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Brief of Amici Curiae Intellectual Property Law Professors in Support of Appellant/Cross-Appellee New Life Art, Inc. and Daniel A. Moore and Affirmance in Part

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Brief of Amici Curiae Intellectual Property Law Professors in Support of Appellant, Board of Trustees of the University of Alabama v. New Life Art, et al., No. 09-16412-AA, (11th Cir. August 5, 2010)

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Nos. 09-16412-AA, 10-10092-A

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

THE BOARD OF TRUSTEES OF THE
UNIVERSITY OF ALABAMA, a public corporation,
Appellee/Cross-Appellant,
v.
NEW LIFE ART, INC., and DANIEL A. MOORE,
Appellants/Cross-Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF ALABAMA, WESTERN DIVISION
CIVIL ACTION NO. CV-05-00585

**BRIEF OF AMICI CURIAE INTELLECTUAL
PROPERTY LAW PROFESSORS IN SUPPORT OF APPELLANT/CROSS-
APPELLEE NEW LIFE ART, INC.
AND DANIEL A. MOORE AND AFFIRMANCE IN PART**

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4. Auburn University
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6. Baumgardner, Lorraine R.
7. Berkman, Gordon, Murray & DeVan
8. The Board of Trustees for the University of Alabama
9. Board of Trustees of the University of Illinois acting for and on behalf of the University of Illinois, Urbana-Champaign
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Identity of the Amici Curiae¹

The following Amici Curiae (collectively, “Amici”) submit this brief in support of the Appellant/Cross-Appellee New Life Art, Inc. and Daniel Moore in *University of Alabama Bd. of Trustees v. New Life Art Inc.*, CV 05-UNAS-PT-585-W (N.D. Ala. Nov. 2, 2009) (“District Court Opinion” or “Opinion”):

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Interest of the Amici Curiae

Amici are law professors who teach and have written extensively on trademark law. Amici have no stake in the outcome of this case.² Our sole interest in this case is in the orderly development of trademark law in a way that serves the public interest by promoting competition and protecting free expression.

Source of Authority of Amici Curiae to File

Appellants/Cross-Appellees consented to the filing of this brief, but Appellee/Cross-Appellant did not. Therefore, a motion for leave of Court to file this brief is submitted herewith in accordance with FED. R. APP. P. 29(a).

² No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amici curiae* or their counsel made a monetary contribution intended to fund its preparation or submission.

Summary of the Argument

The District Court properly held that New Life Art’s (“New Life”) creative works do not infringe the University of Alabama’s (“the University”) rights in the trade dress of its football uniforms, including the their crimson and white colors. First, New Life’s realistic depiction of the University’s football games is not likely to confuse consumers about the source of New Life’s goods, or as to the University’s sponsorship of or affiliation with those goods. Confusion is actionable under the Lanham Act only when it relates to these types of source relationships, and not when consumers merely recognize the plaintiff’s mark. Second, even if some amount of confusion about a relationship between the University and New Life did exist, that confusion would be irrelevant if it was unlikely to affect consumers’ decisions to purchase art from New Life Art. Third, the District Court rightly held that the University’s football uniforms and colors are aesthetically functional as used by New Life. Fourth, and finally, New Life’s expressive works are protected under the First Amendment and cannot be deemed infringing.

Argument

I. The District Court Correctly Found that Confusion is Unlikely

A. Only Confusion Relating to the Source, Sponsorship, or Affiliation of New Life’s Works is Actionable

The District Court properly rejected the University's sweeping assertion that Moore's realistic renditions of notable football plays violate the University's trademark rights simply because consumers will recognize the uniforms depicted in Moore's paintings as those of Alabama's football team. To the extent the District Court concluded that any image of University events inherently created some possibility of confusion simply because the University's uniforms were correctly depicted, it was relying on outdated readings of *Boston Professional Hockey v. Dallas Cap and Emblem Manufacturing*, 510 F.2d 1004 (5th Cir. 1975) and *University of Georgia Athletic Association v. Laite*, 756 F.2d 1535 (11th Cir. 1985), readings that have been repudiated by the Fifth Circuit and are inconsistent with subsequent Supreme Court and Eleventh Circuit cases. This court should correct that mistake.

