



VIA FEDEX ENVELOPE

August 3, 2005

Ms. Jennifer Granick
Center for Internet and Society Cyberlaw Clinic
Crown Quadrangle
559 Nathan Abbott Way
Stanford, CA 94305-8610

Dear Ms. Granick:

This is in response to your July 22, 2005 letter, in which you allege that FedEx improperly invoked the Digital Millennium Copyright Act ("DMCA"). Mr. Brown is currently out of the office so I am responding. Our position remains that Mr. Avila's website infringes both the copyright and trademark rights of FedEx. As a result, Mr. Avila is exposed to numerous claims, including some governed by the DMCA.

As to trademark infringement, in addition to using the FedEx mark to identify its services, FedEx has affixed its mark to clothing. It owns U.S. Trademark Registration No. 2192176 in Class 25, specifically in respect to shirts. Use by Mr. Avila of an identical mark and trade dress in connection with "fedexfurniture.com" was and is likely to create confusion as to the source, sponsorship, and affiliation of Mr. Avila's goods or services. We understand he is still attempting to produce business cards and t-shirts displaying the FedEx mark, indicating he is continuing his attempts to commercially exploit the mark.

The term "fedexfurniture" used on a t-shirt with the FedEx logo would likely confuse the public into believing that FedEx may have expanded its business, or had authorized use of its mark on the shirts or on furniture. Use on a business card further indicates Mr. Avila's commercial use. International Kennel Club, Inc. v. Mightly Star, Inc., 846 F.2d 1079, 1089 (7th Cir. 1988) (if it is found to be logical for consumers to believe that use of a well-known logo implies sponsorship or affiliation, then infringement has occurred, regardless of whether the goods or services are competitive); and Scarves by Vera, Inc. v. Todo Imports, Ltd., 544 F.2d 1167, 1173 (2d Cir. 1976) (trademark owner's right to relief exists when the mark is strong, the junior mark is similar, and it is likely that the senior owner will use its mark on goods similar to the junior user's).

In this case, FedEx has and does use its mark on directly competitive goods. Moreover, use of the fedexfurniture.com url is likely to result in initial interest confusion, at least, which is actionable infringement. The url is registered as a .com, which is the commercial level domain, as opposed to a .net, further indicating Mr. Avil's commercial exploitation of "FedEx". Mr. Avila's use of the mark in all these ways is likely to result not only in confusion, but is likely to dilute, through tarnishment and/or blurring, the FedEx mark.

Your earlier claims of parody appear to have no merit as Mr. Avila's screen shots that we have seen do not mention any social or other commentary regarding FedEx. In fact, his site appears to be a blatant attempt to make money because he asked viewers of the site to send him money and also included a reference to PayPal. His screens did not discuss the nature of FedEx at all as suggested in your earlier letter. The only attempted effort at explaining this site as a parody is in your July 19, letter. Further, use of the mark on t-shirts may not be defended through a parody defense. Harley-Davidson, Inc. v. Ronald Grottanelli, 164 F. 3d 806 (2nd Cir. 1999) (use of a mark simply to promote one's own products and services, even if believed to be somewhat humorous, is not a permitted trademark parody).

The copyright issues are very straight forward based on a simple reading of the copyright statutes. FedEx owns copyright in its packaging. Additionally, it has obtained registrations for those rights. Copies of some of its relevant copyright registrations are enclosed for your reference. The packages reproduced by Mr. Avila also bear FedEx's copyright registration notice, providing Mr. Avila with actual notice of FedEx's rights in its packaging, suggesting that Mr. Avila may have even willfully infringed those rights.

As owner of the copyright in its packaging materials, FedEx has the exclusive right under Section 106 of the Copyright Act to create derivative works, to distribute copies to the public by sale or other transfer of ownership or by rental, lease or lending, and to publicly display its copyrighted works. 17 U.S.C. § 106. Pursuant to Section 113 of the Copyright Act, the exclusive right to reproduce a copyrighted pictorial, graphic, or structural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or not. 17 U.S.C. § 113.

