

THE LIMITED PROTECTIONS OF INTELLECTUAL PROPERTY  
LAW FOR THE VARIETY ARTS: PROTECTING ZACCHINI,  
HOUDINI, AND CIRQUE DU SOLEIL

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Variety acts are a ubiquitous, yet frequently ignored, subset of the performing arts. This article reviews intellectual property law from the perspective of variety artists, exploring the extent to which United States laws protect their work and the implications for the variety arts.

I. VARIETY PERFORMERS AND THEIR WORK

Variety performers generally present “non-dramatic” acts, performances without a larger, overarching storyline.<sup>1</sup> Vaudeville, for example, was full of variety performers, as were European music halls.<sup>2</sup> A singer or musician may perform as a variety artist when the artist’s performance is not part of a larger dramatic piece. The category of variety artists also includes novelty performers like jugglers, clowns, acrobats, fire-eaters, and circus and sideshow performers.<sup>3</sup> There is an enormous spectrum of variety acts, ranging from the sublime to the ridiculous. One performer worked in Vaudeville for years, tap-dancing with a chicken.<sup>4</sup> Although Vaudeville is gone, the variety arts have survived. Traveling circuses and Las Vegas shows feature variety artists.<sup>5</sup> Many street performers

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1. See, e.g., FRANK CULLEN, VAUDEVILLE, OLD AND NEW: AN ENCYCLOPEDIA OF VARIETY PERFORMERS IN AMERICA xi (2007) (categorizing variety acts as “simply a matter of entertainment” in America, UK, and Australia).

2. See *id.* at xii (“Both music-hall and variety offered a series of unrelated acts grouped together on a bill for an evening’s entertainment.”).

3. See *id.* at ix (listing types of variety acts).

4. Interview with Robert Reynolds, Library of Magic Castle, L.A., Cal. (c. 1998).

5. See *Ringling Bros. and Barnum & Bailey Circus: Meet the Stars*, RINGLING BROS. & BARNUM & BAILEY CIRCUS, <http://www.ringling.com/PortalContent.aspx?linkID>

could be considered variety artists, such as the guitar-playing Naked Cowboy who was a Times Square fixture for years, as well as mimes, magicians, acrobats, and dancers.<sup>6</sup> “The Ed Sullivan Show” featured variety acts, and more recently “30 Seconds to Fame,” “Steve Harvey’s Big Time Challenge,” and “America’s Got Talent” have brought novelty acts to the small screen.<sup>7</sup>

Variety performers generally have different priorities than singers, actors, and the authors of books, when it comes to protecting their work. Unlike most actors, variety artists may play a single role and spend years creating and honing an act that they may perform throughout their career. Many also write their own material and create the act they perform. They usually make their living from live performances, rather than from appearing on TV or in movies or selling recordings of their work, so their interest is less in exploiting video of their act than it is in booking additional live performances. The primary protection desired by variety artists is to prevent competitors from copying their work.

Also, for some kinds of performers, their act’s appeal to an audience is based on novelty. The novelty artist has to show the audience something they have never seen before: something more impossible, unexpected, or dangerous than last time. While the general public may happily listen to a song over and over and demand musicians to perform their classic hits, a magician repeating feats will be greeted with jeers of “I know that one!” and “I’ve seen

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=1197&parentID=1181&assetFolderID=1197 (last visited Sept. 28, 2011) (listing various acts featured in circus). See also *Find Tickets to the Best Las Vegas Shows*, LAS VEGAS.COM, <http://www.lasvegas.com/shows/> (last visited Sept. 28, 2011) (listing wide array of acts performing in Las Vegas).

6. See Randy Kennedy, *Horns and Lots of Pushing: Visitors from Texas Blend In*, N.Y. TIMES, Jan. 27, 2005, at B6 available at <http://www.nytimes.com/2005/01/27/nyregion/27cattle.html> (describing spectrum of performers that could be variety acts).

7. See *The Ed Sullivan Show*, MUSEUM OF BROADCAST COMMUNICATIONS, <http://www.museum.tv/archives/etv/E/htmlE/edsullivans/edsullivans.htm> (last visited Nov. 1, 2011) (listing frequent performers like Elvis Presley and The Beatles, and noting that show also included performances by dancers, comics, and jugglers, among others); *30 Seconds to Fame*, INTERNET MOVIE DATABASE, <http://www.imdb.com/title/tt0329801/> (last visited Nov. 1, 2011) (“Each half-hour episode . . . pit[s] approximately 24 acts of diverse talents in 2 rounds of competition.”); See *Steve Harvey’s Big Time Challenge*, CBS, <http://www.tv.com/steve-harveys-big-time-challenge/show/16937/summary.html> (last visited Nov. 1, 2011) (describing show and listing episode summaries which have included performances by acrobats, jugglers, snake charmers, martial artists, and human cannonballs). Additionally, videos of several performers are available on the website. *Id.* See also *America’s Got Talent*, NBC, [www.nbc.com/americas-got-talent/](http://www.nbc.com/americas-got-talent/) (last viewed Nov. 1, 2011) (“The series is a true celebration of the American spirit, featuring a colorful array of hopeful stars, including singers, dancers, comedians, contortionists, impressionists, jugglers, magicians and ventriloquists.”).

that!” A viewer of recent seasons of “America’s Got Talent” will recall the judges pressing jugglers, acrobats, and other novelty acts for new, more amazing feats in subsequent rounds, but they made no suggestions for singers to, for example, hit higher notes.<sup>8</sup>

Novelty acts are works of art in their own right. Seeing Hugo Zacchini’s Human Cannonball act at a fair, Horace Goldin sawing through a woman’s torso in a theater, or watching Jason Peters put his head in a lion’s mouth in the center ring give audiences a real thrill.<sup>9</sup> Horror movies demonstrate the broad audience for entertainments that shock and frighten.<sup>10</sup> Many novelty acts offer similar thrills in a live performance, where anything can happen. Unlike television, which can be edited or re-shot, live performances are inherently unpredictable. Things go wrong, performances are not always exactly alike, the audience has an effect on the performer, and vice versa. If movies and television shows, which have been carefully protected, provide value to society, so would these variety performances; yet, as this article shows, variety artists do not receive the same incentives and rewards.<sup>11</sup> Intellectual property protections in the United States have been crafted to protect dramatic performances but do not meaningfully protect variety acts. This article will explain the relevant statutes, principles, and cases, then describe elements of a variety act which a creator may want to protect and discuss how current United States law applies to those elements. Finally, this article will review some international approaches and consider whether additional protections would benefit variety artists in the United States.

## II. CURRENT UNITED STATES INTELLECTUAL PROPERTY PROTECTION RELEVANT TO VARIETY PERFORMERS

The United States Constitution provides Congress with the power “to promote science and the useful arts, by securing for lim-

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8. See *America’s Got Talent*, *supra* note 7 (providing recasts of recent seasons of America’s Got Talent).

9. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 563 (1977); see also *Goldin v. Clarion Photoplays*, 195 N.Y.S. 455, 456 (N.Y. App. Div. 1922) (discussing Goldin’s performance in which he saws a woman in half); *His Life is Just One Big Circus*, DAILY PRESS (Feb. 22, 2004), [http://articles.dailypress.com/2004-02-22/features/0402220192\\_1\\_circus-troupe-animal-trainer-lions](http://articles.dailypress.com/2004-02-22/features/0402220192_1_circus-troupe-animal-trainer-lions) (discussing Peters’s act of sticking his head inside mouth of lion).

10. See David Germain, ‘Amityville’ *Tops Box Office at \$23 Million*, ALBUQUERQUE J., April 18, 2005, at A3, 2005 WL 15010782 (“[H]orror movies have become almost a sure-thing in Hollywood.”).

11. See *Zacchini*, 443 U.S. at 578 (noting policy goal that public not be “deprived of the benefit of [Zacchini’s] performance”).

ited times to authors and inventors the exclusive right to their respective writings and discoveries.”<sup>12</sup> Accordingly, patents and copyrights are granted for the benefit of the public to give creators and authors incentives to produce new works by allowing them “to reap the reward of [their] endeavors.”<sup>13</sup> The Supreme Court explained that copyrights are “intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of this genius after the limited period of exclusive control has expired.”<sup>14</sup> The following protections have been crafted to encourage the advancement of science and the useful arts, and have some application, however limited, to the variety arts.

### A. Trade Secrets

Trade secret law acts mainly as an industrial protection, giving companies legal rights over the techniques, formulae, and devices they create in hopes of getting an advantage over their competition.<sup>15</sup> Archetypal trade secrets are Kentucky Fried Chicken’s secret mixture of herbs and spices and the formula for Coca-Cola. Although international treaties require the United States to offer protection for trade secrets, each state enacts its own laws.<sup>16</sup> The vast majority of states have adopted the Uniform Trade Secrets Act (“UTSA”).<sup>17</sup> UTSA provides protection for information which “derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value

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12. U.S. CONST. art. 1, § 8.

13. See *Zacchini*, 433 U.S. at 573 (noting State’s interest akin to those of copyright and patent laws).

14. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

15. See ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 28-29 (Aspen Publishers, 3d ed. 2003) (discussing trade secret law goals).

16. See UNITED STATES PATENT AND TRADEMARK OFFICE, *Agreement on Trade-Related Aspects of Intellectual Property Rights*, art. 39.2 (1994) (requiring members to offer trade secret protection); see e.g., Alaska Stat. §§ 45.50.910 et seq. (“Injunctive relief for misappropriation of trade secrets.”); Fla. Stat. Ann. §§ 688.001 et seq. (noting that “Sections 688.001-688.09 may be cited as the ‘Uniform Trade Secrets Act.’”); Va. Code Ann. §§ 59.1-336 et seq. (listing example requirements for individual states).

17. See *Uniform Business and Financial Laws Locator: Uniform Trade Secrets Act*, CORNELL UNIVERSITY LAW SCHOOL (Apr. 2003), <http://www.law.cornell.edu/uniform/vol7.html#trdsec> [hereinafter UTSA] (listing states that have enacted UTSA). Forty-four states have adopted UTSA. *Id.*

from its disclosure or use.”<sup>18</sup> The owner of the information must take “efforts that are reasonable under the circumstances to maintain [the information’s] secrecy” to maintain protection.<sup>19</sup> Qualifying for trade secret protection may be simple, but protection is easily lost. Once precautions are taken, UTSA only protects trade secret owners against use or exposure by those who obtain the information through misappropriation, such as “theft, bribery, misrepresentation, breach or inducement of a breach of a duty to maintain secrecy, or espionage.”<sup>20</sup> If competitors can learn the secret without using nefarious means, for example, by reverse engineering it, taking apart a legitimately obtained product to discover the secret, they can do whatever they like with it—publish the secret, use it themselves, or give it away.<sup>21</sup> Trade secret statutes also provide no protection if the secret can be discovered by “observation of the item in public use or on public display.”<sup>22</sup>

## B. Patents

Patents allow inventors to reserve the rights to use and exploit their inventions. Federal law governs the application process, requirements, and the extent of the protection.<sup>23</sup> To be eligible for a patent, an invention must be the proper subject for a patent, a “process, machine, manufacture, or composition of matter,” which is also new, useful, and non-obvious.<sup>24</sup> In order to receive a patent and the protection it grants, an inventor must file an application with the Patent and Trademark Office (“PTO”). The application must contain, among other things, enough information about the invention that others will be able to understand, make, and use it.<sup>25</sup> When a patent is issued, the PTO publishes it. Patents are public documents and are available online.<sup>26</sup> Once an inventor has re-

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18. UTSA § 1(4)(i).

19. UTSA § 1(4)(ii).

20. UTSA §1(1). *See* § 1(2) (defining “misappropriation”).

21. *See id.* § 1 cmt. 2 (elaborating on policy behind trade secret law of maintaining standards of commercial ethics).

22. *Id.* § 1 cmt. 4.

23. *See* 35 U.S.C. §§ 101-105 (2006) (describing conditions for patents and scope of protection).

24. *See id.* §§ 101-103 (explaining requirements of patent eligibility).

25. *See id.* § 112 (noting requirements of specification).

26. *See Patent Full-Text and Full-Page Image Databases*, USPTO (August 26, 2010), <http://www.uspto.gov/patft/index.html> (providing access to patents online).

ceived a patent, the inventor has exclusive rights to the invention for twenty years and may sue others to stop infringement.<sup>27</sup>

In addition to the patents described above, design patents are also available to protect non-functional design elements which are “new, original and ornamental.”<sup>28</sup> For a design to receive protection, it must be unique or peculiar, and distinctive.<sup>29</sup> Hidden features of the design, or internal elements of a device, are generally not eligible for design patents.<sup>30</sup> Nor are elements that are required for the item to function.<sup>31</sup> The same general laws apply to design patents as apply to patents for mechanical devices.<sup>32</sup> However, the test for infringement of a design patent asks whether the patented design and the allegedly infringing design are so similar that a potential purchaser would mistake one for the other and purchase the infringing item in error.<sup>33</sup>

### C. Trademarks/Service Marks

Trademark law was created to protect consumers by eliminating confusion as to the origin of goods.<sup>34</sup> The theory was that consumers rely on the artisan’s mark in selecting which items to purchase, so a new artisan should be forbidden to use a mark which was already in use (the “senior mark”) because use of the senior mark would confuse consumers into purchasing the new artist’s goods, of unknown quality, when the consumers meant to buy the senior mark-holder’s goods.<sup>35</sup> Service marks serve the same function for designating services. A service mark is “any word, name,

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27. See 35 U.S.C. § 154 (a)(2) (2006) (providing term of patent, subject to payment of fees).

28. Patents for Designs, 35 U.S.C. § 171 (2006) (awarding patents for persons who “invent any new, original, and ornamental design for an article of manufacture, may obtain a patent therefore, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided”).

29. See *id.* § 103 (describing conditions required for patentability, including non-obviousness).

30. See 69 C.J.S. Patents § 100 (2011) (explaining that it is structure itself that is eligible for patent, as opposed to method of its operation).

31. See *id.* (furthering notion that structure is what is patented, not method of operation).

32. See *id.* (explaining that distinguishing factor, however, is that appearance of structure is evaluated in mechanical patents for patentability).

33. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676 (Fed. Cir. 2010) (providing test for infringement of design patent where owner bought infringement action against competitor).

34. See *MERGES ET AL.*, *supra* note 15, at 529-30 (describing background and purpose of trademark law).

35. See *id.* (explaining rationale of trademark law).

symbol, or device, or any combination thereof [used] to identify and distinguish the services of one person and to indicate the source of the services, even if that source is unknown.”<sup>36</sup>

The Lanham Act lays out federal law regarding trademarks and service marks.<sup>37</sup> In addition to words, scents, colors, and shapes, sounds have been granted trademark protection.<sup>38</sup> The Lanham Act also protects against the use of marks (whether or not they are registered), that are likely to mislead the public about where the marked goods or services came from, or who sponsors or recommends the goods.<sup>39</sup>

To receive protection, a mark must be distinctive.<sup>40</sup> A mark’s distinctiveness depends on which category the mark falls into: generic, descriptive, suggestive, arbitrary, or fanciful.<sup>41</sup> If a mark is classified as suggestive, arbitrary, or fanciful, the mark is “inherently distinctive” and receives protection automatically.<sup>42</sup> If a mark is classified as either generic or descriptive, it will only receive protection if a “secondary meaning” attaches to it.<sup>43</sup> Secondary meaning is proven if: (1) actual customers associate the claimed mark with the particular producer; (2) there has been sufficient advertising under the claimed mark; (3) the mark has been used sufficiently; and (4) the producer has had exclusive use of the mark.<sup>44</sup> Consumer surveys are often used to prove secondary meaning, but a

36. See 15 U.S.C. § 1127 (2006) (defining “service mark” under federal trademark laws).

37. See generally 15 U.S.C. § 1051 (2011) (providing background of trademark and service marks).

38. See *In re Clarke*, 17 U.S.P.Q.2d 1238, 1238-40 (TTAB 1990) (allowing Plumeria scent as trademark of sewing threads and embroidery yarns); see also COCA-COLA BOTTLE, Registration No. 696,147 (citing protection of Coca-Cola bottle shape); NBC CHIMES, Registration No. 523,616 (citing protection of NBC chime sound); NBC CHIMES, Registration No. 916,522 (citing protection of NBC chime sound); MGM LION ROAR, Registration No. 7,3555,319 (citing protection of MGM lion roar).

39. See 15 U.S.C. §1125(a) (2006) (presenting how Lanham Act protects public from misleading marks).

40. See *Rice v. Fox Broad. Co.*, 148 F. Supp. 2d 1029, 1064 (C.D. Cal. 2001) (stating valid mark must be “inherently distinctive” or have taken on distinctive “secondary meaning”).

41. See *id.* (categorizing marks into increasing levels of distinctiveness).

42. See *id.* (recognizing suggestive, arbitrary, and fanciful marks as “inherently distinctive”).

43. See *id.* (reiterating that validity established through acquisition of “so-called ‘secondary meaning’”).

44. See *id.* at 1065 (listing factors used to determine “secondary meaning”).

broadly advertised mark may eliminate the need for survey evidence.<sup>45</sup>

Once a mark is deemed worthy of protection, the court will consider whether the competing mark infringes on the protected mark. When determining infringement, an important element is the likelihood of confusion. If goods with similar marks are in competition, "infringement usually will be found if the marks are sufficiently similar that confusion can be expected."<sup>46</sup> If a customer would reasonably think the products were related if they had the same mark, then additional factors come into play.<sup>47</sup> These factors are: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines.<sup>48</sup> To prove confusion, the mark owner is not limited to the perception of the purchaser.<sup>49</sup> If a third party, upon viewing the allegedly infringing product after a consumer purchased it, would be confused about the origin of the product, infringement would be actionable, even if the actual purchaser could not have been confused.<sup>50</sup>

If there is no possibility of confusion, a mark holder can still prevent the use of a competing mark if the new use of the competing mark would cause dilution of the senior mark.<sup>51</sup> Dilution re-

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45. *See id.* ("Association of a mark with a particular product is most often proven by use of consumer surveys, though where there has been substantial advertising under the mark no such survey is explicitly necessary for secondary meaning.")

46. *See* AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979) (quoting Ninth Circuit's determination for whether trademark infringement is apparent).

47. *See id.* ("When the goods are related, but not competitive, several other factors are added to the calculus.")

48. *See id.* at 348-49 (listing factors that come into play for determining infringement if customer reasonably thinks two products would be related if they had same trademark).

49. *See* Lois Sportswear v. Levi Strauss & Co., 799 F.2d 867 (2d Cir. 1986) (protecting trademark status of stitching pattern on rear pocket of Levi jeans).

