

***DASTAR V. TWENTIETH CENTURY FOX: THE
NEED FOR STRONGER PROTECTION OF
ATTRIBUTION RIGHTS IN THE
UNITED STATES***

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I.
INTRODUCTION

Artists and authors create for many reasons. Some create purely because they have stories that must be told, songs that must be played and landscapes that just must be painted. Others create because they believe that, of course, they are creative, and there is a sufficiently large economic market for their works that they will be able to earn a living by exploiting their “exclusive Rights” for “limited Times.”¹ The rights to reproduce, distribute, display, perform and transmit works, and to prepare derivative works, are the economic rights attached to a work. As with other forms of property, they may be bought and sold and licensed. Commercialization of the work is controlled by the owner of the copyrights, and ownership of the copyrights is distinct from ownership of the material object that embodies the work.² The owner of the copyrights is

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1. U.S. CONST. art. I, § 8, cl. 8 (“The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”). The drafters of the Constitution employed the convention still used in German of capitalizing the first letter of all nouns.

2. *See* 17 U.S.C. § 202 (2000).

often not the “author”³ of the work as a result of the author having granted the rights to another person or entity.

Many other countries with advanced schemes of protection for artistic and literary expression also provide the “author” with non-economic rights, such as the right to have one’s name attributed to his work or removed from an altered version of his work that is prejudicial to his reputation. The right of attribution is one of the author’s rights referred to as “moral rights” or *droit moral*.⁴ Moral rights exist in legal systems that view a creative work as an extension of the author’s personality.⁵ Accurate attribution also establishes both the true value of a work and the reputation of its creator, and performs a trademark-like function in identifying both the source of a work and the qualities of a work.

The United States did not have any express protection for a right of attribution until the enactment of the Visual Artists Rights Act of 1990 (“VARA”). As discussed below, the protections under VARA apply only to a limited category of works legally defined as “works of visual art” and are not applicable to the vast majority of creative works. Notwithstanding the lack of an express attribution right that applied across the board to all works, it was well established law that one was able to obtain moral rights-type relief for misattribution of an artistic work in the United States by asserting a claim under section 43(a) of the Trademark Act of 1946 (commonly referred to as the “Lanham Act”) for “false designation of origin.”⁶ Section 43(a) claims have been successfully asserted in connection with altered, edited or mislabeled content in sound recordings,⁷ films,⁸ television⁹ and books.¹⁰ Section 43(a) has also been used to obtain relief against parties who failed to credit com-

3. I am using “author” in the broad sense to apply to a creator of any type of copyrightable subject matter. For the categories of copyrightable subject matter, see 17 U.S.C. § 102(a) (2000).

4. Moral rights are discussed in more detail *infra* Part II.

5. See GEORG W. F. HEGEL, *PHILOSOPHY OF RIGHT* (T.M. KNOX trans., 1952) (1821); Immanuel Kant, *Of the Injustice of Counterfeiting Books*, in 1 *ESSAYS AND TREATISES ON MORAL, POLITICAL, AND VARIOUS PHILOSOPHICAL SUBJECTS* 225, 229-30 (W. Richardson trans., 1798).

6. 15 U.S.C. § 1125(a) (2000).

7. See, e.g., *PPX Enters. v. Audiofidelity Enters.*, 818 F.2d 266 (S.D.N.Y. 1987) (marketing of recordings of a band in which Jimi Hendrix was just a background performer as previously unreleased “Jimi Hendrix” records was a 43(a) violation); *Benson v. Paul Winley Record Sales Corp.*, 452 F. Supp. 516 (S.D.N.Y. 1978) (involving similar marketing of old recordings of George Benson).

8. See, e.g., *King v. Innovation Books, Inc.*, 976 F.2d 824, 828-29 (2d Cir. 1992) (enjoining use of possessory credit in connection with motion picture that was very different from story).

posers,¹¹ or who gave incorrect credit to actors.¹² In short, among intellectual property and entertainment lawyers and academics in the United States, there was consensus that section 43(a) of the Lanham Act, a federal trademark statute, applied to misattribution in connection with creative content.

The Supreme Court closed the door on section 43(a) attribution claims when it decided *Dastar Corp. v. Twentieth Century Fox Film Corp.*,¹³ a case that dealt with the reproduction, editing, repackaging and distribution of copies of public domain videotapes by a competitor. In *Dastar*, the Supreme Court held that section 43(a) of the Lanham Act was “*incapable* of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain”¹⁴ and that attribution claims for communicative works belong under copyright law. Because the right of attribution under copyright law applies only to a very limited category of works, the Supreme Court in *Dastar* effectively ended most causes of action for false or misleading attribution of artistic works. This will encourage plagiarism and misattribution, especially when there is so much material available that is so easy to reproduce and distribute. Congress should act quickly to provide an express attribution right to allow authors to receive credit for their work.

II.

MORAL RIGHTS PROTECTION

In addition to the economic rights that protect the copyright owner against unauthorized commercialization of a work through the reproduction, distribution, adaptation, display and performance of a work, many countries provide an author with so-called

9. *See, e.g.*, Gilliam v. Am. Broad. Co., 538 F.2d 14 (2d Cir. 1976) (holding that television network, by editing out almost one-third of episodes of “Monty Python’s Flying Circus,” created an unauthorized derivative work; ABC had rights only to perform or display the original work).

10. *See, e.g.*, Follett v. Arbor House Pub. Co., 497 F. Supp. 304 (S.D.N.Y. 1980). (holding Lanham Act, section 43(a) violated where famous author’s name appears as principal author on book that he did not write); *c.f.* Clevenger v. Baker Voorhis & Co., 8 N.Y.2d 187, 192 (N.Y. 1960) (holding that poorly edited and incorrect book with plaintiff listed as author could be defamation under New York law).

11. *See, e.g.*, Lamothe v. Atl. Recording Corp., 847 F.2d 1403, 1406-07 (9th Cir. 1988) (holding that attributing authorship of musical compositions to fewer than all of joint authors stated cause of action under Lanham Act for express reverse passing off.)

12. *See, e.g.*, Smith v. Montoro, 648 F.2d 602, 607 (9th Cir. 1981) (finding section 43(a) claim valid where actor’s credit removed from film).

13. 539 U.S. 23 (2003).

14. *Id.* at 32 (emphasis added).

“moral rights” to his reputation and the integrity of his work.¹⁵ While the economic rights are assignable, in general, the non-economic rights are not, though they are usually waiveable. Moral rights protection is derived from the protections contained in Article 6^{bis} of the Berne Convention for the Protection of Artistic and Literary Rights,¹⁶ and includes the right of divulgation (disclosure), the right of paternity (attribution) and the right of integrity (the ability to prevent alterations to a work). The right of divulgation or disclosure is similar to the old, and now preempted, common law right of first publication,¹⁷ except that it is more expansive.¹⁸ In

15. The term “moral rights” is a translation of the French *droit moral*. The translation can be misleading, for *droit moral* does not deal with common notions of morality, but more with rights that create a more personal legal connection between an author and his works. In her article, Professor Kwall noted that a more appropriate term might be the German term *urheberpersönlichkeitsrecht*, which translates into “right of the author’s personality.” See Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1 (1985) [hereinafter Kwall, *American Marriage*] (citing 1 STEPHEN LADAS, THE INTERNATIONAL PROTECTION OF ARTISTIC AND LITERARY PROPERTY § 272 & n.2 (1938)); see also Sidney A. Diamond, *Legal Protection for the “Moral Rights” of Authors and Other Creators*, 68 TRADEMARK REP. 244 (1978); Michael Landau, *Colourization, Copyright and Moral Rights: A U.S. Perspective*, 5 INTELL. PROP. J. 215 (1990); John Henry Merzlyman, *The Refrigerator of Bernard Buffet*, 27 HASTINGS L.J. 1023 (1976); Burton Ong, *Why Moral Rights Matter: Recognizing the Intrinsic Value of Integrity Rights*, 26 COLUM.-VLA J. L. & ARTS 297 (2003); Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors, and Creators*, 53 HARV. L. REV. 554 (1940); Dan Rosen, *Artists’ Moral Rights: A European Evolution, An American Revolution*, 2 CARDOZO ARTS & ENT. L.J. 155 (1983). See generally Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught In the Crossfire Between Copyright and Section 43(a)*, 77 WASH. L. REV. 985 (2002). For a discussion of the differences between American and European views of moral rights, see generally Henry Hansman & Marina Santilli, *Authors’ and Artists’ Moral Rights: A Comparative Legal and Economic Analysis*, 26 J. LEGAL STUD. 95 (1997).

16. The relevant provision in the Berne Convention for the Protection of Literary and Artistic Works contained in Article 6^{bis} provides:

Independently of the author’s economic rights, and even after the transfer of said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of or other derogatory action in relation to, the said work, which would be prejudicial to his honor and reputation.

Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, art. 6^{bis}, § 1, 25 U.S.T. 1341, 828 U.N.T.S. 221 (last revised July 24, 1971).

17. This author believes that as of January 1, 1978, the effective date of the Copyright Act of 1976, any right of first publication is totally preempted, and that any special treatment given to the owners of the copyrights in unpublished works for purposes of infringement analysis was just plain wrong. For example, in *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), a 300-word excerpt from the unpublished manuscript of former President Gerald Ford’s memoirs dealing with President Nixon’s resignation from office and later pardon by Ford

addition to allowing an author to decide when a work should first be distributed to the public, it also includes the right of withdrawal.¹⁹ The right of integrity, which allows artists to enjoin modifications and alterations prejudicial to the artist's honor and reputation and have altered works removed from display can be in conflict with the right to "prepare derivative works" contained in section 106(3) of the U.S. Copyright Act.²⁰ Again, of course, parties can agree to contractual provisions related to alterations or changes.

The right that is central to this article is the right of attribution. The right of attribution is the moral right that does not inter-

was found to infringe. In her misguided analysis, Justice O'Connor relied heavily on the fact that the manuscript was previously unpublished. While there is language regarding the use of unpublished works and fair use in the legislative history, those sections are from House Reports from the 1960s. Nowhere in the final version of the Copyright Act itself is there any indication that the unpublished status should make an iota of difference. Lower courts in *Salinger v. Hamilton*, 811 F.2d 90 (2d Cir. 1987), and *New Era Publications International v. Henry Holt & Co.*, 873 F.2d 576, 583-84 (2d Cir. 1989), followed the Supreme Court's holding in *Harper & Row* and also placed undue emphasis on the fact that the work in question was unpublished. Congress ultimately decided to attempt to undo the doctrinal damage caused by *Harper & Row*, and on October 28, 1992, President George Herbert Walker Bush signed into law a bill that added the following language to the end of section 107 of the Copyright Act: "The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors." 17 U.S.C. § 107 (2000). For further discussions of *Harper & Row* and the use of previously unpublished works, see Gary L. Francione, *Facing the Nation: The Standards for Copyright, Infringement, and Fair Use of Factual Works*, 134 U. PA. L. REV. 519, 530-536 (1986). See also ALEXANDER LINDEY & MICHAEL LANDAU, *LINDEY ON ENTERTAINMENT, PUBLISHING AND THE ARTS: AGREEMENTS AND THE LAW* § 1:25 (3d ed. 2004) [hereinafter LINDEY AND LANDAU] (discussing treatment of derivative works under the Copyright Act).

18. See Kwall, *American Marriage*, *supra* note 15; see also Yochai Benkler, *Siren Songs and Amish Children: Autonomy, Information and Law*, 76 N.Y.U. L. REV. 23, 61 (2001) (discussing the philosophical aspects of the right of withdrawal); Merzlyman, *supra* note 15, at 1028; Roeder, *supra* note 15, at 561. R

19. Under current United States copyright law, in those cases in which only the right of distribution has been assigned, the right to distribute the work could be terminated after a statutorily determined period of time, thereby creating a right to stop additional copies of a work from being distributed. See 17 U.S.C. § 304(c) (2000) (setting forth the rules for terminating grants in connection with works created before January 1, 1978); see also 17 U.S.C. § 203(a) (2000) (setting forth the rules for terminating grants made in connection with works created after January 1, 1978). For pre-1978 works, the window during which one may terminate a grant is tied to the beginning of the copyright term; for works created after January 1, 1978, it is tied to the date of the grant itself, not to the date of the creation of the work. R

20. 17 U.S.C. § 106(3) (2000).

tere at all with any of the exclusive rights of the copyright holder, for there is no generally applicable exclusive right of attribution in section 106 of the Copyright Act. Giving an author the right to have his name associated with his work, or removed from an altered work, does not prevent another party from reproducing, distributing, adapting, displaying or performing a work. It merely provides an author with the right to receive proper credit when it is due and as a result, develop a reputation that accurately reflects the fruits of his labor.

