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Marianna L. Markley
University of Georgia School of Law

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J.D. Candidate, 2020.

HOCUS POCUS: THE MAGIC WITHIN TRADE SECRET LAW

Marianna L. Markley[1]

[1] J.D. Candidate, 2020.

I. INTRODUCTION

"'What the eyes see and the ears hear, the mind believes.'"[2] With a single sentence, Harry Houdini captured the essence of his craft. The best magicians, like Houdini, spend years studying and practicing in order to perfect magic tricks and illusions that will fool even the most careful observers. Houdini, for example, accrued a collection of nearly 4,000 books on topics ranging from magic and slight-of-hand to modern Spiritualism in order to study and perfect his art.[3] His diligent study of magic turned out to be very rewarding because he would eventually be regarded as "the highest paid performer in American vaudeville."[4]

The legacy (and overwhelmingly large collection of magic books) Houdini left behind illustrates that the careful study, practice, and devotion he gave to his life's work allowed him to make his audience see and hear what he wanted them to believe. But Houdini was not the only one to devote his life to perfecting the art of deception. For centuries, magicians have bewitched audiences with tricks, illusions, and death-defying stunts.[5] In fact, Criss Angel, a contemporary magician and illusionist, once wrote that magic is the second oldest profession in the world.[6] As magic tricks have evolved, the mediums in which they are performed have also faced the inevitability of evolution. Today's magic shows appear in mediums ranging from traditional formats like David Copperfield's headlining show at the MGM Grand Hotel & Casino in Las Vegas,[7] to less conventional formats like Justin Willman's Netflix series *Magic for Humans*[8] and David Blaine's YouTube channel for street magic.[9] While magic tricks and shows have continued evolving, one constant remains: every magician fears having their secrets revealed.

In the digital age, performances of magic tricks may be easily recorded and posted on the internet for all to see. While this has provided many magicians with platforms to expand their audience and build their reputations, the Internet

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[2] Bill Schulz, *Harry Houdini's Most Mind-bending Quotes*, ENTREPRENEUR (Nov. 1, 2016), https://www.entrepreneur.com/article/284436.

[3] *Harry Houdini Collection*, LIBRARY OF CONGRESS (March 7, 2018), https://www.loc.gov/rr/rarebook/coll/122.html.

[4] *Harry Houdini Biography,* BIOGRAPHY (Oct. 22, 2014), https://www.biography.com/performer/harry-houdini.

[5] *See* Les Hewitt, *The History of Magic from Dark Art to Pop Entertainment*, HISTORIC MYSTERIES (May 27, 2018), https://www.historicmysteries.com/history-of-magic/.

[6] Criss Angel, *The Unbroken Spell of Magic*, HUFFPOST (May 21, 2013), https://www.huffpost.com/entry/criss-angel-mindfreak_b_2928461.

[7] *See generally*, *David Copperfield at MGM Grand*, MGM GRAND, https://www.mgmgrand.com/en/entertainment/david-copperfield.html (last visited Oct. 14, 2018).

[8] *See Magic for Humans*, NETFLIX (Aug. 17, 2018).

[9] *See* David Blaine, *Street Magic | David Blaine*, YOUTUBE (June 20, 2017), https://www.youtube.com/playlist?list=PLDif3BvvHdkUQFVficd0Onu2b_SsyLmJX.

nevertheless presents a risk that a magician's secrets may be revealed for profit without their knowledge or consent.[10] For example, websites like "Theory11.com" create and sell videos teaching people the secrets behind popular magic tricks.[11] These videos can be instantly downloaded by people all over the world,[12] thus the time and effort magicians put into the creation of their tricks is wasted because anyone can learn and profit off a magician's ingenuity.

Magicians, like Houdini, have spent years developing their tricks, and their careers depend on protecting those secrets. Yet, intellectual property (IP) law offers very little protection to magicians, particularly because of the threats they face in the digital age.[13] Since magicians operate in an area of "'negative space,'" it has historically been difficult for magicians to protect their creative endeavors through copyright, patent, and trademark laws.[14] In the context of art, negative space is defined as "the area surrounding the subject."[15] If this definition is applied to IP law then copyright, patent, and trademark law would be the subjects and magic tricks would fill in the negative space surrounding these subjects because they do not fall squarely within the protection of any of these subjects. Instead of relying on traditional forms of IP law, the magic community has relied almost exclusively on internal enforcement of industry norms.[16] These norms include the governance of attributing credit, using new ideas, and exposing secrets.[17] The magic community is rather unique in this regard, and its uniqueness is the reason why trade secret law might afford magicians with a more pragmatic way to safeguard their tricks.

Although trade secret laws have not traditionally been invoked by magicians seeking to protect their tricks, that might start to change. In April of 2018, David Copperfield surmounted an incredible feat when a court afforded trade secret protection to his magic trick, the "Thirteen."[18] This is a monumental decision for magicians seeking to protect their work through IP law. Although this was not the first time a magic trick has been at the center of litigation, it is one of the first times that a court has explicitly recognized that the secrecy of a magician's trick is protected by trade secret law.

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[10] Rick Lax, *Is the Internet Transforming—or Destroying—the Magic of Magic?*, LAS VEGAS WEEKLY (Dec. 8, 2011), https://lasvegasweekly.com/ae/2011/dec/08/secrets-out/.

[11] *Id.*

[12] *Id.*

[13] JACOB LOSHIN, *Secrets Revealed: Protecting Magicians' Intellectual Property without Law*, *in* LAW AND MAGIC: A COLLECTION OF ESSAYS 123 (Christine A. Corcos ed., 2010).

[14] *Id.*

[15] Dan Scott, *How to Use Positive and Negative Space to Create Better Paintings*, DRAW PAINT ACADEMY (Mar. 5, 2018), https://drawpaintacademy.com/positive-and-negative-space/.

[16] LOSHIN, supra note 12, at 124.

[17] *Id.* at 125-130.

[18] David Copperfield's Disappearing, Inc. v. Eighth Jud. Dist. Ct. in & for Cty. of Clark, No. 75609, 2018 WL 2045939, at *1 (Nev. App. Apr. 20, 2018).

This Note will discuss why trade secret law is the most appropriate form of IP protection for magicians seeking to protect their secrets. First it will discuss the background information on IP protections offered to magicians, specifically within copyright, patent, and trade secret law. After examining previous cases in which magicians have sought protection for their work using each of these different types of IP laws, it will then analyze why trade secret law is the best form of IP protection for magicians.