The University argues, and the District Court partially accepted, that New Life's works are likely to cause confusion because the uniforms depicted in Moore's paintings were the "triggering mechanism" for a sale.³ This claim, however, ignores the fact that the Lanham Act requires a focus on the source of the *goods* at issue. *See* 15 U.S.C. § 1125(a). The plain language of section 43(a) limits claims to uses that are likely to cause confusion of very particular types, specifically confusion *as to the affiliation, connection, or association of such*

³ Brief of Appellee/Cross-Appellant at 28.

person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.” 15 U.S.C. § 1125(a)(1)(A). And this court has made the focus on the source of goods clear. “Our cases have established two elements that [plaintiff] had to prove to merit injunctive relief under § 43(a) of the Lanham Act: (1) that it has trademark rights in the mark or name at issue; and (2) that the defendant adopted a mark or name that was the same, or confusingly similar to the plaintiff’s mark, such that there was a likelihood of confusion for consumers as to the proper *origin of the goods* created by the defendant’s use of the [mark] in his trade.” *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1512 (11th Cir. 1984) (emphasis added).⁴

It is no accident that trademark law focuses tightly on confusion regarding the source of goods.⁵ It does so because the purpose of trademark law, in contrast with patent and copyright, is not to reward innovation or creativity. *See Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001) (“The Lanham Act does not exist to reward manufacturers for their innovation ...”). Instead,

⁴ Amici Curiae University of Arkansas *et al.* (collectively “University Amici”) mischaracterize this fundamental principle of trademark law, claiming “[a] bedrock principle of trademark law is an owner’s right of control the use of its marks.” Amicus at 5. Notwithstanding their desire to control all uses of their marks, trademark owners have never had such plenary control. Setting aside dilution, which is not at issue here, mark owners are entitled only to control uses of a mark that are likely to confuse consumers about the source of another’s goods.

⁵ We use “source” here to include all the source relationships iterated in section 43(a) – source, sponsorship, affiliation, etc.

trademark law is intended to facilitate the operation of a competitive marketplace by preventing sellers from misrepresenting to consumers who is responsible for products or services. *Id.* (“by preventing competitors from copying a source-identifying mark, [trademark law] reduce[s] the customer's costs of shopping and making purchasing decisions, and helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product”) (internal quotations omitted). Hence, the limited nature of trademark rights is not some antiquated legal doctrine; it derives from the core purpose of trademark law.

Boston Hockey and *Laite* departed from these principles in suggesting that trademark infringement could occur when consumers are confused as to the source of a trademark, rather than the product bearing that mark. Most courts after *Boston Hockey* and *Laite* have realized, however, that those cases were inconsistent with trademark law’s purposes and have construed the cases narrowly. In *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, for example, the court expressly declined to read *Boston Hockey* as doing away with the confusion requirement, noting that the plaintiff’s singular emphasis on the “certain knowledge that the [plaintiff was the] source and origin of the trademark symbols” pressed *Boston Hockey* too far. 549 F.2d 368, 389 (5th Cir. 1977) (“By emphasizing this one phrase from our comprehensive opinion, *Boston Hockey*

could therefore be read to dispose of the confusion issue here. We decline, however, to adopt that reading. Boston Hockey also reiterated our unbroken insistence on a showing of confusion, and we believe that our opinion must be read in that context.”). *See also Supreme Assembly, Order of Rainbow for Girls v. J. H. Ray Jewelry Co.*, 676 F.2d 1079, 1082 n.3 (5th Cir. 1982) (explaining that even post-*Boston Hockey* “a claimant must still prove a likelihood of confusion, mistake or deceit of ‘typical’ purchasers, or potential purchasers, as to the connection of the trademark owner with the infringing *product*”) (emphasis added).

Likewise, trademark law’s unquestioned approval of truthful comparative advertising and advertising of replacement parts demonstrates that the only actionable “triggering mechanism” is consumers’ belief that the plaintiff is the *source* of the defendant’s goods. Were this not so, comparative advertising that informed consumers of the existence of generic versions of branded drugs would be infringing, since there would be a causal relationship between the use of the mark and consumers’ choice of the generic. *See* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:52 (4th ed. 2010) (explaining U.S. law’s preference for informing consumers through truthful comparisons even if that diverts business from the trademark owner). Indeed, comparative advertising can even take the form of similar trade dress, so long as it is not so similar it causes source confusion. *McNeil Nutritionals, LLC v. Heartland Sweeteners, LLC*, 511

F.3d 350 (3d Cir. 2007) (contrasting noninfringing and infringing store-brand packaging). Similarly with replacement parts: without using the trademark, the seller can't identify its own goods, and thus there is a causal relationship between use of the mark and the sale. *Cf. B.H. Bunn Co. v. AAA Replacement Parts Co.*, 451 F.2d 1254 (5th Cir.1971) (approving truthful claims about replacement parts). The causation/triggering mechanism argument only holds when it is based on source confusion. *See Custom Mfg. and Engineering, Inc. v. Midway Services, Inc.*, 508 F.3d 641, 647 (11th Cir. 2007) (“Unlike the general prohibition against unauthorized copying that exists in patent and copyright law, the touchstone of liability in a trademark infringement action is not simply whether there is unauthorized use of a protected mark, but whether such use is likely to cause consumer confusion.”).