While moral rights protection has been part of the Berne Convention and therefore part of the law of most countries with systems of protection for artistic and literary works for quite some time, the United States until very recently had been opposed to enacting any kind of express statutory moral rights protection. When the Berne Convention Implementation Act was passed in 1988²¹ and the United States finally became a signatory to the Berne Convention, Congress decided not to amend existing U.S. copyright law to provide express specific moral rights protection. According to both the House Report²² and the Senate Report²³ at the time of the Act's

21. See LINDEY AND LANDAU, *supra* note 17, § 1:1 (discussing revisions to the Copyright Act of 1976, subsequent to its enactment). On October 31, 1988, President Ronald Reagan signed the Berne Convention Implementation Act of 1988 into law. Pub. L. No. 100-568, 102 Stat. 2853 (1988). The Berne Act purportedly conformed United States copyright law to the requirements of the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention) and enabled the United States to join the Berne Convention. See U.S. COPYRIGHT OFFICE, HIGHLIGHTS OF UNITED STATES ADHERENCE TO BERNE CONVENTION, U.S. Copyright Circular No. 93a, for a detailed discussion on how the Copyright Act changed as a result of the United States becoming a signatory of the Berne Convention.

22. H.R. REP. NO. 100-609, at 38 (1988); see also Cathryn A. Heise, *Berne-ing Down the House (and Senate): The Berne Convention Implementation Act of 1988*, 63 FLA. BAR. JNL. 62, 64 (July-Aug. 1989) ("According to the House committee, however, although no federal statute exists relating specifically to the "moral rights" of authors, based upon the testimony of the majority of the witnesses before the House subcommittee, the conclusions of international copyright experts, the comparison of United States' laws with those of Berne member countries, and the current status of federal and state protections of the rights of paternity and integrity, current United States law meets the requirements of Article 6bis.")

23. S. REP. NO. 100-352, at 9-10 (1988); see also Heise, *supra* note 22, at 64 ("According to the Senate report, this existing U.S. law includes various provisions of the Copyright Act and Lanham (Trademark) Act, various state statutes, and common law principles such as libel, defamation, misrepresentation, and unfair competition, which have been applied by courts to redress authors' invocation of the right to claim authorship or the right to object to distortion."); William Patry, *The United States and International Copyright Law: From Berne to Eldred*, 40 Hous. L. REV. 749, 751 (2003) (discussing the "Selective Adherence" to Berne by the United States).

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passage, it was widely believed that there was already ample protection available for enjoining improper attribution under other areas of the law, primarily trademark law.

III.

THE VISUAL ARTISTS RIGHTS ACT OF 1990

Shortly after the United States became a member of the Berne Convention,²⁴ the Visual Artists Rights Act of 1990 finally became law.²⁵ Congress added a new section 106A to the Copyright Act of 1976 providing very limited rights of attribution and integrity for certain works.²⁶ The protections provided under section 106 are extraordinarily limited in scope and apply only to a very small percentage of all works: those that are legally defined as “works of visual art”²⁷ in the Copyright Act. As is quite clear from the legislative

24. The effective date was March 1, 1989.

25. See generally Edward Damich, *The Visual Artists Rights Act of 1990: Toward a Federal System of Moral Rights Protection for Visual Art*, 39 CATH. U. L. REV. 945 (1990) (noting that the enactment of the Visual Artists Rights Act was a step in the right direction, and illustrating its relative shortcomings).

26. 17 U.S.C. § 106A provides:

§ 106A. Rights of certain authors to attribution and integrity

- (a) Rights of attribution and integrity.—Subject to section 107 and independent of the exclusive rights provided in section 106, the author of a work of visual art—
- (1) shall have the right—
 - (A) to claim authorship of that work, and
 - (B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create;
 - (2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and
 - (3) subject to the limitations set forth in section 113(d), shall have the right—
 - (A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and
 - (B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.

17 U.S.C. § 106A (2000).

27. A “work of visual art” is defined in section 101 of the Copyright Act as:

- (1) a painting, drawing, print or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or

history and the language added to the Copyright Act itself, it is evident that Congress did not intend the new provisions protecting attribution and integrity contained in the Visual Artists Rights Act to supersede and preempt any and all other means of obtaining proper attribution for a creative work that is not a work of visual art.

The category of works to which the Visual Artists Rights Act applies is extraordinarily narrow. “[W]ork of visual art” is a specifically defined term in section 101 of the Copyright Act and does not include motion pictures or audiovisual works, works made for hire, photographs not created for exhibition purposes, reproductions of works, works that are not of recognized stature and applied art.²⁸ Basically, anything that is not one-of-a-kind or part of a limited edition of 200 or fewer signed and consecutively numbered copies is not a “work of visual art” and therefore is not covered by the very limited rights of attribution and integrity contained in section

fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include —

(A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;

(ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;

(iii) any portion or part of any item described in clause (i) or (ii);

(B) any work made for hire; or

(C) any work not subject to copyright protection under this title.

17 U.S.C. § 101 (2000).

28. *See Id.* Moral rights protection that is available to civil law artists on the European continent is much stronger than the protection that is available to artists in the United States. For example, in *Huston v. Le Cinq*, the French Cour de Cassation held that the moral rights of the late John Huston could be enforced against a French television station to enjoin the broadcast of a colorized version of *The Asphalt Jungle*, despite the fact that the work was created in the United States under an employment agreement, and despite the fact that the movie studio had the right to determine when and how the film would be released. The French high court reversed the Paris Court of Appeals, which analyzed much of the case with respect to the country of origin of the work. Moral rights protection in many other countries also applies to reproductions of works. *See Merryman, supra* note 15, at 1029-30 (discussing case in which plaintiff was successful in action against Paris department store, Galleries Lafayette, for displaying altered image of original artwork by painter Henri Rousseau); Jane C. Ginsburg, *Art and the Law: Suppression and Liberty*, 19 CARDOZO ARTS & ENT. L.J. 9, 11 (2001) (discussing French cases involving altered reproductions of originals).

106A. The Visual Artists Rights Act of 1990 is more of an “art preservation” act instead of a broad moral rights act.²⁹

In addition to the subject matter limitations of federal moral rights protection under section 106A, the scope of moral rights generally is further limited by the preemption provisions contained in section 301 of the Copyright Act.³⁰ Section 301(d) expressly states, “[n]othing in this title annuls or limits any rights or remedies under any other Federal statute.”³¹ As discussed, *infra*, at the time that VARA became law, it was generally understood and well accepted that an aggrieved author or artist could successfully bring a section 43(a) “false designation of origin” action to correct inaccuracies.

29. During the congressional hearings related to the Visual Artists Rights Act, Professor Jane Ginsburg testified before Congress:

The bill recognizes the special value inherent in the original or limited edition copy of a work of art. The original or few copies with which the artist was most in contact embody the artist’s “personality” far more closely than subsequent mass produced images. Accordingly, the physical existence of the original itself possesses an importance independent from any communication of its contents by means of copies. . . . Were the original defaced or destroyed, we would still have the copies, we would all know what the work looked like, but, I believe, we would all agree that the original’s loss deprives us of something uniquely valuable.

The Visual Artists Rights Act of 1989: Hearings on H.R. 2690 Before the Subcommittee on Courts, Intellectual Property, and the Administration of Justice of the House Committee on the Judiciary, 101st Cong. 84 (1989) (statement of Professor Jane Ginsburg, Associate Professor, Columbia Law School).

30. 17 U.S.C. § 301 provides in part:

(d) Nothing in this title annuls or limits any rights or remedies under any other Federal statute

(f)(1) On or after the effective date set forth in section 610(a) of the Visual Artists Rights Act of 1990, all legal or equitable rights that are equivalent to any of the rights conferred by section 106A with respect to works of visual art to which the rights conferred by section 106A apply are governed exclusively by section 106A and section 113(d) and the provisions of this title relating to such sections. Thereafter, no person is entitled to any such right or equivalent right in any work of visual art under the common law or statutes of any State.

(2) Nothing in paragraph (1) annuls or limits any rights or remedies under the common law or statutes of any State with respect to—

(A) any cause of action from undertakings commenced before the effective date set forth in section 9(a) of the Visual Artists Rights Act Of 1990;

(B) activities violating legal or equitable rights that are not equivalent to any of the rights conferred by section 106A with respect to works of visual art; or

(C) activities violating legal or equitable rights which extend beyond the life of the author.

17 U.S.C. §§ 301(d), (f) (2000).

31. 17 U.S.C. § 301(d).

rate attribution and/or alteration and misattribution of his work.³² Section 301(f) deals with preemption of state law by the Visual Artists Rights Act and expressly provides that state statutes or common law that govern “legal or equitable rights that are not equivalent to any of the rights” granted under the Visual Artists Rights Act are not preempted.³³ The literal language contained in the Copyright Act itself and the House Report illustrate that Congress intended to allow plaintiffs to proceed with both federal and state actions that are not equivalent to the limited rights granted under section 106(A). In fact, a specific example of the type of state actions that would not be preempted by VARA involves state actions related to motion pictures: “Consistent with current law on preemption for economic rights, the new Federal law will not preempt State causes of action relating to works that are not covered by the law, such as *audiovisual works* [and] photographs produced for non-exhibition purposes”³⁴

The absence of an attribution right from copyright law, the body of law that covers forms of artistic expression, is even more striking when one considers that under U.S. patent law, inventors must receive attribution.³⁵ Deliberate failure to list one who is an inventor on an application or the deliberate inclusion of one who did not participate as an inventor can result in total forfeiture of all patent rights. If the addition or omission of a name is inadvertent, an action can be initiated to correct the record. In such cases, there is no loss of right.³⁶ There is no analogous “work made for hire” doctrine in patent law that makes the employer the named “inventor.” Even in cases in which the invention is created by company employees or independently created and then assigned to a

32. Depending upon the copyright status of the work in question and the relationship of the parties, the author may also have had the right to bring an action for infringement of the right to prepare derivative works.

33. For a discussion of preemption of New York State’s moral rights statute, N.Y. Art & Cultural Affairs Law § 14.03 (McKinney Supp. 2004), by U.S. copyright law prior to the enactment of the Visual Artists Rights Act, see *Wojnarowicz v. American Family Ass’n*, 745 F. Supp. 130, 136 n.2 (S.D.N.Y. 1990), in which an artist was successful under the New York moral rights statute against a conservative religious organization that distributed misleadingly labeled reproductions of small sexually-related portions of his work. The Southern District of New York held that the New York statute was not preempted because the rights granted thereunder were not equivalent to rights granted under the Copyright Act. The Court did hint that had VARA already taken effect, the New York statute probably would have been preempted.

34. H.R. REP. NO. 101-514, at 21 (1990) (emphasis added).

35. See 35 U.S.C. § 116 (2000).

36. 35 U.S.C. § 256 (2000).

company, the patent is still listed in the names of the original inventors.³⁷

IV.
U.S. TRADEMARK LAW AND SECTION 43(A) FALSE
ATTRIBUTION ACTIONS PRIOR TO *DASTAR*.

Before examining the *Dastar* opinion in depth, I will first discuss some basics of U.S. trademark law and lay the foundation for “moral rights” type attribution claims under section 43(a)³⁸ of the Lanham Act³⁹ by examining the purpose, scope and application of U.S. trademark law.

