

## Roger L. Zissu



### Practice Description

Litigation for plaintiffs and defendants and counseling on broad spectrum of copyright, unfair competition and trademark issues relating to ownership and infringement of: literary and graphic characters; motion pictures; fiction and non-fiction literary works; television programming; scientific, instructional and educational testing materials; music; artworks and trademarks and trademark concurrent use agreements. Preparation and negotiation of contracts and licensing in all areas, including mergers and acquisitions, author/publisher agreements for books, commissioned artworks and purchase/sale of works of art.

### Education

Dartmouth College (A.B., summa cum laude, 1960, Phi Beta Kappa); University of Paris, Sorbonne and Institut d'Etudes Politiques, Paris, France, 1958-1959; Harvard Law School (LL.B., cum laude, 1963). Member, Harvard Legal Aid Bureau, 1961-1963.

### Professional Activities

Member: The Copyright Society of the U.S.A. (President, 1992-1994; Trustee, 1981, 1983-1986, 1988; Treasurer, 1988-1989; Vice President, 1990-1992); The Association of the Bar of the City of New York (Chairman, Committee on Copyright and Literary Property, 1989-1992; Member, 1970-1973 and 1986-1992; Committee on the Judiciary, 1995-1998, 2003); New York State and American (Member: Section of Patent, Trademark and Copyright Law; Committee on Authors, 1968-1971 and 1985-1989; Forum Committee on the Entertainment and Sports Industries, 1985; Chairman, Subcommittee on Individual Rights Arising Out of Joint Authorship, 1988-1989) Bar Associations; Federal Bar Council; Volunteer Lawyers for the Arts (Board Member, 1987-1990); Law Clerk to Hon. John F. Dooling, Jr., U.S. District Judge, Eastern District of New York, 1963-1965.

### Honors

Recipient in 2013 of Twelfth Annual American Inns of Court Professionalism Award in the Second Circuit. Listings in Best Lawyers in America® (25th consecutive year, including the 24th Edition of The Best Lawyers in America® in both the Copyright Law, and Litigation – Intellectual Property categories); Chambers USA 2017; New York Metro Super Lawyers® 2017, and Top 100 in 2012, 2007; The Legal 500 U.S., World Trademarks Review 1000 (Gold); Managing Intellectual Property magazine; Who's Who Legal, Who's Who in American Law; Who's Who Legal Trademarks; and various other Who's Who publications.

### Admissions

State of New York, 1963  
 U.S. District Courts for the Southern and Eastern Districts of New York, 1965  
 U.S. Court of Appeals for Second Circuit, 1965  
 U.S. Court of Appeals for Ninth Circuit, 1999  
 U.S. Tax Court, 1972  
 United States Supreme Court, 1974  
 U.S. District Court for Northern District of New York, 1989

### Selected Cases

#### [DC Comics v. Towle](#)

802 F.3d 1012 (9th Cir. 2015), cert. denied, 136 S.Ct. 1390 (2016)

On behalf of client DC Comics, the Firm prevailed in a decision by the U.S. Court of Appeals for the Ninth Circuit holding that the Batmobile, Batman's famous car, was subject to copyright protection as a character. In reaching its decision, the Court set forth a new, three-part test for determining protection of a character appearing in comic books, television programs or films under the 1976 Copyright Act, independent of any specific work in which it has appeared and irrespective of whether it "lacks sentient attributes and does not speak." Upon finding that the Batmobile met all of the necessary criteria, the Court then held that DC had the right to bring suit because it had reserved all merchandising rights when it granted licenses for the creation of the 1966 Batman television series starring Adam West and the 1989 Batman film starring Michael Keaton. In the alternative, because the 1966 program and 1989 film were derivative works of the original Batman comics, any infringement of those derivative works also gave rise to a claim for DC, the copyright owner of the underlying works. Finally, the Court found that the replica Batmobiles created by mechanic Mark Towle infringed DC's in the Batmobile as it appeared in the 1966 program and 1989 film. The Court also upheld the District Court's refusal to allow Towle to assert a laches defense on DC's trademark claims because the infringement was found to be willful. The U.S. Supreme Court denied Towle's petition for certiorari on March 7, 2016.

#### [Institute for the Development of Earth Awareness v. People for the Ethical Treatment of Animals](#)

768 F. Supp. 2d 672 (S.D.N.Y. 2011)

The firm obtained summary judgment in favor of client, People for the Ethical Treatment of Animals ("PETA"), dismissing copyright infringement claim brought against PETA in the U.S. District Court for the Southern District of New York on basis of alleged use in PETA animal rights campaign of historical facts and not-new idea of comparing mistreatment of slaves in 19th century America to mistreatment of animals today.

