

Intellectual Property and Startups: Ten Biggest Mistakes Attorneys Miss/Make

By

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Resources

1. The Patent and Copyright Clause, U.S. Constitution.
2. The U.S. Patent Act of 1952, 35 U.S.C. §§ 1 et seq. Excerpts
3. The U.S. Trademark Act, 15 U.S.C. §§ 1051 et seq. (Lanham Act). Excerpts.
4. The Copyright Act of 1976, 17 U.S.C. §§ 101 et seq. Excerpts.
5. Arkansas enacted the Arkansas Trade Secrets Act, ARK. CODE ANN. § 4-75-601 et seq. (2015).
6. Uché Ewelukwa, *Trade Secrets*, Tech Innovations and the Changing Legal Landscape, JURIST – Academic Commentary, Feb. 6, 2018.
7. Uché Ewelukwa, *Trade Secrets: The Defend Trade Secrets Act of 2016*, JURIST – Academic Commentary, Feb. 8, 2018.
8. Uche Ewelukwa Ofodile, *Frank Broyles Publicity Rights Protection Act of 2016: Potential Minefields*, THE ARKANSAS LAWYER (Vol. 52, No. 2, Spring 2017).
9. Uche Ewelukwa Ofodile, *The Right of Publicity Q & A: Arkansas' Publicity Rights Protection act of 2016*, JURIST – Academic Commentary, Nov. 15, 2017.

The Congress shall have Power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

UNITED STATES CONSTITUTION, ARTICLE I, SECTION 8

Appendix L Patent Laws

United States Code Title 35 - Patents

[Editor Note: Current as of August 31, 2017. The Public Laws are the authoritative source and should be consulted if a need arises to verify the authenticity of the language reproduced below.]

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SELECTED PROVISIONS OF OTHER TITLES
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- 18 U.S.C. 1001 Statements or entries generally.
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- AIA § 14 Tax strategies deemed within the prior art.
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PART II — PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

CHAPTER 10 — PATENTABILITY OF INVENTIONS

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35 U.S.C. 100 (note) AIA First inventor to file provisions.

The first inventor to file provisions of the Leahy-Smith America Invents Act (AIA) apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—

(A) a claim to a claimed invention that has an effective filing date on or after March 16, 2013 wherein the effective filing date is:

(i) if subparagraph (ii) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(ii) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section [119](#), [365\(a\)](#), [365\(b\)](#), [386\(a\)](#), or [386\(b\)](#) or to the benefit of an earlier filing date under section [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#); or

(B) a specific reference under section [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

(Sept. 16, 2011, Public Law 112-29, sec. 3(n)(1) (effective March 16, 2013), 125 Stat. 284; references to 35 U.S.C. 386 added Dec. 18, 2012, Public Law 112-211, sec. 102(1) (effective May 13, 2015), 126 Stat. 1531.)

35 U.S.C. 100 Definitions.

[Editor Note: 35 U.S.C. 100(e)-(j) as set forth below are only applicable to patent applications and patents subject to the first inventor to file provisions of the AIA (35 U.S.C. 100 (note)). See 35 U.S.C. 100(e) (pre-AIA) for subsection (e) as otherwise applicable.]

When used in this title unless the context otherwise indicates -

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

(e) The term "third-party requester" means a person requesting ex parte reexamination under [section 302](#) who is not the patent owner.

(f) The term "inventor" means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

(g) The terms "joint inventor" and "coinventor" mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.

(h) The term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by 2 or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(i)(1) The term "effective filing date" for a claimed invention in a patent or application for patent means—

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section [119](#), [365\(a\)](#), [365\(b\)](#), [386\(a\)](#), or [386\(b\)](#) or to the benefit of an earlier filing date under section [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#).

(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

(j) The term "claimed invention" means the subject matter defined by a claim in a patent or an application for a patent.

(Subsection (e) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-567 (S. 1948 sec. 4603); subsection (e) amended and subsections (f) - (j) added Sept. 16, 2011, Public Law 112-29, sec. 3(a) (effective March 16, 2013), 125 Stat. 284.; subsection (i)(1)(B) amended Dec. 18, 2012, Public Law 112-211, sec. 102(1) (effective May 13, 2015), 126 Stat. 1531.)

35 U.S.C. 100 (pre-AIA) Definitions.

[Editor Note: pre-AIA 35 U.S.C. 100(e) as set forth below is not applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 100(e)-(j) for the law otherwise applicable.]

When used in this title unless the context otherwise indicates -

(e) The term “third-party requester” means a person requesting ex parte reexamination under [section 302](#) or inter partes reexamination under [section 311](#) who is not the patent owner.

(Subsection (e) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-567 (S. 1948 sec. 4603).)

35 U.S.C. 101 Inventions patentable.

Whoever 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.

(Public Law 112-29, sec. 33, 125 Stat. 284 (Sept. 16, 2011) provided a limitation on the issuance of patents (see [AIA § 33](#).)

35 U.S.C. 102 Conditions for patentability; novelty.

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see [35 U.S.C. 100 \(note\)](#)). See [35 U.S.C. 102 \(pre-AIA\)](#) for the law otherwise applicable.]

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under [section 151](#), or in an application for patent published or deemed published under [section 122\(b\)](#), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under [section 119](#), [365\(a\)](#), [365\(b\)](#), [386\(a\)](#), or [386\(b\)](#), or to claim the benefit of an earlier filing date under [section 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; Nov. 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691; subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505); subsection (g) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-590 (S. 1948 sec. 4806); subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903; amended Sept. 16, 2011, Public Law 112-29, sec. 3(b), 125 Stat. 284, effective March 16, 2013.*; subsection (d)(2) amended Dec. 18, 2012, Public Law 112-211, sec. 102(2) (effective May 13, 2015), 126 Stat. 1531.)

(Public Law 112-29, sec. 14, 125 Stat. 284 (Sept. 16, 2011) provided that tax strategies are deemed to be within the prior art (see [AIA § 14](#).)

***NOTE:** The provisions of [35 U.S.C. 102\(g\)](#), as in effect on *March 15, 2013*, shall also apply to each claim of an application for patent, and any patent issued thereon, for which the first inventor to file provisions of the AIA apply (see [35 U.S.C. 100 \(note\)](#)), if such application or patent contains or contained at any time a claim to a claimed invention to which is *not* subject to the first inventor to file provisions of the AIA.]

35 U.S.C. 102 (pre-AIA) Conditions for patentability; novelty and loss of right to patent.

[Editor Note: With the exception of subsection (g), not applicable to any patent application subject to the first inventor to file provisions of the AIA (see [35 U.S.C. 100 \(note\)](#)). See [35 U.S.C. 102](#) for the law otherwise applicable.]*

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in — (1) an application for patent, published under [section 122\(b\)](#), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in [section 351\(a\)](#) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under [Article 21\(2\)](#) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g) (1) during the course of an interference conducted under [section 135](#) or [section 291](#), another inventor involved therein establishes, to the extent permitted in [section 104](#), that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who

was first to conceive and last to reduce to practice, from a time prior to conception by the other.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; Nov. 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691; subsection (c) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505); subsection (g) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-590 (S. 1948 sec. 4806); subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903.)

(Public Law 112-29, sec. 14, 125 Stat. 284 (Sept. 16, 2011) provided that tax strategies are deemed to be within the prior art (see [AIA § 14](#)).

