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F. F. Scott Kieff

Robert G. Kramer

Robert M. Kunstadt

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IT'S YOUR TURN, BUT IT'S MY MOVE: INTELLECTUAL PROPERTY PROTECTION FOR SPORTS "MOVES"

F. Scott Kieff, Robert G. Kramer & Robert M. Kunstadt[†]

PROLOGUE

The present volume is devoted to a symposium on Shifting Strategies in Patent Law, including a panel featuring one of the present authors that focused on so-called non-practicing entities. In modern patent parlance, a non-practicing entity is a patent owner who happens not to be in the business of making, using, or selling the patented subject matter, but who still subscribes mysteriously (to some) to the view that it may enjoy the statutory right to exclude others from making, using, or selling that subject matter.[1] This unpublished paper is being dusted off for inclusion in these proceedings because its message is only becoming increasingly relevant to the narrow topic of the panel and conference, as well as the broader themes in policy debates about patents today.

The playing and watching of sports are associated with a vast array of business activities. Billions of dollars are involved, often due to a range of readily identifiable intellectual property (IP) assets embodied in logos, shows, and equipment. But for many, the notion of IP rights in the actual moves that athletes make is simply a non-starter.

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† At the time this article was written, F. Scott Kieff was an associate in the New York office of the law firm of Pennie & Edmonds, Robert G. Kramer was an associate in the firm's Washington DC office, and Robert M. Kunstadt was a partner in the firm's New York office. The authors gratefully acknowledge the support of their former colleagues in the Pennie & Edmonds firm, especially former Senior Partner S. Leslie Misrock, whose wonderfully creative insight inspired playful efforts such as this article. Presently, Robert G. Kramer and Robert M. Kunstadt are practicing law in California and New York, respectively, and F. Scott Kieff is Professor at Washington University School of Law and School of Medicine Department of Neurosurgery and Senior Fellow at Stanford University's Hoover Institution on War, Revolution, and Peace. This work is part of the Hoover Task Force on Property Rights, Freedom, and Prosperity, which studies the philosophical, historical, legal, and economic foundations of property rights, as well as the Hoover Project on Commercializing Innovation, which studies the law, economics, and politics of innovation and which is available on-line at www.innovation.hoover.org. Correspondence may be sent to fskieff.91@alum.mit.edu.

1. *See* 35 U.S.C. § 154 (2006).

This paper argues that the use of IP rights for sports moves may be something well within positive law. For example, even under the new *Bilski* test for patentability, which focuses on physical transformation,[2] a winning sports move that launches a player farther or faster than her opponents would easily be seen as patentable subject matter. But regardless of positive law relevance, the central normative lesson is that when these rights are meaningfully enforced, they give a seat at the commercial sports bargaining table to a much broader range of talent than those who exhibit the utmost in physical prowess.

In simple terms, the use of IP rights in sports gives a fair shake to those who do not practice sport so well–either by choice or by dint of physical challenge: the grammar school version of today's non-practicing entities.

When this paper was written in 1996, a redacted version was published as "A New Hook for IP Practice–Intellectual Property Protection for Sports Moves."[3] The concepts outlined there sparked a great deal of commentary in the popular press as well as in the academic journals and law reviews,[4] including a spirited critique by Robin Jacob, then a Justice and now a Lord Justice at the Royal Courts of Justice in London, England, who at least agreed that the point is "not absurd–legally speaking."[5] In the hope of empowering the reader to judge the merits and demerits, and also perhaps to entertain, the unpublished paper is set forth here essentially as originally drafted.

INTRODUCTION

In 1996, the Pennie & Edmonds ski team was a sponsor of the 1996 Olympic Challenge Race in Stowe, Vermont, held to benefit the U.S. Olympic Team. As the only skiers from an intellectual property law firm, we fielded an intriguing question from a reporter at Vermont radio station KSNO: Is it possible to get exclusive rights for the "moves" used in skiing or other sporting events?

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2. *See In re* Bilski, 545 F.3d 943, 961 (Fed. Cir. 2008) (en banc).

3. Robert M. Kunstadt, F. Scott Kieff & Robert G. Kramer, *A New Hook for IP Practice–Intellectual Property Protection for Sports Moves*, NAT'L L.J., May 20, 1996, at C1.

4. *See, e.g.*, Eric S. Maurer, *An Economic Justification for a Broad Interpretation of Patentable Subject Matter*, 95 NW. U. L. R. 1057 (2001); Richard B. Schmitt, *Effort is Under Way to Put New Meaning on Moves in Sports*, WALL ST. J., May 10, 1996, at B12.

5. Robin Jacob, *Industrial Property–Industry's Enemy*, INTELL. PROP. Q., 3–15 (1997).

On its face, the question seemed innocuous and easy to answer. Yet, upon closer inspection, it became clear that a thorough analysis would be required.

At least three forms of intellectual property protection might be used to secure rights in sports moves. Patent protection might be considered for moves that impart a useful result, such as faster races or longer jumps.[6] Copyright protection might be available for moves that are creative, just as copyright may subsist in the choreography of a dance.[7] Trademark or service mark protection might be available for moves that come to indicate a unique source of goods or services.[8]

Each of these forms of protection is discussed in turn below. Each might be legally appropriate in its own way, and yet each might offend the norms of a traditional sports enthusiast. As suggested in the following hypothetical story, sports today are more than mere recreation; they have become a big business. Modern sports involve important creative and financial concerns. Sporting events serve as a form of entertainment. Countless products and services are promoted by sporting events or sports figures, and entire industries exist to sell goods and services at sporting events or for use by sports participants.[9] Countless people are employed by athletes, teams, coaching staffs, franchises, stadiums, vendors, manufacturers, advertisers, and networks. Each of the players in this big business game demands an efficient system for establishing and exploiting ownership of the goods and services in this market.[10] Intellectual property protection can help to meet this demand.

