

THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



A ROSE BY ANY OTHER NAME: HOW AN ILLUSIONIST USED COPYRIGHT LAW AS A PATENT

SYDNEY BECKMAN

ABSTRACT

Teller is a famous illusionist who, in recent years, has been performing a stage act with Penn Jillete in Las Vegas, Nevada. Teller's signature trick, known as "Shadows," was copied by a magician in Belgium who offered to sell the method. The Belgian's trick, titled "The Rose and Her Shadow," was virtually identical to Teller's illusion. *That which we call a rose by any other name . . .* Teller wanted the Belgian magician to stop offering the trick for sale. After an unsuccessful attempt to negotiate, Teller took his dispute to federal court. His goal? To protect that which cannot be protected — at least not by Copyright law — the secret behind his trick. This paper discusses how a court used Copyright law to do just what Teller sought: To protect the secret behind a copyright protected magic trick.

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Cite as Sydney Beckman, *A Rose by Any Other Name: How an Illusionist Used Copyright Law as a Patent*, 14 J. MARSHALL REV. INTELL. PROP. L. 357 (2015).

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LAW AS A PATENT

SYDNEY BECKMAN

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A ROSE BY ANY OTHER NAME: HOW AN ILLUSIONIST USED COPYRIGHT LAW AS A PATENT

SYDNEY BECKMAN*

*'Tis but thy name that is my enemy;
Thou art thyself, though not a Montague. What's Montague?
it is nor hand, nor foot, Nor arm, nor face, nor any other part
Belonging to a man. O, be some other name!
What's in a name? that which we call a rose
By any other name would smell as sweet...*

*William Shakespeare
Romeo and Juliet (Circa 1600)*

I. PREFACE

A single red rose gently rests in a vase that sits upon a tall thin pedestal. In front of the vase a narrow cone of light drapes over the rose casting the flower's shadow upon a page of white supported by an easel. A menacing figure slowly approaches wielding a sharp knife. But it is not the bloom he approaches — it is the shadow of the rose. Slowly, methodically, the figure cuts a small shadowy branch supporting leaves from the stem. Although the evildoer is nowhere near the actual rose, the real branch falls from the real rose. Another cut made into the shadows, another real branch falls. Then, as though the slow methodical torture of the delicate flower has not been enough, the figure slowly inserts the knife into the middle of the shadow of the rose itself. One by one each petal of the real rose breaks free from its home and flutters to the ground. Finally, with the last twist of the blade, the sole remaining petal is dislodged from its safety and left to fall to the floor. The illusion is known as “Shadows.”¹ And the menacing figure — Teller from the famous duo Penn and Teller.² “Shadows” has been one of Teller's primary illusions for many years.

* © Sydney Beckman 2015. Professor of Law, Lincoln Memorial University Duncan School of Law. The author would like to thank everyone at The John Marshall Law School Review of Intellectual Property Law and especially Amy Taylor and her hard work on the symposium. I would also like to thank Associate Dean Gordon Russell of the Lincoln Memorial University Duncan School of Law for his assistance in cite checking, Blue booking and research and Ann Long for her assistance in finding the impossible resources and making them “magically” appear on my desk. Last, but certainly not least, a special thanks to my wife and best friend Allyson for her unending support in my writing and my love of magic.

¹ A short video showing portions of the trick “Shadows” performed by Teller may be viewed at: <http://youtu.be/etuVHEHF3FM> (Website last visited 6/9/14).

² Marco R. della Cava, *At home: Teller's magical Vegas retreat speaks volumes* USA TODAY (Nov. 16, 2007, 3:27 PM) (http://usatoday30.usatoday.com/life/lifestyle/home/2007-11-15-teller-at-home_N.htm) (reporting that Teller has no last name. He had it legally changed from Raymond Joseph Teller to “Teller.”).

In 2012, another magician copied the illusion,³ posted a video of its performance on YouTube, and offered it for sale.⁴ Years earlier, in 1983, Teller had copyrighted the trick.⁵ As a result of having a registered copyright, Teller demanded the magician stop selling the trick.⁶

Can a magic trick be protected? Is it subject to Copyright protection? So begins the tale of Teller and the case of the Belgian Conjurer.⁷ And, more to the point, the story illustrates how the law of Copyright was used as a Patent to protect the secret behind how “Shadows” is accomplished.

II. INTRODUCTION

For some, magic is a hobby, for others it is a trade consisting of manufacturing, publishing or creating, and for others it is a profession exercised by entertainers. While some magicians purchase tricks and illusions that are performed, others create their own tricks. Teller is one of those magicians who performs magic for a living and creates many of his own tricks. Because Teller makes his living performing magic, the methods behind his illusions are often closely guarded secrets. As magician Harlan Tarbell explained:

Because of the nature of the magician’s work, secrecy is important. The magician depends upon mystery which in turn depends upon secrecy. Magic is interesting just as long as an audience can be puzzled. The ability to make something happen that others know cannot happen, is necessary to the successful magician. The old time magician guarded his mysteries with reverence and awe.⁸

The value of magic as a performance art lies in its mystery. “Ashton Stevens, noted dramatic critic once said, ‘I was the most disappointed man in the world when . . . I discovered how one of the tricks was performed. I would rather believe that magicians perform miracles.’”⁹ As Mark Wilson wrote, “NEVER explain how a trick is done. If the audience knows the secret, then the mystery, the glamor, and the entertainment of the magic are lost.”¹⁰

This paper will first define magic with a brief discussion of the various “types” of magic in terms of venues in which the magic is performed. Next, the paper will

³ As used in this paper, the terms “magic trick,” “trick,” and “illusion” are used interchangeably.

⁴ See *generally* Complaint at ¶ 25, Apr. 11, 2012, Teller v. Dogge, No. 2:12-cv-00591 Document 4 – 1 (stating that Teller became aware of the Dogge video as well as Dogge’s solicitation of money in exchange for the trick’s secret) [hereinafter “Complaint”].