Trademark laws serve several purposes⁴⁰ and are meant to protect the interests of both trademark holders and consumers.⁴¹ The primary role of a trademark or a word or name that functions as a trademark is to distinguish the holder’s goods and services from the goods and services of others and to identify for the relevant public the source of goods and/or services “even if that source is unknown.”⁴² A trademark also serves to inform the public of certain

37. See 37 C.F.R. § 1.46 (2003).

38. 15 U.S.C. § 1125(a) (2000).

39. Lanham Act, 15 U.S.C. §§ 1051-1141n (2000 & Supp. 2004), U.S. Patent & Trademark Office, *available at* <http://www.uspto.gov/web/offices/tac/tmlaw2.html> (last accessed on March 27, 2005).

40. J. Thomas McCarthy lists four functions trademarks perform:

(1) To identify one seller’s goods and distinguish them from goods sold by others; (2) to signify that all goods bearing the trademark come from or are controlled by a single, albeit anonymous, source; (3) to signify that all goods bearing the trademark are of an equal level of quality; and (4) as a primer instrument in advertising and selling the goods.

1 J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 3.2 (4th ed. 1996 & Supp. 2004) (citing *Springfield Fire & Marine Ins. Co. v. Founders’ Fire & Marine Ins. Co.*, 115 F. Supp. 787, 792 (D. Cal. 1953)).

41. Congress receives its power to regulate trademarks from the Commerce Clause of the United States Constitution, which permits federal legislation “to regulate commerce with foreign nations, and among the several states, and with the Indian tribes.” U.S. CONST. art. I, § 8, cl. 3. To further emphasize the difference between trademarks and the other forms of intellectual property, it should be noted that the constitutional authority for regulating trademarks originates from a different clause of section 8 of the Constitution than for regulating copyrights and patents. See U.S. CONST. art. I, § 8, cl.8.

42. Lanham Act § 45, 15 U.S.C. § 1127 (2000). The “even if that source is unknown” language was added as part of the Trademark Clarification Act of 1984, Pub. L. No. 98-620, 98 Stat. 3335 (1984), largely in response to *Anti-Monopoly, Inc. v. Gen. Mills Fun Group*, 684 F.2d 1316 (9th Cir. 1982), in which the Ninth Circuit held that the trademark “Monopoly” for a board game was no longer valid. See S. REP. NO. 98-627 at 9 (1984), *reprinted in* 1984 U.S.C.C.A.N. 5708, 5718, 5726. The

attributes of the goods and/or services connected to the mark such as status, quality, reliability or resale value.⁴³ “For example, the marks ‘Rolls Royce’ and ‘Fiat’ do more than just tell prospective purchasers that the two cars come from different sources.”⁴⁴ The marks “Cartier” and “Wal-Mart” tell consumers much more than just the names of different stores with multiple locations. Similarly, “PBS” and “MTV” tell television viewers more than just the names of the content providers; they explain a great deal about the content itself. It is this combination of the ability to identify both the source of goods and services and the attributes or qualities (good or bad) of the goods and services that makes the proper and accurate use of trademarks and source indicators so important.⁴⁵

Trademark law, therefore, protects two distinctly different groups. On one hand, trademark law protects commercial entities, the companies that use the trademarks in connection with the advertising and selling of their goods and services. The enforcement of trademark law allows a trademark owner to reap the benefits of the “good will” and reputation that have been cultivated over the years, while also preventing competitors from taking a “free ride” on that reputation. On the other hand, trademark law also protects the public by preventing the confusion or deception that results from a use of a similar mark that is inconsistent with the quality and nature of the goods associated with the original mark.

The protections provided under U.S. law by the Lanham Act are not limited only to infringement actions brought by the owners of federally registered trademarks against infringers⁴⁶ or counter-

mark had become generic because its primary significance was to identify not its source, Parker Brothers, but the game itself. *Anti-Monopoly*, 684 F.2d at 1319. For a mark to be generic, it has to identify a category of products, not the source of one of the members of a category. S. REP. NO. 98-627 at 1. By finding that “Monopoly” was generic, the Ninth Circuit essentially held that the relevant market was not board games but real estate board games depicting Atlantic City, New Jersey.

43. See generally William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987) (discussing the benefits of trademarks as sources of information about the nature and quality of goods and services as well as indicators of source); Stephen L. Carter, *The Trouble With Trademark*, 99 YALE L.J. 759 (1990) (“Successful marks are like packets of information. They lower consumer search costs, thus promoting the efficient functioning of the market.”)

44. LINDEY AND LANDAU, *supra* note 17, § 2:2 at 2-15.

45. See William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 277-78 (1988).

46. See 15 U.S.C. § 1114(1) (2000) (authorizing infringement actions by trademark registrants).

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feeters.⁴⁷ The language of section 43(a) is quite broad and protects against many kinds of unfair and/or misleading business practices. Section 43(a) of the Lanham Act provides:

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.⁴⁸

Section 43(a) of the Lanham Act has been successfully asserted to prevent unfair competition,⁴⁹ false designations of origin,⁵⁰ false advertising,⁵¹ infringement of unregistered marks, infringement of

47. See 15 U.S.C. § 1116 (2000) (authorizing *ex parte* seizures of counterfeit goods).

48. 15 U.S.C. § 1125(a) (2000).

49. See, e.g., *Vais Arms, Inc. v. Vais*, 383 F.3d 287 (5th Cir. 2004); see also 2 RUDOLF CALLMANN, UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 11.1 (Louis Altman ed., 4th ed. 2003); cf. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:48, at 11-102 (4th ed. 2003) (discussing the “fair use” trademarks defense).

50. Veronica Tucci, *The Case of the Invisible Infringer: Metatags, Trademark Infringement and False Designations of Origin*, 5.2 J. TECH. L. & POL'Y 2, at <http://grove.ufl.edu/~techlaw/vol5/issue2/invisible.html> (2000) (discussing “false designation of origin” lawsuits as a way of preventing the use of metatags or invisible code on competitors' web pages).

51. False advertising claims would be brought under section 43(a)(1)(B), as opposed to section 43(a)(1)(a). See, e.g., *JR Tobacco of Am., Inc. v. Davidoff of Geneva, Inc.*, 957 F. Supp. 426, 431 (S.D.N.Y. 1997) (finding cigar advertisements and brochures literally false); *Coca-Cola Co. v. Tropicana Products, Inc.*, 690 F.2d 312, 318 (2d Cir. 1982) (finding claim that orange juice was “pure pasteurized juice as it come from the orange” literally false); *Coors Brewing Co. v. Anheuser-Busch Co.*, 802 F. Supp. 965, 967 (S.D.N.Y. 1992) (holding that Coors Beer distributed East of the Mississippi River did not contain “Colorado Rocky Mountain Spring Water”); see also Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L. J. 1717 (1999).

trade dress,⁵² and a cause of action that is akin to the “right of publicity,”⁵³ namely creating a “false impression of endorsement, sponsorship or affiliation.”⁵⁴ Because the United States did not have any express “moral rights” protection whatsoever until the promulgation of the very limited protection in the Visual Artists Rights Act of 1990 for “works of visual art,” creative parties have asserted section 43(a) “false designation of origin” claims either to obtain proper attribution for a work or to prevent the use of their identities in connection with an altered work.”⁵⁵

Section 43(a) “false designation of origin” claims had been successfully asserted for years to correct perceived attribution inaccuracies in many different media. In 1951, in *Granz v. Harris*,⁵⁶ jazz producer Norman Granz was successful in an action to enjoin the distribution of heavily edited recordings bearing the legend “produced by Norman Granz.” In *PPX Enterprises, Inc. v. Audiofidelity En-*

52. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (section 43(a) action successful against party with similar “trade dress” or overall visual appearance of Mexican restaurant); *cf. Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) (distinguishing *Two Pesos* by requiring proof of “secondary meaning” or “association in the minds of consumers with source” for all “product design” trade dress; “product packaging” trade dress can still be inherently distinctive). *See generally* Joan L. Dillon, *Two Pesos: More Interesting for What It Does Not Decide*, 83 TRADEMARK REP. 77 (1993); Michael B. Landau, *Reconciling Qualitex with Two Pesos: Ambiguity and Inconsistency From the Supreme Court*, 3 U.C.L.A. ENT. L. REV. 219 (1996); Vincent N. Palladino, *Trade Dress After Two Pesos*, 84 TRADEMARK REP. 408 (1994); George R. Stewart, *Two Pesos for a Taco: Inherent Distinctiveness and a Likelihood of Confusion for Protectable Trade-mark Rights—Hold the Secondary Meaning*, 8 INTELL. PROPERTY JNL. 1 (1993); Note, *Two Pesos, Inc. v. Taco Cabana, Inc.: The Supreme Court’s Expansion of Trade Dress Protection Under Section 43(a) of the Lanham Act*, 24 LOY. U. CHI. L.J. 285 (1993); Note, *The Same Old Enchilada? The Supreme Court Simplifies The Protection of Inherently Distinctive Trade Dress*, 13 REV. LITIG. 299 (1994); Note, *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992), 60 TENN. L. REV. 449 (1993).

53. *See* LINDEY AND LANDAU, *supra* note 17, § 2:49.

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54. Plaintiffs in “Right of Publicity” lawsuits usually include section 43(a) causes of actions for “false impressions of sponsorship or endorsement” in their complaints as well. *See, e.g., Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 410 (9th Cir. 1996); *Waits v. Frito Lay, Inc.*, 978 F.2d 1093, 1106–07 (9th Cir. 1992); *Prudhomme v. Proctor & Gamble Co.*, 800 F. Supp. 390, 392 (E.D. La. 1992); *see also* 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 5:20 (2d ed. 2004).

55. For discussions of the doctrine of moral rights, *see generally* Diamond, *supra* note 15; Kwall, *American Marriage*, *supra* note 15; Ong, *supra* note 15; Roeder, *supra* note 15; Rosen *supra* note 15; Russ VerSteeg, *Federal Moral Rights for Visual Artists: Contract Theory and Analysis*, 67 WASH. L. REV. 827, 842–43 (1992).

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56. 198 F.2d 585, 588 (2d Cir. 1952).

terprises, Inc.,⁵⁷ the company that held rights to the recordings of the late Jimi Hendrix was successful in a section 43(a) claim against a defendant who sold records purporting to contain previously unreleased Jimi Hendrix material when, in actuality, the recordings merely had Hendrix playing in the back-up band of another performer.⁵⁸ In *Benson v. Paul Winley Record Sales Corp.*,⁵⁹ guitarist and singer George Benson similarly objected to the release of old tapes under the pretense that they were a “new album.”

Section 43(a) claims have also been brought by authors and composers to correct errors in attribution or credit. For example, in *Follett v. Arbor House Pub. Co.*,⁶⁰ Ken Follett, a well known author, was successful against a publisher who created the impression that he was the principal author when, in fact, he had had a very minor role in writing the book. In *Lamothe v. Atlantic Recording Corp.*,⁶¹ a member of the group “RATT,” whose name was omitted from the song writing credits, was able to sustain a valid claim under section 43(a) of the Lanham Act for “false designation of origin” of the songs. In *Smith v. Montoro*,⁶² an actor who appeared in the movie “Convoy Buddies” was not listed in the credits as having played the role. The name of another actor was listed in the credits instead. The court sustained the plaintiff’s false designation of origin claim for “reverse passing off.”⁶³

57. 818 F.2d 266 (S.D.N.Y. 1987).

58. *Id.*; see also *Benson v. Paul Winley Record Sales Corp.*, 452 F. Supp. 516 (S.D.N.Y. 1978) (deceptive marketing of old records of George Benson); *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981) (substituting false name in film credits and advertising).

59. 452 F. Supp. 516.

60. 497 F. Supp. 304 (S.D.N.Y. 1980); *c.f.*, *Clevenger v. Baker Voorhis & Co.*, 8 N.Y.2d 187, 192 (N.Y.1960) (holding very poorly edited and error ridden new edition of reference book with plaintiff listed as the primary author actionable under New York state law).

61. 847 F.2d 1403 (9th Cir. 1988).

62. 648 F.2d 602, 603 (9th Cir. 1981).