[Missing Cougar Co. v. Edgar Rice Burroughs, Inc.](#)

Opp. No. 91189827, 2010 WL 325956 (T.T.A.B. Jan 21, 2010) (summary judgment); 2010 WL 1619443 (T.T.A.B. Apr. 7, 2010) (reconsideration)

We successfully represented Edgar Rice Burroughs, Inc. (ERB)--successor to the famous author of the Tarzan and John Carter of Mars stories--in overcoming an opposition to its application to register the mark JOHN CARTER OF MARS for a variety of toys and games.

[Superman Copyright Termination Litigation](#)

[view case history](#)

The firm was part of the defense team for clients Time Warner Inc., Warner Communications, Inc., Warner Bros. Entertainment Inc., Warner Bros. Television Production Inc. and DC Comics in the ongoing litigation in the U.S. District Court for the Central District of California over the copyright termination interest in certain works featuring the Superman and Superboy characters allegedly owned by the heirs of co-creator, Jerry Siegel. The decisions in which the firm was involved resulted in a number of significant decisions in the complex area of copyright termination and in other areas, relating to, inter alia, defenses to termination claims of work made for hire, co-ownership, derivative work exception, limitation of copyright termination recapture to U.S. rights under copyright and inapplicability of copyright termination to trademark rights; res judicata; jury trial right, and the fair market value of copyright rights in the entertainment arena, among others. Summaries of decisions and links can be found by clicking through "view case history" above.

[Polar Bear Productions, Inc. v. Timex Corp.](#)

No. 05-35811, 2007 WL 2193541 (9th Cir. July 31, 2007); 384 F.3d 700 (9th Cir. 2004)

The firm successfully concluded its representation of Timex Corporation in its defense against copyright and trademark infringement claims brought against it by Polar Bear Productions, Inc. In 2002, when our firm first became involved in the case, Polar Bear had been awarded a \$2.415 million jury verdict for Timex's copyright infringement of a kayaking video entitled "PaddleQuest." We took over the appeal, and, in 2004, the Ninth Circuit vacated the entire \$2.1 million award under Section 504(b) of the Copyright Act of Timex's profits allegedly attributable to the copyright infringement as unduly speculative and cut the damage award from \$315,000 to \$115,000 on the same grounds. The case was then remanded to the district court on Polar Bear's remaining trademark claims. Upon Timex's motion, the court dismissed all of Polar Bear's remaining trademark claims, and Polar Bear appealed the dismissal of its claims to the Ninth Circuit. The Ninth Circuit, in an unpublished opinion dated July 21, 2007, affirmed final dismissal of the case.

[Video-Cinema-Films, Inc. v. The Lloyd E. Rigler-Lawrence E. Deutsch Foundation](#)

No. 04 CV 5332 (S.D.N.Y., Oct. 6, 2006)

We were brought in after the liability phase to represent the defendant in a rare jury trial on statutory damages for copyright infringement. Before we became involved in the case, our client, a nonprofit charitable foundation, was found liable for copyright infringement based on the defendant's use in its Classic Arts Showcase television programming of a short clip from the 1947 movie Carnegie Hall. The plaintiff sought a finding of willful infringement, which would have permitted an award up to \$150,000.00. But we persuaded the jury that our client did not act willfully, and the jury awarded only \$6,700.00 to the plaintiff. This judgment was cut in half by an award of costs to our client because the judgment did not exceed the Rule 68 Offer of Judgment made on our client's behalf immediately upon our entering the case.

[Milne v. Stephen Slesinger, Inc.](#)

430 F.3d 1036 (9th Cir. 2005), cert. denied, 126 S. Ct. 2969 (2006)

In the first judicial treatment of the new termination right enacted in the U.S. Copyright Term Extension Act of 1998, 17 U.S.C. § 304 (d), the U.S. Court of Appeals for the Ninth Circuit affirmed the District Court's decision rejecting an attempt by Disney and Clare Milne to cut off client Stephen Slesinger, Inc.'s right to receive royalties relating to Winnie the Pooh. The court held that Milne could not terminate a 1930 grant where the parties in 1983 had mutually revoked that grant and substituted a new one that was not subject to termination for significantly increased compensation to the author's heirs. The firm also represented Slesinger in successfully opposing Milne's Petition for a Writ of Certiorari filed in the U.S. Supreme Court. In February 2007, on the same theory we also successfully obtained a dismissal for Slesinger of an attempted termination action brought by the granddaughter of the illustrator of the Pooh works.