***NOTE:** The provisions of [35 U.S.C. 102\(g\)](#), as in effect on *March 15, 2013*, shall apply to each claim of an application for patent, and any patent issued thereon, for which the first inventor to file provisions of the AIA apply (see [35 U.S.C. 100 \(note\)](#)), if such application or patent contains or contained at any time—

(A) a claim to an invention having an effective filing date as defined in section [100\(i\)](#) of title 35, United States Code, that occurs before March 16, 2013; or

(B) a specific reference under section [120](#), [121](#), or [365\(c\)](#) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see [35 U.S.C. 100 \(note\)](#)). See [35 U.S.C. 103 \(pre-AIA\)](#) for the law otherwise applicable.]

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section [102](#), if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

(Amended Nov. 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384; Nov. 1, 1995, Public Law 104-41, sec. 1, 109 Stat. 3511; subsection (c) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 sec. 4807); subsection (c) amended Dec. 10, 2004, Public Law 108-453, sec. 2, 118 Stat. 3596; amended Sept. 16, 2011, Public Law 112-29, secs. 20(j) (effective Sept. 16, 2012) and 3(c) (effective March 16, 2013), 125 Stat. 284.)

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case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

(Amended Oct. 9, 1962, 76 Stat. 769; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3935; Oct. 30, 1998, 112 Stat. 3064; Nov. 29, 1999, 113 Stat. 1501A; Nov. 2, 2002, 116 Stat. 1906.)

§ 2 (15 U.S.C. § 1052). Trademarks registrable on the principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the

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same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act. A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be refused registration only pursuant to a proceeding brought under section 13. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be canceled pursuant to a proceeding brought under either section 14 or section 24.

(Amended Oct. 9, 1962, 76 Stat. 769; Jan. 2, 1975, 88 Stat. 1949; Nov. 16, 1988, 102 Stat. 3037; Dec. 8, 1993, 107 Stat. 2057; Dec. 8, 1994, 108 Stat. 4982; Oct. 30, 1998, 112 Stat. 3069; Aug. 5, 1999, 113 Stat. 218; Nov. 29, 1999, 113 Stat. 1501A-583; Oct. 6, 2006, 120 Stat. 1730.)

§ 3 (15 U.S.C. § 1053). Service marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided herein in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

(Amended Nov. 16, 1988, 102 Stat. 3938.)

§ 4 (15 U.S.C. § 1054). Collective marks and certification marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

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CIRCULAR 92

Copyright Law of the United States
and Related Laws Contained in Title 17 of the United States Code

DECEMBER 2016



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Chapter 1'

Subject Matter and Scope of Copyright

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§101 · Definitions²

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

An “anonymous work” is a work on the copies or phonorecords of which no natural person is identified as author.

An “architectural work” is the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.³

“Audiovisual works” are works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

The “Berne Convention” is the Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto.⁴

The “best edition” of a work is the edition, published in the United States at any time before the date of deposit, that the Library of Congress determines to be most suitable for its purposes.

A person’s “children” are that person’s immediate offspring, whether legitimate or not, and any children legally adopted by that person.

A “collective work” is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

A “compilation” is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term “compilation” includes collective works.

A “computer program” is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.⁵

“Copies” are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term “copies” includes the material object, other than a phonorecord, in which the work is first fixed.

“Copyright owner”, with respect to any one of the exclusive rights comprised in a copyright, refers to the owner of that particular right.

A “Copyright Royalty Judge” is a Copyright Royalty Judge appointed under section 802 of this title, and includes any individual serving as an interim Copyright Royalty Judge under such section.⁶

The “WIPO Performances and Phonograms Treaty” is the WIPO Performances and Phonograms Treaty concluded at Geneva, Switzerland, on December 20, 1996.²⁴

A “work of visual art” is—

(1) a painting, drawing, print or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include—

(A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;

(ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;

(iii) any portion or part of any item described in clause (i) or (ii);

(B) any work made for hire; or

(C) any work not subject to copyright protection under this title.²⁵

A “work of the United States Government” is a work prepared by an officer or employee of the United States Government as part of that person’s official duties.

* A “work made for hire” is—

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a “supplementary work” is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an “instructional text” is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

In determining whether any work is eligible to be considered a work made for hire under paragraph (2), neither the amendment contained in section 1011(d) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106-113, nor the deletion of the words added by that amendment—

(A) shall be considered or otherwise given any legal significance, or

(B) shall be interpreted to indicate congressional approval or disapproval of, or acquiescence in, any judicial determination,

by the courts or the Copyright Office. Paragraph (2) shall be interpreted as if both section 2(a)(1) of the Work Made for Hire and Copyright Corrections Act of 2000 and section 1011(d) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106-113, were never enacted, and without regard to any inaction or awareness by the Congress at any time of any judicial determinations.²⁶

The terms “WTO Agreement” and “WTO member country” have the meanings given those terms in paragraphs (9) and (10), respectively, of section 2 of the Uruguay Round Agreements Act.²⁷

§102 · Subject matter of copyright: In general²⁸

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

**§103 · Subject matter of copyright:
Compilations and derivative works**

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

§104 · Subject matter of copyright: National origin²⁹

(a) **UNPUBLISHED WORKS.** — The works specified by sections 102 and 103, while unpublished, are subject to protection under this title without regard to the nationality or domicile of the author.

(b) **PUBLISHED WORKS.** — The works specified by sections 102 and 103, when published, are subject to protection under this title if—

(1) on the date of first publication, one or more of the authors is a national or domiciliary of the United States, or is a national, domiciliary, or sovereign authority of a treaty party, or is a stateless person, wherever that person may be domiciled; or

(2) the work is first published in the United States or in a foreign nation that, on the date of first publication, is a treaty party; or

(3) the work is a sound recording that was first fixed in a treaty party; or

(4) the work is a pictorial, graphic, or sculptural work that is incorporated in a building or other structure, or an architectural work that is embodied in a building and the building or structure is located in the United States or a treaty party; or

(5) the work is first published by the United Nations or any of its specialized agencies, or by the Organization of American States; or

(6) the work comes within the scope of a Presidential proclamation. Whenever the President finds that a particular foreign nation extends, to works by authors who are nationals or domiciliaries of the United States or to works that are first published in the United States, copyright protection on substantially the same basis as that on which the foreign nation extends protection to works of its own nationals and domiciliaries and works first published in that nation, the President may by proclamation extend protection under this title to works of which

Arkansas Trade Secrets Act

A.C.A. §§ 4-75-601 through 4-75-607 (2011)

§ 4-75-601. Definitions.

As used in this subchapter, unless the context otherwise requires:

(1) "Improper means" includes theft, bribery, misrepresentation, breach or inducement of a breach of a duty to maintain secrecy, or espionage through electronic or other means;

(2) "Misappropriation" means:

(A) Acquisition of a trade secret of another by a person who knows or has reason to know that the trade secret was acquired by improper means; or

(B) Disclosure or use of a trade secret of another without express or implied consent by a person who:

(i) Used improper means to acquire knowledge of the trade secret; or

(ii) At the time of disclosure or use, knew or had reason to know that his knowledge of the trade secret was:

(a) Derived from or through a person who had utilized improper means to acquire it;

(b) Acquired under circumstances giving rise to a duty to maintain its secrecy or limit its use; or

(c) Derived from or through a person who owed a duty to the person seeking relief to maintain its secrecy or limit its use; or

(iii) Before a material change of his position, knew or had reason to know that it was a trade secret and that knowledge of it had been acquired by accident or mistake;

(3) "Person" means a natural person, corporation, business trust, estate, trust, partnership, association, joint venture, government, governmental subdivision or agency, or any other legal or commercial entity;

(4) "Trade secret" means information, including a formula, pattern, compilation, program, device, method, technique, or process, that:

(A) Derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use; and

(B) Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

§ 4-75-602. Effect of subchapter on other law.