63. *Id.* at 607. Most trademark or unfair competition actions involve a second party distributing goods or providing services and creating the impression that they do not come from him, but from a more well-known, usually higher-quality entity. This is referred to as “passing off.” “Reverse passing off” occurs when a party presents someone else’s goods and services as his own, or credits them to another party or entity that is also different from the real party who provided the goods and services. For a discussion of reverse passing off, see John T. Cross, *Giving Credit Where Credit Is Due: Revisiting the Doctrine of Reverse Passing Off in Trademark Law*, 72 WASH. L. REV. 709, 715–26 (July 1997). See also Catherine Romero Wright, *Reverse Passing Off: Preventing Healthy Competition*, 20 SEATTLE U. L. REV. 785 (1997); 4 THOMAS J. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:6 (4th ed. 1996 & Supp. 2004).

The most famous case in which a plaintiff was successful in using section 43(a) of the Lanham to bring a “moral rights” type attribution claim in connection with an audiovisual work is *Gilliam v. ABC*,⁶⁴ often referred to as “the Monty Python case.” Several episodes of “Monty Python’s Flying Circus” were produced for the BBC for broadcast. The terms of the agreement between Monty Python and the BBC contained a provision prohibiting any material edits without express permission from the group. The agreement permitted the BBC to further license the limited right to broadcast the episodes to others. Through a series of transactions, the BBC licensed several episodes to Time Life.⁶⁵ Time Life, in turn, licensed the shows to ABC. Because the BBC was able to license only the rights that it possessed in the first place and no more, neither the BBC nor Time Life could have granted ABC any right to make material changes to the work.

Instead of broadcasting the shows in their complete forms as received, ABC excised substantial portions that it thought “contained offensive or obscene matter”⁶⁶ and also edited out content, of course, to make room for commercials. In total, almost one third of the content was removed. As a result, with so much content removed, many sketches or routines made no sense, at all. Scenes were not resolved, punch lines were omitted, and the result was, in the Monty Python Group’s opinion, a discontinuous mess, or what they considered to be an “actionable mutilation.”⁶⁷ They brought an action asserting section 43(a) claims for “false designation of origin.”

The gravamen of the 43(a) claim was that because ABC advertised the shows as “Monty Python’s Flying Circus,” and made no indication that the shows were severely edited, viewers who saw the edited episodes would get the impression that the edited versions were true representations of the group’s work, instead of ABC’s butchered and mutilated version of what used to be “Monty Python’s Flying Circus.” This would especially be true for most of the American audience because of the lack of familiarity with the group or their television episodes in uncut form. The plaintiffs were successful in convincing the court that ABC’s representations were

64. 538 F.2d 14 (2d Cir. 1976).

65. Time Life became TimeWarner, then AOL/TimeWarner, and then TimeWarner again.

66. *Gilliam*, 538 F.2d at 18.

67. *Id.* at 23-24.

“false designations of origin” in violation of section 43(a) of the Lanham Act and were able to win an injunction against ABC.⁶⁸

V.

*DASTAR CORP. V. TWENTIETH CENTURY FOX
FILM CORP.*

A. *Background*

In *Dastar Corp. v. Twentieth Century Fox Film Corp.*,⁶⁹ the Supreme Court was asked to define the relationship between U.S. copyright and trademark law. The case dealt with the copying, editing and repackaging of a public domain film under its own name by a competitor of the producers of the original work. The specific legal issue presented to the Court in the petition for *certiorari* was broad and clear: “whether § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), prevents the unaccredited copying of a work”⁷⁰ Although the work at the center of the controversy had fallen into the public domain, it is important to note that there was nothing in the issue certified for resolution by the Supreme Court that limited its analysis or holding to works in the public domain. Despite some references to “perpetual copyright” *in dicta*, the holding clearly applies to works that are both in the public domain and those that are still protected by copyright.

In 1949, Twentieth Century Fox produced a television series, *Crusade in Europe*, consisting of twenty-six episodes based upon the military memoirs of General Dwight Eisenhower, the thirty-fourth U.S. President, entitled *Crusade in Europe*, published by Doubleday in 1948. Doubleday renewed the book’s copyright, but Twentieth Century Fox failed to renew the copyright on the television series, causing the television series from the 1940s to fall into the public

68. They were also successful on their copyright claim. Their agreement gave the BBC the right to broadcast the shows and to license others to broadcast the shows, but not the right to make unapproved material edits. Because the BBC could not license anything more than its rights to others, neither Time Life nor ABC could have acquired any rights to make alterations. By making such excessive edits, ABC acted outside of the scope of the grant, and the resultant show was an unauthorized derivative work.

69. 539 U.S. 23 (2003).

70. *Id.* at 25. The actual questions presented in the petition for *certiorari* were: “1. Does the Lanham Act protect creative works from uncredited copying, even without a likelihood of consumer confusion? 2. May a court applying the Lanham Act award twice the defendant’s profits for purely deterrent purposes?” Petition for a Writ of Certiorari at i, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02-428).

domain.⁷¹ After renewing the copyright in the book, Doubleday once again licensed the television rights to Fox, including the exclusive right to distribute the *Crusade* television series on video and to sub-license others to do so.⁷²

In 1995, anticipating renewed interest in World War II in light of the upcoming fiftieth anniversary of the War's end, Dastar purchased several copies of Fox's public domain videotapes and then copied and edited the videotapes to make its own film titled "Campaigns in Europe." Dastar made substantial changes to the film by substituting a new opening sequence, credit page and final closing for those of the original *Crusade* television series. Dastar also inserted new chapter-title sequences, moved the 'recap' in the *Crusade* television series to the beginning and retitled it as a 'preview' and removed all references to and images of Eisenhower's book. Dastar also created new packaging for its video, removed all references to Twentieth Century Fox and listed itself and a subsidiary as producer and distributor.⁷³ Dastar's version was shorter than the Twentieth Century Fox film and sold for substantially less.

Twentieth Century Fox sued Dastar under section 43(a) of the Lanham Act for "false designation of origin" for releasing the Twentieth Century Fox video under the Dastar name.⁷⁴ The district court granted Twentieth Century Fox's section 43(a) claims, awarded Dastar's profits to Twentieth Century Fox and doubled the award in order to deter future violations.⁷⁵ The Court of Appeals

71. *Dastar*, 539 U.S. at 23. The copyright in the book was renewed. The issue of whether Dastar's videos infringed the underlying book was not the subject of the action before the Supreme Court. *See, e.g.*, *Russell v. Price*, 612 F.2d 1123, 1128 (9th Cir. 1979) (reaffirming well-established doctrine that a derivative copyright protects only the new material contained in the derivative work, not the matter derived from the underlying work).

72. *Id.* SFM Entertainment and New Line Home Video, Inc., in turn, acquired from Fox the exclusive rights to distribute "Crusade in Europe" on video. *Id.*

73. *Id.* at 26-27.

74. There was also a copyright infringement claim with respect to the copyright in the renewed book. The Court of Appeals for the Ninth Circuit found questions relating to the copyright status of the book based upon whether at the time it was written it would have been a work made for hire.

75. Lanham Act § 35, 15 U.S.C. § 1117(a) (2000), provides:

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125 [§ 43](a), (c), or (d) of this title, or a willful violation under section 1125 [§ 43](c) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 [§§ 29 and 32] of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff,

for the Ninth Circuit affirmed the judgment for Twentieth Century Fox on the Lanham Act claim.⁷⁶ They held that by copying substantially the entire *Crusade in Europe* series created by Twentieth Century Fox and labeling the resulting product with a different name and marketing it without attribution to Twentieth Century Fox, Dastar had committed a “bodily appropriation” of Twentieth Century Fox’s series⁷⁷ that was sufficient to establish “reverse passing off.” The Ninth Circuit also upheld the damages award under the Lanham Act.⁷⁸ Dastar appealed to the U.S. Supreme Court.

B. *The Supreme Court Opinion*

The Supreme Court reversed and held that section 43(a) of the Lanham Act does not prohibit the unaccredited or misattributed copying of a work. Justice Scalia, *in dicta*, expressed concerns that parties might attempt to use the Lanham Act to create a perpetual copyright by imposing restrictions on the use of public domain works.⁷⁹ As explained below, based upon the specific language in the petition for *certiorari* and the broad language in the holding regarding the inapplicability section 43(a) to cases involving artistic attribution and the perceived conflict with copyright law, the holding is not limited to public domain works. The attribution right under section 43(a) has been eliminated with respect to all works, regardless of copyright status.

The Court based its holding that section 43(a) of the Lanham Act does not prevent unaccredited copying of creative works on three grounds: first, the term “goods” in the statute applies only to the “tangible objects” and not to ideas or communications embod-

and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant’s sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

76. *Twentieth Century Fox Film Corp. v. Entm’t Distrib.*, 34 Fed. Appx. 312, 314 (9th Cir. 2002), *rev’d sub nom.* *Twentieth Century Fox Film Corp. v. Dastar Corp.*, 539 U.S. 23 (2003).

77. *Id.*

78. *Id.* at 315

79. *Dastar*, 539 U.S. at 37.

ied in those goods; second, once a copyright or patent expires, a party is free to copy a work without restriction; and third, laws related to communicative content are governed solely by copyright, and therefore, an artistic attribution claim under the Lanham Act would be in direct conflict with the provisions of the Visual Artists Rights Act.

I will address and analyze each of these in turn.

1. The Court Held That “Origin” in Section 43(a)
Applies Only to Tangible Physical Goods.

Twentieth Century Fox brought its case under section 43(a) of the Lanham Act, which provides a cause of action against one who uses a “false designation of origin” in connection with the provision of “goods or services.”⁸⁰ A discussion of the purpose and scope of section 43(a) of the Lanham Act is in the beginning of the *Dastar* opinion. Justice Scalia stated that Congress passed the Lanham Act to provide a federal cause of action to prevent “the deceptive and misleading use of marks,” and “to protect persons engaged in . . . commerce against unfair competition.”⁸¹ “As originally enacted, § 43(a) created a federal remedy against a person who used in commerce either ‘a false designation of origin, or *any false description* or representation’ in connection with ‘any goods or *services*.’”⁸² He then noted that section 43(a) is not a federal codification of the overall law of unfair competition, but can be applied only to “certain unfair trade practices prohibited by its text.”⁸³ In discussing section 43(a)’s applicability, Justice Scalia arrived at an unprecedented and extraordinarily narrow construction:

We think the most natural understanding of the “origin” of “goods”—the source of wares—is the producer of the tangible product sold in the marketplace, in this case the physical Campaigns videotape sold by Dastar. The concept might be stretched . . . to include not only the actual producer, but also the trademark owner who commissioned or assumed responsibility for (“stood behind”) production of the physical product. But as used in the Lanham Act, the phrase “origin of goods” is in our view *incapable of connoting the person or entity that originated the ideas or communications that “goods” embody or contain.*⁸⁴

80. 15 U.S.C. § 1125(a) (2000).

81. *Dastar*, 539 U.S. at 28. (quoting 15 U.S.C. § 1127 (2000)).

82. *Id.* at 29 (emphases added).

83. *Id.* (citing 4 McCARTHY, *supra* note 63, § 27:7, at 27-14).

84. *Dastar*, 539 U.S. at 31-32 (emphasis added).

By defining “goods” as the videotapes themselves, he was able to hold that there was no “false designation of origin” because *Dastar* did indeed produce the “goods” in question. By holding that “origin of goods” is “incapable” of identifying the creative parties behind “communicative works,” the Court effectively eliminated all artistic attribution claims under the Lanham Act related to the manufacture and distribution of items that embody creative content. The Court equated “goods” with the purely physical aspects of the “goods,” the plastic, the magnetic tape, screws and glue. The justices did not discuss whether there can be attributes of goods other than their physical components. An expanded discussion of the nature of “goods” was warranted. For example, can “goods” embody a commitment to quality and a respect for workmanship? Can “goods” reflect a philosophy, such as the use of only human, as opposed to machine labor, or the use of only natural, as opposed to synthetic components?

