

**DR. SEUSS, THE JUICE AND FAIR USE
REVISITED:
TWO DECADES OF PARODY AND SATIRE IN
COPYRIGHT LAW¹**

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I. INTRODUCTION

For the IP Redux Conference, I chose to revisit my article *Dr. Seuss, The Juice and Fair Use: How the Grinch Silenced a Parody*.³ I chose this article for three reasons: it was my first published article as a sole author; it was my first published article on a topic related to intellectual property; and 2018 marks the 20th anniversary of the article's

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³ See Tyler T. Ochoa, *Dr. Seuss, The Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT. SOC'Y 546 (2008).

publication, so it seemed like an opportune time to revisit the article and opine on what has happened to the law of parody and satire during the last two decades.

Part II of this essay will summarize some of the salient features and arguments made in the article. Part III will analyze copyright infringement cases in the last 20 years applying the fair use doctrine to parody and satire. Part IV concludes.

II. A LOOK BACK AT THE ARTICLE

I wrote the article in response to the decision in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*⁴ In that case, the Ninth Circuit affirmed a preliminary injunction barring publication of a book titled *The Cat NOT in the Hat!*, labeled “A Parody by Dr. Juice.”⁵ The book was “a satirical account of the O.J. Simpson trial written in the style of Dr. Seuss.”⁶ Despite the clear principle that an author’s style is not supposed to be protected by copyright,⁷ the Ninth Circuit

⁴ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997).

⁵ “As Told to Alan Katz [and] Illustrated by Chris Wrinn.” The book was scheduled to be published by Penguin Books in 1997, prior to the injunction.

⁶ *See* Ochoa, *supra* note 3, at 547.

⁷ *See* *Williams v. Gaye*, 885 F.3d 1150, 1182 (9th Cir. 2018) (“Our decision does not grant license to copyright a musical style or ‘groove.’”); *Hayuk v. Starbucks Corp.*, 157 F. Supp. 3d 285, 291 (S.D.N.Y. 2016) (“Defendants have copied her style or elements of her ideas, neither of which are protected by copyright law.”); *Trek Leasing, Inc. v. U.S.*, 66 Fed. Cl. 8, 13 (2005) (“The hallmarks of a popular architectural style, as such, are not protectable”); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 35 (1st Cir. 2001) (“copyright does not provide protection for the particular style of photography chosen by Yankee”). *But see* *Salinger v. Colting*, 641 F. Supp. 2d 250, 266–67 (S.D.N.Y. 2009) (citing “Colting’s adoption of Plaintiff’s characteristic style” as part of infringement analysis), *rev’d on other grounds*, 607 F.3d 68, 74 (2d Cir. 2010) (approving district court’s finding that defendant copied more “in both substance and style, than

found the alleged parody infringed the copyright in the Dr. Seuss book *The Cat in the Hat*, based primarily on the appearance of the Cat's red-and-white stovepipe hat on the front and back cover (and 13 times in the text) of the work.⁸ The article is, essentially, an eighty-eight-page rebuttal to the Ninth Circuit's opinion.

The title of the article has several layers of meaning. It conveys that the article concerns the works of Dr. Seuss, O.J. Simpson (nicknamed "The Juice"),⁹ the fair use doctrine, and parody; and it does so with a triple rhyme reminiscent of Dr. Seuss's works.¹⁰ The triple rhyme makes it memorable, as shown by its inclusion in a compilation of memorable law review article titles.¹¹ The title also compares the plaintiff, Dr. Seuss Enterprises, with one of Dr. Seuss's best-known characters, the Grinch.¹² On the downside, the title does not include the word "copyright," so

[was] necessary for the alleged transformative purpose"). To be fair to the *Dr. Seuss* court, the pre-1998 case law was less settled. Compare *Steinberg v. Columbia Pictures Indus., Inc.*, 663 F. Supp. 706, 712 (S.D.N.Y. 1987) (citing "the striking stylistic relationship" between the works, because "style is one ingredient of 'expression'"), with *Judith Ripka Designs, Ltd. v. Preville*, 935 F. Supp. 237, 248 (S.D.N.Y. 1996) ("The copyright laws do not protect styles, but only particular original designs.").

⁸ See Ochoa, *supra* note 3, at 587 n.242, 589–590 n.259–260, 600 n.313, 603–604 n.327–339.

⁹ *O.J. Simpson*, WIKIPEDIA, https://en.wikipedia.org/wiki/O._J._Simpson ("Simpson acquired the nickname 'Juice' as a play on 'O.J.', a common abbreviation for 'orange juice.'").

¹⁰ In retrospect, however, I am appalled that I omitted the "Oxford comma" in the tripartite title.

¹¹ See Stephanie J. Willbanks, *What's in a Name? Would a Rose by Any Other Name Really Smell as Sweet?*, 63 J. LEGAL EDUC. 647, 662 (2014).

¹² See DR. SEUSS, *HOW THE GRINCH STOLE CHRISTMAS!* (1957). The comparison is imperfect, however, because the lawsuit lacks the happy ending in which the Grinch learns to share in the joy of others, rather than trying to take things away from them.

it doesn't show up in a simple word search for titles about copyright law.¹³

The Introduction of the article begins with a parody of the opening stanzas of *How the Grinch Stole Christmas!*¹⁴ This time, however, the Grinch is compared to the three judges of the Ninth Circuit panel that decided the case, rather than to the plaintiff.¹⁵ Opening an article about parody with a parody was very meta; although, in retrospect, it seems I relied on my memory of the original, rather than going back to the original to mimic it more closely.¹⁶ For example, I could have copied the line spacing, italics, and capitalizations more closely, and I could have retained the original order of the fifth and sixth sentences:

Every *Who*
Down in *Who*-ville
Liked parody a lot ...
But the Ninth Circuit Grinches,
With jurisdiction over *Who*-ville,
Did NOT!
The Grinches *hated* parody, whatever the season!

¹³ Eugene Volokh also advised me to change the second part of the title (after the near-obligatory colon), because in his opinion it suggests that the article is merely a case note on the *Dr. Seuss* case, rather than a thorough examination of how the fair use doctrine historically has been applied to parodies. He probably was correct, but I stubbornly kept the title unchanged because I liked how it scanned and the Grinch analogy.

¹⁴ See Ochoa, *supra* note 3, at 546–47.

¹⁵ Yes, I was inconsistent in my use of the Grinch analogy. So, sue me.

¹⁶ “[T]he truest parodies are those that tamper least with the material they are spoofing. Just enough to blow them sky-high. That’s all.” Charles Poore, *Ardent Plea for the Art of Parody*, N.Y. TIMES MAG., March 9, 1958, at 33; see also C. HUGH HOLMAN & WILLIAM HARMON, A HANDBOOK TO LITERATURE 344 (6th ed. 1992) (“Note that the craft of parody prizes minimal tampering.”); Robert J. Kapelke, Comment, *Parody or Piracy: Never the Twain*, 38 U. COLO. L. REV. 550, 565 (1966) (“To make his parody complete and effective the parodist has always tended to stick very closely to the script of the original.”).

Now, please don't ask why. No one quite knows the reason.
It *could* be their heads weren't screwed on just right.
It *could* be, perhaps, that their ties were too tight.
But I think that the most likely reason of all
May have been that their sense of humor was two sizes
too small.

That is perhaps an even better parody, although I think my first effort got the point across.¹⁷

Part II of the article is a sixteen-page analysis of the importance of parody and satire in literature and popular culture.¹⁸ This section was added at the suggestion of my frequent co-author Andrew Wistrich,¹⁹ who remarked that my first draft assumed that readers would share my views on the importance of parody and satire, and that I needed to demonstrate its importance instead. Summarizing and synthesizing the non-legal academic literature on parody and satire was difficult and time-consuming, but the added section became (in my opinion) one of the most important and effective pieces of the article.

