

# TC'S IP CORNER®



OCTOBER 2024 EDITION



# TC'S IP CORNER®

Welcome to TC's IP Corner®. We are excited to share this quarterly email with our clients, colleagues, and friends as we examine hot topics, interesting cases, and weird yet entertaining happenings in the world of intellectual property.

If you have ideas for future editions, please reach out to one of the editors listed below.

# TRICK-OR-TREAT-OR-TRADE DRESS: HALLOWEEN'S TASTIEST REGISTERED DESIGNS

It is Halloween night, trick-or-treating is over, and the family reunites in the living room to pour out their bags and inspect their winnings. The table and floor are covered in everyone's favorite candies, chocolates, and lollipops. Everyone quickly eyes the stash noticing their favorites with just a glance. You can feel the excitement and impending sugar rush in the air.

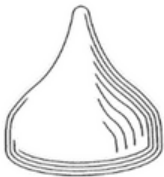
You might not realize in the moment, but as you were salivating over the large piles of candy you were also identifying your top treats based on their trademarks - you may have quickly recognized the candy based on the product name displayed on the wrapper or you may have recognized the candy based off of its shape or even the specific wrapper or packaging. Most are aware that the names of candies and their associated slogans and logos are eligible for federal trademark protection in the United States. But trademark protection doesn't end there. Contemporary trademark law also offers protection to trade dress, which may consist of a product's packaging or product's design (also known as "product configuration").

"Trade dress" is a legal term used to describe the overall visual appearance of a product or its packaging which is used to identify the product's source. Trade dress may include features such as size, shape, color or color combinations, texture, graphics, and other characteristics. A good example is the iconic Coca-Cola bottle design:

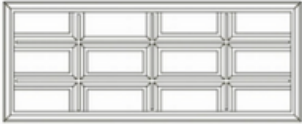






Originally, trade dress referred to the packaging or ‘dressing’ of a product, but it has been expanded to include the design of the product as well. As the development of trade dress to include product design led to a growing number of infringement claims, a number of courts began to express concern as to whether a product’s design could really function as a “trademark” in the minds of consumers. Leaving the Coca-Cola bottle aside, these courts were not convinced that consumers would readily infer a product’s design could serve as a source identifier. For this reason the courts decided that to obtain trade dress protection for a product’s design, a claimant would have to establish the design had “acquired distinctiveness.” Acquired distinctiveness implies that over time consumers may come to identify what might have seemed to be a mere characteristic of the product as a designation of the source of that product.[1]




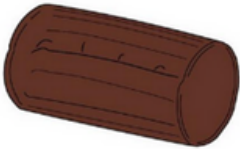
Candy and confectionary companies have taken advantage of this expansion in trademark law and have registered some of our favorite candies’ shapes and packaging to ensure that no other competitor can produce a product of similar shape or in similar packaging. Registering their trade dress protects the unique visual appearance of their product or packaging, prevents copying, and ultimately helps build brand identity and goodwill. Take a look at some of the trade dress registrations for Halloween’s biggest candies:



Trade Dress (Product Configuration)	Key Dates	Description of Mark	International Class and Goods/Services	Owner
 <p>SN: 75221499 RN: 2187189</p>	<p>Reg. Date: September 8, 1998</p> <p>First Use: 1978</p>	<p>The trademark consists of the configuration of a molded, conically shaped candy piece.</p>	<p>Int’l Class 30 - Candy</p>	<p>Hershey Chocolate &amp; Confectionery LLC</p>

[1] Unlike product design, product packaging is capable of being inherently distinctive, meaning the packaging automatically tells a customer that it is referring to a specific brand or source.

