ELECTRONIC FRONTIER FOUNDATION
Protecting Rights and Promoting Freedom on the Electronic Frontier

April 30, 2013

VIA EMAIL: stephanie@furgang.com

Stephanie Furgang Adwar, Esq.
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1325 Avenue of the Americas, 28th Floor
New York, NY 10019

Re: Internet Archive/ "You Asked For It"

Dear Ms. Furgang Adwar,

The Electronic Frontier Foundation represents the Internet Archive, a nonprofit digital library dedicated to improving public access to knowledge and culture. I write in response to April 23 letter threatening that your client, Sandy Frank Film Syndication ("SFFS"), will take legal action against the Archive in connection with a variety of materials that use the phrase "You Asked For It" and/or contain images from a 1950s television show that you admit is in the public domain.

Your letter misstates both the law and the relevant facts. Indeed, it appears to be a brazen attempt to misuse trademark law to invade the public domain.

Let us be clear about the nature of the works at issue. They include: a series of sermons that are entirely unrelated to the 1950s television program but the series title happens to be "you asked for it;" items that apparently contain programming from the 1950s show "You Asked For It;" remix videos that pair clips from the 1950s show with original musical compositions; and metadata for a music album, entitled "You Asked For It," stored as a back-up to information made available by the music catalog musicbrainz.org.

Your client has no colorable trademark claim regarding these materials. First, the Archive's storage and streaming of the public domain television show, and materials that refer to or include images from the show, is entirely noncommercial and, therefore, statutorily exempt from the Lanham Act. *See* 15 U.S.C. §§ 1127, 1125; *Bosley Med. Inst. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005); *Taubman v. WebFeats*, 319 F.3d 770, 774 (6th Cir. 2003); *CPC Int'l v. Skippy*, 214 F.3d 456, 461 (4th Cir. 2000).

Second, none of the uses in question infringes any trademark.

- Television programming: Trademark law does not forbid the use of "You Asked for It" to accurately identify the shows available via the Archive. Indeed, it is unclear how else the Archive might describe the shows. None of the cases you cite is to the contrary. For example, *Hewlett Packard Co. v. Packard Press,* 281 F.3d 1261 (Fed. Cir. 2002) concerned Hewlett Packard's successful attempt to block a commercial printer's registration of "Packard Technologies" in connection with, among other things, data

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processing and data transmission services. *Jean Patou v. Theon,* 9. F.3d 971 (Fed. Cir. 1993) concerned the likelihood of confusion between the terms "Joy," registered by a perfume manufacturer, and "Dermajoy" used by manufacturer of medicated gel that was classified as cosmetic preparation. In other words, both cases stand for the uncontroversial proposition that a party should not be permitted to a register a mark where there is a likelihood of confusion as to the source. There is no such possibility here. No one would imagine that your client, the holder of a trademark in connection with licensing television shows, is the source of the programs in question, not least because no such licensing is even required for these programs.

- Remix videos: The videos in question do not raise a trademark issue – they don't even use the term "You Asked For It." Even if they did use the term, the videos are fully sheltered by the First Amendment, *see L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987); *Cliff Notes v. Bantam Doubleday Dell Publ'g Group*, 886 F.2d 490, 495 (2d Cir. 1989); *CPC Int'l, Inc. v. Skippy Inc.*, 214 F.3d 456 (4th Cir. 2000); *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 906 (9th Cir. 2002). And, to the extent they are noncommercial, they are statutorily exempt from the Lanham Act.

- Sermons and Metadata: These items use the term in its colloquial sense, not to refer to the television show. You state that your client is not seeking take down of "colloquial uses" of the terms "at this time." That is wise.

Your claim that using a search term on the Internet is actionable under trademark law is inexplicable. That is not what the cases you cite hold. Rather, they simply express the proposition that the purchase of keywords in order to intentionally mislead consumers may violate trademark law.

More broadly, your citation to *Dastar v. 20th Century,* 539 U.S. 23 (2003) is surprising at best, because that is one of many cases that doom your legal theory. In that case, the Supreme Court addressed precisely the kind of bootstrapping your client is attempting here. The plaintiff claimed that reproducing (modified) public domain videos without attribution to the original creator infringed trademark law. The Court rejected the claim, noting that any other holding would place trademark law in direct conflict with copyright:

> The right to copy, and to copy without attribution, once a copyright has expired, like "the right to make [an article whose patent has expired]—including the right to make it in precisely the shape it carried when patented—passes to the public." . . . The rights of a patentee or copyright holder are part of a "carefully crafted bargain," . . . under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution.

Id. at 33-34.

By the same token, my client is free to copy and reproduce "You Asked For It," and has no obligation to either reference SFFS or obtain permission from it.

For the above reasons, my client declines to respond to your demand. I sincerely hope SFFS will not choose to trouble a court of law with this matter. However, if SFFS does intend to file suit, please be assured that my client is prepared to defend itself against these spurious claims.

Sincerely,

Corynne McSherry
Intellectual Property Director