

2003

## How Dewey Classify OCLC's Lawsuit

Roger V. Skalbeck

*University of Richmond*, [rskalbeck@richmond.edu](mailto:rskalbeck@richmond.edu)

Follow this and additional works at: <http://scholarship.richmond.edu/law-faculty-publications>

 Part of the [Intellectual Property Law Commons](#), and the [Legal Writing and Research Commons](#)

---

### Recommended Citation

Roger V. Skalbeck, *How Dewey Classify OCLC's Lawsuit*, LLRX.com Sept. 29, 2003.

This Article is brought to you for free and open access by the School of Law at UR Scholarship Repository. It has been accepted for inclusion in Law Faculty Publications by an authorized administrator of UR Scholarship Repository. For more information, please contact [scholarshiprepository@richmond.edu](mailto:scholarshiprepository@richmond.edu).

## Features – How Dewey Classify OCLC's Lawsuit

By [Roger V. Skalbeck](#), Published on September 29, 2003

[Printer-Friendly Version](#)

Founder, Editor, Publisher:

[Sabrina I. Pacifici](#)

Follow [LLRX](#) and [beSpecific](#) on  
Twitter

SUPPORT LLRX

[Donate](#)

[Support Your Local Library](#)

LEGAL RESEARCH

Federal Legislative Research  
Foreign & Comparative Law  
Legislative Research Guide  
United States Law

LIBRARIAN RESOURCES

Competitive Intelligence  
Government Resources  
Information Management  
Law Library Management  
Presentation Skills  
9/11 News & Legal Resources

LEGAL TECHNOLOGY

E-Discovery  
Gadgets & Gizmos  
Intranets  
Knowledge Management  
Websites, Blogs, & Wikis

FROM [BESPACIFIC.COM](#)

Daily Law & Technology News

Commentary - Why Protecting  
Data Privacy Matters, and When

Site tracks and maps data  
breaches around the globe

McKinsey - How companies can  
adapt to climate change

Report - Recommitting American  
Police Culture to Democratic  
Ideals

California drought impacting rural  
poor - arsenic tainted water

Regulatory agencies post public  
sections of resolution plans

GAO Reports - Bureau of  
Reclamation, Medicare Part B  
Drugs, Troubled Asset Relief  
Program

The USA Freedom Act: A Partial  
Response to European Concerns  
about NSA Surveillance

SEC and CFTC Turn to Swaps and  
Security-Based Swaps  
Enforcement

New on LLRX - Human Resources

[Roger V. Skalbeck](#) is the Technology Systems Librarian at George Mason University School of Law in Arlington Virginia. He has worked in law libraries for over a decade, and he is currently pursuing a law degree. He is not a lawyer, and he doesn't even play one on television. Nothing in this article should be construed as legal advice, and none of the statements are intended to favor either side of the litigation.

On September 10, the [Ohio-based Online Computer Library Center](#) ("OCLC") filed a [lawsuit](#) against the [Library Hotel](#) in New York City, claiming three types of trademark-related violations by the hotel. OCLC v. The Library Hotel, No. \_\_\_\_ (S.D. Ohio filed Sept. 10, 2003) ("Complaint"). The [concept](#) for the hotel is that each of its ten stories is themed around one of the main Dewey Decimal Classification categories. OCLC's fundamental objection is that the Library Hotel makes unlicensed use of federally-registered trademarks in a commercial setting without attribution. The lawsuit has been covered in [The New York Times](#) (Michael Lou, Where Dewey File Those Law Books?, New York Times, September 23, 2003). [CNN.com](#) ("Dewey Decimal system owner sues hotel", Associated Press, September 21, 2003.), and numerous newspapers and [blogs](#) (See e.g., Steven Wu, [Hotel Sued for Using Dewey Decimal System](#), on Yale's LawMeme Project; Simon St. Laurent, [When good institutions go bad](#), an O'Reilly Developer Weblog).

In order to understand the nature of the rights asserted here, it is important to properly classify the Dewey Decimal lawsuit. To these ends, this article presents analysis aimed to better define its scope and legal framework. This is not an analysis of the merits of the claims, let alone a prediction as to the outcome. The issues are considered in the following three sections. In closing, I offer a light-hearted [suggestion](#) as to how this suit might be resolved outside of litigation or settlement.