50. *See id.* at 872-73 (discussing both purchaser and post-sale perception of general public).

In the instant case, this post-sale confusion would involve consumers seeing appellant's jeans outside of the retail store, perhaps being worn by a passer-by. The confusion the Act seeks to prevent in this context is that a consumer seeing the familiar stitching pattern will associate the jeans with appellee and that association will influence his buying decisions.

*Id.* (citing *Grotian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1342 (2d Cir. 1975)).

51. *See* 15 U.S.C. § 1125(c) (2006) (presenting possibility for mark holder to prevent use of competing mark in absence of customer confusion); *see also* East-

quires proof of five elements: “(1) the senior mark must be famous; (2) it must be distinctive; (3) the junior use must be a commercial use in commerce; (4) it must begin after the senior mark has become famous; and (5) it must cause dilution of the distinctive quality of the senior mark.”<sup>52</sup> Dilution can happen in two forms. Either the mark is blurred by “lessening . . . the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of” confusion or even competition between products, such as making a mark less exclusive; or the mark is tarnished by associating the mark with some negative quality, like a low-quality or offensive product.<sup>53</sup>

#### D. Copyrights

American copyright law grew out of the English Statute of Anne, which gave an author monopoly rights over the author’s book.<sup>54</sup> The Constitution provided for copyright laws to “promote the Progress of Science and useful Arts.”<sup>55</sup> The United States approach distinguishes our copyright law from its predecessor, as U.S. copyright laws were not intended primarily to protect the author, but to encourage creativity and the creation of new works for the benefit of the public.<sup>56</sup> Current copyright law is embodied in the 1976 Copyright Act, which has since been amended and modified several times.<sup>57</sup> The federal law preempted protections that had already been articulated in state statutes and in common law.<sup>58</sup>

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man Photographic Materials Co. v. Kodak Cycle Co., [1898] EWHC (Pat) 15 R.P.C. 105 (Eng.) (holding that even though use of name Kodak for bicycles would not cause confuse public, it injures original mark owner by making mark less exclusive); Trade-Related Aspects of Intellectual Property Rights, art. 26, April 15, 1994, 33 I.L.M. 119 (discussing protection against dilution of trademarks was also required by TRIPS).

52. See *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 217 (2d Cir. 1999) (finding crackers produced by Nabisco diluted Pepperidge Farm’s trademark of “orange, cheddar cheese-flavored, fish-shaped crackers”).

53. See 15 U.S.C. § 1125 (presenting two forms of dilution); see also *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996) (holding that Muppet character “Spa’am” in *Muppet Treasure Island*, porcine barbarian chieftain, did not tarnish tinned meat trademark).

54. See MERGES ET AL., *supra* note 15, at 320 (presenting fact that American copyright law grew out of English law).

55. See U.S. CONST. art. I, § 8, cl. 8 (stating that U.S. Constitution promotes progress of science and arts for copyright considerations).

56. See *id.* (indicating how U.S. laws distinguish from English law in that U.S. laws promote benefit to public at large instead of individual authors).

57. See MERGES ET AL., *supra* note 15, at 322 (acknowledging amount of times U.S. copyright laws have been amended).

58. See 17 U.S.C. § 301 (1998) (presenting federal law text acknowledges for preempting state laws); see also MERGES ET AL., *supra* note 15, at 322 (explaining

To be eligible for a copyright, a work must be the proper subject matter for a copyright. The federal statute protects:

[O]riginal works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated . . . . Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works
- (5) pictorial, graphic and sculptural works
- (6) motion pictures and other audiovisual works
- (7) sound recordings; and
- (8) architectural works.<sup>59</sup>

“Literary works” does not refer to a level of quality or artistic merit. “[C]atalogs, directories, . . . instructional works, compilations of data [,] computer data bases, and computer programs . . .” all qualify for protection.<sup>60</sup> In addition to the precise text of the work, copyright law proscribes too-close imitation, else a “plagiarist would escape liability by immaterial variations.”<sup>61</sup> Sections (3) and (4) protect fixed directions for performing “dramatic works” and “pantomimes and choreographic works.”<sup>62</sup> A dramatic work has been defined as a performance that tells a story in a way that the audience perceives the events as unfolding in front of them, rather than being described to them.<sup>63</sup> Pantomimes are performances of silent gesture, and the term “choreographic works” is usually inter-

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how federal law preempted certain state laws to offer certain copyright protection).

59. See 17 U.S.C. § 102 (1990) (presenting eligibility requirements for protection under federal copyright law).

60. See H.R. REP. NO. 94-1476 (1976) (exemplifying what Congress intended to qualify for protection).

61. See *Nichols v. Universal Pictures*, 45 F.2d 119, 121 (2d Cir. 1930) (describing importance of not limiting protection of literary property to text alone).

62. See 17 U.S.C. § 102 (1990) (highlighting two areas of subject matter covered by copyright law).

63. See 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.07[A] 2-60 (2007) (citing *Kalem Co. v. Harper Bros.*, 222 U.S. 55, 61 (1911)). Nimmer illustrates that ballets, or similar performances, are copyrightable, but social dancing is not. See also 17 U.S.C. § 102 (1990) (defining protection for dramatic works under copyright law).

preted to cover dance performances.<sup>64</sup> Under the 1909 Copyright Act, only dramatic choreographic works or pantomimes were protected.<sup>65</sup> Protection was expanded to include non-dramatic pantomimes and choreographic works in 1976.

Copyrights protect the expression of the idea, but do not protect the underlying concept. The work to be protected must be original and recorded in a “tangible medium of expression,” like a script, video, or set of choreography notations.<sup>66</sup> The copyright owner receives exclusive rights to copy, distribute, perform, display, and create derivative works or compilations of the copyrighted work for the life of the author plus seventy years, or ninety-five years from publication, if the author is an entity, rather than an individual.<sup>67</sup>

To enforce these rights, a copyright owner may sue for infringement. She must prove that the infringer made unauthorized copies of her work, either by showing direct evidence of copying or proving that the infringer had access to her work and that the allegedly infringing work is substantially similar to hers. A plaintiff shows access by proving the defendant had an “opportunity to view or to copy plaintiff’s work.”<sup>68</sup>

The substantially similar elements must be protectable portions of the original work.<sup>69</sup> Since expressions, and not ideas, are protected under copyright law, a court will only consider similarity of expressions.<sup>70</sup> However, not all elements of expressions can be

64. See NIMMER & NIMMER, *supra* note 63, § 2.07[B] 2-70 (providing usual interpretations for pantomimes and choreographic works).

65. See MERGES ET AL., *supra* note 15, at 370 (describing limited scope of 1909 Copyright Act).

66. See 17 U.S.C. § 101 (2010) (“A work is ‘fixed’ in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”).

67. See 17 U.S.C. § 302 (1998) (noting timeline for copyright protection).

68. See *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1172 (9th Cir. 1977) (holding that defendant must have had reasonable opportunity to see plaintiff’s work). Mere speculation of access is not sufficient to infer access. See *Rice v. Fox Broad. Co.*, 148 F. Supp. 2d 1029, 1049 (C.D. Cal. 2001) (holding that it is impermissible to infer access “through mere speculation or conjecture”).

69. See NIMMER & NIMMER, *supra* note 63, § 13.03[A][1][e], at 13-52 to 13-53 (noting if there is “nonliteral similarity” only in relation to particular segment of plaintiff’s work, and this segment is “a copyrightable portion of a collective work,” then substantial similarity requirement may not apply).

70. See *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir. 1997) (noting substantial similarity does not apply to “similarity of ideas or concepts”).

protected.<sup>71</sup> A plaintiff cannot rely on unprotectable elements to show similarity, and these elements must be “identified, or filtered, before the [original and allegedly infringing] works can be considered as a whole.”<sup>72</sup> There are also several specific limitations on protection for expressions of the same or similar ideas.

The merger doctrine limits protection for expressions of an idea if there are a limited number of ways to express an idea, or if “the expression provides nothing new or additional over the idea.”<sup>73</sup> Courts will consider the idea and the expression of the idea to merge, and will refuse to enjoin subsequent substantially similar expressions in order to avoid prohibiting all future use of the idea.<sup>74</sup> For example, in one case, a particular design for a jeweled brooch in the form of a bee merged with the idea of a jeweled bee-shaped pin, and a similar design could not be enjoined.<sup>75</sup> Application of the merger doctrine will hinge on how narrowly or broadly a court defines the idea being expressed.<sup>76</sup> Once a court deems that idea and expression have merged, the original “will only be protected against nearly identical copying.”<sup>77</sup>

Stock elements in a work also cannot be protected. These “scènes à faire,” or “scenes which must be done,” are so common and expected in certain works that there is no originality in includ-

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71. See *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir. 1994) (noting that some “limiting doctrines” are applied to protection of expressions).

72. See *id.* at 1446 (affirming principle that party claiming infringement may not establish similarities in expression which stem from un-protectable elements).

73. See *Krofft Television Prods.*, 562 F.2d at 1168 (detailing requirements for expressions with respect to merger doctrine); see also *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678 (1st Cir. 1967) (finding that where subject matter allows for, at most, limited number of forms of expression, copyrighting is inappropriate).

74. See *Morrissey*, *supra* note 73, at 678-79 (“[T]o permit copyrighting [in such circumstances] would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance”); see also *NIMMER & NIMMER*, *supra* note 63, § 13.03[B][3], at 13-86 (providing theoretical overview of merger doctrine).

75. See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 739, 742 (9th Cir. 1971) (holding that idea and expression of bee pin design were indistinguishable). *But see* *Maggio v. Liztech Jewelry*, 912 F. Supp. 216, 223-24 n.5 (E.D. La. 1996) (maintaining that idea of jewelry pin did not merge with expression because of unique and original arrangement of jewels).

76. See *NIMMER & NIMMER*, *supra* note 63, § 13.03[B][3], at 13-88.3 to 88.4 (recognizing application of merger doctrine hinges on definition of “idea,” and discussing conclusions reached by several courts on this issue).

77. See *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994) (citing *Krofft Television Prods.*, 562 F.2d at 1167-68) (describing occurrence which prompts protection against nearly identical copying).

ing them.<sup>78</sup> Certain characters, settings, or events are practically indispensable to a genre.<sup>79</sup> For example, in the context of a magic show, a magician dressed in top hat and tails, using a black wand with white tips, and pulling a rabbit out of a hat would all be considered *scènes à faire*, and could not be used to establish substantial similarity.<sup>80</sup> As in the case of merged expressions, *scènes à faire* are only protected if the copy is almost identical.<sup>81</sup>

In addition to individual works, an author may copyright a compilation, which is “formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.”<sup>82</sup> The underlying elements in the compilation do not have to be copyrightable by the creator of the compilation, but only the creator’s additions or the compilation as a whole will be protected by the compilation’s copyright.<sup>83</sup> In a compilation copyright claim, “protection may extend only to those components of a work that are original to the author.”<sup>84</sup> For example, in *Roth Greeting Cards v. United Card Company*, the Ninth Circuit agreed with the district court that even though the text and images on Roth’s greeting cards were not original, and no individual element on the cards was copyrightable, a card should be considered as a whole.<sup>85</sup> Looking at the overall card, the court found a

78. See *Schwarz v. Universal Pictures Co.*, 85 F. Supp. 270, 275 (S.D. Cal. 1945) (defining “*scènes à faire*”); see also NIMMER & NIMMER, *supra* note 63, § 13.03[B][4], at 13-88.5 (explaining that *scènes à faire* doctrine often immunizes individual from liability if similarity of plots follows from common theme).

79. See NIMMER & NIMMER, *supra* note 63, § 13.03[B][4], at 13-88.5 (noting that elements, including characters, are unprotected if they are “as a practical matter indispensable, or at least standard, in the treatment of a given [idea]”); see also *Apple Computer*, 35 F.3d at 1444 (quoting *Frybarger v. Int’l Bus. Machs. Corp.*, 812 F.2d 525, 530 (9th Cir. 1987)) (using “as a practical matter indispensable” language to reiterate that such basic ideas are not protected).

80. See NIMMER & NIMMER, *supra* note 63, §13.03[B][4], at 13-88.4 to 13-88.7 (discussing generally examples of *scènes à faire* and their unprotected nature).

81. See *Apple Computer*, 35 F.3d at 1444 (affirming well-recognized principle that “when an idea and its expression are indistinguishable,” expression is only protected against “nearly identical copying”).

82. See 17 U.S.C. § 101 (2010) (providing definitions).

83. See 17 U.S.C. § 103(b) (“The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.”).

84. *Feist Publ’ns., Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991) (describing how copyrights do not necessarily protect every element of work).

85. See *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109 (9th Cir. 1970) (“[T]here was substantial evidence to support the district court’s finding that the textual matter of each card, considered apart from its arrangement on the cards and its association with artistic representations, was not original to Roth and

valid copyright, and held that United Card Company's card infringed on Roth's copyright because the "total concept and feel" of the cards were the same and the similarity between the cards was clear to a casual observer.<sup>86</sup>

Accordingly, the more original a work, the more protection copyright law gives it. If a work is made mainly of *scènes à faire* or expressions that merge with the ideas they represent, the work will only get "thin" protection from "nearly identical copying."<sup>87</sup> If the work is more original, it will receive broader protection.<sup>88</sup>

The proper test for determining substantial similarity varies among jurisdictions. The traditional test in the lower courts is the audience test.<sup>89</sup> That test hinges on the "spontaneous and immediate" reaction of the ordinary person.<sup>90</sup> If the work is aimed at a particular audience, the court will consider the reaction of that audience, rather than the reaction of the general public.<sup>91</sup>

The Second Circuit still uses the audience test, judging "substantial similarity 'by the spontaneous response of the ordinary lay observer'" to the protectable elements of the works.<sup>92</sup> In *Arden v. Columbia Pictures Industries*,<sup>93</sup> the court compared the novel "One Fine Day" with the film "Groundhog Day."<sup>94</sup> While both works used the idea of a man forced to relive the same day over and over, the court found that no reasonable jury could find the protectable ele-

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therefore not copyrightable. However, proper analysis of the problem requires that all elements of each card, including text, arrangement of text, art work, and association between art work and text, be considered as a whole.").

86. See *id.* at 1110 ("The test of infringement is whether the work is recognizable by an ordinary observer as having been taken from the copyrighted source.") (quoting *White-Smith Music Pub. Co., v. Apollo Co.* 209 U.S. 1, 17 (1907)).

87. See *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994) (explaining doctrine of *scènes à faire*); *Feist Publ'ns.*, 499 U.S. at 357-58 ("[T]he principal focus should be whether the selection, coordination, and arrangement [of facts] are sufficiently original to merit protection. Not every selection, coordination, or arrangement will pass muster.").

88. See *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1524 (9th Cir. 1992) (illustrating that works of fiction and works that are less functional receive more copyright protection than works that are mostly based on facts).

89. See *NIMMER & NIMMER*, *supra* note, 63, § 13.03[E][1] 13-82 and accompanying text for examples of cases applying the audience test.

90. *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 18 (9th Cir. 1933).

91. See *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164-66 (9th Cir. 1977) (holding that since work was aimed at children, children's reactions were determinative in establishing substantial similarity between work in question and copyrighted work).

92. *Arden v. Columbia Pictures Indus.*, 908 F. Supp. 1248, 1258 (S.D.N.Y. 1995) (quoting *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 51 (2d Cir. 1986)).

93. 908 F. Supp. 1248 (S.D.N.Y. 1995)

94. See *id.* at 1249-50 (describing case in which novel and movie made twelve years later both tell story about man who relives same day repeatedly).

ments in the two works to be substantially similar.<sup>95</sup> The court reviewed the various elements the plaintiff claimed were similar, and noted that while there are similar elements—using knowledge gained in previous repetitions of the day, breaking the alarm clock that wakes them with the same recording every morning, and characters committing suicide—the similar ideas are “expressed through different details” in the two works.<sup>96</sup>

In *Feist Publications, Inc. v. Rural Telephone Service Co.*,<sup>97</sup> the Supreme Court applied a different test.<sup>98</sup> Because the works at issue in *Feist* were two telephone directories, an audience’s view of similarity between the two works would not have been terribly enlightening, one phone book being much like another.<sup>99</sup> That Court applied a more critical analysis. It identified the material in *Feist*’s directory that was not copyrightable, and eliminated it from the similarity comparison.<sup>100</sup> Then, the Court determined that since Rural Telephone Service had only copied non-protectable elements from *Feist*’s directory, there was no infringement.<sup>101</sup>

A two-part test for substantial similarity has been developing since 1946.<sup>102</sup> In *Arnstein v. Porter*,<sup>103</sup> plaintiff Arnstein sued songwriter Cole Porter for violating Arnstein’s copyright in a piece of music.<sup>104</sup> The court noted that the proper procedure would be to first consider if the defendant had copied, allowing critical analysis

95. *See id.* at 1260 (reasoning that One Fine Day had much more “complex plot” and was much more detailed and developed than Groundhog Day, which was “light-hearted comedy,” and that, while stories had some similarities, “plot and fundamental essence” of works differed).

96. *See id.* at 1262-63 (showing that even though there are multiple examples of similarities between novel and film, similarities are “insubstantial or pertain to noncopyrightable ideas”).

97. *Feist Publ’ns., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

98. *See id.* at 361-64 (laying out two-part test to establish copyright infringement).

99. *See id.* (analyzing differences in phonebooks and creative content versus purely factual information); *see also* NIMMER & NIMMER, *supra* note 63, § 13.03[E][1][b] (discussing Court’s reasoning in *Feist*).

100. *See Feist*, 499 U.S. at 361-62 (determining that although plaintiff discovered and recorded names to compile phone book, information was raw data and factual, and as such, not able to be copyrighted).

101. *See id.* at 363-64 (asserting facts plaintiff used in its phone book were not original and would continue to exist even if plaintiff never published phone book; the underlying material in phonebook therefore failed originality requirement for copyright protection).

102. *See Arnstein v. Porter*, 154 F.2d 464, 468-69 (2d Cir. 1946) (outlining essential, separate elements needed in order to recover on copyright infringement claim).

103. 154 F.2d 464 (2d Cir. 1946).