Part III of the article contains five subsections. Part III-A summarized the basic principles of fair use,²⁰ as elaborated in the first two of a trio of post-1976 Supreme Court cases.²¹ Part III-B examined the development of fair

¹⁷ There is a balance between mimicking the original more closely and making the desired analogy. I changed “Grinch” to “Grinches” because an appellate panel consists of three judges; but leaving the parody in the singular would have avoided the grammar problem in the last sentence, which in plural form should be: “May have been that their senses of humor were two sizes too small.” But that would have thrown the meter off even more. As it was, I changed “may have been” to “was” in part to compensate for changing “heart” to “sense of humor.”

¹⁸ See Ochoa, *supra* note 3, at 548–64.

¹⁹ U.S. Magistrate Judge, Central District of California (retired 2018).

²⁰ See Ochoa, *supra* note 3, at 564–71.

²¹ See *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985). For reasons to be explained, the third case, *Campbell v.*

use as applied to parody from the mid-1950s to the Copyright Act of 1976.²² Part III-C continued the story of parody as a fair use after fair use was codified in section 107 of the 1976 Act.²³ Part III-D summarized the then-recent decision in *Campbell v. Acuff-Rose Music, Inc.*,²⁴ in which a unanimous Supreme Court held that a rap parody of the song *Pretty Woman* could qualify as a fair use.²⁵ Part III-E briefly summarized what was then the only other post-*Campbell* appellate opinion involving parody.²⁶ The core of this section (Parts III-A to III-C) was written as a seminar paper in my Advanced Copyright course at Stanford Law School.²⁷ One decade later, it was relatively easy to add the last two subsections to bring the paper up to date.

Part IV of the article recounts the facts and the District Court and Ninth Circuit opinions in the *Dr. Seuss* case.²⁸ Part V of the article, “A Critical Analysis of the Ninth Circuit’s Opinion,” is essentially a forty-four-page dissenting opinion, explaining why the Ninth Circuit should have held that the parody was a fair use under copyright law,²⁹ and should have rejected the preliminary injunction under trademark law as well.³⁰ The major points were that the Ninth Circuit erred: 1) in holding that the book was not a “parody” as defined by the Supreme Court;³¹ 2) in holding

Acuff-Rose Music, Inc., 510 U.S. 569 (1994), was left for a later subsection.

²² See Ochoa, *supra* note 3, at 571–74.

²³ 17 U.S.C. § 107 (2012); see Ochoa, *supra* note 3, at 574–80.

²⁴ *Campbell*, 510 U.S. at 569.

²⁵ See Ochoa, *supra* note 3, at 580–84.

²⁶ *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109 (2d Cir. 1998); see Ochoa, *supra* note 3, at 584–85.

²⁷ With thanks to my teacher, Professor Paul Goldstein.

²⁸ See Ochoa, *supra* note 3, at 584–89.

²⁹ *Id.* at 589–620.

³⁰ *Id.* at 620–33.

³¹ *Id.* at 590–94.

that, as a “satire,”³² it could not qualify as a “transformative” use,³³ even though the Supreme Court did not draw any such bright line;³⁴ 3) in holding that the copying was excessive in relation to the purpose, when the parody used only the Cat’s red-and-white stovepipe hat, about as minimal a use as could be imagined to “conjure up” the original;³⁵ 4) in applying a presumption of market harm that the Supreme Court had expressly disavowed in *Campbell*;³⁶ 5) in giving greater protection against criticism to the fictional characters of Dr. Seuss than actual person would enjoy;³⁷ and 6) in also enjoining the parody on trademark grounds, despite the lower court’s finding that there was *no* likelihood of confusion.³⁸

The article has been cited 40 times in the academic literature,³⁹ including once by Judge Alex Kozinski,⁴⁰ and

³² The difference, according to the Supreme Court, is that a parody comments, at least in part, on the work being copied; whereas a satire uses the work being copied to comment solely on something else. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–581 n.15 (1994). This distinction was made most forcefully in Justice Kennedy’s concurring opinion, *Campbell*, 510 U.S. at 597 (Kennedy, J., concurring), which no other Justice joined.

³³ See Ochoa, *supra* note 3, at 594–99.

³⁴ To the contrary, the Supreme Court clearly indicated that a satire *could* qualify as a transformative use and as a fair use. See *Campbell*, 510 U.S. at 580–81 n.14.

³⁵ See Ochoa, *supra* note 3, at 600–04; *Campbell*, 510 U.S. at 588 (“the parody must be able to ‘conjure up’ *at least* enough of that original to make the object of its critical wit recognizable”) (emphasis added).

³⁶ See Ochoa, *supra* note 3, at 604–14; *Campbell*, 510 U.S. at 591.

³⁷ See Ochoa, *supra* note 3, at 615–20.

³⁸ *Id.* at 620–33.

³⁹ That figure does not include 10 self-citations.

⁴⁰ See Alex Kozinski & Christopher Newman, *What’s So Fair About Fair Use?*, 46 J. COPYR. SOC’Y USA 513, 514 & n.4 (1999). That was a more highly-ranked citation before Judge Kozinski retired in the wake of a #MeToo movement-inspired scandal. See Matt Zapposky, *Federal Appeals Judge Announces Immediate Retirement Amid Probe of Sexual Misconduct Allegations*, WASH. POST (Dec. 18, 2017),

several times by leading scholars such as Mark Lemley,⁴¹ David Nimmer,⁴² Pam Samuelson,⁴³ Rebecca Tushnet,⁴⁴ Eugene Volokh,⁴⁵ Tom Cotter,⁴⁶ Stacey Dogan,⁴⁷ and Christine Farley.⁴⁸ It has not yet, unfortunately, been cited by any court.

https://www.washingtonpost.com/world/national-security/federal-appeals-judge-announces-immediate-retirement-amid-investigation-prompted-by-accusations-of-sexual-misconduct/2017/12/18/6e38ada4-e3fd-11e7-a65d-1ac0fd7f097e_story.html?utm_term=.809ebf53ec15.

⁴¹ See Mark A. Lemley, *Should a Licensing Market Require Licensing?*, 70 L. & CONTEMP. PROBS. 185, 193–94 n.62 (2007); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1707 n.102, 1712 n.130 (1999); see also notes 43 & 45, *infra*, for co-authored articles.

⁴² See David Nimmer, *Codifying Copyright Comprehensibly*, 51 UCLA L. REV. 1233, 1242 n.66 (2004).

⁴³ See Pamela Samuelson, *Possible Futures of Fair Use*, 90 WASH. L. REV. 815, 821 n.35 (2015).

⁴⁴ See Bruce P. Keller & Rebecca Tushnet, *Even More Parodic Than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979, 985 n.26, 988 n.42, 998–99 n.99, 100 (2004).

⁴⁵ See Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 917 n.63 (2003); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 194 n.219 (1998).

⁴⁶ See Thomas F. Cotter, *Memes and Copyright*, 80 TUL. L. REV. 331, 393 n. 267, 269 (2005); Thomas F. Cotter & Angela M. Mirabole, *Written on the Body: Intellectual Property Rights in Tattoos, Makeup, and Other Body Art*, 10 UCLA ENT. L. REV. 97, 137 n.180 (2003).

⁴⁷ See Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. DAVIS L. REV. 473, 498 n.110, 502 n.126 (2013), reprinted at 105 Trademark Rep. 1177, 1200 n.110, 1203 n.126 (2015); Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accomplishment?*, 54 EMORY L.J. 461, 486 n.183 (2005).

⁴⁸ See Christine Haight Farley, *The Lingering Effects of Copyright's Response to the Invention of Photography*, 65 U. PITT. L. REV. 385, 443 n.224 (2004).