The express language of section 43(a) applies to goods and services,⁸⁵ yet there is no analysis in the *Dastar* opinion whatsoever with respect to services.⁸⁶ Analysis of the meaning of “origin of services” is conspicuously absent from Justice Scalia’s analysis. If, however, section 43(a) is to be applied to prevent “certain trade practices prohibited by the text,” the Court should have discussed the false designation of origin in connection with the “services” of producing and distributing the videotapes. If a company is involved in both the creation and production of motion pictures or videos and the sale and distribution of the finished tangible products, it will use its trademarks to protect the goods and use its service marks to protect all of the efforts and activities that go into the creation and production of the work. That is exactly what the plaintiffs in this case did. They registered *both* trademarks and ser-

85. 15 U.S.C. § 1125(a) (2000).

86. Services are protected by “service marks.” A “service mark” is defined as “any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.”

15 U.S.C. § 1127 (2000).

vices marks, as any rational studio, distributor or production company would have done.

The Twentieth Century Fox and New Line Cinema registrations were filed under two classes, one for goods and the other for services.⁸⁷ In section 1401.02(a) of the Trademark Manual of Examining Procedure ("TMEP"), International Class 9 for Goods covers "Electrical and Scientific Apparatus." Trademarks filed and registered in that category would protect the finished products⁸⁸ International Class 41 for Services covers "Education and Entertainment." Service marks filed and registered in that category would protect the services involved in the "presentation of works of visual art or literature to the public for cultural or educational purposes."⁸⁹ Twentieth Century Fox has service mark registrations for the "Production and Distribution of Motion Picture Films . . . and Videocassettes"⁹⁰ and "Production and Distribution of Pre-recorded Motion Picture Films . . . and Videocassettes."⁹¹ Fox's distributor, New Line Cinema, also has service mark registration in International Class 41 for "Production and Distribution of Entertainment and Educational Motion Pictures . . . in All Media."⁹²

87. See U.S. Trademark Registration No. 1846550 (registered July 26, 1994); U.S. Trademark Registration No. 1465225 (registered Nov. 17, 1987); see also U.S. Patent and Trademark Office, Trademark Manual of Examining Procedure § 1401.02(a), at 1400-4 to 1400-5 (3d ed. 2003) [hereinafter TMEP] (explaining International Classification of Goods and Services).

88. International Class 9 (Electrical and scientific apparatus) includes: "Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus." TMEP, *supra* note 87, § 1401.02(a), at 1400-10.

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89. International Class 41 (Education and entertainment) includes "Education; providing of training; entertainment; sporting and cultural activities. Explanatory Note: This class contains mainly services rendered by persons or institutions in the development of the mental faculties of persons or animals, as well as services intended to entertain or to engage the attention. Includes, in particular: services consisting of all forms of education of persons or training of animals; services having the basic aim of the entertainment, amusement or recreation of people; Presentation of works of visual art or literature to the public for cultural or educational purposes." TMEP, *supra* note 87, § 1401.02(a), at 1400-25.

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90. U.S. Trademark Registration No. 1602948 (registered June 19, 1990).

91. U.S. Trademark Registration No. 1465225.

92. U.S. Trademark Registration No. 1846550.

The prohibition in section 43(a) of the Lanham Act of “false designations of origin” should not apply only to those who label goods in a confusing or misleading manner, but also to those who misattribute the “services” that go into the creation and production of a physical communicative product. A tangible item most certainly can be the embodiment of the efforts of the artistic parties who were behind its creation. A motion picture can be a physical embodiment of the services of the director, studio or screenwriter; a sound recording can be the embodiment of the services of the composer and performers of the musical compositions; a book can be the embodiment of the author’s writing skills. Photographing, composing, directing and writing are all services under International Class 41—“Entertainment and Education”—the category under which the plaintiffs Fox and New Line took the time, trouble and money to register service marks. If Fox has service mark protection for the use of a mark in connection with the manufacturing, production and distribution of motion pictures and videocassettes, a party that is distributing a reproduction of Fox films under its own name could be considered to be making a “false designation of origin” with respect to the services that went into films.

In its Brief for Respondent,⁹³ although not specifically stating an action for infringement of a “service mark,” Twentieth Century Fox always used the terms “goods and services” together when referring to section 43(a) and cited a case, *Johnson v. Jones*,⁹⁴ in which a plaintiff architect was successful in a 43(a) claim against a competing architect who copied the plaintiff’s plans, removed the original architect’s signature and seal and replaced them with his own. The court held that they were engaged in the provision of the same “services” in the same market and that the mislabeling would confuse clients or potential clients.⁹⁵

It is definitely possible for goods to embody the services provided by those who created the physical objects. Certain artists, musicians and filmmakers provide their services in a unique and recognizable way. The landscape photographs of Ansel Adams are recognizable as coming from a specific photographer. They have very sharp focus and a long depth of field. Helmut Newton’s photographs, with their tall, striking women, are clearly recognizable as the result of his efforts. The same holds true for Richard Avedon

93. Brief for Respondent, 2003 WL 1101321, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02-428).

94. *Id.* at *35 n.11 (citing *Johnson v. Jones*, 149 F.3d 494, 499 (6th Cir. 1998)).

95. *Id.* (citing *Johnson*, 149 F.3d at 503).

and Annie Leibovitz. All of them have provided the services of taking photographs, and all of them have identifiable styles.

The same holds true for the music of Mozart or Thelonius Monk. Different artists or even production companies have different recognizable artistic markers. Some like “soft focus;” some like great detail. Some record music in one take. Some record the tracks separately and do sophisticated mixing. Some artists want every sound to be on the recording. For example, when one listens to recordings of Glenn Gould or Errol Garner, the sound of the musician grunting and humming along as he plays is evident. The musical styles, along with the vocalizations, identify the artists. It is absolutely ridiculous to hold that there could not be a “false designation of origin” claim against someone who copied the works of the abovementioned artists and published and distributed the copies under his own name and own label or publishing house because the person who made the misattributed copies was the party who actually created the “tangible goods”—the photographs, the CDs or the book.

The concept of creating a false impression of personal identity, or essentially, a false designation of the “origin of services,” has been addressed in a number of right-of-publicity cases. Plaintiffs in right-of-publicity lawsuits usually include section 43(a) claims for “false impressions of sponsorship or endorsement” in their complaints as well. The creation of a “false impression” is not in connection with goods; it is in connection with sponsorship or endorsement services. For example, in *Waits v. Frito Lay*,⁹⁶ singer Tom Waits was successful in asserting a section 43(a) claim against a company that used a “sound alike” in a commercial. The sound-alike created the impression that he was providing the singing services of Tom Waits. The same was true in Bette Midler’s case against Ford for using a sound-alike in a commercial.⁹⁷ Singing in a commercial is not a “good.” It is providing a service.

In *Romm Art Creations Ltd. v. Simcha International, Inc.*,⁹⁸ the sale of art posters done in an artistic style very similar to another artist was a “false designation of origin.” In *Gilliam v American Broadcast-*

96. 978 F.2d 1093, 1112 (9th Cir. 1992).

97. See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); see also *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (finding for plaintiff Woody Allen against company that used look-alike in advertisement). For a discussion of the Right of Publicity, see generally LINDEY AND LANDAU, *supra* note 17, §§ 3:16-3:22; 1 MCCARTHY, *supra* note 54, § 5:20.

98. 786 F. Supp. 1126, 1133 (E.D.N.Y. 1992).

ing Company,⁹⁹ the false designation of origin was also with respect to services: the writing and production of television programs. Indeed, after *Dastar*, it is doubtful that Gilliam would be successful on his 43(a) claim.

It should be noted that the Supreme Court did leave open a few slivers of possibilities of recovery under the Lanham Act. For example, Justice Scalia opined that had *Dastar* purchased actual physical copies of the Fox films, relabeled them, repackaged them and then distributed them under the *Dastar* name, that would have been infringement, for under those facts, *Dastar* was not the true source of the goods. Under the facts of the case before the Court, because *Dastar* made the copies that it labeled under its own name, there was no Lanham Act violation, for *Dastar* *was* the source of the goods.

It does not take a room full of “rocket scientists” to figure out that it makes more sense to buy some public domain videotapes, copy them, repackage, relabel and distribute them and totally avoid liability than it does to buy thousands of actual copies of a competitor’s film, repackage and distribute them and be liable for damages and possibly attorneys’ fees. The Court also wrote that there could be liability under section 43(a)(1)(B)¹⁰⁰ for making false statements in the promotion of the films. However, if the actual copying and marketing of the “goods” is not a violation, then stating that the films are “brought to you by *Dastar*” or “produced and distributed by *Dastar*” should not be false statements of fact under section 43(a)(1)(B).

2. Public Domain and Perpetual Copyright Concerns

The Court then addressed whether there are restrictions that can be imposed on a party who wishes to copy a work that has fallen into the public domain. Citing cases such as *Sears, Roebuck & Co. v.*

99. 538 F.2d 14 (2d Cir. 1976).

100. Section 43(a)(1)(B) of the Lanham Act provides:

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—

...

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.

Lanham Act, 15 U.S.C. § 1125(a)(1)(B) (2000).

*Stiffel Co.*¹⁰¹ and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*¹⁰² the Court explained:

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.” The rights of a patentee or copyright holder are part of a “carefully crafted bargain,” under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and *without attribution*.¹⁰³

Justice Scalia is attempting to create new law in this section, for while it is axiomatic that a party may copy a work that is not protected by copyright or patent, there is absolutely nothing in the Patent Act, the Copyright Act or the cited precedent that stands for the proposition—or could even lead to the conclusion—that parties are free to copy a work without ever having to give proper attribution. Copying a work without giving attribution is plagiarism, and the Court, in this section of the opinion, is giving its blessings to the practice.

The Court’s legal analysis regarding the effect of copyright on patent expiration is just plain wrong. The cases that are cited for the proposition that “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” are not on point. Both *Sears, Roebuck & Co. v. Stiffel Co.*¹⁰⁴ and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*¹⁰⁵ were federal preemption cases, dealing with whether state laws that prevented copying could be enforced when there was no federal protection available.

101. 376 U.S. 225 (1964).

102. 489 U.S. 141 (1989).

103. *Dastar*, 539 U.S. at 33-34 (emphasis added) (quoting *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151 (1989)). The full quote from *Bonito Boats*, from which the “carefully crafted bargain” language is taken, is as follows and says nothing whatsoever about “without attribution”: “The federal patent system thus embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years.” See also *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001) (“In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.”).

104. 376 U.S. 225.

105. 489 U.S. 141.

Neither case had anything to do with a supposed conflict among different federal statutes. In *Kellogg Co. v. National Biscuit Co.*, although competitors were free to copy the pillow-shaped form of the shredded wheat, the Supreme Court made it clear that the freedom to copy the product was subject to an “obligation . . . to use every reasonable means to prevent confusion.”¹⁰⁶

There is no conflict between the Lanham Act and the Copyright Act. Nothing in the Copyright Act discusses attribution as one of the exclusive rights of the copyright holder, other than the very limited right in connection with “works of visual art.” Both the legislative history and the actual statutory text expressly provide that the Visual Artists Rights Act does not annul or limit any other rights under federal law. The fact that Congress provided an express attribution right in connection with a very small category of art works should have no effect whatsoever on the applicability of section 43(a) to prevent false designations of artistic attribution.

Justice Scalia is again legislating from the bench, as he so blatantly and unashamedly did in *Wal-Mart Stores, Inc v. Samara Bros., Inc.*,¹⁰⁷ a trade dress case from 2000 in which he rewrote the Lanham Act by requiring “secondary meaning” to be proved in order to protect “product design” trade dress despite the express absence of “product design” in either section 2(e)¹⁰⁸ or section 2(f)¹⁰⁹ of the Lanham Act.¹¹⁰ The Copyright and Patent Acts, with the exception of the little sliver that applies only to “works of visual art,” deal with reproduction, making, using, and selling rights. They do not deal with attribution. The right to “copy without attribution” is simply not there.

The Supreme Court has never held that if a work is not protected by patent or copyright, one is free to copy it without restriction. If that were the case it would be the end of almost all trademark law, for most trademarks that are not graphic marks can-

106. 305 U.S. 111, 121 (1938).