Trade Dress (Product Configuration)	Key Dates	Description of Mark	International Class and Goods/Services	Owner
 <p>SN: 77809223 RN: 4322502</p>	<p>Reg. Date: April 23, 2013</p> <p>First Use: 1968</p>	<p>The mark is a configuration of a candy bar that consists of twelve (12) equally-sized recessed rectangular panels arranged in a four panel by three panel format with each panel having its own raised border within a large rectangle.</p>	<p>Int'l Class 30 - Candy; chocolate</p>	<p>Hershey Chocolate &amp; Confectionery LLC</p>
 <p>SN: 75206688 RN: 2437326</p>	<p>Reg. Date: March 1, 2001</p> <p>First Use: 1994</p>		<p>Int'l Class 30 - Candy</p>	<p>Hershey Chocolate &amp; Confectionery LLC</p>
 <p>SN: 72290811 RN: 911237</p>	<p>Reg. Date: April 13, 1971</p> <p>First Use: 1951</p>		<p>Int'l Class 30 - Chocolate candy</p>	<p>Kraft Foods Schweiz Holding Gmbh</p>

Trade Dress (Product Configuration)	Key Dates	Description of Mark	International Class and Goods/Services	Owner
 <p>SN: 77334494 RN: 3755228</p>	<p>Reg. Date: March 2, 2010</p> <p>First Use: 2008</p>	<p>The mark consists of the configuration of a piece of chocolate candy in the shape of a rounded square having a set of parallel straight sides and a set of parallel convex sides that are arced and a raised section at the top of the candy piece with the lettering "DOVE" on it.</p>	<p>Int'l Class 30 - Confectionery, namely, candy</p>	<p>Mars, Incorporated</p>
 <p>SN: 85441471 RN: 5047574</p>	<p>Reg. Date: March 1, 2001</p> <p>First Use: 1994</p>	<p>The mark consists of a cross-section of a candy bar showing layers within the candy, namely, a middle light brown layer containing several tan-colored peanut shapes and a bottom tan layer, all surrounded by a brown layer. The mark depicts a distinctive two-dimensional cross-sectional view of a candy bar.</p>	<p>Int'l Class 30 - Candy</p>	<p>Hershey Chocolate &amp; Confectionery LLC</p>

Trade Dress (Product Configuration)	Key Dates	Description of Mark	International Class and Goods/Services	Owner
 <p>SN: 78730999 RN: 3282529</p>	<p>Reg. Date: August 21, 2007</p> <p>First Use: 2004</p>	<p>The mark consists of round, individually colored red, blue, orange, green, brown, yellow and white candy pieces with a white stylized letter "m" on each piece.</p>	<p>Int'l Class 30 - Confectionery, namely, candy</p>	<p>Mars, Incorporated</p>
 <p>SN: 76010416 RN: 2535714</p>	<p>Reg. Date: February 2, 2002</p> <p>First Use: 1982</p>		<p>Int'l Class 30 - Confectionery, namely, candy</p>	<p>Mars, Incorporated</p>
 <p>SN: 74332122 RN: 1846873</p>	<p>Reg. Date: July 26, 1994</p> <p>First Use: 1975</p>	<p>The mark consists of a candy portion in the configuration of a jewel mounted on a stylized ring.</p>	<p>Int'l Class 30 - Candy</p>	<p>The Bazooka Companies, LLC</p>
 <p>SN: 87220851 RN: 5552922</p>	<p>Reg. Date: September 4, 2018</p> <p>First Use: 1950</p>	<p>The mark consists of a three-dimensional configuration of a cylindrical-shaped brown candy with a length two times its diameter.</p>	<p>Int'l Class 30 - Candy</p>	<p>Tootsie Roll Industries, LLC</p>