III. PARODY AND SATIRE AS FAIR USE

In the past twenty years, the Ninth Circuit has addressed only one copyright case raising a fair use defense based on parody. That case, *Mattel v. Walking Mountain Productions*,⁴⁹ involved a series of seventy-eight photographs of Barbie dolls “in various absurd and often sexualized positions.”⁵⁰ For example, “‘Barbie Enchiladas’ depicts four Barbie dolls wrapped in tortillas and covered with salsa in a casserole dish in a lit oven”;⁵¹ and in several other photos, “Barbie is about to be destroyed or harmed by ... kitchen appliances, yet continues displaying her well known smile, disturbingly oblivious to her predicament.”⁵² The Ninth Circuit held that whether the series was a parody was a question of law for the court;⁵³ and it concluded that “[Forsythe’s] photographs parody Barbie and everything Mattel’s doll has come to signify.”⁵⁴ It also correctly held that “[w]e do not require parodic works to take the absolute minimum amount of the copyrighted work possible,”⁵⁵ without noting that the *Dr. Seuss* case held exactly the opposite.⁵⁶ Finally, it held there was no market harm

⁴⁹ *Mattel v. Walking Mountain Productions*, 353 F.3d 792 (9th Cir. 2003).

⁵⁰ *Id.* at 796. The series was titled “Food Chain Barbie.” *Id.* A Google search for that phrase will bring up many of the photos.

⁵¹ *Id.* at 796.

⁵² *Id.* at 802.

⁵³ *Id.* at 801.

⁵⁴ *Id.* at 802. The court also correctly rejected an argument that Forsythe “could have made his statements about consumerism, gender roles, and sexuality without using Barbie,” *Id.* at 802 n.7, a variation on the restrictive “reasonable alternative avenues of communication” standard that occasionally succeeds, but is more frequently rejected, in applying the First Amendment to intellectual property law. *See* Ochoa, *supra* note 3, at 626–27 & n.447.

⁵⁵ *Mattel*, 353 F.3d at 805.

⁵⁶ *Dr. Seuss Enters.*, 109 F.3d at 1400 (a “parodist is permitted a fair use of a copyrighted work [only] if it takes no more than is necessary to

because there was no reasonable likelihood that Mattel would license uses such as Forsythe’s,⁵⁷ a conclusion that should have been reached in the *Dr. Seuss* case.⁵⁸ The Ninth Circuit’s opinion in *Walking Mountain* is consistent with its rejection of Mattel’s claims in a trademark case involving the parody song “Barbie Girl,”⁵⁹ and with a lower court’s treatment of another sexual parody of Barbie.⁶⁰

Some observers may have had difficulty in accepting Forsythe’s photographs as parody because they viewed the photographs as absurd or disturbing, rather than humorous or funny.⁶¹ But as the article pointed out, parody and satire may combine varying degrees of “aggression or attack, play (both wordplay and game-playing), laughter, and judgment or criticism.”⁶² An example of a parody in which attack and criticism are paramount is Alice Randall’s *The Wind Done Gone*, a re-telling of Margaret Mitchell’s *Gone With the Wind* from the perspective of Cynara, a mulatto half-sister to

‘recall’ or ‘conjure up’ the object of his parody”). Judge Posner also has expressed this view in *dicta*. See *Ty, Inc. v. Publ’ns Int’l, Inc.*, 292 F.3d 512, 518 (7th Cir. 2002) (“the parodist must not take more from the original than is necessary to conjure it up”). This restrictive view was expressly rejected in *Campbell*. See Ochoa, *supra* note 3, at 601-02.

⁵⁷ *Mattel*, 353 F.3d at 805-06.

⁵⁸ See Ochoa, *supra* note 3, at 601-02.

⁵⁸ *Mattel*, 353 F.3d at 805-06.

⁵⁸ See Ochoa, *supra* note 3, at 609-12.

⁵⁹ See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002) (opinion by Kozinski, J.) (“The song does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself.”).

⁶⁰ See *Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315 (S.D.N.Y. 2002) (holding a reasonable jury could find that “Dungeon Doll,” “a repainted and recostumed Barbie doll” in a dominatrix outfit, could be a fair use).

⁶¹ The Ninth Circuit itself used the words “absurd” and “disturbing” in describing the photos. See *Mattel*, 353 F.3d at 796 (“absurd”), 802 (“disturbingly oblivious”). The only reference to “humor” was in describing Forsythe’s own declaration. *Id.* at 796 (“Forsythe *claims* that ... he attempts to communicate ... his serious message with an element of humor.”) (emphasis added).

⁶² See Ochoa, *supra* note 3, at 556.

Scarlett O'Hara.⁶³ While Randall avoided referring to any of Mitchell's characters by name, her allusions to them were clear enough.⁶⁴ The district court held that Randall's novel was a sequel to *Gone With the Wind*, rather than a parody, in part because it had very little humor.⁶⁵ The Eleventh Circuit vacated the preliminary injunction as "an unlawful prior restraint in violation of the First Amendment,"⁶⁶ finding that Randall's novel "seeks to comment upon or criticize [*Gone With the Wind*] by appropriating elements of the original,"⁶⁷ and noting that "our approach to 'parody' . . . requires no assessment of whether or not a work is humorous."⁶⁸

One of the major points of the article was that the Ninth Circuit erred in holding that "satire," in which elements of a prior work are used to comment on or criticize something else, could not qualify as a fair use.⁶⁹ The Second Circuit has gone the furthest in holding that satires can be "transformative" and therefore fair uses. In *Blanch v. Koons*,⁷⁰ appropriation artist Jeff Koons, who had already thrice lost copyright infringement actions,⁷¹ scanned a number of photos from advertisements and incorporated parts of them into billboard-sized painted collages.⁷²

⁶³ See *Suntrust Bank v. Houghton Mifflin Co.*, 136 F. Supp. 2d 1357, 1364 (N.D. Ga.), *vacated*, 252 F.3d 1165 (11th Cir.), *and opinion issued*, 268 F.3d 1257 (11th Cir. 2001).

⁶⁴ *Suntrust Bank*, 268 F.3d at 1267.

⁶⁵ *Suntrust Bank*, 136 F. Supp. 2d at 1372–78; *see also* Carolyn See, *Scarlett Fever*, Wash. Post, June 24, 2001 ("the book is far from satire or parody. *The Wind Done Gone* doesn't make fun of anything.").

⁶⁶ *Suntrust Bank*, 252 F.3d at 1166; *see also* Lemley & Volokh, *supra* note 45.

⁶⁷ *Suntrust Bank*, 268 F.3d at 1271; *see also id.* at 1268–69, 1270–71.

⁶⁸ *Id.* at 1269 n.23.

⁶⁹ *See supra* notes 32–34 and accompanying text.

⁷⁰ *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006).

⁷¹ *See* *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992); *United Feature Syndicate v. Koons*, 817 F. Supp. 370 (S.D.N.Y. 1993); *Campbell v. Koons*, No. 91 Civ. 6055(RO), 1993 WL 97381 (S.D.N.Y. Apr. 1, 1993).

⁷² *Blanch*, 467 F.3d at 247.

Blanch, a professional fashion photographer whose photo was used in the collage “Niagara,” sued for copyright infringement.⁷³ Koons did not claim that “Niagara” was a parody of her photo; instead, he claimed “he intended to ‘comment on the ways in which some of our most basic appetites—for food, play, and sex—are mediated by popular images.’”⁷⁴ Thus, “‘Niagara’ . . . may be better characterized for these purposes as satire—its message appears to target the genre of which ‘Silk Sandals’ is typical, rather than the individual photograph itself.”⁷⁵ Nonetheless, the Second Circuit expressly held (contrary to the *Dr. Seuss* court) that “the broad principles of *Campbell* are not limited to cases involving parody,”⁷⁶ and asked “whether Koons had a genuine creative rationale for borrowing Blanch’s image.”⁷⁷ In his affidavit, Koons said:

The photograph is typical of a certain style of mass communication. Images almost identical to them can be found in almost any glossy magazine, as well as in other media. . . . By using a fragment of the *Allure* photograph in my painting, I thus comment upon the culture and attitudes promoted and embodied in *Allure* Magazine. By using an existing image, I also ensure a certain authenticity or veracity that enhances my commentary — it is the difference between quoting and paraphrasing.⁷⁸

Consequently, the court held that the use was “transformative,” because “[Koons’] purposes in using Blanch’s image are sharply different from Blanch’s goals in creating it.”⁷⁹

⁷³ *Id.* at 247–48.