[Distinguishing Trademarks from Questions of Patents or Copyright](#)

[Trademarks Owned by OCLC](#)

[Summary of the Three Causes of Action](#)

### Distinguishing Trademarks from Questions of Patents or Copyright

The three major areas of intellectual property are copyrights, patents and trademarks. In the broadest sense, copyrights protect the expression of an idea, patents protect the idea itself and trademarks protect the source of origin of a product or service. Patent and copyright protection was established through Article I of the Constitution, enabling Congress to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." U.S. Const. art. I, § 8. Here OCLC asserts no claims involving writings or discoveries. This lawsuit has nothing to do with science or the useful arts.

As there are no questions of patent infringement, it is immaterial that OCLC is the exclusive owner of at least five active United States patents. See U.S. Patent Nos. 5,910,805; 5,583,762; 5,459,739; 5,146,267 and 4,803,643. Moreover, there is no question here as to whether Melville Dewey has any surviving patent rights for a classification system he first developed in 1873. Nonetheless, current classification systems are certainly eligible for patents. See e.g., "Vehicle occupant classification system and method," U.S. Patent No. 6,609,054 (issued Aug. 19, 2003); "Methods and apparatus for classifying terminology utilizing a knowledge catalog", U.S. Patent No. 6,487,545 (issued Nov. 26, 2002).

There is no need to sort out any of over 1,800 copyright registration records found in the Library of Congress database, which list OCLC as the owner. There are no questions of copyright infringement, let alone issues of copyrightable subject matter for any material that the Library Hotel may have used.

Instead, this is a question of federal trademark and unfair competition law, which is governed primarily by the

*Lanham Act*<sup>1</sup>. *Federal Trademark Act of 1946* (Lanham Act) 15 U.S.C. § 1051. On the occasion of the act's 50th anniversary, the president summarized its core legislative achievements as demonstrated in "protecting consumers against deceit and confusion, in creating incentives for American businesses to produce quality goods and services, and in advancing U.S. trademark law." Letter from Bill Clinton, Celebrating 50th Anniversary of the Lanham Act (July 2, 1996) (available on [INTA website](#)). All of these are at play in OCLC's lawsuit.

The complaint alleges a likelihood of confusion or deceit, false designation of origin of services, implied business approval of the hotel's services and a danger of the Dewey marks becoming generic. Complaint at 9-10. These allegations are encompassed by three causes of action, which are presented below. With respect to the third suggested legislative achievement of the *Lanham Act*, this case could almost certainly do something to advance U.S. trademark law, should it ever go to trial.

## Trademarks Owned by OCLC

The [New York Times article](#) opens with the question "Who knew that someone owned the Dewey Decimal System?" *Luo*. One response might be that any trademark attorney who bothered to check would know the answer. OCLC owns the mark. It has been registered since 1963. In fact, OCLC currently owns no fewer than thirty-six federally-registered trademarks for various products and services. Following are the three relevant trademarks cited in OCLC's complaint:

- a) DEWEY DECIMAL CLASSIFICATION - Registration No. 0755548, registered August 27, 1963, for periodical publication - namely, an index relating to a system of classifying the field of human knowledge;
- b) DDC - Registration No. 1458757, registered September 22, 1987, for publication of books and magazines relating to a system of classifying the field of human knowledge;
- c) DEWEY - Registration No. 1868056, registered December 20, 1994, for periodical publication, electronically recorded on compact discs, featuring an index relating to a system of classifying the field of human knowledge. *Complaint* at 5.

In the earliest registration, the words "Decimal Classification" are disclaimed except for in the context of the mark itself. This is probably not much of a limitation, because "decimal classification" is a generic concept of little value without naming Dewey to describe the correct species of numerical classification. Notably, "Dewey Decimal Classification" was first used in commerce in 1876, when [Melville Dewey](#) published and sold the first edition of this classification system.

In general, there is no problem with allowing federal trademark protection to designate a classification system, when the designation is used in connection with a product or service in interstate commerce. Registered trademarks for classification systems include at least four marks owned by the [U.S. Department of Commerce](#) relating to the North American Industry Classification System (NAICS). See Reg. Nos. 2320850, 2409877, 2407714, and 2732395. Beyond that, the [American Psychiatric Association](#) has registered "DSM" (Reg. No. 2354615), "DSM-IV" (Reg. No. 2148566) and "DSM-IV-PC" (Reg. No. 2147056).