II. BACKGROUND

A. COPYRIGHT LAW

The purpose of copyright law is "[t]o promote the Progress of Science and useful Arts," by allowing authors and inventors to benefit from owning the exclusive rights to their work.[19] Copyright protection is offered to "original works" within categories like literature, music, drama, pantomimes, choreography, motion pictures, and other audiovisual creations.[20] However, copyright protection hinges on the requirement that the work be "fixed in any tangible medium of expression" and fit within a copyrightable subject matter.[21]

Courts have held that magicians are not entitled to copyright protection because magic tricks and illusions do not fit within one of the subject matters that are afforded copyright protection.[22] The world-renowned magician Raymond Teller, one half of the Penn and Teller duo, sued Gerard Dogge for "creat[ing] two YouTube videos offering to sell the secret to" Teller's illusion, "Shadows."[23] Teller performs the trick by placing a vase containing a single rose in front of the audience and erecting a screen behind the props.[24] A light is then shone on the vase and rose so that the shadows of the vase and rose appear on the screen behind them.[25] Teller begins to cut the petals off of the shadow of the rose with a knife while the petals of the actual rose simultaneously fall to the floor.[26] In March of 2012, Dogge created two videos in which he performed a similar act, and the caption boasts, "A Double illusion for the price of 'One'," making it clear that he intended to sell the secret behind Teller's trick.[27]

A copyright infringement claim requires the plaintiff to establish two elements in order for the claim to succeed: (1) that the plaintiff is the owner of a

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[19] U.S. CONST. art. I, § 8, cl. 8.

[20] 17 U.S.C. § 102 (2018).

[21] *Id.*

[22] Teller v. Dogge, 8 F. Supp. 3d 1228, 1233 (D. Nev. 2014).

[23] *Id.* at 1231.

[24] *Id.*

[25] *Id.*

[26] *Id.*

[27] *Id.*

valid copyright; and (2) that the defendant copied the original elements of the work.[28] On January 6, 1983, Teller registered his act as a dramatic work with the United States Copyright Office (USCO) and his "certificate of registration describes the action. . .with meticulous detail, appearing as a series of stage directions acted out by a single performer."[29] The court noted that registration with the USCO "constitute[d] *prima facie* evidence of a valid copyright if it [was] approved within five years of the first publication of a work."[30] Even though Teller registered the act seven years after he first performed it, the court decided that Teller had provided enough substantial evidence to establish that he was, in fact, the creator of "Shadows."[31]

In response, Dogge argued that, even though Teller had registered his act, the "copyright [was] not valid because. . .it [was] registered as a dramatic work rather than [as] a magic routine."[32] The court agreed with Dogge that magic tricks are not copyrightable.[33] However, the court stated that dramatic works and pantomimes were copyrightable, and "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."[34]

The court clarified that magic tricks and illusions are not in and of themselves copyrightable, but their performance can be considered a dramatic work, which is within the protection of copyright law, and therefore copyrightable.[35] Since Teller's certificate of registration meticulously described the act "as a series of stage directions acted out by a single performer[,]" his performance of the illusion is a dramatic work which falls within the protection of copyright law.[36] Therefore, Teller was able to establish that he was the owner of a valid copyright, satisfying the first prong of the test for copyright infringement.[37]

The second prong requires Teller to establish that Dogge copied the original elements of the work.[38] The court looked at whether there were "'articulable similarities between the plot, themes, dialogue, mood, setting, pace, character, and sequence of events'" when comparing the copied work to the original

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[28] *Id.* at 1233 ("In order to prevail on a claim for direct copyright infringement, a plaintiff must establish two elements: (1) the plaintiff's ownership of a valid copyright; and (2) the defendant's copying of constituent elements of a work that are original.").

[29] *Id.*

[30] *Id.*

[31] *Id.*

[32] *Id.*

[33] *Id.*

[34] *Id.*

[35] *Id.*

[36] *Id.*

[37] *Id.*

[38] *See Id.*

work.[39] However, the court noted that ideas, concepts, themes, and scenes-a-faire could not serve as copyrightable elements.[40] After going through their analysis, the court determined that Dogge's and Teller's acts were "nearly identical twins."[41] Therefore, Teller was able to succeed in his copyright infringement claim because both prongs of the test were met.[42]

However, magicians have not always been successful in proving their copyright infringement claims. In the 1940s, Charles Hoffman sued Maurice Glazer for stealing his magic trick.[43] Hoffman was nicknamed "Think-a-Drink Hoffman" because he performed a trick in which he would produce drinks that the audience requested out of a seemingly empty cocktail shaker.[44] Glazer began calling himself "Think-a-Drink Count Maurice" while performing Hoffman's trick.[45] The court stated that even though the act was comprised of bits of poetry, graceful gestures, and attractive stage design and lighting, the performance was not "a dramatic composition as to bring it within the meaning of the copyright act."[46] Therefore, the performance of a magic trick needs to contain more than just snippets of dramatic elements in order to be classified as a dramatic work.[47]

Since the performance of Hoffman's magic trick was not considered a dramatic work, Hoffman failed to establish that he had a valid copyright.[48] Therefore, Hoffman's copyright infringement claim failed on its face because he could not prove that the first prong of the test was met.[49]

When the performance of a trick has not been copyrighted, the court must consider whether the threshold criteria for gaining copyright protection have been met. The "two fundamental criteria. . .[are] originality and fixation in tangible form."[50] Unlike other forms of IP law, originality for copyright protection "does not include requirements of novelty, ingenuity, or esthetic merit."[51] Originality and novelty require different tests. The test of originality requires the author to contribute "something more than a 'merely trivial'

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[39] *Id.* at 1235 (quoting Kouf v. Walt Disney Pictures & Television, 16 F.3d 1042, 1045 (9th Cir. 1994).

[40] *Id.* (citing Cavalier v. Random House, Inc., 297 F.3d 815, 823 (9th Cir. 2002)).

[41] *Id.*

[42] *Id.*

[43] Glazer v. Hoffman, 16 So.2d 53 (Fla. 1943).

[44] *Id.* at 53-54.

[45] *Id.* at 54.

[46] *Id.* at 55.

[47] See Teller, 8 F. Supp. at 1233.

[48] *Id.*

[49] *Id.*

[50] H.R. Rep No. 94-1476, at 51 (1976).

[51] *Id.*

variation, something recognizably 'his own'" to a work.[52] The bar for originality is set lower than for novelty, which makes the originality standard easier to pass. In contrast, the test for novelty requires the court to ask "whether the invention was 'known or used by others in this country before his invention or discovery thereof.'"[53] Therefore, novelty requires something new while originality only requires some minimal level of creativity.

The second criterion for copyright protection requires that the work be fixed in a tangible form.[54] This requirement is met when a work "embodi[ed] in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."[55] The requirement that the work be fixed in a tangible medium is the portion of the test for copyright protection that poses problems for magicians because live magic performances are not fixed.

However, there are ways to get around the fixed requirement of federal copyright protection. Federal copyright law applies only to works in a fixed medium. [56] Therefore, states can offer common law copyright protection to works not fixed in a tangible medium without being preempted by federal law.[57] The preemption statute "explicitly preserves common law copyright protection" for works that are unfixed.[58] However, magicians have not been entirely successful in protecting their secrets from being revealed or disclosed under common law copyright.

