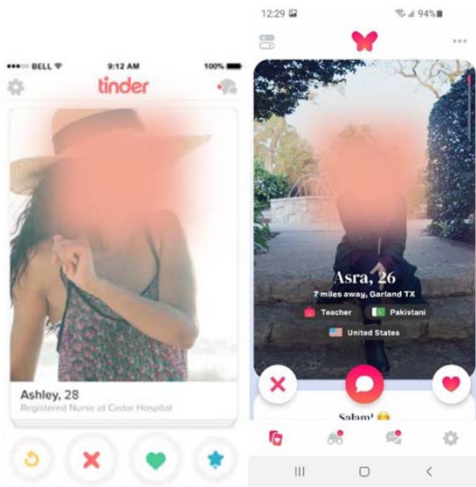
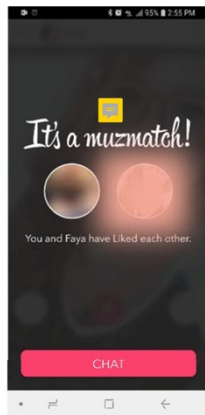
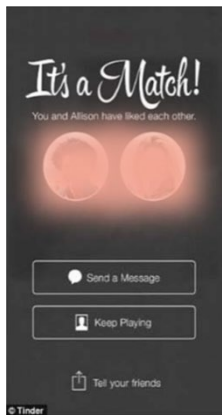


Muslim Dating App Accused of Being Tinder Copycat

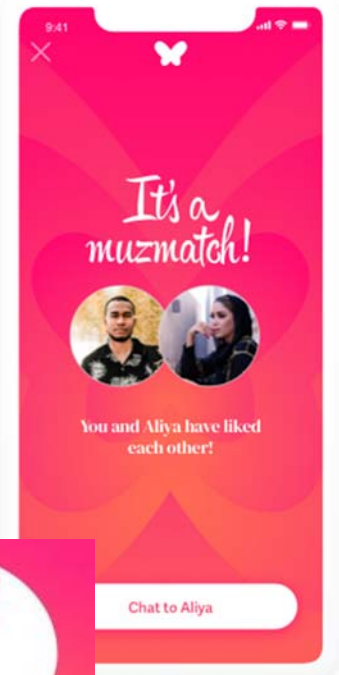


Match Group, which owns Match.com and Tinder, recently sued an online matchmaking service for Muslims based in the UK, Muzmatch, calling it a “Tinder clone”. It contends that the Tinder app is responsible for a cultural revolution in social networking and online dating. The app is famously characterized by a stack of cards containing photos of potential connections nearby. If a user is interested in the person shown it swipes right, if not it swipes left. It owns three utility patents for innovations embodied in the Tinder app, as well as trademark registrations for Match, a stylized design and Swipe. It is seeking registrations for Swipe Left and Swipe Right for use with mobile apps for dating services. It claims these phrases have become synonymous with Tinder, quoting the Oxford English Dictionary, which defines the phrases “as for use with Tinder”.

The Complaint alleges that Muzmatch is a dating app that relies on a card-stack interface containing photos of users and a mutual opt-in premise before users communicate. It quotes its founder as describing Muzmatch as “the world’s first Tinder-styled app now available for Muslims”.



Match also claims protectable trade dress in the Tinder app’s card-stack appearance and the “It’s a Match!” screen. In illustrating that the Muzmatch app is a copycat of Tinder, it compares its original “Match” screen which is nearly identical. While Muzmatch’s current screen no longer uses a grey background, it allegedly contains the salient elements of Match’s trade dress, including identical text and font. In addition, the orange/pink fade background it now uses is



strongly associated with the Tinder app and protected by its Tinder flame trademark registration.

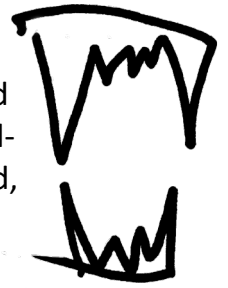
The suit contains detailed allegations of how the claims of its three patents are infringed, including the method in which Muzmatch’s servers determine the geographic location and distance between potential matches. The Complaint includes trademark and trade dress infringement, false designation of origin and trademark dilution since it contends its Match and Swipe Right marks are famous to the general public. In 2018, Match filed a similar suit against the Bumble dating app which was later settled.

