



# “EVERYONE IS ENTITLED TO INTELLECTUAL PROPERTY PROTECTION”

BY M. KELLY TILLERY

**W**hen I was a young associate with a large Philadelphia law firm in 1980, I got my first secretary. It was the luxury era of IBM Selectric typewriters in which each lawyer, including associates, had his/her own secretary. Before I met her, the office manager alerted me that she looked just like Sophia Loren. And she did. Turns out that she was also an outstanding secretary and eventually, a good friend. But she had a past which she sheepishly disclosed to me one day almost out of the blue. She had worked for years for a then elderly, prominent Philadelphia lawyer who I had encountered on occasion. She was his typist for his secret “hobby,” writing steamy, pornographic novels and stories. She was amused by my then wild and carefree yuppie bachelor life in Center City, but her past explained why she blushed at nothing I told her.

I was bemused but thought no more of this curious experience of my new assistant until a few years later, by which time I had started my own firm with two partners and my secretary. I got a call from a gentleman who said he was an advisor to many businesses. When I asked what kind, he simply said, “adult.” My secretary laughed when told and said her experience might be very helpful to these new clients.

So in my first foray into the world of “adult” businesses, I was asked to represent the “Adult Entertainment Coalition,” a group of Pennsylvania businesses who sought to challenge a new law that restricted the manner in which adult films could be shown. The Coalition’s advisor had come to me as a result of seeing press reports about some of my victories in intellectual property

cases on behalf of famous musical artists. I guess he thought if I could protect the intellectual property of Madonna, I could do the same for Marilyn Chambers. Well, I did once represent Barenaked Ladies.

Anyway, I was somewhat leery and knew my more conservative partners would be concerned, so I asked for a huge retainer. To my surprise and delight, a check appeared the next morning. Although I tried mightily to craft a viable theory under Federal Copyright Law to undermine this Puritanical Pennsylvania law, it was simply not possible. Cognizant of the admonition of J. Paul Getty to his lawyers, “Don’t tell me I can’t do what I want to do. Tell me how I can do what I want to do,” I hesitated to tell my new clients that I could not accomplish what they wanted me



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to. Businessmen so often see lawyers as impediments, naysayers. But, as we sometimes must, I said no. So I sent the Coalition my opinion letter and a firm check for more than half of the retainer which I had not had to use.

My new clients were stunned. Not that a lawyer had told them they could not do what they wanted to do (and without a “how to” either), but that a lawyer would return any part of a retainer, much less more than half.

This led to a plethora of more clients and matters in almost every aspect of the “adult industry.” Only recently, that same Coalition advisor observed, in connection with a new case, “Win, lose or draw; you are still the best. I am certain of this. The first time I met you, you didn’t tell me what I wanted to hear but I knew what you told me was correct and this is more important than appeasing someone and giving them false hope.”

While I had represented some clients in the film industry such as Universal Studios, Steven Spielberg’s Amblin Entertainment and George Lucas’s Lucas Films, I had never handled a matter involving an adult, X-rated film. But since I had lots of experience successfully pursuing counterfeiters in a wide variety of industries, I guess it was natural for The Mitchell Brothers of San Francisco, producers of the Marilyn Chambers (the original Ivory Snow girl) “classic,” “Behind The Green Door,” to turn to me for help when their film was being widely counterfeited.

In this new era of Internet porn, I was shocked to hear that anyone was still buying an X-rated movie made in 1972, much less bothering to counterfeit it. I was soon educated by those in the trenches of this unique and interesting industry. Seems that in the pantheon

of porn, there are four “classic” films – “Deep Throat” (1972), “Behind The Green Door” (1972), “Debbie Does Dallas” (1978) and “The Devil In Miss Jones” (1973), all which still sell (and are counterfeited) briskly.

After several filings and an equal number of embarrassed federal judges, I made the world safe for the “classic” film “Behind The Green Door” and, of course, also the inevitable “Behind The Green Door – The Sequel” (1986). My mother was so proud.

The adult industry also includes the manufacturing, distribution, advertising and sale of a wide variety of devices and substances, many of which require/invite intellectual property protection, whether patent, copyright, trademark, trade dress and/or trade secret. And I have had cases involving all. Many such items, previously available only at the likes of Doc Johnson’s, now appear on the shelves of your neighborhood Rite Aid, albeit discretely near the pharmacist. Some are even advertised on network TV in highly suggestive ads. We have come so far.

A client once invited me to a “trade show” at his enormous warehouse in a God-forsaken, urban wasteland of a former industrial neighborhood. I thought I had seen it all. Turns out I had no clue. I still cannot conceive of (and do not want to think about) what one does with/to most of what I had seen.

And I met many actual porn “stars.” Let’s just say that sometimes you do not really want what you think you do. Sometimes it is better that a fantasy remain a fantasy.

My legal skills were not always utilized on behalf of adult businesses, sometimes against them. While the Philadelphia Police regularly arrest street walkers, inexplicably the City

Paper and The Philadelphia Weekly include page after page of ads for prostitutes and “massage parlors.”

A few years ago, I read in one of those papers that legendary cellist Yo Yo Ma was to appear the next day at the Academy of Music. A few pages later, there was an ad, with a picture of a comely, scantily-clad young Asian woman, for the “Yo Yo Ma Spa.”

