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RUNNING WITH THE LAW: COPYRIGHT AND TRADEMARK ISSUES EVERY RACE DIRECTOR MUST CONSIDER

*John Carl Zwisler**

I. INTRODUCTION

I had been running for nearly three hours; I was tired and sore. As I approached mile marker 22, I was staring at a nearly 100 foot vertical climb. I struggled up the hill, moving at a pace that some would hardly call running. Spectators were cheering me on and I appreciated the support but kept my hat low so they could not see the pain and concern in my eyes. As I crested the hill I heard music coming from a guitar player who had set up his amp on the side of the road to encourage runners. This music excited me and helped me keep my pace and finish climbing. Once I had finally reached the top, I knew it was all-downhill from there. I was well on my way to finishing the first ever Green Stride Earth Rock Run, my third marathon in three years.

Running events have been increasing in popularity since 1990.¹ In 2013, over 19 million runners finished races across the country,² which is more than double the number of finishers in 2000.³ This popularity is not isolated to shorter distance races. Full marathons have seen an increase nearly every year since 2004.⁴ Half marathons have seen a similar increase, reaching a new high in 2013 with just under 2 million finishers.⁵

During races, runners are primarily thinking about whether the amount of training they had done was sufficient, whether they had

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1. <http://www.runningusa.org/statistics> (last visited Feb. 15, 2015).

2. *2014 State of the Sport – Part III: U.S. Race Trends*, RUNNING USA (July 9, 2014), <http://www.runningusa.org/2014-state-of-sport?returnTo=annual-reports>.

3. *Id.*

4. *Running USA's Annual Marathon Report*, RUNNING USA (Mar. 23, 2014), <http://www.runningusa.org/index.cfm?fuseaction=news.details&ArticleId=332&returnTo=annual-reports> (2012 did not see an increase as a result of the New York City Marathon being canceled due to hurricane Sandy.)

5. *Id.*

properly fueled for the race, and whether they are even going to be able to finish the race. Runners are not concerned with the marks protected by trademark all over their race day gear, along the course, and on the free goods offered to participants. Runners pay no attention to the copyrighted music they heard at the starting line to get them excited and ready to go, or the songs at the finish line that help their accomplishments come to light.

It was only after I had finished the Earth Rock Run that I considered whether there were any intellectual property rights concerning the music that helped me up that daunting hill at mile 22. From there, I began to think about the other legal challenges a race director has when putting on a well-known race, such as the Boston Marathon, as well as the concerns one might have in putting together a much shorter race for the first time. This interest grew and in this paper I discuss the intellectual property issues that arise from planning and conducting races, which every race organizer must consider. This paper will discuss the various issues that are important to races as they arise in copyright and trademark law.

II. COPYRIGHT

A. *Scope of Copyright*

Copyright is governed by the Copyright Act of 1976; its protection extends to original works of authorship that are fixed in a tangible means of expression that can be reproduced.⁶ Congress included a list of categories of copyrightable protection: literary works, musical works, dramatic works, pantomimes and choreographic works, pictorial works, motion pictures, sound recordings, and architectural works.⁷ The use of the word “include” when referring to the list means that this list is interpreted to be illustrative and non-exhaustive.⁸ Congress has made it clear that copyright protection shall not be extended to an idea, procedure, or process regardless of how it is described in any work.⁹

6. 17 U.S.C. § 102 (2012).

7. *Id.*

8. House Report No. 94-1476, at 53 (1976) (The use of the word “include”, as defined in section 101, makes clear that the listing is “illustrative and not limitative,” and that the seven categories do not necessarily exhaust the scope of “original works of authorship” that the bill is intended to protect.)

9. 17 U.S.C. § 102 (2012).

B. Copyrightable Subject Matter in Bicycle Races

Race directors must realize that certain works used for promotion of a race may be copyrighted. They must also think about works they create and whether they can be subject to protection. While there is no direct case law on the copyrightable material used in connection with a running event, a case from the District of New Mexico, *Wilson v. Brennan*, addresses the same issues in the context of a bicycle race.¹⁰ In that case, a director of the Tour of the Gila bicycle race brought a copyright infringement action against his former partners.¹¹ Mark Wilson, who argued pro se, claimed that his former partners used his intellectual property for the race without his consent.¹² Wilson served as a director of the race for numerous years and helped name the race, design the course, and create maps and other materials athletes used to gain information about the race.¹³ Wilson claimed that he had a valid copyright in virtually all aspects of the race; including the name, the design of the course, and the factual and graphic compilations he had designed for the race.¹⁴ The District Court addressed each aspect of Wilson's claim to copyright protection.

i. Race Name

The court quickly dispensed with Wilson's claim to the copyright in the name of the race. The court stated that Wilson was not the only person involved in coming up with the name of the race and that as a matter of law he was not entitled to a copyright in the name as "words and short phrases such as names, titles, and slogans cannot be protected by copyright law."¹⁵ Wilson could have sought to protect the name under trademark law but he failed to do so.

ii. Race Course Design

The court also concluded that no protection should be given to the design of the racecourse.¹⁶ The court stated that Wilson could not claim a valid copyright in the design of the racecourse, as copyright does not extend to ideas, but only to expressions of ideas.¹⁷ Not much analysis was given to this claim, but the court did note that the county

10. *Wilson v. Brennan*, 666 F. Supp.2d 1242 (D.N.M. 2009).

11. *Id.*

12. *Id.* at 1247.

13. *Id.* at 1248-50.

14. *Id.* at 1251.

15. *Id.* at 1252.