(a) This subchapter displaces conflicting tort, restitutionary, and other law of this state pertaining to civil liability for misappropriation of a trade secret.

(b) This subchapter does not affect:

(1) Contractual or other civil liability or relief that is not based upon misappropriation of a trade secret; or

(2) Criminal liability for misappropriation of a trade secret.

§ 4-75-603. Statute of limitations.

An action for misappropriation must be brought within three (3) years after the misappropriation is discovered or, by the exercise of reasonable diligence, should have been discovered. For the purposes of this section, a continuing misappropriation constitutes a single claim.

§ 4-75-604. Injunctive relief.

(a) Actual or threatened misappropriation may be enjoined.

(b) Upon application to the court, an injunction shall be terminated when the trade secret has ceased to exist; however, the injunction may be

continued for an additional reasonable period of time in order to eliminate commercial advantage that otherwise would be derived from the misappropriation.

(c) If the court determines that it would be unreasonable to prohibit future use, an injunction may condition future use upon payment of a reasonable royalty for no longer than the period of time the use could have been prohibited.

(d) In appropriate circumstances, affirmative acts to protect a trade secret may be compelled by court order.

§ 4-75-605. Preservation of secrecy.

In an action under this subchapter, a court shall preserve the secrecy of an alleged trade secret by reasonable means, which may include granting protective orders in connection with discovery proceedings, holding in camera hearings, sealing the records of the action, and ordering any person involved in the litigation not to disclose an alleged trade secret without prior court approval.

§ 4-75-606. Damages.

(a) In addition to or in lieu of injunctive relief, a complainant may recover damages for the actual loss caused by misappropriation.

(b) A complainant also may recover for the unjust enrichment caused by misappropriation that is not taken into account in computing damages for actual loss.

§ 4-75-607. Attorneys' fees.

The court may award reasonable attorneys' fees to the prevailing party if:

- (1) A claim of misappropriation is made in bad faith;
- (2) A motion to terminate an injunction is made or resisted in bad faith; or
- (3) Willful and malicious misappropriation exists.

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Trade Secrets, Tech Innovations and the Changing Legal Landscape

FEBRUARY 6, 2018 02:58:00 PM | **Uche Ewelukwa**

Edited by: **Kelly Cullen**

JURIST Guest Columnist **Uché Ewelukwa** of **the University of Arkansas School of Law**, discusses the dynamic landscape of trade secret law in a multi-part series. In part 1, she introduces current legal trends in trade secrets ...

I. Introduction

2018 is already proving to be a busy year for trade secret owners, for attorneys that prosecute trade secrets misappropriation cases and for the judges who have to interpret and apply relevant laws. On January 24, 2018, a Wisconsin court **convicted** Chinese wind turbine maker Sinovel Wind Group Co. (Sinovel) of stealing trade secrets from U.S. company American Superconductor Corp. (AMSC). In a lawsuit filed on January 29, 2018, intelligent

electric car company Faraday Future **claims** its two former executives, CFO Stephan Krause and CTO Ulrich Kranz, stole its trade secrets when they left to form Evelozcity, Inc. Jury selection in the Waymo-Uber trade secret trial **concluded** on January 31, 2018; trial was set to start on February 5. What these three cases have in common are breakthrough technological innovations worth millions of dollars, cutthroat competition for global dominance in new and emerging sectors, and highly ambitious and very mobile tech employees. Against the backdrop of the 21st century's impressive technological revolution and a highly competitive marketplace, trade secrets are increasingly recognized as very important business assets. Reflecting the importance of trade secrets, a growing number of countries are taking unprecedented steps to ramp up their legal and regulatory framework for trade secret protection. Overall, recent studies show that trade secrets are playing a significantly increased role in the brand value and corporate strategies of companies big and small. Business executives that ignore or minimize the role of trade secrets in their corporate strategy do so at their own peril.

II. What is a Trade Secret?

According to the World Intellectual Property Organization, "any confidential business information which provides an enterprise a competitive edge" may qualify as a trade secret. In the U.S., the **Uniform Trade Secret Act** defines a trade secret as information, that "derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable," and "is the subject of efforts that are reasonable under the circumstances to maintain its secrecy." To qualify as trade secrets, three important condition must be met. First, the information must be valuable and must confer a competitive advantage on the owner. Second, the information must not be generally known or readily ascertainable. Third, the owner must take on-going reasonable effort to protect the secrecy. Famous examples of trade secrets include the Coca Cola formula, Google's search algorithm, and Kentucky Fried Chicken's original recipe.

III. Just How Important Are Trade Secrets?

Trade secrets are extremely important to mid-market companies, recent studies suggest. A June 2017 **report** by multinational law firm Baker McKenzie found that 82% of senior executives said their trade secrets are an important, if not essential, part of their businesses. The report also found that one in five companies has suffered trade secret theft and that many companies do not know if they have been the victim of trade secret misappropriation. A July 2017 **report** from the European Union Intellectual Property Office (EUIPO) came to similar conclusions. In the report the EUIPO concludes that while innovating firms often use both patents and trade secrets to protect their innovations, the use of trade secrets to protect innovations was higher than the of use patents by most types of companies, in most economic sectors and in all Member States

IV. What Are the Advantages of Trade Secrets Over Patents?

Trade secrets have some advantages over patents, such as:

- **Broad Subject Matter:** Patent protection is only available for processes, machines, manufactures, or composition of matters. Trade secret protection on the other hand is available over technological innovations, manufacturing processes, marketing plans, compilations, and indeed any information that gives the owner a competitive advantage. On October 6, 2017, a federal jury entered a \$2.1 million trade secret verdict in the case of **Bimbo Bakeries USA, Inc. v. Sycamore**, a case that involved the recipe for making bread.
- **No Formal Registration or Examination:** In most jurisdiction, patents are granted by the government after a rigorous examination procedure. No formality or registration is required to enjoy trade secret protection.
- **Potentially Long Life Span:** Patents generally last for twenty years. A trade secret, on the other hand, can last forever provided it remains relatively secret and is the subject to continuing effort to protect secrecy.
- **Absolute Novelty Not Required:** The legal requirements for patentability are much more stringent than those for trade secrets and include the requirements of novelty and non-obviousness.

V. Do Patents Have Any Advantages Over Trade Secrets?

Although trade secrets has any advantages over patents, trade secret protection is not ideal for every type of technology and for every company. Compared to patents, the disadvantages of trade secrets include:

- **Possibility of Reverse Engineering:** In the U.S. and many other jurisdiction, it is lawful to reverse engineer a trade secret. A patent on the other hand cannot be reverse engineered.
- **Ease of loss:** Trade secrets can be lost through theft, industrial espionage, accidental disclosures and willful disclosure in breach of confidential relationships.
- **Independent Creation:** Independent creation is a complete defense to a trade secret misappropriation claim but is not a defense in a patent suit.
- **No Presumption of Validity** In the U.S., a patent is **presumed** valid until invalidated by a court. Trade secrets do not enjoy a similar presumption

VI. A Changing Legal Landscape?

The legal and regulatory landscape for trade secret protection is changing. First, a growing number of countries are passing specific trade secret laws. Second, countries are ramping up the penalties for trade secret theft. Third, some jurisdictions like the European Union (EU) are taking step to harmonize their trade secret laws.