If there was any remaining doubt that the confusion inquiry must focus on the source of goods, it was relieved by the Supreme Court in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003). Like this case, *Dastar* involved a claim that the content of a creative work implicitly suggested the source of that work. Specifically, Twentieth Century Fox argued that use of footage from Twentieth Century Fox's television series without attribution falsely suggested that Dastar was the source of the content. *Id.* at 27. The Supreme Court rejected that claim, declaring it “out of accord with the history and purpose of the Lanham Act

and inconsistent with precedent.” *Id.* at 32. The Lanham Act does not address claims about the source of creative work, or components thereof; it focuses only on confusion regarding the source of *goods*. *Id.* at 39 (“We do not think the Lanham Act requires this search for the source of the Nile and all its tributaries.”); *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 112 (2004) (holding that the Lanham Act requires “a showing that the defendant’s *actual practice* is likely to produce confusion in the minds of consumers about the *origin of the goods or services in question*”) (emphasis added). According to *Dastar*, the relevant goods for purposes of a claim under section 43(a) are the physical copies that circulate in commerce and not the underlying creative works. *Id.* at 37. In *Dastar*, that meant that the relevant question was whether consumers would be confused about the source of the videotapes *Dastar* was selling.⁶

Dastar intended to rein in vague claims of confusion precisely like the one at issue in this case and to make clear that valid trademark claims are predicated on confusion about source. But rather than heeding *Dastar* and the other more recent cases, the University actually urges this court to adopt a standard that goes beyond even *Boston Hockey*. *See Boston Hockey*, 510 F.2d at 1011 (“We need not deal here with the concept of whether every artistic reproduction of the symbol would infringe upon plaintiff’s rights. We restrict ourselves to the emblems . . .”).

⁶ *See Dastar*, 539 U.S. at 37-38.

The fact that most consumers purchase New Life's products because they contain realistic depictions of the University's indicia does not change this result. In fact, this is precisely where *Boston Hockey* and *Laite*'s broad claims were misguided: the fact that some feature is the "triggering mechanism" for purchase does not necessarily mean others' use of that feature is infringing. The feature at issue must be the triggering mechanism *because consumers believe the use of the mark indicates the source of the defendant's goods*. In other words, the relevant question is not simply "would consumers buy the painting if it did not use the University's marks?" It is instead "do consumers believe the defendant's inclusion of the features at issue suggests to consumers that the University has sponsored or endorsed New Life's paintings?" *Cf. Order of Rainbow for Girls*, 676 F.2d at 1084 ("The fact that purchasers purchased Rainbow jewelry as a direct result of the presence of the Rainbow emblem does not compel the conclusion that they did so believing that the jewelry was in any way endorsed, sponsored, approved or otherwise associated with Rainbow, given the court's findings."); *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 322 (4th Cir. 1992) (noting that intent to profit is not the same thing as intent to confuse and stating it "[could not] assume that the commercial success of the . . . [defendant's] T-shirt resulted from consumer confusion; consumers may have been moved to buy the T-shirt by the simple fact that they were amused by the cleverness of its design.").

If it were otherwise, no one could realistically depict any sporting event without violating some teams' trademark rights. Indeed, no one could ever depict a trademark at all without permission. To say that a party infringes when consumers know the mark originates with the mark owner is to say the mark owner owns all uses of a mark in which the mark is recognizable. When a newspaper writes about the University of Alabama, readers recognize the University's name as a mark of the University. By the University's logic, it would have a prima facie trademark claim there too. A headline that caught a fan's attention and worked as a "triggering mechanism" to buy a newspaper would lead to trademark liability.⁷ *Consumer Reports* magazine would be exposed to liability every time someone bought a magazine for a branded product review.

In all these cases, the defendant could be saved only by arguing that the use was not a "use in commerce" or that it was protected by fair use or the First Amendment (all of which, not incidentally, are arguments the University also rejects). The prima facie case should not be interpreted in ways that put such pressure on these nebulous defenses.

As applied here, for Alabama to sustain a claim it must be clear that consumers regard the presence of the Alabama marks as an indication that

⁷ See *Southwest Recreational Industries, Inc. v. FieldTurf*, No. 01-50073, 2002 WL 32783971 (5th Cir. Aug. 13, 2002); *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

Alabama is the source or sponsor of the physical copies of Moore's works of art.