Match Group, LLC v. Muzmatch, Ltd., (W.D. Tx., filed Feb., 2021)

Sneakerhead Artist Sues Puma



Brooklyn artist Christophe Roberts creates sculptures, paintings and art installations that have been widely exhibited throughout the United States in galleries, museums and at NBA Art and All-Star Weeks. He is also recognized as a sneakerhead, a term referring to those who collect and trade sneakers as a hobby and is well-known for his sculptures using sneaker shoeboxes. His unique stylized “Roar”, which he has used since 2013, serves as his artistic signature and the calling card for his brand. In the past he has collaborated with Nike to exhibit his works at its conventions. Roberts’ popularity has allowed him to grow a successful business, which includes selling t-shirts, jackets and other merchandise that prominently feature his Roar Mark.



Roar Mark

The Complaint alleges willful theft/infringement by Puma of the Roar Mark. Roberts alleges that in 2018, after hiring people who worked for him, Puma Basketball significantly integrated the Roar Mark into its marketing and merchandise. This includes merchandise prominently displayed at the Puma Hoops pop-up store in Brooklyn and shirts worn by NBA players and Jay-Z, who Roberts alleges is Creative Director at Puma. After sending a cease and desist letter in 2019, Roberts understood that Puma



would discontinue use of the Roar Mark, but it has not done so. Claims include trademark infringement and dilution and he seeks an injunction, disgorgement of profits and exemplary damages.

Roberts v. Puma North America, Inc., (S.D. N.Y. filed Mar. 25, 2021)

Second Circuit Rules Warhol's Prince Prints Not Fair Use

In 1981, while on assignment for Newsweek, photographer Goldsmith took a series of portrait photos of the musician Prince in her studio. She arranged the lighting to showcase his “chiseled bone structure” and applied additional makeup, including eyeshadow and lip gloss, to accentuate his sensuality. In 1984, Goldsmith licensed one of the photographs to Vanity Fair magazine for use as an artist reference,



Goldsmith

meaning that an artist would create an illustration based on the image. Vanity Fair commissioned Andy Warhol to create the illustration, which was published with the article about Prince, giving attribution to Goldsmith. Unbeknownst to Goldsmith, Warhol created 14 silkscreen prints and two pencil illustrations



Warhol

based on her photo known as the Prince Series. She did not learn of these works until after Prince's death in 2016. The Warhol Foundation filed a declaratory judgment of non-infringement against Goldsmith and she countersued for copyright infringement. In 2019, the district court granted summary judgment for the Foundation based on the doctrine of fair use.

On appeal, Goldsmith argued that the court's conclusion that the Prince Series works are transformative was a subjective evaluation of the underlying artistic message rather than an objective assessment of their purpose and character. The Second Circuit agreed, finding that the Prince Series are not fair use as a matter of law and also taking the unusual step of concluding that they are substantially similar to the Goldsmith photo as a matter of law. Its lengthy opinion reads like a treatise on fair use, in which it analyzes its prior fair use cases and clarifies the proper standards and how they should be applied, especially the “transformative factor”.

Warhol reproduced a photograph as a high contrast two-tone image on acetate that, after any alterations he made, was used to create the silkscreen. For sketches, he projected an image on paper and created a contoured pencil drawing around the projected image. In evaluating the four fair use factors, the district court concluded that the Prince Series was transformative because, while the Goldsmith photo portrayed him as “not a comfortable person” and a “vulnerable human being”, the Prince Series portrays him as an “iconic, larger than life figure”. In deciding whether a work is transformative, courts consider whether the new work merely supersedes the objects of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning or message. Viewing the works side-by-side, the Second Circuit concluded the Prince Series is not transformative. Warhol created this Series by



