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## Copyright Law

### Infringement

#### Mariah Carey's "It's Like That" Does Not Infringe Chafir's "Sexy"

*Chafir v. Carey*, No. 06-CV-3016, 2007 BL 101557 (S.D.N.Y. Sept. 14, 2007)

Plaintiff Rachele Chafir brought an action in the U.S. District Court for the Southern District of New York against Mariah Carey and others involved with the song "It's Like That" (2005). The court granted defendants' motion for summary judgment after determining that Chafir failed to establish that "It's Like That" infringed upon Chafir's own song "Sexy" (2004).

#### *Defendants Deny Connection between Songs*

In 2003, singer-songwriter Chafir created and recorded "Sexy" in New York; she registered the song with the U.S. Copyright Office on September 1, 2004. In November 2004, defendants composed and recorded their song "It's Like That" in Georgia. The song was included as a track on Mariah Carey's album *The Emancipation of Mimi*, which was commercially released in April 2005. Chafir sued for copyright infringement under the Copyright Act, 17 U.S.C. §§ 101 et seq., claiming that defendants were aware of her song prior to November 2004. Defendants asserted that their song resulted purely from their collaborative effort.

#### *Standard for Unauthorized Copying of Work*

To succeed on a claim of copyright infringement, plaintiff must show: "(1) ownership of a valid copyright and (2) unauthorized copying of the copyrighted work." *Chafir* at 4 (citing *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 361 (1991); *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.*, 150 F.3d 132, 137 (2d Cir. 1998)). Defendants conceded that plaintiff satisfied the first element of this test.

To prove the second element, plaintiff must show that her "(1) work was 'actually copied' and, (2) the copyright amounts to an 'improper or unlawful appropriation.'" *Chafir* at 5 (citing *Jorgensen v. Epic/Sony Records*, 351 F.3d 46, 51 (2d Cir. 2003)). To prove actual copying, plaintiff can demonstrate that "(1) Defendants had 'access' to Plaintiff's Song, and (2) the two works have similarities that are 'probative of copyright.'" *Id.*

If a plaintiff can prove two works are “so strikingly similar as to preclude the possibility of independent creation, no showing of access is necessary to demonstrate actual copying.” *Id.* (citing *Repp v. Webber*, 132 F.3d 882, 889 (2d Cir 1997)).

#### *Defendants Did Not Have Access to Plaintiff’s Song*

Chafir argued that the court should infer access to her work because the song was made available to the public through the website the-movement.net and she had distributed CDs with the song to friends, acquaintances, patrons at dance clubs, and attendees of a music industry-related seminar. Further, defendants could not point to how, or by whom, the infringing portion of the song was created, a fact that Chafir claimed signaled infringement. Finally, Chafir relied upon forensic evidence from defendants’ computers that reported over a thousand hits for the word “sexy.”

After considering these assertions, the court concluded “Plaintiff’s proffered evidence fails to establish a reasonable possibility that Defendants had access to Plaintiff’s Song.” *Chafir* at 7. The court explained that simply because plaintiff’s song was publicly available on a website does not automatically mean defendants accessed the song. Despite plaintiff’s evidence of website traffic in general, she failed to provide any proof that defendants had ever actually visited the website. Similarly, the court dismissed plaintiff’s physical distribution of CDs as an inference of access because there was no evidence defendants actually received a copy of the copyrighted song.

Plaintiff’s contention that defendants’ “collective ‘memory loss’” regarding composition details of “It’s Like That” inferred they had “something to hide” was deemed wholly unpersuasive by the court. *Chafir* at 8. “There is absolutely no evidence on record, however, apart from Plaintiff’s speculation, supporting such an inference.” *Id.* Lastly, multiple hits for the word “sexy” on defendants’ computers did not prove access, since plaintiff failed to provide any evidence that those hits related to her song. In sum, “Plaintiff’s theory of access amounts to nothing more than speculation and conjecture.” *Id.* at 9.

#### *Songs Held Not Strikingly Similar*

Because plaintiff failed to show defendants had access to her work, to survive summary judgment she had to prove the two songs were “strikingly similar.” She “must demonstrate that the similarity between the two works is such ‘as to preclude the possibility of independent creation.’” *Chafir* at 10 (citing *Repp*, 132 F.3d at 889). As a result of the limited number of notes and chords in popular music, the strikingly similar test is applied with “particular stringency.” *Id.* at 9 (citing *Tisi v. Patrick*, 97 F. Supp. 2d 539, 548 (S.D.N.Y. 2000)). Both plaintiff and defendants relied upon expert opinions to bolster their arguments.

Plaintiff’s expert declared that defendants’ use of “identical (or nearly identical) notes and sequences of notes, together with their corresponding rhythms,” and the similarity of musical phrases, turnaround, and hook in the songs demonstrated it was “highly improbable that defendants independently created” their song, as these similarities were “beyond coincidence.” *Chafir* at 11.

However, because plaintiff’s expert did “not rule out the possibility of independent creation,” the court held he did not “provide the level of proof necessary to establish ‘striking similarity.’” *Id.* at 11. The court further deemed the musical elements relied upon by plaintiff’s expert to be “basic, non-protectible musical elements” found in numerous other compositions in popular music, as noted by defendants’ expert. *Id.* at 13. As such, the similarities could not serve as proof of striking similarity, and plaintiff’s arguments failed.

#### *Plaintiff Fails to Establish Copyright Infringement*

As a result of Chafir’s failure to offer sufficient evidence of access or evidence of striking similarity, the court granted defendants’ motion for summary judgment.