16. *Id.*

17. *Id.*

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in which the two-day bicycle race was being held is rural, Wilson did not have many roads to choose from when designing the course, and also that, “[m]ost courts that have considered the question have held that sporting events are not copyrightable.”¹⁸

iii. Race Course Bible

The court then addressed Wilson’s claim of copyright to what was called the “Race Bible.” This document included maps, narrative, and other factual information that athletes would want to know about the race. While facts themselves cannot be copyrighted, a compilation of facts is subject to protection.¹⁹ Factual compilations need to meet a minimum degree of creativity to be copyrightable.²⁰ To meet this low bar of creativity a court will look to the choices the author made in selecting and compiling the facts.²¹ The court found that Wilson included information about how bonuses were awarded and how leader jersey and monetary awards were determined; the court also made a note of how Wilson had included easily recognizable spots along the course that racers would be able to recognize and estimated when the leaders would be at these points based on the finishing times of the racers from previous years.²² The court stated that this was a good example of how Wilson selected facts for the “Race Bible” and that his compilation of facts met the minimum degree of creativity necessary for copyright protection.²³

iv. Race Course Maps

The court then addressed the maps that Wilson made for the “Race Bible.”²⁴ The court stated that while most courts have treated maps as compilation of facts; the Copyright Act categorizes them as “pictorial, graphic and sculptural works.”²⁵ The court again stated that there must be an analysis of the selection and creativity of the maps in order to find them copyrightable subject matter.²⁶ The court found that within the maps, Wilson included various landmarks to help orient the racers, chose different thickness of lines to emphasize various geographic features and boundaries, and included the elevation changes

18. *Id.*

19. See *Feist v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350-51 (1991).

20. *Id.* at 348.

21. *Id.* at 348-349.

22. *Wilson*, 666 F. Supp.2d at 1254.

23. *Id.*

24. *Id.* at 1252-1254

25. *Id.* at 1254

26. *Id.* at 1254-55.

the racers will encounter during the course of the race.²⁷ The court held that the information Wilson included met the threshold level for copyright protection.²⁸

While Wilson was not able to obtain protection for every aspect of the materials he created for the race, he was able to establish protection in important pieces of his intellectual property. This case is a great example of what types of materials are copyrightable for running events and should be in the mind of any race director who has already established a race or is planning to do so in the future.

C. Copyrightable Subject Matter In Running Events

i. Racecourse Maps

Race directors all over the country should familiarize themselves with *Wilson* as it provides valuable information on how to protect their intellectual property. As detailed below, numerous race directors and others involved in the running community are already beginning to protect their intellectual property. The Boston Athletic Association (BAA), the organization that organizes the Boston Marathon, has an incredible amount of information on its website about the races it holds each year.²⁹ While each page itself has a notice that all the material on the site is protected by copyright, the BAA has a separate notice on its map that states it is the holder of the copyright and no portion of the map may be used or reproduced without permission.³⁰

The map includes a brief description of the course and the neighborhoods the racers will encounter on their route.³¹ The map also indicates where water and food stations will be along the course.³² It includes mile markers, various MBTA and commuter rail stations, as well as parking lots near the starting line.³³ The map highlights various landmarks such as Wellesley College, the Newton Fire Station, the CITGO sign at Kenmore Square, as well as the infamous “Heartbreak Hill” in Newton.³⁴ This map surely qualifies as copyrightable subject matter as it incorporates the aspects of selection and creativity that the court in *Wilson* found convincing.

27. *Id.* at 1256-57.

28. *Id.* at 1257.

29. <http://www.baa.org>

30. *BOSTON MARATHON Official JetBlue Course map*, BOSTON ATHLETIC ASSOCIATION, http://www.baa.org/~media/Images/BAA/Races/Maps/Boston%20Marathon/2015_bostonmarathon_coursemap.jpg (Last visited February 14, 2014).

31. *Id.*

32. *Id.*

33. *Id.*

34. *Id.*

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The New York Road Runners have a copyright notice on the map to its New York City Marathon.³⁵ However, a notice of copyright is absent from the maps of other well-known races such as the Chicago Marathon³⁶ and the Vermont City Marathon.³⁷ Each of these maps is similar to the one the BAA has produced in the selection of the information and the creativity in conveying that information. As a result, these maps meet the standard for copyright set out in *Wilson* and the organizers of these races should protect their intellectual property.

ii. View The Course Before You Race

Many runners want more than a map of the race they are going to run in order to train. They like to run part of a course before race day to orient themselves to the course and get a feel for its unique challenges. This is not always possible for many people who travel long distances and are unable to look at the course before the race begins. One company, View The Race, Inc. (VTR) is trying to address that problem.

VTR films the courses of various races and hosts them on their own website, YouTube, and the websites of the races themselves.³⁸ As of this point, VTR hosts videos of 177 different races from all over the country.³⁹ Race directors get in touch with VTR to have their courses filmed for a price ranging from \$150-\$700.⁴⁰ VTR not only films and edits the videos but also adds titles and graphics of the race name and/or logo and will also use the maps and elevation charts the creators of the races have produced.⁴¹ VTR speeds up the video during long stretches without any turns and slows down portions of the video to emphasize important or complex parts of the course.⁴² VTR also adds narration to the videos to provide advice and tips to the runners about the various obstacles they will encounter on the course during race day.⁴³

35. *The 2015 New York City Marathon*, NEW YORK ROAD RUNNERS (Last visited Feb. 14, 2013), <http://www.tcsnymarathon.org/sites/default/files/TCSNYCM14CourseMap.pdf>.

36. *Chicago Marathon Course Map*, BANK OF AMERICA CHICAGO MARATHON (Oct. 13, 2013), <http://assets.chicagomarathon.com/wp-content/uploads/2013/08/2013-Course-Map.pdf>.

37. *2014 Course Map*, KEY BANK VERMONT CITY MARATHON & RELAY (2015), http://www.vermontcitymarathon.org/wp-content/uploads/2014/09/CourseMap_2015.pdf

38. <http://viewtherace.com>

39. *Races*, VIEW THE RACE, <http://viewtherace.com/races> (last visited Feb. 17, 2015).