104. *See id.* at 467 (noting plaintiff’s cause of action for copyright infringement regarding musical pieces). Cole Porter wrote “Anything Goes,” “Don’t Fence

and expert testimony to inform the decision.<sup>105</sup> If copying was found, the test would then require application of the old audience test, without any critical dissection of the works, to decide if enough of the original work had been appropriated to support the plaintiff's claim.<sup>106</sup>

In *Sid & Marty Krofft Television Productions, Inc. v. McDonalds Corp.*,<sup>107</sup> the Ninth Circuit provided a slightly different two-part test for infringement. First, the court applied an extrinsic, or objective, test.<sup>108</sup> Using expert testimony and step-by-step analysis, a court objectively determines whether the *ideas* are substantially similar.<sup>109</sup> The court may consider the ideas, the type of work, materials used in the work, the subject, and the setting.<sup>110</sup> The extrinsic test may "require[ ] a comparison of plot, theme, dialogue, mood, setting, pace and sequence."<sup>111</sup>

If the court finds similarity, it continues to the intrinsic/subjective test, to determine if "there is substantial similarity in the *expression* of the ideas so as to constitute infringement."<sup>112</sup> In this second part of the test, no expert testimony or analysis is allowed. The issue is whether a casual observer would notice a similarity in the "total concept and feel of the works."<sup>113</sup>

The extrinsic first prong of the *Krofft* test has continued to develop in the Ninth Circuit and is no longer restricted to comparing ideas.<sup>114</sup> The first prong "now objectively considers whether there are substantial similarities in *both* ideas and expression," and the

Me In" and "De-Lovely," among other songs. *See generally id.* (introducing defendant as composer).

105. *See id.* at 468 (discussing different approaches to determine whether copying occurred).

106. *See id.* (addressing second prong of similarity test).

107. *Krofft Television Prods., Inc. v. McDonalds Corp.*, 562 F.2d 1157 (9th Cir. 1977).

108. *See id.* at 1164 (addressing components of extrinsic test).

109. *See id.* (emphasis added) (explaining extrinsic test's reliance on "specific criteria").

110. *See id.* (listing "specific criteria").

111. *See Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984) (citation omitted) (listing factors helpful for determining similarities between ideas), *cert. denied*, 470 U.S. 1052 (1985).

112. *See Shaw v. Lindheim*, 919 F.2d 1353, 1358 (9th Cir. 1990) (emphasis added) (citation omitted) (discussing application of intrinsic-subjective test).

113. *See Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000) (describing second prong of two-part extrinsic/intrinsic test to determine similarity in works of art).

114. *See Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994) (discussing evolution of extrinsic test).

second prong continues to subjectively compare only expression.<sup>115</sup> The *Apple Computer, Inc. v. Microsoft Corp.*<sup>116</sup> court suggested three steps for evaluating the first prong in 1994.<sup>117</sup> First, the plaintiff lists the similar elements between the plaintiff's work and the allegedly infringing work.<sup>118</sup> Second, the court uses analyses and expert opinions to decide which elements named by the plaintiff in step one are protected under a copyright and which are unoriginal, merged with the idea, scènes à faire, or otherwise non-protectable.<sup>119</sup> Finally, the court determines the scope of protection due to the plaintiff's work, either "broad" or "thin" protection.<sup>120</sup> A plaintiff whose work merits thin protection will only receive a finding of infringement for practically identical copying.<sup>121</sup> Courts grant works broader protection when they decide the work represents artistic choices made from a wide realm of possibilities for artistic expression, and so should allow a finding of infringement for non-identical copying.<sup>122</sup> The level of protection is decided on a case-by-case basis.<sup>123</sup>

Applying the second prong of the *Krofft* test has remained essentially the same since its inception. For example, in *Universal City Studios, Inc. v. Film Ventures International, Inc.*,<sup>124</sup> in which the defendant stipulated to the first prong of the test for the purpose of challenging the plaintiff's motion for a preliminary injunction,<sup>125</sup> the

115. *See id.* (explaining present-day application of two-part test).

116. 35 F.3d 1435 (9th Cir. 1994).

117. *See id.* at 1443 (discussing helpful steps to determine scope of copyright protection).

118. *See id.* (explaining step one of test).

119. *See id.* (noting step two of test). For example, in *Apple Computer*, the court used a great deal of technical knowledge to establish which elements of the graphical user interface were worthy of copyright protection. *See id.* at 1444-45 (describing "ideas" that fell under scope of copyright protection).

120. *See id.* at 1443 (finding "the court must set the appropriate standard for a subjective comparison of the works to determine whether, as a whole, they are sufficiently similar to support finding of illicit copying").

121. *See Frybarger v. Int'l Bus. Machs. Corp.*, 812 F.2d 525, 530 (9th Cir. 1987) (indicating that in cases of thin protection "the mere *indispensable* expression of these ideas . . . may be protected only against virtually identical copying.") (emphasis in original).

122. *See McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 321 (9th Cir. 1987) (holding that decorative plates and other artistic works which "are not factual receive much broader protection under the copyright laws because of the endless variations of expression available to the artist") (citation omitted).

123. *See Apple Computer*, 35 F.3d at 1447 ("Which end of the continuum a particular works falls on is a call that must be made case by case.").

124. 543 F. Supp. 1134 (C.D. Cal. 1982).

125. *See id.* at 1137 ("For the purposes of this motion for a preliminary injunction, Defendants have stipulated that the general idea of both 'Jaws' and 'Great

defendant agreed that the basic idea of its film, "Great White," was substantially the same as the plaintiff's film, "Jaws."<sup>126</sup> The court proceeded to perform the second prong of the *Krofft* test and found it likely "that a jury, applying the intrinsic ordinary observer test, would find the [protectable] expression of ideas in [the motion pictures] 'Jaws' and 'Great White' to be substantially similar."<sup>127</sup> The court found the "local politician," the "salty, English-accented skipper," the "local shark expert," and the "local police chief" to be similar characters in both films.<sup>128</sup> Additionally, significant scenes and plot points appeared in both films and major characters met similar fates.<sup>129</sup>

### E. Unfair Competition

Unfair competition is a rather amorphous civil tort.<sup>130</sup> The purpose of making unfair competition a civil tort is to encourage competition by enforcing a fair playing field.<sup>131</sup> The Paris Convention for the Protection of Industrial Property defined unfair competition as "[a]ny act of competition contrary to honest practices in industrial or commercial matters . . . ."<sup>132</sup> One commentator identified three types of unfair competition: creating confusion with a competitor; lying and discrediting a competitor; and misleading the public about the quality of your goods.<sup>133</sup>

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White' is the same, and, thus, the first prong of the bifurcated substantial similarity test . . . has been satisfied.").

126. *See id.* at 1136-39 (discussing similarities between "Jaws" and "Great White"). *Universal City Studios* took place before *Apple Computer*, so the first prong of the *Krofft* test was still restricted to evaluating similarities between ideas, and did not consider the expression itself. *See id.* at 1134 (noting that case was decided in 1982).

127. *See id.* at 1141 (finding sufficient similarity of expression for preliminary injunction).

128. *See id.* at 1137 (discussing similarities between characters of "Jaws" and "Great White").

129. *See id.* at 1137-39 (describing numerous plot similarities between "Jaws" and "Great White").

130. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 1:8 (4th ed. 2011) (stating that "challenge [of unfair competition] is to try to accurately define in the abstract the shape of that tort").

131. *See id.* (explaining that "American law sets a minimum level of 'fairness' in competition. In other words, it is illegal to compete 'too hard'").

132. Paris Convention for the Protection of Industrial Property, art. 10*bis*, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305.

133. *See* MCCARTHY, *supra* note 130 (stating that there are "three specific types of unfair competition: all acts that create confusion with the company, goods or activities of a competitor; false allegations that discredit a competitor; and indications that are liable to mislead the public as to things such as the nature or qualities of the goods").

In the United States, the doctrine of unfair competition is broad and comes into play in conjunction with a variety of other laws. The Federal Trade Commission and several states find unfair competition if: “(1) . . . the practice . . . offends public policy . . . [by being] within at least the penumbra of some common law, statutory, or some other established concept of unfairness; (2) [the conduct] is immoral, unethical, oppressive, or unscrupulous; [and] (3) [the conduct] causes substantial injury to consumers [competitors or other businessmen].”<sup>134</sup> The law of unfair competition distinguishes between following the example of a competitor, which encourages competition and is permissible, and “the slavish or systematic appropriation of the result of his [work] in order to spare the cost of one’s own,” which is impermissible.<sup>135</sup> There are many types of unfair competition, including: “passing off,” when an infringing party “confuse[s] the public into thinking the plaintiff endorses, sponsors or licenses the defendant’s work, product, or use of the characterization; “misappropriation,” using the plaintiff’s character; violating a right of publicity; infringing on trademarks or trade dress; confusing customers by using similar names for businesses, artistic works, or goods; using “bait and switch” sales strategies; false advertising; and stealing trade secrets, among others.<sup>136</sup>

In the world of entertainment, unfair competition law has been used to protect elements of an act not covered by traditional intellectual property laws.<sup>137</sup> For example, courts have awarded injunctions to the owners of the Lone Ranger character against individuals making public appearances on horseback while wearing masks and calling out “Hi yo, Silver!”<sup>138</sup> Even distinctive voices and styles have been protected against imitators. In particular, one

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134. See *Sporty’s Farm L.L.C. v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 501 (2d Cir. 2000) (citing *Saturn Const. Co. v. Premier Roofing Co.*, 238 Conn. 293, 310-311 (1996)) (holding that cybersquatting was not unfair competition under Connecticut’s proscription of “unfair methods of competition and unfair or deceptive acts or practices”).

135. See LOUIS ALTMAN & MALLA POLLACK, *CALLMANN ON UNFAIR COMPETITION, TRADEMARKS, AND MONOPOLIES* § 15:22 (4th ed. 2004) (discussing distinction between “merely following the ‘tip’ of a rival” and methodical appropriation).

136. See MCCARTHY, *supra* note 130, at §§ 1:10, 10:45, 10:47 (listing types of conduct labeled unfair competition, passing off trademark infringement, and discussing misappropriation doctrine).

137. See *Protection Against Unfair Competition*, ESA INTELLECTUAL PROPERTY (Dec. 8, 2004), [http://www.esa.int/esaMI/Intellectual\\_Property\\_Rights/SEMVOT9DFZD\\_0.html](http://www.esa.int/esaMI/Intellectual_Property_Rights/SEMVOT9DFZD_0.html) (discussing protection against unfair competition).

138. See *Lone Ranger, Inc. v. Cox*, 124 F.2d 650, 651-52 (4th Cir. 1942) (holding plaintiff entitled to relief against defendant who played “Lone Ranger” part in circus); see also *Lone Ranger, Inc. v. Currey*, 79 F.Supp. 190, 198 (M.D. Pa. 1948) (enjoining defendant from using words “Lone Ranger”).

court sustained Burt Lahr's unfair competition claim against a chemical company using an imitation of his voice as the voice of their cartoon "spokesduck."<sup>139</sup> In another case, Bette Midler won a suit against Ford Motor Company, who hired one of Midler's former backup singers to imitate her performance when she refused Ford's request to use her single "Do You Want to Dance" in a television commercial.<sup>140</sup>

Unfair competition claims are not limited to voice imitations.<sup>141</sup> In *Prouty v. National Broadcasting Co.*,<sup>142</sup> the author of the novel *Stella Dallas*, sued the broadcaster of a radio show based on future events in the life of her book's eponymous heroine.<sup>143</sup> Prouty was devastated that her maternal "working-class heroine" was being turned into the subject of a "sentimental melodrama."<sup>144</sup> Although the district court sustained her unfair competition claim through National Broadcasting's motion to dismiss, she was unable to stop the broadcasts.<sup>145</sup>

Imitation of a performer's style does not always provide a sustainable unfair competition claim.<sup>146</sup> In *Shaw v. Time-Life Records*,<sup>147</sup> the court ruled that Artie Shaw, the swing-era bandleader, could

139. See *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 259 (1st Cir. 1962) (finding defendant's commercial was enhanced by voice imitation). In addition, Burt Lahr was best known for his performance as the cowardly lion in the 1939 motion picture version of *The Wizard of Oz*. See Bert Lehr, PUBLIC BROADCASTING SERVICE (Oct. 15, 2011), [http://www.pbs.org/wnet/broadway/stars/lahr\\_b.html](http://www.pbs.org/wnet/broadway/stars/lahr_b.html) (recounting biographical information of Bert Lehr).

140. See *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (reinstating her claim after dismissal in lower court). In addition to her unfair competition claim, Bette Midler also had a right of publicity claim against Ford Motor Company. See *id.* (finding defendant appropriated Midler's identity). A jury awarded Bette Midler \$400,000 in damages. See *Midler v. Young & Rubicam, Inc.*, Nos. 90-55027-28, 1991 U.S. App. LEXIS 22641, at \*2 (9th Cir. July 16, 1991) (affirming judgment of district court).

141. See *Prouty v. Nat'l Broad. Co.*, 26 F. Supp. 265, 265-66 (D. Mass. 1939) (denying motion to dismiss unfair competition claim for novel).

142. 26 F.Supp. 265 (D. Mass. 1939).

143. See *id.* at 265-66 (describing plaintiff's claim).

144. See Lynn Gordan Hughes, *Olive Higgins Prouty*, DICTIONARY OF UNITARIAN & UNIVERSALIST BIOGRAPHY, <http://www.uua.org/uuhs/duub/articles/olivehigginsprouty.html> (last visited April 9, 2005) (discussing Prouty's reaction to radio broadcast).

145. See *Prouty*, 26 F.Supp. at 266 (denying defendant's motion to dismiss); Hughes, *supra* note 144 (stating inability to prevent broadcasts).

146. See, e.g., *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 207-08 (1975) (ruling that summary judgment was properly denied in regards to unfair competition claim). Artie Shaw, an alto saxophone player, was considered to be one of the top bandleaders in swing. See *Artie Shaw*, HEP JAZZ, [www.hepjazz.com/bios/artieshaw.html](http://www.hepjazz.com/bios/artieshaw.html) (last visited Nov. 2, 2011) (detailing career of prominent saxophone player and bandleader).

147. 38 N.Y. 2d at 201.

not enjoin others from copying his “sound.”<sup>148</sup> The court held that as long as the imitator did not present his product as being Shaw’s or cause confusion about the source of the recording, another musician could copy Shaw’s performance style.<sup>149</sup> Another court ruled in favor of Goodyear Tire & Rubber Company in Nancy Sinatra’s suit against the company for a tire advertisement using a version of Ms. Sinatra’s signature song, “These Boots Are Made for Walking,” imitating her arrangement.<sup>150</sup> After listening to the two recordings, the court found Sinatra’s recording indistinctive, and held that there was no “confusion of source” between the two works.<sup>151</sup> Also found relevant was the fact that Sinatra did not own the rights to the song, and that the copyright owner had the right to license the work as it desired.<sup>152</sup>

#### F. Right of Privacy

The right of privacy first appeared in an 1890 law review article by Samuel Warren and Louis Brandeis, “The Right to Privacy,” which proposed the violation of a person’s right to be left alone as a tort.<sup>153</sup> A subsequent privacy action received short shrift in a New York court, which held it to be the legislature’s job to create this new cause of action.<sup>154</sup> The New York legislature quickly re-

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148. See HEP JAZZ, *supra* note 146 (detailing “[Shaw’s] highly individual tone and lyric approach to interpretation plus a superlative technique have marked him as one of the great jazz clarinet players of all time-possibly the greatest”); *Shaw*, 38 N.Y. 2d at 205 (noting that Shaw could not copyright his interpretations of other copyrighted works).

149. See *id.* at 201 (describing Artie Shaw, the swing-era bandleader, could not enjoin others from copying his “sound”).

150. See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 718 (9th Cir. 1970) (citing Sinatra’s objection that commercial deceived public into believing she was participant in commercial).

151. See *id.* at 716 n.12. (explaining that to untrained ear there was no readily identifiable accent, range, quality, or pitch that would to identify it with particular person).

152. See *id.* at 716 (“Had she desired to exclude all others from use of the song so that her ‘secondary meaning’ with the song could not be imitated she could have purchased those rights from the copyright proprietor.”).

153. See Samuel Warren & Louis Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 218-19 (1890) (“The invasion of the privacy that is to be protected is equally complete and equally injurious . . . Viewed as a wrong to the individual, this rule is the same pervading the whole law of torts, by which one is held responsible for his intentional acts, even though they are committed with no sinister intent; and viewed as a wrong to society, it is the same principle adopted in a large category of statutory offenses.”).

154. See *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 545, 545 (1904) (“The legislative body could very well interfere and arbitrarily provide that no one should be permitted for his own selfish purpose to use the picture or name of another for advertising purposes without his consent. . . . The courts, however,

sponded and passed privacy laws the next year.<sup>155</sup> Other states accepted the new tort under common law.<sup>156</sup> Privacy cases fit into four basic categories:

(1) intrusion upon the plaintiff's physical solitude or seclusion, (2) public disclosure of private facts, (3) publicity which places the plaintiff in a false light in the public eye, and (4) appropriation of the plaintiff's name or likeness for the defendant's benefit or advantage.<sup>157</sup>

The first three types of privacy cases apply mostly to the right of private people to be left alone, focusing on the injury to human dignity. The last frequently comes into play as the right of public figures to control use of their names and images. This has become known as the Right of Publicity.

### G. Right of Publicity

In an early right of publicity case, Thomas Edison won an injunction stopping a company from using his name and image to advertise their products.<sup>158</sup> Rather than approaching the case as a tort claim, the court treated Edison's claim as a property claim. It held:

If a man's name be his own property, as no less an authority than the United States Supreme Court says . . . it is difficult to understand why the peculiar cast of one's features is not also one's property, and why its pecuniary value, if it has one, does not belong to its owner.<sup>159</sup>

Taking a different approach, other early courts treated the fourth cause of action as a privacy right that was waived when an individual

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being without authority to legislate, are required to decide cases upon principle."); *see also id.* (articulating that plaintiff's image was used to advertise flour without her consent).

155. *See* N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1992) ("A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.");

156. *See Pavesich v. New Eng. Life Ins. Co.*, 122 Ga. 190, 197 (1905) (summarizing that right of privacy is derived from natural law and recognized by municipal law).

157. WILLIAM LLOYD PROSSER & W. PAGE KEETON, PROSSER AND KEETON ON TORTS (West Group, 5th ed. 1984) (setting forth basic privacy case categories).

158. *See Edison v. Edison Polyform Mfg. Co.*, 73 N.J. Eq. 136, 137 (Ch. 1907) (explaining that Mr. Edison did not want his name used as part of corporate title or in connection with business or advertisements of the company).