- **European Union:** EU countries have until June 9, 2018 to bring their domestic legislation into compliance with **Directive (EU) 2016/943**, protecting trade secrets against unlawful acquisition, use and disclosure. The Directive was adopted on May 26, 2016, and aims at harmonizing the trade secret laws of EU Member States.
- **China:** The **General Provisions of the Civil Law of the People's Republic of China** was adopted at the 5th Session of the Twelfth National People's Congress of the People's Republic of China on March 15, 2017, and became effective October 1, 2017. Article 123 confirms that trade secrets are recognized and protected as a form of intellectual property in China.
- **United States:** In May 2016, the U.S. Congress passed the **Defend Trade Secrets Act of 2016** ("DTSA"), which creates a brand new federal civil cause of action for trade secret misappropriation. Section 2 of the DTSA states unequivocally that "[a]n owner of a trade secret that is misappropriated may bring a civil action." Before the DTSA, trade secret was primarily protected under state law.
- **Japan: Amendments** to Japan's Unfair Competition Prevention Act became effective on January 1, 2016. Among other things, the amendments expanded the punishment for the theft of trade secrets.
- **Subnational Governments (e.g. the State of Texas):** On 19 May 2017, Texas Governor Greg Abbott signed **House Bill 1995**, which amends several provisions of the Texas Uniform Trade Secrets Act to bring it into conformity with the DTSA.

VII. What Lessons for Businesses?

Long regarded as the stepchild of intellectual property rights, trade secrets are gradually coming into their own and are increasingly at the center of multi-million dollar lawsuits between major tech titans. The good news is that legal protection for trade secret is becoming stronger in a growing number of countries. The bad news is that with increased digitization, globalization, and the growing popularity of electronic communication technologies, trade secrets are extremely vulnerable to theft and unauthorized disclosure especially in sectors with high employee mobility. In *Waymo v. Uber*, a former Waymo employee allegedly stole 14,000 electronic files shortly before he left Waymo. At the center of **Sinovel's trade secret theft scandal** is Dejan Karabesevic, a former employee of a wholly-owned subsidiary of AMSC. On January 18, 2018, Xu Jiaquiang a former software developer for IBM Corp. was **sentenced** to five years in prison for stealing trade secrets belonging to IBM.

Patent or trade secrets? That is a tough question. The choice of protection strategy will frequently depend on a number of factors including the subject matter of innovation (whether production or process), the nature of the trade secret and the marketplace, the risk of disclosure, as well as business considerations such as the desire to sustain exclusivity for an extended period of time. Overall, evidence suggests that innovating firms

tend to combine patents with secrecy and use both to protect different aspects of their innovation. Companies choosing to rely on trade secrets must ensure the security of their innovations using a mix of physical security measures, legal (contractual) measures, and technological security measures.

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Learn more about [John Mitchell](#) from the *Washington Post*.



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Trade Secrets (Part 2): The Defend Trade Secrets Act of 2016

FEBRUARY 8, 2018 07:00:00 PM | **Uche Ewelukwa**

Edited by: **Kelly Cullen**

JURIST Guest Columnist **Uché Ewelukwa** of the **University of Arkansas School of Law**, discusses the dynamic landscape of trade secret law in a multi-part series. In part 2, she discusses the Defend Trade Secrets Act of 2016 ...

I. Introduction

Signed into law on May 11, 2016, the **Defend Trade Secrets Act of 2016** ("DTSA") creates a new federal private right of civil action for trade secrets misappropriation. Section 2 of the DTSA states unequivocally that "[a]n owner of a trade secret that is misappropriated may bring a civil action." One of the most significant provisions of the DTSA is the *ex parte* seizure provision. The *ex parte* seizure provision gives trade secret owners the right, in

extraordinary circumstances, to request the court to order the seizure of property if necessary to prevent the propagation or dissemination of the trade secret that is the subject of an action. Are attorneys requesting *ex parte* seizure orders and are courts granting such requests? The questions are important because oftentimes there is an urgent need for a company to stop a departing employee or a former business partner from taking or disclosing proprietary information. In an explosive new lawsuit filed in January 2018, Faraday Futures **alleges** that a former executive, Bill Strickland, “copied and took potentially thousands of FF’s most sensitive electronic documents from his FF computer and FF’s servers.” Tan Liu, a former employee of Rockwell Automation, Inc., was **charged** (since **acquitted**) with 12 counts of stealing trade secrets from Rockwell. Just before he left Rockwell, Liu allegedly downloaded 2,500 files containing Rockwell’s proprietary software and source code.

II. *Ex Parte* Seizure Order Under the DTSA

Under the DTSA, a court may issue an *ex parte* seizure order “only in extraordinary circumstances.” Courts appear to be reluctant to grant *ex parte* seizure orders and are granting it only in truly extraordinary circumstances. In **Mission Capital Advisors LLC v. Romaka**, the court awarded the first, and possibly the only, DTSA seizure order in the U.S. to date. In this case, Plaintiff Mission Capital Advisors LLC (“Mission”) accused an employee, Romaka, of downloading confidential company files including contact lists. Forensic examination of Romaka’s personal desktop had revealed that he had indeed downloaded a multitude of company files. Plaintiff requested a seizure order. When the defendant failed to acknowledge service or to show up for hearing, the court ordered the United States Marshals Service (“U.S. Marshal”) to copy onto a storage medium and delete specific files (the Contact Lists of Plaintiff Mission Capital Advisors LLC.) on the Defendant’s computer.

A request for an *ex parte* seizure order was denied in **Balearia Caribbean Ltd., Corp., v. Calvo**. Plaintiff Balearia Caribbean Ltd., Corp. (“BCL”) alleged that its former Chief Executive Officer, Hernan Calvo, misappropriated its trade secrets. Just before he left BCL, Calvo had his personal laptop computer reconfigured to access Balearia’s electronic information systems and secretly inserted an electronic command into his BCL email addresses to ensure that all email communications he received would be surreptitiously forwarded in their entirety to his private G-mail account. Nevertheless, the court denied BCL’s request to seize Calvo’s personal computer concluding that the applicant failed to demonstrate the “extraordinary circumstances contemplated by the DTSA.”

In **OOO Brunswick Rail Management v. Sultanov**, plaintiffs OOO Brunswick Rail Management and Brunswick Rail Group Limited (“Brunswick”) alleged that defendants, former employees, Richard Sultanov and Paul Ostling, misappropriated Brunswick’s confidential information. Plaintiff filed an *ex parte* application for inter alia a seizure order under the DTSA, a seizure and preservation order under Rule 65, and expedited discovery.

The court granted the request for a seizure and preservation order under **Rule 65** but denied the request for a seizure order pursuant to the DTSA concluding that seizure under the DTSA was unnecessary because an order under Rule 65 was adequate.

