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DePaul Journal of Art, Technology & Intellectual Property Law

Volume 2
Issue 2 *Spring 1992*

Article 7

Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc. 944 F.2d 1446 (9th Cir. 1991)

Frank Monango

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Recommended Citation
Frank Monango, *Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc. 944 F.2d 1446 (9th Cir. 1991)*, 2 DePaul J. Art, Tech. & Intell. Prop. L. 54 (1992)
Available at: http://via.library.depaul.edu/jatip/vol2/iss2/7

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3. 283 Cal. Rptr. at 649.
4. 110 S.Ct. at 2706.
5. 283 Cal. Rptr. at 650, citing 110 S.Ct. at 2706-2707.
6. 283 Cal. Rptr. at 651.
7. *Id.* at 652 n.10, quoting White v. Fraternal Order of Police, 909 F.2d 512, 523 (D.C.Cir. 1990).
8. *Id.* at 652 n. 10.
9. *Id.* at 652.
10. *Id.* at 653.
11. *Id.* at 654.

Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc.,

944 F.2d 1446 (9th Cir. 1991).

Introduction

The Academy filed a copyright infringement suit against Creative House after it had offered for sale the Star Award, a statuette similar to the Academy's "Oscar." The Ninth Circuit reversed the district court and ruled that no general publication of the Oscar had taken place and that it was entitled to protection under the Copyright Act of 1976. In addition, the Ninth Circuit found violations of the Lanham Act, California unfair competition laws, and the California anti-dilution statute.

Facts

The Academy claimed common law copyright protection for the Oscar from 1929 through 1941. The Oscar was registered with the United States Copyright Office in 1941 and all Oscars since then have contained statutory copyright notices. After 1941, the Academy restricted the manner in which winners could advertise their Oscar and gave the Academy the right of first refusal on the sale of any Oscar. In 1976, Creative House produced the Star Award. Physically, the only differences between it and the Oscar are that the Star Award is two inches shorter and inlcudes a star rather than a sword. The Star award was produced for sale to other corporate buyers.

The Academy filed suit under federal law for copyright infringement and violation of the Lanham Act, and under California law for unfair competition and trademark dilution. The district court denied all of the Academy's claims, reasoning that a general publication of the Oscar had occurred prior to the 1976 Copyright Act's effective date which triggered a loss of the common law copyright, there was no likelihood of confusion of the awards under federal trademark law, and the Star had not diluted the Oscar's quality under California law.

Legal Analysis

The Court first addressed whether the "Oscar" should be afforded federal protection under the Copyright Act of 1976. Under the Copyright Act, protection is afforded to a work if it has not become part of the public domain prior to the Act's effective date.[1] The court agreed with the Academy that the copyright registration of 1941 for the Oscar as an unpublished work of art created a rebuttable presumption that the Oscar was an unpublished work and that Creative House bore the burden of showing that the Oscar had entered the public domain.[2] Merely displaying the Oscar to the public does not divest the award of common law copyright protection.[3] However, Creative House argued that the distribution of the Oscar between 1929 and 1941, without any restrictions on its use or sale, amounted to a general publication.[4] The Academy contended that this distribution was merely a limited publication.[5]

According to the Supreme Court in *White v. Kimmel*, a limited publication occurs when distribution is both to a definitely selected group and for a limited purpose without the right of further reproduction, distribution, or sale.[6] The district court concluded, and this court agreed, that the Oscar is awarded only to a select group of persons.[7] A distribution does not occur simply because winners are allowed to advertise the fact that they won the award or display pictures of it.[8] Also, the Academy does not promote the Oscar for its own commercial benefit. Therefore, the Academy's purpose is a limited one to advance the motion picture arts and sciences.[9] The court then ruled that, although there was no express restriction on use or distribution of the Oscar before 1941, these restrictions were implied.[10] Neither the Academy nor a recipient has ever offered to transfer the Oscar to the general public, recipients are not allowed to sell or distribute their Oscars, and recipients are not free to make copies of the Oscar and distribute them. The Academy did not sell or profit from this award. Under the *White* test, this was a limited publication that did not divest the Oscar of its common law protection.[11]

The Ninth Circuit then addressed the issue of federal trademark infringement under the Lanham Act, 15 U.S.C. ¶ 1125(a).[12] Under this section, "the ultimate test is whether the public is likely to be deceived or confused by the similarity of the marks."[13] The district court found no violation and misapplied a six-factor test including: (1) strength of the mark; (2) similarity in appearance; (3) class of goods; (4) marketing channels; (5) evidence of actual confusion; and, (6) the defendant's intent.[14]

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