159. *Id.* at 141.

entered the public sphere.<sup>160</sup> In *O'Brien v. Pabst Sales Co.*,<sup>161</sup> Pabst used O'Brien's picture on a calendar advertising its beer.<sup>162</sup> O'Brien, an All-American football player from Texas Christian University, sued, claiming that as a member of the Allied Youth of America, "he was greatly embarrassed and humiliated" when his image was used to promote alcohol.<sup>163</sup> The court found that O'Brien was not a private person because he had sought various forms of publicity and that nothing in the advertisement was "false, erroneous or damaging" to him.<sup>164</sup> The court dismissed his claim.<sup>165</sup>

Federal law does not specifically cover a right of publicity. The closest federal statute is the Lanham Act § 43(a), which allows a litigant to block registration of a trademark that implies a false connection with a person, living or dead.<sup>166</sup> Rights of publicity are mostly a state matter.

States vary on their provision and interpretation of rights of publicity. Some have acknowledged it as a common law claim.<sup>167</sup> Other states have passed statutes.<sup>168</sup> Currently, courts in Alabama, California, Connecticut, Florida, Georgia, Hawaii, Illinois, Kentucky, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah, and Wisconsin have recognized a common law right of publicity.<sup>169</sup> California, Indiana, Kentucky, Nevada,

160. See, e.g., *O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 167 (5th Cir. 1941) (noting that plaintiff, well-known and famous professional football player, had intentionally posed for many pictures that were to be used for publicity-purposes, and thus use of such pictures was not invasion of his privacy), *cert. denied*, 315 U.S. 823 (1941).

161. 124 F.2d 167 (5th Cir. 1941).

162. See *id.* at 168 (explaining that Pabst included photograph of O'Brien "in football uniform characteristically poised for the throw" directly below Pabst Blue Ribbon label).

163. See *id.* at 168-69 (asserting that O'Brien was member of Allied Youth of America that wished to do away with alcohol among young people).

164. See *id.* at 170 ("[M]aking and selling beer is a legitimate and eminently respectable business and people of all walks and views in life, without injury to or reflection upon themselves, drink it, and that any association of O'Brien's picture with a glass of beer could not possibly disgrace or reflect upon or cause him damage.").

165. See *id.* ("We think it perfectly plain that the District Judge was right both in the view he took that nothing in the publication violated plaintiff's right of privacy and that nothing in it could be legitimately or reasonably construed as falsely stating that he used, endorsed, or recommended the use of Pabst's beer.").

166. See 15 U.S.C. § 1125(a) (placing restriction on trademark registration for marks implying false connection with person).

167. See RIGHTS OF PUBLICITY AND PRIVACY § 6.1[B] (1999) [hereinafter RIGHTS OF PUBLICITY] (detailing state of common law right to publicity).

168. See *id.* (describing state legislation governing publicity rights).

169. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977) (discussing state interest in allowing for right of publicity); see e.g., *Allison v. Vintage*

Oklahoma, Tennessee, Texas, and Washington have passed statutes specifically addressing a right of publicity.<sup>170</sup> Florida, Massachusetts, Nebraska, New York, Rhode Island, Utah, Virginia, and Wisconsin have statutes that focus on privacy rights and include protection for a right of publicity.<sup>171</sup> The state statutes generally require two elements. First, the plaintiff must own an enforceable right in an identity or persona. Second, the defendant must have used some aspect of the identity or persona, without permission, in a way that the plaintiff is identifiable from the use and which will likely cause damage to the persona's commercial value.

California's right of publicity was extended to an extreme in *White v. Samsung Electronics*.<sup>172</sup> There, Samsung published an ad "depict[ing] a robot, dressed in a wig, gown, and jewelry . . . selected to resemble [Vanna] White's hair and dress. The robot was posed next to a game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is

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Sports Plaques, 136 F.3d 1443, 1447 (11th Cir. 1998) (interpreting Alabama's "commercial appropriation privacy right" to be the equivalent of Right of Publicity); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 826 n.15 (9th Cir. 1974) (finding common law right of publicity); *Bi-Rite Enters. v. Bruce Miner Co.*, 757 F.2d 440, 442 (1st Cir. 1985) (explaining right of publicity); see *Zim v. W. Publ'g Co.*, 573 F.2d 1318, 1327 (5th Cir. 1978) (calling right privacy right); *Fergerstrom v. Hawaiian Ocean View Estates, Inc.*, 441 P.2d 141, 144 (Hawaii 1968) (referring to right as privacy right); *Stone v. Creative Commc'n, Inc.*, 216 USPQ 261, 261 (N.D. Ill. 1981) ("The fact that the plaintiff is already well-known and has little privacy to invade does not denigrate the tort of commercial exploitation"); *Cheatham v. Paisano Publ'n, Inc.*, 891 F. Supp. 381, 384-85 (W.D. Ky 1995) (finding tort of unreasonable publicity); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983) (setting forth elements to right of publicity claim); *Uhlaender v. Henrickson*, 316 F. Supp. 1277, 1281 (D. Minn. 1970) (defining right of publicity); *Munden v. Harris*, 134 S.W. 1076, 1079 (Mo. App. 1911) (finding one has exclusive right to profit from one's own picture); *Palmer v. Schonhorn Enters.*, 232 A.2d 458, 461 (N.J. Super. 1967) (listing privacy torts recognized by state); *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339, 1354 (D.N.J. 1981) (stating that courts have recognized right of publicity). *But see* *Reeves v. United Artists Corp.*, 765 F.2d 79, 80 (6th Cir. 1985) (stating Ohio does not recognize right to publicity claims after death); *Hogan v. A.S. Barnes & Co.*, 114 USPQ 314, 320 (Pa. C.P. 1957) (holding possible property right in privacy known as right of publicity); *Kimbrough v. Coca-Cola/USA*, 521 S.W.2d 719, 722 (Tex. App. 1975) (calling it "privacy"); see *Nature's Way Prod., Inc. v. Nature-Pharma, Inc.*, 736 F. Supp 245, 252 (D. Utah 1990) (stating common law right of publicity); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 397 (Wis. 1979) (stating Wisconsin common law recognizes right of publicity); RIGHTS OF PUBLICITY, *supra* note 167, at 6-7, 6-8 (stating tort of right of publicity).

170. See RIGHTS OF PUBLICITY, *supra* note 167, at 6-8 (describing states that have statutes directly acknowledging right of publicity).

171. See *id.* (finding some states acknowledge right of publicity through privacy right statutes).

172. 971 F.2d 1395 (9th Cir. 1992).

famous.”<sup>173</sup> Vanna White sued Samsung under California Civil Code § 3344, California’s common law right of publicity, and section 43(a) of the Lanham Act.<sup>174</sup> The Ninth Circuit Court of Appeals affirmed the dismissal of the § 3344 claim, holding that the Samsung ad did not use White’s “name, voice, signature, photograph, or likeness.”<sup>175</sup> However, that court reversed the lower court’s dismissal of White’s right of publicity claim, holding that “[i]t is not important *how* the defendant has appropriated the plaintiff’s identity, but *whether* the defendant has done so.”<sup>176</sup> It also reinstated White’s Lanham Act claim that Samsung used “a false description or representation” of her.<sup>177</sup> For a Lanham Act claim to survive, White had to show a “likelihood of confusion . . . over whether White was endorsing Samsung’s VCRs.”<sup>178</sup> After following the established eight-factor test for confusion, the court held that White had raised “a genuine issue of material fact concerning a likelihood of confusion as to her endorsement.”<sup>179</sup>

### III. APPLYING INTELLECTUAL PROPERTY PROTECTION TO THE SPECIAL NEEDS OF VARIETY PERFORMERS

Most variety artists make their living from live performances, rather than appearing on television or selling recordings of their shows. Therefore, variety artists tend to be more interested in protecting their acts and material from other performers than in exploiting recordings of their performances, although there is a significant business in creating instructional books and videos for use within the arts and those who create such works have an interest in protecting their books and videos from unauthorized copying.

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173. *See id.* at 1396 (stating factual background surrounding plaintiff’s alleged copyright infringement). Samsung called the advertisement the “Vanna White” ad. *See id.* (noting that White did not give consent or get paid for ad).

174. *See id.* (listing cause of action). Section 43(a) of the Lanham Act is codified at 15 U.S.C. § 1125(a). *See id.* at 1397 (noting where Lanham Act is codified).

175. *See id.* at 1397 (explaining that robot used to depict Vanna White had mechanical features dissimilar from White’s precise features and thus did not amount to her likeness as defined by § 3344).

176. *Id.* at 1397-98 (emphasis added).

177. *See id.* at 1400-01 (citing 15 U.S.C. 1125(a)) (stating that White’s claim was improperly dismissed at summary judgment stage in light of likelihood of confusion assessment required to prevail on claim brought pursuant to Lanham Act).

178. *Id.* at 1399-1400 (citation omitted).

179. *Id.* at 1401. The eight factors are: “(1) strength of plaintiff’s mark; (2) relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant’s intent in selecting the mark; (8) likelihood of expansion of the product lines.” *Id.* (citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)).

There is no single clear cause of action that protects a variety performer's rights to his or her act. This section will consider various elements of a variety act and discuss the claims an artist could bring against a copying performer. Since the author is a magician, many examples will be drawn from that art, but the issues and law will apply throughout the variety arts.

#### A. Protecting a Stage Name or Act Title

A name or a title can not only embody an artist's persona, but also provide a way for the audience members to remember whose performance they saw, and for prospective employers to recall whom they want to hire. Trademark claims have been used to protect stage names and act titles when there are close copies. Charlie Chaplin successfully sued Charles Amador and prevented Amador from performing as "Charles Aplin," dressing like and using the signature mannerisms of Chaplin's "Little Tramp" character.<sup>180</sup> That court defined Chaplin's character by describing his costume, rather than his personality or other qualities.<sup>181</sup> Amador was not only enjoined from using the name "Charlie Aplin," he was forbidden from using a costume similar to Chaplin's character's costume.<sup>182</sup> The *Chaplin* court noted: "it is plaintiff's right to be protected against those who would injure him by fraudulent means; that is, by counterfeiting his role—or, in other words, plaintiff has the right to be protected against 'unfair competition in business.'"<sup>183</sup>

In the late 1930s and into the 1940s, Charles Hoffman performed in vaudeville theaters with his "Any-Drink-Called-For" magic act as "Think-a-Drink Hoffman."<sup>184</sup> Hoffman opened his act with a short speech, and then invited his audience to think of any drink

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180. See *Chaplin v. Amador*, 269 P. 544, 544-45 (Cal. Dist. Ct. App. 1928) (presenting finding of lower court on appeal).

181. See *id.* at 545 (explaining Chaplin's costume). The court stated: Chaplin has generally worn a kind of attire peculiar and individual to himself, consisting of a particular kind or type of mustache, old and threadbare hat, clothes and shoes, a decrepit derby, ill-fitting vest, tight-fitting coat, and trousers and shoes much too large for him, and with this attire, a flexible cane usually carried, swung and bent as he performs his part. This character, and the manner of dress, has been used and portrayed by Charles Chaplin for so long and with such artistry, that he has become well known all over the world in this character.

*Id.*

182. See *id.* (affirming decision reached by trial court).

183. *Id.* at 546.

184. See *Glazer v. Hoffman*, 16 So. 2d 53, 53-54 (Fla. 1943) (introducing plaintiff's magic act and copyright infringement claim against defendant).

they might desire.<sup>185</sup> As members of the audience thought of beverages, Hoffman poured beakers of water into cocktail shakers and finally poured out each specialty drink.<sup>186</sup> Hoffman's act was an improvement on an act by a Swiss magician performing as De Roze, who had his audiences name aloud the drinks they wanted.<sup>187</sup> Neither of the performers had created the "Any-Drink-Called-For" act, and they were not the only ones performing it.<sup>188</sup> In 1943, Hoffman sued a competing magician named Maurice Glazer for allegedly copying Hoffman's act.<sup>189</sup> Glazer performed effectively the same act, giving a short speech – sometimes even the same speech as Hoffman's – and then pouring requested drinks. It was not recorded whether Glazer's audiences had to announce their requests, or if he fulfilled silent requests as well.<sup>190</sup> Glazer even took a similar stage name, using "Think-a-Drink Count Maurice" and "Have-a-Drink Count Maurice."<sup>191</sup> The court granted Hoffman an injunction preventing Glazer from using the "Think-a-Drink" trade name and from delivering Hoffman's copyrighted speech before performing the act.<sup>192</sup> However, the court also held that Hoffman was not entitled to copyright protection on the rest of his act.<sup>193</sup> Thus, Glazer could continue to perform "Any-Drink-Called-For."<sup>194</sup>

A more recent, and less successful, suit involved the series of specials called "Breaking the Magician's Code: Magic's Biggest Secrets Finally Revealed," which aired on the Fox network starting

185. *See id.* at 54 (describing parts of overall performance).

186. *See id.* (explaining details of act).

187. *See* MILBOURNE CHRISTOPHER & MAURINE CHRISTOPHER, ILLUSTRATED HISTORY OF MAGIC 292 (2006) (citing differences among performers' shows and techniques). The *Glazer* court did not note the performance's origin. *See Glazer*, 16 So. 2d at 54 (reciting facts of case).

188. *See Glazer*, 16 So. 2d at 54 (describing act's characteristics as common to sleight-of-hand magic acts).

189. *See id.* at 53 (listing elements of copyright infringement claim).

190. *See id.* at 54 (explaining elements of Glazer's performance).

191. *See id.* (comparing plaintiff's and defendant's trade names).

192. *See id.* at 56 (affirming lower court's injunction regarding pre-performance "patter" and use of trade name).

193. *See id.* (reversing remaining aspects of prior holding).

194. *See id.* (limiting injunction to "patter" and trade name). This case occurred before the "choreography" and "pantomime" sections were added to the Copyright Act. *See supra* notes 62-64 and accompanying text (highlighting when "choreography" and "pantomime" were added to Copyright Act). With the protection of those sections, the silent portion of the act might have received copyright protection, if it met the required standards. *See supra* notes 61-72 and accompanying text (clarifying Copyright Act's protections for dramatic works, choreography, and pantomimes).

in November 1997.<sup>195</sup> Robert Rice, owner of a 1986 video, “Mystery Magician—He Dares To Expose the Secrets Behind Magic’s Most Mystifying Illusions,” sued Fox, claiming he had a common law trademark in the title “Mystery Magician,” and that Fox violated his trademark.<sup>196</sup> Rice had not registered “Mystery Magician” as a trademark, so he first had to prove the mark was sufficiently distinctive.<sup>197</sup> The court held that his mark was descriptive at best, requiring him to produce evidence of secondary meaning to receive protection.<sup>198</sup> Rice did “no customer surveys,” and the evidence showed that advertising for his video had been “extremely limited.”<sup>199</sup> Therefore, the court found that Rice had no mark worthy of protection in the term “Mystery Magician,” and dismissed his trademark claim. The court used the same rationale to dismiss Rice’s Lanham Act claim that “Mystery Magician” was protected from “false representations concerning the origin, association, or endorsement of goods or services through the wrongful use of another’s distinctive mark . . . .”<sup>200</sup>

### B. Protecting a Character

A variety artist may spend years creating, developing, and performing as a particular character. That character may be as distinctive as Charlie Chaplin’s tramp character, but many are not.<sup>201</sup> The majority of variety and novelty acts tend to focus on the feats that make the act remarkable, rather than developing a substantial or nuanced character. Although a clown, for example, may want to

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195. See *Rice v. Fox Broad. Co.*, 148 F. Supp. 2d 1029, 1037-38 (C.D. Cal. 2001) (describing production and broadcast of television specials).

196. See *id.* at 1047 (discussing basis for plaintiff’s common law trademark claim). Rice made a variety of claims, including a trademark claim for the masked magician character, and a copyright claim for the show as a whole. See *id.* (noting different types of claims Rice made). Each claim will be discussed separately as protection for those elements are covered in the proceeding sections. See *infra* notes 286-351 and accompanying text (discussing elements of trademark and copyright claims).

197. See *id.* at 1064 (recounting case law standard for proving distinctive trademark).

198. See *id.* at 1064-65 (detailing process to establish “secondary meaning” once plaintiff’s argument fails to prove trademark is sufficiently distinctive).

199. See *id.* at 1065 (evaluating public impression of disputed trademark that it lacked “secondary meaning”).

200. See *id.* at 1062-64 (citation omitted) (finding no substantial similarity between his video and Television Specials). *Id.* at 1063 (stating Rice was unable to claim that his work was real inspiration for Television Specials because they “[were] not substantially similar to his [Rice’s] copyrighted work.”).

201. See JOYCE MILTON, TRAMP: THE LIFE OF CHARLIE CHAPLIN 61 (1996) (discussing his character’s distinctive features which made Chaplin “instantly recognizable”).

protect the costume and quirks which make his character different from other clowns, he is unlikely to receive copyright protection, as illustrated by the examples below.

### 1. *Copyright*

Character copyrights have been granted for characters such as Godzilla, James Bond, Superman, and Rocky Balboa, as well as Mickey Mouse, Minnie Mouse, Donald Duck, and Goofy.<sup>202</sup> All these characters were protected because they “transcend the boundaries of any one copyrighted work.”<sup>203</sup> In order to protect a character, the character must be “‘the story’,” or at least be “fleshed out” enough to deserve protection separate from the surrounding work.<sup>204</sup> Frequently, these characters have appeared in various media forms and in a number of separate works, with their personalities and attributes consistent from work to work so that they are distinct from other characters.<sup>205</sup> For example, the character James Bond is still recognizable as “a unique character [with] specific qualities,” even though a number of actors have played the role.<sup>206</sup> Courts also consider how much appeal the plot of the piece holds compared to how much draw the character itself has, positing that “audiences do not watch Tarzan, Superman, Sherlock Holmes, or James Bond for the story, they watch these films to see their heroes at work.”<sup>207</sup> For example, the standard for providing copyright protection to characters is so high that detective Sam Spade from “The Maltese Falcon” was not deemed worthy.<sup>208</sup>

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202. See *Rice*, 148 F. Supp. 2d at 1055 (citing *Toho Co., Ltd. v. William Morrow & Co.*, 33 F. Supp. 2d 1206, 1215 (C.D. Cal. 1998); *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1296 (C.D. Cal. 1995); *Warner Bros., Inc. v. Am. Broad. Co.*, 720 F.2d 231, 240-45 (2d Cir. 1983); *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431, at \*7 (C.D. Cal. Apr. 25, 1989); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978)) (listing cases protecting specific characters based on copyright protection which attached apart from character’s depiction in separate copyrighted work).

203. See *Rice*, 148 F. Supp. 2d at 1055 (observing that characters were protected because they were developed in more than single productions).