⁷⁴ *Id.* at 247.

⁷⁵ *Id.* at 254.

⁷⁶ *Id.* at 255.

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Id.* at 252.

In accepting Koons' affidavit without skepticism, the court remarked: "Koons's clear conception of his reasons for using 'Silk Sandals,' and his ability to articulate those reasons, ease our analysis in this case. We do not mean to suggest, however, that either is a *sine qua non* for a finding of fair use—as to satire or more generally."⁸⁰ This was amply demonstrated in another case involving appropriation art, *Cariou v. Prince*,⁸¹ in which the plaintiff's photographs of Jamaican Rastafarians were used in defendant's series of 30 paintings and collages titled *Canal Zone*.⁸² In holding that 25 of Prince's works were clearly transformative and fair use, (and that the other five presented genuine issues of material fact),⁸³ the court abandoned any distinction between parody and satire and other types of fair uses:

The district court imposed a requirement that, to qualify for a fair use defense, a secondary use must "comment on, relate to the historical context of, or critically refer back to the original works." Certainly, many types of fair use, such as satire and parody, invariably comment on an original work and/or on popular culture. . . . As even Cariou concedes, however, the district court's legal premise was not correct. The law imposes no requirement that a work comment on

⁸⁰ *Id.* at 255 n.5.

⁸¹ *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013).

⁸² *Id.* at 698–99, n.2.

⁸³ The apparent distinction is that Cariou's work was collaged with images from other sources in 25 works, whereas the other five featured only Cariou's work with minimal changes. It is reminiscent of the old joke that "copying one source is plagiarism, copying multiple sources is research." See Garson O'Toole, *If You Steal from One Author, It's Plagiarism; If You Steal from Many, It's Research*, QUOTE INVESTIGATOR (Apr. 5, 2018), <https://quoteinvestigator.com/2010/09/20/plagiarism>.

the original or its author in order to be considered transformative.⁸⁴

The court held that Prince’s works were “transformative” despite the fact that Prince testified that “he ‘do[es]n’t really have a message,’ that he was not ‘trying to create anything with a new meaning or a new message,’ and that he ‘do[es]n’t have any . . . interest in [Cariou’s] original intent.”⁸⁵ The court explained: “What is critical is how the work in question appears to the reasonable observer, not simply what an artist might say about a particular piece or body of work. Prince’s work could be transformative even without commenting on Cariou’s work or on culture, and even without Prince’s stated intention to do so.”⁸⁶ This is the complete opposite of the approach taken in the *Dr. Seuss* case, in which the court dismissed the parody author’s proffered explanation as “pure shtick” and a “post-hoc characterization of the work [that] is ‘completely unconvincing.’”⁸⁷

The Seventh Circuit criticized *Cariou*’s heavy reliance on “transformative use,” saying that if applied exclusively it might override the exclusive right to prepare derivative works.⁸⁸ Nonetheless, it held that a t-shirt that used a “posterized” version of a mayor’s official portrait to criticize him was a fair use.⁸⁹ It also held that *South Park*’s

⁸⁴ *Cariou*, 714 F.3d at 706 (quoting *Cariou v. Prince*, 784 F. Supp. 2d 337, 348 (S.D.N.Y. 2011)).

⁸⁵ *Id.* at 707 (quoting *Cariou*, 784 F. Supp. 2d at 349). Prince fared more poorly in a subsequent case, in which his work consisted entirely of a third-party’s Instagram post of the plaintiff’s photo, “along with a cryptic comment written by Prince.” *Graham v. Prince*, 265 F. Supp. 3d 366, 381 (S.D.N.Y. 2017) (denying motion to dismiss).

⁸⁶ *Cariou*, 714 F.3d at 707.

⁸⁷ *Dr. Seuss Enters.*, 109 F.3d at 1403.

⁸⁸ *Kienitz v. Sconnie Nation, LLC*, 766 F.3d 756, 758 (7th Cir. 2014). Indeed, it apparently disregarded the transformative use standard altogether, despite the Supreme Court’s command in *Campbell*. *Id.*

⁸⁹ *Id.* at 758–59.

parody of a viral video titled “What What (In the Butt),” substituting a “naïve nine-year-old” cartoon boy for an adult male but otherwise “recreat[ing] a large portion of the original version, using the same angles, framing, dance moves and visual elements,” was a fair use.⁹⁰ This is consistent with a number of cases in which media that are well-known for parody and satire, such as Comedy Central’s *South Park* and *The Daily Show*,⁹¹ and Fox’s *Family Guy*,⁹² are given wide latitude to parody and make fun of other works.⁹³

As a plaintiff, Dr. Seuss has had mixed success in the past 20 years. In California, it successfully defeated a motion to dismiss by the prospective publishers of a Dr. Seuss/Star Trek “mashup” titled *Oh, the Places You’ll Boldy Go!*,⁹⁴ but in New York, the court granted a declaratory judgment of fair use to the author of *Who’s Holiday*, a play that imagines Cindy Lou Who as a 45-year-old alcoholic drug abuser, knocked up by, married, and divorced from the

⁹⁰ *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687, 689 (7th Cir. 2012). The video is described as “a paean to anal sex.” *Id.*

⁹¹ *See Kane v. Comedy Partners*, 68 U.S.P.Q.2d 1748, 1751 (S.D.N.Y. 2003) (“Virtually any clip appearing on [*The Daily Show*] is implicitly accompanied by a comment on its absurdity.”).

⁹² *See Bourne Co. v. Twentieth Century Fox Film Corp.*, 602 F. Supp. 2d 499 (S.D.N.Y. 2009) (holding the song “I Need a Jew” is a parody of “When You Wish Upon a Star” and a fair use); *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962 (C.D. Cal. 2007) (holding a five-second use of Carol Burnett’s “Charwoman” character in a porn shop was a parody and a fair use).

⁹³ This trend was already apparent, but not expressly identified, in 1998. *See Ochoa*, *supra* note 3, at 574 (Mad Magazine), 577–78 (Saturday Night Live), 585 (film actor Leslie Nielsen); *see also* *Eveready Battery Co. v. Adolph Coors Co.*, 765 F. Supp. 440 (N.D. Ill. 1991) (Nielsen).

⁹⁴ *See Dr. Seuss Enters., L.P. v. ComicMix, LLC*, 256 F. Supp. 3d 1099, 1106 (S.D. Cal. 2017) (finding the mashup “fails to qualify as a parody [but] it is no doubt transformative.”). The court adhered to its views after an amended complaint. *See Dr. Seuss Enters., L.P. v. ComicMix, LLC*, 300 F. Supp. 3d 1073 (S.D. Cal. 2017).

Grinch, all in comedic rhyming verse.⁹⁵ The disparate results suggest the importance of forum-shopping, as the case law regarding parody remains more favorable to defendants in the Second Circuit than in the Ninth Circuit.⁹⁶

IV. CONCLUSION

There is much more to be said about parody and satire, but too little space in which to say it.⁹⁷ Because fair use is a case-by-case determination, there will always be cases that fall outside the mainstream of judicial thought. The *Dr. Seuss* case, however, remains so far outside the mainstream that it deserves all of the scorn I heaped upon it in the article. I can only repeat the conclusion I reached 20 years ago: “The Ninth Circuit . . . should seize the earliest possible opportunity to overturn the *Dr. Seuss* opinion and to conform its approach to parody cases to the more generous standards of the Supreme Court.”⁹⁸

⁹⁵ See *Lombardo v. Dr. Seuss Enters., L.P.*, 279 F. Supp. 3d 497, 503–04 (S.D.N.Y. 2017).