⁵ This statement is made in quite the broadest sense. As this paper explains, the method behind the trick is not subject to copyright protection. What Teller had done, and as will be explained in detail, was copyright the performance.

⁶ See *generally* Complaint at ¶ 26.

⁷ As used in this paper, the terms “conjurer,” “magician,” and “illusionist” are used interchangeably.

⁸ HARLAN TARBELL, *THE TARBELL COURSE IN MAGIC XIX* (Ralph W. Read ed., D. Robbins & Co., 1999).

⁹ *Id.*

¹⁰ MARK WILSON, *THE MARK WILSON COURSE IN MAGIC*, 7 (Mark Wilson, 1929) (1988) (emphasis in original).

examine Teller's signature illusion "Shadows" by breaking it down into its parts and describing the parts that are, and are not, subject to legal protection. Third, the article discusses the law of Copyright as it relates to the parts of a magic trick. Next, the paper discusses how a Belgian magician copied and filmed himself performing a version of "Shadows" that he titled "The Rose and Her Shadow" and offered it for sale. Fifth, the paper will break down the relevant parts of the lawsuit filed by Teller against the Belgian magician in terms of the copyright infringement aspects and how they relate to Teller's trick. This discussion is followed by an examination of how the lawsuit effectively used the registration of a copyright to protect a method that, under the law, can only be protected by a patent. This is followed by an analysis of the court's decision and concludes with the author's comments on how this could affect similarly situated illusions in the future.

III. DEFINING MAGIC

"The musician is not a person who just plays pieces of music. He first must be trained in the scales, the combining of notes to make harmony, proper timing; the mathematics and history of music."¹¹ A musician may play one or more types of instrument such as guitar, violin, piano, or trombone. "Fundamentally, the making of a magician is no different . . ."¹² A magician must learn the apparatus, "must be trained in the mechanics, the alternate methods and be skilled in the presentation in order to meet any conditions that may arise."¹³ And just as a musician has a choice of many instruments, there are many forms of magic such as "close-up," "platform," and "stage" magic.¹⁴

A. Types of Magic

Within the realm of magic, there are a number of types or kinds of performances; many of which may be protected by the laws of Copyright. While the references to "close-up," "platform," and "stage" magic refer to the venue in which the performance will take place, with regard to each venue, there are different types of magic that may be performed in that particular venue. As mentioned, one of the venues for magic is "close-up." Often times, close-up magic may involve the use of magic props such as cups, cards, or coins. For example, one of the oldest known tricks in magic is known as the cups and balls.¹⁵ Although there are many variations of the trick, generally

¹¹ HARLAN TARBELL, THE TARBELL COURSE IN MAGIC XIII (Ralph W. Read ed., D. Robbins & Co., 1999).

¹² *Id.* at XIII.

¹³ *Id.*

¹⁴ See generally HARLAN TARBELL, THE TARBELL COURSE IN MAGIC XII (Ralph W. Read ed., D. Robbins & Co., 2003).

¹⁵ Wolfgang Decker, SPORTS AND GAMES OF ANCIENT EGYPT 123 – 24 (Allen Guttmann trans., Am. Univ. in Cairo Press, 1993) (suggesting that, although disputed, the first documented magic trick was a performance of the "cups and balls" by the magician Dedi in ancient Egypt in approximately 2700 Before the Common Era (BCE)) [hereinafter "Decker"].

with this trick, a magician displays a set of three cups and three balls that appear to be identical. The balls appear and disappear, move from cup to cup and ultimately join each other under one cup. The finale usually involves making something larger than the original balls appear under the cups. This trick is usually performed relatively close-up; it is not a trick meant for a large stage.¹⁶

Magicians generally design tricks and illusions mindful of the venue in which they will perform. Consider the illusion in which a magician places a person in a box, only to cut the box into three pieces with large, metal blades, separating the box. This trick is not designed for close quarters but rather for a stage. An effect that requires large props and a significant distance between the audience and the magic props would not be viable in a small venue. On the other hand, a trick using a regular deck of playing cards is generally not designed for a stage but rather for close quarters.¹⁷

B. Deconstructing an Illusion

By definition, an illusion is “something that looks or seems different from what it is; something that is false or not real but seems to be true or real.”¹⁸ Magicians present illusions to entertain. For purposes of this paper, the term “illusion” refers to something presented by a magician in the context of entertainment.

In this context, an illusion may consist of many parts such as: music; choreography; dance; props; and patter.¹⁹ Each of these parts, potentially, is subject to protection as intellectual property. In the United States, at the federal level three mechanisms exist for the protection of intellectual property: copyrights, trademarks, patents. Additionally, trade secrets serve to help protect certain forms of intellectual property although there is no federal statute formalizing this protection. Examining the parts of an illusion individually, it is easy to understand how particular forms of intellectual property may be subject to certain protections. For example, the musical score that accompanies an illusion may be protected by copyright law.²⁰ So too, the choreography of a performance may be subject to copyright protection.²¹

More challenging, however, are other parts that make-up an illusion. For example, consider the illusion of the magician “cutting” a person in half. For this illusion, a person is placed prone into a box and an object (such as a blade, saw or similar cutting device) is used to seemingly sever the person in half resulting in the illusion that the person has, in fact, been sliced into two pieces. Although audience members know that the illusion is not real, what may escape them is “how” the illusion

¹⁶ The use of technology has changed this somewhat in recent years. The use of a camera and a projector has enabled this illusion to be performed for much larger audiences. Nevertheless, even with such technology, the magic of the performance is somewhat lost in a larger venue.

¹⁷ There are, of course, exceptions to this statement as some fabulous magicians have performed on a large stage with only a handful of cards. Additionally, some card tricks are, in fact, designed for a large stage.

¹⁸ “Illusion”, MERRIAM WEBSTER ONLINE DICTIONARY, <http://www.merriam-webster.com/dictionary/illusion> (last visited Mar. 16, 2015).