204. See *id.* at 1055-56 (citation omitted) (describing two ways to copyright characters apart from copyrighted work itself).

205. See *id.* at 1056 (acknowledging “significant development” for characters necessary to make them copyrightable).

206. See *Metro-Goldwyn-Mayer*, 900 F. Supp. at 1296 (describing consistency requirement that protectable characters have constant specific qualities despite differing storylines).

207. See *Rice*, 148 F. Supp. 2d at 1056 (quoting *Metro-Goldwyn-Mayer*, 900 F. Supp. at 1296) (emphasizing importance of main character in works).

208. See *Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc.*, 216 F.2d 945, 950 (9th Cir. 1954) (denying copyright protection for character).

Robert Rice argued that his “mystery magician” character in *Rice v. Fox Broadcasting Company* was copyrightable apart from its appearance in the video.<sup>209</sup> He claimed:

The plot, setting, sequence of events, dialogue (or monologue), mood, tone and pace are all directly driven from the persona of the *Masked Magician*, a character accurately described . . . as a magician anti-hero who embarks upon a simple, direct approach to the age-old ‘no-no’ of telling tales out of school by revealing highly secret magic illusions to the public.<sup>210</sup>

To the contrary, the court found the “Masked Magician” to be most remarkable for the lack of any specific traits, noting that the character was presented in a way that removed practically all elements of unique identity.<sup>211</sup> The court considered the character more of an archetype of a magician than an actual character, “little more than an undifferentiated cipher . . . .”<sup>212</sup>

The court also applied the merger and “*scènes à faire*” doctrines and reduced the level of available protection for Rice’s Mystery Magician character. It found that there are only so many “ways to express the ‘idea’ of a magician revealing the secrets of tricks/illusions while being disguised to protect his identity,” and that the expressions of the characters in both Rice’s video and the Fox specials merge with that idea.<sup>213</sup> The court further noted that, “in the genre of ‘revealing magic tricks,’” a masked magician was a “*scène à faire*,” and because Rice’s copyright in his Mystery Magician was therefore “‘thin,’” it could only be violated if the “allegedly infringing character [was] nearly identical.”<sup>214</sup> The court then pointed to various distinctions between the two characters and denied relief.<sup>215</sup>

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209. *Rice*, 148 F. Supp. 2d at 1055-58 (arguing “Mystery Magician” character alone was enough for viable copyright infringement claim, and stating court’s counter-argument to claim).

210. *Id.* at 1055 (citation omitted).

211. *See id.* at 1056 (determining character’s anonymity, lack of character development, and ability to be replaced).

212. *See id.* at 1057 (concluding character was without identity and more notable for its lack of depiction).

213. *See id.* (describing Masked Magician’s representation of classic magicians or illusionists, rather than unique character portrayal).

214. *See id.* at 1057-58 (declaring no reasonable juror would find Rice’s character to meet that standard).

215. *See id.* (determining characters were not “substantially similar . . . [under] matter of law”).

## 2. *Right of Publicity*

If a performer's actual image or voice is used, the artist may have a right of publicity claim. If the performer is sufficiently famous and distinctive, protection may extend beyond the performer's actual image to prohibit any representation that is identifiable as that performer. As discussed above, rights of publicity vary from state to state.<sup>216</sup>

The Supreme Court recognized the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Company*, a 1977 case involving a novelty act.<sup>217</sup> Hugo Zacchini was a "human cannonball."<sup>218</sup> In his act, he climbed into a cannon that then shot him two hundred feet through the air into a net.<sup>219</sup> He claimed his father had created the act, and that only his family had performed it for the last fifty years.<sup>220</sup> A reporter brought a movie camera to Zacchini's show at the Geauga County Fair in Burton, Ohio, and filmed the fifteen second segment climax of Zacchini's act.<sup>221</sup> The tape was broadcast on the 11 o'clock evening news.<sup>222</sup> Zacchini sued Scripps-Howard, the operator of the television station, claiming that the station's actions were an "unlawful appropriation of plaintiff's professional property."<sup>223</sup> The trial court granted Scripps-Howard summary judgment.<sup>224</sup> The Ohio Court of Appeals reversed, holding Zacchini had stated a copyright claim, with one judge noting in his concurrence that Zacchini had a claim under the right of publicity.<sup>225</sup> The Supreme Court of Ohio followed the concurring

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216. See *supra* notes 167-171 and accompanying text (acknowledging states' varying positions on right of publicity laws).

217. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 563 (1977) (acknowledging that in August and September 1972 this novelty act was performed on regular basis at Geauga County Fair and audience not charged separate admission to watch act).

218. See *id.* at 563 (explaining "Zacchini performed his fifteen second act in fenced space within fair grounds").

219. See *id.* (describing details of act).

220. See *id.* at 564 (detailing Zacchini claim that he was "engaged in the entertainment business").

221. See *id.* at 563-64 (noting that Zacchini had seen movie camera previously and had asked reporter not to film his performance).

222. See *id.* at 564 (reciting facts of incident leading to claim).

223. See *id.* (citing Brief for Petitioner at \*3, *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (No. 76-577), 1977 WL 189127 at \*3) (recounting that Zacchini claimed news station "showed and commercialized the film of his act without his consent").

224. See *id.* (holding against plaintiff).

225. See *id.* (stating decision of court of appeals). The Ohio appellate court found that "entertainment, in the sense of a total performance, does not fall within any reasonable definition of newsworthiness warranting the use of the First Amendment to allow its *total* appropriation by a news medium." *Zacchini v.*

judge and held Zacchini's claim was based on a property right in the "publicity value of his performance."<sup>226</sup>

The United States Supreme Court found the purpose of Ohio's right of publicity to be providing an individual "the right . . . to reap the reward of his endeavors . . . ."<sup>227</sup> Like copyrights and patents, the right of publicity "provides an economic incentive for [the performer] to make the investment required to produce a performance of interest to the public."<sup>228</sup> The Supreme Court believed that, as a professional performer, Zacchini would provide the public the benefit of his performances "as long as his commercial stake in his act is appropriately recognized."<sup>229</sup> The Court noted that broadcasting an entire show "goes to the heart of petitioner's ability to earn a living as an entertainer," and that the strongest case for a violation of the right of publicity is not using a performer's image or reputation, "but the appropriation of the very activity by which the entertainer acquired his reputation in the first place."<sup>230</sup> The case was then remanded to the Ohio Supreme Court, which subsequently remanded the case for trial regarding the issue of infringement, and possibly damages.<sup>231</sup>

Since *Zacchini*, other cases, notably *White v. Samsung Electronics*, have expanded the right of publicity.<sup>232</sup> This expansion may allow

*Scripps-Howard Broad. Co. v. National Basketball Ass'n*, No. 33713, 1975 WL 182619, at \*7 (Ohio Ct. App. July 10, 1975) (reversing summary judgment in favor of defendant).

226. See *Zacchini*, 433 U.S. at 562 (noting that Ohio Supreme Court ruled in favor of broadcasting company on grounds that "it was constitutionally privileged to include in its newscasts matters of public interest that would otherwise would be protected by the right of publicity, absent an intent to injure or to appropriate for some nonprivileged purpose").

227. See *id.* at 573-74 (referring to fact that Zacchini "did not seek to enjoin the broadcast of his act; he simply sought compensation for the broadcast in the form of damages").

228. See *id.* at 576 ("[The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.']") (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

229. See *id.* at 578 (asserting that Zacchini simply wanted to be paid for broadcast of his performance as opposed to seeking to enjoin broadcast of his performance altogether).

230. See *id.* at 576 (explaining that protection provides economic incentive for Zacchini to make investment required to produce performance of interest to public).

231. See generally *id.* at 583 (remanding to Ohio Supreme Court).

232. See *supra* notes 172-179 and accompanying text (explaining court's reasoning on right of publicity); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992) (recognizing "the common law right of publicity reaches means of appropriation other than name or likeness . . . [and] does not require that appropriations of identity be accomplished through particular means . . .").

variety artists to protect themselves against imitators if the artist is sufficiently famous and if the imitator used indicia of the performer's character. An imitator's use of the same costume elements coupled with the performance of the same feats could provide a basis for one performer to claim the imitator violated his or her right of publicity. However, this argument is unlikely to succeed. The *White* expansion of the right of publicity has not been adopted by the other federal circuit courts, nor has it been tested further within the Ninth Circuit.<sup>233</sup> In most jurisdictions, the right of publicity does not extend nearly as far.<sup>234</sup> Additionally, few variety artists have approached Vanna White's level of celebrity or notoriety, so it is unlikely many would receive her level of protection.<sup>235</sup>

### C. Protecting a Device or Element

Variety performers often use special equipment in their performances, and many innovative performers adapt their equipment or invent new devices. A juggler creates a specially weighted and balanced knife to juggle. A ventriloquist fits out a dummy with eyebrows that wiggle to make it more expressive. A magician designs a box to restrain an assistant while the magician slices the assistant into tiny pieces and puts the assistant back together. Just like any other device, these inventions may qualify for intellectual property protection. It is impractical, however, for many variety artists to take advantage of these protections.

#### 1. *Trade Secret Protection*

When one thinks of magicians protecting the secrets of their art, the first thing to come to mind is trade secret protection.<sup>236</sup> A

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233. See *ETW Corp. v. Jireh Publ'g Inc.*, 332 F.3d 915, 938 (6th Cir. 2003) (denying expansion of right of publicity); see also *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959, 962 (10th Cir. 1996) (holding First Amendment right to free expression outweighs MLB's right of publicity). The Ninth Circuit denied an *en banc* hearing in *White*, a decision in which several judges dissented. See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1512 (9th Cir. 1993) (denying petition for rehearing).

234. See *White*, 989 F.2d at 1512 (denying petition for rehearing). For a further discussion of right of publicity, see *supra* notes 158-176 and accompanying text.

235. See *White*, 971 F.2d at 1398 (expanding right of publicity). At the time of the action, approximately forty million people watched Vanna White on *Wheel of Fortune* each day. See *id.* at 1396 (describing popularity of *Wheel of Fortune* by reference to daily viewership).

236. See *Harrison v. SF Broad.*, 1998 WL 355462 at \*3 (E.D. La. 1998) (noting plaintiffs described themselves as "class members who hold common 'trade secrets' that are shared in the 'common domain of magicians, illusion builders and magic dealers.'" (quoting Pl.'s Pet. and Application for Class Certification, filed in Civil

trade secret is secret information that gives the owner a competitive advantage.<sup>237</sup> Trade secret protection is impractical and almost impossible for variety artists to maintain because the protection is so easy to lose. The owner of a trade secret must take precautions to prevent others from learning the secret in order to avoid losing the protection.<sup>238</sup> Variety artists frequently move from venue to venue and only rarely have any control over who has backstage access. They usually lack the power to make everyone they work with sign non-disclosure agreements.<sup>239</sup> As a result, it is often very difficult for such artists to implement protections that a court would consider reasonable precautions to maintain secrecy.

Even if a performer could satisfy the requirements necessary to obtain trade secret status for their acts, protection probably would not last long. Variety artists use their trade secrets, or devices embodying those secrets, in plain sight, onstage, and in front of an audience. Anyone who buys a ticket can get a good look. Competitors could watch the secret in use and then legitimately reverse engineer the invention and use it for themselves.<sup>240</sup>

For example, in the late 1870s, a magician named Buatier deKolta was popular for performing a flower production, his own invention.<sup>241</sup> In the course of his show, he took a single large sheet of paper, twisted it into a cone, and shook it, sending tissue-paper flowers spilling out over the stage as the cone overflowed.<sup>242</sup> During one performance, a draft whisked some of the flowers off the

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District Court for the Parish of Orleans). The plaintiffs were suing over Fox Broadcasting's television specials, "Breaking the Magicians' Code," (the same ones at issue in *Rice v. Fox Broadcasting*, discussed *infra* notes 289-321 and accompanying text) for revealing "trade secrets" belonging to the class of Plaintiffs. See *Harrison*, 1998 WL 355462 at \*1 (presenting plaintiffs' claim of misappropriation of trade secrets).

237. See MERGES ET AL., *supra* note 15 (discussing trade secret law). For additional explanation of trade secret characteristics, see *supra* notes 15-22 and accompanying text.

238. See Uniform Trade Secrets Act § 1(4)(ii) (1985) (providing definition of "trade secret"). For a further discussion of trade secrets, see *supra* notes 15-22 and accompanying text.

239. *But see* Don Butler, *Copperfield Prefers Tears to Gasps*, CANADA.COM (March 4, 2006), <http://www.canada.com/ottawacitizen/news/arts/story.html?id=2d8839ba-45fb-4352-a00a-dd36af60c318&k=17073> (discussing that all of Copperfield's employees sign NDAs).

240. See UTSA §1(1) (stating reverse engineering as legitimate means for using trade secret). For a further discussion of trade secret protection, see *supra* notes 15-22 and accompanying text.

241. See JIM STEINMEYER, *HIDING THE ELEPHANT: HOW MAGICIANS INVENTED THE IMPOSSIBLE AND LEARNED TO DISAPPEAR* 161 (Carroll & Graf, 2003) (describing deKolta's flower trick).

242. See *id.* (describing deKolta's flower trick).

stage.<sup>243</sup> A magician watching the show grabbed a flower and dashed out of the theater.<sup>244</sup> Shortly thereafter, and ever since, deKolta's specially designed paper flowers could be purchased cheaply at any magic shop.<sup>245</sup> The exposure of deKolta's flowers was accidental, caused by a stray breeze, and a competitor took advantage of the opportunity.

Harry Kellar was the preeminent magician in America in the late nineteenth and early twentieth centuries.<sup>246</sup> He constantly needed new illusions to add to his show so he could offer his audiences something new and amazing during each tour.<sup>247</sup> In addition to purchasing the inventions of other magicians, Kellar traveled to London each year to study the latest creations of John Nevil Maskelyne, the greatest illusion inventor of that time.<sup>248</sup> In 1901, Maskelyne's showpiece was "The Entranced Fakir," an impossible levitation that utterly baffled even the magicians who saw it.<sup>249</sup> None of the methods of levitation known to the craft could explain what happened in this illusion.<sup>250</sup> It seemed to be the perfect illusion, and Kellar had to have it.<sup>251</sup> In an attempt to learn the secret, Kellar and his mechanic attended several performances, sitting in different sections of the theater and even bringing opera glasses to get a close-up view, but they learned nothing.<sup>252</sup> Finally, Kellar bought a front-row ticket.<sup>253</sup> In the middle of Maskelyne's performance, just as his assistant's body rose toward the ceiling, Kellar got up, climbed the stairs to the stage, got a good look at Maskelyne's apparatus, and left.<sup>254</sup>

Under modern trade secret law, Kellar probably could have used knowledge obtained this way to legally reverse engineer Mas-

243. *See id.* (describing one particular performance of flower trick).

244. *See id.* at 161-62 (describing one particular performance of flower trick).

245. *See id.* at 162 (describing implications of accidental revealing of flower trick).

246. *See* MILBOURNE CHRISTOPHER, *THE ILLUSTRATED HISTORY OF MAGIC* 219 (Running Press Book Publishers, 2005) (describing Kellar's profitable tours of California and Mexico). Kellar was probably the inspiration for the title character in L. Frank Baum's "The Wizard of Oz." *See* STEINMEYER, *supra* note 241, at 167 (noting Kellar was leading magician at time of Baum's book).

247. *See* STEINMEYER, *supra* note 241, at 169 (detailing Kellar's search for new tricks).

248. *See id.* (detailing Kellar's search for new tricks).

249. *See id.* (describing Maskelyne's new levitation trick).

250. *See id.* (discussing different methods of levitation).

251. *See id.* at 170 (noting illusion's genius).

252. *See id.* at 169 (discussing methods used to discover illusion).

253. *See id.* (detailing Kellar's attempts to ascertain Maskelyne's method).

254. *See id.* (discussing Kellar's actions).

kelyne's levitation. As it turned out, Kellar's brazen venture onto Maskelyne's stage was futile. He did not learn enough to reverse engineer the levitation.<sup>255</sup> Determined to learn the secret, Kellar paid Paul Valadon, another magician performing at Maskelyne's theater, to provide rough sketches of the apparatus.<sup>256</sup> In 1904, Kellar finally introduced his version of the Maskelyne levitation in the United States.<sup>257</sup> Howard Thurston, Kellar's successor, subsequently performed the Maskelyne levitation in the United States for many years.<sup>258</sup> In Thurston's presentation, he actually invited members of the audience up on stage.<sup>259</sup> He knew the volunteers would see part of the mechanism, but believed their presence would make the illusion even stronger for the hundreds in the gallery.<sup>260</sup> The levitation eventually, and ironically, also appeared in the show of another magician who had hired Thurston's old backstage assistants.<sup>261</sup> This miraculous illusion could not have been protected as a trade secret. The nature of a magic show prevented it.

## 2. *Patent Protection*

The Maskelyne levitation could most likely have been protected by a patent because it fit the basic requirements.<sup>262</sup> It was a novel, useful, certainly non-obvious device, and had Maskelyne described it sufficiently and submitted a patent application, he probably would have been granted a patent. Patents would be a perfectly acceptable method for some variety artists to protect their inventions, when secrecy regarding the mechanism is not required. However, magicians rarely patent their inventions. The reason for this omission is illustrated by the story of Horace Goldin.

Goldin, the man who popularized "Sawing a Woman in Half" in the United States in the 1920's, patented the "Illusion Device" he

255. *See id.* at 169-70 (detailing illusion's intricacy).

256. *See id.* at 170 (recounting arrangement between Kellar and Valadon).

257. *See id.* at 174 (discussing Kellar's act).

258. *See id.* at 210 (noting Thurston's succession).

259. *See id.* at 209 (recounting Thurston's illusion).

260. *See id.* at 210 (discussing benefits and disadvantages of audience participation).