In the "Think-a-Drink" case, Hoffman argued that his performance was "a child of his brain, created by heavy investments of time and labor, and therefore [was] an intellectual production protected by the common law."[59] Glazer took the opposite position that the trick was nothing more than "the common property of magicians" because sleight of hand performances have been performed by magicians for centuries.[60] The court disagreed with both parties' arguments and held that since Hoffman had performed the trick publicly and in front of an audience, the trick had been effectively published and became property of the general public.[61] The court rejected Hoffman's common law

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[52] Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99,103 (2d Cir. 1951)(quoting Chamberin v. Uris Sales Corp., 150 F.2d 512, 513 (2d Cir. 1945)).

[53] Elec. Storage Battery Co. v. Shimadzu, 307 U.S. 616, 621 (1939).

[54] LOSHIN, *supra* note 11, at 131.

[55] 17 U.S.C. § 101 (2018).

[56] 17 U.S.C. § 301 (2018).

[57] *Id.*

[58] H.R. REP NO. 94-1476, at 131 (1976).

[59] Glazer v. Hoffman, 16 So.2nd 53, 55 (Fla. 1943).

[60] *Id.* at 54.

[61] *Id.*

copyright claim since the law only protected unpublished works and his trick had been published due to its public performance.[62]

However, the Florida court misinterpreted the definition of "publish" because it is generally understood as distributing tangible copies of a work.[63] This decision was not supported by prior Supreme Court rulings nor does it find support in the modern definition of publication.[64] This misinterpretation of the meaning of "publish" was detrimental to Hoffman in his common law copyright claim, and is not supported by precedent.

Despite what the court held in *Glazer*, it is possible for live performances to receive common law copyright protections.[65] The composers of an act within a musical revue sued Vitaphone Corporation for copying important parts of their act.[66] The court held that even though the plaintiffs did not copyright their work with the USCO, the corporation infringed on the composers' common law copyright.[67] Therefore, while it is not guaranteed, it is possible for an unpublished dramatic work containing a magic trick or illusion to receive common law copyright protection, but it depends on the jurisdiction.

B. PATENT LAW

The goal of patent law is to reward people who have invested their time and labor into creating an invention.[68] This purpose is forwarded by patent law because it encourages inventors to invent by granting them the exclusive rights to monopolize and benefit from their inventions for a limited amount of time.[69] The productive effort made by inventors "will have a positive effect on society through the introduction of new products and processes of manufacture into the economy, and the emanations by way of increased employment and better lives for our citizens."[70]

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[62] *Id.*

[63] F. Jay Dougherty, *Now you own it, now you don't – or do you? Copyright and related rights in magic productions and performances*, *in* NON-CONVENTIONAL COPYRIGHT: DO NEW AND ATYPICAL WORKS DESERVE PROTECTION? 237, 267 (Enrico Bonadio & Nicola Lucchi eds., 2018) ("Courts have sometimes struggled with the question of what constitutes 'publication'. Certainly once physical copies of a work have been distributed to the general public, a publication has taken place.").

[64] *Id.* at 268.

[65] *See* Casino Prods., Inc. v. Vitaphone Corp., 295 N.Y.S. 501, 505 (NY 1937).

[66] Id. at 501.

[67] *Id.* at 505.

[68] W. Elec. Co. v. Milgo Elec. Corp., No. 74-1601-CIV-CA, 1976 WL 21189, at *4 (S.D. Fla. Mar. 17, 1976).

[69] A. F. Stoddard & Co. v. Dann, 564 F.2d 556, 563 (D.C. Cir. 1977)(quoting Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 480-81 (1974)).

[70] *Id.*

In exchange for the exclusive right to benefit from a legal monopoly, inventors must disclose how their inventions work.[71] When the time limit on the government granted monopoly expires, the disclosure must allow the people who were restricted from profiting from the inventions to receive the knowledge of the invention.[72]

The law requires "that the patent application. . .include a full and clear description of the invention and 'of the manner and process of making and using it' so that any person skilled in the art may make and use the invention."[73] When an inventor is granted a patent, the information contained within the patent application, including the disclosure, is circulated to the public so that it can be added "to the general store of [public] knowledge."[74] Disclosure is intended to "stimulate ideas and the eventual development of further significant advances in the art."[75]

In order for a patent to be approved by the United State Patent and Trademark Office (USPTO), an invention must fit within one of the patentable subject matters.[76] Patentable subject matters include a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."[77] The court has held that abstract principles and ideas by themselves are not patentable.[78] Therefore, if an invention does not fall into one of the subject matters listed within the statute, then it will not be granted a patent.

In addition to fitting within one of the patentable subject matters, an invention also needs to meet three more criteria in order to receive patent protection. The first requirement is that the invention must be novel.[79] An invention is novel and eligible for a patent unless:

> (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to

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[71] *Id.* at 564.

[72] *Id.* at 564(quoting United States v. Dubilier Condenser Corp., 289 U.S. 178, 187 (1933))("To insure adequate and full disclosure so that upon the expiration of the 17-year period 'the knowledge of the invention ensures to the people, who are thus enabled without restriction to practice it and profit by its use'").

[73] *Id.* (quoting 35 U.S.C. § 112 (2018).

[74] *Id.*

[75] *Id.*

[76] 35 U.S.C. §101 (2018).

[77] *Id.*

[78] Gottschalk v. Benson, 409 U.S. 63, 65 (1972)(citing Rubber-Tip Pencil Co. v. Howard, 87 U.S. 498, 507 (1874))("An idea of itself if not patentable.")(also citing Le Roy v. Tatham, 55 U.S. 156, 175 (1852))("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.").

[79] 35 U.S.C. § 102 (2018).

> the public before the effective filing date of the claimed invention; or
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> (2) the claimed invention was described in a patent issued under section 151 [35 USCS § 151], or in an application for patent published or deemed published under section 122(b) [35 USCS § 122(b)], in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention if it was not available to the public before its filing date and it was not described in a patent or application that had already been filed.[80]

The courts have held that the test for novelty is "whether the invention was 'known or used by others in this country before his invention or discovery thereof.'"[81] The requirement of novelty is a much higher standard than that required for copyright protection, which only requires originality.

The second requirement for patentability is that the invention must be nonobvious.[82] The test for nonbviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."[83]

The court looks to four factor inquiries that must be satisfied in order meet the test for nonobviousness, which are: "(1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicators of non-obviousness, more commonly termed secondary considerations."[84] Secondary considerations include "commercial success, long felt but unsolved needs, [or] failure of others… [that] give light to the circumstances surrounding the origin of the subject matter sought to be patented."[85] Obviousness is judged through the eyes of a hypothetical person with ordinary skill in the art who is "presumed to be one who thinks along the lines of conventional wisdom in the art and is not one who undertakes to innovate."[86]

The third requirement for patentability is that the invention must be useful.[87] How useful the invention is does not matter so long as the utility is not frivolous

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[80] *Id.*

[81] *See e.g.*, Elec. Storage Battery Co., 307 U.S. at 621.