¹⁹ THE NEW AMERICAN OXFORD DICTIONARY 1254 (1ST ed. 2001) (“rapid or smooth-flowing continuous talk, such as that used by a comedian or salesman”).

²⁰ COPYRIGHT ACT OF 1976, 17 U.S.C. § 102(a) (2012).

²¹ *Id.*

was accomplished. This “how,” or the method behind the magic trick, is composed of closely guarded secrets; such secrets have always been key to what some consider one of the world’s oldest forms of entertainment.²² The Copyright Act describes, in great detail, the forms of intellectual property it does and does not govern.²³ The secret behind how an effect is accomplished (i.e., the process performed which results in the appearance that the person was cut in half) is not subject to copyright protection. As a result, only patent protection and trade-secret protection could secure the method.

IV. “SHADOWS” LAID BARE

“Shadows” is an illusion that:

[E]ssentially consists of a spotlight trained on a bud vase containing a rose. The light falls in such a manner that the shadow of the real rose is projected onto a white screen positioned some distance behind it. Teller then enters the otherwise still scene with a large knife, and proceeds to use the knife to dramatically sever the leaves and petals of the rose’s shadow on the screen slowly, one-by-one, whereupon the corresponding leaves of the real rose sitting in the vase fall to the ground, breaking from the stem at exactly the point where Teller cut the shadow projected on the screen behind it.²⁴

Shadows is an integral part of Teller’s performance repertoire.²⁵ It has become “iconic . . . as the piece with the longest association with the Penn and Teller show, and to Teller himself . . . ‘Shadows’ is . . . a major part of the Show [sic] currently running at The Rio, and it has been used so extensively and exclusively by Teller that it has become his signature piece . . .”²⁶

²² See Decker, *supra* note 15.

²³ 17 U.S.C. § 102(a) (2012) (providing that “[c]opyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device). Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”

²⁴ Complaint at ¶ 15, Apr. 11, 2012, Teller v. Dogge, No. 2:12-cv-00591 Document 4 – 1.

²⁵ *Id.* at ¶ 17.

²⁶ *Id.* at ¶ 17.

A. The Parts of “Shadows”

To understand the controversy and, ultimately, the effect of Teller’s victory, it is necessary to break down the parts of Teller’s illusion. Parsing the description of ‘Shadows’ we can break down the parts of the illusion and determine what, if any, protections may be afforded by intellectual property laws. The illusion consists of the following:

1. The title

Teller calls his trick “Shadows.”²⁷ Titles are not subject to copyright protection and, in fact, are specifically excluded as a category subject to copyright protection.²⁸ A name can, under certain circumstances be protected by trademark²⁹ but such form of protection is not in issue here.³⁰ Mr. Dogge’s trick used a different name and, although similar, such was not a matter in controversy raised by Teller.

2. The staging

The trick “essentially consists of a spot light trained on a bud vase containing a rose. The light falls in such a manner that the shadow of the real rose is projected onto a white screen positioned some distance behind it.” Staging is not subject to copyright protection.³¹ Teller included a drawing of how the effect would be staged as part of his application for copyright protection.³²

3. The performance

Teller then enters the otherwise still scene with a large knife and proceeds to use the knife to dramatically sever the leaves and petals of the rose’s shadow on the screen slowly, one-by-one, . . . ”³³ This part, the performance, is critical for the purposes of copyright. Adding to the performance is Teller’s signature, characteristic silence. This performance is the part of the illusion that Teller has registered and protected by

²⁷ Certificate of Copyright Registration for *Shadows*, U.S. Copyright Reg. No. PAu 469609 (Jan. 6, 1983).

²⁸ 37 C.F.R. § 202.1 (1992); *see also* <http://www.copyright.gov/help/faq/faq-protect.html> (last visited Mar. 16, 2015).

²⁹ 15 U.S.C. § 1052 (2013).

³⁰ There was no reference in Teller’s Complaint to any controversy involving Dogge’s title “The Rose and Her Shadow.”

³¹ 17 U.S.C. § 102(a) (2012). Staging does not fall into any of the specified categories of Section 102(a) of the Copyright Act: literary works; musical works; dramatic works; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; nor architectural works.

³² Exhibit 1 for Plaintiff, Apr. 11, 2012, Teller v. Dogge, Case 2:12-cv-00591-JCM-GWF Document 5-1 [hereinafter “Exhibit 1 for Plaintiff”].

³³ *Id.*

Copyright.³⁴ The Copyright Act expressly permits the registration of “dramatic works” and “pantomimes.”³⁵ The application filed by Teller listed the performance as a “pantomime” and a “drama.”³⁶ In his complaint, however, Teller only references the application of his illusion as a “dramatic work.”³⁷ The distinction, for purposes of this particular suit, has no bearing on the premise of this paper as the validity of the copyright was not challenged by Dogge.³⁸

4. *The secret*

“[T]he corresponding leaves of the real rose sitting in the vase fall to the ground, breaking from the stem at exactly the point where Teller cut the shadow projected on the screen behind it.”³⁹ This is, and is not, the secret. That is, this portion of Teller’s copyright describes the effect and, in particular, the “magic” effect. What is missing is the how (the process — or the mechanics — or the gimmick) that makes the illusion happen. What is missing is the secret. Processes are not subject to copyright protection.⁴⁰

B. *Registration of “Shadows”*

It could be, that back in 1983, Teller had a premonition that he would need to protect his trick at some point in the future. Given the number of parts that make up “Shadows”, he might have been able to patent the methodology behind the illusion.⁴¹ Nevertheless, the only protection he sought was that of copyright.⁴² Teller’s copyright protects the “drama” or the “pantomime” or both.⁴³ There is no patter, no music, and

³⁴ *Id.*

³⁵ 17 U.S.C. § 102(a).

³⁶ Exhibit 1 for Plaintiff, *supra* note 32.