[Hogarth v. Edgar Rice Burroughs, Inc.](#)

342 F.3d 149 (2d. Cir. 2003), cert denied, 72 U.S.L.W. 3465, 3589, 3598 (2004)

The U.S. Court of Appeals for the Second Circuit affirmed the trial decision in favor of Edgar Rice Burroughs, Inc., owner of all existing rights in the Tarzan character, that two Tarzan books published in 1972 and 1976 illustrated by artist Burne Hogarth were works for hire owned by Burroughs, notwithstanding erroneous registrations stating that Hogarth was the author of the works. Hogarth's estate also unsuccessfully claimed that Edgar Rice Burroughs had licensed the use of the Hogarth illustrations from the books to Disney for its 1999 animated movie "Tarzan."

[American First Run Studios v. Edgar Rice Burroughs, Inc.](#)

No. B153518, 2003 WL 1861585 (Cal. App. 2d Dist. Apr 11, 2003)

We successfully defended an appeal in the California Court of Appeal of Edgar Rice Burroughs, Inc.'s lower court victory dismissing the claims of American First Run Studios. American First Run had claimed that Disney's 1994 animated "Tarzan" movie under license from Edgar Rice Burroughs "the owner of all rights in the Tarzan character" was copied from and substantially similar to American First Run's earlier authorized live-action Tarzan television programs, even though the only similarities were the common presence of the pre-existing appearance of Edgar Rice Burroughs's Tarzan character.

[Times Mirror Magazines, Inc. v. Field & Stream Licenses Company](#)

103 F. Supp. 2d 711 (SDNY 2000), aff'd, 294 F.3d 383 (2d. Cir. 2002)

Plaintiff owned the trademark Field & Stream for publications, and defendant owned the Field & Stream trademark for clothing and other products. The parties had co-existed for decades and had more recently entered into concurrent use and settlement agreements specifying the products reserved to each. We won summary judgment dismissing plaintiff's trademark infringement claims seeking to invalidate the concurrent use agreements based on allegations of breach of contract and likelihood of public confusion. At a trial on defendant's counterclaim for breach of a covenant not to sue, we won a judgment of \$1.8 million which was affirmed by the U.S. Court of Appeals for the Second Circuit.

[Burroughs v. MGM](#)

98 Civ. 7448 (S.D.N.Y. 2000)

We represented the heirs of Edgar Rice Burroughs in the first case interpreting the 1976 Copyright Act's termination provisions. The decision required editing MGM's 1981 remake of its 1932 film Tarzan, The Ape Man, but then held that the edited version did not contravene the provision of a 1931 motion picture license requiring MGM to adhere to the original story in exercising the right granted to it to remake the original production of this film and did not violate the Burroughs' heirs' rights under the copyright laws' newly enacted provisions allowing copyright owners to terminate prior grants.

[Charles Atlas v. DC Comics](#)

112 F. Supp 2d. 330, 56 U.S. P.Q. 2d 1176 (S.D.N.Y. 2000)

We won summary judgment on First Amendment and other grounds dismissing plaintiff's U.S. Trademark Act claims of likelihood of confusing arising out of the parodic inclusion in DC Comics' "Flex Mentalo" comic books of a copy of the well known and often-mocked Charles Atlas "Hero of the Beach" body building course ad which did not have copyright protection.

[Lynch Jones & Ryan v. Standard & Poor's](#)

1998 N.Y. Misc., 47 U.S.P.Q. 2d 1759 (N.Y. Sup. Ct. 1998)

We established the continuing viability of protection against "hot news" misappropriation of time sensitive financial data and products under New York State law.

[Playboy Enterprises v. Dumas](#)

960 F. Supp. 710 (S.D.N.Y. 1997), aff'd, 159 F.3d 1347 (2d Cir. 1998)

In 7 year litigation successfully represented widow of artist Patrick Nagel who won ownership in trial and on appeal of more than half of 338 copyrights at issue for paintings reproduced in Playboy magazine in 1974-84 period. Artist's widow won ownership on the ground that the Playboy payment check endorsements for these works did not constitute valid work made for hire agreements or transfers of the artist's copyrights under the 1976 Copyright Act.

[National Basketball Association v. Motorola](#)

939 F. Supp. 1071 (S.D.N.Y. 1996), rev'd, 105 F.3d 841 (2d Cir. 1997)

We successfully tried the NBA's "hot news" misappropriation claim arising out of defendants' unauthorized transmissions on an AOL online site and via a Motorola hand-held beeper product (the "Sports Trax") of game statistics on a real-time basis, i.e., while the games are still in progress. We also served in an of counsel capacity to the NBA in the appeal in which the Second Circuit reversed the district court's ruling.