40. *Want A Course Video for your Event?*, VIEW THE RACE, <http://viewtherace.com/services/course-video> (last visited Feb. 14, 2015).

41. *Id.*

42. *Id.*

43. *Id.*

VTR's choices of showing different aspects of the landscape of the course, speeding up and slowing down during the editing process, and adding information via narration would subject the videos to copyright protection; these videos would easily fall within the motion picture category mentioned in the copyright statute. VTR does not currently have a notice in any of their videos that they are copyrighted. However, on the terms and conditions page of its website there is a notice that the website and the original content contained within are owned by VTR and are protected by copyright law.⁴⁴ Additionally, when a race video is hosted on YouTube, there is a notice that the video is being used via a license.⁴⁵ These videos are another example of the numerous materials a race may produce that are copyrightable subject matter under the *Wilson* criteria.

iii. *Music Licensing*

Many runners would agree that music is an important part of any race. Race directors often play music at the starting line to help pump up the athletes and get them ready to tackle what lies ahead of them. Along the route there are bands or groups that play music to encourage runners through challenging parts of the course.⁴⁶ At the finish line, music is blaring to help the athletes get excited and finish strong. While music is an integral part in putting on a fun and exciting race, many race directors do not consider that they are using copyrighted material or the need to obtain licenses in order to use it. Failing to do so can subject race directors to fines and suits as authors of musical works retain a public performance right.⁴⁷ I spoke with the director of a marathon, hereinafter *The Director*, I ran two years ago. He confirmed that there was music playing at both the start and the finish line of the race and that he had not obtained a license to use it.⁴⁸ At first he told me that he did not think he had to obtain a license but then directed me to a website in which information about obtaining licenses for races is readily available.⁴⁹

44. *View The Race Terms of Service ("Agreement")*, VIEW THE RACE, <http://viewtherace.com/terms-conditions> (last visited Aug. 12, 2014).

45. *Hyannis Half Marathon Hyannis Massachusetts Half Marathon*, VIEW THE RACE, <https://www.youtube.com/watch?v=7lDkLJtnzKo> (last visited Aug. 6, 2014).

46. <http://www.vermontcitymarathon.org/resources/spectator-guide/> (For example, Burlington Taiko is known for playing thunderous drums to help runners up the daunting climb at mile 15 in the Vermont City Marathon.)

47. 17 USC § 106 (2012).

48. Telephone interview with anonymous, *Director, Marathon* (July 28, 2014). Name withheld to protect anonymity.

49. *Id.*

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The Road Runners Club of America (RRCA) is the oldest and largest organization in the U.S. that is dedicated to distance running.⁵⁰ The RRCA includes over 2,300 member clubs and events that represent over 250,000 runners in the U.S.⁵¹ Its website hosts an article entitled “Music License Reminder for RRCA Members”.⁵² (This article was also published in the RRCA Quarterly Newsletter in Summer 2010).⁵³ The article cautions race directors that if they are not paying for licenses and are playing music at their race day events, they can be subject to both fines and lawsuits.⁵⁴ The article stresses the fact that music is valuable intellectual property and the American Society of Composers, Authors and Publishers (ASCAP) and Broadcast Music Incorporated (BMI) have contacted RRCA members regarding music licensing.⁵⁵ Information regarding music licensing and endurance events can also be found on the ASCAP website.⁵⁶

ASCAP and BMI are the two largest organizations that manage public performance rights and licenses for music copyright holders.⁵⁷ Race directors need to get in touch with these organizations if planning on playing recorded music during the race or having bands play along the course. According to the article on the RRCA website, it is easy to obtain a blanket license for use of the songs in the entire ASCAP catalogue, which includes over 435,000 songwriters.⁵⁹ The ASCAP representative stated that a one-day license for a small race attended by 1-6,000 runners and spectators would only cost \$50 while a large race hosting over 25,001 runners and spectators would cost \$150 in licensing fees.⁶⁰ I spoke with an employee at BMI and requested what a license would cost for a race with both live and re-

50. *History Of The RRCA*, RRCA, <http://www.rrca.org/about/history/> (last visited Aug. 6, 2014).

51. *Id.*

52. *Music License Reminder For RRCA Members*, RRCA, <http://www.rrca.org/services/news-entry/music-license-reminder-for-rrca-members/> (last visited Aug. 6, 2014).

53. Jean Knaack, *Inside Track*, QUARTERLY NEWSLETTER FOR THE MEMBER OF THE ROAD RUNNERS CLUB OF AMERICA 1 (Summer 2010), http://www.rrca.org/downloads/inside-track/RRCA_Summer_2010_IT_reduced.pdf.

54. *Id.*

55. *Id.*

56. *Endurance Events*, ASCAP, <http://www.ascap.com/licensing/types/endurance-marathon-triathlon.aspx> (last visited Aug. 14, 2014).

57. The American Society of Composers, Authors and Publishers, <http://www.ascap.com> (last visited Aug. 13, 2014).

58. BMI, <http://www.bmi.com> (last visited Aug. 13, 2014).

59. *ASCAP Keeps You in Tune With Copyright Law*, ASCAP, http://www.ascap.com/~/_media/files/pdf/licensing/general/brochures/ascap_keeps_you_in_tune_with_the_copyright_law.pdf (last visited Aug. 6, 2014).