³⁷ Complaint at ¶ 15, Apr. 11, 2012, Teller v. Dogge, No. 2:12-cv-00591 Document 4 – 1 (explaining that Teller uses a knife to “dramatically sever the leaves and petals of the rose’s shadow . . .”).

³⁸ Although the validity of the copyright was not challenged by Defendant’s responsive pleadings, Dogge’s answer to Teller’s complaint made an allegation that Teller “clearly abandoned his copyrighted work.” Answer to Complaint at 5:13-17, Oct. 24, 2012, Case 2:12-cv-00591-JCM-GWF Document 39. This allegation was never tried nor addressed by the Court in its Order, Sept. 30, 2014, Teller v. Dogge Case 2:12-cv-00591-JCM-GWF Document 233.

³⁹ Complaint at ¶ 15.

⁴⁰ 17 U.S.C. § 102(b) (2012).

⁴¹ The question of whether Teller’s illusion “Shadows” would, or would not, have been eligible for patent protection is beyond the scope of this paper. There is no publicly available information that indicates whether or not Teller considered, or made any attempt to patent the effect. This paper addresses the ramifications of his choice in copyrighting part of the act and the effect such copyright had in lieu of formal patent protection.

⁴² Neither Teller’s complaint nor any other publicly available document specifically states that copyright is the only form of protection Teller secured. *See* Complaint, Apr. 4, 2012, Teller v. Dogge Case 2:12-cv-00591-JCM-GWF Document 4-1. Had Teller received patent protection then presumably he would have sued Dogge for patent infringement in addition to, or in lieu of, copyright infringement. He did not.

⁴³ *See* Exhibit 1 for Plaintiff, *supra* note 32.

no method mentioned in the copyright.⁴⁴ Was Teller truly concerned with the protection of his “pantomime,” was he distressed about the possibility someone would, one day, attempt to steal his dramatic work? No, “the point and purpose of Teller’s lawsuit [was]⁴⁵ aimed at preventing the sale and disclosure of the secret behind how “Shadows” is performed.”⁴⁶ Ultimately, that was the underlying point of the registration.

V. THE LAW

A. Protection of Intellectual Property

The Copyright Act has no express provision for the protection of magic and her secrets.⁴⁷ However, the Copyright Act does expressly protect certain elements, or parts, of an illusion. In the case of the illusion “Shadows,” Teller registered a copyright for the performance of the trick in the form of a pantomime or dramatic work in 1983.⁴⁸ Such registration is expressly permitted by the Copyright Act.⁴⁹ The Copyright Act permits the protection of the expression of the illusion.⁵⁰

B. A Patent versus Copyright as Applied to Magic

“Copyrights protect the expression of the idea, but do not protect the underlying concept.”⁵¹ The important distinction between the protections provided by copyright and those provided by patent — for purposes of this paper — is that “ideas, procedures, process[es], system[s] and method[s] of operation” which are specifically excluded as intellectual property, but which may be protected by copyright, are the very things that make up the ultimate illusion presented by a magician. With regard to “Shadows,” the lack of patent protection means that someone other than Teller could build the necessary props to perform “Shadows” but because of the copyright protection, could not perform the illusion in the way protected by the copyright.

Consider, for example, the illusion known as “Pepper’s Ghost.” In 2011, Ian O’Connell and James Rock were issued a patent to protect an apparatus and method (hereinafter “Pepper’s Ghost”) that accomplished the projection of images that appeared as ‘ghosts.’⁵² The official abstract reads, in part:

⁴⁴ *Id.*

⁴⁵ At the time of publication of Hagan and Samuels’ article, Teller’s lawsuit was not yet concluded.

⁴⁶ Jennifer Hagan & William Samuels, *Teller v. Dogge: When Two Magicians Duel Over the Secret to an Iconic Illusion, They Conjure a Copyright Infringement Lawsuit*, 38(1) NEW MATTER 14, 17(2014) [hereinafter “Hagan and Samuels”].

⁴⁷ *Id.* at 14.

⁴⁸ Certificate of Copyright Registration for *Shadows*, U.S. Copyright Reg. No. PAu 469-609 (Jan. 6, 1983).

⁴⁹ 17 U.S.C. § 102(a)(4) (2012).

⁵⁰ See Hagan and Samuels, *supra* note 46.

⁵¹ Sara J. Crasson, *The Limited Protections of Intellectual Property Law for the Variety Arts: Protecting Zacchini, Houdini, and Cirque Du Soleil*, 19 VILL. SPORTS & ENT. L.J. 73, 83 (2012).

⁵² U.S. Patent No. 7,883,212 (issued Feb. 8, 2011).

An image projection apparatus . . . [that] projects an image such that light forming the image impinges upon the screen such that a virtual image is created from light reflected from the screen, the virtual image appearing to be located behind the screen.⁵³

Because patent covers both an “apparatus” and a “method”⁵⁴ it is not the proper subject of protection by copyright. Rather, it squarely falls within the exceptions of the Copyright Act outlined by § 102(b).⁵⁵ If O’Connell and Rock had written a description of how to perform the illusion — much the way Teller drafted the description of how to perform Shadows, and had they copyrighted that description, then both the apparatus itself and the performance would be protected; the description of the performance by copyright and the apparatus and methodology by patent.

So too, a written explanation on how to accomplish a particular magic trick using playing cards or coins (the methodology) might also be subject to patent protection. However, the instructions themselves (words, layout, description, graphics, photographs, et cetera) would be subject to protection under Section 201(a) of the Copyright act.⁵⁶ Although copyright protection would not protect the method (which would require a patent for protection), it would protect the presentation of the method in the form registered in the U.S. Copyright Office.⁵⁷ This is exactly what Teller accomplished.