107. 529 U.S. 205 (2000).

108. 15 U.S.C. § 1052(e) (2000) (setting forth several categories of marks that will be denied registration for a lack of distinctiveness, including “merely descriptive” marks, “primarily geographically misdescriptive” marks and marks that are “primarily merely a surname.” These marks may be registered and protected under the provisions of Section 2(f).

109. 15 U.S.C. § 1052(f) (2000) (listing the categories of marks that can be registered if the “mark has become distinctive of the applicant’s goods in commerce” by showing secondary meaning).

110. For a detailed discussion of the protection of trade dress, see generally Joan L. Dillon & Michael Landau, *Two Pesos v. Taco Cabana: Still More Interesting for What it Did Not Decide*, 94 TRADEMARK REP. 944 (2004).

not be protected by copyright. Section 202.1(a) of the Copyright Office Regulations¹¹¹ provides, “Words and short phrases such as names, titles and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; [and] mere listing of ingredients or contents” are not subject to copyright. Most trademarks would fall within those categories of uncopyrightable material. The fact that “Don’t Leave Home Without It,” “Microsoft,” “Zoom, Zoom, Zoom,” “Jaguar” and “It’s the Real Thing” are not protected by copyright does not mean that they can be used in any manner. A company should not be allowed to make coffee cups and T-shirts with these marks with impunity by claiming that it is the true “origin of goods,” namely the manufacturer of physical items. Similarly, when the copyright to Mickey Mouse eventually expires, it should be a section 43(a) violation for one to make and sell merchandise with Mickey’s image. A false impression of affiliation with Disney would be created, and one should not be able to avoid liability by claiming that section 43(a) only applies to goods.

During the term of the copyright, if a use is unauthorized and does not fall within “fair use”¹¹² or one of the other statutory exemptions, the party using the work without authorization infringes one or more of the copyright holder’s exclusive rights under section 106¹¹³ and can be enjoined¹¹⁴ and held liable for damages¹¹⁵ and attorneys’ fees.¹¹⁶ When the copyright expires and the work falls into the public domain, any member of the public is free to copy the work, distribute the work, perform the work and alter or modify the work. The right of attribution is not one of the exclusive rights enumerated in section 106. Unlike the right of reproduction, the right of distribution and the other exclusive rights, there is no exclusive right of attribution that is extinguished when a copyright expires.

As a policy matter, the public domain is important, as is emphasized by Professor Jessica Litman, in that it furnishes the raw material for others to use.¹¹⁷ Giving attribution does not, in any

111. Registration of Claims to Copyright, 37 C.F.R. § 202.1(a) (2003).

112. See 17 U.S.C. § 107 (2000).

113. 17 U.S.C. § 106. (2000).

114. 15 U.S.C. § 502 (2000).

115. 15 U.S.C. § 504 (2000).

116. 15 U.S.C. § 505 (2000).

117. Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965 (1990) (“It furnishes a crucial device to an otherwise unworkable system by reserving the raw material for the commons, thus leaving that raw material available for other authors to use. The public domain thus permits the law of copyright to avoid a con-

way, diminish or restrict the “raw material.” It merely provides credit where credit is due. For example, by naming the compositions “Variations on a Theme by Paganini (Op. 35)” and “Variations and Fugue on a Theme by Handel (Op. 24),” Brahms informed musicians and listeners alike that his new works incorporated the works of the other composers. The works and styles of three composers, Brahms, Paganini and Handel, are preserved. Accurate attribution helps to establish individual reputations and builds a cultural heritage by identifying works with their authors.

Imagine the result over time if after works fell into the public domain, others claimed the works as their own. Bodies of works would not be associated with certain artists or composers who created them. It is not implausible that unscrupulous individuals with money and marketing plans could over time hijack the reputations of their predecessors and falsely build their own reputation by aggressively promoting the works of others as their own.

3. The Court Perceived an Apparent Conflict
Between Section 43(a) and the Copyright Act.

The Court went on to address the relationship between copyright law and trademark law and arrived at a conclusion that severely limits the scope and application of the Lanham Act. Despite more than a half-century of cases holding otherwise, the Court held that a “false designation of origin” claim under section 43(a) could not be maintained against a defendant who commercializes creative material with improper or misleading attribution. Justice Scalia explained:

The problem with this argument . . . is that it causes the Lanham Act to conflict with the law of copyright, which addresses that subject specifically The Visual Artists Rights Act of 1990 provides that the author of an artistic work “shall have the right . . . to claim authorship of that work.” That express right of attribution is carefully limited and focused Recognizing in § 43(a) a cause of action for misrepresentation of authorship of noncopyrighted works (visual or otherwise) would render these limitations superfluous¹¹⁸

frontation with the poverty of some of the assumptions on which it is based.”); see also Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain*, 66 LAW & CONTEMP. PROBS. 173, 175-76 (2003); Robert P. Merges, *A New Dynamism in the Public Domain*, 71 U. CHI. L. REV. 183 (2004). See generally Mark Rose, *Nine-Tenths Of The Law: The English Copyright Debates And The Rhetoric Of The Public Domain*, 66 LAW & CONTEMP. PROBS. 75 (2003).

118. *Dastar*, 539 U.S. at 33-35 (quoting 17 U.S.C. § 106A(a)(1)(A) (2000)).

The Court held that a right of attribution in connection with any “communicative” work would create a conflict with the “carefully crafted” rights in section 106A of the Copyright Act.¹¹⁹ It is important to note that the language in the holding regarding the perceived conflict between the Lanham Act and the Visual Artists Rights Act is general and broad and makes no distinction whatsoever between works that are in the public domain and those that are still covered by copyright. *Dastar*, therefore, stands for the proposition that there is absolutely no right to prevent false attribution of a work under section 43(a) of the Lanham Act regardless of the copyright status of the work.

According to the Court, all issues related to attribution of any creative or communicative work should be governed solely by copyright law. Because the only attribution right that is available at present under the U.S. Copyright Act is the one under the Visual Artists Rights Act, which applies only to the very limited category of “works of visual art,” the result of *Dastar* is that there is no right of attribution at all under U.S. law for the vast majority of works.

In arriving at this holding, the Court did not demonstrate that it considered the respective rights that were “carefully crafted” by Congress. In contrast, the Court demonstrated that it has not read the statutes, legislative history, cases, commentary or anything else related to the respective nature, scope and purposes of copyright law and trademark law, or worse, that it either did not understand them or willfully disregarded the express language of Congress once again.

There is no conflict between section 43(a) of the Lanham Act and the Copyright Act, either with respect to the public domain provisions or the attribution provisions in the Visual Artists Rights Act. First, copyright and trademark law serve very different purposes. The purpose of the copyright law is to provide incentives in the form of “exclusive Right[s]” for “limited Times”¹²⁰ to authors

119. 17 U.S.C. § 106A.

120. Works created on or after January 1, 1978 are protected for a term of the life of the author plus seventy years thereafter. See 17 U.S.C. § 302(a) (2000). If a work is a “joint work,” the work is protected for a term of the life of the last surviving author plus seventy years thereafter. See 17 U.S.C. § 302(b) (2000). In the case of anonymous, pseudonymous works, or works made for hire created on or after January 1, 1978, the term of protection is for either 95 years from the date of first publication or 120 years from the date of creation, whichever comes first. For works created and copyrighted prior to January 1, 1978, that were still protected by copyright on January 1, 1978, the term of protection is now 95 years from the date of publication with notice or registration and deposit with the U.S. Copyright Office. See 17 U.S.C. § 304(a) (2000).

and artists to create, thereby adding to the “marketplace of ideas” and ultimately benefiting the public by providing them with access to more works.

If the Court had really considered the “carefully crafted” intellectual property statutes, it would have realized that copyright law and trademark law can easily coexist and that preventing “false designations of origin” and requiring proper attribution for all kinds of goods and services was a part of that “carefully crafted bargain.” There are all kinds of exemptions in both the Copyright Act¹²¹ and the Lanham Act.¹²² The mutual exclusivity of copyright and trademark is not one of them.¹²³

4. Bad Facts Make Bad Law

Although it sounds cliché, bad facts do make bad law. In *Dastar*, the facts were terrible; they presented the quintessential “damned if you do, damned if you don’t” conundrum. At first blush, it seems that *Dastar* probably would have been sued for “false designation of origin” under section 43(a) of the Lanham Act whether it gave credit to Twentieth Century Fox or not. In order to make its product, *Dastar* purchased actual copies of the videotapes, edited the series and added its own material. *Dastar* thereby seemingly put itself in what I will call “Monty Python’s Catch-22.”¹²⁴ By releasing the film without giving Twentieth Century Fox credit, *Dastar* allegedly engaged in “reverse passing off”—trying to convince the public that something that was made by someone else was made by it. However, had *Dastar* released their heavily edited version that was only a little longer than one-half of the Fox original, Fox proba-

121. See, e.g., 17 U.S.C. 102(b) (2000) (subject matter not eligible for copyright protection).

122. See, e.g., 15 U.S.C. § 1052 (2000) (listing types of marks ineligible for registration on the principal register); 15 U.S.C. § 1115(b) (2000) (describing defenses to incontestability).

123. It can also be argued that an action for attribution under section 43(a) of the Lanham Act and an action for attribution under VARA are different causes of action because the elements that a plaintiff must satisfy differ. In a section 43(a) false designation of origin claim, a plaintiff must prove a “likelihood of confusion.” In an attribution claim under VARA there is no such requirement. All that must be shown is that the artist’s name is either being used in connection with a work that he did not create or is not being used in connection with a work that he did create.

124. A “Catch-22” is described, in Joseph Heller’s novel of the same name, by the following scenario: “[He] would be crazy to fly more missions and sane if he didn’t, but if he was sane he had to fly them. If he flew them he was crazy and didn’t have to; but if he didn’t want to he was sane and had to.” JOSEPH HELLER, *CATCH-22* 46 (Simon and Schuster 1961).

bly would have complained along the lines of the plaintiff's arguments in *Gilliam v. ABC*: that Dastar was attempting to pass off its product as having been created or approved by Fox. "On the one hand, they would [have] face[d] Lanham Act liability for *failing* to credit the creator of a work on which their lawful copies [were] based; and on the other hand they could face Lanham Act liability for *crediting* the creator if that should be regarded as implying the creator's 'sponsorship or approval' of the copy."¹²⁵ The Court's solution to this apparent dilemma was simply to hold that section 43(a) did not apply rather than identify behavior that would avoid it in the future. Once Dastar's edits and changes had been made, the work was no longer solely that of Twentieth Century Fox nor was it solely attributable to Dastar. Dastar should have used a credit such as "based upon *Crusade in Europe*, previously produced and released by Twentieth Century Fox" or "contains scenes and footage from *Crusade in Europe*, previously released by Twentieth Century Fox."

C. *Ramifications of the Supreme Court's Decision in Dastar.*

The *Dastar* opinion's effect on the real world will be great and wide-reaching, possibly broader than the Court intended at the time that it decided the case. The question presented for review, however, was quite broad and so were many of the statements in the opinion. As a result, the decision applies to both public domain works and copyrighted works. In addition, state statutory and common law causes of action for "unfair competition," "false designation of origin," and "unfair trade practices" will probably also be preempted, closing even those avenues for recovery for misattribution. As a result, outside of institutions or professions with their own codes of conduct or internal sets of rules that severely punish plagiarism, we can expect plagiarism and artistic misattribution to dramatically increase.