60. Knaack, *supra* note 53.

corded music and an estimated amount of 2,000 people. For those specifications I was quoted a price of \$230 minimum for a one-day use blanket license.⁶¹

The Director confessed that in the ten years he has been organizing his race he has never paid for a license, as it was just not in his budget to do so. While it is possible ASCAP and BMI will not find out about the use of unlicensed music played at races, the consequences of not procuring a license can be very severe. On the ASCAP website, the organization states that anyone who chooses to use copyrighted material without permission is subject to having, “a court assess damages, a minimum of \$750 for each song “infringed”, and can require you to pay attorney’s fees and court costs.”⁶² This quote is consistent with language in the Copyright Act that determines statutory damages⁶³ and the awarding of attorney’s fees and court costs.⁶⁴ The information about the requirement to obtain licenses, the reasonableness of the costs, and the large penalties one may be subjected to is readily available.

iv. *Race Day Photographs*

After the race is over runners often look forward to seeing photos that are taken during the race itself. There is almost always a photographer along the racecourse to take photos of runners as they pass by, and depending on the size of the race there may be numerous photographers stationed at various points. The photos are usually uploaded to an online library and each runner can search for the pictures they are in by entering in the number on the bib they wore during the race. The photos are available for sale if anyone should choose to buy them. Unless the photos are bought they are watermarked, are low resolution, or are otherwise marked to indicate they have not been purchased and to incentivize the athletes to make purchases. Often times runners will download these marked photos, without purchasing them, and share them on various social media sites to show their accomplishments. What those runners might not know about this act is that they are likely violating copyright law.

A writer for the well-known magazine, *Runners World*, spoke with an attorney, Rachel Schaffer, to discuss this issue.⁶⁵ Schaffer analo-

61. Telephone interview with anonymous, BMI employee (Aug. 1, 2014).

62. ASCAP, *supra* note 59.

63. See 17 U.S.C. § 504 (2012).

64. See 17 U.S.C. § 505 (2012).

65. Mark Remy, *Photo Sharing: What the Law Says*, REMY’S WORLD (June 30, 2104), <http://www.runnersworld.com/fun/photo-sharing-what-the-law-says>.

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gizes sharing a race day photo without permission to downloading a copyrighted song from the Internet.⁶⁶ She explains that in both of these instances there is infringement; it does not matter that the sharing of the intellectual property is not for commercial gain.⁶⁷

Another issue discussed was a comment from a reader who claimed that sharing a low-resolution photo would likely be considered “fair use” because the market for the high-resolution photo is not being substantially diminished.⁶⁸ The reader brings up a valid argument but negates to discuss the other factors in considering a fair use defense. In *Harper & Row v. Nation Enterprises*, the Supreme Court laid out the four factors for determining whether or not something falls within the fair use doctrine: 1) The purpose and the character of the use. 2) The nature of the copyrighted work. 3) The substantiality of the portion used in relation to the copyrighted work as a whole. 4) The effect on the potential market for or value of the copyrighted work.⁶⁹

With these factors in mind, sharing a copyrighted race day photo would likely not fall within a fair use defense. The purpose of the use is likely not transformative as it is intended solely for personal purposes. Photographs are copyrightable subject matter and an entire photo is used when it is shared on other websites. While the reader suggests that there is little to no harm to the copyright owner, this is likely not the case. *Harper & Row* made it clear that the market does not have to be affected at this point in time but if the use “should become widespread, it would adversely affect the *potential* market for the copyrighted work.”⁷⁰ (emphasis added) If many race participants use the marked photos and do not purchase them, this certainly could affect the potential value of the unmarked photos, as fewer people would want to buy them. Should the practice become the norm in the running community, copyright holders of the photos would likely see direct harm. Despite the advice from Mrs. Schaffer, many people commented on the *Runners World* article stating they will continue to share the marked photos and that there is no market harm to the copyright holder.⁷¹

While this practice may continue among some in the running community, The Director is very careful when it comes to this issue. He compiles the finishing times of all the participants of his race and

66. *Id.*

67. *Id.*

68. *Id.*

69. *Harper & Row v. Nation Enters.*, 471 U.S. 539, 560-61 (1985).

70. *Id.* at 568.

71. Remy, *supra* note 65.

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sends a hard copy to everyone who participated. Included in this packet are photos of the top finishers as well as others that he selects. He stated that he always gets permission from the copyright holders of the photos to use in this packet.⁷² When asked about sharing marked photos on the Internet he said that it is something that he does not approve, but it is something a race director should not concern himself with, as it is the copyright holder's responsibility to take action against the infringement.⁷³

While the packet The Director sends to race participants is important to note for copyright concerning photographs, the packet itself is likely copyrightable material. Just as the "Race Bible" in *Wilson* contained facts, this packet lists the finishing times of all the participants and there is nothing creative about that. However, The Director provides a brief factual summary of the happenings at the race, some anecdotes, and selects the photos he wants to use. The Director said he chooses some photos specifically to showcase runners who would not usually be featured, as they were not top finishers.⁷⁴ The selection used in compiling this factual data and the creativity involved in putting it together would satisfy the requirements for earning copyright protection.

III. TRADEMARK

A. *Scope of Trademark*

Trademark protection is governed by the Lanham Act and extends to any word, name, symbol, or device, or any combination that is used by a person or which a person has a bona fide intention to use in commerce to distinguish goods or unique products from those manufactured or sold by others to indicate the source of the goods.⁷⁵ While most people are familiar with trademarks to distinguish goods, other marks qualify for protection, including service marks, trade names, collective marks, and trade dress.⁷⁶ Trademark protection is offered in part to avoid consumer confusion and allow the public to get the same quality good or service they would expect from the associated mark, as well as to protect the "good will" of a trademark owner.

72. Anonymous interview, *supra* note 48.

73. *Id.*

74. *Id.*

75. 15 U.S.C. § 1127 (2012).