Attorneys appear to be using the DTSA's *ex parte* seizure process sparingly and are instead opting for temporary restraining orders (TROs) and orders for expedited discovery. In **Henry Schein, Inc. v. Cook, Henry Schein, Inc.** (HSI) alleged that defendant and former employee Jennifer Cook looted confidential data, failed to return her laptop for two weeks after she stopped working for HSI, unlawfully accessed HSI's computer system after her resignation and attempted to erase the e-mails that she sent from her HSI computer. Granting the plaintiff's request for a TRO, the court ordered the defendant to "immediately preserve all documents, data, tangible things, and other materials relating to th[e] case." The defendant was also enjoined "from altering, destroying, or disposing of any evidence or other materials, in any form, relating to th[e] action," and "from directly or indirectly accessing, using, disclosing, or making available to any person or entity other than Plaintiff, any of HSI's confidential, proprietary, or trade secret documents, data or information."

So what can we learn from the handful of cases that have addressed the DTSA's *ex parte* seizure provisions?

First, courts are reluctant to issue *ex parte* seizure orders. The only *ex parte* seizure order under the Act to date is that issued in *Mission Capital Advisors LLC v. Romaka*.

Second, courts appear to be more willing to allow more common forms of pre-trial relief, such as expedited discovery and TROs. In **Dazzle Software II v. Kinney**, the court denied plaintiff's request for civil seizure of computers and computer storage devices pursuant to the DTSA but granted in part a motion for expedited discovery that permitted the plaintiff to take the depositions of several key witnesses.

Third, a lot can be achieved with an "ordinary" TRO under Rule 65. In **Earthbound Corporation v. MiTek USA, Inc.**, the TRO required the defendant to inter alia "immediately deliver to a neutral third-party expert ... all flash drives, SD cards, cell phones, and other external drives ... that are in Defendants' possession, custody, or control," for forensic imaging at defendants' expense. In **Panera, LLC v. Nettles**, the court ordered the defendant to provide his personal laptop and any other materials that may have housed plaintiff's information for review and inspection.

Fourth, even if a plaintiff is successful in getting an *ex parte* seizure order, such an order is likely to be limited. The DTSA stipulates that *ex parte* seizure orders shall "provide for the narrowest seizure of property necessary to achieve the purpose of [the statute]." Not surprising, in *Mission Capital Advisors LLC v. Romaka*, the court only allowed the seizure of a single document, a contact list.

III. Conclusions

The legal and regulatory landscape for trade secret protection is changing in the United States and around the world. The usefulness of some of the recent laws are beginning to be tested in courts. Although an important piece of legislation, reliance the DTSA's *ex parte* seizure provision is still limited but is likely to grow. When it comes to using trade secret to protect innovations, extreme vigilance backed-up by appropriate contractual, technological and physical security measures remains the word. However, where an invention is patentable, the risk of disclosure is high, and reverse engineering is highly possible, a company would be well advised to consider patents over trade secrets.

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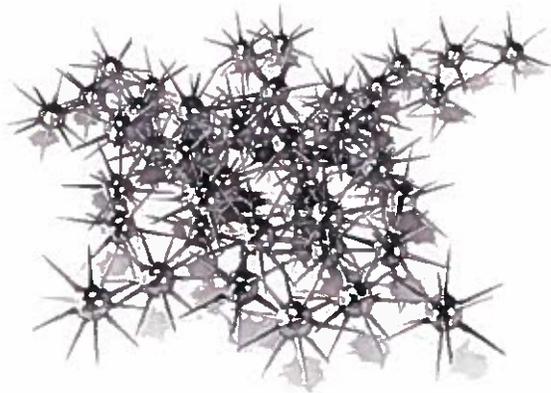
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Frank Broyles Publicity Rights Protection Act of 2016: Potential Minefields

By Uche Ewelukwa Ofodile



I. Introduction

In 2016, the Arkansas legislature passed the Frank Broyles Publicity Rights Protection Act (“Broyles Act” or “Act”).¹ Prior to the enactment of the Act, Arkansas recognized the tort of invasion of privacy-appropriation under common law.² The Act is significant because the right of publicity in the United States is essentially a state-based right and there is as yet no federal right of publicity statute. The Act comes at a time when social media is redefining what it means to be a celebrity and is also expanding the avenues for the exploitation of an individual’s personality. Because the right of publicity is not as well-understood or as widely practiced as other types of intellectual property rights, a lot of controversies and confusion surround this area of law. This article introduces the Frank Broyles Act, highlights thorny provisions of the statute, and discusses decisions of courts in other jurisdictions, that may provide guidance for attorneys and courts in Arkansas.

II. Right of Publicity: What is it?

The right of publicity derives from the common law tort of invasion of the right of privacy³ and is defined as the right to prevent the unauthorized commercial use of one’s identity.⁴ No federal statute explicitly recognizes the right of publicity, although some measure of protection is available under the Trademark Act of 1946 (the Lanham Act). In the U.S., the right of publicity is protected primarily through state common law and/or statutory law and was first articulated by the Second Circuit Court of Appeals in 1953.⁵ Although about 38 states now recognize the right of publicity, not every state has codified this right.

III. The Frank Broyles Publicity Rights Protection Act of 2016: Overview

The key features of the Broyles Act are outlined in this section. Who is protected, what is protected, and the elements of a statutory right of publicity claim in Arkansas, as well as the key exceptions to the right of publicity in Arkansas are discussed.



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A. What is Protected?

The Broyles Act protects five aspects of an individual's identity: name, voice, signature, photograph, and likeness.⁶ The Act does not protect every aspect of an individual's identity. Thus, distinctive appearances, gestures, and mannerisms, as well as unique phrases are not explicitly recognized under the Act.⁷

B. Who Is Protected?

The Broyles Act protects only natural persons, living or dead.⁸ Arkansas' statutory right of publicity is not limited to celebrities. Members of church choirs, soccer moms, aspiring models, local farmers, and children are protected. The right is available "only to individuals maintaining a domicile or residence in the State" on or after the effective date of the Act.⁹

C. Duration of Rights; Postmortem Protection

The Act offers robust post-mortem protection. This statutory right of publicity survives death and is fully descendible and transferable.¹⁰ The rights are exclusive to "[a]n individual during the individual's lifetime" and to "[t]he executors, administrators, heirs, devisees, and assignees of the individual for fifty (50) years after the individual's death."¹¹ An individual's post-mortem right of publicity in Arkansas is not contingent on lifetime exploitation and is not lost if the individual's successors fail to exploit it.

D. Elements of a Right of Publicity Claim

The Act reaches unauthorized commercial use of an individual's protected identity. To make out a publicity rights claim under the Act, a plaintiff must plead and prove:

- ownership of a valid and protectable right;
- commercial use by a defendant of a living or deceased individual's "readily identifiable" name, voice, signature, photograph, and/or likeness; and
- lack of consent.

Intent is not an element of a right of publicity claim in Arkansas and commercialization is not a prerequisite to a valid and protectable right of publicity under the Act. Furthermore, the Act provides that "[t]he existence or nonexistence of profits from the unauthorized commercial use shall not be a criterion for determining liability."¹²

E. Key Exceptions and Exclusions

The Broyles Act provides exemptions and

exceptions from liability for a number of activities including *inter alia*:

- use "[i]n connection with a news, public affairs, or sports broadcast, ... an account of public interest, or a political campaign;"¹³
- use in "[a] work of political, public interest, or newsworthy value ...;"¹⁴
- use in a photograph or likeness where the individual appears as a member of the public, an attendee of a photographed event, or in a public place, and the individual is not named; and
- specified uses by an institution of higher education or by a nonprofit organization, club, or supporting foundation.

F. Common Law Right of Publicity

Any pre-existing common law right of publicity does not survive the Act.¹⁵ This is very significant because unlike the statutory "laundry list" of particular means of appropriating an individual's right of publicity, the common law right of publicity protects "identity" broadly construed.