1. The *Dastar* Holding Probably Preempts State Causes Of Action For Misattribution.

After the Supreme Court reversed the Ninth Circuit and held that section 43(a) was "incapable" of identifying the parties behind the "ideas of communicative" aspects of the work, the U.S. District Court for the Central District of California granted Dastar's motion for reconsideration of Twentieth Century Fox's state-based unfair

125. *Dastar*, 539 U.S. at 36.

competition claims.¹²⁶ The district court dismissed Fox's state claims, holding that the California reverse-passing-off claim was the same as the federal Lanham Act claim, and noting that they both are resolved by "applying the same test of consumer confusion."¹²⁷ "[T]he congruence of the California unfair competition claim and the Lanham Act claims was sufficient to warrant dismissal of Plaintiff's unfair competition claim."¹²⁸

2. The *Dastar* Holding Applies to Works Protected By Copyright and Public Domain Works.

Although the film that *Dastar* copied was no longer protected by copyright, the issue presented to the Supreme Court for resolution was not limited to works in the public domain. The issue in the petition for *certiorari* was "whether § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), prevents the unaccredited copying of a work"¹²⁹ The issue was *not* "whether §43(a) prevents the unaccredited copying of a work that is in the public domain and not protected by copyright."

The Court's holding regarding the inability of section 43(a) to apply to creative works was not limited to public domain works. The Court made a blanket holding that a right of attribution under section 43(a) was incapable of identifying creative parties because it would conflict with the provisions related to attribution in the Copyright Act.

Prior to the *Dastar* opinion, the creator of a work, or one who played a major part in connection with the production of a creative work or a "communicative product," as the Court called it, could bring an attribution claim under the Lanham Act. By holding that section 43(a) does not apply to claims for unaccredited copying without expressly limiting the decision to public domain works, the Court has eliminated all attribution rights under U.S. trademark law for all works, regardless of copyright status.

Since the *Dastar* decision, the lower courts have interpreted *Dastar* as applying to all works and have denied relief to those who have asserted attribution claims in connection with works that are not in the public domain. For example, in *Smith v. New Line Cin-*

126. See *Twentieth Century Fox Corp. v. Dastar Corp.*, No. CV98-07189FMC(EX), 2003 WL 22669587 (C.D. Cal. Oct. 14, 2003).

127. *Id.* at 1539.

128. *Id.*

129. *Dastar*, 539 U.S. at 25. For the actual questions presented in the petition for *certiorari*, see *Petition for a Writ of Certiorari*, *supra* note 70, at i.

ema,¹³⁰ the Southern District of New York held that a section 43(a) action related to an allegedly unattributed screenplay was “foreclosed by *Dastar*”¹³¹ because the plaintiff was not the originator of the “tangible good offered for sale,”¹³² the films themselves. In *Williams v. UMG Recordings*, plaintiff’s claim for attribution in connection with “story/screenplay” and “editing” in a new work were denied as a matter of law.¹³³ Similarly, in *Zyla v. Wadsworth, Div. of Thomson Corp.*, an author who had contributed to earlier versions of a college textbook brought a section 43(a) action for allegedly not receiving sufficient attribution in the most current edition of the text.¹³⁴ The First Circuit held that it was the same type of claim brought in *Dastar* and was therefore completely barred.¹³⁵

In *Borrego v. BMG U.S. Latin*,¹³⁶ the Ninth Circuit held that plaintiffs no longer had a “reverse passing off” claim for misattributing plaintiff’s copyrighted songs to another songwriter. In *Bob Creeden & Assoc. v. Infosoft, Inc.*,¹³⁷ the court denied plaintiff’s section 43(a) claim because it held that the “tangible product” was the finished software produced by the defendant, not the plaintiff’s software from which the defendant’s program had been derived.

While the Supreme Court may have intended to prevent the assertion of “false designation of origin” claims under section 43(a) to works in the public domain in order to avoid a “perpetual copyright,” the language of their opinion, and the opinions by the lower courts that have interpreted *Dastar*, have applied the 43(a) bar to copyrighted works as well.

3. The *Dastar* Decision Encourages Plagiarism and Artistic Misattribution

As discussed above, the Supreme Court not only held that section 43(a) is “incapable of connoting the person or entity that originated . . . ideas or communications,”¹³⁸ but also opined that “reading section 43(a) of the Lanham Act as creating a cause of action for . . . plagiarism . . . would be hard to reconcile with [the Court’s] previous decisions.”¹³⁹ The Court is encouraging plagiarism by

130. No. 03 Civ. 5274(DC), 2004 WL 2049232 (S.D.N.Y. 2004).

131. *Id.* at *7.

132. *Id.* at 4.

133. 281 F. Supp.2d 1177, 1183 (C.D. Cal. 2003).

134. 360 F.3d 243 (1st Cir. 2004).

135. *Id.* at 252.

136. No. 03-55430, 2004 U.S. App. LEXIS 6568, at **2-3 (9th Cir. 2004).

137. 326 F. Supp. 2d 876, 879 (N.D. Ill. 2004).

138. *Dastar*, 539 U.S. at 32 (emphasis added).

139. *Id.* at 36. Justice Scalia claimed that allowing an action for plagiarism under the Lanham Act would go against other Supreme Court trademark prece-

eliminating the primary causes of action¹⁴⁰ that an author has

dent, mainly *Wal-Mart Stores, Inc. v. Samara Bros, Inc. Dastar*, 539 U.S. at 36-37 (citing *Wal-Mart*, 529 U.S. 205 (2000)). The *Wal-Mart* decision, however, had absolutely nothing to do with artistic attribution; it dealt with whether the product design, a form of trade dress, of children's clothing could be protected and enforced against "knock-offs" without secondary meaning or consumer association with source. Nonetheless, Justice Scalia makes clear in the *Dastar* opinion that trademark law cannot deal with plagiarism.

140. On remand, the Central District of California held that Twentieth Century Fox's equivalent state unfair competition action was preempted. *See Twentieth Century Fox Corp. v. Dastar Corp.*, No. CV98-07189FMC(EX), 2003 WL 22669587 (C.D. Cal. Oct. 14, 2003). It is, therefore, doubtful whether state unfair competition or unfair business practice causes of action can currently survive under *Dastar*. There is one possible twist around the preemption problem.

While unattributed works of authorship, or direct quotations not presented as such, may not be actionable plagiarism under theories of "unfair competition" or "false designation of origin" anymore, the false attribution and/or presentation of material in quotation marks that, in reality, was never actually said by a party may rise to defamation. In *Masson v. New Yorker Magazine, Inc.*, 686 F. Supp. 1396 (N.D. Cal. 1987), *aff'd.*, 895 F.2d 1394 (9th Cir. 1990), *rev'd*, 501 U.S. 496 (1991), a well-known psychoanalyst brought an action against the author of an article containing fabricated misattributed quotations and the magazine in which the article appeared, claiming that placement of statements in quotation marks gave the readers the impression that the plaintiff had actually made the statements at issue. Based upon the nature of the statements attributed to him, the plaintiff alleged that the article defamed him. The district court found that the quotations were rational interpretations of the substance of the interviews between the plaintiff and the author, and granted summary judgment in favor of the defendants. The Ninth Circuit affirmed, but the Supreme Court reversed and remanded, holding that under California law, whether a writer acted with "actual malice" for purposes of meeting the liability standard in a defamation case was an issue for the jury. *Id.*

A strong argument can be made that because of the similarity of the causes of action for "false designation of origin" under the Lanham Act and "unfair competition" under most state laws, any state claim that was purely a false attribution claim would fail after *Dastar*. If, however, the misattribution can rise to potential defamation, the claim under state law for defamation should not be preempted by *Dastar*, for the complained-of harm is not merely incorrect association, but serious harm to reputation. It should be noted that some different sets of rules apply for defamation claims based upon misattribution on the Internet. Sections 1202(a) and (b) of the Copyright Act may provide a cause of action for providing any false copyright management information in connection with the electronic display or digital transmission of a work. "Copyright management information" includes "the name of, or any other identifying information about, the author of a work." 17 U.S.C. § 1202(c)(3) (2000). On the other hand, depending upon the jurisdiction, section 230 of the Communications Decency Act may preempt liability for state causes of action for those service providers or users who display or pass along misrepresentations that could possibly rise to the level of defamation. *See, e.g., Zeran v. America Online, Inc.*, 129 F.3d 327 (4th Cir. 1997) (holding that section 230 of the Communications Decency Act, 47 U.S.C. § 230 (2000), provides an absolute immunity to service providers and users for the actions of third parties on interactive computer networks and systems); *Blumenthal v. Drudge*, 992 F. Supp.

against one who has appropriated uncopyrighted material and passed it off as his own or used unattributed copyrighted portions of works in ways that would not infringe, such as “fair use.”¹⁴¹

Although some have used plagiarism and copyright infringement interchangeably, plagiarism and copyright infringement are not the same thing. While one who commits copyright infringement, (e.g., by reproducing and distributing another’s work without authorization), may also be committing plagiarism by not giving attribution to the original author, there are numerous situations—such as “fair use” and the use of public domain materials—in which the unauthorized use of a work may not rise to the level of copyright infringement, but certainly constitutes plagiarism.

Plagiarism is presenting another’s ideas or written material without giving attribution to the original author,¹⁴² or worse, giving the distinct impression that the unattributed material is the original work of the plagiarizer.¹⁴³ There are numerous definitions of plagi-

44 (D.D.C. 1998) (same); *Green v. America Online, Inc.*, 318 F.3d 465 (3d Cir. 2003) (same). *But see* *Grace v. eBay Inc.*, 16 Cal. Rptr. 3d 192 (Cal. Ct. App. 2004) (holding that section 230 does not provide immunity against those who distribute material that they know or have reason to believe is defamatory).

141. “Fair use” was initially a judicially created doctrine, but is now codified. 17 U.S.C. § 107 (2000).

142. It is not surprising at all that a group of judges would not want strict controls against plagiarism. Clerks do much of the writing of opinions published under judges’ names. I have yet to see a judicial opinion with a footnote acknowledging the authorial contribution of a clerk. In several recent articles, several commentators expressed the belief that when it comes to plagiarism, judges are some of the worst offenders. *See generally* Jaime S. Dursht, *Judicial Plagiarism: It May Be Fair Use but Is It Ethical?*, 18 *CARDOZO L. REV.* 1253 (1996); *see also* Roger Billings, *Plagiarism in Academia and Beyond: What Is the Role of the Courts?*, 38 *U.S.F. L. REV.* 391, 395 (2004). (“Perhaps the greatest wordsmiths of them all, lawyers and judges, are the biggest plagiarizers.”). Commenting on a judge’s order decertifying class status of a group of plaintiffs in a tobacco-related case, *Liggett Group v. Engel*, in which 86% of the language of the judge’s order was reproduced verbatim from the tobacco company’s briefs without attribution, Professor Alan Dershowitz is quoted as having said, “If a student ever did what this judge did, he’d be tossed out on his rear end from Harvard Law School We teach our students as a matter of ethics that when you borrow, you attribute. It’s more important in judicial decisions because the public has a right to know that the judge borrowed from one side or another’s brief. *See* Siobham A. Morrissey, *A Case of Judicial Plagiarism?*, 2 No. 30 *ABA JNL. E. REP.* 1 (Aug. 2, 2003).

143. Professor Green views the granting of attribution as a social norm. *See generally* Stuart P. Green, *Plagiarism, Norms, and the Limits of Theft Law: Some Observations on the Use of Criminal Sanctions in Enforcing Intellectual Property Rights*, 54 *HASTINGS L.J.* 167, 171 (2002) (discussing the moral and ethical implications of plagiarism); Billings, *supra* note 142 (discussing the repercussions of plagiarism in certain professions); Dursht, *supra* note 142 (severely criticizing the widespread

arism. Most are conceptually the same but are linguistically slightly different. What is quite interesting, especially when one considers the *Dastar* dictum that section 43(a) does not apply to plagiarism,¹⁴⁴ is that, in general, the definitions of plagiarism are expressed in the language of “garden variety” Lanham Act violations. As noted by Stuart Green,¹⁴⁵ plagiarism has been defined as “steal[ing] and pass[ing] off (the ideas or words of another) as one’s own” or “us[ing] (another’s created production) without crediting the source.”¹⁴⁶ The late Alexander Lindey, in *PLAGIARISM AND ORIGINALITY*, referred to plagiarism as “taking the product of another person’s mind and presenting it as one’s own.”¹⁴⁷ Roger Billings characterized plagiarism as “passing off others’ intellectual production as their own.”¹⁴⁸ The term “passing off” is classic trademark and unfair competition parlance.