In the case of *Glazer v. Hoffman* the court had to consider whether the copyright protected the methodology.⁵⁸ The plaintiff alleged, in part, that another magician had stolen his act in which “he produced real, straight or mixed . . . beverages, such as . . . cocktails, liquors . . . coffee and ice cream sodas from metal cocktail shakers . . . which drinks were thought of or requested by members of his audiences.”⁵⁹ The court held that the underlying methodology, the means in which the drinks were created, was not subject to copyright protection.⁶⁰

There is a relatively clear distinction as to what parts of magic tricks are, or are not, subject to copyright protection. Many of the feats accomplished by a magician are — to an extent — subject to copyright protection. There are hundreds if not thousands of books on the subject of magic. Many of these books are registered with the U.S. Copyright Office. As referenced *supra*, one of the most famous is a series of books known as the “Tarbell Course in Magic.” This series of books contains hundreds of different methods for accomplishing a variety of effects. Just as with the instructions for a method of sleight of hand, the layout, text, description, graphics and details of the

⁵³ *Id.*

⁵⁴ *Id.* (describing the Pepper’s Ghost invention as, “a projection apparatus arranged to project an image of an object upon an inclined, partially reflective, screen so as to give a false perception of depth and a method for constructing such an apparatus.”)

⁵⁵ 17 U.S.C. § 102(b).

⁵⁶ 17 U.S.C. § 201(a).

⁵⁷ 17 U.S.C. § 102(a). As examples, a book, a set of instructions, even a video would be protected via copyright registration.

⁵⁸ *Glazer v. Hoffman*, 16 So. 2d 53 (Fla. 1943).

⁵⁹ *Id.* at 53 – 54.

⁶⁰ *Id.* at 53.

effects presented in the Tarbell books are protected by copyright. The underlying methodology or methodologies, however, are not protected.⁶¹

VI. DOING THE UNTHINKABLE

As Dr. Tarbell wrote “. . . secrecy is important.”⁶² Although magicians do share secrets, they do so to teach others and to improve the art. Generally, magicians use social norms to police magicians who disclose secrets to non-magicians.⁶³ Teller has never shared the methods behind how his trick “Shadows” worked. There is no evidence that Teller ever published, lectured or otherwise disclosed to anyone other than those individuals working on his show, the method behind how the petals and the leaves would fall from the rose. The registered copyright gives no insight into the method.⁶⁴ Since its creation in 1976, Teller has guarded the secret behind “Shadows.”⁶⁵ Some thirty-six years later, Teller was faced with the threat that his secret was about to be exposed.

A. *The Rose and Her Shadow*

In 2012, a man by the name of Gerard Dogge attempted to market an illusion titled “‘The Rose and Her Shadow,’ which he described as his version of Teller’s ‘Shadows.’”⁶⁶ According to Teller’s complaint, Dogge’s version of the magic trick was “substantially similar to Teller’s copyrighted work ‘Shadows.’”⁶⁷ Teller further alleged that “Defendant has recorded a video of himself performing the dramatic work ‘The Rose and Her Shadow,’ and had posted it on the popular Internet website YouTube along with an advertisement offering to sell the magic trick to consumers.”⁶⁸

Teller’s complaint goes on to allege that “Teller contacted Defendant by telephone and notified him that Defendant’s work ‘The Rose and Her Shadow’ was infringing on Plaintiff’s copyrighted work ‘Shadows’ . . . and . . . requested that Defendant cease all use and offers to sell his infringing work ‘The Rose and Her Shadow.’”⁶⁹

Fundamentally, Dogge has committed two acts that are addressed by the lawsuit. The first act is Dogge’s performance of the trick he called “The Rose and Her Shadow,”

⁶¹ 17 U.S.C. § 102(b) (stating that “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

⁶² HARLAN TARBELL, *THE TARBELL COURSE IN MAGIC XIX* (Ralph W. Read ed., D. Robbins & Co., 1999).

⁶³ See Hagan and Samuels, *supra* note 46 (citing Timothy Lee, Yet Another Example of Innovation Without Patent Protection: From the Must-Be-Magic Dept., *TECHDIRT* (Sept. 11, 2007)), <http://www.techdirt.com/articles/20070910/224932> (last visited Feb. 15, 2015).

⁶⁴ See Appendix (Teller’s Copyright).

⁶⁵ Complaint at 3 (stating that Teller created the act in 1976).

⁶⁶ See Hagan and Samuels, *supra* note 46, at 16.

⁶⁷ Complaint at ¶ 21, Apr. 11, 2012, Teller v. Dogge, No. 2:12-cv-00591 Document 4 – 1.

⁶⁸ *Id.* at ¶ 22.

⁶⁹ *Id.* at ¶ 26.

which he filmed and uploaded to YouTube.⁷⁰ The second was his duplication of methodology used to perform the trick that he offered for sale.⁷¹

B. Attempts to Settle the Dispute

Although many of the court's records are sealed and facts "behind" the controversy have been kept confidential, it has been suggested that Teller offered to pay Dogge \$15,000 to stop selling Dogge's version of the trick and keep the methodology secret.⁷² Teller, however, claimed, "that Dogge was not interested in a good-faith settlement of the parties' dispute, but was interested instead in leveraging as hefty a pay-out from the world-famous Teller as he could muster."⁷³

VII. THE LAWSUIT

Teller finally brought a lawsuit for copyright infringement and unfair competition against Dogge on April 11, 2012, after unsuccessful attempts to settle the dispute.⁷⁴

A. The Complaint

As noted in his complaint, Teller's claims arose "largely out of two videos Dogge posted on YouTube of Dogge performing Teller's copyrighted work "Shadows," together with an offer to sell the illusion with props and instructions for around \$3,000."⁷⁵ Teller alleged that Dogge, "[h]oping to make millions, . . . created his own prop and made plans to sell it and the illusion to the public."⁷⁶ Teller alleged that "Dogge created a video of himself performing the Work called 'The Rose and Her Shadow,' in an attempt to copy or 'clone' Teller's work. He decided to profit from Teller's work by selling instructions on how to perform the illusion and his prop."⁷⁷ He further alleged that the "Defendant intended his video . . . reach a worldwide audience, and intended to sell the illusion to anybody who would buy it."⁷⁸

⁷⁰ *Id.* at 22.