In constructing useful articles on which the pictorial work is displayed, Mr. Avila created a derivative work without permission of FedEx. 17 U.S.C. § 105(a). Since the pre-existing work that serves as the basis for a derivative work is itself protected by copyright, its unauthorized incorporation into a derivative work constitutes copyright infringement. Mattel, Inc. v. Robarb's, Inc., 139 F. Supp. 2d 487, 497 (S.D.N.Y. 2001) (defendant's use of Mattel's registered packaging without permission constituted the production of an infringing derivative work). The consent of the copyright owner of the pre-existing work is necessary in order to render the derivative or collective work non-infringing. Id. One who reproduces a derivative work without the authorization of the pre-existing work's owner violates the exclusive rights of the copyright owner. Id.; 17 U.S.C. § 501(a).

Further, by disseminating copies of FedEx's copyrighted works and of Mr. Avila's unauthorized derivative works over the Internet, Mr. Avila distributed and displayed copies of the copyrighted work without authorization from FedEx. This constitutes infringement of FedEx's exclusive rights. Ford Motor Co. v. B&H Supply, Inc., 646 F. Supp. 975, 989 (U.S. Dist. Minn. 1986) (defendants infringed upon Ford's exclusive right of distribution by distributing products in infringing packaging). FedEx did not transfer copyright ownership to Mr. Avila simply by sending him packaging materials bearing the copyrighted material. Mr. Avila's online distribution of these copies is a violation of FedEx's Section 106 distribution rights.

Finally, by posting photographs of works derived from FedEx packaging materials as well as lists of materials required, Mr. Avila is inducing, causing or materially contributing to the infringing conduct of others, and could be held liable as a contributory infringer. Gershwin Publishing Corp. v. Columbia Artists Management, Inc., 443 F.2d 1159, 1162 (2d Cir. 1971) (sponsor of performances of works without permission from the copyright owners found liable for contributory infringement based on knowing participation in the infringement).

For all of the foregoing reasons, it is clear that FedEx in no way improperly invoked the DMCA, as it has a number of actionable claims.

In addition, Mr. Avila did not obtain the packaging "lawfully" as you represent in your letter. Mr. Avila ordered the packaging online via fedex.com. Before doing so he was required to agree to the fedex.com terms of use. These terms provide as follows: "fedex.com is provided solely for the use of current and potential FedEx customers to interact with FedEx and may not be used by any other person or entity, or for any other purpose." (emphasis added). Mr. Avila breached this contract by using fedex.com in a manner not permitted under the terms and conditions and is encouraging others to do likewise. Moreover, he ordered the packaging on a screen referring to "shipping supplies", thereby representing that he was ordering packaging for shipping, not for some other purpose.

Finally, this matter has never been about social commentary as urged by you in your July 19 letter, or about a large corporation pursuing any individual, which is typically alleged by individuals when involved in infringing activity such as this. FedEx, like Stanford, is simply made up of people who come to work everyday to support themselves and their families. Their job responsibilities include, among other things, serving their customers, protecting the company's or organization's property, and respecting the rights of others. FedEx suspects Mr. Avila likewise attempts to protect the rights he holds in his personal property, and we hope he will respect the rights of others.

In light of all these reasons, we would appreciate you removing the inaccurate posting located at <http://cyberlaw.stanford.edu/> as shown below and advising Mr. Avila to govern his actions accordingly.

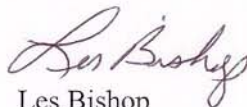
FedExFurniture Back Online

Over two weeks ago, FedEx improperly used the DMCA notice and takedown provisions to get the website at www.fedexfurniture.com taken offline. The company claimed trademark infringement and conversion, neither of which allows it to take advantage of the powerful remedy provided under the DMCA. Neither claim is valid, as the site only uses the word FedEx to describe the appearance of the boxes, and the company gives the boxes away for free without contractual limitations or restrictions. So our client has now put the site back up and continues to display his resourceful use of objects that companies give away for free.

Thank you.