A FUTURISTIC STORY OF OLYMPIC PROPORTIONS

Imagine the scene at a future Olympics: the athletes are watching one another, the fans are watching the athletes, the sponsors are

6. *See* Peter Lee, *The Evolution of Intellectual Infrastructure*, 83 WASH. L. REV. 39, 53 (2008).

7. *See id.* at 52-53.

8. *See id.* at 52.

9. *See* SportsBusinessJournal.com, About the Sports Business Industry, http://www.sportsbusinessjournal.com/index.cfm?fuseaction=page.feature&featureId=43 (last visited June 12, 2009).

10. Each of the players in this vast market benefits from the efficiency of fixed property rights in the fuel that drives the market transactions. *See* R. H. Coase, *The Problem of Social Cost*, 3 J.L. & ECON. 1, 19 (1960) (describing the importance of rules for fixing the initial allocation of resources over which parties can then bargain in order to increase joint profits). A key element of that fuel should be intellectual property; and patents, copyrights and trademarks may provide the best tools for securing those rights.

watching the fans, and the lawyers are watching them all. At the center of attention stand two Olympians–not Dan and Dave this time–but Cain and Abel, head-to-head in competition, each poised and ready to deploy one of his protected moves.

The event is about to begin. Even from the distance of the helo-cam, Abel is easily recognized. Loved for his charisma and panache, Abel is recognized by his "Abel-ist" move well before his name is noticed on the bottom of the screen. The sponsors love Abel because the fans love Abel. The fans sit glued to the TV screen enduring commercials and foregoing bathroom breaks just to watch the beautiful choreography of Abel's move. In the past, cameras would not record the "Abel-ist" move because it was only a "follow-through," considered entirely irrelevant to his statistical performance because it would unfold after he had crossed the finish line. The camera operators, however, quickly learned that a few seconds of an "Abel-ist" move would capture an audience for almost the entire hour that it took the event to unfold.

It's Cain's turn now. He is a powerful athlete and inventive as well, often pioneering new methods for practicing his events. Cain, too, has fans and sponsors, including equipment manufacturers who flock to his door. Cain can make even last year's equipment perform top-notch, and he makes quality equipment work like magic, taking his body and the sponsor's equipment to new heights, new lengths, and new speeds. This year is no different, and Cain's radical move has worked: Cain went higher, farther, and faster, leading most marketers to expect a similar increase in sales of the products he used.

The instant replays run several times. Cameras from each angle have captured the moments and the viewers watch the replays in "slow-mo." The fans think "Hey, I could do that, and then I, too, would be a champion–just like Cain." The coaches think, "Hey, I could certainly teach that at my school next season." The other athletes think, "Hey, we can copy both Cain and Abel, then we will do well and look good, too." This is when lawyers spoil the fun: "There can be no copying because these moves are protected intellectual property."

PATENTS–FOR THE INVENTIVE JOCK

The owner of a patented product or process can prevent anyone from making, using, offering for sale, or selling the patented

invention for the entire term of the patent.[11] Neither innocent copying nor independent origination of a patented invention will provide a defense to patent infringement.[12] While the protection afforded by patents is very strong, it is also short in comparison to the protection that is available for copyrights and trademarks. In general, patents last for only seventeen years.[13]

According to the pertinent statute, "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."[14] This one sentence, studded with legal catchwords, sets forth the requirements for patentability. All patentable inventions must be new.[15] They also must be non-obvious[16]–and "obvious" is a legal buzzword with enough interpretive baggage to fill the team bus.[17] In addition, the specification of a patent application (and hence the final, printed patent) must

> contain a written description of the invention, and of the manner and process of using it, in such full, clear, concise, and exact terms as to enable a person skilled in the art to which [the invention]

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11. 35 U.S.C. § 271(a) (2006).

12. *Id.* Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 477-78 (1974) ("If an invention meets the rigorous statutory tests for the issuance of a patent, the patent is granted, for a period of 17 years . . . . This protection goes not only to copying the subject matter, . . . but also to independent creation."). *See also* Michelle Armond, *Introducing the Defense of Independent Invention to Motions for Preliminary Injunctions in Patent Infringement Lawsuits*, 91 CAL. L. REV. 117, 147 (2003); F. Scott Kieff, *Property Rights and Property Rules for Commercializing Inventions*, 85 MINN. L. REV. 697, 736 (2001); Stephen M. Maurer & Suzanne Scotchmer, *The Independent Invention Defence in Intellectual Property*, 69 ECONOMICA 535 (2002).

13. 35 U.S.C. § 154(a)(2) (2006); 35 U.S.C. § 154(a)(2) (1994). All patents arising out of applications that were filed before June 8, 1995 have a patent term that spans seventeen years from the issue date of the patent. Patents arising out of applications that were filed on or after June 8, 1995 have a patent term that begins on the date the patent issues, but lasts twenty years measured from the earliest claimed application filing date. The average term for these more recent applications will remain seventeen years because for most applications, there is an average of three years between filing and issuance. However, if the application claims the benefit of a substantially earlier filing date (to ante-date certain prior art, for example), then the patent term may be much shorter. *See* Merck & Co., Inc. v. Kessler, 80 F.3d 1543, 1546-48 (Fed. Cir. 1996).

14. 35 U.S.C. § 101 (2006).

15. 35 U.S.C. § 102 (2006).

16. 35 U.S.C. § 103 (2006).

17. The legal test for obviousness was first articulated by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1965).

> pertains . . . to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.[18]

This means that the inventor must (1) describe the invention adequately to give notice of that which the inventor regards as the invention, (2) effectively teach the reader to make and use the invention, and (3) provide the best way to use the invention.

