

# GIPSON HOFFMAN & PANCIONE

## IN THIS ISSUE

[Doll Wars: Barbie v. Bratz](#)

[Scared of Internet Pirates?](#)

## LAWRENCE R. BARNETT



Mr. Barnett is the firm's managing partner. Mr. Barnett represents diverse domestic and international private and public companies, as well as individual entrepreneurs, in the full range of corporate, securities and business matters.

Mr. Barnett is responsible for the content of this newsletter.

[More: About Mr. Barnett](#)  
[Contact Mr. Barnett](#)

## KENNETH I. SIDLE



## IP INSIGHT

A Newsletter Featuring Practical Analysis of Intellectual Property, Entertainment and Media Issues

Welcome to our first issue of the GHP online newsletter "IP Insight." At GHP, we strive to make tangible contributions to our clients' success with services that extend beyond the routine. We provide creative and practical solutions to problems that arise in today's complex business environment.

Equally important to what we do is how we do it. We operate in flexible, integrated service groups that combine our expertise and knowledge to help our clients realize their business objectives.

[Lawrence R. Barnett](#)

### Doll Wars: Barbie v. Bratz

by [Ken Sidle](#)

What does a company have to gain by ensuring that the intellectual property created by one of its workers belongs to the company even after the worker leaves the company? Potentially in excess of \$100 million and control of its competitor's assets.

Such are the lessons learned from the biggest IP case of the past year -- or perhaps any year -- the copyright infringement case between Mattel, the maker of Barbie dolls, and MGA Entertainment, the maker of Bratz dolls. Unlike the all-American blonde and preppy Barbie doll, the Bratz doll is variously described as a doll of indeterminate ethnic background, "saucy," and far more modern and contemporary than its tried and true counterpart. The Bratz doll concept originated with designer Carter Bryant.

In the lawsuit, Bryant and MGA contended that Bryant conceived the design of the Bratz dolls during a period when he was not working for Mattel and legitimately sold the concept to MGA after Mattel had passed on it. On the eve of trial, Mattel and Bryant reached a confidential out of court settlement.

In July 2007, a federal jury determined that Bryant had come up with the Bratz concept while working at Mattel, and in August 2007, the jury awarded Mattel damages in the amount of approximately \$100 million-an award that was substantially increased by subsequent orders of the trial judge.

In December 2008, a federal trial judge issued an order declaring that Mattel owns all right, title, and interest in the Bratz dolls and characters. The judge also permanently enjoined MGA from

Mr. Sidle is the head of GHP's litigation group. Mr. Sidle has won several high profile cases in the areas of copyright and intellectual property, including a unanimous United States Supreme Court decision.

[More: About Mr. Sidle](#)  
[Contact Mr. Sidle](#)

#### ELLIOT B. GIPSON



Mr. Gipson is a member of the firm's IP/Media group. Mr. Gipson's practice includes the registration, protection and enforcement of copyrights and trademarks.

[More: About Mr. Gipson](#)  
[Contact Mr. Gipson](#)

manufacturing, marketing or selling any of the Bratz and Bratz--related products.

The Bratz case amply demonstrates the importance of ensuring protection of copyrighted works that are created by an employee. While, under the Copyright Act, copyrightable works that are prepared by an employee within the course and scope of his employment are usually considered works made for hire for that person's employer, it's always possible that a jury could find that works that the employee created at home during non-working hours were not made within the "course and scope" of his employment. For companies whose intellectual property assets form a valuable part of their business -- i.e., nearly every 21st century enterprise -- the better practice is always to have a written agreement with your employees in which they acknowledge that all copyrightable works they create while they are employed by the company are works made for hire for the company, regardless of when or where they are created. Companies should also take similar steps to protect other valuable intellectual property assets such as patents and trademarks. As is clear from the Bratz case, a relatively small effort to protect one's intellectual property assets now can pay enormous dividends in the future.

### Scared of Internet Pirates? Beware of Rescuers

by [Elliot Gipson](#)

You have spent time and money building your business and your website. Understandably, you want to protect it. One day, you get an email from an internet website protection service informing you that someone else has registered a domain name similar to yours. For a small fee, this service offers to buy the domain name on your behalf and monitor registration activity of similar domain names in the future. Good idea?

If the old English saying about a fool and his money comes to mind, then you are on the right track. The fact of the matter is that there are very few legitimate "internet website protection services" but many enterprising and ethically challenged individuals willing to exploit your fears to make a quick buck.

Such services purport to offer the prospective clients a chance to protect their trademarks by blocking "John Doe" from registering certain domain names such as "yourcompanyname.eu" and "yourcompanyname.be." The emails often give you a short timeline in which to respond and advise that if you do not respond you risk losing the name forever.

In fact, these services are most often scams intended to scare companies into purchasing the domain names that "John Doe" is purportedly interested in purchasing. While there may be some value in companies purchasing domain names related to their trademarks, they should not feel as if they need to do so through the efforts of such purported rescuers.

If someone were to register a domain name similar to your company's trademarks so as to be confusingly similar, the correct procedure would be to file a complaint pursuant to ICANN's Uniform Domain Name Dispute Resolution Policy, or alternatively, to file a civil complaint in the relevant jurisdiction. Any offers to police domain names before they are registered should therefore be met with appropriate skepticism.

Thank you again for taking the time to read our newsletter. If there is

an issue or topic that you would like to see covered in a future IP Insight, please contact any GHP lawyer.

Email Marketing by

