machines functional appearance (bending rods for resistance) that can not be protected by trademark law and/or (ii) Nautilus’s longstanding dominance in this particular industry—not from any closeness of the “Crossbow” and “Bowflex” marks.

In affirming the district court, the CAFC held that ICON’s first argument is without support in the law. As to the second argument, the CAFC held that marks must not be compared in parts but in their entirety. As to ICON’s final argument, the CAFC held that a diminished standard of similarity is applied when comparing the marks of closely related goods, as in this case. There was no legal error in the district court’s analysis that requires reversal. The selection of a trademark by a junior user that incorporates a word from a direct competitor’s commercially successful established trademark may lead to the preliminary injunction of the junior user’s new mark. ■



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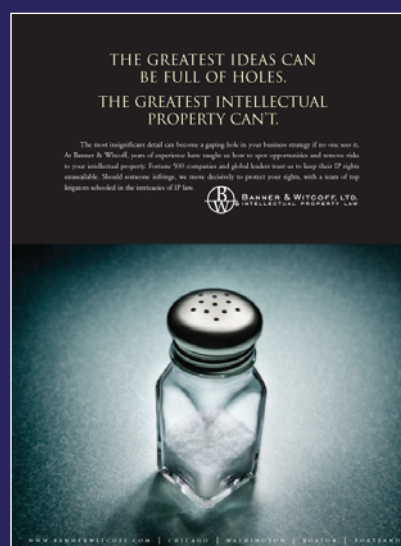
In his dissent, Judge Dyk counters that the plain meaning of the term “baffle” via dictionaries should not be limited to the single embodiment, as the patentee did not act as his own lexicographer and the prosecution history does not disclaim the plain meaning of “baffle.” He further counters that the impact resistance objective is one of several objectives taught in the specification and that claims do not need to meet every stated objective. In addition, he argues it is improper to construe claim language contrary to plain meaning to preserve its validity—particularly without an effort to distinguish the prior art.

Federal Circuit opinions over the past few years provide adequate support for both positions. Whatever the outcome of the *Phillips* case, the *en banc* opinion should remove much of the confusion surrounding claim construction. At the very least, the *en banc* order identifies some of the confusion and the seemingly disparate approaches to claim construction. Hopefully, the outcome of *Phillips* will provide a clear approach to claim construction upon which patentees and interested parties can rely with greater certainty to evaluate the scope of patent claims. ■

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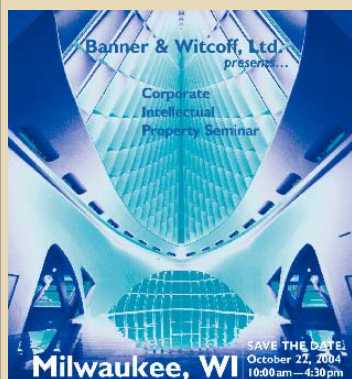


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