Let's assume (realistically) that Cain's move can be described in a way that satisfies all these requirements. However, there remains the issue of whether Cain's move will satisfy a threshold element of patentability: it must fall within at least one of the three statutory classes of patentable subject matter–processes, machines, or compositions of matter. The Supreme Court in *Chakrabarty*[19] interpreted these statutory categories expansively to "include anything under the sun that is made by man."[20] Yet, while expansive, these categories do not encompass everything. For example, the Supreme Court has also reminded that laws of nature are not patentable subject matter. So, while Einstein might have been able to patent a method for converting mass into energy, his law $E=mc^2$, in and of itself, is not patentable.[21]

It is common for sporting good companies to obtain patent protection for equipment used in sports. A well-known example is Howard Head's Patent No. 3,999,756 on the PRINCE "oversize" tennis racket.[22] Numerous patents exist on golf balls.[23] An improved, easy-to-set sail can be patented (Figure 1).[24] The same is true of ski equipment, such as ski boots (Figure 2), e.g., Patent No. 5,269,079 to Kunstadt, Figure 2, and Salomon's Patent No. 4,593,483.[25]

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18. 35 U.S.C. § 112 (2006).

19. Diamond v. Chakrabarty, 447 U.S. 303 (1980).

20. *Id.* at 309 (quoting S. REP. NO. 82-1979, at 5 (1952) and H.R. REP. NO. 1923, at 6 (1952)).

21. Diamond v. Diehr, 450 U.S. 175, 185-91 (1981).

22. Tennis Racket, U.S. Patent No. 3,999,756 (filed Sept. 10, 1975).

23. *See, e.g.*, Polyurea Composition Suitable for a Golf Ball Cover, U.S. Patent No. 5,484,870 (filed June 28, 1993); Polyurethane Golf Ball, U.S. Patent No. 5,334,673 (filed Dec. 24, 1991); and Method of Molding Polyurethane Covered Golf Balls, U.S. Patent No. 5,006,297 (filed Feb. 22, 1989).

24. Unstayed Sail with Releasably Engageable Luff and Leech, U.S. Patent No. 5,477,799 (filed Aug. 23, 1994).

25. *See, e.g.*, Ski Footwear, U.S. Patent No. 5,269,079 fig. 2 (filed Mar. 4, 1992); Tightening and Closure Apparatus for Ski Boot, U.S. Patent No. 4,593,483 (filed Nov. 28, 1983).

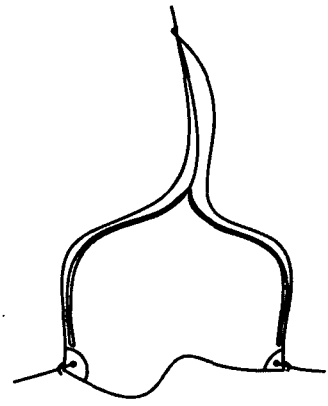


Fig. 1. Improved Spinnaker Sail

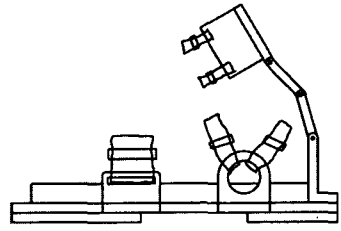


Fig. 2. Improved Ski Boot

But what about processes? The question here is whether Cain's move is a "useful process" as these words are used in the patent law. If so, then the move is patentable. For example, the Supreme Court in *Tilghman*[26] allowed Charles Goodyear to patent a process for vulcanization of rubber.[27] The availability of process patent protection suggests a fertile opportunity for patents in the field of sports. In baseball, for example, pitching speed is critical, with a 100 mph fastball being the hallmark of a major league pitcher. What if someone were to invent a technique for holding the ball to permit throwing 10 mph faster than anyone now can? Such an innovation would have tremendous utility in the major leagues. The improved

26. Tilghman v. Proctor, 102 U.S. 707, 722, 734 (1880).

27. *Id.* at 722, 734.

process of throwing the ball could be described as a series of steps, similar to the steps for vulcanization of rubber, and the major league pitching corps would surely testify to its utility. The same could be envisioned in many sports: a method for sailing an America's Cup yacht wherein the yacht sails 10 degrees closer to the wind; a method for high-jumping higher (remember the Fosbery flop); or a method for downhill skiing 10 percent faster. Even the popular media recognizes that modern athletes use science to turn a contender into a champion and devote entire programs to the topic.[28]

Focusing on skiing, it seems to these authors (as amateur ski racers) that almost every year the recommended technique has to be relearned. Whatever technique one has religiously practiced all year, based upon the prior year's instruction, must be unlearned in order to adjust ski weight, body position, and hip angles to the preferred new stance. Ski coaches and instructors analyze footage from winning Olympic and World Cup racers in order to copy the latest stances and inculcate them into their students. Certain developments are considered as watershed, such as the triangular stance pioneered by Ingemar Stenmark in the 1970s.[29] Many ski magazines offer feature articles on the topic interspersed, of course, with paid advertising–complete with close-up photographs of famous skiers doing their moves.[30] To an intellectual property lawyer, such rampant copying cries out for remedy, but to give rise to a remedy there must be a right that has been infringed. To secure such a right, the underlying subject matter must be patentable. Just like the patent protection available to a method for vulcanizing a longer lasting tire, patent protection might also be available for an improved method of skiing faster by using a certain stance. Indeed, since ski races are won by margins of only hundredths of seconds, even the smallest improvement in ski technique is of great value and could bring significant profit to its developer. Since ski boots, ski gloves, and likely every other type of ski equipment has been patented,[31] the lack of process patents for ski moves positively begs for a remedy.

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28. *See, e.g.*, Fox Sports Network, Sport Science, http://msn.foxsports.com/sportscience (last visited June 12, 2009).