"Dewey Decimal Classification" and "DDC" are most typically used in conjunction with a subscription to a cataloging service offered by OCLC, and the company apparently paid over \$100,000 in 2001 to promote goods and services offered in conjunction with these marks. *Complaint* at 6-7. Each of the cited marks has been in use for well over five years, so they are incontestable as defined by U.S. trademark law. 15 U.S.C. § 1065. A registration for an incontestable trademark provides "conclusive evidence of the validity of the registered mark and [...] of the registrant's exclusive right to use the registered mark in commerce." 15 U.S.C. § 1115(b). "The purpose of incontestability in federal trademark law is, quite simply, to avoid having the validity of trademarks litigated endlessly." *Sovereign Order of Saint John of Jerusalem, Inc. v. Grady*, 119 F.3d 1236 (6th Cir. 1997). An incontestable mark cannot be challenged as one that is merely descriptive of the goods or services in question. See *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 196 (1985). Clearly, OCLC owns intellectual property that should enjoy some level of federal protection. The question is how these rights might be enforced.

## Summary of the Three Causes of Action

### Federal Trademark Infringement

The first cause of action involves questions of trademark infringement. Here OCLC argues that they have exclusive rights to use the marks, which have become incontestable under 15 U.S.C. § 1115. *Complaint* at 10. Note though that the status of "incontestability relates to the validity of the mark and does not eliminate the necessity of the registrant proving infringement." 5 *McCarthy on Trademarks and Unfair Competition* § 32:154 (4th ed.). OCLC's chief argument stresses that use by the Library Hotel is "likely to cause confusion as to sponsorship or authorization by OCLC, or alternatively, destroy the origin-identifying function of the Dewey Marks." *Complaint* at 10. OCLC claims that the usage in question is "deliberate, willful and wanton" under 15 U.S.C. § 1117. *Complaint* at 11. As evidence of the willfulness of these actions, OCLC states that they previously wrote to the Library Hotel on three occasions, seeking proper acknowledgement of OCLC's ownership of the marks on the hotel's website. *Complaint* at 9. In further describing the conduct of the Library Hotel, OCLC quotes an interview with the hotel's owner, Henry Kallan, where he states that he "was even thinking of registering the

concept [of the hotel] as intellectual property.” *Complaint* at 8. (quotation in Glenn Haussman, [Hotelier Sees Service As Strongest Asset](#), (May 31, 2000)).

In the context an Internet site, mere usage of a known mark doesn’t automatically constitute infringement in the federal jurisdiction where this lawsuit has been filed. See e.g., *PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243 (6th Cir 2003) (vacating an injunction as to the use of metatags on a website), *Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687 (6th Cir. 2003) (finding no infringement as to the use of a trademark in a file directory path). Because the Library Hotel incorporates OCLC’s marks in the visible text of their site and in the hotel itself, this could be a more straightforward question of trademark infringement.

#### **Federal Unfair Competition, False Designation of Origin, Passing Off and False Advertising**

The second cause of action relates to a question of unfair competition. This claim is often used to prevent unauthorized endorsement, often by celebrities, and it need not involve a federally-registered trademark. See e.g., *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983). The statute protects from false designation of origin, including a false representation of sponsorship or approval. 15 U.S.C. § 1125(a). A designation of origin is considered false if it creates a likelihood of confusion in the consuming public. *Johnson v. Jones*, 149 F.3d 494, 502 (6th Cir. 1998). However, this statute “does not have boundless application as a remedy for unfair trade practices.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041, 2045 (2003). In the complaint, OCLC focuses on the potential for false sponsorship and false origin, also citing a concern that their Dewey could become generic in the eyes of consumers. *Complaint* at 11.

The question here turns on an analysis of any inferred approval or sponsorship by OCLC for the Library Hotel’s usage. If somebody were to open a hotel themed around major league baseball teams with rooms named after famous players, people might likely conclude that the baseball league had sponsored or approved of the use in the hotel. Moreover, people would probably assume that the hotel had licensed use of the relevant marks in question. In the case of the Library Hotel, there is no attribution as to the source of origin of the Dewey Decimal Classification marks. OCLC has clearly not assented to the use, as evidenced by the language of the complaint itself.

