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THOUGHTS ON DASTAR FROM A COPYRIGHT PERSPECTIVE: A WELCOME STEP TOWARD RESPITE FOR THE PUBLIC DOMAIN

Lynn McLain

I. INTRODUCTION

Suppose you are an artist or an author of some type: for example, a writer, a filmmaker, a sculptor, an architect, a composer, a designer of computer software, or even a designer of needlepoint patterns. You want to build on something that is "in the public domain," that is, it is not protected by a copyright or a patent.1

Perhaps you want to incorporate a copy of "the Mona Lisa" in a collage or an advertisement, or write a modernized version of The Tales of Huckleberry Finn (much as West Side Story is a modernized version of Romeo and Juliet).2 Maybe you want to take an early twentieth century women's suffrage poster, on which the copyright has expired, and reproduce it on posters for your lecture on women's rights, or as a dust cover on your book on the same topic. You may wish to make and sell copies of old silent movies, to which you have added sound tracks. Or you may wish to copy a centuries old mosaic tile design you have found on a church floor and make it into a needlepoint pattern.

You assume that, because the underlying works are in the public domain, they must be freely useable by anyone. You proceed as above, and you are sued. If you are not able to have the case against you quickly dismissed, then the public domain is not as free and "public" as it ought to be (and as it must be, in order to achieve its intended goal).

Over the past few decades, serious encroachments on the public domain have developed, particularly through the burgeoning growth in some American jurisdictions of causes of action under § 43(a) of the federal Lanham Act for "passing off" and "reverse passing off,"3 as well as through a state law "right of publicity," which protects a person's name, likeness, persona, and voice, and even imitations of a person's voice, from commercial use.4 If the right of publicity applied, you could not copy "the Mona Lisa" without her heirs' consent (assuming her identity could be proved), despite the fact that the painting is not protected by copyright.

1 Professor and Dean Joseph Curtis Fellow, University of Baltimore School of Law. The author wishes to express her appreciation to Steven L. Goldberg, Jr., J.D. 2004, for his research assistance.


4 See infra notes 41-53 and accompanying text.
Even if you had obtained consent from the painting’s subject, suppose you reproduced the painting. If the plaintiff had prevailed in the recent case of *Dastar Corp. v. Twentieth Century Fox Film Corp.*, so that § 43(a) of the Lanham Act (which prohibits, *inter alia*, false or misleading designations or representations regarding the origin of goods) applied, you would have to credit Leonardo da Vinci, even though the work was in the public domain. Yet, if your copies were not as high quality as da Vinci’s (which seems highly likely, if not inevitable), crediting him might also violate § 43(a). You would find yourself in a “lose-lose” situation. To add to your predicament, if § 43(a) were applicable, but you had made changes so that the work was neither totally da Vinci’s nor totally yours, how would you determine whom you should credit, and how?

Thus both a broadly defined right of publicity and a broad reading of § 43(a) would create barriers to the facile use of items in the public domain. Such interference would thwart the underlying purpose of the United States Constitution’s copyright and patent clause: facilitation of the growth of knowledge.

In its recent decision in *Dastar*, the United States Supreme Court held that § 43(a) provides no right of attribution to the creator of an underlying or original work when that work is in the public domain and is copied by another. In that event, the manufacturer of the copies may designate itself as the source of the copies. The Court did a good day’s work, stemming one of the leaks that have been draining the public domain.

Though other questions remain unresolved and other leaks unstemmed, *Dastar* is a welcome step towards regaining the public domain, and towards establishing that the confines of the public domain, with regard to nondeceptive reproduction of public domain works, and preparation of derivative works based upon them, must be delimited by only the copyright and patent laws.

This article will provide a background discussion of the copyright and patent schemes and their delineation of the public domain. It then will discuss the role of trademark law in that balance, and some of the case law regarding both § 43 of the Lanham Act and the right of publicity. Finally, it will hail the Supreme Court’s decision in *Dastar* as a hopeful sign that the Court will reject the approach of the more expansive cases that have hampered the free use of works in the public domain.

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5 539 U.S. 23 (2003), on remand, 2003 WL 22669587, 68 U.S.P.Q.2d 1636 (C.D. Cal. 2003) (granting defendant’s motion for summary judgment; no violation of California unfair competition law regarding reverse passing off, because California law is congruent with Lanham Act, as to which the Supreme Court’s decision had changed the law).

6 See infra note 43.

7 See infra notes 10-13 and accompanying text.
II. THE COPYRIGHT AND PATENT SCHEMES AND THEIR RELATION TO THE PUBLIC DOMAIN

American copyright and patent law is intended to promote knowledge by rewarding authors and inventors of deserving works with limited monopolies for limited times, after which those works fall into the public domain. The United States Constitution gives Congress the power to "promote the Progress of Science" (in the sense of the Latin "scientia," meaning "knowledge") and "the useful Arts" (in the sense not of "fine arts" but of inventions, useful to artisans) by granting copyrights and patents to authors and inventors for their writings and inventions. The Constitution dictates that these intellectual property rights last only "for limited Times," so that at the end of the copyright or patent term, the writing or invention will be in the public domain, free for all to use.

The intellectual property rights created by Congress are seen as carrots, economic rewards, to encourage (1) the creation of writings and inventions, (2) their disclosure to the public through publication or registration with the Copyright Office or Patent Office, and, eventually, (3) their complete descent into the public domain. All three steps flow ineluctably toward the growth of knowledge, which is the primary goal of the copyright and patent clause. Subsequent authors and inventors build upon publicly disclosed earlier works, hastening our progress.

