5-1-1993

Trademark Law: Victor Decosta v. Viacom International, Inc., No. 91-2211, 1992 U.S. App. LEXIS 32712 (1st Cir. Dec. 17, 1992)

registered. Plaintiff claims it is allowed statutory protection under the doctrine of limited publication D.C.I. also argues that its federal claim is not barred by the statute of limitations because it "relates back" to the original state complaint filed. Pardini cross-appealed, arguing that the trial court erred in denying attorney's fees.

Held: D.C.I.'s distribution was a general, rather than limited publication, and was therefore divested of statutory protection. The doctrine of limited publication applies only if two requirements are met: (1) the work may only be distributed to a select group of people; and (2) the work may only be distributed for a limited purpose. D.C.I. did not meet these requirements. Next, the court held that D.C.I.'s federal claim was barred by the statute of limitations as it did not arise out of the state claim and was a separate cause of action. Finally, the court stated that as D.C.I.'s action was not frivolous or brought in bad faith, Pardini should not receive attorney's fees. *Affirmed.*

J.H.

PATENT LAW

IN RE BRADLEY C. CARLSON, No. 92-1248, 1992 U.S. App. LEXIS 32675 (Fed. Cir. Dec. 16, 1992).

Bradley Carlson appeals a decision of the U.S. Patent and Trademark Office which affirmed the examiner's rejection of a reexamination of a claim holding Carlson's design as unpatentable. This case is based on a design protected by a German Geschmacksmuster, which may cause Carlson's design to be obvious. Carlson argues that the foreign patent, the German Geschmacksmuster, may only serve as a prior art if it discloses its invention in an accessible manner. Carlson further argues that even if the Geschmacksmuster is prior art, his design is not obvious as his design is symmetrical and the other is asymmetrical.

Held: The court held that since the Geschmacksmuster fully discloses the design upon which German law conferred exclusive rights, it constitutes prior art. As to the obviousness question, the court held that where products are designed asymmetrically, a symmetrical design would be obvious to one of ordinary skill, and therefore obvious and unpatentable. *Affirmed.*

J.H.

TRADEMARK LAW

VICTOR DECOSTA V. VIACOM INTERNATIONAL, INC., No. 91-2211,

1992 U.S. App. LEXIS 32712 (1st Cir. Dec. 17, 1992).

Holder of re-run rights for a certain television series appealed jury verdict against it for trademark infringement with respect to the depiction of a certain character in the program. Plaintiff Victor DeCosta, since 1947, had held himself out to the public at rodeos, hospitals, and charitable events as a black-clad cowboy named "Paladin." He had previously brought suit against the CBS television network alleging trademark infringement with respect to the CBS series "Paladin." The series ran between 1957 and 1964 and featured a black-clad cowboy who appeared and behaved very similarly to plaintiff's character, and who was also named "Paladin." In that case, the court held that plaintiff had failed to prove a trademark violation. Subsequent to that decision, plaintiff registered his mark. Here, plaintiff brought a trademark infringement action against the company which holds the re-run rights to the original "Paladin" series.

Held: The success of plaintiff's suit depends upon the relitigation of issues that were already decided against him in his previous action against CBS. Therefore, the doctrine of "collateral estoppel" bars plaintiff's new claim. The fact of trademark registration is not a relevant legal change which transforms the previously litigated issues into new issues, thus overcoming the doctrine of collateral estoppel. Nor does registration alone significantly affect plaintiff's ability to successfully prove the critical element of public confusion with respect to competitive uses of the same mark. Moreover, the decisions relied on by plaintiff representing a change in the law regarding the theory of "reverse confusion" were decided incorrectly and are therefore not to be considered. *Reversed.*

J.B.

COPYRIGHT LAW

PAUL OLSEN v. R.J. REYNOLDS TOBACCO CO., No. 91-55677, 1992 U.S. App. LEXIS 34033 (9th Cir. Dec. 18, 1992).

Paul Olsen, plaintiff, appeals summary judgment granted in favor of the defendant, R.J. Reynolds Tobacco Co., in his action for copyright infringement of his photocomposition of a logo designed by another company. Olsen was provided with the final logo in order to prepare a photocomposition of it. He signed a contract releasing his copyright interest in the logo to R.J. Reynolds, whose identity he did not know but was told that he could not learn of. Olsen argues that the contract is not a transfer of his copyright interest because the agreement transfers his interest in