Trade Dress (Product Packaging)	Key Dates	Description of Mark	International Class and Goods/Services	Owner
 <p>SN: 76492000 RN: 2873540</p>	<p>Reg. Date: Aug 17, 2004</p> <p>First Use: 1982</p>	<p>The mark consists of a gold-wrapped candy ball with a brown and gold striped wrapper at the base of the ball. There is a white oval in the middle of the ball. The oval is outlined by a gold, white and red stripe. The color gold is claimed as a feature of the mark.</p>	<p>Int'l Class 30 – Candy</p>	<p>Ferrero S.p.A.</p>
 <p>SN: 85455568 RN: 4161166</p>	<p>Reg. Date: October 17, 1995</p> <p>First Use: 1991</p>	<p>The mark consists of a configuration of a conical-shaped chocolate candy wrapped with a striped, twisted foil surmounted by a white plume within which are the words "HUGS".</p>	<p>Int'l Class 30 – Candy</p>	<p>Hershey Chocolate &amp; Confectionery LLC</p>



Trade Dress (Product Packaging)	Key Dates	Description of Mark	International Class and Goods/Services	Owner
 <p>SN: 85174045 RN: 4082217</p>	<p>Reg. Date: January 10, 2012</p> <p>First Use:</p>	<p>The mark consists of the wording "MILK CHOCOLATE" in brown appearing above the wording "REESE'S" in yellow outlined in the color brown, below the wording "REESE'S" is the wording "FILLED WITH REESE'S PEANUT BUTTER" in white on a blue banner, the image of a partially bitten chocolate piece with the imprinted wording "REESE'S" in brown and the filling of the candy in light brown, and the entire mark appears on an orange background. The matter shown in dotted lines shows positioning of the mark and is not part of the mark.</p>	<p>Int'l Class 30 - Candy</p>	<p>Hershey Chocolate &amp; Confectionery LLC</p>
 <p>SN: 85455568 RN: 4161166</p>	<p>Reg. Date: June 19, 2012</p> <p>First Use:</p>	<p>The mark consists of the word "HERSHEY'S" in silver block letters on a dark maroonish-brown background followed by the words "SYMPHONY CREAMY MILK CHOCOLATE ALMONDS &amp; TOFFEE CHIPS" in medium blue stylized letters on a light tan background; the background is striped with dark tan lines; the outer dotted lines show placement of the mark and are not part of the mark.</p>	<p>Int'l Class 30 – Candy; Chocolate</p>	<p>Hershey Chocolate &amp; Confectionery LLC</p>

TC's IP group has experience filing and maintaining trade dress applications and registrations. If you or a client are interested in learning more about trade dress or have a product design or packaging you would like to register please reach out to a member of our IP group.

# VIRTUAL YOUTUBERS – AN INTERESTING INTERSECTION OF IP RIGHTS

A V-Tuber is a “virtual YouTuber.” Like typical YouTubers, they entertain audiences in a variety of ways, such as by directly interacting with their audience via a chat function, streaming gameplay, or by creating online performances that include song and dance. Similarly, they may be independent or associated with an entertainment company. Unlike typical YouTubers, however, V-Tubers use a computer-generated avatar rather than record their physical selves. Depending on the level of sophistication (and investment) by the V-Tuber, the avatar may be two or three dimensional, may be voiced by an individual or via technology such as text-to-speech, and may or may not be “rigged” to move in accordance with the physical movements of an individual equipped with motion tracking technology. In the most sophisticated cases, the effect is a fully articulable, voiced “avatar” that may have its own persona and backstory. Such an arrangement presents a variety of intellectual property considerations and opportunities.

## Trademark

A trademark is “a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons.”[1] “The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.”[2]

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[1] *Vidal v. Elster*, No. 22-704, 2024 WL 2964139, at \*3 (U.S. June 13, 2024) (quoting *Trade-Mark Cases*, 100 U.S. 82, 92, 25 L.Ed. 550 (1879)) (internal quotation marks omitted); see also 15 U.S.C. § 1127.

[2] *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 142 (2015).

Both independent V-Tubers and those associated with companies build their own brand around their avatar, and V-Tubers affiliated with companies may also build brands around particular groupings of V-Tubers who frequently interact with each other. Trademarks are a cornerstone of brand building, and this is reflected by the number of trademarks registered in this space. For example, COVER Corporation – a Japanese corporation that develops and manages virtual reality and augmented reality software application products, as well as operates one of the largest virtual YouTubing businesses under the brand Hololive – owns over 200 live trademarks/applications in the United States alone, many of which are directed to the names of individual V-Tubers and V-Tuber groups.