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8 U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have Power . . . [t]o 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.").

9 Eldred v. Ashcroft, 537 U.S. 186, 189 (2003). See L. Ray Patterson & Craig Joyce, Copyright in 1791: An Essay Concerning the Founders' View of the Copyright Power Granted to Congress in Article I, Section 8, Clause 8, of the U.S. Constitution, 52 EMORY L.J. 910, 952 (2003) (concluding that the Founders "viewed copyright as a positive law, not a natural law, concept" and that they incorporated the "for limited Times" provision in the Copyright Clause so that Congress could make the period of copyright monopoly "long enough to provide a profit but short enough to protect the public domain").

10 E.g., Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984) ("The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired. ‘The copyright law, like the patent statute, makes reward to the owner a secondary consideration. In Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932), Chief Justice Hughes spoke as follows respecting the copyright monopoly granted by Congress, ‘The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.’ It is said that reward to the author or artist serves to induce release to the public of the products of his creative genius.’ United States v. Paramount Pictures, 334 U.S. 131, 158 [1948].").

11 Id. See Kimberly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1453 (Fed. Cir. 1984) ("[I]t has been unusual that opinions have explained the real reason for the denial
Congress – or its designees, the Copyright Office and the Patent and Trademark Office – establishes the standards that a writing or invention must meet in order to be copyrightable or patentable. If a work achieves these marks, it will be protected for the applicable term of years designated by Congress, at the end of which it will fall into the public domain. If a work falls short of these standards, a disclosed writing or invention will fall into the public domain, as long as it is not protected as another form of patent rights, which is the basic principle (to which there are minor exceptions) that no patent should be granted which withdraws from the public domain technology already available to the public.”)

12 Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 228-29 (1964) As the Sears court explained:

Thus the patent system is one in which uniform federal standards are carefully used to promote invention while at the same time preserving free competition. [fn. The purpose of Congress to have national uniformity in patent and copyright laws can be inferred from such statutes as that which vests exclusive jurisdiction to hear patent and copyright cases in federal courts, 28 U.S.C. § 1338(a), and that section of the Copyright Act which expressly saves state protection of unpublished writings but does not include published writings, 17 U.S.C. § 2.] Obviously a State could not, consistently with the Supremacy Clause of the Constitution, extend the life of a patent beyond its expiration date or give a patent on an article which lacked the level of invention required for federal patents. To do either would run counter to the policy of Congress of granting patents only to true inventions, and then only for a limited time. Just as a State cannot encroach upon the federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objections of the federal patent laws.

* * *

Doubtless a State may, in appropriate circumstances, require that goods, whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to the source, just as it may protect businesses in the use of their trademarks, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as to the source of the goods. But because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying.

Id. at 230-33 & n.7. Sears and its companion case, Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 237 (1964), are hereinafter referred to as “Sears-Compco.” Sears-Compco, 376 U.S. at 230-31 (“Finally, and especially relevant here, when the patent expires the monopoly created by it expires, too, and the right to make the article - including the right to make it in precisely the shape carried when patented - passes to the public.”). See Sony Corp., 464 U.S. at 429 (“As the text of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors or to inventors in order to give the public appropriate access to their work product. Because this task involves a difficult balance between the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society’s competing interest in the free flow of ideas, information, and commerce on the other hand, our patent and copyright statutes have been amended repeatedly.”).
intellectual property (particularly, trade secret\textsuperscript{14} or trademark\textsuperscript{15}) that is not preempted by the copyright/patent clause.

States may protect intellectual property,\textsuperscript{16} as long as they do not upset the balance that Congress has established between what is copyrightable or patentable and what is not.\textsuperscript{17} This means, as held by the Supreme Court in \textit{Sears-Compco} and expanded upon by \textit{Goldstein}, that states cannot create the equivalent of a copyright or patent with regard to subject matter as to which Congress has established national standards.\textsuperscript{18} Otherwise, the states could affect what goes into or is held back from the public domain. The states cannot hold such power, or Congress would be unable to achieve the mission assigned it by the Constitution.

For example, for a published idea or process to be kept out of the public domain, it must achieve federal patent protection. Section 102(b) of the federal Copyright Act of 1976 explains that copyright cannot extend to an idea or process.\textsuperscript{19} Therefore, state law cannot provide copyright-like protection for ideas or processes either.\textsuperscript{20} If the states could do so, ideas and

\textsuperscript{15} Trade-Mark Cases, 100 U.S. 82, 99 (1879). Trademarks are protectible under both federal law (the Lanham Act, 15 U.S.C. §§ 1125(a)) and state law.
\textsuperscript{17} \textit{See Sears-Compco}, 376 U.S. at 231 & n.7 and at 238-39 (1964); \textit{Goldstein} v. California, 412 U.S. 546, 569-70 (1973) (“The standards established for granting federal patent protection to machines thus indicated not only which articles in this particular category Congress wished to protect, but which configurations it wished to remain free. The application of state law in these cases to prevent the copying of articles which did not meet the requirements for federal protection disturbed the careful balance which Congress had drawn and thereby necessarily gave way under the Supremacy Clause of the Constitution. No comparable conflict between state law and federal law arises in the case of recordings of musical performances [first fixed before February 15, 1972, the effective date of the Second Recording Amendment to the Copyright Act]. In regard to this category of “Writings,” Congress has drawn no balance; rather, it has left the area unattended, and no reason exists why the State should not be free to act.”). \textit{See infra} note\textsuperscript{20}.
\textsuperscript{18} \textit{Sears-Compco}, 376 U.S. at 231 and at 237 (1964); \textit{Goldstein}, 412 U.S. at 569-70 (1973). \textit{See} 17 U.S.C. § 301(a) (2002) (“On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.”).
\textsuperscript{19} 17 U.S.C. § 102(b) (2002) (“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.”).
\textsuperscript{20} United States \textit{ex rel.} Berge v. Bd. of Trs. of Univ. of Ala., 104 F.3d 1453, 1463 (4th Cir. 1997) (“the shadow actually cast by the [Copyright] Act’s preemption is notably broader than the wing of its protection”); Selby v. New Line Cinema Corp., 96 F. Supp. 2d 1053,
processes that had not achieved federal patent protection could be removed from the public domain.