Specifically, the University of Alabama must show that Moore's inclusion of the Alabama marks in his paintings is likely to confuse consumers about a relationship between Moore and the University or about the University's sponsorship or approval of Mr. Moore's goods. It simply is not enough to claim that consumers will recognize the marks as marks of the University. Nor is it enough to say that consumers might believe the University sponsored or is affiliated with the works simply because the uniforms appear as part of the images Moore created. *Cf.*

Bretford Mfg., Inc. v. Smith System Mfg. Corp., 419 F.3d 576 , 581 (7th Cir. 2005) (stating that, under *Dastar*, "[t]he right question ... is whether the consumer knows who has produced the finished product" and rejecting the plaintiff's claim because the purchaser of the defendant's table knew that the defendant was the producer of the actual, tangible product (regardless of who supplied the components of the table).

B. Some Confusion is Irrelevant

Even if the University could show that consumers are likely to be confused about the source of the physical goods sold by New Life, that confusion should be regarded as irrelevant absent some reason to think it would materially affect consumers' purchasing decisions. As the District Court found, Moore's artistic conception of his subject matter sells the works at issue. There is simply no reason

to think that consumers care what sort of contractual relationship, if any, New Life has with the University, or that they would ever even think about licensing when buying art. Confusion that has no bearing on any decisions consumers make is, like confusion over whether Pluto is or is not a planet, not something in which the Lanham Act should take an interest.

As the Supreme Court held in *Dastar*, the Lanham Act “should not be stretched to cover matters that are typically of no consequence to purchasers.” 539 U.S. at 33. And as some courts have recognized, sponsorship or affiliation in the context of university merchandise is unlikely to be of consequence. In *Board of Governors of the University of North Carolina v. Helpingstine*, for example, the court rejected the University of North Carolina’s claim against a t-shirt manufacturer that sold merchandise bearing the university’s marks, stating

Given that there is a distinct possibility that individuals who buy products from Johnny T-Shirt do not base their decision upon whether the product is sponsored or endorsed by UNC-CH and that Plaintiffs bear the burden of establishing likelihood of confusion, the court holds that UNC-CH must meet its burden by showing more than simply the identity of the marks. Instead, *it must provide evidence establishing that individuals do make the critical distinction as to sponsorship or endorsement, or direct evidence of actual confusion.*”).

714 F. Supp. 167, 173 (M.D.N.C. 1989).

Following *Dastar*, this Circuit has also explicitly recognized that the Lanham Act targets only confusion by the *purchasing* public, not non-purchasers,

because only purchasers' confusion could cause the kind of harm that trademark law aims to prevent. *Custom Mfg. and Eng'g*, 508 F.3d at 650-51; *cf. id.* at 652 (“We reject such a theory of infringement in a vacuum, as liability under the Lanham Act is properly tied to the real-world context in which the alleged trademark use occurs.”). It follows that confusion that is not tied to a purchase decision—no matter in whose mind it exists—is equally irrelevant to the Lanham Act.

Materiality is particularly important in cases of expressive works because it is very likely that consumers will be motivated to purchase the work by the quality of the artistic expression and not by their belief as to who authorized the physical good. *See Silverman v. CBS, Inc.*, 870 F.2d 40, 48-49 (2d Cir. 1989) (“[M]ost theater-goers have sufficient awareness that the quality of a musical depends so heavily on a combination of circumstances, including script, score, lyrics, cast, and direction, that they are not likely to be significantly influenced in their ticket-purchasing decision by an erroneous belief that the musical emanated from the same production source as the underlying work.”).

Here, in light of Moore's own artistic reputation and his prominent use of his name on each painting, there is simply no reason to think that consumers care what sort of contractual relationship, if any, New Life has with the University, or that they would even think about such a relationship when making decisions. *Cf., e.g.,*

Nabisco, Inc. v. Warner-Lambert Co., 220 F.3d 43 (2d Cir. 2000) (holding that prominent use of the defendant’s own name diminished the chance of confusion). Indeed there is good evidence any such confusion is irrelevant to consumers: New Life sold unlicensed art for almost many years to no apparent harm.

Focusing on materiality also should inform the scope of relief even if the court believes some confusion is relevant. Specifically, even if the Court concludes that some small number of consumers may care about the University’s relationship to Moore’s work, that concern can be addressed simply by prohibiting New Life from making any explicit statement (such as “Officially Licensed by the University of Alabama”) that suggests authorization. Indeed, that distinction between licensed and unlicensed work, which New Life has diligently made, has clearly been successful in preventing any harm for these many years.

II. The District Court Properly Held that New Life’s Works Are Protected Works

If New Life had been offering educational services using the University of Alabama’s name, or fielded a collegiate athletic team using the allegedly distinctive uniform colors, the considerations in this case might be different, though in the latter instance many other teams might have arguments of their own. But Moore is an artist whose paintings represent an entire scene taken from reality.

