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Copyright Law: Paul Olsen v. R.J. Reynolds  
Tobacco Co., No. 91-55677, 1992 U.S. App. LEXIS  
34033 (9th Cir. Dec. 18, 1992)

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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

“ideas and inventions” which are not copyrightable. Olsen also contends that the transfer was conducted by fraudulent means as he did not know the identity of the user of the logo.

*Held:* The court held that as Olsen’s work is a photocomposition of a logo, it is the expression of ideas which is copyrightable although ideas themselves are not. The contract in this case shows Olsen’s intent to transfer all interest in his work, including the copyright interest. The court also held that this was not done fraudulently as Olsen contracted with full knowledge that the identity of the client would not be disclosed. *Affirmed.*

J.H.

## COPYRIGHT AND TRADEMARK INFRINGEMENT

SEGA ENTERPRISES LTD. v. ACCOLADE, No. 92-15655, 1993 U.S. App. LEXIS 78 (9th Cir. Jan. 6, 1993).

*Accolade appealed the district court’s grant of a preliminary injunction in favor of Sega, a manufacturer of computer video game programs, for copyright and trademark infringement. Accolade used a two-step process to render its video games compatible with the Genesis console, a video system developed and marketed by Sega. First, Accolade reverse-engineered Sega’s video game programs by transforming the object code into source code, and second, created its own games for the Genesis. The most recent version of the Genesis console, Genesis III, incorporates the trademark security system (TMSS) initialization code which enables video game programs to operate on Genesis III, and also prompts a screen display of the Sega trademark. Accolade again reverse-engineered, and in one of its newly released games did not place the TMSS initialization code at the correct location in the program.*

*Held:* Disassembly of a copyrighted object code is, as a matter of law, a fair use of the copyrighted work if such disassembly provides the only means of access to those elements of the code that are not protected by copyright, and the copier has a legitimate reason for seeking such access. Sega’s use of the TMSS that triggered the display of its registered trademark did not constitute trademark infringement where the trademark owner made a deliberate decision to include the code in the console device so as to limit general access, but doing so resulted in false labeling. Accolade desired only to make its video game compatible with the Genesis III console, and there is no known feasible alternate method of gaining access. *Affirmed in part; Reversed in part; and Remanded.*

H.C.