⁷¹ *Id.* at 21.

⁷² Jenny Small, *The Illusion of Copyright Infringement Protection*, 12 CHI.-KENT J. INTELL. PROP. 217, 228 (2013).

⁷³ Reply in Support of Motion for Clarification, or in the Alternative, Motion for Reconsideration of This Court's October 9, 2012 Order (Doc. #28) at 2:7 – 9, Nov. 13, 2012, Teller v. Dogge, Case No. 2:12-cv-00591 Document 44 [hereinafter "Reply in Support of Motion for Clarification"].

⁷⁴ See Complaint at 1, Apr. 11, 2012, Teller v. Dogge, No. 2:12-cv-00591 Document 4 – 1.

⁷⁵ Emergency Motion for Mirror Imaging of Dogge's Hard Drive, and for Stipulated Consent to Obtain Videos from YouTube at 3: 6 – 8, Apr. 30, 2013, Teller v. Dogge, Case No. 2:12-cv-00591 Document 75.

⁷⁶ Plaintiff's Motion for Summary Judgment as to the Copyright Infringement Claim at ¶ 2, July 8, 2013, Teller v. Dogge, Case 2:12-cv-00591-JCM-GWF Document 122.

⁷⁷ *Id.* at ¶ 3. (emphasis added)

⁷⁸ *Id.* at ¶ 10.

Teller apparently spared no expense prosecuting his claims. He presumably paid and sought to recover \$57,906.95 in costs and \$931,661.65 in attorney's fees for a grand total of \$989,568.60.⁷⁹

B. The Judgment

The court found that the lawsuit stemmed from “two YouTube videos defendant posted . . . [that had] between twelve and fourteen views, a very small amount.”⁸⁰

In granting summary judgment for Teller on the issue of infringement, the court held that Teller was the owner and creator of “Shadows,” that he had a valid copyright⁸¹ in the work and that the Defendant infringed on that right.⁸² After reviewing the supporting documentation filed by Teller's attorney, the court found the requested costs and attorney's fees “reasonable.”⁸³ The court — which previously granted summary judgment on the infringement claim⁸⁴ — ultimately awarded costs and attorney's fees, although somewhat less than the amounts requested by Teller.⁸⁵ The damage award granted by the court totaled \$15,000.00.⁸⁶

VIII. THE SMOKE AND THE MIRRORS

A. Copyright as applied to “Shadows”

Why did Teller sue a relatively unknown magician for posting a YouTube video of his own (Dogge's) performance of “The Rose and Her Shadow?” Recall the judge's finding that “the lawsuit stemmed from two YouTube videos defendant posted . . . [that had] between twelve and fourteen views.”⁸⁷

“Teller's lawyer, Mark Tratos . . . state[d] that . . . Teller is simply deeply troubled that another magician intends to ruin the magic of his illusion in order to make a few dollars.”⁸⁸ Formally, however, Teller's pleadings represented that he “initiated [the

⁷⁹ Order at 11, Sept. 30, 2014 Teller v. Dogge, Case No. 2:12-cv-00591 Document 233 [hereinafter “September Order”].

⁸⁰ *Id.* at 6.

⁸¹ *Id.* at 5.

⁸² *Id.* at 10.

⁸³ *Id.* at 11.

⁸⁴ Teller v. Dogge, No. 2:12-CV-591 JCM GWF, 2014 WL 4929413, at *1 (D. Nev. Sept. 30, 2014) (stating that on March 20, 2014, the court “granted Teller's motion for summary judgment on the issue of liability for copyright infringement.”).

⁸⁵ September Order, *supra* note 79, at 12 (awarding \$30,000 in costs and \$500,000 in attorney's fees).

⁸⁶ *Id.* at 12.

⁸⁷ *Id.* at 6:17 – 20.

⁸⁸ See Hagan and Samuels, *supra* note 46, at 15.

lawsuit] to protect and enforce his United States copyright,⁸⁹ which defendant Dogge was publically infringing through a YouTube posting.”⁹⁰

Judge Mahon, in his Order on Summary Judgment held that the Defendant “created two YouTube videos offering to sell the secret to one of Teller’s signature illusions.”⁹¹ The court noted that “[t]hrough there are organizations, taken seriously by many in the magic community, that blackball any performer who reveals a magician’s secret, Teller has opted to pursue this action with copyright infringement and unfair competition claims arising under federal law.”⁹²

It was the secret that Teller sought to protect; the process or mechanism that caused the rose petals to fall at the direction of the performer is what “makes” the effect and, hence, the “magic.” Although Judge Mahan noted, “the secret behind the trick does not impress the court, the performance it is used for is everything.”⁹³

The court effectively intertwined the two; that is, the secret behind the trick was an integral part of the performance. Therein lays the key to Teller’s success.

IX. THE ANALYSIS

The court held that the Defendant conflated the “idea of copying the secret of the illusion with copying the public performance of the work.”⁹⁴ In truth, the court did exactly that. The performance of “Shadows” is so intertwined with the method that the illusion could not be performed without the prop. That is, without a vase and rose that accomplishes the intended effect, there would be no performance. More importantly, the vase and rose can realistically only be performed in substantially the same way as Teller portrays in his description.

In Dogge’s execution of the illusion there is a diversion in the similarity of the performance. In both versions, the performer cuts the shadow of the rose and corresponding leaves and petals fall to the ground.⁹⁵ After that, the performances diverge. But after that, the trick is effectively over. Teller cuts his hand and smears blood on the paper while Dogge removes the stem of the rose from the bottle and pours out the water into a glass.⁹⁶ Although both of those actions are part of the performance, neither has anything to do with the trick itself. Accordingly, the court finds the differences between the two performances “inconsequential compared to the overwhelming number of significant and subtle similarities between these two

⁸⁹ Complaint at 8, Apr. 11, 2012, *Teller v. Dogge*, No. 2:12-cv-00591 Document 4 – 1. The lawsuit also alleged unfair competition under the Lanham Act. An analysis of that facet of the lawsuit is beyond the scope of this article.

