Proskauer

Three Point Shot

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Keep Off the (Patented) Grass

Maintaining a beautiful lawn usually requires a lot of work, unless you are friends with Edward Scissorhands or install a "Brady Bunch" lawn of artificial grass instead. Installing artificial grass (or turf) has been an increasingly popular option in the sports industry, but with the average price of installation of a football field being quoted at $380,000, things were bound to get dirty.

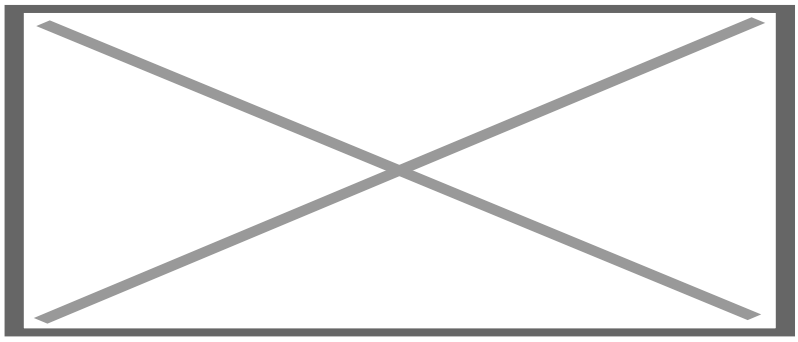
In 2010, FieldTurf USA, Inc. and FieldTurf Tarkett, Inc. ("FieldTurf") filed a patent infringement suit against AstroTurf, LLC. (*FieldTurf USA, Inc. v. Astroturf, LLC*, No. 2:2010cv12492 (E.D. Mich. filed June 23, 2010)). Recently, after a month long trial, a jury found AstroTurf willingly infringed FieldTurf's U.S. patent No. 6,723,412 ("the '412 patent") and awarded FieldTurf $30 million in damages.

FieldTurf and AstroTurf are rivals in the artificial grass industry – manufacturing, selling and installing synthetic turf products for sports and recreational fields. The first major installation of a synthetic grass surface was in 1966 at the Astrodome in Houston, Texas. It was touted as being able to stand up better to wear than natural grass, require less maintenance, and "survive" without sunlight when installed in closed stadiums. However, after extended use, the first generation of artificial surfaces became harder and less resilient, presented drainage problems, interfered with the speed and bounce of balls, caused skin abrasion to players and even gripped players' cleats, representing a risk of injury to players' legs, ankles or knees (including metatarsophalangeal joint sprain, or "turf toe").

With time, manufacturers developed new technologies and "synthetic turf systems" to make it closer to the real thing. This brings us to the turf war around FieldTurf's '412 patent. According to FieldTurf, its '412 patent provides an improved synthetic grass surface that is more resilient, has improved drainage and playing properties, is less expensive to maintain, and less abrasive to players. Shortly after its issuance, at the request of a third party, the USPTO reexamined and confirmed the patentability of all claims of the '412 patent. Although there is still debate about whether artificial turf increases the risk of sports injuries, FieldTurf also claims its product is safer than any other artificial surface and "equal to – if not better than – natural grass in most critical areas of player safety."

For those who want to dig further, the main advance of the '412 patent, according to FieldTurf's filing, was that it employed grass ribbons "having a length about twice as long as the spacing between the rows of ribbons" and in a unique three-layered particulate infill system comprised of a bottom layer of washed silica sand, a mix of cryogenic rubber and silica, and a top layer of larger-sized cryogenic rubber, in which "the thickness of the particulate material is at least two-thirds the length of the ribbons."

Here's a look at FieldTurf's patented system:



In its infringement complaint, FieldTurf asserted that after the issuance of the '412 patent, AstroTurf offered for sale, sold and installed certain synthetic turf products covered by one or more of the claims of the '412 patent. In addition to the patent infringement claim, FieldTurf alleged violations of the Lanham Act and unfair competition under Michigan common law, asserting AstroTurf had intentionally engaged in unfair methods of competition by making false and/or misleading statements about its products.

Not content to wonder if those patented grass stains would come out in the wash, AstroTurf counterclaimed for a declaratory judgment that the '412 patent was invalid, and not infringed, and also asserted violations of the Lanham Act, unfair competition and defamation. According to AstroTurf, its competitor withheld material information from the USPTO that would have affected the patentability of the '412 patent.