Given the significant brand building opportunities, V-Tubers provide an opportunity for trademark prosecution (both domestic and international), portfolio maintenance, and trademark policing and enforcement.

## Copyright

Copyright exists at common law and from the moment the work of authorship becomes fixed in a tangible medium.[3] The Copyright Act, Title 17 of the United States Code, provides additional context, permitting copyright protection for original works of authorship fixed in any tangible medium of expression. [4] Works of authorship include (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.[5]

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[3] *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.* 499 U.S. 340 (1991).

[4] 17 U.S.C. § 102.

[5] *Id.*

Section 106 of the Copyright Act provides copyright owners the exclusive rights to do and to authorize any of the following:

1. to reproduce the copyrighted work in copies;
2. to prepare derivative works based upon the copyrighted work;
3. to distribute copies of the copyrighted work to the public;
4. to perform the copyrighted work publicly; and
5. to display the copyrighted work publicly.[6]

V-Tubers involve a vast array of copyrightable subject matter. First, the artwork for the virtual avatar itself is registrable. Thus, any companies entering this space will want to be sure that any agreements for the creation of such avatars make clear who owns the copyright for the avatar. In most cases, a written work-for-hire agreement or written copyright assignment may be beneficial to companies to ensure they retain the ownership rights. Additionally, any subsequent uses of the avatar by the V-Tuber would be independently registrable as derivative works, which leads to employment law considerations noted below.

Further, the V-Tubers performances may also involve copyrighted material and the appropriate rights need to be secured. For example, if the V-Tuber were to perform a choreographed song and dance, it may be necessary to secure the rights to the underlying choreography and music (which can involve multiple rights-holders depending on the extent of the use). The online nature of the performances also means that an understanding of the Digital Millennium Copyright Act (DMCA) is essential in order to (1) prevent a V-Tuber's videos from being removed or (2) remove unauthorized reproductions of performances that have been posted online. In short, V-Tubers present significant opportunities for registering new copyrighted works as well as ensuring proper clearance and licensing occurs for the performances.

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[6] 17 U.S.C. § 106.

## Other Legal Opportunities

Another interesting issue raised by the V-Tuber industry relates to name, image, and likeness, which has previously been found to include some virtual likenesses.[7] In the event the avatar is made in the likeness of the performer, there could be additional means of protecting the avatar.

Finally, as noted above, the industry presents opportunities for collaboration between labor and IP law practitioners. Employment contracts with hired talent will need to clearly establish ownership of the various intellectual property rights and maintain the right of the IP owner to police the use of the IP and to prevent tarnishment of any registered trademarks.

If your clients are employing V-Tubers or employing or working with other creators, please reach out to a member of TC's IP group and we can help.

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[7] See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013) (reversing grant of summary judgement, and finding that right of publicity claim based on use of football player's identity in video game could proceed); see also *No Doubt v. Activision Publ'g, Inc.*, 192 Cal. App. 4th 1018, 1022, 122 Cal. Rptr. 3d 397, 401 (2011) (affirming denial of motion to strike and finding that use of the band No Doubt's name, image, and likeness beyond scope of license supported right of publicity claim).

# AI AND ELVIS?

While Elvis Presley's life and career occurred long before artificial intelligence became mainstream, Elvis' name is intersecting with AI today based on legislation titled the Ensuring Likeness, Voice, and Image Security ("ELVIS") Act. The ELVIS Act was passed on March 21, 2024 by the Tennessee legislature with the intent to protect artists and actors from the use of AI to mimic their voices. The ELVIS Act protects artists' voices with a broad definition of voice. The definition includes "a sound in a medium that is readily identifiable and attributable to a particular individual, regardless of whether the sound contains the actual voice or a simulation of the voice of the individual." Tenn. Code Ann. § 47-25-1102.