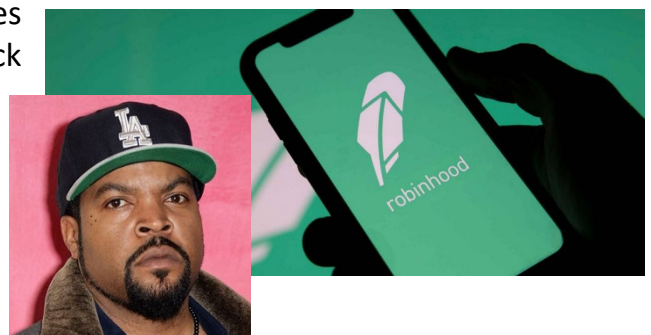
removing certain elements from the Goldsmith photo, such as depth and contrast, and embellishing the images with loud unnatural colors. Crucially, the Series retains the essential elements of the Goldsmith photo without significantly adding to or altering these elements. The Court emphasized that it is irrelevant that each Prince Series work is immediately recognized as a Warhol. “Entertaining that logic would inevitably create a celebrity-plagiarist privilege; the more established the artist and the more distinct that artist’s style, the greater leeway that artist would have to pilfer the creative labors of others.” There is little doubt that the Series reflects Andy Warhol’s talent and distinctive aesthetic. However, the question is simply whether the law permits Warhol to claim it as his own.

The amount and substantiality of use also favors Goldsmith. A comparison of the images makes clear that Warhol did not use the Goldsmith photo simply as a reference to accurately document the physical features of its subject. Instead, the Warhol images are instantly recognizable as depictions/images of the Goldsmith photo itself. The fourth factor, whether the challenged use could adversely affect the potential market for the copyrighted work, also weighs in favor of Goldsmith. Both Goldsmith and the Foundation have sought to license their depictions of Prince to magazines to accompany articles about him. Both works are illustrations of the same famous musician with the same overlapping customer base. Finally, after rejecting the fair use defense the Court held that given the degree to which Goldsmith’s work remains recognizable within Warhol’s, there can be no reasonable debate that the works are substantially similar.

The Andy Warhol Foundation For The Visual Arts, Inc. v. Goldsmith, 2021 WL 1148826 (2nd Cir., March 26, 2021)

Ice Cube Sues Robinhood Trading App

The Complaint just filed against Robinhood alleges that it used Ice Cube’s image with the caption “Check Yo Self”, which is an altered version of his signature catch phrase, in it’s blog Robinhood Snacks. The suit includes claims for misappropriation of his likeness and Lanham Act unfair competition. Ice Cube charges that Robinhood is the antithesis of everything he stands for.



Jackson v. Robinhood Markets, Inc. et al., (N.D. Ca., filed Mar. 2021)

Company Emails Show Bad Faith Intent to Mislead/Infringe



The maker of Little Trees air freshener products sued the maker of Refresh Your Car! air fresheners for infringing its *Black Ice* trademark by using the mark *Midnight Black Ice Storm* on packaging for its competing products, including vent sticks, diffusers and gel cans. After evaluating the likelihood of confusion factors, the district court granted judgment in favor of defendant. Plaintiff Car Freshner appealed and the Second Circuit reversed. It found the *Black Ice* mark inherently distinctive for use with car air fresheners and noted that it is extremely unusual for a junior user's mark to include two identical words of a senior user's mark in sequence.

Weighing heavily in favor of reversal was evidence of defendant's bad faith in adopting the mark. Internal emails of its employees are highly probative of their intent to mislead consumers. Employees instructed that the new Refresh fragrances would include a Black Ice variant, decided to have some fun and "get as close to the Black Ice name as we can". The emails stated that they wanted the customers to immediately make the connection. As the Court emphasized, "rarely does an infringement case reveal such explicit evidence of bad faith." The parties are preparing for trial.