261. *See id.* at 211 (recounting assistant's later use of illusion). The record did not support that a non-disclosure agreement or contractual clause existed, which had there been, might have resulted in Thurston having a cause of action. *Id.*

262. For a further discussion of qualifications for obtaining a patent, see *supra* notes 23-33 and accompanying text.

used for his “Sawing.”<sup>263</sup> Goldin’s patent is available to the public, and was available as soon as it was awarded, while he was still performing the “Sawing.”<sup>264</sup> Anyone who wanted to find out how Goldin achieved his feat just had to ask the Patent Office, which is antithetical to the secrecy required for an effective magic show. One court noted that the value of a magic show “depends upon the degree of mystery in which the performer is able to envelop the means which he uses to accomplish the end.”<sup>265</sup>

Goldin’s patent worked against him when he sued the R.J. Reynolds Tobacco Company.<sup>266</sup> R.J. Reynolds used an advertising campaign for Camel Cigarettes called “It’s Fun To Be Fooled . . . It’s More Fun To Know.”<sup>267</sup> The campaign was a series of comic strips showing magicians performing various illusions, and then exposing them.<sup>268</sup> Goldin sued over the strip illustrating “Sawing a Woman in Half.”<sup>269</sup> The court held Goldin did not have an actionable unfair competition claim since the advertisement “did not reveal to the public any thing or any fact of which the public was not already deemed to have knowledge” and that he had “abandoned his secret to the public” when he obtained his patent.<sup>270</sup>

Some variety artists use design patents to protect their creations. Design patents allow the patent holders to prevent others from copying decorative, non-functional elements of a device, and prevent confusion between an original prop and an imitation.<sup>271</sup> While this would serve an artist’s need not to reveal a device’s secret workings, the protection is limited, as the design patent does not

263. U.S. Patent No. 1,458,575 (filed Sept. 9, 1921) *available at* <http://patimg1.uspto.gov/.piw?docid=01458575&SectionNum=1&IDKey=113D9FF536BD&HomeUrl=http://pimg-piw.uspto.gov>.

264. *See* UNITED STATES PATENT AND TRADEMARK OFFICE, [www.uspto.gov](http://www.uspto.gov) (last visited Nov. 2, 2011 ) (showing description and schematic of device).

265. *Goldin v. Clarion Photoplays, Inc.*, 195 N.Y.S. 455, 456 (1st Dept. 1922).

266. *See Goldin v. R.J. Reynolds Tobacco Co.*, 22 F. Supp. 61, 65 (S.D.N.Y. 1938) (discussing why Goldin’s patent ended up working against him).

267. *See id.* at 63 (describing advertising campaign).

268. *See id.* (explaining how it was “more fun to know” the secrets behind the illusions, and that Camel Cigarettes were made of tobacco superior to other brands). The comic strips are in the possession of Mike Caveney of Pasadena, CA. *Id.*

269. *See id.* at 62 (introducing Goldin’s suit against Camel).

270. *Id.* at 65.

271. *See Gorham Co. v. White*, 81 U.S. 511, 531 (1871) (discussing design patents).

apply to necessary, functional elements, which could then be copied without infringing.<sup>272</sup>

### 3. *Various State Laws*

Another option for performers seeking to protect their acts is to look to miscellaneous state laws. Horace Goldin managed to prevent Clarion Photoplays from showing a movie that exposed the workings of his patented "Sawing a Woman in Half" by bringing an unfair competition action.<sup>273</sup> Goldin proved, to the satisfaction of the court, that: he created the illusion; the illusion was distinct from prior mutilation or decapitation illusions; he was well known for performing it; and he would lose his booking there if the movie were to be shown in a town.<sup>274</sup> The court granted the requested injunction, noting "the conclusion cannot be escaped that the purpose of the defendants in the making and exhibition of their picture is to unlawfully and unfairly take advantage of the success which has rewarded the plaintiff's initiative and to deprive him of the fruits of his ingenuity, expense, and labor."<sup>275</sup>

Another case invoked an even more rarely used cause of action. The same Fox magic exposure special that inspired the *Rice* lawsuit also engendered the ire of Joseph F. Harrison, who sued Fox under the Louisiana Abuse of Rights doctrine.<sup>276</sup> In 1998, Harrison represented a group of "magicians, illusion builders and magic dealers" suing Fox Broadcasting.<sup>277</sup> In the "Petition and Application for Class Certification," the plaintiffs alleged they were class members who held common "trade secrets" that were shared in the "common domain of magicians, illusion builders and magic dealers," and that the defendants knew publishing the "trade secrets" could do damage to the class of plaintiffs, and yet they still published the information "deliberately, brutally, wantonly, and

272. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. R. 2008) (discussing how trial court has job of "distinguishing between those features of the claimed design that are ornamental and those that are purely functional").

273. See *Goldin v. Clarion Photoplays*, 195 N.Y.S. 455, 456, 460 (1st Dept 1922) (holding "the defendants have simply sought unfairly and unjustly to profit by plaintiff's success, by adopting the name which he gave to his illusion, and by copying his methods in an unfair competition and unreasonable interference with plaintiff's rights, which the courts should and will prevent").

274. See *id.* at 456 (discussing necessary elements that Goldin met).

275. See *id.* (stating holding of court).

276. See *Harrison v. SF Broad.*, CIV. A. 98-1107, 1998 WL 355462 (E.D. La. Jun. 30, 1998) (discussing Harrison's suit against Fox).

277. See *id.* at \*1 (introducing parties to suit).

willfully.”<sup>278</sup> The misuse of the legal term “trade secrets” when Harrison meant that the information revealed were secrets of the magicians’ trade, almost led the court to believe Harrison was relying on Louisiana’s Uniform Trade Secrets Act, which all involved agreed was inapplicable.<sup>279</sup> Unfortunately for Harrison, the Louisiana Abuse of Rights doctrine was no more help to him. The doctrine is usually used in contract or property cases, and the plaintiff may have a remedy if:

(1) rights were exercised for the exclusive or predominant purpose of harming another; (2) rights were exercised in the absence of a serious and legitimate interest that is worthy of judicial protection; (3) rights were used in violation of moral rules, good faith, or elementary fairness; or (4) rights were exercised for a purpose other than that for which they were granted.<sup>280</sup>

Harrison’s case was dismissed for failure to state a claim for which relief could be granted because no contractual or property rights were abused.<sup>281</sup> The court acknowledged the frustration of the magicians, recognizing that the suit “seeks to redress the betrayal of the honor code among magicians, but such redress is not available here because no *legal* rights have been violated.”<sup>282</sup>

#### D. Protecting Choreography

##### 1. *Special Elements of the Act*

###### a. Secret Elements

Some variety acts work because of special choreography that is not seen or appreciated by the audience, such as the secret maneuvering that allows a magician’s assistant to appear in the box that previously held a tiger. While choreography can be protected under copyright law, its usefulness to variety artists is very limited. To gain copyright protection, the choreography must be fixed in a

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278. *See id.* at \*3 (quoting Plaintiff’s Petition and Application for Class Certification, SF Broadcasting, CIV. A. 98-1107, 1998 WL 355462 (E.D. La. Jun. 30, 1998)).

279. *See Harrison*, 1998 WL 355462, at \*3-4 (describing Harrison’s near disqualification by using improper term).

280. *Id.* at \*4 (citing *Deus v. Allstate Ins. Co.*, 15 F.3d 506, 520 (5th Cir.1994), *cert. denied*, 513 U.S. 1014).

281. *See id.* at \*4 (stating reason why case was dismissed).

282. *See id.* (emphasis added) (showing court’s understanding of challenges of magicians).

tangible medium.<sup>283</sup> The performer could make a recording of the performance from an angle that would reveal the secret move, or the details could be fixed in some other medium, like a written description. However, the more successful a magician is in keeping the special choreography a secret from the audience, the more difficult it will be to prove that the imitator copied the material. If the imitating performer never had access to the secret choreography, infringement will be challenging to prove.

Another difficulty is that many illusions can usually be accomplished in a variety of ways, and gaining exclusive rights for one method does not provide protection for the illusion if performed in a different manner. Accordingly, the benefit from copyrighting the secret choreography is limited. Also, if there was only one way to create the illusion, the concept of merger, which provides that protection will not be granted for expressions of ideas when the expression is the only way to express the idea, would likely prevent copyright protection for secret moves, since actions required to execute an idea will merge with the idea.<sup>284</sup> For example, just like the basic instructions in a recipe cannot be protected by copyright, the movements necessary to maneuver an ace to the top of the deck would not be protected.

Trade Secret protection is also unlikely to give the variety artist much protection for clandestine choreography for the same practical reasons it does not grant much protection to mechanisms - the means for creating the illusions are too easily reverse engineered by other practitioners, the usual performance conditions make it too easy for others to gain access to the secret choreography, and it is too difficult to enforce the secrecy needed to maintain the protection.<sup>285</sup>

#### b. Featured Elements

Some variety performers feature unique choreography in their acts, which make their acts different and more dangerous or more exciting, exhilarating, and electrifying than their competition. A

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283. See 17 U.S.C. § 102 (1990) (providing subject matter requirements for original works to be eligible for copyright protection under federal statute).

284. See *Morrissey v. Procter & Gamble Co.*, 379 F.2d. 675, 678-79 (1st Cir. 1967) (holding that copyright cannot extend to expression where there were only limited number of possibilities); see also *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (detailing requirements for expressions with respect to merger doctrine); *supra* notes 73-81 and accompanying text (detailing application of merger doctrine in court).

285. For a further discussion on trade secrets, see *supra* notes 236-261 and accompanying text.

trapeze artist may be the first to perform a quadruple flip when the competition is doing triples. When a variety artist performs for the same audience over and over, they must provide a new feat to draw a crowd, and when a performer looks for work, they must have something to distinguish them from their rivals. These elements also will most likely not be protected under current United States intellectual property laws. The idea of the feat cannot be protected, and the expression or execution of a quadruple flip, for example, would merge with the idea.

## 2. *The Act as a Whole*

### a. Copyright

Copyrighting an act as a whole is possible by fixing it in a tangible medium, either by writing down the script and choreography or by videotaping a performance.<sup>286</sup> While these precautions will grant the variety artist all of the rights available from copyright laws, the value of that protection is limited. In order to enforce the copyrights, artists would have to prove, among other things, that there was substantial similarity between their acts and the allegedly infringing performances.<sup>287</sup> Unless an act was copied in its entirety, this is a difficult claim to prove. The case against Fox Broadcasting for its magic exposure specials, mentioned above, was one of the few such cases to result in a published opinion. In 1997, Fox aired the first of a series of specials called “Breaking the Magicians’ Code” (the “Special”). The Special featured an anonymous “Masked Magician” who performed and exposed several illusions.<sup>288</sup> Rice sued Fox Broadcasting for allegedly imitating a video Rice had made in 1985-86, which featured a masked magician performing and exposing several illusions (the “Video”).<sup>289</sup> Rice sued Fox and asserted copyright infringement, violations of the Lanham

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286. For a detailed discussion on copyrights, see *supra* notes 54-129 and accompanying text. See 17 U.S.C. § 102 (1990) (detailing requirements for original works to be eligible for copyright protection).

287. See *supra* note 81 and accompanying text (providing that expressions are only protected if copy is almost identical); see also *supra* notes 89-129 and accompanying text (detailing application of various tests for determining “substantial similarity” in copyrights).

288. See *Rice v. Fox Broad.*, 148 F. Supp. 2d 1029, 1038 (C.D. Cal. 2001) (specifying that special was created for broadcast).

289. See *generally id.* at 1035-37 (C.D. Cal. 2001) (noting that video was produced and distributed in 1986).

Act, unjust enrichment, and violation of the California Unfair Business Practices Act, among other claims.<sup>290</sup>

In this suit, Rice did not claim to own the rights to the effects performed and exposed in the Video and the Special.<sup>291</sup> Instead, Rice claimed that he had rights to the character of the performer and to the dialogue, mood, pace, setting, and sequence of events in the Video.<sup>292</sup> One illusion was a version of “Sawing Through a Woman,” which had been patented by Horace Goldin in the 1920s.<sup>293</sup> Both shows also featured a “Lady into Tiger” illusion, an act of levitation, and the “Zig Zag Lady.”<sup>294</sup> The court found the illusions themselves to be in the public domain, and treated both works, the Video and the Special, as compilations of un-copyrightable elements.<sup>295</sup> Accordingly, that court applied the law from *Feist*, which held that there was no infringement where un-copyrightable facts were copied.<sup>296</sup> The *Rice* court acknowledged that:

Though Plaintiff’s video is obviously more creative and original than a typical factual compilation, or the telephone directory which was at issue in *Feist* . . . it is certainly analogous in the sense that Plaintiff may not rely on the tricks themselves to show substantial similarity, and must

290. *See id.* at 1033 (acknowledging that four state-law claims have been dismissed).

291. *See id.* at 1033, 1039 (discussing parties’ disputes concerning presentation style, order of tricks, music, and camera angles).

292. For a discussion of copyright infringement regarding secret elements, see *supra* note 283-285 and accompanying text. *See also Rice*, 148 F. Supp. 2d at 1040 (recognizing plaintiff’s argument identifying similarities to be in “costume, social standing, and the respective roles of the two men in the two presentations”).

293. *See Rice*, 148 F. Supp. 2d at 1036-38 (noting the order of illusion and whether or not illusion was revealed in respective shows); U.S. Patent No. 1,458,575 (filed Sept. 9, 1921).

294. *See Rice*, 148 F. Supp. 2d at 1036-38 (comparing which illusions were featured and order in which illusions appeared in respective shows). Each show also featured illusions not performed in the other. *Id.* In “Zig Zag Lady,” a woman steps into an upright cupboard, the magician closes the door, pushes blades through her chest and hips, and slides the middle section out to the side, showing she has been divided into three parts. The magician pushes the center section back, removes the blades, and opens the door, allowing the woman to step out, whole and in one piece.

295. *See id.* at 1054 (“[I]t is undisputed that Plaintiff may claim no right to the particular tricks (or their explanations) which are included in both the Rice Video and the first episode of the Television Specials. These are apparently in the public domain.”). For discussion of two-pronged extrinsic and intrinsic test, see *supra* notes 102-111 and accompanying text.

296. *See Rice*, 148 F. Supp. 2d at 1050-54 (citing *Feist Publ’n, Inc. v. Rural Tel. Service Co.*, 499 U.S. 340, 361 (1991)) (noting only copyrightable material can be copywritten). For a further discussion of *Feist*, see *supra* notes 98-101 and accompanying text detailing substantial similarity test Court applied.

rely on the sequence of those tricks, on the parameters within which they are presented, and on elements of the Rice Video *aside* from the tricks which are distinctive/original.<sup>297</sup>

The court then compared the performances element by element.<sup>298</sup> First, as discussed previously, it considered the main character, the Mystery Magician.<sup>299</sup> The court found that Rice's Mystery Magician lacked sufficient definition to be copyrightable, since it was more of an archetype of a magician, a cipher, rather than a unique, identifiable character with qualities that remain constant over several works.<sup>300</sup> The court noted that if Sam Spade, protagonist of "The Maltese Falcon," was not copyrightable outside of that work, then the Rice's Mystery Magician certainly did not merit that protection.<sup>301</sup>

Next, the court considered the dialogue or monologue in each piece, holding that an identical, or at least "substantially similar," script was required in order to qualify as infringement.<sup>302</sup> The court noted that finding infringement based on scripts being similar in theme or effect would be too close to granting protection for the underlying ideas, and that protection was also prohibited because various speeches by the Mystery Magician qualified as *scènes à faire*, in the sense that any performance revealing how magic tricks worked would likely include speeches

[A]bout how tricks have been passed down through the ages, along with the 'magicians' code' that the secrets of those tricks should never be revealed to the viewing public [or] a closing speech about wanting to inspire viewers . . . to love and appreciate magic and magicians.<sup>303</sup>

The court also considered the moods of the two performances, finding them to be dissimilar: the Video was detailed and careful,

297. *Rice*, 148 F. Supp. 2d at 1054 (citation omitted).

298. *See id.* at 1055-60 (detailing court's "analytic dissection" according to video's elements).

299. *See id.* at 1055-58 (discussing character of Mystery Magician as first element).

300. *See id.* at 1056-58 (determining ubiquitous nature of masked magician character).

301. *See id.* at 1056 (citing *Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc.*, 216 F.2d 945, 950 (9th Cir. 1954)) (distinguishing "The Maltese Falcon" from mystery magician).

302. *See id.* at 1058 (denying plaintiff's claim of substantial similarity in dialogue).

303. *Id.*

while the Special was “sarcastic, even cynical.”<sup>304</sup> But even if the moods were similar, the court would have considered that to be an unprotectable element, since a mood of secrecy and mystery would naturally go with a show about revealing magic.<sup>305</sup> The court also found no similarity in the settings of the two performances, as the Video took place in an empty theater and the Special was set in an empty warehouse.<sup>306</sup> The court noted that any similarity related to the use of a “secret night-time setting” qualified as a “*scène à faire*” and was not worthy of protection.<sup>307</sup>

Finally, the court compared the similarity of the “overall sequence of events” of the specials.<sup>308</sup> While Rice attempted to compare the two works at a general level, the court desired a much narrower comparison.<sup>309</sup> Rice pointed to the opening shots of both works as evidence of similarity.<sup>310</sup> In the Video, the opening scene shows the protagonist performer’s feet walking down a dark street outside the theater in which the action takes place, and the Special begins with the narrator walking into view in a warehouse.<sup>311</sup> Instead of being swayed, the court found these scenes to be evidence of the differences between the two works, as the Video had no narrator appearing on-screen.<sup>312</sup>

Once the court eliminated every other basis for claiming copyrights to the Video, it noted that Rice’s only remaining claim must be based on “some direct copying in the *way* in which the tricks are revealed, the dialogue associated therewith, the sequence in which the tricks are revealed, or some other aspect of the particular ‘performance’ which is captured on the Rice Video.”<sup>313</sup> The two works had only five tricks in common.<sup>314</sup> None of the five were performed identically in both works.<sup>315</sup> The court noted that the tricks

304. *Id.*

305. *Id.* at 1058-59.

306. *Id.* at 1059.

307. *See id.* (emphasizing ubiquity of dark, secret settings among magic shows).

308. *See id.* at 1059-60 (listing plaintiff’s claims for similarity in plots).

309. *See id.* at 1059-61 (requiring less “elevated level of abstraction” for similarity analysis).

310. *See id.* at 1060 (recounting one of plaintiff’s listed commonalities).

311. *See id.* (describing opening scenes).

312. *See id.* (“[T]his points out one of the ways in which the ‘plot’/‘sequence’ of these two works is decidedly not ‘substantially similar’: there is an on-screen host in the Television Specials, who is given at least as significant a role in the development of the ‘plot’ as is the Masked Magician himself.”).

313. *Id.* (emphasis in original).

314. *See id.* (noting number of tricks shared by works).