Very truly yours,

FEDEX CORPORATION



Les Bishop
Lead Counsel
(901) 434-8506
FAX: 434-9268

LAB/nln

569287

CERTIFICATE OF REGISTRATION

39-38

FORM TX

UNITED STATES COPYRIGHT OFFICE



This Certificate issued under the seal of the Copyright Office in accordance with title 17, United States Code, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

JAN 20 1990
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Marybeth Peters
REGISTER OF COPYRIGHTS
United States of America

REGISTRATION NUMBER

TX 3-934-031



EFFECTIVE DATE OF REGISTRATION

NOV 15 1994
Month Day Year

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

TITLE OF THIS WORK

1 New FedEx Letter

PREVIOUS OR ALTERNATIVE TITLES

PUBLICATION AS A CONTRIBUTION If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared. Title of Collective Work

If published in a periodical or serial give: Volume Number Issue Date On Pages

NAME OF AUTHOR

2 a Federal Express Corporation

DATES OF BIRTH AND DEATH
Year Born Year Died

Was this contribution to the work a "work made for hire"?
 Yes
 No

AUTHOR'S NATIONALITY OR DOMICILE
Name of Country
OR { Citizen of United States
Domiciled in United States

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK
Anonymous? Yes No
Pseudonymous? Yes No
If the answer to either of these questions is "Yes," see detailed instructions.

NATURE OF AUTHORSHIP Briefly describe nature of the material created by this author in which copyright is claimed.

Author of entire work

NAME OF AUTHOR

DATES OF BIRTH AND DEATH
Year Born Year Died

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 No

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Name of Country
OR { Citizen of
Domiciled in

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NATURE OF AUTHORSHIP Briefly describe nature of the material created by this author in which copyright is claimed.

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DATE AND NATION OF FIRST PUBLICATION OF THIS PARTICULAR WORK Complete this information ONLY if this work has been published.
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United States Nation

4 **COPYRIGHT CLAIMANT(S)** Name and address must be given even if the claimant is the same as the author given in space 2.

Federal Express Corporation
1980 Nonconnah Blvd.
Memphis, TN 38132

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APPLICATION RECEIVED NOV 15 1994
ONE DEPOSIT RECEIVED
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NOTE

Under the law, the "author" of a "work made for hire" is generally the employer, not the employee.

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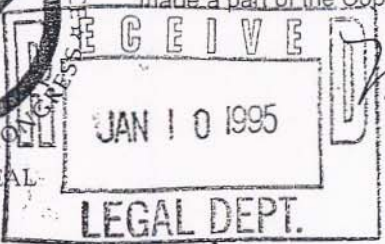
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TITLE OF THIS WORK

New FedEx Pak

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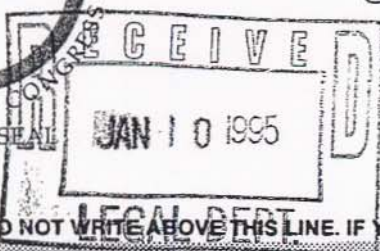
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NAME OF AUTHOR ▼

Federal Express Corporation

DATES OF BIRTH AND DEATH
Year Born ▼ Year Died ▼

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 Yes
 No

AUTHOR'S NATIONALITY OR DOMICILE
Name of Country
OR { Citizen of _____
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Anonymous? Yes No
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Author of entire work

NAME OF AUTHOR ▼

DATES OF BIRTH AND DEATH
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United States
Nation

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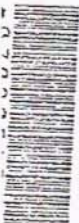
Federal Express Corporation
1980 Nonconnah Blvd.
Memphis, TN 38132

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NOV 15 1994
REMITTANCE NUMBER AND DATE

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NOTE

Under the law the "author" of a "work made for hire" is generally the employer



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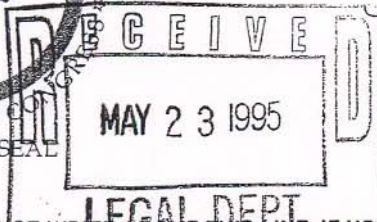
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New FedEx Tube

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Author of entire work

NAME OF AUTHOR ▼

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NOTE

Under the law the "author" of a work made for hire is the employer or other person or organization for whom the work was prepared.

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