Car-Freshner Corp. v. Energizer Holdings, Inc., et al., 980 F.3d 314 (2nd Cir. 2020)

60's Guitarist Claims Old Spice Stole His Image

Legendary guitarist Wayne Kramer sued the maker of Old Spice Guitar Solo body wash for using the image of a rock guitarist playing what looks like his Fender signature Stars and Stripes guitar. Kramer was a founding member of the 60's band MC5 known for its *Kick Out The Jams* album, and he contends he co-created the punk rock and heavy metal genres. Kramer is a prominent social activist and co-founded Jail Guitar Doors, a non-profit that donates instruments to rehabilitated incarcerated men and women. In 2011, Fender released a limited-run replica of the Stars and Stripes Wayne Kramer Stratocaster.



Kramer alleges the design of the body wash was clearly inspired by his performances. The suit contends that the Old Spice image implies that Kramer endorses its Guitar Solo body wash and includes claims for false endorsement under the Lanham Act and violation of his right of publicity. Kramer says he is appalled by this use of his likeness because it creates a perception of hypocrisy in the public eye and irreparably undermines the important international social work that has been his life's mission. This case recently settled, but the terms are confidential.

Kramer v. The Proctor & Gamble Co., (W.D.Ca., filed Nov. 24, 2020)

Street Artist Futura Says North Face Stole His Atom Design

The graffiti artist known as Futura began his career spray painting abstract futuristic designs on subway cars in the 70's, and his works now hang in galleries throughout the world as part of the "Subway School" of artists. Over the years Futura has become



known for a signature element that appears repeatedly in his work, a stylized depiction of an atom. He has often used the atom design as a logo for consumer products he offers, including apparel. In an effort to associate themselves with Futura's brand of urban cool, companies like Nike, Uniqlo, the New York Mets and

Yankees and even The North Face have paid to collaborate with him.



Futura alleges that in 2019, without his consent, North Face began using his atom design as a logo for a new line of its apparel and fabric technology. In addition to using the atom design, North Face also calls its new line FUTURELIGHT to purposely associate the line with him. The artist sued The



North Face, contending that the combination of the atom design and the name FUTURELIGHT falsely creates the perception that he is associated with its product line. He alleges that while North Face had previously made apparel in collaboration with Futura, it made no attempt to obtain authorization from him or

even inform him before extensively using his atom logo in a \$20 million ad campaign. Claims include false designation of origin and unfair competition under the Lanham Act but not copyright infringement. While Futura contends he owns the copyright rights to the design he does not have a copyright registration, which is required to file a copyright infringement action.

McGurr v. The North Face Apparel Corp., (C.D. Ca., filed Jan., 2021)

Yakama Nation Sues Vineyards for Appropriating Traditional Language



The Yakama Nation General Council sued a number of vineyards/wineries for trademark infringement and violation of the Indian Arts and Crafts Act, among other claims, for using names from the Yakama National traditional language. Some of the labels used the tribe's name, Yakama, the Yakama leader and treaty signer Chief Kamiakin and depictions of Native Americans on horseback. Tribal names such as Kamiakin are hereditary property that can only be used by members of the deceased's family and are bequeathed through ceremony from generation to generation.

The Complaint contends that use of the names on wine bottles constitutes cultural appropriation and gives a false impression that the Tribe endorses and approves these products. In fact, Kamiakin signed the 1855 Yakama Treaty, which banned alcohol from the reservation. It alleges that "plaintiffs have suffered shock and embarrassment and emotional distress at the use of this name on a wine bottle in that it is contrary to what Kamiakin believed in, plays into the stereotype of approval of use of alcohol by Native people and is contrary to the teachings plaintiffs try to convey to their future generations". A number of the defendants, including Sheridan and Dineen Vineyards, have agreed to stop using the names.



The Yakama National Tribal Council v. Sheridan Vineyards, et al. (E.D. Wa., January 21, 2021)

Ninth Circuit Reverses \$1.8 Billion Lanham Act Award

Morrison Knudsen Corp was a world-renowned construction and engineering firm involved in projects such as the Hoover Dam and the San Francisco Bay Bridge. It was later acquired by AECOM Energy. In 2017, it sued another company using an identical name contending defendants concocted an elaborate scheme to pass themselves off as Morrison Knudsen, including creating a website in which they falsely claimed its previous projects as their own. AECOM obtained summary judgment on its false advertising, false designation or origin and cyberpiracy claims. The court entered an award of \$1.8 billion based on press releases because defendants did not offer evidence disputing the calculation and failed to comply with discovery.