76. *Id.*

B. Boston Athletic Association T-Shirts

The court in *Boston Athletic Association v. Sullivan* dealt with a third party using the marks of the BAA on shirts and other apparel.⁷⁷ The BAA has organized the Boston Marathon since its inception in 1897.⁷⁸ The BAA registered the names Boston Marathon and BAA Marathon and its unicorn logo in Massachusetts in 1983; it registered the name Boston Marathon with the United States Patent and Trademark Office in 1985.⁷⁹ In 1986, the BAA gave an exclusive license to Image Impact to use their marks on apparel.⁸⁰ Defendants Sullivan and Beau Tease began selling shirts with the Boston Marathon mark without the consent of the BAA.⁸¹ The BAA sued both parties for infringement and sought an injunction enjoining them from selling shirts with its mark.⁸² The questions before the court were whether there was a likelihood of confusion between the goods, as well as a “promotional goods” issue; whether there is a likelihood of confusion that the BAA licenses or otherwise endorses the defendant’s shirts.⁸³

The court laid out the relevant factors when inquiring about a likelihood of confusion analysis: 1) the similarity of the marks; 2) the similarity of the goods; 3) the parties’ channels of trade; 4) the relationship between the parties’ advertising; 5) the classes of prospective purchasers; 6) evidence of actual confusion; 7) the defendant’s intent in adopting the mark; and 8) the strength of the plaintiff’s mark.⁸⁴

As to the first five factors the court found that the shirts were identical, the parties were offering virtually the same goods, and they sold and advertised the shirts in substantially the same ways.⁸⁵ Before moving to the sixth factor, the Appeals Court addressed the lower court’s decision to split the potential consumers into two categories; those who knew enough about the race to know that the BAA was the sponsor and those that did not know the BAA was the sponsor.⁸⁶ The Appeals Court reversed the lower court’s decision to split the public because the BAA had supplied sufficient evidence of magazine articles, advertisements, and television broadcasts that continuously showed the public that the BAA was the sponsor of the Marathon and

77. *Boston Athletic Ass’n. v. Sullivan*, 867 F.2d 22, 23 (1st Cir. 1989).

78. *Id.* at 24.

79. *Id.* at 24-25.

80. *Id.* at 25.

81. *Id.* at 26.

82. *Id.*

83. *Id.* at 28-29.

84. *Id.* at 29.

85. *Id.* at 30.

86. *Id.*

the court found no reason to split the consumers into two categories.⁸⁷ The court moved on to the other relevant factors and found that there was evidence of consumer confusion, that the defendants intended to profit from using the BAA marks, and that the BAA marks were strong and warranted broad protection.⁸⁸

Based on that analysis, the court held that there was a strong likelihood of confusion of the goods and moved on to the promotional goods issue.⁸⁹ The court based its analysis on the facts of the likelihood of confusion claim, but came to some other significant conclusions. The court stated that the BAA did not have to prove that the public would conclude that the defendants' product was "officially sponsored by the Marathon's sponsor (whoever that sponsor may be)."⁹⁰ The court was able to presume that given the defendants' intentional use of the marks, purchasers were likely to buy the shirts because of that reference.⁹¹ The court stated it would be fair to presume that purchasers would be confused about the shirts source or sponsorship because the purchasers would mistakenly assume the defendants' shirts had some connection with the official sponsor of the Marathon and the defendants were not able to effectively rebut this presumption.⁹² The defendants were enjoined from manufacturing or selling shirts that used the BAA mark.⁹³

C. Trade Dress and Golf Holes

Pebble Beach Co. v. Tour 18 I Ltd., like *Wilson*, does not involve a running event; it involves golf courses seeking to protect the design of their golf holes via trade dress.⁹⁴ While this does not involve a running event, it sheds light on a way a race director may be able to obtain protection for their racecourse.

Tour 18 owned and operated a public golf course in Humble, Texas.⁹⁵ It created three of its holes by copying the design of certain holes of well-known courses, Pebble Beach Co. (Pebble Beach), Resorts at Pinehurst, Inc. (Pinehurst), and Sea Pines.⁹⁶ These three

87. *Id.* at 31.

88. *Id.* at 31-32.

89. *Id.* at 32.

90. *Id.* at 33.

91. *Id.* at 34.

92. *Id.*

93. *Id.*

94. *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 532 (5th Cir. 1998). Abrogated on other grounds by *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001).

95. *Id.* at 533

96. *Id.*

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courses, together as plaintiffs, brought an action claiming the holes were protectable trade dress and that Tour 18 had infringed their marks.⁹⁷

Trade dress refers to the total image and overall appearance of a product and may include features such as size, shape, and color to characterize a particular product.⁹⁸ Under the Lanham Act a trade dress will only be protected if it is nonfunctional, this “serves to assure that competition will not be stifled by the exhaustion of a limited number of trade dresses.”⁹⁹ The test for functionality was set out in *Qualitex v. Jacobson Products Co.*¹⁰⁰ The Supreme Court stated that functionality rests on whether the trade dress is “essential to the use or purpose of the article or if it affects the cost or quality of the article . . . if exclusive use of the feature would put competitors at a significant . . . disadvantage.”¹⁰¹ The District Court held that the plaintiffs’ designs were nonfunctional because there is an “unlimited number of alternative designs” to the plaintiffs’ designs and there was no evidence the plaintiffs’ designs were superior to the many alternatives.¹⁰² Additionally, experts testified that allowing protection for the plaintiffs’ designs would not unduly injure competition and Tour 18 did not need to copy other golf hole designs in order to be successful in the Houston market.¹⁰³ Based on this evidence, the District Court found the designs to be nonfunctional and the Court of Appeals did not find this to be clearly erroneous.¹⁰⁴

The Court of Appeals then turned to the issue of distinctiveness and began by stating that trade dresses are distinctive and protectable if they indicate a source.¹⁰⁵ The court stated that trade dress is classified into five categories: 1) generic, 2) descriptive, 3) suggestive, 4) arbitrary, or 5) fanciful.¹⁰⁶ The court stated that the last three are inherently distinctive and do not require any additional showing for protection because “their intrinsic nature serves to identify a particular source of a product.”¹⁰⁷ In order to qualify as arbitrary or fanciful the trade dress must, “bear no relationship to the products or services

97. *Id.* at 532.

