

## Q&A With Early Sullivan's Devin McRae

*Law360, New York (September 19, 2011, 10:17 AM ET)* -- Devin A. McRae is a founding partner of Early Sullivan Wright Gizer & McRae LLP. His practice focuses on copyright and trademark infringement, and entertainment and employment disputes. He represents individual and institutional clients in entertainment and business disputes, and insurers and reinsurers in coverage, bad faith, and subrogation actions. His clients include producers, celebrities, a major television network and members of a foreign legislature.

Among other cases, he is presently defending American Broadcasting Companies Inc. and Endemol USA Inc. in a copyright action pertaining to the prime-time show "Wipeout," defending Fidelity National Financial Inc. against a discrimination and wrongful termination lawsuit and representing a South Pacific insurance company in a multimillion-dollar subrogation action against the American Samoa government.

### **Q: What is the most challenging case you have worked on and what made it challenging?**

A: An immigration appeal I handled pro bono before the Ninth Circuit Court of Appeals. I represented a Haitian-born individual ordered to return to Haiti based on a criminal conviction after decades as a permanent United States resident, service in the United States Army during the foreign conflict in Vietnam and raising two American-born adult sons (one who likewise has served in the United States armed forces).

The matter required me to quickly learn immigration law and procedure, and all applicable criminal law and procedure. The challenge presented was being responsible for a matter that would have a long-term impact on another person's future, while having very little background in criminal and immigration law. I am pleased to report that I obtained a reversal of the removal order. See *Desire v. Gonzales*, 245 Fed. Appx. 627 (9th Cir. 2007).

### **Q: What aspects of your practice area are in need of reform and why?**

A: A plaintiff must establish that its work and the defendant's work are "substantially similar" to prove copyright infringement in the Ninth Circuit. The "extrinsic test" is one of two tests used to establish this similarity. Under this test, the courts conduct an "analytic dissection" and comparison of the works at hand to assess whether a defendant's work is so "substantially similar" to a plaintiff's work as to support a finding of illicit copying. In this extrinsic test, the courts take care to separate what is protectable in the plaintiff's work from what is not, and the nonprotected elements may not contribute to a finding of substantial similarity.

Examples of nonprotected elements are: the basic idea for a story; standard treatments that flow from that basic plot idea and/or stock elements in a particular genre; and acts, scenes, characters, themes or other elements borrowed from another author, from the public domain or which are otherwise not the plaintiff's "original expression." The so-called "inverse ratio rule" ostensibly lessens the level of proof required to show "substantial similarity" when the plaintiff can show that the defendant had a "high degree of access" to its work.

The Ninth Circuit could make it clearer (although this is the existing law) that the inverse ratio rule does not impact whether elements are (or may be) protected or nonprotected, and is relevant only to the amount of "similarity" in protected expression there must be to rise to the level of "substantial similarity." This would curtail spurious copyright claims that rest on inevitable access (for example, because the plaintiff's show was broadcast and the defendant saw it) and similarity in nonprotected content alone. Classes of content are deemed nonprotected because that content is said to rightfully belong to the public for anyone to use and not to be monopolized by any person.

**Q: What is an important case or issue relevant to your practice area and why?**

A: On March 8, 2011, the Ninth Circuit published its opinion in *Network Automation Inc. v. Advanced Systems Concepts Inc.*, 638 F.3d 1137 (9th Cir. 2011), which settled the question in this circuit whether bidding on a competitor's mark to trigger ad placement on the results page of a Web search engine is, in and of itself, an infringement of that mark. The court of appeals held that keyword advertising may in fact be a legitimate form of comparative and contextual advertising.

The court found no reason to believe on the "sparse record" before it that consumers would be deceived by the mere presence of keyword ads. This led to the reversal of a preliminary injunction forbidding a party from buying keyword advertising to be displayed when Internet users entered the trademark of its competitor.

The *Network Automation* decision established four factors that are "most relevant" for determining whether consumers would likely be confused in the keyword advertising context: (1) the strength of the mark; (2) the evidence of actual confusion; (3) the type of goods and degree of care likely to be exercised; and (4) the labeling and appearance of the advertisements and the surrounding context on the screen displaying the results page. I was defending a broadcast network against Lanham Act and unfair competition claims when the *Network Automation* decision was published.

The claims alleged that my client had infringed three of the plaintiff's trademarks by using them as search engine keywords (amongst thousands of other keywords) to trigger clearly labeled ads for the premiere of its new show. The decision was published three days prior to the plaintiff's "consumer confusion" expert deposition.

At the time of the deposition, neither the plaintiff nor its "consumer confusion" expert seemed to be aware of the *Network Automation* case or the newly established four "most relevant" factors. When I examined the expert at his deposition, he gave away three of the four factors (stating he had no opinion on them) and admitted he was speculating on the fourth factor because the plaintiff or its lawyers had failed to commission a consumer confusion survey. I had prepared a draft summary judgment motion on those claims, and never had to use it because the plaintiff soon voluntarily dismissed the claims based on its lack of proof under the new test.

**Q: Outside your own firm, name an attorney in your field who has impressed you and explain why.**

A: I've worked with many lawyers with impressive attributes, including Dean Hansell (Dewey & LeBoeuf) and his effective negotiation style, which is seemingly nonconfrontational and delivered with the most pleasant tone but highly aggressive in position; Jack Hursh (Dorsey & Whitney) and his practical, cost-effective approach to litigation, and his conversational, clear and concise oral argument style; and Patty Glaser (Glaser Weil) and her intense, commanding interpersonal presence.

**Q: What is a mistake you made early in your career and what did you learn from it?**

A: Being drawn into unproductive, costly discovery disputes with the opposing side. To circumvent this, I counsel my clients to avoid taking untenable positions in discovery, and I eliminate needless posturing in the "meet and confer" process and keep the letter-writing to a minimum.

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