BY GREGORY J. SATER

Copyright Litigation Over TV Commercials and Infomercials

So your product is a mega-hit on TV, the money's rolling in, and you're sipping champagne in a stretch limo singing "Let the Good Times Roll" when all of a sudden, a friend calls you and says grimly, "I think you'd better turn on the TV." There, to your horror, you see that a major competitor has just come out with a very similar TV commercial for a very similar product. You feel your stomach do a Shawn White impression—a snowboard half-pipe double McTwist corkscrew—as the reality sinks in that, on this product, *you've got no patent*. Game over? No!

Too many times in our industry, I see people in these situations focus only on whether there's a patent and, if so, on how strong it is. However, marketers in situations like this *also* need to consider trademark, trade dress and copyright law. Those "soft" intellectual property law disciplines can provide remedies every bit as powerful as patent law and, indeed, when wielded properly in court, can be even *more* powerful.

If, in the course of bringing a copycat product to market, your competitor has come too close to the name of your product or to the look and feel of your product or to the creative content of your TV commercial—if your competitor really has flattered you with the "sincerest form of flattery," as the saying goes—you may be able to stop him in his tracks with an injunction and even recover millions of dollars in damages without anyone ever so much as uttering the word "patent."

This article will focus on copyright law. Others in the future will focus on trademark, trade dress and other areas of "soft IP" law.

BURDEN OF PROOF

To establish copyright infringement of a TV commercial, you must prove two elements: *ownership* and *copying*. To prove ownership, you must prove that the commercial was an original work that you created or that you otherwise now own by assignment or by a "work-made-for-hire," and you must prove compliance with certain statutory formalities (such as having filed for copyright registration prior to filing suit). To prove copying, you must prove (either directly or, more likely, indirectly with circumstantial evidence) that the other side had *access* to your commercial before producing theirs. You also must prove that there is a *substantial similarity of protectable expression* between your commercial and theirs. More on that later…

What do you win, if you win? For one thing, you win the damages that you suffered as a result of the infringement; that can include your lost profits. You only need to show a "reasonable probability" that your claimed damages were caused by the defendant's copyright infringement; the burden then shifts to the other side to prove that some or all of your damages would have occurred anyway. Also, if, in the eyes of the jury, the award you'll get for your damages will not make you whole for the infringement, then the jury also can award you all of the profits of the infringer. In addition, you can recover your attorneys' fees.

Those are some pretty potent remedies! But what does it take to prove "substantial similarity of protectable expression?" What content from your TV commercial is considered "protectable," and what isn't?

Aren't all DR commercials similar to some extent? The answer is yes, but also no. Yes, obviously, DR commercials often have simi-

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larities. For instance, they're two minutes long, they present a problem, they present a solution, they show some demos, and they end with a call to action. But they also have a lot of creative differences. As industry insiders know, two companies can bring to market basically the identical product and, whereas one has its commercial bomb, the other can have its commercial become an instant runaway success with a high MER. There's something about every hit that has made it a hit with the public: something in the choices the producer made, when he or she put it together, scene for scene, shot for shot, word for word, demo for demo. It's not just the product that makes the telephone ring, it's the *commercial* you made for that product, it's the name you picked for it, and sometimes other factors beyond the product itself. This is the crux of copyright law: the creative choices you make in your TV spot belong to you. The ideas don't belong to you, but the way you *express* them does.

Before you run out and sue every competitor, however, for every last similarity you see in their competing spots, understand that, as with everything in life, there are limits. It's going to be hard to win a copyright case against a competitor if the only similarity between your commercials is that you both have a doctor in a white lab coat extolling the merits of your products, or you both have a pretty model raving about how clean and acne-free her skin is. If copyright law protected such things, nobody could ever again make a Western with cowboys, sheriffs, guns, horses, posses, disputes over land rights, and a duel at high noon in front of the saloon. That's why the law doesn't protect "scènes à faire": things that are inevitable, themes, incidents and character types that really are a "must" in the particular genre. Everyone is free to use such things.

A second major limitation is that, as noted above, copyright law does not protect an idea, but only the expression of that idea. Of course, often it can be difficult to tell where an idea ends and where its expression begins. To assist with discerning where the line is, courts have developed the "merger" doctrine, under which, if an idea and its expression cannot be separated, then there's no copyright protection.

Take, for example, a map that shows the route of a natural gas pipeline. You can't show the route and be accurate about it without basically making the same map.

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DO YOU HAVE A CASE?

Despite these two limitations under the law, it would be the rare TV commercial that would *not* be protectable under copyright. For one thing, while something common such as an expert testimonial from a doctor in a white lab coat may not be protectable, the particular *way* it has been portrayed may be. Moreover, you must consider it in *context*, with the *rest* of the spot. This is because—and this point is very important—in a copyright case you must consider the two works as a whole, and the copyright claimant can receive protection for the *way* in which he or she has *ordered or arranged* elements, including elements that, by themselves, would never be protectable. The *sequence* of events that you put together in your commercial—the order of scenes, themes or images—even if each by itself is just a "scène à faire"—can result in an overall creative work that is fully protected.

As the protagonist says in the recent movie "A Flash of Genius," Charles Dickens did not invent the word "it" nor the word "was" nor the word "best" nor the word "of," but that doesn't mean someone else has the right to copy "A Tale of Two Cities," which begins with the line, "It was the best of times, it was the worst of times."

As the Supreme Court has said, if the selection or arrangement of nonprotectable elements was the product "of at least some minimal degree of creativity," then the Copyright Act provides protection. Such selection "implies the exercise of judgment in choosing which facts from a given body of data to include."

Some amount of skill, labor, judgment, expertise or "creative spark" needs to be shown for copyright protection. But, as most judges have found, the bar isn't very high. (In one case, for example, a court awarded copyright protection to the publishers of a wholesale coin price guide—something that basically merely consisted of public domain *facts*, i.e., the prices of coins being sold on the market—because the court was impressed that the publishers had used judgment and expertise in distilling and extrapolating the data they would put into their book.)

For these reasons, *never underestimate* your potential for having a potent copyright infringement claim if a competitor comes along and not only copies your product, whether patented or otherwise, but also copies elements of your commercial. You might have a case! eR

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