⁹⁰ Reply in Support of Motion for Clarification at 1.

⁹¹ *Teller v. Dogge*, 8 F.Supp.3d 1228, 1231 (Nev. 2014).

⁹² *Id.* at 1231.

⁹³ *Id.* at 1234.

⁹⁴ *Id.*

⁹⁵ *Id.* at 1231 (explaining that Dogge enters an “otherwise still scene, picks up a large knife, and proceeds to use the knife to dramatically sever the leaves and petals of the rose’s shadow on the screen slowly, one-by-one, whereupon the corresponding leaves of the real rose sitting in the bottle fall to the ground, breaking from the stem at the point where Dogge cut the shadow.”).

⁹⁶ *Id.* (explaining that Teller’s version ends with “Teller pricking his thumb with the knife, and holding his hand in front of the canvas. A silhouette of a trail of blood appears, trickling down the canvas just below the shadow of Teller’s hand.”).

works . . . [and] finds that “Shadows” and “The Rose and Her Shadow” are substantially similar . . . ”⁹⁷

Dogge attempted to persuade the court that the methods behind the tricks are different and, therefore, could not be in violation of copyright law.⁹⁸ The court, however, properly noted that the distinction is irrelevant (to a copyright claim) because the methods — or secrets behind the illusion — “are *not perceivable by the audience*.”⁹⁹ The court held that in comparing the two works, the “court compares only the *observable* elements.”¹⁰⁰ The court dismissed Dogge’s argument concerning differences between the two illusions, stating that, “any individual could reap the benefits of another’s creative labor by copying a final product and altering a few inconsequential details.”¹⁰¹ Copyright law requires substantial similarity, not exact similarity, to find infringement.¹⁰² A performer could change the color or type of the flower, or the vessel in which it rests but in the final observation, the performance is essentially the same.

The court agreed with Dogge that “magic tricks are not copyrightable.”¹⁰³ Presumably, the court meant that the methods and processes behind the tricks are not subject to copyright because the court subsequently holds that “Shadows” is subject to copyright.¹⁰⁴ The court so holds because “Shadows” (clearly a magic trick) is a dramatic work and a pantomime that is subject to copyright protection.¹⁰⁵ One particular portion of the court’s holding is critical to not only Teller’s victory but to an understanding of how, in this case, the copyright was effectively used as a patent: “The mere fact that a dramatic work or pantomime includes a magic trick, or even that a particular illusion is its central feature does not render it devoid of copyright protection.”¹⁰⁶

The court’s ruling is significant. When a magic trick is the effect and the effect is the trick (such as the case with “Shadows,”) then copyright protection effectively protects the underlying method. Dogge argued, and the record does not indicate that it was disputed, that his method was different than Teller’s method.¹⁰⁷ But Dogge’s argument was irrelevant because the court concerned itself with what was perceived by the audience.¹⁰⁸ As a result, the method for the accomplishment of an illusion can

⁹⁷ *Teller*, 8 F.Supp.3d at 1236.

⁹⁸ *Id.* at 1236.

⁹⁹ *Id.* at 1236 (emphasis in original).

¹⁰⁰ *Id.* (emphasis in original).

¹⁰¹ *Id.* (emphasis in original).

¹⁰² *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002) (relying on substantial similarity not exact similarity for its analysis of copyright infringement).

¹⁰³ *Teller v. Dogge*, 8 F.Supp.3d 1228, 1233 (Nev. 2014).

¹⁰⁴ *Id.* (explaining that even though the magic trick is not copyrightable, “this does not mean that “Shadows” is not subject to copyright protection.”).

¹⁰⁵ *Id.* (stating that “Teller’s certificate of registration describes the action of “Shadows” with meticulous detail, appearing as a series of stage directions acted out by a single performer. Because dramatic works and pantomimes clearly fall within the protection of the Copyright Act, Dogge has presented no reason for the court to doubt the validity of Teller’s copyright.”).

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at 1236 (stating that “Dogge contends that the works are not substantially similar because his secret to performing the illusion differs from Teller’s.”).

¹⁰⁸ *Id.* (reasoning that Dogge’s argument concerning different methodology implicitly “argues about aspects of the performance that are not perceivable by the audience. In discerning substantial similarity, the court compares only the observable elements of the works in question.”).

be protected by a copyright when the copyright reflects a performance that is intertwined with the illusion.

X. THE CONCLUSION

Teller did not spend approximately \$1,000,000.00 on legal fees because some virtually unknown magician from Belgium uploaded a couple of YouTube videos of himself performing a magic trick. Even though the trick was virtually identical to Teller's trick "Shadows," the trick had only been viewed a handful of times. No, Teller's concern was not Dogge's performance nor the mere videos. Teller's concern was the method. Dogge offered to sell the secret — the method behind the trick. And the court found Dogge's actions infringing. Teller, by suing and winning, has protected the secret behind the illusion. He protected with a copyright that which only a patent can legally protect: A method for performing a trick.

APPENDIX (TELLER'S COPYRIGHT)

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FORM P

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See instruction
before comp
this space.

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DEPOSIT ACCOUNT If the registration fee is to be charged to a Deposit Account established in the Copyright Office, give name and number of Account.

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Account Number ▼

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Teller

c/o J. Teller

2032 Cherry Street

Philadelphia, PA 19103

Area Code & Telephone Number ▶ 714-891-0602 or message 215-568-1194

Be sure to
give your
daytime phone
number

CERTIFICATION* I, the undersigned, hereby certify that I am the

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of the work identified in this application and that the statements made
by me in this application are correct to the best of my knowledge.

Typed or printed name and date ▼ If this is a published work, this date must be the same as or later than the date of publication given in space 3.