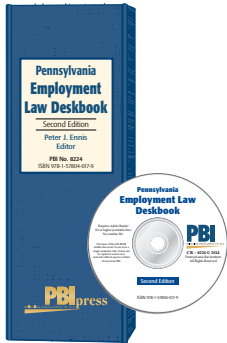
Since Mr. Ma earns a rather handsome living teasing angelic notes from the depths of his 1712 Stradivarius, I thought it unlikely that he had branched out into massage parlors or that he had licensed his name to these “masseuruses.” So, on the evening he appeared at The Academy, I had a letter hand delivered to him alerting him to what appeared to be an unauthorized use of his famous name.

Sure enough, the next issue of that urban paper included no further ad for the “Yo Yo Ma Spa” and shortly thereafter, I received a letter of thanks from Mr. Ma’s management who obviously had taken measures to stop the illegal use of his name.

One of the fun aspects of IP law is that it presents frequent opportunities to seek or defend against motions for preliminary injunctions. There is nothing like the exhilaration of basically preparing for and trying a case in just a few weeks or sometimes days. Most fun you can have with your clothes on! Oftentimes, the injunction card is played as a clever gambit to force resolution of an otherwise vanilla commercial dispute by getting the matter before a judge quickly and ahead of all others. Such as it was for my licensee client in a seemingly mundane licensing dispute over royalty payments and scope of use under a license. What made it unusual was that the license was for the sale

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of “reproductions” of male porn stars’ “equipment.”

The licensor sued for copyright infringement claiming it owned copyright rights in and to each of these “works of art” and had even registered them with the Copyright Office. Well, as criminal defense lawyers say that prosecutors can get a grand jury to indict a ham sandwich, IP lawyers know that lots of things that are not copyrightable get through the Copyright Office.

I had learned in 1978 from Professor Paul Bender at Penn Law School that in order to be copyrightable, a work had to be “an original work of authorship” and it could not be functional. So, I argued that these “works” were merely slavish copies/castings of human body parts and thus, not original. And, that if they had any “author,” it was either God or the actors’ parents, not the Licensor. Further, these items were clearly “functional” as used for sexual gratification, not works of art.

My opponent, a rather stylish gent, bearing a large gym bag filled with “exhibits,” creatively and amazingly, with a straight face, argued that his client’s “works” were indeed “works of art” as they constituted “an homage to the male phallus” – a phrase I never imagined I would hear, must less in a Federal courtroom. As titters rolled through the courtroom filled with observers from a local college, I thought of the scene from Stanley Kubrick’s “A Clockwork Orange” wherein Malcolm MacDowell assaults a homeowner with a huge white sculpture, more arguably such an “homage.”

The Judge was less amused or distracted. She was a middle-aged, woman and had once been an Oakland, Calif. police officer, so I figured she had seen everything. Non-plussed, she asked my foppish opponent to bring forth his

“exhibits” so she could examine these “works of art” for herself. As he eagerly delivered several packaged items to the bench of this Article III Jurist, I stood by quietly knowing my work here was done. A good lawyer knows when to stand down.

The judge closely examined several “exhibits” paying particular attention to the “instructions” on the packaging. She turned to counsel and inquired as to why a work of art had “instructions” and was “dishwasher safe.” The licensor’s counsel reluctantly acknowledged that his art “homage” could also be used for other purposes. Case closed. Motion denied. *ConWest Resources, Inc. v. Playtime Novelties, Inc.*, 2006 WL 3346226, 2006 U.S. Dist. LEXIS 85461, 84 U.S.P.Q. 2d 1019 (N.D. CA. 11/17/06) - a reported case which copyright law legend William Patry observed “should immediately make its way into copyright casebooks.”

Media reports say that Viagra® is the nation’s #1 recreational drug. Thus, it is no surprise that enterprising businessmen would seek to counterfeit it and/or replicate its effects using a non-drug dietary supplement, not subject to the rigors of the FDA drug approval process. I recently encountered the latter in a preliminary injunction motion. The owner of a federally registered trademark for “STIFF NIGHTS®,” for a “male sexual enhancement herbal supplement,” one Erb Avore (yes, his real name) sought to stop a couple of my clients from selling product they had purchased in the marketplace claiming it was counterfeit.

As these things are wont to occur, the hefty filings were dumped on me by my clients about 48 hours before the Preliminary Injunction Hearing. Scrambling to investigate the facts and law, we found that plaintiff had not

sold any product in two years because his supplier was under indictment for allegedly including an analogue of the active ingredient in Viagra® in his product and the plaintiff’s principal was an indicted co-conspirator. And, it turned out the papers filed included little, if any, evidence of wrong doing on the part of my clients.

So, I first demanded that plaintiff produce the affiant to testify live and be cross-examined at the hearing. And I contacted the U.S. Attorney handling the case who was very interested to know that a man he was still investigating might be testifying and being crossed in court in a civil case on the very topics pertinent to his investigation. Needless to say, the affiant did not show, plaintiff could not prove its case and the motion was denied. More than one way to skin a cat. Or make the world safe for STIFF NIGHTS.

Comment 5 to Section 1.2 of the Pennsylvania Rules of Professional Responsibility provides that, “Legal representation should not be denied to people who are unable to afford legal services, or whose cause is controversial or the subject of popular disapproval. By the same token, representing a client does not constitute approval of the client’s view or activities.” As I like to say, everyone is entitled to intellectual property protection.

While some may not approve of the adult industry, it is, like all other industries, including cigarettes, guns, and alcohol, entitled to intellectual property protection. ■

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