Ultimately, the jury disagreed, finding that AstroTurf willingly infringed the '412 patent and awarding FieldTurf $30 million in lost profits and reasonable royalties. The jury also rejected, in their entirety, AstroTurf's counterclaims, and following the verdict, the parties have filed multiple post-trial motions. Bouncing right up after that ferocious tackle, Astroturf announced that the ruling will not impact customers because it only relates to a limited line of products in its portfolio and that the company may appeal the judgment. For now, however, it looks like the grass is greener on FieldTurf's side.

"It Ain't Over Till It's Over" – Photographers Obtain Preliminary Injunction to Halt Infringing Sales of Memorabilia

The late Yogi Berra once quipped: "You've got to be very careful if you don't know where you are going, because you might not get there." Professional sports photographers know exactly where they are going when aggressively pursuing protection of their rights.

On June 23, 2015, plaintiffs Scott Boehm and David Stluka, two professional sports photographers, lodged a suit requesting several sports memorabilia suppliers and retailers to stop selling or distributing sports collectibles containing unauthorized copies of their photographs. In an instant replay, this is the second copyright infringement case that the plaintiffs have brought against sports memorabilia retailers for selling unlicensed copies of their copyrighted photographs as part of sports merchandise, having litigated similar claims in Wisconsin district court in 2013.

In the current dispute, the photographers filed for a preliminary injunction, claiming irreparable harm if the alleged unlicensed sales continue. Even though some of the retailers claimed that the injunction was not necessary, as they professed to have already stopped selling any infringing merchandise, the photographers argued that without the injunction there is no way to eliminate the defendants' incentive to sell off inventory of the merchandise before a definitive court ruling or otherwise prevent any future copyright violations. A Wisconsin district court found the defendants' practices out of bounds, ruling that the balance of harms favored the plaintiffs and the public interest favored enforcement of IP rights. In August 2015 (and later enunciated in a September 2015 Order), the court granted a preliminary injunction barring the defendants from creating, displaying, selling, or distributing any reproduction in any medium of the copyrighted photographs that are the subject of the suit. (*Boehm v. Scheels All Sports*, No. 15-379 (W.D. Wisc. Sept. 8, 2015)). The September Order also prohibited the defendants from destroying or otherwise disposing of any unauthorized copies in any medium of the covered photographs, and required the defendants to safely secure all memorabilia that contains the covered photos (and retain all documents relating to the sale or acquisition of the covered photographs).

Following the issuance of the original injunction in August, a visit to the store of one of the defendants, Gameday Sports LLC, allegedly revealed the presence of contested merchandise still on sale – what the plaintiffs labelled as an attempt to "hide evidence before discovery began" and a violation of the preliminary injunction. Crying foul, the plaintiffs subsequently moved the court for several types of relief: (1) injunctive relief barring the defendant from further violations of the injunction; (2) a directed verdict of willful copyright infringement ($600,000 in total for four instances of alleged infringement); (3) $25,000 in sanctions for non-compliance and attorney's fees, and an additional $10,000 per day for any continuing violations. The photographers accused Gameday Sports of continuous violation of the injunction and deceiving the court about the store's voluntary cessation of unlicensed products sales containing the plaintiffs' works. Subsequently, another online store was allegedly discovered to be selling infringing merchandise, despite the store operator having reported to the court that he had no reproductions of the covered photographs in his possession.

Upon further review, on October 26, 2015, the court made a preliminary finding of contempt and ordered the defendants to appear at a future hearing to show cause why they should not be sanctioned for contempt, including potentially for criminal contempt. Yet, on November 25, 2015, the court refused to amend the existing preliminary injunction to require all defendants to "quarantine reproductions of any photograph in which the defendant does not itself hold the copyright, pending review by an independent auditor." The court recognized the plaintiffs' legitimate concerns of non-compliance with the injunction, but declined to impose a "sweeping prohibition" involving works not at issue in the suit, instead suggesting that the court would award appropriate relief against defendants who have failed to comply with the injunction.

After obtaining a preliminary injunction and pushing for sanctions against those sellers who allegedly violated the court order, the plaintiffs have no intention of winning the battle but losing the war. The plaintiffs also requested that the court amend the preliminary injunction to require that all defendants "quarantine reproductions of any photograph in which the defendant does not itself hold the copyright, pending review by an independent auditor." The court denied the motion, however, refusing to impose such a "sweeping prohibition" on photographs not at issue in the suit, instead noting that in accordance with sanctions sought by the plaintiffs, the court would award appropriate relief against non-complying defendants. Determined to protect their rights, the photographers are still seeking monetary damages and a permanent injunction to ban the sale of the infringing articles once and for all. It ain't over till it's over, as the final decision is yet to come.