## Chukchansi Tribe Protected by Sovereign Immunity against Copyright and Trademark Infringement Allegation

*Breakthrough Management Group, Inc. v. Chukchansi Gold Casino and Resort*, No. 06-CV-01596, 2007 BL 98389 (D. Colo. Sept. 12, 2007)

The U.S. District Court for the District of Colorado ruled that the Chukchansi Indian Tribe was eligible for sovereign immunity from a variety of claims including copyright and trademark infringement that were brought by consulting company Breakthrough Management Group, Inc.

#### *Alleged Copying by the Tribe and the Casino*

The Chukchansi Gold Casino is located in California and is operated by the Chukchansi Indian Tribe. Breakthrough, which provides online training and consulting services alleged that the casino purchased a single license for one of its courses, which was to be used by the casino’s director. According to the complaint, the casino breached the license agreement by recording and transcribing the class and making it available to all of its 1,300 employees. In addition to allegedly duplicating the copyrighted contents of Breakthrough’s class, the casino substituted its trademark for Breakthrough’s mark on the CD it distributed.

Breakthrough sued the casino, the tribe, the Chukchansi Economic Development Authority, the casino director and

two other tribe employees, alleging that they were liable under a variety of copyright and trademark infringements, the federal Racketeer Influenced and Corrupt Organizations Act (RICO), and torts of conversion, misappropriation, misrepresentation, and fraud under Colorado law, in addition to multiple breaches of the original license agreements. The defendants moved to dismiss all of Breakthrough's claims.

#### *Court Finds No Waiver of Tribal Sovereign Immunity*

The court dismissed Breakthrough's claims against the tribe, finding it was entitled to sovereign immunity. The court noted that the party seeking to sue a sovereign entity bears the burden of showing that the defendant waived its immunity. Breakthrough contended that the defendants waived immunity by entering into a license agreement which provided that, "the sole and exclusive venue for any and all disputes involving, arising out of or related to this Agreement shall be the state and federal courts located within the state of Colorado, County of Boulder." *Breakthrough* at 6.

Although the U.S. Supreme Court has held that an agreement by an Indian tribe to submit disputes to arbitration constitutes a waiver of sovereign immunity, the instant court stated that there was "no clear answer" to the question of whether a sovereign entity can waive its sovereign immunity simply by entering into a contract containing such a selection clause. *Breakthrough* at 8 (citing *C&L Enterprises, Inc. v. Citizen Band Potawatomi Tribe*, 532 U.S. 411 (2001)). In determining if a sovereign has waived immunity in a contract, the court looks to whether the agreement not only specifies the forum in which disputes will be brought, but specifically permits claims to be brought against the sovereign. The court observed that when a sovereign has agreed to submit contract disputes to arbitration, as in *C&L Enterprises*, the agreement must specify where claims may be brought, and whether such claims may be brought.

In the instant case, however, "the parties' agreement speaks only to where a suit may be brought but it does not expressly or impliedly address whether a suit may be brought." *Breakthrough* at 10. In this respect, the court said, the case resembled *American Indian Agricultural Credit Consortium, Inc. v. Standing Rock Sioux Tribe*, 780 F.2d 1374 (8th Cir. 1985), where the U.S. Court of Appeals for the Eighth Circuit held that a clause in a promissory note providing that, "in the event of a collection action . . . the law of the District of Columbia would apply," was insufficient to waive an Indian tribe's sovereign immunity. *Breakthrough* at 9, 10. The court observed that Indian tribes possess "a special cloak of immunity from suit," and that Breakthrough had not altered or specially negotiated the terms of its standard commercial license agreement to account for the Tribe's unique status. *Id.* at 10. A consequence of the "take-it-or-leave-it" nature of the license, the court found,

was that its venue provision was insufficient by itself to demonstrate that the tribe waived its sovereign immunity. *Id.* at 11.

#### *Court Addresses Claims of Immunity by Tribe Affiliates*

Breakthrough did not dispute that the tribe was entitled to sovereign immunity if the court determined that the tribe had not waived immunity. However, Breakthrough argued the casino, the development authority, and the individual defendants could not share in that immunity because a judgment against those entities would not reach the tribe's assets. The court ordered that an evidentiary hearing be held on October 23, 2007, to determine whether the casino and the development authority were entitled to immunity.

The court did find, however, that the individual defendants were not protected by sovereign immunity. Whether tribal employees enjoy sovereign immunity, the court said, depends on whether a judgment against them would reach the assets of the tribe. If such employees are sued in their official capacities, they enjoy sovereign immunity unless they exceeded the scope of their delegated powers. As a result, tribal employees who are sued in their individual capacities do not enjoy sovereign immunity. The court concluded that Breakthrough sued the three employees in their individual capacities because it was "challenging the discrete acts of *these* individual Defendants," and was not asserting claims against them simply by virtue of their occupancy of offices within the Tribe or other entities. *Breakthrough* at 15 (emphasis in original).

#### *Court Dismisses Tort and RICO Claims*

The court held that Breakthrough's claims for conversion and misappropriation were preempted by the Copyright Act and noted that 17 U.S.C. § 301(a) provides that "all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright" are preempted by the Copyright Act. *Breakthrough* at 24. Preemption occurs if: (i) the work is within the scope of the "subject matter of copyright" and (ii) the rights granted under state law are equivalent to the exclusive rights established by copyright law. *Id.* However, if a state law cause of action requires an extra element that makes the claim qualitatively different from a copyright claim, it is not preempted. The court found that the conversion and misappropriation claims required no elements other than the existence of property owned by the plaintiff and a wrongful taking of the property by the defendants. Because there was no essential difference between these claims and a copyright infringement claim, the state law claims were preempted by the Copyright Act.

Having also dismissed Breakthrough's RICO claims, if the court rules that the casino and the development authority are entitled to sovereign immunity, the director will be the lone remaining defendant.