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The Ninth Circuit reversed. The press releases announced that the EPA and others had awarded the "fake" Morrison Knudsen three construction contracts totaling \$1.8 billion. While a plaintiff is entitled to disgorgement of defendant's profits, it is plaintiff's burden to show with reasonable certainty defendant's gross sales from the infringing activity. The Court held that the press releases merely showed defendants had been awarded contracts, not whether they were completed or received any payments under the contracts. In remanding the case for further calculations, the panel noted that since defendants had not provided any reliable evidence of sales or profits, the district court is not precluded from issuing sanctions.

AECOM Energy And Construction, Inc. v. Morrison Knudsen Corp., 2020 WL 1117780 (9th Cir., March 24, 2021)

VARA Claim is Cheesy

Artist Cosimo Cavallaro began creating an artwork called “Cheese Wall” near the U.S./Mexican border. After the work reached almost 70 feet it was allegedly destroyed by federal contractors constructing an actual border wall. The artist’s suit claims violation of the Visual Artists Rights Act “(VARA)”. According to the Complaint, Cavallaro often makes sculptures in perishable materials to comment on the absurdity of effort, waste and decay. He leased private property near the border and began construction of the piece made entirely out of bricks of Cotija cheese, which he made himself from scratch. He contends that federal contractors hired to fortify the border wall intentionally destroyed his work, causing harm to his reputation and significant lost profits.



Cavallaro intended his work to encourage people to think of the border wall differently by considering the waste inherent in building any wall. He also planned to create and sell bronze casts of the cheese blocks in galleries around the world. Other perishable works he created attracted critical acclaim, including covering supermodel Twiggy in melted cheese and creating a large sculpture of Jesus made out of chocolate, which provoked outrage from Catholics. The parties are preparing for trial.

VARA claims have been used successfully by graffiti artists in recent years, including obtaining a \$6.75 million judgment against a Brooklyn warehouse owner who painted over street art on the side of his building. The artists in that case also obtained \$2 million in attorneys’ fees. (See *5Pointz* case in our April, 2020 Intellectual Property Alert).

Cavallaro v. SLSCO, Ltd., (S.D. Ca., filed Nov. 2020)

Trademark Modernization Act of 2020 (TMA)



The TMA is now law and includes some important changes for trademark owners. First, it restores the presumption of irreparable harm once a trademark owner shows infringement, which is required to obtain injunctive relief. This had always been the law, but in 2006 the Supreme Court in *eBay Inc. v. Merc. Exchange LLC* ruled that patent owners were not automatically entitled to this presumption. Since *eBay*, federal courts have been split on whether irreparable harm is presumed in trademark cases or they must apply the strict equitable factors outlined in *eBay*.

The Act also establishes two ways to challenge federal registrations due to non-use: expungement and reexamination. A petition for expungement contends that the trademark was never used in U.S. commerce in connection with the listed goods or services. A reexamination petition contends that the trademark was not used in commerce prior to the registration date. The purpose of these new vehicles is to remove “deadwood” registrations that are not in use. It has become increasingly difficult for companies to find available trademarks. There are many registrations that may be fraudulent, including a huge increase in trademark applications filed by Chinese companies, along with the use of fake specimens to obtain registrations. The Act also shortens the time for applicants to respond to PTO refusals. Respondents previously had six months but the examiners now have discretion to shorten this to 60 days.

Protecting Lawful Streaming Act

This Act only applies to a service designed for streaming without the copyright owner’s permission and whose primary purpose is unauthorized streaming. The person or entity must act willfully “for purposes of commercial advantage or private financial gain”. A first offender may face a fine or imprisonment up to 3 years or both. Repeat offenders can be imprisoned up to 10 years and fined. The purpose of the Act is to penalize large scale illicit streaming. The Act will not affect the activities of ordinary internet users since it does not apply to individuals who use pirate streaming services.





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Thank you for reading!

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