98. *Id.* at 536.

99. *Id.* at 537.

100. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

101. *Id.* at 165.

102. *Pebble Beach Co.*, 155 F.3d at 538.

103. *Id.*

104. *Id.* at 539-40.

105. *Id.* at 540.

106. *Id.*

107. *Id.*

to which they are applied.”¹⁰⁸ For a trade dress to be suggestive, it must not describe a particular characteristic of a good or service and must require the consumer to “exercise the imagination in order to draw a conclusion as to the nature of the goods or services.”¹⁰⁹ The court found that Pebble Beach and Pinehurst did not meet these standards, as the golf holes were “commonplace features of a golf hole and therefore does bear a relationship to the product, a golf hole.”¹¹⁰ Additionally, the court noted that the designs create golf holes and nothing more; a consumer does not have to “exercise . . . one’s imagination to realize one is viewing a golf hole.”¹¹¹ Therefore, the court found that Pebble Beach and Pinehurst did not fall into the fanciful, arbitrary, or suggestive categories.¹¹²

Conversely, the District Court found that Sea Pines’ hole was inherently distinctive because of the association it has with a lighthouse near the hole.¹¹³ The District Court noted this qualified for inherent distinctiveness as Sea Pines emphasizes the particular hole in its advertisements and promotional materials and the association the lighthouse has with the hole has lead it to commonly be referred to as the “Lighthouse hole.”¹¹⁴ The District Court found that the incorporation of the lighthouse served, as an “arbitrary source-identifying feature” and the hole was therefore inherently distinctive.¹¹⁵

The Court of Appeals chose not to discuss whether Sea Pines’ hole was inherently distinctive as it affirmed that it had acquired secondary meaning. The following evidence can prove secondary meaning in trade dress: 1) length and manner of use of the mark or trade dress; 2) volume of sales; 3) amount and manner of advertising; 4) nature of use of the mark or trade dress in newspapers and magazines; 5) consumer-survey evidence; 6) direct consumer testimony; and 7) the defendant’s intent in copying the trade dress.¹¹⁶ The Court of Appeals found secondary meaning based on Sea Pines’ extensive advertising, unsolicited publicity of the trade dress of Sea Pines’ hole and the lighthouse in golf publications, and Tour 18’s intent to copy and use the trade dress.¹¹⁷ Based on this evidence, the court found that Sea Pines’

108. *Id.*

109. *Id.*

110. *Id.*

111. *Id.*

112. *Id.*

113. *Id.*

114. *Id.* at 534.

115. *Id.* at 540.

116. *Id.* at 541.

117. *Id.*

hole had acquired secondary meaning and therefore deserved trade dress protection.¹¹⁸ Conversely, Pebble Beach and Pinehurst were unable to provide any evidence that their holes had acquired secondary meaning and were therefore not subject to trade dress protection.¹¹⁹

The Court of Appeals then moved through a likelihood of confusion analysis using the same factors that were laid out in *Sullivan*.¹²⁰ The court noted that no golfer would stand on the tee at Tour 18 and think he or she was playing Pebble Beach or Sea Pines but there was significant evidence that consumers were confused as to whether or not Tour 18 had acquired permission from the other courses to use their golf hole designs. The plaintiffs brought survey evidence of people who played at Tour 18 as well as testimony of witnesses who had not yet played the course who were all confused about whether Tour 18 had obtained permission from the other courses.¹²¹ The Court of Appeals concluded that the District Court's finding of actual confusion and a likelihood of confusion based on Tour 18's use of the protected trade dress were not clearly erroneous.¹²² As a result, the Court of Appeals affirmed the injunction against Tour 18, limiting the use of Sea Pines' trade dress.¹²³

While this case is about protecting holes at a golf course, it can be useful for directors of running events. Race directors can use this case as a basis for claiming trade dress protection for their courses, an idea that will be examined more thoroughly below.

IV. COPYRIGHT AND TRADEMARK PROTECTION FOR RACECOURSES

A. *Racecourses-Copyright*

In *Wilson*, the court was reluctant to allow copyright protection for the design of the racecourse because it viewed it as in an idea rather than an expression of an idea. As a result, the court gave very brief reasoning as to why the racecourse was just an idea and not an expression. The court did note that Wilson had worked with a number of other people in designing the course, and that it would not be possible to distinguish who would be the author of the work.¹²⁴ The court also noted that the county that the course was held in does not allow for

118. *Id.*

119. *Id.* at 540.

120. *Id.* at 543.

121. *Id.*

122. *Id.* at 545.

123. *Id.* at 550-54.

124. *Wilson*, 666 F. Supp.2d at 1252.

many choices when designing a multi-stage bicycle race.¹²⁵ These two factors can easily be dealt with under copyright law.

First, it would be possible for the group of people who helped design the race to file as joint authors and dispel any confusion as to who made the selections for the race. Wilson argued that he selected much of the course independently and would therefore be the sole author of the work.¹²⁶ However, the court was unable to distinguish which decisions were independently his and which the group made. The authors of a joint work are considered to be co-owners of copyright in the work.¹²⁷

Second, the limited selection of roads Wilson had in designing the course is not the case for every race director. In large running events, such as the Boston Marathon or the New York City Marathon, a race director has a wide discretion about how to organize a race. The directors of the New York City Marathon designed the course so the athletes run through each borough.¹²⁸ The Boston Marathon has its finish line at Copley Square just outside the Prudential Center, one of the most iconic buildings in the city.¹²⁹ Race directors may also select a course because it is flat and fast or will provide a challenge for the athletes. The Baystate Marathon is known amongst runners as being one of the fastest marathon courses, and the directors of the race made the choice to design the course in such a way that would help runners achieve qualifying times for the Boston Marathon.¹³⁰ This is apparent from a quick visit to the homepage of their website which boasts this marathon is “For Runners-By Runners Let us help you get your Boston Qualifier.”¹³¹ Conversely, the San Francisco Marathon is known for being a challenge as the course takes advantage of the city’s infamous hills.¹³² While the New York City and Chicago Marathons each had about 40,000 finishers in 2013,¹³³ San Francisco had

125. *Id.*

126. *Id.*

127. 17 U.S.C. § 101 (2012).