[82] 35 U.S.C. § 103 (2011).

[83] *Id.*

[84] Eaton Corp. v. Parker-Hannifin Corp., 292 F.Supp.2d 555, 577 (D. Del. 2003).

[85] Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 11 (1965).

[86] Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454 (1985).

[87] 35 U.S.C. § 101 (2018).

or dangerous.[88] Therefore, the bar for utility is very low.

For an invention to be patented, it must satisfy all three requirements for novelty, nonobviousness, and usefulness.[89] An invention must also fit within the patentable subject matters set out by the statute,[90] while also satisfying the disclosure requirement.[91] Inventors must therefore jump through a lot of hoops in order to not only get their invention patented, but to also receive the reward of a government-granted monopoly.

It is not impossible for a magician to receive a patent, and in fact, a magician has been granted a patent on his magical invention. On June 12, 1923, Horace Goldin was granted a patent for a famous illusion he called "Sawing a Woman in Half."[92] Goldin patented the box that he used to create an illusion of a woman being sawed in half.[93] The court noted that "the public [had] been unable to determine the method by which the illusion [was] created and the same has therefore been in great demand."[94] Therefore, Goldin was profiting quite a bit from his invention, so protecting the secret behind his illusion was the key to insuring his continued success.[95] With the patent, Goldin was able to keep people from recreating his invention or performing his trick because he had been granted the exclusive right to monopolize his invention.[96]

The defendant, R.J. Reynolds Tobacco Company, was sued by Goldin because the company had an advertising campaign that displayed an advertisement providing an explanation of how the illusion was performed.[97] The defendant argued for the dismissal of Goldin's claim because Goldin had already voluntarily disclosed how the illusion was performed in his patent application.[98]

The court agreed with the defendant's argument and held that Goldin's patent application was a "clear and detailed expose of the secret to the public by the plaintiff himself."[99] The court also held that Goldin's patent is limited to a monopoly of the invention used to perform the trick, not the illusion itself.[100]

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[88] Converse v. Cannon, 6 F.Cas. 370, 372 (D. La. 1873).

[89] *Graham*, 383 U.S. at 11.

[90] 35 U.S.C. § 101 (2018).

[91] 35 U.S.C. § 103 (2018).

[92] Goldin v. R.J. Reynolds Tobacco Co., 22 F.Supp. 61, 62 (S.D.N.Y. 1938).

[93] *Id.*

[94] *Id.*

[95] *Id.*

[96] *Id.* at 64 (Goldin "[has] the sole and exclusive right to the performance, display and control of the trick").

[97] *Id.* at 62.

[98] *Id.* at 62-63.

[99] *Id.* at 64 (The court describes Goldin's patent No. 1,458,575 in great detail and in the disclosure Goldin clearly gives away how the trick is performed.).

[100] *Id.*

Therefore, the defendant's printed advertisement did not violate Goldin's patent.[101]

Goldin ran into a little bit of a problem with patent law's disclosure requirement. Goldin had revealed the secret behind his illusion by patenting his invention because "[a]ny one who cares to can rightfully and lawfully procure a copy of said patent, containing a full detailed and diagramed explanation of the trick, upon request made to the United States Patent Office."[102] Therefore, RJ Reynolds Tobacco Corporation "did not disclose the secret of the illusion in the advertisement" because it did not reveal to the public anything that it did not already know.[103]

A patent can protect a magician's invention of a mechanism used to create an illusion, but the monopoly on that invention comes at the price of disclosing how the illusion is performed.[104] By disclosing the secret of the illusion or magic trick in a patent application, a magician makes that secret part of the public record which can be viewed by anyone.

In order to circumvent the disclosure requirement, some magicians have described their invention very vaguely in their patent applications.[105] However, under the modern patent regime, vague disclosures can make a patent unenforceable.[106] The USTPO has a strict disclosure requirement, and therefore, there is no way for magicians to get around the issue of self-revealing their secrets when applying for a patent.[107]

C. TRADE SECRET LAW

Trade secrets are secrets that a business protects in order to keep other businesses from receiving its competitive advantage.[108] The justification for

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101 *Id.*

102 *Id.*

103 *Id.* at 65.

104 *See Id.* at 64.

105 LOSHIN, *supra* note 11, at 132 ("Describing [a magician's] innovative method of using mirrors to make 'ghosts' appear, Henry Dirks and J.H. Pepper explained unhelpfully, 'The proper angle of inclination of the glass is ascertained experimentally.'").

106 *Id.*

107 *Id.*

108 *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 (1995)("A trade secret is any information that can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others."); *see also* RESTATEMENT (FIRST) OF TORTS § 757 (1939)("A trade secret may consist of any formula, pattern, device or compilation of information which is used in one's business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it.").

protecting trade secrets is to "encourage investment in research by providing an opportunity to capture the returns from successful innovation."[109] Unlike copyright or patent law, trade secret law does not have a formal registration requirement. Therefore, when determining whether a trade secret is actually a trade secret, a court will analyze several factors.

First, the court will look to see if the trade secret is actually a secret. By definition, a trade secret has to be a secret, not just public or general knowledge.[110] However, it is important to note that secrecy is not void "if the holder of the trade secret reveals the trade secret to another 'in confidence, and under an implied obligation not to use or disclose it.'"[111] Usually, a holder of a trade secret will disclose the trade secret to employees because they need to know the business advantage the secret creates in order to use it in the course of their employment.[112]

Second, the court will look to see how a trade secret was disclosed. Trade secret law protects the disclosure or unauthorized use of the secret by those who the holder has "confided under the express or implied restriction of nondisclosure or nonuse."[113] Trade secret law also provides protection against those who gain knowledge of a trade secret through improper means such as through "theft, wiretapping, or even aerial reconnaissance."[114] However, when a secret is discovered through "fair and honest means, such as by independent invention, accidental disclosure, or by so-called reverse engineering," then trade secret law does not offer any protection because these are not improper means of discovering a trade secret.[115]

Third and finally, a court will consider the trade secret's novelty. Although a patent's requirement of novelty is not required full-stop in trade secret law, it is nevertheless an important factor.[116] Novelty is not required because "[q]uite clearly discovery is something less than invention."[117] Even though complete novelty is not required, "some novelty will be required if merely because that

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[109] RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 (1995).

[110] *See* Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 475 (1974)("The subject of a trade secret must be secret, and must not be of public knowledge or of general knowledge in the trade or business.").

[111] *Id.* (quoting Cincinnati Bell Foundry Co. v. Dodds, 10 Ohio Dec.Reprint 154, 156 (1887)).

[112] *Id.*

[113] *Id.*

[114] *Id.*

[115] *Id.*

[116] *Id.* (quoting W.R. Grace & Co. v. Hargadine, 392 F.2d 9, 14 (6th Cir. 1968)).