⁹⁶ Which is not to say that all parodies succeed in the Second Circuit. See, e.g., *Salinger v. Colting*, 641 F. Supp. 2d 250, 257–61 (S.D.N.Y. 2009) (finding *60 Years Later: Coming Through the Rye* to be a “sequel” rather than a parody of *Catcher in the Rye*), *rev’d on other grounds*, 607 F.3d 68 (2d Cir. 2010).

⁹⁷ Because of space limitations, I have not attempted to cover trademark parodies here.

⁹⁸ Ochoa, *supra* note 3, at 633.

INTELLECTUAL PROPERTY LAW GETS EXPERIENCED

VICTORIA F. PHILLIPS¹

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I. INTRODUCTION

A decade ago, in *Clinical Legal Education and the Public Interest in Intellectual Property Law*, I described with my faculty colleagues our motivations for launching a public interest intellectual property law clinic at the American University Washington College of Law.² That article

¹ Professor of Practice of Law and Director, Glushko-Samuelsan Intellectual Property Law Clinic, American University Washington College of Law. I would like to thank the intellectual property scholar-advocates who imagined and created the elegant foundation for the current law school IP clinical community. Special thanks to my IP clinic colleagues Peter Jaszi, Christine Farley, Josh Sarnoff and Ann Shalleck and also to Pamela Samuelson and Bob Glushko for their vision and support. I am also always inspired by the sustained public interest work and achievements of my IP clinical colleagues. Thanks also to Ann Bartow and Dean Megan Carpenter for giving me the opportunity to revisit this work at UNH Law School’s “IP Redux” conference.

² Victoria Phillips et al., *Clinical Legal Education and the Public Interest in Intellectual Property Law*, 52 ST. LOUIS U. L.J. 735 (2008).

introduced our goals and framework for a pioneering clinic framed around a variety of live-client student representations performed under close faculty supervision, weekly case rounds focusing on issues experienced directly by the students in their representations, and a seminar built around a year-long lawyering simulation addressing the public interest dimensions of intellectual property. In that article, we chronicled one live-client student representation in the copyright policy area, the Copyright Office's 1998 Digital Millennium Copyright Act's exemption proceedings, to illustrate our effort to help students better understand the interaction of theory, doctrine, and practice in the dynamic field of intellectual property law.

In this essay, I reflect on developments in the decade since publication of that piece and explore the growth and maturing of the new community of law school intellectual property law clinics. I find that in most respects these new clinics stand comfortably on shoulders of the pioneers of the clinical legal education movement. The founders of the early clinical programs were responding to the social ferment and legal rights explosion of the 1960s. They envisioned the clinical method as much more than merely a way to enrich legal education with professional and skills training. They also saw it as a means of encouraging law schools to attend to the legal needs of the disenfranchised and to engage students in the pursuit and understanding of social justice.³ In the last decade, the IP clinical community has matured to serve the very same access to justice goals. The new clinics are strong voices in the IP realm for the public interest, consumer and civil liberties communities. The IP clinic community has also expanded and inspired much needed access to pro-bono IP and related legal services

³ Stephen Wizner, *The Law School Clinic: Legal Education in the Interests of Justice*, 70 *FORDHAM L. REV.* 1929, 1932–33 (2002).

for underserved communities of creators, non-profits, small businesses, and start-up entities.

II. GETTING EXPERIENCED

The number of IP and related clinics has exploded in the past decade.⁴ The most recent survey conducted by the law school clinical community shows that Transactional and IP clinics are among the fastest growing segment of law school clinical offerings.⁵ The new IP clinics gained momentum from a variety of forces including an increased emphasis on experiential learning in the law school curriculum, the emergence of specialty clinics, the increased intellectual property activities of existing transactional law clinics, and most importantly, an increased need for intellectual property legal services for individuals and entities of limited means given the rise of the new internet economy.

The development of these clinics has been influenced by the general expansion of experiential learning across the law school curriculum. The trend towards more experiential opportunities throughout education, including law schools, has accelerated in the last few decades.⁶ Direct calls for

⁴ See Cynthia L. Dahl & Victoria Phillips, *Innovation and Tradition: A Survey of Intellectual Property and Technology Legal Clinics*, 25 CLINICAL L. REV. 401 (Fall 2018) (surveying all the new IP and technology clinics and discussing work taken on and innovations in this new community).

⁵ See ROBERT R. KUEHN & DAVID A. SANTACROCE, CTR. FOR THE STUDY OF APPLIED LEGAL EDUC., THE 2016-17 SURVEY OF APPLIED LEGAL EDUCATION, 8-9 (2017), http://www.csale.org/files/Report_on_2016-17_CSALE_Survey.pdf.

⁶ See generally David I. C. Thompson, *Defining Experiential Legal Education*, 1 J. EXPERIENTIAL LEARNING 1, 1-3 (2014); Veronica Donahue DiConti, *Experiential Education in a Knowledge-Based Economy: Is It Time to Reexamine the Liberal Arts?*, 53 J. OF GEN. EDUC. 167 (2004); Becky Beaupre Gillespie, *The Evolution of Experiential*

curricular change in legal education were sounded in the 1992 ABA MacCrate Report, the 2007 Carnegie Report, and in the 2015 ABA requirements mandating experiential learning opportunities for all students.⁷ These reports all agreed that the best training for lawyers is not in a curriculum focused exclusively on study of legal doctrine and case law, but one that integrates doctrine with training in skills and focuses on the development of each student's professional identity.⁸ With each passing year, more and more experiential learning has been demanded in the legal academy. The most recent ABA requirements are a

Learning, THE UNIVERSITY OF CHICAGO LAW SCHOOL (Oct. 3, 2017), <https://www.law.uchicago.edu/news/evolution-experiential-learning>.

⁷ AMERICAN BAR ASSOCIATION, ABA STANDARDS AND RULES OF PROCEDURE FOR APPROVAL OF LAW SCHOOLS 2015-2016, at 16–17 (2015), https://www.americanbar.org/content/dam/aba/publications/misc/legal_education/Standards/2016_2017_aba_standards_and_rules_of_procedure.authcheckdam.pdf [*hereinafter* ABA STANDARDS AND RULES OF PROCEDURE]; WILLIAM M. SULLIVAN ET AL., CARNEGIE FOUNDATION FOR THE ADVANCEMENT OF TEACHING, EDUCATING LAWYERS: PREPARATION FOR THE PROFESSION OF LAW 7–8 (2007), http://archive.carnegiefoundation.org/pdfs/elibrary/elibrary_pdf_632.pdf; AMERICAN BAR ASSOCIATION, LEGAL EDUCATION AND PROFESSIONAL DEVELOPMENT—AN EDUCATIONAL CONTINUUM: REPORT OF THE TASK FORCE ON LAW SCHOOLS AND THE PROFESSION: NARROWING THE GAP, (1992), [<https://perma.cc/6X7G-4GEL>] [*hereinafter* LEGAL EDUCATION AND PROFESSIONAL DEVELOPMENT].

⁸ The Carnegie Report noted:

[M]ost law schools give only casual attention to teaching students how to use legal thinking in the complexity of actual law practice. Unlike other professional education, most notably medical school, legal education typically pays relatively little attention to direct training in professional practice. The result is to prolong and reinforce the habits of thinking like a student rather than an apprentice practitioner, conveying the impression that lawyers are more like competitive scholars than attorneys engaged with the problems of clients.