128. *supra* note 35.

129. *supra* note 30.

130. *Baystate Marathon Course*, MAPMYRUN, <http://www.mapmyrun.com/us/lowell-ma/baystate-marathon-course-route-45172814> (last visited Feb. 17 2015).

131. Baystate Marathon & Half Marathon, <http://baystatemarathon.com> (last visited Aug. 13, 2014).

132. THE SAN FRANCISCO MARATHON, <http://www.thesfmarathon.com/the-races/full-marathon/course-info-and-maps/> (last visited Feb. 17 2015).

133. *The 2013 ING New York City Marathon*, NEW YORK ROAD RUNNERS, <http://www.nyrr.org/races-and-events/2013/the-2013-ing-new-york-city-marathon> (last visited Sept. 3, 2014) (follow “Race Report” hyperlink). NYC had more than 50,000 starters, Chicago Marathon Race Results 2013, <http://www.marathonguide.com/results/browse.cfm?MIDD=67131013> (last visited Sept. 3, 2104).

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less than 7,000 in 2014.¹³⁴ Part of the attraction to the race, or lack thereof, is that it is a challenging course and the organizers of the race “have dismissed talk of altering the course to make it easier.”¹³⁵ Unlike the director in *Wilson*, the people who create these courses are not limited to a few roads that are suitable for a race. It is apparent that directors of these larger races take care in the selection of the routes so runners will go through beautiful parts of a city or make decisions on the relative difficulty of a course.

This creativity in the selection of racecourses was sufficient to persuade a Polish court that a racecourse should be subject to copyright protection.¹³⁶ Polish copyright law is similar to U.S. copyright law and extends protection to such works as photographs, industrial designs, music, and stage works.¹³⁷ The court in case file I C 238/06 held that the route of the Bochina Independence Half-Marathon met the prerequisites of an artistic work within the meaning of Polish law.¹³⁸ In awarding protection for the route the court noted the selection of the streets for the race in order to provide proper paving, that there was no substantial differences in route grading, and the author had taken the terrain of the course into significant account.¹³⁹

It is important to note that under Polish law, copyright protection does not extend to inventions, procedures, and *ideas* (emphasis added).¹⁴⁰ The same is true under U.S. copyright law and was the primary reason the court in *Wilson* denied copyright protection for the course.¹⁴¹ Despite this barrier, the Polish court felt that the selection process of the racecourse was sufficiently creative to warrant copyright protection.

U.S. race directors select the routes of their courses for a variety of reasons, as stated above. Should another person seek copyright protection of a racecourse in a future instance, a court should take this selection of creativity into account and should not dispel a racecourse as just an idea that does not deserve protection. Additionally, it must

134. *San Francisco Marathon 2014*, RACE CENTRAL, <http://www.runraceresults.com/Secure/RaceResults.cfm?ID=RCLF2014> (follow “Overall” hyperlink) (last visited Sept. 3, 2014).

135. Kevin Helliker, *The Race Even Marathoners Fear*, THE WALL STREET JOURNAL (July 13, 2010), <http://online.wsj.com/news/articles/SB10001424052748703283004575363214110587160>.

136. Tomasz Rychlicki, *Copyright law, case I C 238/06*, POLISH IT & IP LAW NEWS (June 15, 2009), <http://rychlicki.net/en/2009/06/15/782/>.

137. *Act of 4 February 1994 ON COPYRIGHT AND RELATED RIGHTS*, 1 UNESCO (1994), http://portal.unesco.org/culture/en/files/30304/11420011803pl_copyright_2005_en.pdf/pl_copyright_2005_en.pdf.

138. Rychlicki, *supra* note 136.

139. *Id.*

140. *Act of 4 February 1994 ON COPYRIGHT AND RELATED RIGHTS*, 1 *supra* note 137.

141. *Wilson*, 666 F. Supp.2d at 1252.

be recognized that with the availability of certain technology the creativity in selecting a course design has even greater possibilities. Websites like [mapmyrun.com](http://www.mapmyrun.com)¹⁴² and products such as the Nike+ SportsWatch¹⁴³ allow users to track their runs in real time, provides information on distance and speed, and highlights the route the user has taken onto a map via GPS technology. This technology would allow any runner or race director to run a specific course and make some sort of design such as spelling a word or making a symbol or shape. When the user gets home he or she can upload the data of that run onto their computer and a design for a racecourse has been put into a fixed tangible form within seconds.

Racecourses are not designed arbitrarily; rather, race director's creative decisions shape these courses. These creative decisions should be given substantially more weight than was given by the court in *Wilson* should another person try and seek copyright protection of a racecourse. Extending copyright protection to racecourses would allow race directors to prohibit others from organizing different races on the copyrighted course or would require a license to do so. Copyright protection would reward race directors for their creativity and would incentivize more complexity and creativity on their part in order to keep designing new and exciting courses.

B. Racecourses-Trade Dress

The District Court in *Pebble Beach Co.* extended trade dress protection to Sea Pines' golf hole as the lighthouse associated with the hole served as an arbitrary source indicator and the Court of Appeals found it had acquired secondary meaning to the general public.¹⁴⁴ A race director should keep this in mind and consider if a part of their course could be subject to protection. To illustrate this idea, I will examine the Boston Marathon, specifically two points along the course: "Heartbreak Hill" and the finish line on Boylston street.