29. *See, e.g.*, United States Ski and Snowboard Educational Series, http://www.ussa.org/magnoliaPublic/ussa/en/formembers/coaches/learningmaterials.html (last visited June 12, 2009).

30. *See, e.g.*, Stu Campbell & Dave Merriam, *Be Strong to Ski Strong*, SKI, Mar.–Apr. 1996, at 79-85.

31. Ski Equipment, U.S. Patent No. 4,846,492 (filed July 7, 1988); Ski Glove, U.S. Patent No. 4,742,579 (filed Feb. 25, 1987); Ski Boot, U.S. Patent No. 3,597,862 (filed July 31, 1969).

The controversy that might arise in sports from an awakening of interest in patents on sports moves would likely parallel the controversy that has arisen in the medical community from patents on operations. Medical procedures, just like industrial procedures, can be protected under the current patent laws. For example, Dr. Samuel Pallin was issued U.S. Patent No. 5,080,111 on a method for performing an incision in the eye during cataract surgery, such that the resulting wound will heal without suturing, minimizing scarring.[32] Other doctors cannot perform this operation without permission from Dr. Pallin. Patents on medical devices and drugs are commonplace and raise no objection, but surgeons have traditionally considered it to be their duty to develop new operative procedures and then dedicate them to the public for free use by all colleagues.[33] The traditional vehicle has been publication of the procedure in an academic medical journal, so all readers of the journal can learn to practice the operation.[34] Many doctors consider the exclusive rights of the patent system to run afoul of the traditional collegial practices and as a result, to be unethical.[35]

Others argue, to and through their senators, that such patents "could have a negative impact on Congressional efforts to make health care more affordable and accessible."[36] Indeed, legislation such as the Ganske-Wyden Bill has been proposed to prohibit such patents on medical procedures.[37]

Regardless of the fate of bills like this, many medical researchers will no doubt continue to dedicate their inventions to the public by

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32. Method of Making Self-Sealing Episcleral Incision, U.S. Patent No. 5,080,111 (filed June 28, 1990).

33. Silvy A. Miller, *Should Patenting of Surgical Procedures and other Medical Techniques by Physicians be Banned?*, 36 IDEA 255, 256-60, 265 (1996); Steven L. Nichols, *Hippocrates, the Patent-Holder: The Unenforceability of Medical Procedure Patents*, 5 GEO. MASON L. REV. 227, 246, 254 (1997).

34. *Eye Surgeon Loses Effort To Enforce His Patent*, N.Y. TIMES, Apr. 3, 1996, at D20, available at http://www.nytimes.com/1996/04/03/us/eye-surgeon-loses-effort-to-enforce-his-patent.html.

35. Nichols, *supra* note 33, at 246, 258. Interestingly, this debate continues even though the suit over Dr. Pallin's patent was recently settled. Pallin v. Singer, No. 2:93-CV-202, 1996 WL 274407 (D.Vt. Mar. 28, 1996). *See* Greg Bonzo, *Method Patent Fails*, AM. MED. NEWS, Apr. 15, 1996, at 1; Michele L. Robinson, *Lawsuit Claiming Medical Procedure Patent Ruled Invalid*, BIOWORLD TODAY, Apr. 15, 1996, at 74. Both of these reports fail to mention that the defendants had previously lost a motion for a summary judgment of patent invalidity. Pallin v. Singer, No. 5:93-202, 36 U.S.P.Q.2d, at * 1054 (D. Vt. May 1, 1995).

36. *AMA Delegates Condemn Surgical Method Patents; Surgeons Take Both Sides in Debate*, OCULAR SURGERY NEWS, Sept. 1, 1994 at 22.

37. Medical Procedures Innovation and Affordability Act, H.R. 1127, 104th Cong. (1995).

choosing not to file patent applications, by offering royalty-free nonexclusive licenses to everyone, or by not enforcing their patent rights. This behavior is entirely analogous to the behavior of people from all walks of life who donate property to the public or to the poor. However, remedies for poverty and the high cost of healthcare should not depend upon the state of intellectual property law.

The same controversy would likely arise in the sports world, if patenting of athletic moves were to become commonplace. The issues raised by such patents would likely have to be addressed by the governing sports bodies, such as the NBA, NFL, Major League Baseball, and the Olympic Committee. In the absence of league rules prohibiting such patents, the field is presently open for savvy athletes and their agents to protect their innovations by patent law.

Some sports enthusiasts might argue that, as the title of this article suggests, a patented sports move would be "unsporting". However, this argument must be tempered for at least three important reasons.

First, the patent right does not take something away from society. Concerns are often raised that a patent gives a right to prevent others from doing that which they would otherwise be able to do, absent the artificial legal obstacle imposed by patent law. In essence, this resembles a natural law libertarian concern that we all have some fundamental right to do what we want (more or less), and we should not be prevented from moving our bodies in a certain way merely because some patent attorney filed a paper in the Patent Office. While on its face this argument has substantial appeal, it ignores the very nature of the patent system. Patents are only available for something that is new and nonobvious.[38] To be new and nonobvious, the invention must, by definition, not have been within the public's knowledge in the first instance.[39] A patent, therefore only permits the patentee to keep the public from using for a limited time the very thing that he or she first introduced to the public in the patent application. For this reason, patents and copyrights have been defended by scholars like Nozick as consistent with the "Lockean Proviso" because "[a]n inventor's patent does not deprive others of an object which would not exist if not for the inventor."[40]

Secondly, in the sports context, the proverbial playing field may be leveled by preventing the patentee from making exclusive use of

38. 35 U.S.C. §§ 102, 103 (2006).

39. § 102.