[117] *Id.* (quoting A.O. Smith Corp. v. Petroleum Iron Works Co., 73 F.2d 531, 538 (6th Cir. 1934)).

which does not possess novelty is usually known; secrecy, in the context of trade secrets, thus implies at least minimal novelty."[118]

Once a court determines that there is a valid trade secret, the court will then look at six different elements when analyzing a claim for misappropriation of a trade secret:

> (1) The extent to which the information is known outside the business;
>
> (2) the extent to which it is known to those inside the business, *i.e.*, by the employees;
>
> (3) the precautions taken by the holder of the trade secret to guard the secrecy of the information;
>
> (4) the savings effected and the value to the holder in having the information as against competitors;
>
> (5) the amount of effort or money expended in obtaining and developing the information; and
>
> (6) the amount of time and expense it would take for others to acquire and duplicate the information.[119]

Additionally, the holder of a "trade secret must take some active steps to maintain its secrecy in order to enjoy presumptive trade secret status."[120]

Over the years, there have been a few magicians who have claimed that their magic tricks and illusions are protected by trade secret law. In one such case, Joseph F. Harrison sought to represent a class of magicians "who claim[ed] that they were injured by [FOX Broadcasting Company's] broadcast of a special television program, *Breaking the Magicians Code: Magic's Biggest Secrets Finally Revealed*."[121] The show aired in the late 90s and featured a Masked Magician who revealed how common magic tricks were performed.[122]

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[118] *Id.* at 1883-1884.

[119] State ex rel. The Plain Dealer v. Ohio Dept. of Ins., 687 N.E.2d 661, 672 (Ohio 1997) (citation omitted).

[120] *Id.* (quoting Water Mgt. Inc. v. Stayanchi, 472 N.E.2d 715, 718 (Ohio 1984)).

[121] Harrison v. SF Broad., No. CIV. A. 98-1107, 1998 WL 355462, at *1 (E.D. La. June 30, 1998).

[122] *See generally Breaking the Magician's Code: Magic's Biggest Secrets Finally Revealed* (Nash Entertainment Nov. 24, 1997) (streaming on Netflix).

Harrison argued that the broadcast "resulted in the publication of . . . 'trade secrets' shared among the class" of magicians.[123] Harrison asserted that FOX Broadcasting "knew publishing the 'trade secrets' would do damage to the class of Plaintiffs and did so 'deliberately, brutally, wantonly, and willfully.'"[124] However, the Louisiana Uniform Trade Secrets Act did not provide a remedy for the alleged misappropriation or disclosure of the trade secrets.[125] Since trade secret law at this time was still governed exclusively by state law, the magicians in this action were flat out of luck.

The plaintiffs in the action tried to backtrack and get out of the realm of trade secret law by "urg[ing] that the term 'trade secret,' which was placed in quotations in their Petition, was meant only as an analogy and derived from the title of the Show."[126] The court gave the "Plaintiffs the benefit of the doubt that they did not invoke the Uniform Trade Secrets Act in their Petition," but their case also failed on their civil law claims.[127] Therefore, civil law and trade secret law failed to protect the secrets of the magicians who wanted to stop FOX Broadcasting from airing a show that revealed how their popular magic tricks and illusions were performed.

However, other magicians have been successful in protecting their secrets through trade secret law. Horace Goldin, the famous magician who invented the 'Sawing a Woman in Half' trick, may not have won on his earlier patent infringement claim, but he did win another case by invoking trade secret law.[128]

Goldin sued Clarion Photoplays for producing a film called "Sawing a Lady in Half" and Alexander Film for displaying photos of the film for exhibition.[129] Goldin claimed that the defendants were trying to expose the secret behind his famous illusion.[130] The court agreed that by producing the film and exhibiting the photos, the defendants' purpose was to unjustly profit from Goldin's illusion.[131] The defendants had created a film that severed a woman in half and put her back together, and their film's title and the name of Goldin's illusion

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123 Harrison v. SF Broad., No. CIV. A. 98-1107, 1998 WL 355462, at *1 (E.D. La. June 30, 1998).

124 *Id.* at *3.

125 *Id.*

126 *Id.* at *4.

127 *Id.*

128 Goldin v. Clarion Photoplays, Inc., 195 N.Y.S. 455, 460 (1922).

129 *Id.* at 457.

130 *Id.*

131 *Id.* ("[T]he conclusion cannot be escaped that the purpose of the defendants in the making and exhibition of their picture is to unlawfully and unfairly take advantage of the success which has rewarded the plaintiff's initiative and to deprive him of the fruits of his ingenuity, expense, and labor.").

were quite similar. This led the court to believe that the defendants' goal was to profit off Goldin's success.[132]

In an attempt to defeat Goldin's trade secret claim, the defendants argued that the "plaintiff [was] not the creator of a new and unusual act and did not devise the illusion in question."[133] The defendants claimed that "there [was] no novelty in the illusion" because the British Museum contained an ancient Egyptian papyrus which recounted an incident that occurred at a magical séance where a magician was able to reattach a person's severed head.[134] It was said that the trick was "accomplished by hypnotism."[135] Later versions of the trick were performed by using a dummy head, which the defendants argued made Goldin's illusion an old trick that was not a secret since it has been written down and described before.[136]

The court, however, did not find this argument very convincing because the variations of the illusion were not accomplished through similar methods as those employed by Goldin.[137] Goldin provided affidavits which established that he was, in fact, the creator of the illusion.[138] In one of the affidavits, testimony was given by Servais Le Roy, a professional magician who had been paying Goldin for a license to perform this illusion, in which he "[swore] that the production of this motion picture film [would] ruin plaintiff's performance and prevent the booking of further dates."[139]

The affidavits proved to the court that the film and the photos "[had] the effect of depreciating the value of plaintiff's act to such an extent that. . .it would render plaintiff's act absolutely valueless, since the very mystery or trick of the act would be gone."[140] Therefore, it was contended that if the film or photos were shown in the same town where the plaintiff was performing, then he would have necessarily had to cancel his act.[141]

The court held that Goldin successfully "established that he is the originator of the illusion in question. . .and that his creation of the illusion has been so universally recognized that the title thereof is in the public mind associated with

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132 *Id.*

133 *Id.*

134 *Id.*

135 *Id.*

136 *Id.*

137 *Id.* at 458.

138 *Id.* ("Harry Houdini… states that, so far back as his memory and records go, he is positive that he never witnessed a production of the illusion 'Sawing a Woman in Half' by any one other than the plaintiff.").

139 *Id.* at 458-459.

140 *Id.* at 459.