In contrast, copyright protection has nothing at all to do with attribution or credit. It provides only the rights of reproduction, distribution, display, performance and others set forth under section 106. Moreover, there are statutory exemptions in the Copyright Act that allow one to use material without authorization yet not infringe. For example, under the “fair use” doctrine, one who, without any authorization from a copyright holder, uses portions of a copyrighted work for purposes “such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringe[r] of copyright.”¹⁴⁹ This is especially true in situations of re-

practice of judicial plagiarism and distinguishing between plagiarism and copyright infringement).

144. *See Dastar*, 539 U.S. at 36.

145. Green, *supra* note 143, at 173.

146. *Id.* at 173 (citing *MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY* 888 (10th ed. 1998)).

147. *Id.* (citing *ALEXANDER LINDEY, PLAGIARISM AND ORIGINALITY* 2 (1952)).

148. Billings, *supra* note 142, at 396.

149. Section 107 of the Copyright Act of 1976 provides:

Limitations on exclusive rights: Fair use

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

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porting, commentary and scholarship, in which a second author incorporates small portions of important and eloquently stated material from another author's work into his or her work. The use of the work, even though still protected by copyright, does not infringe. If the excerpt is properly attributed, all is well. If it is not given attribution, the author, although not infringing, would be plagiarizing.¹⁵⁰

Therefore, with respect to the use of material that does not infringe copyright, there is no cause of action for misattribution. If a work is copyrighted, unauthorized use can be enjoined under copyright law, but because there is no right of attribution among the exclusive rights of the copyright holder, it is highly doubtful that a judge could use his or her injunctive powers under section 502 to order attribution.¹⁵¹ Unless the work falls under the definition of a "work of visual art," or unless the misattribution of the work involves removing "copyright management information," (which includes the author's name in the digital display or transmission of a work that is still protected by copyright under section 1202),¹⁵² there is no express provision in copyright law for correcting the misattribution.¹⁵³ In contrast, under the Lanham Act, in addition to enjoining the "false designation of origin" or trademark infringement, for years, courts have granted monetary awards

(4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

17 U.S.C. § 107 (2000).

150. In the event that the original author is an employee of the second author, or created the work under the second prong of section 101(2)'s requirements for a "work made for hire," the second party would be the "author." In most schemes of legal protection in which there is protection for attribution, the rights belong to the "author."

151. *See* 17 U.S.C. § 502 (2000). The scope of injunctions under section 502 of the Copyright Act apply only to violations of Title 17. If a misattributed work does not fall under the definition of a "work of visual art," a court probably has no statutory authority to order that the liable party take corrective measures to rectify the inaccurate impression that the work was created by someone other than the other.

152. *See* 17 U.S.C. § 1202 (2000).

153. *See* *Wojnarowicz v. Am. Family Ass'n*, 745 F. Supp. 130, 136 (S.D.N.Y. 1990) (holding attribution claim under New York moral rights statute not preempted by the Copyright Act because at the time, slightly before the enactment of VARA, there was no equivalent right under copyright law).

to enable the aggrieved party to engage in “corrective advertising.”¹⁵⁴

The attribution provisions of the Visual Artists Rights Act apply only to single photographs for exhibition or signed and consecutively numbered limited editions of 200 or fewer.¹⁵⁵ The Visual Artists Rights Act does not apply to “any reproduction . . . of the work.”¹⁵⁶ Therefore, if a third party were to scan an image of one of the above-mentioned works and publish it as his own, while there might be a copyright infringement claim based upon the unauthorized reproduction, there could not be a false attribution claim. If the photographs taken by one of the photographers commissioned by the U.S. government to document the Great Depression, such as Walker Evans, Dorathea Lange or Russell Lee, were downloaded from the U.S. Library of Congress, the Visual Artists Rights Act would not apply to those photographs for several reasons. They are reproductions. They are “works made for hire.” They are U.S. Government works.¹⁵⁷ Under the Court’s logic, if a party scans an image, eliminates all references to the original photographer and sells the reproductions under his name, there is not a “false designation of origin” because the tangible goods—the physical copies of the photograph—did, indeed, originate from the copier. That result is absurd.

Let me present another hypothetical to illustrate the Supreme Court’s *Dastar* holding. Assume that I find some dusty reels of magnetic tape at a thrift shop. Because I still own a reel-to-reel tape player, I purchase the tapes, take them home and play them. The tapes turn out to be tapes recorded in the United States in the 1960s of a famous musician, say Eric Clapton, playing public-domain blues tunes. I, therefore, do not have to worry about copyright infringement with respect to the musical compositions. There also would not have been protection for the tapes because sound

154. See, e.g., *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1375 (10th Cir. 1977); *Zelinsky v. Columbia*, 335 F.3d 633, 641 (7th Cir. 2003).

155. See 17 U.S.C. § 101 (2000), for the definition of a “work of visual art.”

156. 17 U.S.C. § 106A(c)(3) (2000).

157. Under section 105 of the Copyright Act of 1976, works created by U.S. government employees within the scope of their employment are not protected by copyright. It is possible for the U.S. government to own works that are protected by copyright, if those works were acquired through donation, purchase, or satisfaction of an obligation. It is just those works created by the U.S. government that are not protected.

recordings¹⁵⁸ were not considered to be copyrightable subject matter until the Sound Recording Act of 1971.¹⁵⁹ Neither the compositions nor the sound recordings were protected by federal copyright.¹⁶⁰

Knowing that the works are in the public domain, I decide to enter into the record business and commercialize the recordings. I start my own record (or CD) company called “Misattribution Music” and then burn CD copies of the tapes. I list myself as both composer of the musical compositions and performer and release the CDs under my label. Under *Dastar*, there would be absolutely no Lanham Act section 43(a) violation, because first, section 43(a) is “incapable of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain,”¹⁶¹ and second, my recording company is, indeed, the “origin of goods” because I pro-

158. See Michael B. Landau, “Publication,” *Musical Compositions, and the Copyright Act of 1909: Still Crazy After All These Years*, 2 VAND. J. ENT. L. & PRAC. 28 (2000), for a detailed discussion of the status of musical compositions and sound recordings under the 1909 Copyright Act. Landau discusses how “sound recordings” were not viewed as “copies” of the musical compositions, but as “captured performances.” Performances were not “publications” for the purpose of being vested with copyrights. Therefore, the sound recordings, as captured performances, were also not “publications” of the underlying compositions. See also Benjamin Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 473 (1955).

159. H.R. REP. NO. 92-487, at 2 (1971); see also Landau, *supra* note 158, at 36. The Sound Recording Act extended protection to the sound recordings *themselves* as opposed to the “tangible medium of fixation” or “reproductions of sound recordings.” This protection was intended for the “aggregation of sounds” created by the record producers or the performers “whose performance is captured.” The statute’s legislative history indicates that its purpose was to stop the “unauthorized reproduction of phonograph records and tapes” by “record pirates;” the legislation was only to be effective until December 31, 1974, at which time the next copyright revision could possibly provide permanent protection. This protection was included as copyrightable subject matter in the 1976 Copyright Act as section 102. 17 U.S.C. § 102 (1994). Further, the legislative history of section 301 of the current act, dealing with common law preemption, reveals that Congress intended to both prevent pre-1972 sound recordings from enjoying “perpetual protection” under common law and to prevent such works from immediately falling into the public domain. H.R. REP. NO. 94-1476, at 133 (1976).

160. For purposes of this illustration, I am not taking into consideration whether state common law or statutory law could be used to prevent the distribution of unauthorized copies of pre-1972 sound recordings. See, e.g., *Capitol Records, Inc. v. Naxos of Am., Inc.*, No. 30, 2005 WL 756591 (N.Y. April 5, 2005) (holding that the original sound recordings, which had been recorded in the United Kingdom, had fallen into the public domain under U.K. law, and that New York common law protected pre-1972 sound recordings despite the fact that there was no federal protection).

161. *Dastar*, 539 U.S. at 32 (emphasis added).

duced and manufactured the recordings. There would also not be a claim under the copyright act for misattribution because VARA does not apply to recordings, musical compositions or reproductions of works. There may not be a claim under any analogous state law because it would be preempted. What is wrong with this picture?

VI. CONCLUSION AND PROPOSALS

The Supreme Court changed more than a half century of well-established law with its opinion in *Dastar*. While the Court may have had good intentions in attempting to eliminate use restrictions on works in the public domain, in attempting to achieve its objective, it arrived at a broad holding that completely eradicated all trademark-related attribution rights. The specific facts in *Dastar* almost guaranteed a holding with doctrinal problems.

As the law in the United States now stands, there is no longer a cause of action for false, inaccurate or omitted attribution under section 43(a) of the Lanham Act. The traditional road for relief has now been closed. This will have to be addressed, for it does not adequately recognize or reward creative parties, and it puts the United States further at odds with the rest of the world with respect to artists' rights.¹⁶² In the short run, more people, or their lawyers, will include attribution requirements in licensing, production, writing and distribution agreements, thereby creating at least a contractual right for parties with privity. In the long run, *Dastar* has created a problem that needs to be addressed by Congress or revisited and modified by the Supreme Court.

162. At times, one wonders whether the United States really cares. On July 27, 2000, a dispute settlement panel of the World Trade Organization ("WTO") held that the small business exemptions from performance royalties contained in the Fairness in Music Licensing Act and codified in the then-newly amended section 110(5) of the Copyright Act of 1976, violated Article 13 of the Agreement on Trade Related Aspects of Intellectual Property Rights ("TRIPS"). See WTO Dispute Settlement Body Panel Report on United States—Section 110(5) of the US Copyright Act, WT/DS160/8 (July 31, 2000). The provision exempting businesses under a certain physical size from the obligation to pay performance royalties was held to "conflict with a normal exploitation of the work" and "reasonably prejudice[d] the legitimate interests of the right holder." Action by the WTO Dispute Settlement Body Panel Report on United States—Section 110(5) of the US Copyright Act, WT/DS160/R (June 15, 2000). The United States still has not changed the provision. See Status Report by the United States on United States—Section 110(5) of the US Copyright Act, WT/DS160/24/Add.3 (Feb. 7, 2005). By making the exemption apply only to United States works, it should then be legal.

The faster and cleaner way to rectify the problem created by the Supreme Court is for Congress to make it clear that there should be attribution rights for all kinds of creative works. The express statutory language and the legislative history of the Visual Artists Rights Act illustrate that Congress did not intend the right of attribution under the Act to be the only available right of attribution for any work that is of a creative or “communicative” nature. Although Congress was quite clear in the statute and legislative history, maybe they were not clear enough for the Supreme Court. If there is to be an attribution right for currently protected works, Congress should add a right of attribution to the exclusive rights of the copyright holder as set forth in section 106 for application to all works.

The new exclusive right under section 106(7) should read:

§ 106 (7) to claim attribution in connection with any work of which he or she is the author. In connection with derivative works, the attribution right applies to all material portions of the underlying works upon which the derivative work was based.¹⁶³

In order to avoid running afoul of the “limited Times” requirement in the Copyrights and Patents clause of the U.S. Constitution, I would also amend the Lanham act by adding a new subsection to section 43(a):

§ 43(a)(1)(C); in the sale, distribution, commercial advertising or promotion of “communicative goods and services,” misrepresents or misattributes the services that were material to the creation of the “communicative goods and services,” 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. This right shall exist separately and in addition to any of the rights provided under Title 17.

The damage done by the *Dastar* Court needs to be rectified—sooner than later. Proper attribution has great value. It serves the purposes of building reputations and of informing the public of the true nature of artistic goods and services. Attribution rights are as important, if not more important, than monetary recoveries or injunctive relief to some. Either Congress or the Supreme Court

163. I am leaving the question open as to how Congress wishes treat “works made for hire.” For now, I am assuming that the employer remains the author in the context of a work made for hire.

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should act quickly to prevent users of another's material from being able to "reap where [they have] not sown."¹⁶⁴ Misattribution of "communicative" works should not be a wrong without a remedy.

164. *See* *International News Service v. Associated Press*, 248 U.S. 215, 239 (1918).