40. ROBERT NOZICK, ANARCHY, STATE, AND UTOPIA, 182 (1974).

the patented move through properly drafted league rules. Such rules have served to structure and control many improvements to sports activities in the major leagues, disallowing, for instance, corked bats which hit farther and vaseline-coated baseballs which curve better.[41] Alternatively, assuming there are no antitrust violations, leagues might even mandate that a player-patentee grant a license on reasonable terms to all competitors if the player-patentee wishes to use the move himself. Perhaps league involvement would be desirable, to develop a system regulating the exploitation of this type of patent, similar to the current system under which team trademarks are exclusively licensed to the league and exploited on a collective basis for the common good of all teams. While such arrangements have been the norm to date in league sports, they are presently under challenge in the NFL by Dallas Cowboys owner Jerry Jones.[42]

Finally, the right to exclude others that is at the core of the patent right does not require that there be any exclusion. Many patentees choose to offer broad based non-exclusive licenses to anyone interested in paying a nominal fee. This licensing strategy is common in the biomedical community for basic inventions. For example, the Columbia University patents on transforming cells with foreign DNA[43] and the Stanford University patents on recombinant DNA[44] have been available for licensing by just about anyone and the fees are commensurate with the intended use: low for academic use and high for commercial use.[45] The universities that own these patents can use the revenues to fund new research. Similarly, a public spirited

41. William S. Robbins, *Baseball's Antitrust Exemption – A Corked Bat For Owners?*, 55 LA. L. REV. 937 (1995); Major League Baseball Official Rules: 6.06 http://mlb.mlb.com/mlb/downloads/y2008/official_rules//06_the_batter.pdf (last visited June 13, 2009); Major League Baseball Official Rules: 8.02 http://mlb.mlb.com/mlb/downloads/y2008/official_rules/08_the_pitcher.pdf (last visited June 13, 2009).

42. *Cowboys' Owner Sets Pact With American Express*, WALL ST. J., Oct. 9, 1995, at A4; *NFL Sues Cowboys Owner Over Unauthorized Pacts*, WALL ST. J., Sept. 19, 1995, at A10; Roger Thurow, *NFL's Levinson Teaches Old Pros New Moves*, WALL ST. J., Feb. 2, 1996, at B8.

43. Processes for Inserting DNA into Eurcaryotic Cells and for Producing Proteinaceous Materials, U.S. Patent No. 4,399,216 (filed Feb. 25, 1980).

44. Process for Producing Biologically Functional Molecular Chimeras, U.S. Patent No. 4,237,224 (filed Jan. 4, 1979).

45. *See e.g.*, Cathryn Campbell, *Licensing in the Biotechnology Industry*, *in* LICENSING BEST PRACTICES: THE LESI GUIDE TO STRATEGIC ISSUES AND CONTEMPORARY REALITIES 203, 206 (2002); IPBiz: Fortune on Bayh-Dole: a Litigious Scrum of Data-hoarding and Suspicion, http://ipbiz.blogspot.com/2005/09/fortune-on-bayh-dole-litigious-scrum.html (last visited June 13, 2009); Stanford University Office of Technology Licensing, http://otl.stanford.edu (last visited June 13, 2009).

sports champion might offer a non-exclusive license at varying rates and donate the proceeds to a charity such as the U.S. Olympic Team.

COPYRIGHTS–BECAUSE JOCKS ARE CREATIVE, TOO

Just as patents may be available for those moves that are functional, copyrights may be available for those that are creative. Federal law creates four conditions for copyright protection: (1) the work must be fixed in a tangible form; (2) the work must be original; (3) the work must be creative; and (4) the work must be within the subject matter of copyright.[46]

The fixation requirement of federal law is easily satisfied for works consisting of sounds, images, or both, that are being transmitted. They are "fixed" for purposes of the statute even "if a fixation of the work is being made simultaneously with its transmission."[47] A work such as a sports move can be fixed simply by recording it onto "home video."[48] In the alternative, the move might be explained in choreographic short-hand notation that could be written down. In the context of television broadcasting of an event, the work may be fixed if the television company is making a taped copy of the broadcast, simultaneous with its transmission, and under the authority of the artist (here the athlete).

The originality requirement is also a fairly low hurdle to copyright protection. Originality only refers to the source of the work.[49] To be "original," the work must only have been independently created; it need not be new.[50] As the Supreme Court illustrated in the *Feist* decision, "[A]ssume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence, copyrightable."[51]

Creativity may sometimes be a greater issue for copyright practitioners because only works with sufficient creative content are protected, and the word "creative" seems subjective. The courts, however, have recognized that only a modicum of creativity is

46. Under the Statute, there are three requirements, with the second requirement subsuming two sub-parts. A work must (1) be fixed, (2) be an original work of authorship, and (3) must be within the subject matter of copyright. The second requirement actually includes two distinct concepts: originality and creativity. 1 Melville B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT, §§ 1.06[A], 1.08[C][1], 2.01[A]-[B] (2008).

47. 17 U.S.C. § 101 (2006).

48. Nimmer, *supra* note 46, § 2.03[B][2].

49. Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).

50. *Id.*

51. *Id.* at 346.

required for a work to be copyrightable.[52] As Justice Holmes declared in the *Bleistein* case when holding a circus poster to be copyrightable, "[If certain works] command the interest of any public, they have a commercial value–it would be bold to say that they have not an aesthetic and educational value–and the taste of any public is not to be treated with contempt."[53] According to Justice Holmes, this high value is what makes the work "creative" for purposes of copyright. It is immediately obvious that sports moves "command the interest" of at least the sports enthusiast portion of the public (not a small portion at all). Particularly in the case of the "Abel-ist" move, the fans will endure countless commercials just to see the brief moment of Abel's creative genius. The willingness of viewers to endure the commercials is strong evidence of the value they place on the move.