G. Remedies

Remedies available under the Act are limited to injunctive relief, actual damages, and profits. Unlike Indiana's right of publicity statute, the Act does not provide for statutory damages, treble damages, punitive damages, attorneys' fees or costs.¹⁶ The Broyles Act does not appear to provide for preliminary injunctive relief either;¹⁷ a court may issue an injunction only "upon finding a violation." Significantly, the remedies granted under the Act constitute the exclusive basis for asserting a claim for the unauthorized commercial use of protected identity in Arkansas.¹⁸

IV. Thorny Issues in the Frank Broyles Publicity Rights Protection Act of 2016: Guidance for Attorneys and the Courts

Several provisions of the Act are likely to pose interpretive challenges for the courts. Moreover, with wide disparity in right of publicity laws of different states, difficult jurisdictional issues and choice of law issues should be expected. Faced with matters of first impression, courts in Arkansas could look at the decisions of courts in other jurisdictions for guidance.

A. Protected Identity

Arkansas law explicitly protects name, likeness, voice, photograph and signature. A lot of battles can be expected over what precisely is protected. While "likeness" and "photo-

graph" are defined in the statute, "name," "voice" and "signature" are not defined.

One issue that may arise is whether "name" includes former names, assumed names, and nicknames. The Broyles Act is somewhat ambiguous on the issue. By contrast, Indiana's right of publicity statute explicitly provides that "name" means "the actual or assumed name ... that is intended to identify the person."¹⁹ The Broyles Act protects an individual's "readily identifiable" name. Consequently, "identifiability" will be the analytical key and the trigger. One of the Plaintiff's challenges will be proving that he or she is readily identified by a given name. By analogy, an Arkansas attorney could turn to persuasive cases. For example, in the case of *Ali v. Playgirl, Inc.*, a drawing of a nude black man labeled "The Greatest" was found to infringe Mohammed Ali's right of publicity.²⁰ The *Ali* court took judicial notice of the fact that Ali had regularly claimed that appellation "the Greatest" for himself and that his efforts to identify himself in the public mind as "the Greatest" had been so successful that he was regularly identified as such in the news media. In the case of *Abdul-Jabbar v. Gen. Motors Corp.*,²¹ former NBA player Kareem Abdul-Jabbar successfully sued General Motors Corporation when the company used the name "Lew Alcindor" in commercial advertising. Kareem Abdul-Jabbar was named Ferdinand Lewis ("Lew") Alcindor at birth, but had not used the name "Lew Alcindor" for commercial purpose for about 10 years at the time the lawsuit was filed.

Voice misappropriation is a specie of the violation of the right of publicity. It is unclear whether the Broyles Act creates a cause of action for the deliberate imitation of an individual's voice. Courts in California have generally construed the statutory protection of "name, voice, signature, photograph or likeness" more narrowly than the common law's protection of "identity." Thus, although California courts have upheld voice misappropriation claims involving sound-alikes, they have done so under California's common law, not under the state's right of publicity statute. In *Midler v. Ford Motor Co.*, Ford Motor Company used a Bette Midler "sound-alike" in a commercial.²² The Ninth Circuit rejected Bette Midler's statutory right of publicity claim even though the relevant statute prohibits unauthorized use of a person's "name, voice, signature, photograph or likeness" on the reasoning that

the defendants “did not use Midler’s name or anything else whose use is prohibited by statute.” However, the same court concluded that Midler had stated a claim for violation of her California common law right of publicity because “the defendants ... did appropriate part of her identity” by using a Midler sound-alike. The Ninth Circuit reached a similar conclusion in *Waits v. Frito-Lay*, a case involving a Doritos commercial in which a relatively unknown singer was used to mimic Tom Waits’ gravel voice.²³

The Broyles Act defines “likeness” as “a reproduction of the image of an individual by any means other than a photograph.”²⁴ This could prove problematic. At what point does a caricature or an impressionistic resemblance become a “likeness”? Is there a difference between a robot with mechanical features and a mannequin molded to an individual’s precise features? Courts in California have generally construed “likeness” more narrowly than “identity.” In *White v. Samsung Elecs. Am., Inc.*, the Ninth Circuit affirmed a decision of the district court that a robot that dressed and posed like Vanna White next to a “wheel of Fortune” was not White’s “likeness” within the meaning of California’s right of publicity statute. However, the Ninth Circuit also concluded that White’s claim for misappropriation of identity may be actionable under the state’s common law.²⁵ It would appear that whether an animatronic figure is a likeness of an individual has to be determined without reference to the familiar clothing and setting typically associated with the individual.²⁶

B. Commercial Uses and Incidental Uses

The Broyles Act only prohibits unauthorized commercial uses. Commercial use is defined as use “[f]or advertising, selling, or soliciting purchases of products, merchandise, goods, or services,” and use “[o]n or in connection with products, merchandise, goods, or other commercial activity that is not exempt.” A challenge for the courts will be determining how and where to draw the line between commercial use and non-commercial use. Is the use of an individual’s identity for fundraising actionable? The Act is silent on the issue while Indiana’s law explicitly defines “commercial purpose” to include fundraising.²⁷ What can be made of expressive works such as books, films, paintings, songs, and video games which communicate ideas

but at the same time generate considerable profit for the producer? The Broyles Act exempts use of a protected identity in “[a] play, book, magazine, newspaper, musical composition, visual work, work of art, audiovisual work, radio or television program ... or a dramatic, literary, or musical work.”²⁸ Even cases involving commercial advertisement can present complex issues for the courts. In 2009 when Michael Jordan was inducted into the Basketball Hall of Fame, two grocery chains, Jewel Osco and Dominick’s, ran advertisements congratulating Jordan on his induction. Dominick’s advertisement contained a statement “You are a cut above” over a steak coupon while Jewel Osco’s advertisement contained the store’s tag line “Good things are just around the corner.” In *Jordan v. Jewel Food Stores, Inc.*,²⁹ one issue before the court was whether the store’s ad was fully protected noncommercial speech. The Seventh Circuit explored the boundaries of commercial speech and ultimately held that Jewel’s ad was not constitutionally protected speech.

C. Consent

Under the Broyles Act, consent is required to use one’s identity. The Act does not call for written consent, however.³⁰ This could prove problematic particularly in the context of social media platforms. When users agree to a platform’s Term of Use, what exactly are they consenting to and to whom are they giving the consent? Does posting a picture on Flickr, snapchat or Twitter imply consent to everyone on the platform to use the photos? Few courts have defined “consent” in the right of publicity context. *Fraley v. Facebook, Inc.*, a class action suit against Facebook for its Sponsored Stories, demonstrate that the issue of consent in the context of social media can prove to be very problematic and embarrassing for all concerned.³¹

D. First Amendment Vs. Right of Publicity

“The interaction between the right of publicity and the constitutional freedom of speech is perhaps one of the murkiest areas of right of publicity law.”³² While the federal circuits and state courts agree that the right of publicity must be balanced against First Amendment considerations, they disagree on how and where to strike the balance. When it comes to resolving the tension between the right of publicity and the First Amendment, courts apply vastly different tests. The tests are highly contradictory and unpredictable.