Section 102(a) of the Copyright Act provides for the copyrightability of protectible expression in original works (including literary works) that are fixed in a tangible medium of expression. Therefore, state law cannot provide copyright-like protection for fixed (written down, taped, or recorded) literary works. A literary work that is fixed may achieve copyright protection only by complying with the federal Copyright Act, and only for the time prescribed by that Act. Failure to achieve protection under the Act—for example, by lack of originality—will result in the work’s falling into the public domain once it is made public.

Once even a copyright-protected original fixed work is published by the author, the ideas and processes contained and described in it fall into the public domain (unless protected by patent). Protection of those facets of a published writing may be obtained only via a patent, as to which Congress has established high standards.

If the inventor chooses to keep the process or idea secret, however, it may be protected as a trade secret, under state law. The United States Supreme Court has held that state trade secret protection is not the equivalent of a patent and, therefore, is not preempted by either the copyright and patent clause or the supremacy doctrine.

Section 301 of the Copyright Act of 1976 codified the Supreme Court's holdings, including those in Sears-Compco and Goldstein, with regard to state law protection of types of works falling within the subject matter of copyright. Section 301(a) provides:

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1061-62 (C.D. Cal. 2000) (§ 102(b)'s provision that copyright does not extend to ideas creates a balance, so that ideas flow into public domain; implied-in-fact contract claim for ideas in copyrighted screenplay was preempted).

17 U.S.C. § 102(a)(1) (2002) ("Copyright 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 . . .").

E.g., Rosciszewski v. Arete Assocs., 1 F.3d 225, 232-33 (4th Cir. 1993) (Virginia Computer Crimes Act, which would have punished the reproduction of appellant's ORBIS computer software, is preempted by the Copyright Act of 1976).

Baker v. Selden, 101 U.S. 99, 102-03 (1879) ("To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government. * * * By publishing the book, without getting a patent for the art, the latter is given to the public.").

Id.

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.\textsuperscript{26}

A state may not provide protection equivalent to copyright for fixed works.

A Copyright Office regulation provides that “short phrases” are “not subject to copyright.”\textsuperscript{27} We do not want to remove such basic building blocks from the public domain.\textsuperscript{28} They must be fully available to use in new writings. Yet short phrases and logos that may not be copyrightable may enjoy trademark protection under either state or federal law or both, when trademark law is not equivalent to copyright law. Trademark protection has been held to be generally different in kind from copyright and patent protection.\textsuperscript{29} Trademark law does not necessarily prevent the reproduction of a work; it generally merely protects consumers from being misled as to the source of the copy.

III. THE ROLE OF TRADEMARK LAW

Like copyright and unlike patent, trademark protection does not prevent others from copying an underlying idea or process. But unlike copyright, trademark does not generally prevent others from copying the particular words or symbols that constitute a trade name, slogan, or logo. Under trademark law, copying is precluded only where the copying would


\textsuperscript{27} 37 C.F.R. § 202.1(a) (2002).

\textsuperscript{28} See, e.g., John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986) (upholding Copyright Office’s refusal to register a sports team’s logo).

\textsuperscript{29} See, e.g., J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 6:1 (2002).
create confusion among consumers as to the source of a good or service. Trademark protection will last as long as the mark is recognized by the consuming public as signifying a particular source of the good or service. It thus can last perpetually.

For example, trademark law provides that a cola drink sold by Howard Johnson's cannot be called Coca-Cola when it was not made by the Coca-Cola Company. But it can be called HoJo’s Cola, as the word “cola” has become generic, describing a brown, carbonated soft drink. A clock not manufactured by Rolex could not be labeled “Rolex” without violating the trademark on Rolex watches, as consumers are likely to be misled into thinking that the clock will have been manufactured by the manufacturer of the watch. But a cheap brand of tire could probably be called “Roll-X” without impinging on the watch manufacturer’s trademark or that of the manufacturer of the antacid tablet, Rolaids. Consumers are unlikely to think that the tires emanate from the same source as either the watches or the pills. And a poet could wax poetic about Rolexes, Roll-X’s, and Rolaids, without misleading the public as to the origin or source of the poem.

As “good fences make good neighbors,” clear lines of demarcation between copyright, patent, trade secret, and trademark protection ensure that the realms of the first two – and the concomitant expanse of the public domain when works fail to achieve copyright or patent protection, or when that protection expires – are not encroached upon. A copyright cannot protect an idea or process, but can protect its literary explanation. A patent can protect the useful aspects of an invention, but not its literary description. The title of a novel is not protected by the novel’s copyright, but the title may enjoy trademark protection. A book cover labeled “Gone with the Wind”