While simulation is not defined, this definition appears to encompass AI imitations of actors. Further evidence that this act targets AI imitations is that it makes a person liable if the person "distributes, transmits, or otherwise makes available an algorithm, software, tool, or other technology, service, or device, the primary purpose or function of which is the production of an individual's photograph, voice, or likeness without authorization from the individual." Tenn. Code Ann. § 47-25-1105(a)(3). The lack of definition of simulation could spell trouble for voice actors that imitate other voices and cover/tribute bands. These attempts to mimic famous actors and musicians are arguably "simulations of the voice of the individual." This also raises the issue of whether someone whose natural voice sounds similar to another person is "simulating" the other person.

The issue of the use of a naturally similar voice made the news when users of OpenAI's ChatGPT noted that one of the voices used by ChatGPT (a voice titled "Sky") sounded similar to Scarlett Johansson.

OpenAI quickly removed the voice and released a statement explaining that “[w]e believe that AI voices should not deliberately mimic a celebrity's distinctive voice—Sky’s voice is not an imitation of Scarlett Johansson but belongs to a different professional actress using her own natural speaking voice.” *How the voices for ChatGPT were chosen*, OpenAI (May 19, 2024). OpenAI further explained the lengthy process, and timeline, they went through in selecting the voices and that they had no intention to resemble her voice.

The issue of mimicking voices is also the basis of a class action filed in the Southern District of New York on May 16, 2024. *Lehrman v. Lovo, Inc.*, No. 24-cv-03770 (S.D.N.Y. May 16, 2024). In *Lehrman*, two voice actors are suing an AI startup, Lovo, accusing them of illegally copying their voices. According to the complaint, Lovo’s CEO and co-founder claims that Lovo can take a real human voice, clone it (including accents), and make it available to customers to turn any text that the customer has into the cloned voice even if the voice actor has never actually said those words before. One of the plaintiffs, Lehrman, alleges that an anonymous person reached out through a freelancer marketplace asking Lehrman to provide a voice over for “academic research purposes only.” Lehrman later learned that the anonymous person was an employee of Lovo and that Lovo had mimicked his voice and was offering the AI voice to customers.

If your clients are using AI in creating work product or are worried about their likeness being imitated, please consult with a member of TC’s IP group for assistance in helping your clients protect their creations and likeness.

# WHAT'S IN A NAME? THE SUPREME COURT HOLDS THE TRADEMARK "NAMES CLAUSE" CONSTITUTIONAL

That which we call a rose may smell just as sweet under another name. But does that which we call a mark function as a source identifier under the name of a particular living individual without his consent? The Supreme Court decided that very question in the case *Vidal v. Elster*. The question was whether the so-called "names clause" of the Lanham Act (the federal statute governing trademark law), which prevents the registration of a trademark that "[c]onsists of or comprises a name. . . identifying a particular living except by his written consent," is an unconstitutional restriction on free speech in violation of the First Amendment. The Court held that it is not.

The purpose of trademark law is to protect distinctive marks (e.g., words, names, symbols) to help distinguish a particular worker's goods from those of others. Trademarks provide a valuable resource to manufacturers by ensuring that consumers know the source of a product and can evaluate it based on the manufacturer's reputation. Trademarks also provide a benefit to consumers, who therefore know the source of the goods they purchase.

In this case, Elster sought to register a trademark containing the name of another person, without that person's consent. The Trademark Office refused to register the mark based on the names clause. Elster appealed, arguing that the names clause violated his First Amendment right to free speech.

On appeal, the Supreme Court determined that the names clause discriminates based on the content of the speech (i.e. whether or not it includes the name of an individual), but that the names clause does not discriminate on the viewpoint of the speech, because the names clause applies regardless of whether the trademark's message is disparaging, neutral or complimentary.