141 *Id.*

his own name."[142] The court recognized that Goldin deserved protection because "[t]he result of his ingenuity and skill has been to produce for him very large financial returns, with a reasonable prospect of their continuance for a long time to come."[143]

The court did not explicitly state that the illusion was subject to trade secret protection but rather protected Goldin's rights under the broad idea of unfair competition.[144] The court held that "the defendants have simply sought unfairly and unjustly to profit by plaintiff's success, by adopting the name which he gave to his illusion, and by copying his methods in an unfair competition and unreasonable interference with plaintiff's rights, which the courts should and will prevent."[145] Although the court did not formally recognize Goldin's illusion as a trade secret, the court did, however, recognize that the secret was valuable and that Goldin had taken reasonable steps to protect his secret, which was enough to qualify the illusion as a valid trade secret.[146]

While the court in Goldin's case was somewhat reluctant to formally protect his illusion under trade secret law, there was a magician who was able to get a court to *explicitly* state that his magic trick was subject to trade secret law. The world-famous magician David Copperfield was sued by a participant in his magic trick, the "Thirteen."[147] During a performance of the "Thirteen" in his Las Vegas show, an audience member, Gavin Cox, was injured while participating in the illusion. The trick is performed by selecting thirteen random audience members. The participants are seated on a platform that is elevated above the stage, and then a curtain falls around them, obscuring them from view. Flashlights are given to the participants, and they shine their lights through the curtain so the audience believes that the participants are still seated on the elevated platform. Then, *abracadabra*! The curtain falls and the participants magically appear in the back of the theater!

Unfortunately Gavin Cox suffered brain and other related injuries when he fell while participating in the "Thirteen" trick.[148] Stagehands had allegedly told Cox to run "through an outdoor alleyway that his lawyers say was coated with construction dust."[149] In order to receive compensation for the injuries he

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142 *Id.*

143 *Id.*

144 *Id.* at 460.

145 *Id.*

146 Id. at 456.

147 David Copperfield's Disappearing, Inc. v. Eighth Judicial Dist. Court in & for Cty. of Clark, No. 75609, 2018 WL 2045939, at *1 (Nev. App. Apr. 20, 2018).

148 *Jury: David Copperfield Not Liable for Tourist's Injuries*, CNBC (May 30, 2018), https://www.cnbc.com/2018/05/30/jury-david-copperfield-not-liable-for-tourists-injuries.html.

149 *Id.*

sustained, Cox filed suit in the Eight Judicial District Court of the State of Nevada against David Copperfield and the companies involved in the production of the magic show.[150] Cox argued that the defendants negligently failed to maintain the premises, acted "knowingly, willfully and maliciously, with a conscious disregard for [his] safety", and negligently hired, trained, and supervised their employees.[151]

In response, the defendants contend that Cox's negligence in failing to watch his step exceeded their own negligence, if they were even negligent at all, and therefore Cox should be barred from recovering any damages.[152] The defendants also argued that they should not be held liable for Cox's injuries because those injuries were not caused by the defendants' actions, but rather were the result of third party negligence.[153]

After hearing all the evidence, the jury decided in favor of the defendants.[154] The jury recognized that by a preponderance of the evidence the defendants did act negligently, but their negligence was not the proximate cause of the accident.[155] Instead, the jury decided that Cox's own negligent conduct was the proximate cause of the accident, and so Cox was barred from recovering any damages.[156]

This case put the performance of the trick at the center of litigation. Throughout the trial, it was very important for Copperfield to protect the secret behind his trick, and although he could not keep the secret from the jury, judges, and lawyers, he could keep it off the trial's public record.[157] During litigation, Copperfield petitioned for a writ of mandamus "challeng[ing] a district court order denying [his] request to close the portions of the trial during which alleged trade secrets concerning the 'Thirteen' illusion [were] presented."[158] The court recognized that it was unusual to close a courtroom, but that "doing so [was] appropriate in certain circumstances, such as when a competing interest outweighs the public interest in open trials."[159]

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[150] Complaint and Demand for Jury Trial at 1, David Copperfield's Disappearing, Inc. v. Eighth Judicial Dist. Court in & for Cty. of Clark (2018) (No. 75609).

[151] *Id.* at 5-9.

[152] Amended Answer to Plaintiffs' Complaint and Cross-Claim Against Team Construction Management, Inc. at 6, David Copperfield's Disappearing, Inc. v. Eighth Judicial Dist. Court in & for Cty. of Clark (2018) (No. 75609).

[153] *Id.* at 7.

[154] Verdict at 1-4, David Copperfield's Disappearing, Inc. v. Eighth Judicial Dist. Court in & for Cty. of Clark (2018) (No. 75609).

[155] *Id.*

[156] *Id.*

[157] David Copperfield's Disappearing, Inc., No. 75609, 2018 WL 2045939, at *2.

[158] *Id.*

[159] *Id.*

The court noted the protection of trade secrets is a competing interest that outweighs the public interest of an open trial.[160] The court also recognized that the state law of Nevada "protects against the public disclosure of trade secrets during litigation."[161] The court held that the "information concerning how the 'Thirteen['] and other illusions are performed constitutes a trade secret, at least to the extent that that information is not public knowledge."[162] The participants in the illusion were even asked to sign confidentiality agreements before participating, which proves that David Copperfield took steps to insure the protection of his trade secret.[163] Even though many audience members have participated in the trick over the years, the secret behind the trick is still kept under wraps because "the participants are made aware of only some portions of the trick."[164]

Furthermore, the disclosure of how the whole trick is performed "could result in irreparable harm" for David Copperfield.[165] The court held that since revealing the secret behind the performance of the "Thirteen" could cause harm to Copperfield, "good cause exist[ed] to close the portions of trial during which such information could be revealed."[166] As a result, throughout the course of litigation, the court was closed when "information that has not yet been made public or that overlaps with information that has not been made public" was being discussed.[167]

David Copperfield was successful in protecting the secret behind the performance of the "Thirteen" because the court recognized that Copperfield possessed a secret, something not generally known by the public, that was of value and that he had taken reasonable steps to protect.[168] In a case like this, the court was interested in protecting Copperfield's innovation and ingenuity. Therefore, the court protected against disclosure of Copperfield's secret so that he could continue to profit from his trade secret.[169]

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[160] *Id.* (citing Publicker Indus. V. Cohen, 733 F.2d 1059, 1071 (3d Cir. 1984)) ("'[T]he protection of a party's interest in confidential commercial information, such as a trade secret, where there is sufficient threat of irreparable harm,' weighs against the presumptive right to an open trial").

[161] *Id.* (citing NRS 600A.070) ("In any civil or criminal action, the court shall preserve the secrecy of an alleged trade secret by reasonable means.").

[162] *Id.*

[163] *Id.*

[164] *Id.*

[165] *Id.*

[166] *Id.*

[167] *Id.* at *2.

[168] *Id.*

[169] *Id.* at *1.

III. ANALYSIS

The Background section of this Note illustrates that magicians have had a difficult time using traditional IP laws to protect their magical secrets. Copyright, patent, and trade secret laws each have pros and cons when it comes to protecting a magician's secrets. However, upon further analysis of these types of IP laws, it is clear that trade secret law provides the most appropriate form of IP protection for magicians.