315. *See id.* (comparing performance of magic tricks in videos at issue).

were not performed in the same order, nor was the dialogue during the performances substantially similar.<sup>316</sup> Looking at all of these factors, the court found that there was not sufficient similarity between the two performances to find copyright infringement.<sup>317</sup>

*Glazer v. Hoffman*, discussed previously, a 1943 case from the Supreme Court of Florida, is based on outdated law, but still illustrates how copyright claims of novelty artists have been treated by the courts.<sup>318</sup> Hoffman's copyright was found only to apply to the speech he gave before beginning his performance and not to the performance, as the performance was not a "dramatic composition" within the protection of the then-existing Federal copyright laws.<sup>319</sup> The *Hoffman* court also stated that a performer only held rights to a creation before its "publication or dedication to the public," and that by performing his act, "the trick or stunt became the property of the general public" and Hoffman had terminated any rights he may have had to the act under the common law and relevant statutes.<sup>320</sup> While the court granted Hoffman protection for the introduction to his performance and for his trade name "Think-a-Drink Hoffman," the plaintiff in the case, Mr. Glazer, was allowed to continue performing the "Any Drink Called For" act, which received no protection.<sup>321</sup>

Even with the later addition of copyright protection for pantomimes, magicians and other variety artists will have a hard time gaining copyright protection for their work for the same reasons Rice had difficulty – the merger of ideas and expression and the "*scènes à faire*" doctrine. For example, the idea of juggling a bowling ball, a chainsaw and a hedgehog cannot be copyrighted, because it is an idea. Any performer trying to protect such an act will have trouble, because the choreography of juggling would likely be considered to merge with the idea, just as a list of ingredients merges with the idea of making the cake. Also, as in *Rice*, the

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316. See *id.* at 1060-61 (finding differences between two videos' presentation of magic tricks).

317. See *id.* at 1061 (rejecting claim any juror could find substantial similarity, and therefore copyright infringement).

318. See generally *Glazer v. Hoffman*, 16 So. 2d 53 (Fla. 1943). For a full description of the case, see *supra* notes 184-194 and accompanying text.

319. See *Glazer*, 16 So. 2d at 55 (concluding Hoffman failed to bring act within terms of copyright statute).

320. See *id.* (stating act became property of general public after public performance).

321. See *id.* at 55-56 (requiring performer to use own name and not appropriate good reputation of another). For a further discussion of the details and holding of the case, see *supra* notes 184-194 and accompanying text.

“*scènes à faire*” doctrine will work against protecting novelty performances because many of these acts tap into traditions and refer to themes with which audiences are familiar. This may make the acts uncopyrightable. As Rice discovered, these doctrines will make only the most perfect plagiarists liable for copyright infringement.

#### b. Right of Publicity

The right of publicity is not as well defined as copyright, but it is unlikely to provide more protection for the particular interests of variety performers. The foundational right of publicity case, *Zacchini*, involved the unauthorized use of a video recording of Zacchini’s human cannonball act.<sup>322</sup> The Supreme Court specifically noted that the facts of *Zacchini* did not require them to consider if the performer’s right of publicity could prevent the television station from putting on its own, competing, human cannonball display.<sup>323</sup> *Zacchini* also only involved damages, not an injunction.<sup>324</sup> Hugo Zacchini was not seeking to prevent the television station from using the tape of his act; he only asked that it compensate him for airing the tape.<sup>325</sup>

This holding is of limited utility for variety artists. *Zacchini* does not address whether a variety artist with an original act can require other performers to pay to imitate that act, or whether the artist can enjoin other performers from using the act at all.<sup>326</sup> The Supreme Court did point to some arguments for allowing injunctions, such as the similarity between the goals of the right of publicity and copyright and patent laws.<sup>327</sup> However, the Court also noted the goal of allowing the public to benefit from the creation, indicating a preference for disseminating the work as far as possible and a predisposition against allowing the creator of the act to enjoin other

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322. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977). For a further discussion of the case, see *supra* notes 216-235.

323. See *id.* at 577 n.13 (detailing arguments that copyright law does not violate First Amendment because no restrictions are placed on communication of ideas or concepts).

324. See *id.* at 578 (“Petitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it.”).

325. See *id.* (acknowledging that petitioner wants commercial value of his act recognized).

326. See *id.* at 578-79 (limiting evaluation to specific remedy sought by petitioner).

327. See *id.* at 576 (asserting enforceable right of publicity, like copyright and patent laws, provides economic incentive for performer to create).

performances.<sup>328</sup> In light of *Zacchini*, it is unclear, in the variety arts context, if imitators would have to pay the originator of the act.

### E. Protecting Jokes

Variety and novelty performers spend a lot of time testing new jokes, playing with exactly the best words for a punch line, and trying to figure out what will get the biggest reaction from their audience.<sup>329</sup> While protection for a joke is unlikely, it is possible. Comedian Jeff Foxworthy is best known for his “redneck” stand-up comedy routine, built around jokes like: “You might be a redneck if . . . you’ve ever financed a tattoo,” “You might be a redneck if . . . your dog and your wallet are both on a chain,” and “You might be a redneck if . . . your dad walks you to school because you’re in the same grade.”<sup>330</sup> Taking advantage of Foxworthy’s popularity, a company called Custom Tees started printing shirts with text like: “If you’ve ever financed a tattoo . . . you might be a redneck.”<sup>331</sup> Foxworthy succeeded in getting a preliminary injunction against Custom Tees.<sup>332</sup> In his suit, Foxworthy claimed a common-law trademark in the phrase: “you might be a redneck.”<sup>333</sup> After Foxworthy commenced his suit, Custom Tees started printing shirts with the phrase “you ain’t nothing but a redneck” instead of “you might be a redneck.”<sup>334</sup>

Because Foxworthy had not registered the phrase as a trademark, he relied on section 43(a) of the Lanham Act in his suit.<sup>335</sup> Section 43(a) grants protection to unregistered marks if the unauthorized use would be “likely to cause confusion . . . as to the origin,

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328. *See id.* at 576-77 (stating that patent, copyright, and publicity laws advance public welfare by encouraging production of works that advance science and useful arts).

329. *See e.g.*, *THE ARISTOCRATS* (Lion’s Gate Pictures 2005). This documentary illustrates this developmental process as it follows many performers telling their versions of the same joke. The comedians tinker with the joke’s progression while competing to make their retelling the most vile and disgusting. The author cautions that nearly everyone will find this film offensive.

330. *See Foxworthy v. Custom Tees, Inc.*, 879 F. Supp. 1200, 1204 (N.D. Ga. 1995) (providing background information on plaintiff’s popularity as performer and style of humor).

331. *See id.* (summarizing events that led to litigation).

332. *See id.* at 1200 (noting Foxworthy’s successful attempt to prevent company’s use of phrase associated with his act).

333. *See id.* at 1209 (explaining Foxworthy’s belief that he had valid claim for common law trademark over phrase).

334. *See id.* at 1204 (noting slight change in language used by Custom Tees following commencement of lawsuit).

335. *See Lanham Act*, 15 U.S.C. § 1125(a) (2006); *Foxworthy*, 879 F. Supp. at 1209 (explaining purpose of Lanham Act and its application in this case).

sponsorship, or approval of his or her goods, services, or commercial activities by another person.”<sup>336</sup> Without a registered trademark, the court first considered whether Foxworthy had a mark eligible for protection.<sup>337</sup> The court found that “you might be a redneck” was Foxworthy’s catch phrase, the “hook” that made his act unique.<sup>338</sup> He used this phrase as the title of his first book, his national tour, his “platinum selling album,” his Showtime special, and his “page-a-day” calendar.<sup>339</sup> The court noted that while “you might be a redneck” may have a functional element as the set-up for a joke, it also served to distinguish Foxworthy’s act from the acts of others performing in the redneck comedy genre.<sup>340</sup>

Next, the court considered the likelihood of confusion.<sup>341</sup> The court found “you might be a redneck” to be a suggestive mark, requiring the public to “use their imaginations . . . to discern the content of the humor . . . .”<sup>342</sup> When the court considered the similarity between Foxworthy’s punch line and the phrase used on the shirts, it looked at more than the actual words, stating “[T]he issue is the result [of the phrase], not the precise language.”<sup>343</sup> In the context of mocking rednecks, phrases creating “a ‘test’ . . . for whether one is a redneck” are similar.<sup>344</sup> In the rest of the court’s analysis, none of the factors favored Custom Tees, and the court granted Foxworthy the injunction.<sup>345</sup> The court also granted an in-

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336. Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2006) (stating application of statute).

337. *See Foxworthy*, 879 F. Supp. at 1209-11 (examining whether Foxworthy had trademark to protect).

338. *See id.* at 1210 (establishing that phrase was specific to Foxworthy’s routine).

339. *See id.* (listing examples of Foxworthy’s use of phrase).

340. *See id.* at 1211 (noting unique element of Foxworthy’s routine).

341. *See id.* at 1212-17 (articulating next step in court’s test). For a further discussion of the Eleventh and Ninth Circuit’s differing tests, see *supra* notes 48-50 and accompanying text. The Eleventh Circuit *Conagra* test includes:

- (1) strength of plaintiff’s mark
- (2) degree of similarity between the two marks
- (3) similarity between the products or services
- (4) similarity of target market
- (5) similarity of advertising
- (6) intention of defendants- were they looking to free ride on the association
- (7) actual confusion.

*Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1514 (11th Cir. 1984).

342. *See Foxworthy*, 879 F. Supp. at 1212 (highlighting connection between phrase and intended humorous effect).

343. *See id.* at 1213 (reciting court’s focus on meaning behind language).

344. *See id.* (establishing similarity between Foxworthy’s phrase and Custom Tee’s phrase).

345. *See id.* at 1212-17 (detailing court’s rationale and eventual holding).

junction for Foxworthy's copyright claim, holding that he was entitled to protection on his 'punch lines,' since they were original expressions of the jokes' ideas.<sup>346</sup>

Jeff Foxworthy's victory is unlikely to help many other variety artists, since, even in 1995, he was more famous than the vast majority of variety artists and had marketed his catchphrase in a variety of forms all over the country.<sup>347</sup> The comedian prevailed because of his fame, his ubiquitous use of the "you might be a redneck" phrase, and because the copying shirts printed his jokes verbatim.<sup>348</sup>

As demonstrated in *Rice*, *Foxworthy*, and *Hoffman*, the standard for protecting pieces of an act is very high.<sup>349</sup> First, because words and short phrases are generally not copyrightable.<sup>350</sup> Also, after filtering out ideas, expressions that merge with those ideas, and "*scènes à faire*," very little would be left to protect. Finally, few variety performers have the notoriety and exposure that allowed Foxworthy to protect his catchphrase based on a common law trademark claim and the Lanham Act.<sup>351</sup>

#### F. Protecting a Gimmick

In the musical *Gypsy!*, Mazeppa tells the young woman about to become the famous stripper Gypsy Rose Lee, that in order to be a success, "[w]hat you need is an idea—something that's gonna make your strip . . . special!"<sup>352</sup> Many variety artists similarly attempt to make their act unique. Performers will try to distinguish their act with a gimmick—a signature look, feat, or other element that will

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346. See *id.* at 1217-19 (explaining court's decision to grant injunction and rationale).

347. For a discussion of fame and its effects on copyright claims, see *supra* notes 330-346 and accompanying text.

348. For a discussion of publicity and its effects on copyright claims, see *supra* notes 329-351 and accompanying text.

349. See generally *Glazer v. Hoffman*, 16 So. 2d 53 (Fla. 1943) (articulating standards for offering protection to pieces of acts); *Rice v. Fox Broad. Co.*, 148 F. Supp. 2d 1029 (C.D. Cal. 2001) (giving more examples of high standard); *Foxworthy v. Custom Tees, Inc.*, 879 F. Supp. 1200 (N.D. Ga. 1995) (rearticulating same issue). For a further discussion of *Glazer*, see *supra* notes 184-194. For a further discussion of *Rice*, see *supra* notes 195-200. For a further discussion of *Foxworthy*, see *supra* notes 329-351.

350. See *Signo Trading Intern. Ltd. v Gordon*, 535 F. Supp 362, 365 (N.D. Cal. 1981) (discussing characteristics of copyrightable works); see also 37 CFR § 202.1.

351. For a further discussion of the *Foxworthy* matter, see *supra*, notes 332-352 and accompanying text.

352. *Gypsy!* (Warner Bros. Pictures 1962). "You Gotta Get a Gimmick," lyrics by Stephen Sondheim.

make their performance stand out from the rest, make them special, and help them get work.

Copyright laws will most likely be useless to protect the signature aspect of the act, since the expression will almost certainly merge with the idea, and thus cannot be protected by copyright. Although performers may think of their gimmick as their “trademark,” trademark law will also not provide any protection for a signature acrobatic feat, for example.<sup>353</sup> Unfair competition may be the legal theory that would give a performer the best chance of protecting his or her signature performance.<sup>354</sup> In *DeCosta v Columbia Broadcasting Systems, Inc.*,<sup>355</sup> creating a character with a distinctive name, slogan, or costume was found to be enough to qualify for protection.<sup>356</sup> The court identified a number of factors which came into play: whether the plaintiff had rights to the original performance, whether there had been misappropriation by the defendant, whether there had been any palming off (putting one party’s name on work done by another party), and whether there was a likelihood of confusion between the two acts.<sup>357</sup> Even though the defendant prevailed in that case, that cause of action leaves others hope.

#### IV. INTERNATIONAL SOURCES OF PROTECTION FOR VARIETY ARTISTS

##### A. Moral rights

Some countries recognize the “moral rights” of creators over their artistic works, including (1) the right for the creator of a work to be recognized as that work’s author; (2) the right to determine when a work is complete, such as the right of final cut; (3) the right to decide whether, how, and when a work may be published or otherwise made available to the public; and (4) the right to prevent others from editing, mutilating, or otherwise changing a completed work.<sup>358</sup> For example, the Berne Convention for the Protection of Literary and Artistic Works grants authors a limited version of moral rights when it provides for “the right to claim authorship of

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353. For a further discussion of U.S. copyright and trademark law, see *supra*, notes 54-133 and accompanying text.

354. For a description of Unfair Competition, see *supra* notes 130-152 and accompanying text.

355. 520 F.2d 499 (1st Cir. 1975).

356. *See id.* at 512-13 (1st Cir. 1975) (discussing protection under common law trademark doctrine).

357. *See id.* at 513 (listing factors to determine copyright protection).

358. *See generally* JEREMY PHILLIPS & ALISON FIRTH, INTRODUCTION TO INTELLECTUAL PROPERTY LAW (Butterworths 4th ed. 2001) (discussing copyright protection in foreign countries).

the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.”<sup>359</sup> Traditionally, the United States has not recognized such rights.

Even the moral rights of the Berne Convention provide little protection for variety artists. It is not clear variety artists would be considered authors under the convention, as that term is not specifically defined, and if they were included, the terms of the convention may or may not be extended to create a right to prevent others from imitating their performances.

### B. United Kingdom’s Dramatic and Musical Performers’ Act

The United Kingdom has a long history of variety artists performing in its music halls, but it has not provided any better for them in its laws. For example, in 1925, Parliament passed the Dramatic and Musical Performers’ Act (“DMPA”), which created criminal liability for making and selling unauthorized recordings of artists’ performances.<sup>360</sup> The DMPA provided performers with little satisfaction. It created only criminal, and not civil, liability, leaving performers without individual recourse.<sup>361</sup> The court in *Musical Performers’ Protection Association Ltd v. British International Pictures Ltd.*,<sup>362</sup> determined that a group of musicians did not have a private cause of action under the DMPA to sue a film production company for using a recording of the musicians’ performance. The court reasoned that under the DMPA, any fines imposed under the statute were paid to the government, and not to the artist, indicating the performers had no property right in their performance, and thus no right to sue.<sup>363</sup>

### C. The Rome Convention

In 1961, the International Convention for the Protection of Performers, Producers of Phonograms, and Broadcasting Organizations (“Rome Convention”) was held in Rome and resulted in the addition of thirty-four new articles providing additional protections

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359. See generally, Berne Convention for the Protection of Literary and Artistic Works, art. 6 § 1, Sept. 9, 1886.

360. See generally, Dramatic and Musical Performers Act, 1925, H.C. Deb., Vol. 185, ser. 5, cols. 1790-91 (Eng.) (criminalizing making and selling unauthorized recordings).

361. See e.g., *Musical Performers’ Prot. Assoc. Ltd v. British Int’l Pictures Ltd.*, (1930) 46 T.L.R. 485 (noting Act’s lack of civil redress).

362. (1930) 46 T.L.R. 485.

363. See *id.* at 485-97 (discussing lack of civil recourse for performer).

beyond traditional copyrights.<sup>364</sup> The Rome Convention, however, made the protection of variety artists optional, providing only the “possibility of protecting” those performers against the “broadcasting and the communication to the public” of their work without their permission if: (i) the original fixation was made without their consent; (ii) if the reproduction is made for purposes different from those for which the performers gave their consent” or, (iii) if the original fixation qualified as fair use, but the later use of the fixation does not qualify for that exception.<sup>365</sup> The Intergovernmental Committee of the Rome Convention drafted a Model Law in 1964 from which the signatory countries could work to create their own laws.<sup>366</sup> The Model Law, if adopted, would make protections more definite than the Convention, alone. It provided, among other things, that “[w]ithout the authorization of the performers, no person shall [fix an] unfixed performance.”<sup>367</sup> The effect of this Model Law would be similar to the effect of *Zacchini*.<sup>368</sup> It would provide little protection against imitation by other performers.

However, *Zacchini* himself would still be out of luck. The Convention explicitly restricts its protections to “performers,” defined as “actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, or otherwise perform literary or artistic works.”<sup>369</sup> The Rome Convention treats variety artists as a separate category. Article nine, titled “Variety and Circus Artists,” provides that “Any Contracting State *may*, by its domestic laws and regulations, extend the protection provided for in this Convention to artists who do not perform literary or artistic works.”<sup>370</sup>

The Rome Convention might have provided more protection for variety artists, but those performers were deliberately omitted from the Convention. During the negotiations, Austria proposed widening the application of the rule to “literary or artistic recitations, presentations or performances of all kinds,” but the proposal

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364. International Convention for the Protection of Performers, Producers of Phonograms, and Broadcasting Organizations [hereinafter Rome Convention], Oct. 26, 1961, 496 U.N.T.S. 43 (discussing Rome Convention).

365. *See id.* § 7.

366. *See id.*

367. *Id.* art. 7.

368. For a further discussion of *Zacchini*, see *supra* notes 217-133 and accompanying text. The United States is not a signatory to the Rome Convention.

369. Rome Convention, *supra* note 364, art. 3(a).

370. *Id.* art. 9 (emphasis added).

was voted down.<sup>371</sup> Austria later proposed that the protections apply to “anyone who takes part as an artist in the performance or presentation of a literary or artistic work or a variety show.”<sup>372</sup> That suggestion was also rejected, leaving protection for the work of variety artists out completely.