Sports moves are proper subject matter for copyright under a number of theories. First, sports moves may be considered choreography. As with traditional dance choreography, basic steps or gesticulations may not be protected; however, as one might imagine, the "Abel-ist" move is more than one simple step or gesture. Certainly a combination of even a few basic steps or gestures will rise to the level of choreography as contemplated by the statute. For example, the copyright in Balanchine's "The Nutcracker" could be infringed by a book portraying several still photographs of the ballet.[54]

Secondly, sports moves may be considered audiovisual works. The statute carefully defines audiovisual works as those that "consist of . . . related images which are intrinsically intended to be shown by the use of machines, or devices such as projectors, . . . regardless of the nature of the material objects, such as films or tapes, in which the works are embodied."[55] Importantly, the wording of the statute recognizes that the work is distinct from the particular object in which it might be fixed.

Indeed, the playing of a sport–not just the televising of it–has been found to be the proper subject of copyright protection in the *Baltimore Orioles* decision.[56] The decision, while ground-breaking, seems defensible. Choreography is a form of copyrightable subject

52. Balt. Orioles, Inc. v. Major League Baseball Players Ass'n, 805 F.2d 663, 669 n.7 (7th Cir. 1986); Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102-03 (2d Cir. 1951).

53. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 252 (1903).

54. Horgan v. MacMillan, Inc., 789 F.2d 157 (2d Cir. 1986).

55. 17 U.S.C. § 101 (2006).

56. *Balt. Orioles, Inc.*, 805 F.2d at 674-75.

matter.[57] Copyright can be obtained by recording a dance in tangible form through a system of written notation or by depositing a film or tape depicting the dance.[58] Some might object that while dance is a form of art, and therefore well within traditional subject matter for copyright, sports performances are not art, and therefore not deserving of protection. Consider, however, a sport like gymnastics or ice skating which is heavily influenced by the grace and artistry of dance, and where the distinction between sport and dance is well blurred. Free-style skiing could be considered in the same category as gymnastics, being a discipline requiring graceful, visually-impressive movements executed on skis. Surely, all of these forms of dance should be recognized as copyrightable, no less than traditional ballet. The fact that a form of art is popular, or appeals to the masses as distinguished from academic critics is not a reason for denial of copyright protection, but rather a reason for granting it.[59]

Notably, the procedural posture of the *Baltimore Orioles* decision was unexpected. The players, rather than arguing for copyright protection, were arguing against it. The players urged that they possessed a right of publicity in their performances in the course of playing baseball.[60] They claimed that this right belonged to them (through their union), rather than to the team owners or the league.[61] In response, the baseball league argued that any such right of publicity was preempted by the availability of copyright in the game performance.[62] The court accepted the league's argument.[63] The interesting point is that while it had been recognized for years that a televised baseball game, like any other television show, could be copyrighted as an audiovisual work, this decision meant that the actual playing of the game (whether or not televised) enjoyed copyright protection. The court ruled that federal copyright law preempted any state law publicity interest of the players and that since the players were employees of the team, their copyright interest in the game belonged to the team, based on the "works made for hire" principle.[64]

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57. *Horgan*, 789 F.2d at 160.

58. *Id.* at 161.

59. *Bleistein*, 188 U.S. at 251-52.

60. *Balt. Orioles, Inc.*, 805 F.2d at 667.

61. *Id.*

62. *Id.* at 674-79.

63. *Id.* at 674.

64. *Id.* The "works for hire" doctrine vests copyright ownership of works by an employee in the employer. 17 U.S.C. § 201(b) (2006). One may question the preemption ruling, since

Some may object that moves in a sport like baseball should not be copyrightable because throwing or catching a baseball is "functional." It is true that works of utility such as auto hubcaps and computer menus can be denied protection.[65] However, it is difficult to see how the playing of a baseball game is functional in the same sense as is an automobile hubcap. At root, games and sports are diversions and entertainment, perhaps quite the opposite of the performance of useful, functional works. Their purpose is not unlike that of many movies: to entertain. Consider for example, the case of professional wrestling. These performances are reminiscent of Charlie Chaplin's improvised slapstick routines from his famous silent movies. It is recognized that "stage business," gags and jokes, are copyrightable.[66] No one would argue that Charlie Chaplin's movies are uncopyrightable: so why should similar performances by professional wrestlers not be copyrightable? And if a wrestling performance is copyrightable, why not a baseball game?

Reasoning by analogy to dance, Copyright Office regulations provide that simple dance steps like the waltz are not copyrightable.[67] However, something like a free-style skiing routine should be able to escape that limitation. Certain moves in sports are far from simple, and so should be found to possess the level of creativity required to obtain copyright protection. Consider, for example, the elaborate slam dunk routines televised as part of the NBA All-Star Weekend. Carefully crafted for aesthetic appeal to the audience, these routines are quite the opposite of functional. The most successful dunks use a complex series of aerial motions, much like a ballet.[68] Free-style skiing and snowboarding share many of the same attributes of the NBA's slam dunk competition: elaborate motions, visual display and fan appeal.[69] Hence, a wide range of potentially copyrightable

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rights of publicity and copyright rights are ordinarily considered distinct legal concepts. One can easily see that copyright and the right of publicity can co-exist: a movie star is not denied a right of publicity simply because the movies that are the vehicles for establishing his or her fame are copyrightable works. Hence, the Orioles players may have been victims of a bad call on this issue.

65. Lotus Dev. Corp. v. Borland Int'l, Inc., 49 F.3d 807, 815 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 233 (1995) (per curiam) (computer menus); Norris Indus., Inc. v. Int'l Tel. & Tel. Corp., 696 F.2d 918, 919 (11th Cir. 1983) (hubcaps).

66. Nimmer, *supra* note 46, § 2.13.

67. Nimmer, *supra* note 46, §§ 2.06, 2.07, 2.09.

68. InsideHoops.com, NBA Slam Dunk Contest, http://www.insidehoops.com/slam-dunk-contest.shtml (last visited June 13, 2009).