30 See id. at § 6:14. But see Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004 (5th Cir. 1971) (copying of ice hockey teams' logos on patches to put on clothing violated trademark law) (an approach rejected in Order of Job's Daughters v. Lindeburg & Co, 633 F.2d 912, 918 (9th Cir. 1980)).
31 See, e.g., Kohler Co. v. Moen, Inc., 12 F.3d 632, 637 (7th Cir. 1993) (explaining that trademark rights may continue as long as the mark is used to distinguish and identify).
32 See, e.g., Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 1530 (Fed. Cir. 1994) (“[T]rademark protection is potentially perpetual in duration.”).
33 See Coca-Cola Co. v. Howard Johnson Co., 386 F. Supp. 330, 334-38 (1974). See also Coca-Cola Co. v. Overland, Inc., 692 F.2d 1250, 1252 (9th Cir. 1982) (enjoining Overland from substituting in response to orders for "Coca-Cola" or "Coke" any beverage other than that sold by the Coca-Cola Company unless Overland first gives customer notice of the substitution and obtains the customer’s approval).
36 Baker, 101 U.S. at 102-04 (1879).
37 See id. at 102-03.
will likely infringe Margaret Mitchell’s heirs’ (or her publisher’s) trademark if it is not made clear that the book is entirely different, e.g., a tale of losses from the high tech stock market decline.

Things become worrisome only where a body of law that is not copyright affects either the copyright owner’s right to exploit the copyrighted work or the public’s right to use a copyrightable-type of work that is in the public domain. For the reasons first set forth in the Supreme Court’s decisions in Sears-Compco, the calibration of this balance must be by Congress alone, and in the copyright arena alone.

IV. PASSING OFF, REVERSE PASSING OFF, AND SECTION 43(A)

Section 43(a) of the Lanham Act protects even unregistered trademarks. Originally enacted in 1946, section 43(a) now reads, as amended in 1988:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Section 43(a) is a creature of Congress. It thus might not be seen to be capable of conflicting with Congress’s power under the copyright clause. But § 43(a) was enacted pursuant to the Commerce Clause, not the copyright clause. Should it disturb the copyright/public domain balance reached by Congress under the copyright clause, it does no less harm to that

39 See supra note 38.
40 See supra note 12.
scheme than the state laws proscribed by *Sears-Compo* and § 301 of the Copyright Act. It is from this principle that some of the lower courts had strayed, pre-*Dastar*. These courts had been quick to find “passing off” and “reverse passing off” actionable under § 43(a), where in this author’s opinion the facts of the cases were adequately, and should have been found to be exclusively, controlled by federal copyright law.

A. "Passing Off" and "Reverse Passing Off"

"Passing off" occurs where the defendant deceives consumers into believing that its goods are those of the plaintiff’s. If, for example, Rite-Aid sold batteries manufactured by it but labeled them as Duracell batteries, Rite-Aid would be guilty of passing off. Here consumers would be misled into buying something they thought came from the manufacturer of Duracell. Assuming the batteries were inferior to or different from what the consumers expected, the consumers would be harmed.44 Duracell would also be harmed due to the resulting loss of goodwill.

"Reverse passing off" is the opposite. Here the defendant markets the plaintiff’s goods as the defendant’s. This would occur if Rite-Aid relabeled authentic Duracell batteries as “Rite-Aid” batteries. Here, again, the consumers would be duped, and Duracell would lose goodwill to Rite-Aid, who would “get credit” for the better batteries.

These concepts properly may be applied to various non-copyrightable aspects of copyrightable types of works, such as book, song, and movie titles. A theater-goer who purchases tickets to "The Producers" will be harmed if the play turns out not to be the Mel Brooks movie spin-off the theater-goer expects, but an entirely different work, with no connection to Mel Brooks. The potential harm of the type addressed by trademark law may be prevented, however, by clearly labeling the good as coming from the defendant, rather than the plaintiff. Thus, "The Producers: A Play about the Steel Industry" would likely not infringe Mel Brooks’s trademark. Similarly, "Gone With the Wind," labeled "a story of loss in the high tech stock market," by "A.N. Author," would not be found to be passing itself off as Margaret Mitchell’s book.

But some lower courts have read § 43(a) so broadly as to provide a duplicate remedy for copyright infringement. This is unnecessary, as copyright is adequate to the task. It is also dangerous, in that trademark protection can be perpetual, and will apply even when copyright does not.

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44 See Don J. DeBenedictis, *Photo Realism: Judge Requires Truth in Labeling for Ansel Adams Copies*, 75 A.B.A. J. 37 (Oct. 1989) (discussing *Adams v. Day Dream Publishing, Inc.*, C-89-0873-WDK (C.D. Cal. 1989) (heirs of Ansel Adams had cause of action for "passing off" against publisher of calendars, books, and posters of Ansel Adams’ prints that were in the public domain, because reproductions were inferior to original prints; fair labelling was ordered)).
B. "Paddington Bear" Goes to Court

In a series of English children's books, Paddington Bear travels by train to Paddington Station, London, and embarks on a number of humorous adventures. The illustrated character was soon reproduced in licensed stuffed toys and other media. Amidst Paddington Bear's commercial success, a manufacturer produced nightshirts that had a close look-alike of Paddington Bear reproduced on the fabric. The nightshirts contained the notice "© Fred Original."45

In Eden Toys, Inc. v. Florelee Undergarment Co., the United States Court of Appeals for the Second Circuit held that the nightshirt infringed the copyright on a derivative work, a version of Paddington Bear manufactured in the United States.46 This decision—although pushing the envelope of how minimal changes could be in order to deserve a derivative copyright47—was a straightforward copyright infringement case.