Heartbreak Hill is located between miles 20 and 21 in Newton.¹⁴⁵ It is known in the running community as one of the most challenging parts of the Boston Marathon as it is a steep incline, and it is located during a point in the race where most runners begin to hit the wall.¹⁴⁶

142. MAPMYRUN, www.mapmyrun.com, (last visited Aug. 13, 2014).

143. Nike+ SportsWatch GPS review, CNET (May 27, 2011), <http://www.cnet.com/products/nike-plus-sportwatch-gps/>.

144. 155 F.3d at 540-41.

145. Boston Athletic Association, *supra* note 30.

146. See e.g. Robert James Reese, *Just How Bad is Heartbreak Hill?*, Run The Numbers (April 15, 2013) <http://www.runnersworld.com/races/just-how-bad-heartbreak-hill>.

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To qualify for trade dress protection Heartbreak Hill would have to be nonfunctional and meet either the inherently distinctive or the secondary meaning threshold.¹⁴⁷ The court in *Pebble Beach Co.* noted that the plaintiff's golf holes were nonfunctional as there were unlimited number of alternative designs the defendant could have chosen for golf hole designs.¹⁴⁸ A director of a race in Boston would have similar options to the defendant in *Pebble Beach Co.* There are numerous streets in the Boston area that a director may choose from and the opportunities for various designs increase as a director chooses combinations of those streets. As a race director has opportunities for alternative designs for a course, or part of a course, it would likely be found that the use of Heartbreak Hill in the Boston Marathon would be nonfunctional.

While nonfunctional, Heartbreak Hill would have to be inherently distinctive or have acquired secondary meaning to qualify for trade dress protection.¹⁴⁹ It is at this juncture protection would not be awarded. Unlike the lighthouse near the Sea Pines hole in *Pebble Beach Co.* there is no distinctive building or mark to associate with Heartbreak Hill. It looks like any other road on other parts of the course and there is nothing around to serve as an "arbitrary source-identifying feature."¹⁵⁰

Additionally, Heartbreak Hill has not earned sufficient secondary meaning amongst the general public. While it is a known part of the course for those involved in the sport, the general public is not familiar with that section of the course. I had been running on Heartbreak Hill for months before learning it was part of the Boston Marathon course. The Sea Pines golf course had advertised the infringed hole in various ways and that was one of the primary ways the court was able to find secondary meaning.¹⁵¹ While looking at the BAA website there are no pictures of Heartbreak Hill, nor is it mentioned in the section of the website dedicated to information about the course itself.¹⁵² While Heartbreak Hill may be found to be nonfunctional, it would likely not qualify for trade dress protection because it is not inherently distinctive and has not obtained secondary meaning.

Heartbreak Hill may not be able to qualify for trade dress protection, but the same might not be true for the finish line of the race. The

147. *Pebble Beach Co.*, 155 F.3d 526 at 536.

148. *Id.* 155 F.3d at 538.

149. *Id.* at 536.

150. *Id.* at 540.

151. *Id.* at 541.

152. BOSTON ATHLETIC ASSOCIATION, www.baa.org (last visited Aug. 13, 2014).

finish line of the Boston Marathon is in iconic Copley Square and is near landmarks such as the Prudential Center and the Boston Public Library. Just as Heartbreak Hill would likely be found to be nonfunctional because of the numerous routes in Boston a director may choose from, the same would be true as to this area of the course.

The District Court in *Pebble Beach Co.* was able to find that Sea Pines' golf hole was inherently distinctive as the nearby lighthouse served as an "arbitrary source-identifying feature."¹⁵³ The Prudential Center and Boston Public Library, two well-known buildings, would be able to serve as arbitrary source-identifying features as those buildings have been at the site of the finish line for at least forty years. They are distinctive buildings and setting up a finish line at that spot would trigger an association with the Boston Marathon amongst the general public.

The finish line of the Boston Marathon has undoubtedly earned a secondary meaning after the terrorist attacks that took place during the race in 2013. Tamerlan Tsarnaev and his brother Dzhokhar Tsarnaev placed two homemade explosives at the site of the finish line of the marathon, killing three people and injuring more than 260.¹⁵⁴ This event received international news coverage and put the site of the attack, the finish line, into the minds of the public all over the country and the world. That area will always be associated with the terrorist attacks and the Boston Marathon itself. The court in *Pebble Beach Co.* laid out several factors to consider whether a trade dress has obtained a secondary meaning.¹⁵⁵ The amount of coverage these attacks garnered is directly related to a number of those factors including; the amount and manner of advertising, the nature of use of the mark or trade dress in newspapers and magazines, consumer-survey evidence, and direct consumer testimony. The BAA would be able to offer evidence, concerning these factors, that because of the attacks and the subsequent publicity, the general public would associate a race finish line at that site with the Boston Marathon. The finish line of the Boston Marathon would likely be found to be nonfunctional, inherently distinctive, and to have obtained secondary meaning. Therefore, it could be subject to trade dress protection.

153. *Pebble Beach Co.*, 155 F.3d at 540.

154. Michael Ray, *Boston Marathon bombing of 2013*, ENCYCLOPEDIA BRITANNICA (July 22, 2014), <http://www.britannica.com/EBchecked/topic/1924021/Boston-Marathon-bombing-of-2013>.

155. *Pebble Beach Co.*, 155 F. 3d at 541.

V. CONCLUSION

Directors of running events need to be aware of the intellectual property that is being used at their races and the value of their own intellectual property. While numerous topics have been discussed in this paper, these are only a few of the intellectual property issues that arise from marathons and other running events. These issues will become more prominent as the sport continues to grow in popularity and more technology is used to support and promote races.