At least five different tests have been applied. The Second, Fifth and Sixth Circuits apply the Rogers test,³³ the Third Circuit and the Ninth Circuit apply the Transformative Use test,³⁴ the Sixth Circuit has applied the Transformative Work test,³⁵ and some Circuits (the Eighth, Tenth, and Eleventh) frequently use a more flexible, ad hoc balancing test.³⁶ State courts are also coming up with their own tests. The Missouri Supreme Court has applied a “Predominant Purpose” test.³⁷ The U.S. Supreme Court has addressed the right of publicity only once in *Zacchini v. Scripps-Howard Broadcasting Co.*³⁸ and has, thus far, offered no guidance on the issue. The good news is that Arkansas’ right of publicity statute permits broad First Amendment exemptions. The bad news is that there are a number of gray areas that are not addressed or not well addressed in the statute. For example, the Act specifically exempts use in “[a] work of political, public interest, or newsworthy value including ... a transformative creation of a work of authorship.”³⁹ Unfortunately, the Act does not define “transformative.”

E. Copyright Preemption Doctrine

The “Copyright Preemption” doctrine is alive and well.⁴⁰ Pursuant to 17 U.S.C. § 301(a) of the Copyright Act, federal copyright law preempts all state-law claims regarding rights that are equivalent to the exclusive rights protected under § 106 of the Act. To determine whether a state-law claim is preempted, courts generally ask two questions. First, does the claim fall “within the subject matter of copyright” as defined by 17 U.S.C. § 102?⁴¹ Second, does the cause of action implicate rights that are “equivalent” to any of the exclusive rights of a federal copyright?⁴² To avoid copyright preemption, a right of publicity claim must contain at least an “extra element” that is “qualitatively different” from the elements required to prove copyright infringement.⁴³

In a case decided on April 5, 2017, *Maloney v. T3 Media, Inc.*, the Ninth Circuit ruled that a publicity-right claim “is not preempted when it targets non-consensual use of one’s name or likeness on merchandise or in advertising.”⁴⁴ However, the Ninth Circuit went on to hold that “when a likeness has been captured in a copyrighted artistic visual work and the work itself is being distributed for personal use, a publicity-right claim interferes with the exclusive rights of the copyright holder, and is preempted by section 301 of the Copyright Act.”

F. Actual Damages

The only remedies available under the Act are actual damages, defendant's profit, and permanent injunction. Consequently, significant battles over the calculation of actual damages can be expected. In calculating actual damage commercial injury to plaintiff is usually the primary focus and courts typically try to determine the fair market value of the property right in the plaintiff's identity which the defendant used.⁴⁵ While Bette Midler was awarded \$400,000 for the Ford commercial and Michael Jordan got an \$8.5M jury award against Dominick's grocery chain, most cases will not result in a multi-million dollar award. Request for damages have been denied where plaintiff could not prove injury.⁴⁶

G. Nationwide Injunction

In fashioning injunctions, the geographical reach of the injunctions could prove controversial. Because the right of publicity is a state-based right, what is prohibited in Arkansas may be legal in other states. This begs the question of whether Arkansas' courts will issue nationwide injunctions when a complained-of act occurs outside Arkansas and is legal in the state in which it occurred? Nationwide injunctions in right of publicity cases are troublesome and could be found to violate the Due Process Clause and the Commerce Clause of the Constitution.⁴⁷ Apart from the Constitutional questions, the interests of comity may strongly favor more limited injunctions.

V. Conclusion

The Frank Broyles Act gives individuals, celebrities and non-celebrities, the exclusive right to control, direct and commercially use their name, voice, signature likeness and/or photograph. Given that the right to commercially exploit one's protected identity can be an extremely valuable asset, this right cannot and should not be ignored in determining the value of a decedent's estate. Entertainment lawyers, intellectual property lawyers, tax attorneys and even estate planning attorneys all need to be aware of the Frank Broyles Act. For all its growing popularity, the right of publicity law is very controversial and, as applied to nonadvertising uses involving expressive works, has to survive strict scrutiny. Although numerous calls have been made for a federal right of publicity statute, none appears to be in the horizon.⁴⁸ Until a federal right of publicity statute comes into

existence, attorneys and courts will have to grapple with constitutional restraints on state right of publicity laws, difficult jurisdictional issues, as well as complex choice of law questions arising from the fact that different states have widely divergent right of publicity laws. Given unprecedented technological advances, novel claims that implicate the right of publicity and raise novel issues in law should also be expected.

Endnotes:

1. ARK. CODE ANN. § 4-75-1101 (2016).
2. *Olin Mills, Inc. v. Dodd*, 234 Ark. 495, 353 S.W.2d 22 (1962); *Stanley v. Gen. Media Communications, Inc.*, 149 F. Supp. 2d 701 (W.D. Ark. 2001).
3. RESTATEMENT (SECOND) OF TORTS, § 652A (1977); see also William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 398-407 (1960).
4. J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1:23 (2d ed. 2012).
5. *Haelan Laboratories Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).
6. ARK. CODE ANN. § 4-75-1104.
7. IND. CODE ANN. § 32-36-1-6. Section 6 protects personality defined to mean: name, voice, signature, photograph, image, likeness, distinctive appearance, gesture, and mannerisms.
8. ARK. CODE ANN. § 4-75-1103(2).
9. ARK. CODE ANN. § 4-75-1113(b).
10. ARK. CODE ANN. § 4-75-1104(b)(3)(A).
11. ARK. CODE ANN. § 4-75-1107.
12. ARK. CODE ANN. § 4-75-1109(c)(3).
13. ARK. CODE ANN. § 4-75-1110(a)(1)(A).
14. ARK. CODE ANN. § 4-75-1110(a)(1)(B)(ii).
15. ARK. CODE ANN. § 4-75-1111(b).
16. IND. CODE ANN. § 32-36-1-10, Section 10 (providing for statutory damages, punitive damages, and treble damages). See also IND. CODE ANN. § 32-36-1-12 (providing for reasonable attorney's fees, costs, and expenses relating to an action.).
17. IND. CODE ANN. § 32-36-1-12, Section 12(2) (providing for temporary or permanent injunctive relief).
18. ARK. CODE ANN. § 4-75-1111(a).
19. IND. CODE ANN. § 32-36-1-3.
20. 447 F. Supp. 723, 728 (S.D.N.Y. 1978).
21. 85 F.3d 407 (9th Cir. 1996).
22. 849 F.2d 460 (9th Cir.1988).
23. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).
24. ARK. CODE ANN. § 4-75-1103(3).
25. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992).
26. *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284 (9th Cir. 1999).
27. IND. CODE ANN. § 32-36-1-2.
28. ARK. CODE ANN. § 4-75-1110 (a)(1)(B)(i).
29. 743 F.3d 509, 522 (7th Cir. 2014).
30. By contrast, Indiana's right of publicity statute explicitly requires written consent. IND. CODE ANN. § 32-36-1-8, Section 8(a).
31. 830 F. Supp. 2d 785 (N.D. Cal. 2012).
32. Gil N. Peles Esq., *The Right of Publicity: A Practitioner's Enigma*, 17(2) J. OF INTELLECTUAL PROPERTY LAW 351-359 (2010).
33. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).
34. *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* ("Keller v. Electronic Arts"), 724 F.3d 1268, 1271 (9th Cir. 2013); *Hart v. Electronic Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013).
35. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003).
36. *C.B.C. Dist. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007); *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959 (10th Cir. 1996); *Toffoloni v. LFP Publ'g Grp.*, 572 F.3d 1201 (11th Cir. 2009).
37. *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003).
38. 433 U.S. 562 (1977).
39. ARK. CODE ANN. § 4-75-1110 (a)(1)(B)(ii). Emphasis added.
40. *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986).
41. *Carson v. Dynegy*, 344 F.3d 446, 456 (5th Cir. 2003).
42. *Id.*
43. *Michaels v. Internet Entmt. Group, Inc.*, 5 F. Supp. 2d 823, 837 (1998).
44. Case No. 15-55630 (9th Cir. April 5, 2017).
45. *Jordan v. Dominick's Finer Foods, LLC*, 115 F. Supp. 3d 950 (N.D. Ill. 2015).
46. *Andretti v. Borla Performance Industries, Inc.*, 426 F.3d 824 (6th Cir. 2005).
47. *Herman Millar, Inc. v. Palazzetti Imports & Exports, Inc.*, 270 F.3d 298, 323-324 (6th Cir. 2001).
48. International Trademark Association, Board Resolution: U.S. Federal Right of Publicity, 3 March 1998, available at <http://www.inta.org/Advocacy/Pages/USFederal-RightofPublicity.aspx>. ■