But the Second Circuit went further. It also held that the legend "© Fred Original" was a "false designation of origin" and thus a violation of the Lanham Act.48 Under this holding, any time a manufacturer—even if innocently believing it holds copyright—uses a copyright notice that incorrectly claims copyright, the manufacturer will violate the Lanham Act.49 That overlap—in effect making the copyright infringement by the nightshirt manufacturer also a Lanham Act infringement—is obviously unnecessary in order to further the policy underlying copyright.50 One may argue that the overlap does no harm to the copyright/public domain balance because the Lanham Act cause of action is merely duplicative of the copyright claim. Yet this ignores the wisdom of Sears-Compco, which held that there could not be a parallel (admittedly, there it was a state law) cause

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45 Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27, 31 (2d Cir. 1986).
46 Id. at 37.
48 Eden Toys, 697 F.2d at 37.
49 Accord Waldman Pub'l'g Corp. v. Landoll, Inc., 43 F.3d 775 (2d Cir. 1994) (remanding on reverse passing off claim as to literary work); Nintendo of America, Inc. v. Dragon Pac. Int'l, 40 F.3d 1007, 1011 (9th Cir. 1994) (affirming award of both statutory damages for copyright infringement and actual damages for trademark infringement); EFS Mktg., Inc. v. Russ Berrie & Co., 836 F. Supp. 128 (S.D.N.Y. 1993) (finding that the use of copyright notice by works that do not qualify as derivative works because of only slight variations from public domain works violated the Lanham Act, even though the parties held copyright registrations); Scholastic, Inc. v. Stouffer, 124 F. Supp. 2d 836 (S.D.N.Y. 2000) (denying motions to dismiss “reverse passing off” counter claims under the Lanham Act and state unfair competition law for failure to attribute authorship of elements of "Harry Potter" to defendant rather than to plaintiff J.K. Rowling, and holding that they were not duplicative of copyright claim).
of action for copyright or patent, period. Else Congress’s exclusive power under the copyright/patent clause can be circumvented and diminished. That same diminution can result if the courts construe Congress’s own action under the Commerce Clause, in such a way as to upset the balance Congress has deliberately created under the copyright/patent clause between what is protectible and what is in the public domain. Indeed, recognizing a duplicative cause of action under the Lanham Act could cause much mischief, as Lanham Act protection is potentially perpetual and could conflict with the “limited Times” provision of the copyright clause.51

Perhaps this point may be more easily seen in a different context, where the underlying work was in the public domain.

C. What Harm?

Suppose that Paddington Bear had been in the public domain: that Fred took Paddington and made some changes, to come up with a somewhat different image; and that Fred again published with the notice “© Fred Original.” There now is no copyright infringement.

But if the Copyright Office finds insufficient originality for the new version to deserve copyright as a derivative work, does the now held-to-be-incorrect legend mean that Fred has violated the Lanham Act? Such a holding would force copyright proprietors, or those who believe themselves to have created something copyrightable including those who work with public domain items and make what they believe to be derivative works — (and who wish to enjoy the added protection that copyright notice provides, e.g., under the Uniform Copyright Convention), to proceed through registration with the Copyright Office before publishing with notice. Absent approval of the Copyright Office, the creator of the new version risks a finding that she has violated the Lanham Act. The resulting de facto requirement for registration, in order to proceed without risk of liability under the Lanham Act, is plainly at odds with the Copyright Act’s provision that registration is permissive, not mandatory.52 Worse, even a certificate of registration has been held to be insufficient to preclude a violation of the Lanham Act under this theory.53

There is no need for the Lanham Act to stick its nose under the tent. The copyright law provides adequately for protection against infringers and for non-protection of those who do not gain a copyright.

51 See supra note 32.
52 See 17 U.S.C. §§ 408(a) & 411 (registration is permissive at least until one wishes to file suit for infringement).
53 EFS Mktg., Inc. v. Russ Berrie & Co., 836 F. Supp. 128 (S.D.N.Y. 1993) (use of copyright notice by works that do not qualify as derivative works because of only slight variations from public domain works violated the Lanham Act, even though the parties held copyright registrations); Nintendo of America, Inc. v. Dragon Pacific Int’l, 40 F.3d 1007 (9th Cir. 1994) (affirming award of both statutory damages for copyright infringement and actual damages for trademark infringement).
If the goal of having the public domain is to be met – and growing the public domain is the ultimate goal of the copyright and patent clause – the line of demarcation between what is and what is not in the public domain must be kept clear. Cases such as *Eden Toys* create an unnecessary overlap between copyright law and the Lanham Act that prevents federal copyright law from alone dictating what is protected and what is in the public domain. The same criticism must be made of various state and federal lower courts’ expansive decisions regarding the “right of publicity:” they muddy the water as to what is in the public domain.

V. THE RIGHT OF PUBLICITY’S INTERFERENCE WITH THE BALANCE BETWEEN COPYRIGHT AND THE PUBLIC DOMAIN

The fast-growing “right of publicity,” an assignable right to the commercial use of one’s name or likeness, has thrown another monkey wrench at the balance established by the Copyright Act, a balance protected by *Sears-Compco* and § 301(a) of the Copyright Act. The “right of publicity” cause of action can upset this balance in two ways: (1) by interfering with a copyright owner’s right to license uses of its copyrighted work and (2) by interfering with others’ rights to use or copy what copyright law has relegated to the public domain.

The two most notorious cases illustrating the reach of this monkey wrench both involve extreme readings of what is protected as an individual person’s likeness, for which that person has the right to decline or authorize its commercial use. The “Bette Midler case” exemplifies the first type of interference with the federal copyright scheme, and the “Vanna White case,” the second.