#### D. Dutch Copyright Law

A Dutch court recently addressed this very issue. In November, 2011, a Dutch court found a magician had infringed on the copyright of another magician who used to work with him.<sup>373</sup> Rafael van Herck sued his former employer, Hans Klok, for performing a sequence of illusions in the manner originated by von Herck.<sup>374</sup> One of von Herck’s claims was based on copyright law. While much of the proceedings were kept under wraps, due to the parties’ desire to keep the details of the illusions secret, the rough Google Translation of the von Herck court’s decision reflects a process similar to the United States’ copyright analysis.<sup>375</sup>

The Dutch court noted that while the basic illusions alone (thrusting a hand through a person’s torso or knocking a person’s head off their shoulders and restoring it) may not be protected, the routine and story created by Herck in performing them involved “creative choices,” effectively making the performance a “play” which had been imitated by Klok without permission.<sup>376</sup> Herck was awarded damages and costs, totaling approximately \$16,725.<sup>377</sup>

#### V. THE BENEFITS AND PROBLEMS OF ADDING ADDITIONAL PROTECTIONS

Having explored how current intellectual property laws provide little protection for variety artists, the next question is whether

371. Records of the Diplomatic Conference on the International Protection of Performers, Producers of Phonograms and Broadcasting Organizations, Rome, 10 to 26 Oct. 1961. CDR/23, at 208.

372. *Id.* at CDR/49, at 209.

373. See *Abracadabra! Dutch Court Fines Magician Over Act*, CBS (Nov. 9, 2011, 10:11am), [http://www.cbsnews.com/8301-501714\\_162-57321353/abracadabra-dutch-court-fines-magician-over-act/](http://www.cbsnews.com/8301-501714_162-57321353/abracadabra-dutch-court-fines-magician-over-act/) [hereinafter *Abracadabra!*] (outlining holding of Dutch court with respect to copying of prior sequence of live performance).

374. *Id.*

375. Judgment Interim Order of November 9, 2011, District Court, The Hague, 404 011/KG ZA 11-1144, available at <http://zoeken.rechtspraak.nl/detailpage.aspx?ljn=BU3795>

376. *Id.* at ¶ 4.6, note 4.

377. See *Abracadabra!*, *supra* note 369 (explaining Herck’s damages for copying of his live, creative performance).

those artists would benefit from additional protections, and if so, what those protections should be. Some variety artists perform a piece the same way it has been performed for decades. Others create new material. Some of those inventors suffer when other performers copy their carefully crafted material, when cut-rate manufacturers knock off their designs, or when students of the art illegally download their instructional videos from file-sharing networks. This section explores the potential benefits and damages that could arise from adding intellectual property protections by using magicians as a sample case.<sup>378</sup>

As discussed above, one purpose of intellectual property law is to encourage creativity in the arts.<sup>379</sup> The Supreme Court noted in *Zacchini*, that for an artist to invest the time and work to create a performance, he would require “his commercial stake in his act [to be] appropriately recognized.”<sup>380</sup> There is currently a great deal of unauthorized copying within the magic world. Instructional videos made by magicians for sale to the trade are swapped on file-sharing networks. On occasion, when a rising star appears with a unique act, a rash of similar acts appear shortly afterwards. Anecdotal evidence speaks of magicians giving up on the art because they could not “reap the reward of their endeavors.”<sup>381</sup>

Without additional intellectual property protection, the risk remains that magicians will see what they perceive to be their proprietary work copied by other performers. However, adding new intellectual property protections could also interfere disastrously with how magicians learn, work, and create new material. There is no lack of creativity in the magic community. To the contrary, the lack of protection appears to be, on the whole, good for the art form.

Magic is a remix culture. Innovative performers make use of old ideas from different places put together in new ways. Adding intellectual property protections would partition off these ideas, make them inaccessible, and cut magicians off from vital source

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378. The author is a magician, and is familiar with the workings of that community. While magic will be used as a representative example of the variety arts, other variety arts communities may differ in how their arts are learned, developed, passed on, and perpetuated, and accordingly, how they would benefit from or be damaged by additional protections.

379. For a further discussion of this IP law, see *supra* notes 54-58 and accompanying text.

380. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977) (noting performers’ desire to receive payment for their performances).

381. See *id.* at 573 (explaining performers’ need for financial benefit to justify time spent planning and preparing performances).

materials. For example, suppose a magician wants to create a performance in which a selected card reappears in different places, over and over. There are many known techniques for getting a spectator to pick a particular card, for shuffling cards, and for manipulating a chosen card to appear in different places. A magician may select a shuffle from one source, a cut from another, or a showy fan found elsewhere. All of these elements may combine to create a unique routine even though the building blocks have existed for years. Having to determine the origin of each technique, let alone obtain the rights to use these building blocks, would be prohibitively difficult.

Since Scot's *Discoverie of Witchcraft* was published in 1584, magicians have studied books that collect and explain principles and tricks.<sup>382</sup> Many instructional books, including most of those available in mainstream bookstores and public libraries, compile material from a variety of sources, with no information regarding the origin of the magic tricks discussed. For example, one classic text is the *Tarbell Course in Magic*, a six volume set first published in 1927 and still commonly used by magicians.<sup>383</sup> These books are encyclopedias of magic tricks and techniques, many of which are still regularly used in performances today. Tarbell was not the originator of this material, but he cited no sources for his information. Another example is *The Expert at the Card Table*, written by S.W. Erdnase, a seminal work on card manipulation.<sup>384</sup> Erdnase was a pen-name, and although there are several theories regarding his identity, no one has been able to definitively determine who he was, let alone find his heirs to license the material in his book. With resource materials like these, it would be practically impossible for a magician to determine, with any level of certainty, what rights had to be obtained, and from whom, in order to perform this material.

It is also common for inventors of magic material to write magazine articles or books about their innovative creations, or to market instructional videos through websites or specialty shops. Some magicians make a significant portion of their income selling instructional materials to other magicians. Generally, originating magicians do not publish their innovative material until they are ready to allow others to perform it, and it is also general practice for ma-

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382. See REGINALD SCOT, *DISCOVERIE OF WITCHCRAFT* (1584) (illustrating one of first published books on witchcraft and magic tricks).

383. See HARLAN TARBELL, *TARBELL COURSE IN MAGIC* (D. Robbins & Co., Inc., 1999) (giving example of magic trick).

384. See S.W. ERDNAME, *EXPERT AT THE CARD TABLE* (Dover Publications, 1995) (providing second example of magic trick with cards).

gicians to purchase those magazines, books, or videos with the expectation that they have the right to perform the effects described.

These books and videos, which show and explain a performance in detail, serve to fix a performance, as required by current copyright law, to gain protection for the performance. So, ironically, by writing the book or filming the video, the author may gain the right to prevent purchasers from performing the presented magic effects, if the imitation is sufficiently close and the protection sufficiently broad. If authors pursued and enforced those rights, magicians would have to contact the author and obtain a license to perform the material or risk being sued. While it is possible for some to seek licenses, it seems more likely that magicians would ignore the licensing requirements and follow tradition instead. An author would then have the option to sue the people who purchased his book and performed the magic without an additional license. This could result in negative publicity and customer backlash.<sup>385</sup> Whether magicians respect a licensing requirement or fear being sued by the author, separating the right to perform the magic effects described in the book from the purchase of the book would probably also destroy the market for new instructional books and videos.

Some magicians who author instructional books and videos also complain that their materials are illicitly copied, and their videos are being duplicated or shared online. Those authors have a clear recourse. Just as the music and film industries have sued people who share files of movies and music, these authors can sue copiers and file-sharers for copyright infringement. Nevertheless, in a relatively small community like that of magicians, a backlash from potential customers could be very damaging.

The fashion industry is currently going through a similar debate. Fashion is also an industry built on copying and combining elements.<sup>386</sup> The lack of intellectual property protection for clothing designs allows many designers and retailers to offer similar garments, allowing fashion fads to change rapidly, in turn boosting sales in the garment industry as a whole. Top designers' expensive garments appear on the runway and red carpet. While not every-

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385. It is debatable whether a magic club, for example, would invite, or hire, a magician to lecture to and teach its members if the lecturer had a reputation for suing his students.

386. See David Bollier & Laurie Racine, *Control of Creativity? Fashion's Secret*, CHRISTIAN SCIENCE MONITOR (Sept. 9, 2003), [www.csmonitor.com/2003/0909/p09s01-coop.html](http://www.csmonitor.com/2003/0909/p09s01-coop.html) (discussing fashion industry's acceptance of derivation and collaboration as creative tools).

one can afford the couture gown worn by the Oscar nominee, many women will buy a similar style dress featured in a fashion magazine the next month. This is possible because there is currently no intellectual property law covering clothing designs that prevents manufacturers from quickly selling designs similar to the dress of the moment, or the new jean/tight hybrid pant.<sup>387</sup> Some designers are seeking additional intellectual property laws to change that situation.<sup>388</sup>

Other designers are fighting those changes out of concern that giving one designer a monopoly over a fashion design would have a damaging effect on innovation in the industry.<sup>389</sup> For example, some fear that this would be equivalent to one designer getting a monopoly over the zipper. Also, forcing the copying to stop could injure the industry. New fads drive sales, and it is debatable whether new fads could develop if only one company made the style, or only one store sold it. While all the reasons for concern in the fashion industry may not directly apply to the variety arts, it is certainly worth considering the benefits an industry or art receives from allowing imitation.

There is also a question as to whether those who copy the work of innovators are truly in competition with those innovators. Suppose an innovator creates a new illusion, a new kind of box to use for sawing a woman in half, for example. To obtain the prop from the originator or licensed manufacturer would be quite expensive, and a handful of the top tier of performers may take the risk of a new, unproven apparatus and make the purchase. However, it will not be too long before some manufacturer starts selling knock-offs for much less, and a larger segment of the field may buy them. The performers who purchase the knock-offs might have purchased the originals, likely to be of higher quality and identifiable as originals to those in the know, if they had the resources. These performers may aspire to purchase the originals some day. Also, the knock-off may provide greater exposure for the illusion because the more an illusion is performed, the greater its exposure to potential customers.

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387. See *id.* (explaining that too much private control of fashion is harmful to creativity).

388. See Kathleen Fasanella, *Proposed Law to Destroy 90% of Design Business*, FASHION-INCUBATOR (May 14, 2009, 1:13 PM), [www.fashion-incubator.com/archive/proposed-law-to-destroy-90-of-design-businesses/](http://www.fashion-incubator.com/archive/proposed-law-to-destroy-90-of-design-businesses/) (discussing Design Piracy Prohibition Act).

389. See, e.g., *id.* (detailing increased hardships on innovation).

Some variety acts imitate an innovative performer's style, theme, or hook. Occasionally, a performer gathers acclaim for an act that has a unique gimmick.<sup>390</sup> For example, a performer may become prominent with an act where he produces medals, compact discs, or other items not in common use at that time. Shortly, a number of other magicians may start performing acts with similar props. There is a strong argument that these imitators are free-riding off of the work and notoriety of the original performer. As a matter of policy, the law should protect the innovator and allow him to reap the "reward of his endeavors."<sup>391</sup> However, if imitators take the idea and improve upon it, or add to it, then they are also advancing the development of the art, which should be encouraged. While the perspectives of the innovators may vary, it is not entirely clear whether it is in the innovator's best interest, or whether it would benefit the art as a whole, to stop permitting copying completely.

Another possibility is that intellectual property protections would become practically meaningless, given the general lack of resources of many performers in the field. Only a few performers at the very top would have the money to dedicate to pursuing a lawsuit, and many potential defendants would be effectively judgment proof. Smaller, poorer, innovative magicians would likely be unable to enforce their intellectual property rights against infringers with greater resources. Similarly, smaller, poorer performers would also be ill prepared to defend themselves even if they were in the right. The availability of this monopoly would give bigger players with more resources an enormous advantage over those without the resources to defend themselves. As a result, the addition of intellectual property protections would likely only advantage a few of the largest players in the field, and would give no added incentives or benefits to new players to enter the field and create.

Finally, magicians may not want the courts to be the arbiter of these disputes. There is a great deal of risk in putting that power in the hands of a fact finder who knows nothing about the art. Magicians seeking to enforce or defend rights to their material would have to explain the history and significance of developments in magic to the court and would have to educate the fact finder about how magic works, and why distinctions are vital or immaterial to the

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390. For a further discussion of gimmicks, see *supra* notes 54-129, 353 and accompanying text.

391. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (explaining goals of patent and copyright law).

art form. Distinctions that may seem obvious or dramatic to one immersed in the art may appear minimal or irrelevant to a non-practitioner. Introducing the finders of fact to the culture and history of magic is a challenge not every potential litigant may want to take on.

An alternative to legal protections would be an informal, internal enforcement of an ethics and standards code within the art. Teller, of Penn & Teller, has referred to observance of the code prohibiting imitation of a competitor's performance as "the gentlemanly thing to do."<sup>392</sup> While these governance mechanisms are not as strong as the protections offered by intellectual property laws, they are customized to the art, come directly from the community, and may be enforced by those who are knowledgeable and committed to the craft. Their potential impact should not be underestimated.

Recently, albeit outside of the world of variety arts, internal or informal shaming and self-enforcement mechanisms have been amazingly effective. Around November 4, 2010, Monica Gaudio, a blogger and food writer, posted an entry on her blog describing her interactions with the editor of a magazine called *Cooks Source*.<sup>393</sup> Ms. Gaudio explained how she found that an article of hers had been published without her consent in *Cooks Source*, both online and in print.<sup>394</sup> The article published by *Cooks Source* had apparently been copied from a website owned by Ms. Gaudio.<sup>395</sup>

When Ms. Gaudio finally reached a *Cooks Source* editor, the editor declined to give her either an apology or compensation.<sup>396</sup> Instead, the editor informed Ms. Gaudio that "the web is considered public domain" and that she should be grateful *Cooks Source* had even bothered to attach Ms. Gaudio's name to her work.<sup>397</sup> Word spread of Ms. Gaudio's situation, and people took action.<sup>398</sup> A

392. See Campbell Robertson, *Dueling Magicians: Whose Trick is it Anyway?*, N.Y. TIMES (Sept. 27, 2006), [www.nytimes.com/2006/09/27/theater/27magi.html](http://www.nytimes.com/2006/09/27/theater/27magi.html) (suggesting gentlemanly way to act in magic industry).

393. See *Copyright Infringement and Me*, ILLADORE'S HOUSE O CRACK (Nov. 3, 2010, 11:14 PM), [illadore.livejournal.com/30674.html](http://illadore.livejournal.com/30674.html) (discussing contact with editor).

394. See *id.* (describing discovery of article published without original author's consent).

395. See *id.* (explaining where magazine found Gaudio's article).

396. See *id.* (summarizing Gaudio's phone conversation with editor). Gaudio had requested a contribution to the Columbia School of Journalism as her compensation.

397. See *id.* (showing editor's view of taking and using articles from internet).

398. See Dugald Baird, *Cooks Source: US Copyright Complaint Sparks Twitter and Facebook Storm*, THE GUARDIAN (Nov. 4, 2010), [www.guardian.co.uk/media/pda/](http://www.guardian.co.uk/media/pda/)

spoof Twitter account appeared, others tweeted comments with a “#CrooksSource” hashtag, and the *Cooks Source* Facebook page became overwhelmed with angry posts, including some blaming the magazine for a wide and humorously unlikely variety of infamy, including inventing Windows Vista and having been on the grassy knoll.<sup>399</sup> Some of those outraged searched the archives of *Cooks Source Magazine*, finding and highlighting other instances where the magazine potentially plagiarized, claiming to have identified over one hundred and fifty instances where Cooks Source published articles copied from the internet.<sup>400</sup> Other people contacted *Cooks Source’s* advertisers, and some advertisers pulled their ads.<sup>401</sup> The magazine has since folded.<sup>402</sup>

Similarly, magicians have attempted to enforce copyright protections on a smaller scale. Upon hearing that a publisher was selling copies of a book containing unauthorized material originally written by a recently deceased magician, several members of the community contacted magic retailers to ask them not to carry the book. Many retailers agreed not to carry or sell the book. While it is unclear how many retailers cooperated, it does appear that the community is capable of enforcing its ethics when a large enough group is sufficiently offended. The magic community has historically been effective at maintaining the secrets of the trade, for example, and discouraging their exposure to the public.

While the current, open, cooperative system does sometimes permit free riders to benefit from the work of others, it makes innovation and collaboration easier and less risky for variety artists and does a better job of encouraging the creation of new works. While some performers suffer economically and emotionally from seeing

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2010/nov/04/cooks-source-copyright-complaint (detailing response to revelation of magazine publishing articles without permission).

399. See *id.* (discussing storm of activity on Twitter); see also *Cooks Source*, FACEBOOK, [www.facebook.com/CooksSourceMagazine](http://www.facebook.com/CooksSourceMagazine) (last modified Nov. 7, 2010) (showing deluge of comments on Facebook); Andrea James, *More Cooks Source Treachery Revealed!*, BOINGBOING (Nov. 4, 2010, 8:49 PM), [www.boingboing.net/2010/11/04/more-cooks-source-tr.html](http://www.boingboing.net/2010/11/04/more-cooks-source-tr.html) (listing other revelations about *Cooks Source*).

400. See Jeremy King, Comment to *Cooks Source*, FACEBOOK (Nov. 6, 2010, 10:18 AM), [www.facebook.com/CooksSourceMagazine](http://www.facebook.com/CooksSourceMagazine) (alleging extent of plagiarizing); see also *Cooks Source Article Tracking*, GOOGLE DOCS, <http://bit.ly/dDoxxP> (last visited Nov. 2, 2011) (listing allegedly infringing articles).

401. See Josh Jasper, *Copyright for Dummies*, PUBLISHERS WEEKLY (Nov. 4, 2010), [blogs.publishersweekly.com/blogs/genreville/?p=851](http://blogs.publishersweekly.com/blogs/genreville/?p=851) (discussing advertisers that pulled ads from magazine).

402. See Michelle Castillo, *Top 25 Tech Fails of the Year: 22. Cook’s Source Copyright Ignorance*, TIME: TECHLAND (Dec. 22, 2010), [techland.time.com/bps-machinery/22-cooks-source-copyright-ignorance/](http://techland.time.com/bps-machinery/22-cooks-source-copyright-ignorance/) (showing failure of *Cooks Source*).

their creative work used by others, the variety arts benefit from granting inspired individuals unfettered access to communal knowledge. Without additional legal protections, the community can still enforce its ethics and standards through social pressures, which, while imperfect, can be very effective. The benefits to the arts are well worth the risk.