Trademark law was not intended to prohibit artists like Moore from depicting individuals in their work simply because those individuals are wearing trademarked apparel. Indeed, audiences are interested in Moore's work precisely because they are realistic depictions of actual events.

We think the District Court rightly concluded that the University's football uniforms are functional as used by New Life, and that New Life's art is protected by a fair use defense. But whether the doctrinal tool is functionality (because uniform colors are essential to the purpose of representing an element of the world); aesthetic functionality (because New Life has a non-reputation-related interest in providing a feature consumers want); nominative fair use in the spirit of *Mattel Inc. v. Walking Mountain Productions*, 353 F.3d 792 (9th Cir. 2003); or a First Amendment-based defense like the one in *Rogers v. Grimaldi*, 875 F. 2d 994 (2d Cir. 1989), the point is the same: Trademark law recognizes that claims of source confusion must be rejected when they interfere with substantial policies ensuring freedom to speak or to compete.

A. The District Court Correctly Held that the University's Marks are Aesthetically Functional as Used by New Life

The District Court properly concluded that the New Life used the Alabama colors primarily for a functional purpose.⁸ Moore’s intent, as the District Court found, “was to paint interesting plays.” (Doc. 311 at 11). Painting interesting plays in an Alabama football game necessitates depiction of Alabama football uniforms, which serve the non-source-related function of making the painting realistic.

As this court recognized in *Dippin’ Dots, Inc. v. Frosty Bites Distribution, LLC*, 369 F.3d 1197 (11th Cir. 2004), the Supreme Court has identified two different types of functionality: (1) mechanical or utilitarian functionality; and (2) aesthetic functionality. *See TrafFix*, 532 U.S. 23. Features are functional in the first, utilitarian sense when they are “essential to the use or purpose of the article or ... [affect] the cost or quality of the article.” *Id.* at 32; *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995). Aesthetically functional features, on the other hand, are features valued by consumers for non-source-related reasons such that ““exclusive use of the feature at issue would put competitors at a significant non-reputation-related disadvantage.”” *TrafFix*, 532 U.S. at 33.⁹

⁸ As the University of Alabama’s uniform colors are unregistered, the University bears the burden of proving that the claimed features are not functional. 15 U.S.C. § 1125(a)(3).

⁹ University Amici downplay *TrafFix* by claiming the Court’s discussion of “aesthetic functionality” was mere dicta. University Amicus at 19, fn 7. In fact, the distinction between utilitarian and aesthetic functionality was an important part of the Court’s holding that competitive necessity need not be considered when the

Utilitarian functionality serves two purposes. “First, by ensuring that competitors remain free to copy useful product features, it prevents the trademark law from undermining its own pro-competitive objectives. Second, the functionality doctrine prevents the trademark law from conflicting with the patent law by eliminating trademark monopolies of potentially unlimited duration on a product's utilitarian features.” See *Wilhelm Pudenz, GmbH v. Littlefuse, Inc.*, 177 F.3d 1204, 1207 (11th Cir. 1999) (internal citations omitted). Aesthetic functionality shares only one of these concerns. It is not concerned with patent law because aesthetic functionality focuses on features that are not mechanically necessary for the operation of the product at issue. But because it deals with features that are necessary because of a market constraint imposed by consumer

feature is functional under the “traditional rule.” *TrafFix*, 532 U.S. at 33. The Sixth Circuit’s holding that the dual-spring design at issue in *TrafFix* was not functional was based on its judgment that the feature was not competitively necessary. *Id.* at 32 (“The Court of Appeals in the instant case seemed to interpret this language to mean that a necessary test for functionality is “whether the particular product configuration is a competitive necessity.”) (citations omitted). In reversing the Sixth Circuit, the Supreme Court explicitly rejected the notion that competitive need was relevant once the traditional test of functionality was established. By contrast, it made clear that the competitive need inquiry is proper in aesthetic functionality cases. *Id.* at 33. Moreover, it is irrelevant whether the University Amici agree with the Supreme Court that aesthetic functionality was the issue in *Qualitex*. See University Amicus at 19, n. 7 (suggesting that *TrafFix* was about the issue in *Qualitex*). The point is that the *TrafFix* Court acknowledged the existence of both types of functionality.