69. *See, e.g.*, Ira Berkow, *The XVIII Winter Games: Freestyle Skiing; Flipping and Twisting, Americans Jump to Gold*, N.Y. TIMES, Feb. 18, 1998, at C3, available at http://www.nytimes.com/1998/02/18/sports/xviii-winter-games-freestyle-skiing-flipping-

material exists in sports which, as of today, is not being fully appreciated or economically exploited.

To return to the catalyst for this article, successful skiers become well-known by winning Olympic performances and World Cup victories. Skiers obtain income through sponsorship contracts with ski companies and collateral endorsements of consumer products.[70] However, direct payment for performance, other than prize money, is not the norm. If skiers were to envision themselves more like actors in an improvised drama, contributing their copyrightable performances to a collective work, this might open the way for negotiations with broadcasters and sponsors to include compensation (such as a share in television proceeds, or residuals on rebroadcasting).

Again, some sports enthusiasts might argue that, as the title of this article suggests, a copyrighted sports move would be unsporting. However, this argument must be tempered for the same important reasons discussed above with respect to patents.

On its face, it would appear that our first argument in the context of patents would not apply in the context of copyrights, because patents are only issued to new things while copyrights can be issued to things that are not new. However, in the context of copyright protection, a creative rendition of an existing work may itself be copyrightable, but the protection afforded the creative copy is quite narrow. As Justice Holmes wrote in the *Bleistein* case when finding copyright to subsist in a creative copy of an original that was in the public domain, "The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy."[71] Therefore copyrights, just like patents, only prevent society from using that which the author (or inventor) added to society. In this sense, they "take" nothing that they

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twisting-americans-jump-gold.html; Barbara Lloyd, *The Ski Report; It's a Bird, a Plane, a Freestyler*, N.Y. TIMES, Dec. 24, 1998, at D5, http://www.nytimes.com/1998/12/24/sports/the-ski-report-it-s-a-bird-a-plane-a-freestyler.html; Bill Pennington, *Olympics: Freestyle Skiing; Moseley Returns Amid Controversy*, N.Y. TIMES, Feb. 11, 2002, at D9, available at http://www.nytimes.com/2002/02/11/sports/olympics-freestyle-skiing-moseley-returns-amid-controversy.html; International Olympic Committee, Freestyle Skiing, http://www.olympic.org/uk/sports/programme/disciplines_uk.asp?DiscCode=FR (last visited June. 13, 2009).

70. John Steinbreder, *How Much Is A Gold Medal Worth?*, SNOW COUNTRY, Jan. 1996, at 41.

71. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 249 (1903). *Cf.* Rogers v. Koons, 960 F.2d 301, 308 (2d Cir. 1992).

have not themselves given and that will not become freely available when protection expires.

TRADEMARKS–FOR JOCKS WITH GOODWILL

Beyond patent protection for functional moves, and copyright protection for creative moves, trademark protection may be available for moves that are capable of indicating the source of a particular good or service, in other words, for moves that embody consumer goodwill. Indeed, not only should each form of IP protection be considered for any given sports move, some may enjoy protection under more than one type of IP, as is common with various goods and services in the marketplace.

Trademark rights extend to descriptive marks that have obtained secondary meaning among relevant consumers and to marks that are fanciful or suggestive.[72]

The Lanham Act defines a trademark to be:

> any word, name, symbol, or device, or any combination thereof– (1) used by a person, or (2) which a person has a bona fide intention to use in commerce . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.[73]

As articulated last year by the Supreme Court in *Qualitex*,[74] the statute describes the universe of things that can qualify as a trademark in the broadest of terms.[75] The statute says that trademarks "include any word, name, symbol or device, or any combination thereof."[76] Since human beings might use as a "symbol" or "device" almost anything that is capable of carrying meaning, this language, read literally, is not restrictive. "If a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?"[77] Therefore, like the breadth of patentable subject matter, the breadth of trademark subject matter is quite expansive, including just about any "mark" that can be used to indicate source, and embody goodwill.

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72. Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1041 (2d Cir. 1992).

73. 15 U.S.C. § 1127 (2006).

74. Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995).

75. *Id.* at 162.

76. § 1127.

77. *Qualitex*, 514 U.S. at 162.



Fig. 3. NBA Logo

As an example in the sports context, the NBA has successfully registered and asserted trademark rights in its logo of a basketball player dribbling a basketball[78] (Figure 3). Similarly, the Kareem Abdul-Jabbar "sky hook" is also captured in two pending trademark applications.[79] While the NBA logo and the "sky hook" design mark comprise sports moves frozen in a stylized silhouette, trademark rights might also extend to protect a three-dimensional, real-time movement of a sports figure. Given certain technological changes and the realities of the marketplace, this type of protection should easily be palpable. Trademark law and its underlying theories of unfair competition are already prepared to embrace such protection. As with many other aspects of the marketplace, the first people prepared for this change will benefit by their early action.

Recent trademark law has seen the expansion of trademark subject matter to include the trade dress protection of a restaurant,[80] the color of a product,[81] and distinctive sounds.[82] In keeping with this

78. U.S. Trademark No. 1,525,782 (filed Nov. 20, 1987).

79. U.S. Trademark No. 74,593,669 (filed Nov. 1, 1994); U.S. Trademark No. 74,593,488 (filed Nov. 1, 1994).

80. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992).

81. Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995) (green-gold press pads); *In re* Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1128 (Fed. Cir. 1985) (pink fiberglass insulation).

82. *See, e.g.*, AT&T's numerous trademark applications for sounds, including: U.S. Trademark No. 74,675,238 (filed May 16, 1995). *See also* Joseph Diamante & Darren W. Saunders, *If Harley-Davidson Has its Way, the Resounding Roar that its Motorcycles Make*

expansive notion, trademark protection has not only been extended to building designs, colors, and sounds, but has also been extended to logos depicting famous people. and to three-dimensional product configurations.[83] These examples confirm an underlying market pressure to protect as valuable property any mark that can function as an indication of source and thereby be used to attract and embody goodwill.