SULLIVAN ET AL., *supra* at note 7, at 6.

culmination of this gradual evolution. They mandate at least six experiential credits for graduates of accredited law schools.⁹

Outside the academy, rapid changes sweeping across the economy and technology landscape have also helped to shape this trend. Most significant was the migration to digital technology and the development of the new internet-based economy. The new economy ushered in an expansion in the need for increased expertise in intellectual property and technology-related legal services.¹⁰ In many respects, the new community of IP clinics has evolved to address the emerging needs of the digital world.¹¹ Some were launched explicitly to promote public interest IP policy by extending the voice of advocates guarding the critical balance in IP between protecting creative endeavors and promoting access to information and creative work.¹² Many of the newest offerings were initiated primarily to provide pro bono assistance with IP rights acquisition through participation in the United States Patent and Trademark Office's Law School Clinic Certification Program permitting student practice in trademark and patent prosecution.¹³

The ABA MacCrate Commission observed that a lawyer should be committed to the values of “contributing to

⁹ ABA STANDARDS AND RULES OF PROCEDURE, *supra* note 7, at 16–17 (“One or more experiential course(s) totaling at least six credit hours.”).

¹⁰ See generally Anthony Reese, *Copyright and Trademark Law and Public Interest Lawyering*, 2 U.C. IRVINE L. REV. 911, 918 (2012).

¹¹ See KUEHN & SANTACROCE, *supra* note 5, at 7–8 (demonstrating that clinics focusing on immigration, transactional law, and IP reported the largest percent increase between 2011 and 2014 surveys); see also Dahl & Phillips, *supra* note 4.

¹² The clinics funded by Pamela Samuelson and Robert Glushko were early examples of this type of clinic.

¹³ See Act of Dec. 16, 2014, Pub. L. No. 113-227, 128 Stat. 2115 (USPTO Law School Clinic Certification Program). See generally Jennifer Fan, *Institutionalizing the USPTO Law School Clinic Certification Program for Transactional Law Clinics*, 19 LEWIS & CLARK L. REV. 327 (2015).

the profession's fulfillment of its responsibility to ensure that adequate legal services are provided to those who cannot afford to pay for them and to enhance the capacity of law and legal institutions to do justice.¹⁴ The maturing IP clinical community is answering this call. Pro bono legal assistance and expertise in IP law has historically been unavailable through legal services entities and the general practice law school clinics. Until very recently, pro bono IP representation was also very rarely provided by private law firms.¹⁵ The new network of IP clinics has emerged to increase pro bono activity in this field. It serves as both a needed policy voice for consumers and civil society advocates and provides direct legal services to those unable to afford assistance in the specialized IP legal marketplace.

III. IP CLINICS HAVE BECOME A STRONG VOICE FOR JUSTICE IN THE IP SYSTEM

In a keynote speech several years ago to the law school clinical community poverty scholar Peter Edelman noted:

Whatever we're teaching, we need to make sure that students know the historical and structural context for the issues they are working on, particularly in clinics that represent people on an individual basis... Law teachers throughout the school should take part in the

¹⁴ LEGAL EDUCATION AND PROFESSIONAL DEVELOPMENT, *supra* note 7, at 140.

¹⁵ See Raymond Miller, *The Real McCoy Part 3: How to Bridge America's Innovation Gap*, IP WATCHDOG (Nov. 8, 2012), <https://www.ipwatchdog.com/2012/11/18/the-real-mccoy-part-3-how-to-bridge-americas-innovation-gap/id=30103/> (recognizing the gap of intellectual property attorneys providing pro bono work for entrepreneurs).

conversation about expanding access to justice in all the meanings of the phrase¹⁶

Edelman makes clear that access to justice should mean not only providing those without means access to lawyers (the “access”), but access to justice must also mean fighting to address underlying inequality by engaging in the larger social justice fight (the “justice”). He urged law schools and their legal clinics to claim their responsibility to contribute to widening access to justice on both levels. In this vision, law school clinics should both connect lawyers to low-income communities and provide representation not only on an individual basis, but also by way of activities that help to build community, in terms of empowerment and concrete transactional projects.¹⁷ He urged clinical faculty to think more about how we can configure our work so that in addition to helping people one-by-one, we think about the structural problems that contribute to people being in poverty.¹⁸ A progressive view of access to justice must include “normative legal protection, legal awareness, legal aid and counsel, adjudication, enforcement, and civil society oversight.”¹⁹

In the last decade, IP clinics have continued to encourage law students to learn about the relationships among IP theories, policies and practices, especially those that implicate access to justice. Our students have experienced the stories of clients seeking IP protection as

¹⁶ Peter Edelman, Carmack Waterhouse Professor of Law and Public Policy & Faculty Director of the Center on Poverty and Inequality, Georgetown University Law Center, Keynote Address at the 2015 AALS Conference on Clinical Legal Education, Law Schools’ Rule in Increasing Access to Justice (August 2015).

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ UNITED NATIONS DEVELOPMENT PROGRAMME, PROGRAMMING FOR JUSTICE: ACCESS FOR ALL: A PRACTITIONER’S GUIDE TO HUMAN RIGHTS-BASED APPROACH TO ACCESS TO JUSTICE (2005).

well as clients for whom the legal framework of IP laws restrict their ability to engage in educational, creative, innovative or culturally significant endeavors. By serving as the lawyers for many different kinds of clients affected by the rapid changes in IP law and policy, our students are witnessing first-hand the tensions reflected in approaches to protecting access to information and the products of creative endeavors. In their daily client representations IP clinics serve as law and policy laboratories to test the effects of various IP theories and regimes on consumers and the diverse creative client community.

IP clinic students are forced to wrestle with the inherent conflict in the language of the U.S. Constitution as well as the Universal Declaration of Human Rights. Both documents grant a right freely to participate in the cultural life of the community but also the right to protection of the moral and material interests resulting from production. Student attorneys come to see in their own work that the two principles—access to information and a rationale for its restriction—are in tension and that this tension central to how law structures our cultural life.

Clinical scholar Jane Aiken has observed that the final stage of a lawyer and law student’s development is “justice readiness.”²⁰ At this stage a student or lawyer “demonstrates an appreciation for context, understands that legal decision-making reflects the value system in which it operates, and can adapt, evaluate, and support her own analysis.” The “justice ready” lawyer can become proactive in shaping legal disputes with an eye toward social justice. Today IP clinics and their students are becoming justice ready. Nearly half of the growing IP clinic community engages in some kind of policy advocacy to make the IP system fairer for all. Clinic students are routinely engaged

²⁰ Jane Aiken, *Provocateurs for Justice*, 7 CLINICAL L. REV. 287, 291 (2001).

in drafting white papers, preparing amicus briefs, and filing comments and replies in regulatory rulemaking proceedings. This advocacy also takes the form of educational outreach projects such as best practices guides, legal toolkits, and curricula for IP and technology educational programs. Other policy projects include FOIA requests, federal and state lobbying, and policy research and education of federal, state and local legislatures. Some clinics also engage in impact litigation efforts in copyright, trademark, patent, and trade secret areas as well as privacy, FOIA requests, free speech, and right of access advocacy. The clinics represent clients as varied as consumers, small entrepreneurs, disability groups, children's groups, prisoners, civil rights groups, the Native community, scholars, and countless creatives. In such respects, IP clinics have answered Edelman's call for promoting access to justice and play an important role in educating communities of creators and decision makers on the need for just laws in this specialized area.²¹

Indeed, many of the consumers, scholars, and creators seeking (and being granted) exemptions under the anti-circumvention provisions of the DMCA, the illustrative representation in our earlier article, have over the last decade been successfully represented by the new community of IP clinics. Some of the clinics taking on these matters are among the oldest in the community and several were funded by seed money and named for IP scholar and Berkeley Law Professor Pam Samuelson and her husband Robert Glushko. As described in our previous article, our own clinic students have long been involved in advocacy related to the DMCA rulemaking. In 2006, our clinic was asked to provide representation in these proceedings for clients seeking exemptions from prohibitions contained in the Act. The DMCA amended U.S. copyright law by adopting new Section 1201, which prohibited circumvention of