expectations,¹⁰ aesthetic functionality strongly implicates the first of the two purposes of the utilitarian functionality doctrine. *See Deere & Co. v. Farmhand, Inc.* 560 F Supp. (S.D. Iowa), *aff'd*, 721 F.2d 253 (8th Cir. 1982) (finding the color green for farm equipment functional based upon evidence that farmers preferred their farm equipment to be in matching colors); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (1995) (defining features as aesthetically functional “[w]hen aesthetic considerations play an important role in the purchasing decisions of prospective consumers,” and a particular design feature “substantially contributes to the aesthetic appeal of a product”). And that is why the Supreme Court focused the inquiry in aesthetic functionality cases on the competitive effects of exclusive use. *TrafFix*, 532 U.S. at 32-33. Aesthetic functionality therefore considers whether consumers demand certain features such that “exclusive use [of those features] would put competitors at a significant non-reputation-related disadvantage.” *Id.*

This court applied the lessons of *TrafFix* in *Dippin’ Dots*, finding that the color, shape, and size of dippin' dots [have] ‘aesthetic functions’ that easily satisfy the competitive necessity test because precluding competitors like FBD from copying any of these aspects of dippin' dots would eliminate all competitors in the flash-frozen ice cream

¹⁰ As in fact utilitarian functionality is ultimately dependent on consumer desires. No object is functional unless a consumer wants to do something with it: even a wheel only has value because people want to use it, which is why roller skates can be functional even if there are more efficient, safer, and more pleasant ways to travel.

market, which would be the ultimate non-reputation-related disadvantage.

Dippin' Dots, 369 F.3d at 1203 n. 7. And while the shape and size of dippin' dots could be viewed as mechanically functional, ice cream colors are functional purely in the aesthetic sense. Dippin' Dots' color code was based on flavor, and certain flavors generally are denoted with particular colors. But coloring of the flash-frozen ice cream was not compelled by its ingredients or the method by which it was made. In fact, the coloring is completely artificial, so there is no reason the defendant could not have made its strawberry-flavored ice cream purple.¹¹ The defendant's need to use pink was purely a function of consumer expectations: a substantial number of consumers want their strawberry-flavored ice cream to be pink.

Inability to use Alabama's uniform colors would put New Life at a similarly significant, non-reputation-related disadvantage. Indeed, the fact that most consumers purchase New Life's products *because* they contain realistic depictions of the Alabama football uniforms actually demonstrates New Life's competitive need. As the University emphasizes, if New Life were to make the University's jerseys purple, Alabama fans would not want them. *See* Brief of Appellee/Cross-

¹¹ For this reason University Amici are wrong when they claim, contrary to the express language of the decision, "color shape and size of the flash-frozen ice cream beads at issue did not serve 'aesthetic functions' but utilitarian ones." University Amicus at 15, note 4.

Appellant at 29. But consumers wouldn't want a painting of a purple Statue of Liberty, and for the same reason: consumers want realistic depictions of real-world things, and neither the Statue of Liberty nor the University of Alabama's uniforms are purple. Other colors simply are no substitute for *accurately depicting* Alabama's Crimson and White, and it is accurate depiction, rather than source identification, over which the University here seeks a monopoly.¹²

This is precisely the understanding of competitive necessity that motivated this court in *Dippin' Dots*, where, in rejecting the claim that the defendant had other design features available to it, this court said:

DDI's argument that FBD could still compete in the ice cream market by producing, e.g., soft-serve ice cream, which would not have many of the same functional elements as dippin' dots and thus would not infringe upon DDI's product trade dress, is unavailing. FBD does not want to compete in the ice cream business; it wants to compete in the flash-frozen ice cream business, which is in a different market from more traditional forms of ice cream.

369 F.3d at 1204. In the same way, New Life *could* have used different colors. But if it did so, it would have been selling a different product. Fans of Alabama football want pictures of Alabama football players, and it is cold comfort to say that New Life can sell pictures of non-Alabama football players. *See Publ'ns Int'l*,

¹² This point is further established by the District Court's finding that "the plays and Moore's reputation established during a period when his art was agreeably not licensed are what predominantly trigger the sales" of his paintings. (Doc. 311 at 7). Barring him from depicting reality would hamper his ability to use his own talents and reputation to produce art.