Copyright law may seem like a very attractive form of IP protection for magicians since the world-famous magician Teller was successful in protecting his illusions through the use of copyright law.[170] However, copyright law has two major drawbacks. First, copyright law only provides protection for magicians who are able to fix their performance in a tangible medium, like film. Second, the law does not recognize magic tricks and illusions as copyrightable subject matters within the statute.[171]

A problem posed by copyright law is that a magician's performance of his tricks and illusions are not always necessarily fixed in a tangible form as the law requires. If a magician is a street or stage performer then their magic tricks may not be fixed in a tangible medium, like within a video recording. In the modern digital age, fixation may not pose a huge problem for most magicians because they are likely to have access to a cell phone that can create an instant video recording. Even so, the fixation requirement of copyright protection may pose a problem for some magicians who do not have access to a device that can make video recordings.

Even if a magic trick or illusion is fixed in a tangible medium, there is no guarantee that it will receive copyright protection because magic tricks and illusions do not fall within the scope of copyright's protectable subject matters.[172] As the courts have stated, a magic trick or illusion, in and of itself, is not a subject matter protectable under copyright law.[173] This requirement of copyright protection is the main obstacle for magicians to overcome. In order to receive copyright protection, magicians will have to disguise their magic tricks or illusions as dramatic works, which is precisely what Teller had to do in order to win his lawsuit.[174]

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[170] *See* Teller v. Dogge, 8 F.Supp.3d 1228 (D. Nev. 2014).

[171] *See* 17 U.S.C. § 102 (2018).

[172] *Id.*

[173] *See Id.*; *See also* 17 U.S.C. § 102 (2018)(Listing the subject matter protected by copyright law).

[174] *See Teller*, 8 F.Supp.3d at 1233 ("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;" thus, it fell within the subject matter of a dramatic work.).

To receive copyright protection, magicians will have to make an effort to add dramatic elements to their magic tricks and illusions in order to disguise their magical performances as dramatic performances. However, if such an effort is made, there is still no guarantee that the court will consider a magician's magic trick or illusion to fit the definition of a dramatic work. In the case of 'Think-a-Drink Hoffman,' the court held that the performance of his magic trick, even though it was comprised of bits of poetry, graceful gestures, and attractive stage and lighting design, could not be deemed a dramatic work.[175]

Even if magicians are able to convince the court that their magic tricks or illusions are dramatic works, copyright law only protects against the copying of the performance, not magic trick or illusion. The elements of a copyright infringement claim are that (1) the plaintiff has a valid copyright; and (2) the defendant copied the original elements of the work.[176]

The court will determine whether the original and copied work are substantially similar by determining whether an ordinary observer would be able to point to both works as having the same aesthetic appeal.[177] The court has noted that ideas, concepts, themes, and scenes-a-faire are not copyrightable elements.[178] Thus, if a copycat magician learns the secret to another magician's magic trick and is able to copy it without copying the aesthetic appeal of the performance, the magician who invented the trick would most likely not be successful in a suit for copyright infringement. Therefore, copyright law falls short of actually protecting magicians' secrets because it only protects their performance of their magic tricks or illusions.

Patent law is probably the last choice of IP protection for magicians who are seeking to protect their secrets. In fact, patent law does the exact opposite of protecting a magician's secret because filling out a patent application requires the magician to disclose the secret behind their magic trick or illusion.[179] Furthermore, once a patent application is filed with the USPTO, it becomes a part of the public record for anyone to access.[180] Intuitively, it seems that it is problematic for magicians to have to describe and disclose the secrets to their illusions in a patent application. While such a disclosure requirement would not be as explosive if the application was kept confidential until the patent's protection expired, the application nevertheless becomes a part of the public record once it is submitted. This means that anyone can access that information and discover how a magician's new trick or illusion is performed.[181]

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175 Glazer, 16 So.2d 53, 55.

176 *See Teller*, 8 F.Supp.3d at 1233.

177 Horgan v. Macmillan, Inc., 789 F.2d 157, 162 (2d Cir. 1986).

178 *Teller,* 8 F.Supp.3d at 1235.

179 *See* A.F. Stoddard & Co. v. Dann, 564 F.2d at 556, 564 (D.C. Cir. 1977).

180 *Id.*

181 *Id.*

The magician, Goldin, who invented Sawing a Woman in Half, learned firsthand how the disclosure requirement of patent law can be a huge problem for magicians who are trying to protect their secrets. By submitting the patent application, Goldin ultimately revealed the secret of how his trick was performed, and so he could not stop people from sharing his secret.[182] Therefore, if magicians want to patent his magic trick or illusion, they will have to publicly disclose how their tricks or illusions are performed, which is exactly the opposite of what most magicians are trying to accomplish when seeking out IP protection.

A patent may not keep the secret of an illusion or magic trick from being revealed, but it will keep others from unlawfully duplicating the mechanism that is employed to perform a magician's magic trick or illusion.[183] So even though a copycat magician knows the secret behind a magician's magic trick or illusion, they cannot copy the trick by using the mechanism or process that the magician patented, which makes it harder for the copycat to perform the copied trick. However, the patent protection will eventually expire, and then, any magician can use the patented mechanism to perform the magic trick or illusion.

By the same token, the average audience member, who is not seeking to profit from a magic trick or illusion, will most likely not take the time to look up a magician's patent application. People are notoriously lazy and most likely will not spend their time combing through the USPTO's database for a magician's patent application. Therefore, in reality, many people would not know how a magic trick or illusion is performed even if a magician procures a patent. This more salient issue then stems less from audiences becoming aware of how a trick is performed and more from other magicians who try and capitalize on the original magician's hard work in creating the illusion.

When magicians are seeking to protect their secrets, copyright and patent laws should not be their first choice. Trade secret law is the most appropriate form of IP law for magicians seeking to protect their secrets for four reasons. First, magicians have a valid trade secret because they have a secret that is valuable and they take reasonable steps to protect those secrets.[184] Second, their secrets are not publicly or generally known, which further reinforces the notion that they harbor valid trade secrets.[185] Third, trade secret law protects against the disclosure or unauthorized use of the secret by those who the holder has confidentially shared the secret with.[186] Finally, trade secret law also protects against others gaining the knowledge of a secret through improper means.[187]

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182 Goldin v. R.J. Reynolds Tobacco Co., 22 F.Supp. at 61, 64 (S.D.N.Y. 1938).

183 *Id.*

184 *See* State ex rel The Plain Dealer, et al. v. Ohio Dept. of Ins. et al., 687 N.E.2d 661, 672 (Ohio 1997).

185 *See* Kewanee Oil Co. v. Bicron Co., 416 U.S. 470, 475 (1974).

186 *Id.*

187 *Id.*

In order to have a valid trade secret, a person must have a secret that is economically valuable and worth legal protection.[188] In most cases, magicians hold many secrets that are economically valuable. Forbes published a list of the highest paid celebrities in 2018, and David Copperfield ranked 33rd in a tie with celebrity chef Gordon Ramsay and in one spot above the legendary Beyoncé Knowles.[189] Just the fact that David Copperfield made more money than Beyoncé in 2018 proves that a magician's secrets have the potential to be very valuable.