A. Copyright Owner’s Hands are Bound

In the Bette Midler case, the United States Court of Appeals for the Ninth Circuit read the California right of publicity to be so broad as to

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55 Preventing artists from portraying public figures without their permission would infringe on the goals of both the copyright clause and the First Amendment. See ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915 (6th Cir. 2003) (holding that a painting portraying Tiger Woods’ winning of the 1997 Masters violates neither his right of publicity nor the Lanham Act).
prevent the copyright owner of a song from freely licensing its use. There the copyright owners of the musical composition "Do You Want to Dance?" had licensed its use in a Ford automobile commercial.

Bette Midler had earlier made a popular sound recording of the song. She owned the copyright in neither the song nor the sound recording. Ford Motor Company wanted to use Bette Midler, singing that song, in a television commercial.

Ford bought a license from the copyright holder of the song. Ford asked Midler to sing for its commercial, but she declined. Ford then hired another singer and instructed her to make her performance sound like Midler's version. This was all perfectly legitimate and within the balance carefully established by Congress in the Copyright Act.

Under the Copyright Act, the copyright owner in a musical sound recording (who in any event is most often a record company, not the performer) has protection against only "record pirates" who do not hold their own recording session but simply press new copies of the first person's recording. A subsequent maker of a new sound recording of a song must either have permission (as is required for use in a television commercial) or enjoy a § 115 compulsory license as to the underlying song, if it is protected by copyright. In that event, § 114 provides that the new recording session may even "imitate or simulate those [sounds] in the copyrighted sound recording," as long as it does not "directly or indirectly recapture the actual sounds fixed in the recording." Ford had done just what Congress had permitted in the context of new recordings under § 115. Certainly what Congress has approved without the need for the copyright owner's permission would not be something Congress intended to forbid the copyright owner from approving itself.

But the Ninth Circuit held that California state law would hold that Midler's distinctive voice was part of her likeness and, therefore, Ford's commercial infringed upon Midler's right of publicity. Even labeling the ads "celebrity sound-alike" would not cure the problem. Ford simply could not air the ads without Midler's permission. Therefore, the copyright proprietor was precluded from exploiting its copyrighted work as it chose, within the balance created by Congress.

This preclusion was accomplished under state law, giving a right to the performer of the song, whose contribution Congress has excluded from entitlement to copyright protection, except against mere "record pirates." Midler thus struck a stunning blow to the copyright/public domain balance.

B. Effect on What is in the Public Domain

Under the facts of Midler, the copyright proprietor could not freely license the song, as it chose. Logically, under Midler, the states also can
extend such a right of publicity to prevent voice imitation in public domain songs under similar circumstances.

The same harmful effect on the public domain flows from another Ninth Circuit decision, *White v. Samsung Electronics America, Inc.* Here the defendant was the author of a copyrightable type of work, a print advertisement (hence an author to be encouraged under the copyright clause). The ad depicted a robot wearing an evening gown and turning letters on a set reminiscent of “The Wheel of Fortune” game show set. The thrust of the ad was that, at a time far in the future, Samsung’s VCR would still be “state of the art.” The defendant had copied the idea of a Vanna White-type functionary on a Wheel of Fortune-type set.

Vanna White sued under California law, alleging that the ad violated her right of publicity by exploiting her “likeness.” The majority of a divided panel found for White. Judge Alarcon, however, wrote an inspired and delightful dissenting opinion, as did Judge Kozinski, who wished to rehear the case en banc. They had the better of the argument. The majority’s decision foiled a creative author—the author of the humorous ad—who under copyright law copied only a noncopyrightable idea. Surely this result is not consonant with the purpose of the copyright clause.

The defendants in *Midler* and *White* both had the green light under copyright law—whether because of permission from the copyright proprietor or because of the fact that what was copied was unprotected and in the public domain under copyright law. But that was insufficient to allow these subsequent users or authors to proceed safely.

These causes of action under § 43(a) and the right of publicity have grown like kudzu, choking the public domain. Although some jurisdictions have declined to follow the cases discussed above, either as to § 43(a) or as to the right of publicity, these cases continue to reach their tendrils across the country, since many defendants publish their works in every state, and thus are liable to suit in every federal circuit and every state.

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60 See supra note 57.
62 *White*, 971 F.2d at 1397.
63 *White II*, 971 F.2d at 1402-08 (Alarcon, J., concurring in part and dissenting in part).
64 *White*, 989 F.2d at 1512-21 (Kozinski, J., dissenting, joined by O'Scannlain and Kleinfeld, JJ.).
65 Section 43(a) also has been used to provide a remedy for a defendant's commercial use of the plaintiff's likeness. *Prudhomme v. Proctor & Gamble Co.*, 800 F. Supp. 390, 395 (E.D. La. 1992) (holding that unauthorized use of a celebrity look-alike in an advertisement violated § 43(a) of the Lanham Act).
The United States Supreme Court’s decision in Dastar, however, provides hope that the kudzu will be eradicated.

VI. _DASTAR TO THE RESCUE_

The Court’s opinion in Dastar has two salient virtues. First, the Court recognizes the value of the public domain (particularly reassuring, since this is a value that the Court had only recently snubbed in _Eldred v. Ashcroft_68 upholding the constitutionality of Congress’s extension of the American copyright term to life plus 70 years, even ex post facto for those works that had been created with the expectation of shorter copyright terms).69 Second, it soundly reaffirms the Sears-Compco doctrine that the federal copyright law describes the public domain, where works falling within the subject matter of copyright are at issue.