Regardless of the message, an applicant cannot receive a trademark registration that identifies someone else.

Typically, a content-based, but viewpoint-neutral speech restriction requires a heightened scrutiny because content-based speech restrictions are presumptively unconstitutional. But the Supreme Court did not apply heightened scrutiny here. Concluding that trademarks are “uniquely content-based” by their very nature and purpose of source-identification, the Court crafted a decision it described as “narrow.”

The Court held that the names clause does not violate the First Amendment because of the historical tradition of the names clause and trademark law as a content-based speech restriction. By crafting the decision so narrowly, the Court cautioned that it did not set forth any new framework for First Amendment analysis.

In sum, applicants who seek to register a trademark identifying someone else may still have their applications rejected based on the names clause. But nothing will come of nothing, and trademark registration remains a valuable resource for brand owners seeking to protect their reputation.

If you have a question about trademarks or trademark registration, please reach out to a member of TC’s IP team.

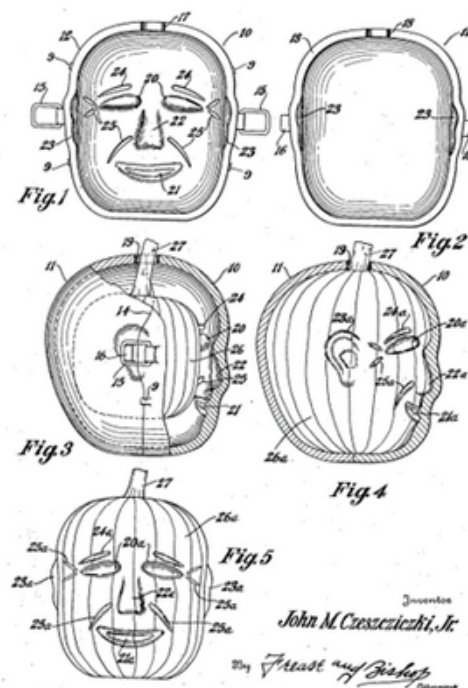
**YES... THIS REALLY HAPPENED**

# MOLDING A PUMPKIN

It is the end of October, the weather is cooling down, the leaves are changing colors, and Halloween is just around the corner. This is your last chance to decorate the house with pumpkins, skeletons, ghosts, spider webs, and witches' brooms to invite (or scare away) this year's eager trick-or-treaters.

One of America's favorite ways to welcome fall and decorate for Halloween is to carve a jack-o'-lantern. However, as many of us know, carving a jack-o'-lantern can be hard and messy – you have to pick the perfect pumpkin, cut through the hard shell, scoop out all of the insides, and then hope the design you picked to carve turns out right.

One inventor successfully received a U.S. Patent for his alternative to carving a jack-o'-lantern. The patent, entitled "Forming Configurations on Natural Growths," registered as U.S. Patent No. 2,096,507 (1937):



Acknowledging the considerable skill a carver must have to simulate facial features and the difficulty in picking the perfect pumpkin, the inventor of the '507 patent invented a method for morphing and forming a growing pumpkin (or other bulb-shaped growth) into the shape of a face and/or human head by using a mold.

The novel and nonobvious method instructs users to:

1. Enclose an immature pumpkin in a mold shaped like a human face and/or head;
2. Allow the pumpkin to grow into and form to the mold;
3. Remove the mold; and then
4. Allow the pumpkin to continue growing before detaching it from its plant

Thankfully for those who have the means to grow a pumpkin, a disdain for carving, and a desire to have a scary pumpkin on their porch, the '507 patent has long expired and is available for all to use during the spooky season.

Happy scaring!



# TC'S IP CORNER®

Contributors to this edition of IP Corner include Brendan Bement, Steven Heinrich, Alex Weidner, and Sylvia Turner. Editors are Justin Mulligan, Sartouk Moussavi, Shoko Naruo, Michael Parks, and Tom Polcyn.

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