Ltd. v. Landoll, Inc., 164 F.3d 337, 342 (7th Cir. 1998) (rejecting the plaintiff's claim that the allegedly infringing cookbooks' pages could have been gilded a color other than gold, which was the color of the plaintiff's cookbooks' gilded pages, because “[g]old connotes opulence” and is “a natural color to use on a fancy cookbook”).¹³

The University, and University Amici, seek to avoid this conclusion by arguing that any disadvantage New Life would suffer if it was not entitled to use Alabama's team colors are reputation-related. *See* University Amicus at 13-14. But this argument mischaracterizes the role of “reputation” here. When the Supreme Court said that the functionality doctrine protects competitors only against a “non-reputation-related” disadvantage, it did not mean that the features at issue could not evoke a mark holder or its reputation. Every use of a mark that consumers recognize as a reference to the mark holder implicates reputation in this sense. The “reputation” that matters is a reputation *as a source of goods or services*. "

¹³ In fact the plaintiff in *Dippin Dots* argued, and this Court rejected, an argument specifically about colors that was much like the one the University presses here. *Dippin' Dots* claimed that, even if the defendant needed to use certain colors generally, it did not need to copy the “identical Pantone color” used by *Dippin Dots*. The court expressly rejected that argument. *Dippin' Dots*, 369 F.3d at 1205 n.9. This too was consistent with the Supreme Court's instruction in *TrafFix* that, once a feature is functional, alternative design possibilities need not be considered. *See TrafFix*, 532 U.S. at 33-34

The relevant question is whether the disadvantage that New Life would suffer if it could not depict the University's marks relates to an attempt to benefit from the reputation of the University by using its mark to indicate the source of artistic goods or whether instead the disadvantage would flow from New Life's inability to engage in expression unrelated to indicating the source of the goods. **And the proper focus here is on the role those features play as used by New Life.** Some courts have misunderstood this and have refused to find aesthetic functionality when the defendant has made use of a feature that unambiguously serves as a trademark when used to denote the plaintiff's goods or services on the theory the aesthetic function cannot be separated from source indication. *See, e.g., Bd. of Supervisors for La. State Univ. Agric. & Mech. College v. Smack Apparel Co.*, 550 F.3d 465, 486 (5th Cir. 2008), *cert. denied*, 129 S. Ct. 2759 (2009) (affirming the District Court's holding that the plaintiff universities' color schemes, logos, and designs had no significance other than to identify the Universities and were therefore nonfunctional); *Automotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1067, 1074 (9th Cir. 2006), *cert. denied*, 549 U.S. 1282 (2007) (refusing to declare plaintiff's logo functional when used to adorn a key chain, even while recognizing that "[c]onsumers sometimes buy products bearing marks such as the Nike Swoosh, the Playboy bunny ears, the Mercedes tri-point star, the Ferrari stallion, and countless sports franchise logos,

for the appeal of the mark itself, without regard to whether it signifies the origin or sponsorship of the product.”).

These decisions miss the mark because they focus on the role the features at issue play when used by the plaintiffs as an indicator of the source of their products. The fact that a product feature is non-functional in some contexts, however, does not necessarily mean that the feature is non-functional for all purposes. The aesthetic functionality doctrine, at its core, is concerned about the consequences of giving one party exclusive rights to a feature that may harm others' ability to offer products with features that consumers want. Where the plaintiff and defendant compete directly, the consequence of a finding of aesthetic functionality will be to bar trademark protection for the feature altogether. *See Deere*, 560 F.Supp. 85. But this will not always be so: the defendant in a particular case might need access to a particular feature for a different reason than the plaintiff, leaving the trademark perfectly valid in its primary market, but functional within the context of the defendant's use. *See Rosetta Stone, Ltd. v. Google, Inc.*, No. 1:09-cv-00736-GBL-TCB slip. op. (E.D. Va. August 3, 2010) (finding Google's particular use of trademarked keywords as triggers for paid advertisements functional even though the terms clearly operated as trademarks for the plaintiff's goods). It is the defendant's non-source-related need, in such cases, that triggers the aesthetic functionality doctrine. When, as here, the defendant is

depicting a mark as part of a larger work depicting real-life events, the information-conveying function of the use can readily be distinguished from a source or sponsorship message.

At bottom, the University's functionality argument, like its argument regarding relevant confusion, boils down to a simple contention that New Life's ability to use the colors of Alabama's football uniforms allows New Life to gain a benefit for which the University would charge a licensing fee if it could.¹⁴ But this circular claim to a licensing market does not justify the right they seek. *See generally*, Mark A. Lemley & Mark P. McKenna, *Owning Mark(et)s*, 109 Mich. L. Rev. __ (forthcoming 2010) (<http://ssrn.com/abstract=1604845>). Where, as here, the trademark is used by the defendant primarily as a desirable feature of a product rather than to indicate the source of its own goods, "competition suffers – and consumers pay – if other sellers are shut out of the market for that feature."¹⁵

¹⁴ The University's professed concern for its image is certainly not evident in its licensed rivalry figurines showing arch-enemy Auburn humiliating the Tide mascot, uniforms, and colors. See <http://www.elitedeals.com/mem-col-au-072-400.html> (uniforms); <http://www.elitedeals.com/mem-col-au-051-400.html> (mascot wearing uniform: "It is hand painted in team colors and, as you can see, show the mascot squeezing the rival mascot for all he's worth. See how scared that other mascot looks? Now that's funny."); http://www.footballfanatics.com/COLLEGE_Auburn_Tigers/Auburn_Tigers_Crunchtime_Rivalry_Figurine (Tide colors). Many of the University Amici license similarly humiliating treatments, available for purchase at the same sites.