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The Right of Publicity Q&A: Arkansas' Publicity Rights Protection Act of 2016

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Edited by:

JURIST Guest Columnist [Professor Uché Ewelukwa Ofodile](#) of the University of Arkansas School of Law discusses answers to questions about Arkansas' new right of publicity legislation ...

The right of publicity is the right to control the commercial use of one's identity. Over the years, a growing number of celebrities, athletes and sports personalities have brought lawsuits to enforce their right of publicity including [Vanna White](#) of "Wheel of Fortune" fame, [Tom Waits](#), [Bette Midler](#), [Jesse "The Body" Ventura](#), Michael Jordan, Tiger Woods, Hulk Hogan, and Muhammed Ali. In some states, the right of publicity extends beyond the grave and has been

exercised on behalf of dead personalities such as **Elvis Presley** and **Jimi Hendrix**. In the United States (U.S.), a growing number of states have adopted right of publicity statutes (e.g. **California**, **Indiana**, and **Illinois**) and a few more are considering adopting similar statutes. When seven-time Grammy-winning singer Prince died in 2016, a bill – the “Personal Rights in Names Can Endure” (or PRINCE) Act – was immediately introduced in the state legislature in an attempt to codify the right of publicity in Minnesota law; the bill was subsequently retracted. In April 2016, the Arkansas legislature passed the **Frank Broyles Publicity Rights Protection Act of 2016** (“Frank Broyles Act” or “Act”).

It is important for individuals in the U.S. and outside the U.S. to be aware of the right of publicity law applicable in a state like Arkansas because unlike trademarks, patents, and copyrights, which are governed by federal law, in the U.S. the right of publicity is a state law intellectual property right. Moreover, thanks to globalization, a growing number of people from around the world are having reason to be in Arkansas and may have reason to seek to enforce their right of publicity in a state court. For instance, Arkansas is home to the world’s largest retailer, Wal-Mart.

1. What does the Frank Broyles Act protect?

The Act creates a property right in the commercial use of one’s identity. The Act protects five aspects of an individual’s identity: name, voice, signature, photograph, and likeness from unauthorized commercial use. The Act does not protect every aspect of an individual’s identity. The Act does not protect distinctive appearances, gestures, unique phrases, and mannerisms.

2. Who does the Frank Broyles Act protect? Does the Frank Broyles Act protect children?

The Act protects individuals defined as “natural persons whether living or dead.” Children of all ages are protected. However, the Act does not protect pets and other animals.

3. Does the Frank Broyles Act require an identity-holder to be a celebrity or to have a commercially valuable identity?

No. Unlike the law of some states, in Arkansas an identity holder need not be a celebrity. However, although the Act protects ordinary individuals, non-celebrities may have a harder time proving actual damages resulting from any unauthorized use of their identity.

4. Does protection under the Frank Broyles Act hinge on whether an individual is exploiting or has exploited his or her identity in the past?

No. Prior exploitation of an individual’s identity is not required to trigger the right of publicity in Arkansas.

5. Is the right of publicity created by the Frank Broyles Act transferable?

Yes. The property right created by the Act is freely transferable, assignable, licensable, and descendible, in whole or in part, by contract or by a trust, testamentary disposition, or other instrument.

6. How long does the right of publicity in Arkansas last? Does the right expire upon the death of an individual?

Arkansas' right of publicity lasts throughout the lifetime of an individual and for fifty (50) years after the individual's death. In other words, dead individuals have a protectable right of publicity in Arkansas. Under the Act, an individual's right of publicity is exclusive to the individual during the individual's lifetime. After death, the right is exclusive to the individual's executors, administrators, heirs, devisees, and assignees.

7. What types of uses does the Frank Broyles Act prohibit? Is registration required to exercise Arkansas' Statutory right of publicity?

The Act only prohibits unauthorized "commercial use" of an individual's identity. Commercial use is defined as the use of an individual's 'readily identifiable' name, voice, signature, photograph, or likeness "[f]or advertising, selling, or soliciting purchases of products, merchandise, goods, or services;" or "[o]n or in connection with products, merchandise, goods, or other commercial activity that is not exempt."

8. Is registration required to exercise a right of publicity in Arkansas?

No. Formal registration is not required to exercise a right of publicity under the Act. However, to fully exercise and enforce a post-mortem right of publicity, it is advisable for a successor-in-interest of a descendant's right of publicity to register his or her claim of property rights.

9. Is domicile and/or residence in Arkansas required to exercise Arkansas' statutory right of publicity?

Yes. Protection under the Act is available "only to individuals maintaining a domicile or residence in the State of Arkansas" on or after the effective date of the Act. Although protection under the Act is available only to individuals maintaining a domicile or residence in Arkansas, given the presence of a growing number of Fortune 500 companies in the State, more and more people from across the U.S. and around the world have reason to be in the state and may have cause to enforce their right of publicity in the state.

10. Is any and every use of an individual's identity absolutely prohibited in Arkansas?

No. The Act exempts several types of uses from liability including: (i) use "[i]n connection with a news, public affairs, or sports broadcast, ... an account of public interest, or a political campaign;" (ii) use in work of political, public interest, or newsworthy value including a comment, criticism, parody, satire, or a transformative creation of a work of authorship; and (iii) use in a photograph or likeness where the individual appears as a member of the public, an attendee of a photographed event, or in a public place, and the individual is not named.

In conclusion, the right of publicity is going global. Sometimes foreign nationals bring right of publicity claims in the U.S. and other times, U.S. citizens attempt to enforce their right of publicity overseas. Former Panamanian dictator Manuel Noriega (**against Activision Blizzard, Inc.**) and legendary Brazilian soccer player Pelé (against **Samsung Electronics Co.** [complaint])

have both brought lawsuits in the U.S. to enforce their right of publicity. In turn, U.S. celebrities – Michael Douglas and Catherine Zeta-Jones – successfully enforced their rights of publicity in the United Kingdom by bringing a breach of confidence cause of action.

The provisions of the Frank Broyles Act are yet to be litigated in court. How to appropriately balance the right of publicity against the public interest in free speech and free press will be a challenge for courts in Arkansas. Moreover, unlike Indiana's **right of publicity statute** that contain broad jurisdictional and choice of law provisions, the Act lacks a choice of law provision. It thus remains to be seen how court in Arkansas will address thorny jurisdictional questions if and when they arise.

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