CyberLaw

Jonathan Rosenoer

At the January 1994 meeting of OneNet Live in San Jose, California, Jonathan Rosenoer made a presentation about law and publishing in the electronic world. Although he spoke particularly about BBSes and telecommunications, he outlined several of the current issues being raised regarding Free Speech, copyright, and legal developments in the field of "Cyberlaw." Here is a condensation of Rosenoer's thorough and comprehensive article that appears in CyberLaw ™. Rosenoer may be reached through his addresses which appear at the end of this article. Ed.

The chief purpose of the First Amendment guarantee of freedom of speech and of the press is to facilitate the flow of information. The Copyright Clause is also a part of the Constitution and was intended, in major part, to promote free speech by providing access to copyrighted materials.

In 1989, Berkeley Systems, Inc. introduced a computer program designed to prevent images from burning into the screen of computer monitors. This "screen saver" utility program—named "After Dark"—became very popular, due in large part to its graphics displays. "After Dark" includes a number of graphics modules, including one that depicts 1950's, rounded, two-bread slice toasters with angel wings flying from right to left across the computer monitor screen accompanied by slices of toast. According to Berkeley's attorneys, Berkeley holds valid copyright and trademark registrations in the Flying Toaster.

Delrina Corporation publishes a new computer screen saver program called "Opus 'n Bill." Their program features comic-strip characters Opus (a penguin) and Bill the Cat, created by Berkeley Breathed. As described by Delrina's counsel,

"[I]rreverant satire, caricature, and parody are at the heart of Breathed's unique and well-known brand of humor, and they are present throughout the various screen sequences or 'modules' in __Opus 'n Bill__."

In an Opus 'n Bill module named "Death Toasters," the character Opus fires a shotgun at flying toasters. The toasters fly in formation and launch an attack of their own against Opus, by firing toast or diving from above to knock him down. According to Delrina, the parody is clearly aimed at Berkeley, "the established and self-proclaimed leader in the screen saver software field."

Since there [was] no intent to confuse the public, claim[ed] Delrina, there [was] no actionable trademark infringement. Delrina also urged that the "very strength of [Berkeley's] mark weighs against a likelihood of confusion… "In addition, since Delrina's Opus 'n Bill screen saver is an obvious parody, it is a form of expression protected under the First Amendment."

Following a hearing, the United States District Court for the Northern District of California found Berkeley had shown a reasonable likelihood of success on its copyright infringement claim and enjoined Delrina from using the flying toasters in its Opus 'n Bill screen saver. The Court did not reach the trademark issue due to its finding of probable success on the copyright claim.

The Court held Berkeley had established ownership of a valid copyright, despite Delrina's showing that the flying toaster icon had been used previously on a record album jacket. As stated by the Court, the copyright statute only requires that a copyrighted work be an independent creation, not that it be novel.

Berkeley had also shown copying by Delrina, albeit indirectly. Berkeley's. To the extent there exist differences in expression between Delrina's toasters and Berkeley's, the Court noted that the test for substantial similarity of expression is based upon a side-by-side comparison of the two works — not an element-by-element dissection. Here, an ordinary reasonable person would find that Delrina captured the total concept and feel of Berkeley's toasters despite the distinctions, and that is all that is required.

The Court also did not accept the claim there is only a limited number of ways to depict a flying toaster and, therefore, Berkeley's toasters should be protected only against exact copying.

Although differentiating Delrina's toasters could result in a less effective parody, the Court noted that "at times the copyright law may require that parodists sacrifice the best parody to the interest of the copyright owner in his or her original expression."

Finding Berkeley has "demonstrated probable success on the merits by making out a prima facie case of copyright infringement...," the Court went on to consider Delrina's defense of parody, which, observed the Court, "is not a presumptively fair use." According to the Court, "parody as a defense to copyright infringement is considered within the framework of the fair use defense" and is based on consideration of four factors:

"(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
(2) the nature of the copyrighted work;
(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
(4) the effect of the use upon the potential market for or value of the copyrighted work.

On the first factor, the Court held Delrina's commercial use "raises a presumption of unfair exploitation of the copyrighted material." This presumption may be rebutted, however, by "__convincing__ the court that the parody does not __unfairly__ diminish the economic value of the original."

On this latter point, the Court found that Delrina had not shown that any commercial substitution would be because consumers thought the parody of the winged toasters was more humorous. There was, in fact, no evidence either way. The Court held that Delrina had not, therefore, rebutted the presumption of unfair use created by Delrina's commercial use of the toasters.

On Delrina's claim it had "taken no more than necessary to conjure up the image of [Berkeley's] screen saver in order to parody it," the Court acknowledged that three factors have been considered in determining whether a parody has "taken

excessively from the original in the circumstances—the degree of public recognition of the original work, the ease of conjuring up the original in the chosen medium, and the focus of the parody."

In light of the above, the Court entered a preliminary injunction prohibiting Delrina from using the flying toasters in its Death Toasters module, in its packaging, or in connection with the advertising, distribution or sale of the Opus 'n Bill screen saver.

The case of the Death Toasters highlights the fact that the subject matter of both the First Amendment and the Copyright Clause is the same, i.e., information. The fact the information is communicated by parody does not disqualify it from free speech protection. To the contrary, parody is one of the forces that led to the establishment of the free speech protections we enjoy today. The Court's decision here illustrates that copyright law is being driven with great regard to private, commercial interests. The reason why free speech rights receive short shrift in cases such as this is aptly analyzed in __The Nature of Copyright__,

"Logically, political rights, [such as free speech rights], must be regarded as more important than [an individual's rights to control the products of his or her effort for profit], since the latter ultimately have to be both recognized and enforced by the government that is sustained by political rights. Proprietary rights tend to be concrete, however, whereas political rights are typically abstract, and in a one-to-one combat of ideas the concrete usually has the advantage over the abstract. In copyright litigation, for example, an accusation that a defendant has stolen the plaintiff's property is much more powerful than the claim that a defendant is exercising a free-speech right. The larger truth as to the importance of political rights is often lost in the legal melee." Rosenoer said, "In this case, it is deeply troubling not only that free speech values received such little attention but that the Death Toasters were effectively banned without a jury's consideration. If the First Amendment's guarantee of free speech and intent to prohibit the government from acting as censor is to have substantive content in copyright cases, at the very least there should be more deference to allowing juries to determine factual questions and less reliance on presumptions that prejudice the outcome in favor of private, commercial interests."

(A copy of the opinion and other information concerning the __Berkeley Systems__ action were kindly made available to the author by Mark A. Steiner, Esq., of Townsend and Townsend Khourie and Crew, attorneys for Berkeley Systems, Inc.)

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