Running Shoe Companies Accused of Infringing Sports Apparel Patent

They can run, but they can't hide! Asics and New Balance, two leading sports apparel companies known for their popular brands of running shoes, may have gotten themselves stuck in the mud. Blackbird Tech LLC, a firm that routinely assists individual investors and small companies realize the value of their patents, sued the several companies in Delaware federal court this month for allegedly infringing its own patent for a sports bra. (See e.g., *Blackbird Tech LLC v. ASICS America Corp.*, No. 15-00929 (D. Del. filed Oct. 14, 2015)). Blackbird also filed separate suits against the sportswear entities, citing U.S. Patent Number 7,867,058 in similar complaints. In addition to going after Asics and New Balance, Blackbird stretched its patent portfolio even further and pursued a claim against Lululemon – no stranger to litigation itself – along with Swoob and Zoot Sports, two lesser-known sports apparel companies.

The company generally seeks a recovery of past damages in the form of, at a minimum, a reasonable royalty and injunctive relief, indicating a desire for a jury trial on all issues. According to its website, Blackbird often resolves these kinds of disputes through settlement.

The patent in question is described with particularity: it covers a sports bra with an integral storage pouch formed by a top opening on the material, capable of holding an object such as a phone or other electronic device. The patent was filed in 2007 and eventually published in 2011. According to Blackbird, the products that infringe on the patent include: Asics' Abby Pocket Bra, New Balance's Fabulous Framer Bra, Lululemon's Stuff Your Bra II, Swoob's Idona Racerback Pocket Sports Bra and Zoot's Women's Run Moonlight Bra.

This is not the first instance of a patent holder accusing competitors of infringement over a sports bra; earlier this year, Sarvint Technologies claimed that one of Victoria's Secret's offerings infringed on a patent of its own. Further, at least one of the alleged infringers, Lululemon, finds itself on the other end of a familiar dispute. The high-end workout apparel company sued Calvin Klein and G-III Apparel in 2012 for violating a design patent on its yoga pants. Since then, it has accumulated a total of 31 patents on a variety of designs.

These recurring disputes should not come as a surprise: the women's athletic apparel segment is growing fast (not to mention the frequency of runners toting their phones or other devices on runs), and companies are jockeying for position as they try to capture additional market share. With so many big players implicated by Blackbird's claims, any court ruling could ripple throughout the entire industry. Whatever the result, this dispute is another in an increasing trend of "athleisure" brands looking to protect their sales via intellectual property rights.

Postscript: Exhale…Ninth Circuit Rules Sequence of Yoga Poses Not Copyrightable

In the June edition of Three Point Shot, we wrote about the copyright dispute between Bikram Choudhury and his Bikram yoga institution and a small yoga studio that began offering Bikram-style "hot yoga" classes that used the same sequence of 26 poses. In the past, Mr. Choudhury had issued cease and desist letters to several yoga studios for copyright infringement, typically resulting in settlements that have prevented such studios from using the Bikram name or copying the Bikram Sequence of poses. The defendant, Evolation Yoga, however, remained inflexible and refused to capitulate, prompting this heated dispuate. In 2012, a California district court dismissed the copyright claims and held that although books or photographs that depict a compilation of exercises may be copyrightable, the compilation authorship would not extend to the selection of the exercises themselves depicted in the photographs.

After analyzing the bends and twists of the Copyright Act, the Ninth Circuit affirmed the dismissal of copyright claims, refusing to place copyight law's idea-expression dichotomy on its head and achieve the legal enlightenment that Choudhury's attorneys urged. (*Bikram's Yoga College of India, L.P. v. Evolation Yoga, LLC*, 2015 WL 5845415 (9th Cir. Oct. 8, 2015)). The appeals court held that the Bikram Sequence was not copyrightable because it was an idea, process, or system designed to improve health, rather than an expression of an idea, and was otherwise ineligble for protection as a compilation of choregraphic work: "That the Sequence may produce spiritual and psychological benefits makes it no less an idea, system, or process and no more amenable to copyright protection." The appeals court rejected Choudhury's argument that, in fashioning the sequence, he could have chosen from hundreds of postures, instead concluding that "the possibility of attaining a particular end through multiple different methods does not render the uncopyrightable a proper subject of copyright." In a final pose, on December 7th, Choudhury filed a petition for an en banc rehearing before the full Ninth Circuit.

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