A. _The Concept of the Public Domain_

Once a work within the scope of copyright is in the public domain under copyright law, it ought to be in the public domain under all legal theories, to the extent that it can be freely copied, altered, performed, displayed, and distributed. Thus, when Mark Twain’s “Tom Sawyer” went into the public domain, any publisher could print copies and sell it, without owing Twain any money and without his enjoying any veto power. As long as the publisher does not change the text, the publisher ought to be able to credit Mark Twain as the author, so that the consuming public knows what it is purchasing. The author ought to have no right to stop this commercial use of his name, as the book is in the public domain, and it remains apparent that Twain is its author. The publisher also ought to be free to delete Twain’s name, as the publisher chooses. Naming someone else as the author, however, ought not be permitted, by virtue of the Lanham Act, as that would mislead consumers.70

The book “Tom Sawyer, by Mark Twain” must be free to be reproduced as such. If states’ right of publicity laws, like that applied in the Bette Midler and Vanna White cases, were so broad as to prevent the publisher’s selling its copies of the properly attributed book, the state laws ought to be held to be preempted by the copyright clause. Permitting the state

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69 In an opinion by Justice Ginsburg, the majority of the Court upheld this extension despite the “for limited times” provision in the Constitution’s copyright clause -- and permitted Congress to justify this extension as desirable harmonization with the terms recently extended by European countries, see 537 U.S. at 204-10 & nn.10-17. No mention was made of the fact that those countries have no written constitutions limiting their legislatures’ power in this area. Justices Stevens and Breyer each dissented. See Matt Jackson, _Harmony or Discord? The Pressure Toward Conformity in International Copyright_, 43 IDEA 607, 627-34 (2003), for a discussion on the push for copyright law harmonization around the world.

70 See _supra_ note 38.
laws' interference with the public's right of free distribution of what is in the public domain would upset the balance that Congress has carefully established under the copyright regime.

The work's distribution must be governed by federal copyright law and no other (excepting only any restrictions on the copyright law that may be imposed by the First Amendment\(^71\)). Even Congress ought not be permitted to upset the copyright/public domain balance via its power from any source (including the much more general commerce clause, which is its source of power for the Lanham Act\(^72\)) other than the copyright clause of the Constitution.\(^73\)

Yet that public domain had been intruded upon by a line of federal cases construing § 43(a) of the Lanham Act that was reversed in Dastar.\(^74\)

B. No "Right of Attribution" of Authorship under § 43(a)

Under that line of cases, the subsequent user of a public domain work (such as "Tom Sawyer") was "damned if he did" attribute the work to the original author (Mark Twain) and "damned if he didn't." If he gave attribution, but the copies he sold were not actually produced by that author, he was guilty of "passing off."\(^75\) If he failed to give attribution, he was guilty of "reverse passing off."\(^76\)

In Dastar, the defendant Dastar had reproduced, with some revisions, a work within the subject matter of copyright, that was in the public domain. The work in question was a television documentary series, a derivative work (adapted from a book by another author) which series had enjoyed copyright protection but had fallen into the public domain when its proprietor failed to renew the copyright.\(^77\) (Whether the copyright on the original work, the book underlying the television series, was infringed by the defendant's actions was not addressed by the Supreme Court; the court of appeals had remanded on that count.\(^78\)) The defendant had made some editing changes and marketed the resulting videotapes as its own:

*Dastar* manufactured and sold the [World War II] Campaigns video set as its own product. The

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\(^72\) U.S. CONST. art. 2, § 8, cl. 8.

\(^73\) The reach of the more specific provision should govern to establish the parameters of Congress's power as to copyright-like or patent-like protection for categories of works over which Congress has power under the copyright/patent clause.

\(^74\) *Dastar*, 123 S. Ct. at 2049.

\(^75\) *Id.*

\(^76\) *Id.*

\(^77\) *Id.* at 2044.

\(^78\) *Id.* at 2045 & n.2.
advertising states: "Produced and Distributed by: Entertainment Distributing" (which is owned by Dastar), and makes no reference to the [plaintiff's] Crusade television series. Similarly, the screen credits state "DASTAR CORP presents" and "an ENTERTAINMENT DISTRIBUTING Production," and list as executive producer, producer, and associate producer, employees of Dastar.  

The plaintiff argued that Dastar's failure to credit the plaintiff as the source of the series violated § 43(a) of the Lanham Act. Eight members of the Court (Justice Breyer did not participate) held, in an unanimous opinion authored by Justice Scalia, that § 43(a) provides no right of attribution to the creator of a work that is in the public domain and copied by another. The Court emphasized that the purpose of the Lanham Act differs from that of the copyright law, and that a copyright proprietor's protection is provided solely by the copyright law. Here, Dastar was the source, or "origin," of the goods – the tangible videotapes. Hence, it committed no violation of § 43(a). The fact that the goods were communicative made no difference in the Lanham Act analysis. The same result obtained as would have if the

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79 Id. at 2044.
80 Id. at 2044-45.
81 Id. at 2050.
82 Id. at 2048.
83 Id.
84 Id. at 2050. See Bretford Mfg. v. Smith Sys. Mfg. Co., 286 F. Supp. 2d 969 (N.D. Ill. Oct. 6, 2003) (No. 98-C0287) (no cause of action for reverse passing off when goods were not "sold in the marketplace").
85 Dastar, 123 S. Ct. at 2050.
86 Id. at 2047-50. The Court explains:

It could be argued, perhaps, that the reality of purchaser concern is different for what might be called a communicative product – one that is valued not primarily for its physical qualities, such as a hammer, but for the intellectual content that it conveys, such as a book or, as here, a video. The purchaser of a novel is interested not merely, if at all, in the identity of the producer of the physical tome (the publisher), but also, and indeed primarily, in the identity of the creator of the story it conveys (the author). And the author, of course, has at least as much interest in avoiding passing-off (or reverse passing-off) of his creation as does the publisher. For such a communicative product (the argument goes) "origin of goods" in § 43(a) must be deemed to include not merely the producer of the physical item (the publishing house Farrar, Straus and Giroux, or the video producer Dastar) but also the creator of the content that the physical item conveys (the author Tom Wolfe, or – assertedly – respondents).