[EFS Marketing, Inc. v. Russ Berrie & Company, Inc. and Russell Berrie](#)

76 F.3d 487 (2d Cir. 1996)

We successfully represented the Russ Berrie defendants who were sued for violation of plaintiff's alleged "trade dress" rights in a line of troll

dolls based upon the original Dam troll doll for which copyright protection was lost in 1965 due to publication without copyright notice. The Second Circuit affirmed dismissal of all of plaintiff's trade dress claims and reversed and then also dismissed plaintiff's false advertising claim arising out of use of Russ Berrie's copyright notice on its new versions of the original troll dolls.

[Cordon Art B.V. v. Walker](#)

40 U.S.P.Q. 2d 1506 (S.D.Cal. 1996)

We successfully brought the first case under the Uruguay Round GATT amendments to the US Copyright Act to stop unauthorized copying of the works of Dutch artist, M.C. Escher, for which U.S. copyright protection had been restored.

[Dominic Murray v. British Broadcasting Corporation and BBC Lionheart Television Int'l](#)

81 F. 3d 287 (2nd Cir. 1996)

We represented the BBC in securing dismissal for forum non conveniens of an action for copyright infringement and unfair competition brought in US against the BBC by a British subject with respect to BBC television character "Mr. Blobby."

[The Novus Group, Inc. v. Dean Witter, Discover & Co.](#)

93 Civ. 1056A, U.S. District Court, E.D. Va., Alexandria Division (April 1994)

We successfully represented Discover Card defendants in a jury trial in the so-called "Rocket Docket" against claims for alleged trademark infringement and unfair competition. Plaintiff, a Washington, D.C. business consulting firm, claimed that defendants' adoption of the subsidiary mark "Novus" to identify merchant and ATM locations accepting the Discover Card caused "reverse confusion."

[Weissman v. Freeman](#)

868 F.2d 1313 (2d Cir.), cert. denied, 493 US 883 (1989)

We established the point that defendant's joint authorship with plaintiff of an underlying medical work did not entitle him to claim copyright co-ownership or fair use of the material newly added by plaintiff to derivative work based on the co-authored underlying work where the defendant had not participated in preparing the new material to update the original work.

[Harper & Row Publishers, Inc. v. Nation Enterprises, Inc.](#)

501 F.Supp. 848 (S.D.N.Y. 1986), aff'd 723 F.2d 195 (2d Cir. 1983), reversed and remanded, 471 US. 539 (1988)

The Nation magazine, without authorization, had copied portions of former President Gerald Ford's unpublished memoirs. In this landmark case involving the fair use doctrine, the U.S. Supreme Court's 1985 decision to reinstate the district court decision for the plaintiffs remains the seminal copyright fair use case under the 1976 Copyright Act. Roger Zissu won the case at trial, establishing that the unpublished status of a work narrows the scope of permissible fair use of a work and that a news reporting purpose alone does not justify excessive copying under the fair use doctrine.

[DC Comics, Inc. v. Filmation Associates, Inc.](#)

486 F. Supp. 1273 (S.D.N.Y. 1986)

This trial decision, involving DC Comics', "Plasticman" and "Aquaman" characters, has gone further than any other in upholding and broadening character protection under the U.S. Trademark Act by holding the ingredients of entertainment characters to function as symbols of origin that can be protected from unauthorized copying. After the jury awarded DC \$1.2 million, it accepted a remittitur lowering the damage award.

[Edgar Rice Burroughs, Inc. v. High Society Magazine](#)

7 Media L. Repr. 1862 (S.D.N.Y. 1981)

We represented the owner of "Tarzan" in enjoining pornographic photo essay purporting to show "Tarzan" and "Jane."

[Edgar Rice Burroughs, Inc. v. Video Marc Dorcel](#)

Working with French counsel, we successfully represented Edgar Rice Burroughs, Inc. in reaffirming its continuing copyright rights in the original 1912 Tarzan story "Tarzan of the Apes" TARZAN character in Berne member countries and in obtaining a permanent injunction and substantial damages in a copyright infringement action against an unauthorized video based on the TARZAN character. Favorable decisions were obtained in the Tribunal de Grande Instance and Cour D'Appel.

#### **Published Works**

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**Funny is Fair: The Case for According Increased Value to Humor in Copyright Fair Use Analysis**Benjamin Kaplan Et Al., An Unhurried View of Copyright Republished/and with Contributions from Friends, 2005 LexisNexis Matthew Bender, republished in Journal of the Copyright Society of the U.S.A., Winter-Spring 2008, Vol. 55, Nos. 2-3

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**Copyright Luncheon Circle: The Interplay of Copyright and Trademark Law in the Protection of Character Rights With Observations on Dastar v. Twentieth Century Fox Film Corp.**Journal of the Copyright Society of the U.S.A., Winter 2004

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**Protection for Facts and Data Bases in the New World Order**

**The Past Revisited, The Copyright Act of 1976 at Mid Decade: An Overview with Observations**