#### **Dilution of Famous Marks**

The final issue involves potential diluting of OCLC’s marks. Federal protection against dilution of famous trademarks is found in 15 U.S.C. § 1125(c). Whereas trademark infringement focuses on protection of consumers that has its origins in the common law, dilution protection is established by statute and it focuses on protecting the uniqueness of a famous mark itself. *Moseley v. V Secret Catalogue*, 123 S. Ct. 1115, 1122 (2003). The Supreme Court has held that this test requires a showing of actual dilution of a famous mark, as opposed to a somewhat more prospective standard of a likelihood of dilution. *Id.* at 1124. On its face, this appears to be a difficult test, and courts since *Moseley* have upheld this standard in the jurisdiction where this lawsuit was filed. See *Kellogg Co. v. Toucan Golf, Inc.*, 337 F.3d 616 (6th Cir. 2003). (finding no actual dilution of Kellogg’s marks by golf products bearing a realistic toucan bird).

However, cases considering questions of trademark dilution have frequently involved trademarks that differed in some noticeable manner. In *Moseley*, the Supreme Court writes that “at least where the marks at issue are not identical, the mere fact that consumers mentally associate the junior user’s mark with a famous mark is not sufficient to establish actionable dilution.” *Moseley*, at 1124. (emphasis added). With respect to the usage by the Library Hotel, there is no variation in spelling, and thus a question of mental association may be moot. Though the Library Hotel doesn’t market goods or services under a direct Dewey brand, they use the identical marks owned by OCLC. That said, OCLC will still have the burden of proving that they indeed have a famous mark, in light of eight non-exclusive factors listed in the statute. 15 U.S.C. §1125(c)(1). Of the three causes of action, dilution may present the most interesting questions of trademark law, based on the information available at present.

#### **An Alternative Suggestion to Fix Things**

Though the Dewey Decimal Classification system can be the butt of many jokes, this lawsuit is clearly no laughing matter. Here OCLC is seeking to recover three times the Library Hotel’s profits as a result of their actions or three times OCLC’s damages, whichever is greater. *Complaint* at 15. [Joseph R. Dreidler](#), a lawyer representing OCLC was quoted to say they are willing to settle with the hotel, and “[a]t a minimum, if they want to continue to use [the marks in question], there certainly has to be some sort of a license to the Library Hotel.” Mike Pramik, *Trademark Lawsuit; Hotel’s Use of Library Theme Opens Legal Chapter*, Columbus Dispatch, September 20, 2003.

Settlement or continued litigation are just two possible paths in the next stage of this matter. As an alternative, the Library Hotel could simply choose to use a different system of classification for their hotel. One option would be to use the [Library of Congress Classification System](#). The Library of Congress has no current trademarks relating to their system, and it is probably second only to Dewey in terms of name recognition for library classification systems. Living in the Washington, D.C. area, I would prefer that they reserve this option for a hotel closer to the actual [Library of Congress](#).

Instead, the Library Hotel could choose to adopt a different classification system that was developed in New York by somebody who lived at the time of Melville Dewey. Henry Evelyn Bliss was born in New York in 1870, and he worked for over three decades to develop his own system of classification. See Lois Mai Chan, *Cataloging and Classification: An Introduction*, at 392. (2nd Ed. 1994). One potential problem in choosing Bliss is that this system is maintained by the [Bliss Classification Association](#) in England. There should be no problems of trademark infringement or dilution, but there could theoretically be issues of false designation of origin. Irrespective of these legal concerns, by adopting Bliss Classification the Library Hotel could pay homage to a former New York resident who was clearly dedicated to a love of books and libraries. Also, all hotel guests could enjoy a Blissful experience, not just those who choose to purchase the hotel's [Erotica Package](#).

In the movie [Party Girl](#), Parker Posey exhibits maturity and responsibility in the workplace by learning how the Dewey Decimal system actually works. *Party Girl* (Party Productions 1995). Perhaps learning more about the type of protection afforded to the Dewey Decimal Classification trademark can also result in better understanding and respect in the business world. Hopefully, an amicable and mutually-agreeable outcome can be achieved without costly court battles.

Copyright © 2003, Roger V. Skalbeck. All Rights Reserved.

---

[1] For a historical overview of the act, in honor of its 50th birthday, see: "The Lanham Act: Alive And Well After 50 Years". INTA. Available at: <http://www.inta.org/about/lanham.html>

---