²¹ See Dahl & Phillips, *supra* note 4.

technological measures on digital media that effectively control access to or copying of copyrighted content on that media.²² This legislative prohibition also provided authority for the Librarian of Congress to adopt three-year renewable exemptions to the access prohibition for particular “classes of copyrighted works,” when users of such works “are, or are likely to be” “adversely affected” in their ability to make lawful non-infringing uses of these works such as fair use.²³

Peter DeCherney, then an Assistant Professor in the University of Pennsylvania’s Cinema Studies Program, retained our clinic to request an exemption that would be important for his and fellow cinema studies professors who wanted to use clips from encrypted films in their teaching.²⁴ Our clinic’s successful efforts on their behalf ultimately encouraged others to join in subsequent efforts to chip away at the prohibitions created by the DMCA on the fair use of works for important educational, cultural, artistic, consumer, and creative purposes. In the most recent round of the Copyright Office’s process, our students once again represented Professor DeCherney who sought further expansion of his previous exemptions for additional scholarly purposes.²⁵ In this round, seven other law school IP clinics also represented clients seeking particular exemptions in the proceedings.²⁶ The clinics represented

²² 17 U.S.C. § 1201 (2012).

²³ *Id.*

²⁴ See Jeanne Leong, *Cinema Studies Prof Obtains Exemption to Allow Use of Copyrighted Movie Clips in MOOCs*, PENN TODAY (Nov. 5, 2015), <https://penntoday.upenn.edu/2015-11-05/latest-news/cinema-studies-prof-obtains-exemption-allow-use-copyrighted-movie-clips-moocs>.

²⁵ Peter DeCherney, *Petition for New Exemption under 17 U.S.C § 1201*, U.S. COPYRIGHT OFF., SEC. 1201 RULEMAKING: SEVENTH TRIENNIAL PROC. (2018), <https://www.copyright.gov/1201/2018/petitions-091317/class1/class-01-newpetition-decherney-et-al.pdf>.

²⁶ See U.S. Copyright Office, *Comment Letters on Proposed Exemptions Against Circumvention of Technological Measures Protecting*

clients as varied as the Electronic Frontier Foundation, Center for Democracy and Technology, Authors Alliance, American Association of University Professors, Organization for Transformative Works, Interactive Fiction Technology Foundation, Association of Transcribers and Speech-to-text Providers, Association of Research Libraries, American Library Association, American Farm Bureau Federation, Museum of Art and Digital Entertainment, Software Preservation Network, National Corn Growers Association, and the National Farmers Union.²⁷ As an example, the Colorado Law Samuelson-Glushko Technology Law and Policy Clinic filed on behalf of organizations such as the Association on Higher Education and Disability arguing for an exemption for disability service professionals to circumvent the technological protection measures on video games.²⁸ The University of Southern California Gould School of Law Intellectual Property and Technology Law Clinic argued for an exemption for farm equipment articulating how certain anti-circumvention

Copyrighted Works (2018), <https://www.copyright.gov/1201/2018/comments-031418/>.

²⁷ See U.S. Copyright Office, Comment Letter of U.C.I Intellectual Property, Arts, and Technology Clinic on Proposed Exemptions Against Circumvention of Technological Measures Protecting Copyrighted Works (2018), https://www.copyright.gov/1201/2018/comments-031418/class1/Class_01_Reply_Authors_Alliance_et_al_.pdf; U.S. Copyright Office, Comment Letter of Colorado Law Samuelson-Glushko Technology Law & Policy Clinic on Proposed Exemptions Against Circumvention of Technological Measures Protecting Copyrighted Works (2018), https://www.copyright.gov/1201/2018/comments-031418/class2/Class_02_Reply_ASTP_et_al_.pdf [*hereinafter* Colorado Reply Comments]; U.S. Copyright Office, Comment Letter of California Western School of Law New Media Rights Clinic on Proposed Exemptions Against Circumvention of Technological Measures Protecting Copyrighted Works (2018), http://www.librarycopyrightalliance.org/storage/documents/EFF_NMR_OTW_1201_Comment_proposed_class_1.pdf.

²⁸ See Colorado Reply Comments, *supra* note 27, at 5–6.

measures inhibit the ability of farmers to repair their own equipment, threatening their livelihood.²⁹ Were it not for the advocacy assistance offered by these law school IP clinics, none of these groups or individuals would have had a meaningful voice in these important debates. Clinic participation helped to contribute to the broader justice mission of exposing the real harms felt by real people as a result of the statute. In the last decade, law school clinic advocacy in these proceedings and others have helped to push back against the consumer unfriendly protectionism and injustice inherent in many aspects of the existing IP regime.

IV. IP CLINICS HAVE ENHANCED ACCESS TO PRO BONO IP ASSISTANCE

The earliest forms of clinical legal education embraced hands-on legal training through the provision of access to legal services for traditionally unrepresented clients.³⁰ The first clinics were inspired by the thinking of legal realists like Karl Llewellyn and Jerome Frank who advanced the view that students must learn about law as a means to an end rather than as an end itself.³¹ The realists conceived of the law as a public profession charged with inescapable social responsibilities. The experiments in early

²⁹ See U.S. Copyright Office, Comment Letter of University of Southern California Gould School of Law Intellectual Property and Technology Law Clinic on Proposed Exemptions Against Circumvention of Technological Measures Protecting Copyrighted Works (2018), https://www.copyright.gov/1201/2018/comments-031418/class7/Class_07_Reply_AFBF_NCGA_NFU.pdf.

³⁰ See generally Jerome Frank, *A Plea for Lawyer-Schools*, 56 YALE L.J. 1303 (1947); John S. Bradway, *The Objectives of Legal Aid Clinic Work*, 24 WASH. U. L.Q. 173 (1939); Jerome Frank, *Why Not a Clinical-Lawyer School?*, 81 U. PA. L. REV. 907 (1933).

³¹ Frank, *A Plea for Lawyer-Schools*, *supra* note 30; Bradway, *supra* note 30; Frank, *Why Not a Clinical-Lawyer School?*, *supra* note 30.

clinical legal education found a strong advocate in William Pincus, Vice-President of the Ford Foundation.³² Pincus was an advocate for legal services for the poor and felt strongly that law schools should play a role in addressing the lack of access to justice.³³ Under his leadership, the Ford Foundation provided the first funding to law schools to establish legal clinics to serve the poor.³⁴ Civil rights and poverty lawyers moved to the academy to start the first wave of law school clinics grounded in service to the poor.³⁵ As we enter the newest wave of clinical legal education, law school clinics continue to play an important role in making access to justice a reality for many low-income and disenfranchised communities. They do so not only by exposing law students to the legal problems encountered in the daily lives of the disadvantaged, but also by allowing students to connect with the obligation to find substantive and creative ways to respond to unmet legal needs.³⁶

The new IP clinical community is rising to meet this access to justice mission as well. The most common way that these clinics provide access to the IP system to those with limited means is through intellectual property rights acquisition. This work is handled by most IP clinics. Their students obtain trademarks, including performing trademark searches, drafting clearance memos and opinion letters for clients, and filing and prosecuting applications for federal registration.³⁷ Some clinics also handle patent prosecution including performing prior art searches and drafting opinion letters, and the filing of provisional and non-provisional

³² See Margaret Martin Barry et al., *Clinical Education for This Millennium: The Third Wave*, 7 CLINICAL L. REV. 1, 18–19 (2000) (reviewing the history of clinical legal education).

³³ *Id.*

³⁴ *Id.*

³⁵ *Id.* at 13.

³⁶ *Id.* at 15–16.