Teller (Raymond Teller)

date ▶ Jan 2, 1983



Handwritten signature (X) ▼

(Raymond Teller)

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will be
mailed in
window
envelope

Name ▼

Raymond Teller

Number/Street/Apartment Number ▼

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Have you:

- Completed all necessary spaces?
- Signed your application in space B?
- Enclosed check or money order for \$10 payable to Register of Copyrights?
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* 17 U.S.C. § 506(e): Any person who knowingly makes a false representation of a material fact in the application for copyright registration provided for by section 409, or in any written statement filed in connection with the application, shall be fined not more than \$2,500.

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SHADOWS

by Teller

SETTING: Stage center is a projection screen composed of a piece of paper 4 feet high and 3 feet wide, stretched on a frame, supported by an easel.

Six or seven feet directly downstage of the screen is a small spotlight at stage floor level. It shines up at the screen.

Between the two, supported on a little table, is a rose in a bud vase. The rose has a central stem topped by a red blossom, and a branch with leaves on either side.

When the spotlight is turned on, the vase and rose cast a sharp shadow on the screen.

CHARACTER: The Murderer. He carries a large, glistening dagger.

HISTORICAL NOTE: This gothic pantomime has been performed by its creator over 1100 times since 1976. It's about time he registered a copyright, don't you think?

Copyright 1983 by Teller

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ACTION:

The stage is dark.

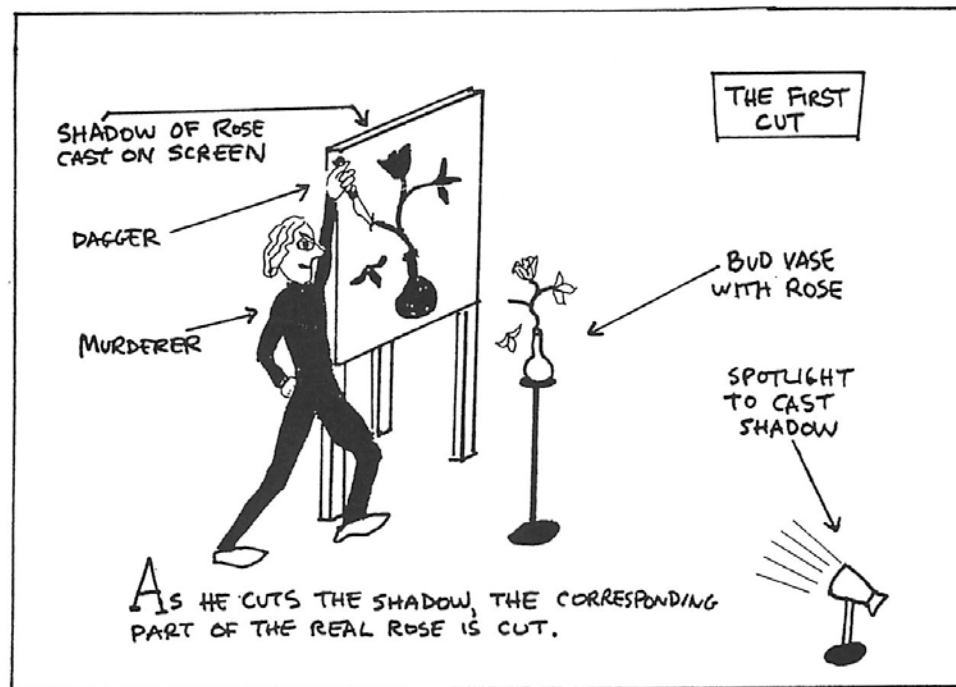
The spotlight is slowly illuminated, revealing the rose and the vase, and casting their shadows on the screen.

The Murderer becomes visible, lurking stage right, turning his dagger thoughtfully in his fingers.

He looks up and sees the rose. He takes a few steps towards it.

He notices the shadow, and takes a few more steps, bringing himself to the (stage right) edge of the screen.

He looks down at the (stage right) branch of the rose. He looks back at the shadow of that branch. He raises the dagger.



He places the tip of the dagger on the paper screen, just at the point where the shadow of the branch joins the shadow of the leaves. He stabs gently through the paper.

The (stage right) leaves of the real rose fall, breaking from the stem at exactly the point where the shadow was cut.

Copyright 1983 by Teller

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The Murderer pauses, then glides to the far (left) edge of the screen. He looks at the remaining (stage right) leaf-branch.

Again he cuts through the shadow, and again the corresponding real rose leaves fall.

He looks at the blossom.

He raises the dagger, placing its tip on the shadow of the stem just where it joins the blossom. He pierces the paper.

One by one petals start to fall.

He twists the knife. More petals fall. Only one remains.

He gives a final jab. The last petal drops off.

He lowers the dagger. He contemplates the stem of the rose, now pruned of its leaves and its flower.

As he turns the dagger thoughtfully in his fingers, he accidentally pricks his right thumb on the point of the knife.* He reacts, drawing a quick breath, and bringing his thumb quickly to his mouth to suck the blood from the wound.

Abruptly, as if struck by an idea, he looks at the rose stem, and up at the shadow of the rose stem. He lowers his thumb, looks at the wound, and up at the screen.

Slowly he raises his hand, thumb pointing downward, casting its shadow crisply on the brightest portion of the screen.

With his right index finger, he pushes along the pad of the thumb, as if trying to force blood out of the wound.

From the tip of the shadow of his thumb a small stream of blood emerges and, red and glistening, runs down the surface of the paper.

He sees the blood. He reaches up and touches the stream with the heel of his right hand. It is real.

He looks out startled towards the audience. As he turns outward, his hand slides down the stream of blood, spreading its color down the paper in a broad, butcher smear.

The light fades out quickly.

THE END

*Variation: He reaches out to take the stem of the rose, but, as he grasps it, he pricks his thumb on a thorn.

Copyright 1983 by Teller