¹⁵ Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory L.J. 461, 465 (2004)

B. The District Court Properly Held New Life's Paintings Are Protected Expression

Amici are in agreement with Amici Curiae American Society of Media Photographers, Inc. and Alabama Press Association that the University's position puts the Lanham Act in needless conflict with the First Amendment. We therefore only add the following observations: Broad claims to control untethered from material confusion regarding the source of goods or services pose particular risks to free expression. In fact, while all aspects of trademark law can pose First Amendment threats, it is no accident that the worst problems don't come from traditional suits against the sale of competing products, but rather from claims that try to stretch the concept of confusion to cover creative works by using the rubric of sponsorship or affiliation.

With the importance of brand image in today's economy, trademarks "form an important part of the public dialog on economic and social issues."¹⁶ Restricting this speech is harmful to society. As Judge Kozinski has noted, "[m]uch useful social and commercial discourse w[ill] be all but impossible if speakers [are] under threat of an infringement lawsuit every time they ma[k]e reference to a person,

16. 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:146; *see also* *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30 (1st Cir. 1987) ("[T]rademarks offer a particularly powerful means of conjuring up the image of their owners, and thus become an important, perhaps at times indispensable, part of the public vocabulary." (quoting Robert C. Denicola, *Trademarks As Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 195-96)).

company or product by using its trademark.”¹⁷ And this is the natural consequence of the University’s claim. If the University can control an artistic depiction of an event in which its players participated, then it can make the same arguments to control uses of its name, images of its players, images of its buildings, or any other indicia that serve to identify the subject matter of an informational or artistic work.

There are good reasons that the subjects of discourse are not allowed to decide how they will be shown or spoken of, outside the heavily regulated boundaries of defamation and privacy law. The First Amendment barred Jerry Falwell from suppressing a depiction of himself that he found humiliating, *see Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46 (1988), and the First Amendment likewise protects even more favorable depictions from more subtle censorship. As Doc. 255, Exhibit 20 shows, an artist producing a University-licensed work would be subject to NCAA regulations, which require changing players’ names and fictionalizing history. An artist’s freedom to choose to produce a more realistic representation should not be subject to the constraints the University has put on its own depictions. *Cf. CBC Distribution and Marketing, Inc. v. Major League Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007) (finding that the First Amendment trumps ownership claims over facts regarding baseball players).

17. *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992); *see also Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992) (holding that the First Amendment is implicated by expressive, rather than commercial, uses of a trademark).

III. Conclusion

Amici respectfully submit to the Court that, for the foregoing reasons, New Life Art's realistic depiction Alabama football games cannot give rise to a claim under the Lanham Act.

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CERTIFICATE OF COMPLIANCE

Pursuant to Rule 32(a)(7)(C) of the Federal Rules of Appellate Procedure, the undersigned certifies that:

1. This brief complies with the type-volume limitation of FED. R. APP. P. 29(d) and 32(a)(7)(B) because this brief contains 6,501 words, excluding the parts of the brief exempted by FED. R. APP. P. 32(a)(7)(B)(iii), as determined by the word processing system used to generate the brief.
2. This brief complies with the typeface requirements of FED. R. APP. P. 32(a)(5) and the type style requirements of FED. R. APP. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Office Word 2007 in Times New Roman font, 14 point.

Dated: August 5, 2010

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CERTIFICATE OF SERVICE

I hereby certify that I filed the foregoing BRIEF OF AMICUS CURIAE INTELLECTUAL PROPERTY LAW PROFESSORS IN SUPPORT OF NEW LIFE ART, INC. AND DANIEL MOORE AND IN SUPPORT OF AFFIRMANCE, IN PART on August 5, 2010, by sending the original and six (6) copies thereof by Federal Express to:

Clerk, United States Court of Appeals for the Eleventh Circuit

I further certify that I served the foregoing BRIEF OF AMICUS CURIAE INTELLECTUAL PROPERTY LAW PROFESSORS IN SUPPORT OF NEW LIFE ART, INC. AND DANIEL MOORE AND IN SUPPORT OF AFFIRMANCE, IN PART on August 5, 2010 by sending a copy thereof by Federal Express Ground, in a sealed envelope, to the address of each counsel, as listed below:

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