³⁷ See Dahl & Phillips, *supra* note 4.

patent applications. IP clinics also engage in related counseling and transactional work for clients, including advising on fair use, counseling regarding cease and desist letters, and drafting and negotiating a wide variety of licenses and contracts.³⁸

One of the most innovative and successful developments in expanding the delivery of IP pro bono assistance has been the creation and expansion of the U.S. Patent and Trademark Office's Law School Certification Program established in 2008.³⁹ This program came about as a result of a 2006 request for student practice in the agency by our IP Clinic.⁴⁰ The background research and underlying theory supporting the petition was created by our clinic students themselves. We proposed the creation of a student practice rule in the USPTO modeled on the numerous student practice rules in state and federal courts across the country. Our IP clinic students had been appearing in federal court under these rules in litigation matters, but were restricted from participating in the IP rights acquisition process at the USPTO on their own. Over the years, other federal agencies had also adopted rules explicitly permitting students in law school clinics to practice before them in various capacities.⁴¹ In the request we noted that as the importance to the economy of trademarks and patents had grown, law school clinical programs had gradually been

³⁸ *Id.*

³⁹ See Act of Dec. 16, 2014, Pub. L. No. 113-227, 128 Stat. 2115 (USPTO Law School Clinic Certification Program). See generally Fan, *supra* note 13.

⁴⁰ Letter & Memorandum from Washington College of Law Intellectual Property Clinic to James Toupin and John Whealan (Oct. 31, 2006) (on file with author) [hereinafter Letter & Memorandum from WCL IP Clinic].

⁴¹ See Wallace J. Mlyniec & Haley D. Etchison, *Conceptualizing Student Practice for the 21st Century: Educational and Ethical Considerations in Modernizing the District of Columbia Student Practice Rules*, 28 GEO. J. LEGAL ETHICS 207, 234 (2015).

expanding their representation of clients needing these services. In fact, law school clinics (through and in the names of their supervising faculty) had been increasingly appearing before the Office to file and prosecute both trademark and patent applications. At the same time, more law school clinics were being created that focused specifically on providing intellectual property legal services to those unable to afford quality legal services in the marketplace.

The request noted that student practice in the USPTO would accomplish a number of short-term and long-term goals for applicants, the agency, and law students given the growing community of IP and transactional clinical programs.⁴² Student practice would increase access to justice by allowing individuals and entities that otherwise would not obtain quality legal services in the marketplace to receive competent legal representation. It also would signal to the bar and to the public the agency's commitment to assuring fair treatment for all clients, regardless of their wealth, income or background. Authorizing law student practice would also improve the quality of the representation of clients' legal interests before the PTO relative to pro-se appearances (or in some cases representation by entities engaged in consumer fraud). In many circumstances, allowing law students to practice would reduce the work of and improve the decisions made by the agency staff. Most importantly, the request noted that authorization of student practice would improve the quality of legal education of law students, by providing practical opportunities for them to engage in advocacy under the supervision of qualified law professors. We also argued that these educational benefits would ultimately accrue to the USPTO, as trained students subsequently might practice before or ultimately be hired as attorneys there.

⁴² Letter & Memorandum from WCL IP Clinic, *supra* note 40.

After thoughtful deliberation, in 2008, the USPTO initiated its Law School Clinic Certification Pilot Program.⁴³ It certified six law school IP clinics and granted their enrolled clinic students limited recognition to practice before the USPTO under the guidance of their clinical faculty supervisors. While clinic students had been practicing under their faculty supervisor's name and bar license, the new rule allowed students to take ownership over the process of drafting and filing either patent or trademark applications for their real-world clients. It granted them the authority to sign applications, respond to Office Actions and to communicate directly with patent examiners and trademark attorneys in prosecuting the applications they had filed.⁴⁴ Word of the pilot program spread throughout the clinic community and in 2010, the agency expanded it to add ten more clinics for trademark practice. Only two years later, 11 patent and nine more trademark clinics were added to the program. In 2014, an additional nine patent and 15 trademark clinics joined the Program. Of the 42 law school clinics that were then certified for student practice, 17 were certified for patent and trademark work, 19 were certified only for trademark practice, and the remaining six clinics were only certified for patent practice.⁴⁵

Given the growing reputation of the pilot program, the noted benefits to pro se and low income applicants and the desire by many law schools to participate, Congress enacted legislation on December 16, 2014 authorizing the program to continue for ten years.⁴⁶ Just this year, the

⁴³ See *Law School Clinic Certification Program*, UNITED STATES PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic1>.

⁴⁴ *Id.*

⁴⁵ See *id.*

⁴⁶ An Act to Establish the Law School Clinic Certification Program of the United States Patent and Trademark Office, and for other purposes, Pub. L. No. 113-227, 128 Stat. 2114 (2014).

USPTO announced that 20 new law schools joined the program, and five currently participating law schools have added a second clinic during the 2016-2018 expansion.⁴⁷ Eight more law schools were added to both the patent and trademark portions of the program, five added to the patent portion of the program, and twelve to the trademark portion of the program. The total number of participating law schools now stands at 63.⁴⁸ This program and its participating law schools have assisted numerous clients desiring IP rights to further their start-up businesses and nonprofits. In the 2017 fiscal year, the USPTO reported that the law school clinics had undertaken 1889 representations and obtained 39 patents and 363 trademarks for their clients.⁴⁹ The aspirations noted in our original request for student practice at the agency have been realized. In its first report to Congress on the program the USPTO reported:

More than 2,700 law school clinic students have been able to practice patent and/or trademark law before the USPTO under the guidance of a Faculty Clinic Supervisor. Not only has this provided superior legal training and invaluable experience to these students, but by providing their IP services to the public pro bono, this has also increased access to legal representation for the public. Specifically, by expanding education about patents, trademarks, and the patents and trademarks system at the law school level, independent inventors and entrepreneurs that have otherwise not been able to obtain quality legal services, have been afforded access to the competent legal representation necessary to succeed and compete in today's economy.⁵⁰

⁴⁷ See *Law School Clinic Certification Program*, *supra* note 43.

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ UNITED STATES PATENT AND TRADEMARK OFFICE, REPORT ON THE LAW SCHOOL CLINIC CERTIFICATION PROGRAM (2016),

The student practice rule benefits clients, local economies, the USPTO and countless IP clinic law students across the country. Many IP clinic graduates have also been hired onto the USPTO examining corps. Much like the early Ford Foundation grants for the first law school clinics, this program was a creative and unique collaboration responding to unmet legal needs in the IP field and has served a catalyst for clinic growth.

V. CONCLUSION

The legal realists and the faculty of the first law school clinics did not set out to transform law schools into trade schools providing training in only practical lawyering skills. The pedagogy of clinical legal education is centered on the continual interaction of theory, practice and reflection. Rules and doctrine are intertwined in that iterative process. I feel confident that the new IP clinics have taken their rightful place in the clinical community and are serving the goals envisioned by the early theorists and founders of the clinical legal education movement. Karl Llewellyn wrote that a lawyer’s work “is impossible unless the lawyer who attempts it knows not only the rules of the law . . . but knows, in addition, the life of the community, the needs and practices of his client—knows, in a word, the working situation he is called upon to shape”⁵¹ Our continuing goal as an IP clinical community should be to introduce our students to the “working situation” of clients needing IP assistance and give them a voice in the IP issues of the day. Clinical legal education has long provided access to legal representation and a robust public voice for the disenfranchised or under-funded stakeholders. It has also

https://www.uspto.gov/sites/default/files/documents/USPTO_Law_School_Clinic_Cert_Program_Report-ec_2016.pdf.

⁵¹ KARL N. LLEWELLYN, *THE BRAMBLE BUSH: THE CLASSIC LECTURES ON THE LAW AND LAW SCHOOL* 17–18 (Oxford Univ. Press 2008).

been instrumental in helping law students to comprehend the important social concerns of the day. Ten years later, it is very clear that the growing and robust IP clinical community is well positioned to continue to serve the twin goals underlying meaningful access to justice.