As the sophistication of marketing techniques expands to include technologically advanced, real-time video or motion-simulating graphics, it will become increasingly more feasible to attach these graphics to products, product packaging, brochures, advertisements, and internet home pages for the sale of goods and services. So long as these graphics function as an indication of source, they could be considered trademark subject matter.

The key question underlying all trademark determinations is whether the asserted mark can become a sign, recognized by the public, to point to a particular good or service and the goodwill that has become associated with it. The "Abel-ist" move should meet this test.

Sounds have a time dimension, as do sports moves. Product configurations exist in three coordinate dimensions, as do sports moves. Logos can portray famous and easy-to-identify people, as do sports moves. All three can be used to indicate marketing, manufacturing, or distribution sources, so why not sports moves? Why not extend to Abel, or Abel's employer, protection from other athletes' copying of the fanciful or suggestive dimensions of his sporting behavior?

One might argue that Abel's move is not attached to goods or services, and thus cannot function as an indication of the source of those goods or services. However, modern technology may soon make such attachment feasible. Picture a hologram attached to packaging of baseball bats or attached directly to baseball gloves, which shows the three-dimensional distinctive movement of a famous pitcher. Capable of indicating source? Yes. Picture a video segment of a distinctive end-zone dance of a famous football player displayed at the top of a world wide web home page for the local football team's

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Could Become a Registered, Protected Sound Under the Trademark Act, 18 NAT'L L.J. 10, at B5 (Nov. 6, 1995).

83. 1 Anne Gilson LaLonde, Karin Green, & Jerome Gilson, GILSON ON TRADEMARKS, § 2.11[8] (Release No. 68, 2008). Not all commentators are pleased with this trend. *See, e.g.*, Alex Kozinski, *Trademarks Unplugged*, 84 TRADEMARK REP. 441, 446-7 (1994).

fan store or Internet phone-chat service. From any "angle," protection for these distinctive indications of source will soon become a necessary part of the modern marketplace. For the very reason that these distinctive sports moves can become valuable property, trademark law should offer appropriate protection.

Like sports moves, other choreographic works might be considered trademarks when affixed to particular goods or services. For example, footage of Charlie Chaplin waddling about a stack of PC boxes might be displayed every time an IBM-brand computer is turned on. Once the technological problem of affixing these types of marks to goods and services is resolved, trademark attorneys and the Patent and Trademark Office should not hesitate to encourage their protection.

But what about protection of the sports move qua sports move? The real issue here is the separation that is needed between a trademark and the underlying good or service that the mark represents. Trademark protection is not available for the good or service itself. Abel provides the service of being a competitive sportsman. The "Abel-ist" move is a fanciful embellishment that Abel has added to his service to indicate that he is its source. Therefore, the "Abel-ist" move might arguably be protectable in its own right as an indicator of source.

This example can be brought closer to home if we imagine that Abel is a professional football player who has developed a particular endzone dance to celebrate the successful engagement and defeat of an opposing team, led (of course) by quarterback Cain. We might also assume that this endzone dance is so fanciful that TV fans remain glued to their sets through three minutes of commercials following Abel's victory, just to watch this dance (foregoing bathroom breaks and snack refills). Fan identification of Abel's move with the games of Abel's team makes the commercial time during these games more valuable. It is precisely this value that makes trademark protection necessary. If Abel notices that his "Abel-ist" move is being used by brother Cain in an attempt to draw crowds, usurp goodwill, and benefit financially from Abel's creativity, then Abel should be able to sue Cain for trademark infringement.

THE FUTURISTIC STORY–FACT OR FICTION?

It may seem that Cain, Abel, patents, trademarks, and copyrights are all figments of the authors' imaginations, at least so far as the sports world goes. But this cannot really be the case. Even the casual

sports viewer remembers the frenzy of attention surrounding Dan and Dave, and the similarity among Dan, Dave, Cain, and Abel is not coincidental.

Olympic medals offer much more than their value as a congratulatory trophy. They enable substantial indirect financial value that can be realized by, inter alia, direct marketing of products and services and by endorsement of third-party products and services. A quick reach for a recent issue of Snow Country will reveal a lengthy article about the commercial value of Olympic and other sports medals.[84] The reader need only flip through the same issue to find examples, including an advertisement for former World Cup skier Michael Aday's "Aday's World Cup Heat" barbecue sauce, at page 18.[85] Indeed, on the same page the reader will find a comment noting that graphics play the most important role in ski sales.[86] Ski graphics may feature signature endorsements by champion skiers, and they help consumers recognize the brands used by champions in televised racing events. While Aday might endorse his own products, other Olympians reach beyond their own products and even beyond sports as well. For example, Janet Evans, the four-time Olympic Medalist in swimming, is now pictured in an advertisement for Cadillac Seville, promoting its "fluid grace."[87] The value of Olympic medals has increased in recent years, and all signs indicate this trend will continue.

The role lawyers may play in future Olympics is also not far-fetched: this year a team of arbitrators will be present in Atlanta to resolve rules disputes on the spot.[88] Perhaps in a few years, they will also ensure that instant justice is dispensed for intellectual property claims.

84. Steinbreder, *supra* note 70, at 41.

85. *Snow Country Store*, SNOW COUNTRY, Jan. 1996, at 18.

86. *It's a Fact*, SNOW COUNTRY, Jan. 1996, at 18.

87. ARCHITECTURAL DIG., Apr. 1996, at 43.

88. Richard C. Reuben, *And the Winner Is . . . : Arbitrators to Resolve Disputes as they Arise at Olympics*, A.B.A. J., Apr. 1996, at 20.

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