The problem with this argument according special treatment to communicative products is that it causes the Lanham Act to conflict with the law of copyright, which addresses that subject specifically. The right to copy, and to copy without attribution, once a copyright has expired, like "the right to make [an article whose patent has expired]—including the right to make it in precisely the shape it carried when patented—passes to the public." Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 230, 84 S.Ct. 784, 11 L.Ed. 2d 661,
plaintiff's work had been, for example, a toaster that was not protected by patent and that had no trademark protection in its physical design. There, too, had Dastar manufactured identical toasters, labeling them as coming from Dastar would have been proper.

The Court left open the possibility that, if the defendant had made a false statement, such as labelling the videotapes "contents created by Dastar," the defendant would have violated § 43(a) by making a false representation as to the good's "nature, characteristics, [or] qualities." That

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* * * To hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do. See Eldred v. Ashcroft, 537 U.S. 186, 208, 123 S.Ct. 769, 154 L.Ed. 2d 683 (2003).

Id. at 2047-48, 2050.

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Id. at 2050 ("If . . . the producer of a video that substantially copied the Crusade series were, in advertising or promotion, to give purchasers the impression that the video was quite different from that series, then one or more of the respondents might have a cause
is, in this author’s opinion, as it should be. Had Dastar so labeled the tapes, its representation would have been knowingly false. Declining to engage in knowing falsity is not a burden on those who wish to properly use public domain works.

But the Court’s analysis happily suggests that labeling that is truthful in the eyes of the producer of the good, acting reasonably, would not violate § 43(a). This, coupled with the court’s emphasis that copyright law is the only body of law that may provide a cause of action for copyright infringement, supports the welcome inference that the Court would not readily endorse the apparent Eden Toys holding that an incorrect copyright notice, without more, is a violation of § 43(a) in addition to any underlying copyright violation.

C. An Encouraging Step

The Court’s recognition in Dastar of the importance of the public domain – and the Court’s reaffirmation that copyright law alone governs the rights in categories of works falling within the subject matter of copyright – are hopeful indications for defenders of the public domain.

Perhaps the Court will grant certiorari in other cases that will give it the opportunity to hold, for example, that a right of publicity as applied in Midler and White is preempted by copyright law.88 If given the opportunity, the Court also ought hold that “shrink-wrap” licenses – which are contracts of adhesion rather than ones negotiated between the parties – and causes of action for misappropriation89 and quasi contract90 which also apply against

88 See Balt. Orioles, Inc. v. Major League Baseball Ass’n, 805 F.2d 663 (7th Cir. 1986) (holding that baseball players’ right of publicity was not infringed by television broadcasts of baseball games) (author’s note: unfortunately, the case was not decided on preemption grounds, but on the ground that the players’ contributions were works made for hire and thus the copyright to them was owned by the teams; the opinion overlooked the fact that the players made no copyrightable contributions to the film).

89 See e.g., Alcatel USA, Inc. v. DGI Technologies, Inc., 100 F.3d 772 (5th Cir. 1999) (finding misappropriation claims as to computer software preempted by federal copyright law). Compare e.g., Schuchart & Associates v. Solo Serve Corp., 540 F.Supp. 928 (W.D. Tex. 1982) (preemption of misappropriation claim, but not of unjust enrichment claim for value of services rendered, regarding defendant’s copying and use of plaintiff’s copyrighted mechanical and electrical drawings) with Yost v. Early, 87 Md. App. 364,
the world rather than between negotiating parties that override the balance established by Congress as to fair use are also preempted.\footnote{385-89, 589 A.2d 1291 (1991) (preemption of conversion and unjust enrichment claims re: reproduction of computer software programs).} Such decisions would help to enhance the public domain, at no cost to the scheme of copyright protection designed by Congress.

VII. CONCLUSION

In 1964, \textit{Sears-Compco} clearly voiced the importance of the federal patent and copyright law's demarcation establishing the line between what is and what is not in the public domain. Expansive subsequent readings by some lower courts regarding § 43(a) of the Lanham Act, some states' recognition of an individual's right of publicity and state contract law enforcing restrictive shrink-wrap licenses blurred those lines.

In its 2003 decision in \textit{Dastar}, the Supreme Court has resoundingly reasserted the \textit{Sears-Compco} rationale, but in the context of the Lanham Act. \textit{Dastar} is an important step in staunching the flow of works out of the public domain, from which they had been carried not by copyright law, but by § 43(a) or, \textit{e.g.}, the right of publicity.

It is to be hoped that the Court will continue the work that it has begun. The public domain's borders, having been drawn by the federal copyright and patent laws, must not be permitted to be truncated by other bodies of law, so that one dare not make free use of public domain works. Such intrusion on the balance Congress has established between the public domain and the copyright and patent-protected domain ought not be tolerated. This fact remains, no matter whether the attempted intrusion is by federal trademark law or by state law such as that regarding misappropriation, quasi-contract, contracts of adhesion, or the right of publicity.

\footnote{\textit{See} Werlin \textit{v. Reader's Digest Ass'n}, 528 F.Supp. 457 (S.D.N.Y. 1981) (finding cause of action under quasi-contract) (in this author's opinion, a cause of action under a contract implied-in-fact could have been properly found, instead).}