When determining whether a secret should be afforded trade secret protection, the court will look to whether the trade secret holder took reasonable steps to protect their secret.[190] Generally, magicians are willing to create and share their secrets within the magic community.[191] Magicians will share common and popular magic with just about anybody who is willing to pay for those secrets; the former type of magic is common tricks and illusions for amateur and professional magicians and the latter is amateur stuff that anyone can walk into a magic shop and buy.[192] But "the really good and innovative stuff among the magic world's top performers," called "proprietary" magic, is shared selectively.[193]

The really juicy secrets of the magic community are shared only among professional magicians. For example, Goldin allowed another professional magician, Servais Le Roy, to perform Sawing a Woman in Half under a license that required Le Roy to pay Goldin $250 per week.[194] The magic community respects magicians who invent and teach others their secrets.[195] Since the magic community has occupied a realm outside of IP protection, magicians created a community that "internalize[s] a handful of common norms that govern how secrets, techniques, and presentations are to be treated."[196] Among these norms is the rule to "[n]ever expose a secret to a non-magician."[197]

Magicians' organizations, like the International Brotherhood of Magicians or London's Magic Club, enforce the community's norms.[198] A magician that "behav[es] badly may not be invited to give lectures, invited to perform in magic

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188 *Id.*

189 *The World's Highest-Paid Entertainers*, FORBES (July 16, 2018, 10:00 AM), https://www.forbes.com/celebrities/#623d73d35947.

190 *State ex rel The Plain Dealer et. al.,* 687 N.E.2d at 672.

191 LOSHIN, *supra* note 11, at 127.

192 *Id.*

193 *Id.*

194 Goldin v. Clarion Photoplays, Inc., 195 N.Y.S. 455, 458 (1922).

195 LOSHIN, supra note 11, at 136.

196 *Id.*

197 *Id.* at 137.

198 Id. at 136.

competitions, or featured in magic trade publications," and in some extreme cases, the poorly behaved magician can even be shunned from the community and blackballed from performing.[199]

Therefore, the magic community is determined to deter magicians from stealing or unethically sharing secrets through internal policing. A requirement of trade secret law is that the holder of a secret must take reasonable steps to prevent the secret from being revealed. Most professional magicians within the magic community are policing each other to make sure that secrets stay with their creators and those that their creators have confidentially shared secrets with.

For a secret to be protected by trade secret law, it also has to be a secret that is not publicly or generally known.[200] A magician who creates a new and innovative magic trick or illusion usually possesses a secret that is not public or general knowledge. Oftentimes, a new trick or illusion will not even be considered general knowledge within the magic community. Therefore, a magician with a new trick or illusion can have a secret that is protected by trade secret law.

Trade secret law is the best form of IP protection for magicians because it actually protects secrets. Once it is established that a magician has a trade secret, the law will protect the disclosure or unauthorized use of the secret by those who the holder has confidentially shared the secret with.[201] For example, Goldin could have taken legal action against his licensee, Le Roy, if he had disclosed the secrets Goldin had confidentially revealed to him on how to perform Sawing a Woman in Half. If Le Roy had told every magician in town how to perform Sawing a Woman in Half, Goldin most likely would have been able to sue Le Roy for misappropriating his trade secret. Trade secret law offers protection against "express and implied restrictions of nondisclosure."[202]

Trade secret law also protects against misappropriation of a trade secret that was learned through improper means like "theft, wiretapping, or even aerial reconnaissance."[203] For example, if someone stole a magician's confidential files and read a description of how to perform a trick and thus, discovered how to perform it himself, that would be an unlawful misappropriation of a trade secret. The magician, in such a case, would most likely have legal recourse against the thief through trade secret law. Since trade secret law actually protects against the unlawful use or disclosure of trade secrets and the unlawful discovery of secrets through improper means, it is the best form of IP protection for magicians seeking to protect their secrets.

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199 *Id.* at 138.

200 *See generally* Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 480-81 (1974).

201 *See Kewanee Oil Co.*, 416 U.S. 470.

202 *Id.*

203 *Id.*

There is, however, one major drawback to trade secret law. If a secret is discovered through "fair and honest means, such as independent invention, accidental disclosure, or by so-called reverse engineering," trade secret law does not offer any protection against the secret's use or disclosure.[204] For example, if someone studies a video of a magician's performance and is able to figure out how the trick is performed and performs it himself, then he is able to perform that trick without the magician having any legal recourse against him. This fact is not necessarily damning for magicians because if a trick or illusion is really innovative and unique, it will be difficult for others to reverse engineer.

All in all, magicians who are seeking to protect their magical secrets through IP protection should do so through trade secret law. Trade secret law is the most appropriate form of protection because magicians already possess trade secrets. Magicians have secrets that are valuable and not general or public knowledge, and magicians take reasonable steps to protect their secrets. Trade secret law also provides protection against the unlawful disclosure or use of secrets and the discovery of those secrets through unlawful means. The only drawback to trade secret law is that magicians will not have legal recourse against those who honestly discover how magic tricks or illusions are performed without using unlawful means. However, this drawback to trade secret law may encourage magicians to become more innovative in order to make it more difficult for people to honestly discover the secrets to performing their magic tricks and illusions.

IV. CONCLUSION

Magicians operate in a grey area on the brink of traditional IP protection. Magicians have attempted to use copyright, patent, and trade secret laws to protect their secrets with varied success. Since magic tricks and illusions do not fit within a copyrightable subject matter, magicians must disguise their magic tricks and illusions as dramatic works in order to receive protection. But even if magicians go through the trouble of masking their tricks or illusions as dramatic works, the court may still decide that the trick or illusion did not contain enough dramatic elements to qualify as a dramatic work protectable by copyright law.

Patent law does the exact opposite of protecting a magician's secret. Since patent law requires the disclosure of how the trick or illusion is performed, the secret behind the magic trick or illusion becomes part of the public record once the patent application is filed. Therefore, if a magician receives patent protection, then anyone who cares can take the time to look up the patent application and discover the secret behind the magic trick or illusion.

Trade secret law is the most appropriate form of IP protection for magicians because trade secret law protects secrets. Magicians have valid trade secrets because they have secrets that are economically valuable and not general or

[204] *Id.*

public knowledge, and magicians take reasonable steps to protect their secrets. Trade secret law protects a magician's secrets from being unlawfully used or disclosed by those the magician has confidentially shared the secret with, like a magician's assistant, employee, or licensee. Trade secret law also protects a magician's secret from being discovered through improper means like theft. Therefore, trade secret laws offer the most robust protections for a magician's tricks, so more magicians should try to utilize trade secret laws to keep audiences guessing how a trick is performed each time they yell, "Abracadabra!"