

DASTAR'S NEXT STAND

Mark P. McKenna*

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* Professor of Law and Notre Dame Presidential Fellow, Notre Dame Law School. Thanks to Barton Beebe, Stacey Dogan, Mike Madison, and Rebecca Tushnet for helpful discussions of the ideas in this Essay, and to the participants at the University of Georgia School of Law's Symposium on the Future of Intellectual Property.

A spate of recent cases involve Lanham Act claims based on the defendant's use of aspects of the plaintiff's creative work. The magician Teller, for example, recently sued another magician for copyright infringement and false designation of origin for the latter's alleged copying and use of one of Teller's well-known magic tricks - the "highly innovative and unusual dramatic work 'Shadows.'"¹ Edgar Rice Burroughs sued the publisher of Warlord of Mars, a comic book series "based on" the John Carter of Mars series, and a series of spin-offs. Despite what seem to be accusations that the publisher created unauthorized derivative works, ERB's complaint is notable for the lack of a

¹ Complaint, Teller v. Dogge, 2:12-cv-00591 (D. Nev. Apr. 11, 2012), available at <http://james.grimmelmann.net/files/legal/teller-v-dogge-complaint.pdf>.

copyright infringement claim under United States law - with the exception of a claim of copyright infringement under U.K. law, all of ERB's claims were Lanham Act claims² The owner of the copyrights in the Darkover series of novels sued the author of Molly of Darkover and Women of Darkover for copyright and trademark infringement for her unauthorized use of "Darkover" in the titles of her books her setting of the books on the planet of Darkover.³ And most famously, Fleischer Studios, owner of the formerly copyrighted Betty Boop character, sued the seller of t-

²; Complaint, Edgar Rice Burroughs, Inc. v. Dynamic Forces Entm't, Inc., 1:2012-cv-01192 (S.D.N.Y. Feb. 12, 2012) (alleging infringement of various Tarzan and John Carter of Mars marks);

³ Complaint, Marion Zimmer Bradley Literary Works Trust v. Battle, 3:2012-cv-00073 (N.D. Cal. Jan. 5, 2012).

shirts that depicted Betty Boop for trademark infringement.⁴

Another group of recent cases involve claims of trademark infringement where the marks at issue originated more conventionally—meaning the claimed marks did not arise out of creative works themselves—but the allegedly infringing use was within the content of an expressive work. Louis Vuitton sued the producers of the movie *The Hangover*, alleging that inclusion of fake Louis Vuitton bags in the movie in an obviously comedic moment (and a reference to a bag as a “Lewis Vuitton”) constituted false designation of origin under § 43(a), as well as common law unfair competition and trademark dilution under

⁴ *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115 (9th Cir. 2011), withdrawn, *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011).

New York Law.⁵ The University of Alabama sued Daniel Moore, an artist who paints scenes from Alabama football games (like the one below), claiming that Moore infringed its trade dress rights in the design of its football uniforms.⁶

⁵ Louis Vuitton Malletier S.A. v. Warner Brothers Entertainment Inc., 11 Civ. 9436 (slip op. June 15, 2012) (<http://www.nysd.uscourts.gov/cases/show.php?db=special&id=189>).

According to the court, Louis Vuitton alleged that in one early scene in the Film the "four main characters in Los Angeles International Airport before a flight to Thailand for the character Stu's bachelor party and wedding." "[A]s the characters are walking through the airport, a porter is pushing on a dolly what appears to be Louis Vuitton trunks, some hard-sided luggage, and two Louis Vuitton Keepall travel bags." Alan, one of the characters, is carrying what appears to be a matching over-the-shoulder Louis Vuitton "Keepall" bag, but it is actually an infringing Diophy bag. Moments later, Alan is seen sitting on a bench in the airport lounge and places his bag (i.e., the Diophy bag) on the empty seat next to him. Stu, who is sitting in the chair to the other side of the bag, moves the bag so that Teddy, Stu's future brother-in-law, can sit down between him and Alan. Alan reacts by saying: "Careful that is . . . that is a Lewis Vuitton." No other reference to Louis Vuitton or the Diophy bag is made after this point.

⁶ Univ. of Alabama Bd. of Trs. v. New Life Art, --- F.3d ----, 2012 WL 2076691 (11th Cir. 2012).



The University's lawsuit was reminiscent of Tiger Woods's trademark infringement and right of publicity suit against artist Rick Rush for depicting Woods in limited edition prints celebrating champions of the Masters golf tournament.⁷

⁷ ETW, Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003).



All of these cases put significant pressure on the boundary between copyright and trademark law, some of them raising directly the question of the extent to which trademark law can be used to control expressive content.

One might have thought that the Supreme Court's decision in Dastar v. Twentieth Century Fox would control these cases, or at

least would give some clear guidance.⁸ After all, despite the fact that the Court resolved the case by interpreting the statutory language “origin of goods,” Dastar was animated in large part by the Court’s concern that requiring attribution for creative content would turn trademark law into some “mutant” form of copyright protection.⁹ Thus, one might expect Dastar to

⁸ 539 U.S. 23 (2003).

⁹ See id. at 34 (“[A]llowing a cause of action under § 43(a) for that representation would create a species of mutant copyright law that limits the public’s federal right to copy and to use expired copyrights.” (internal quotation marks omitted)). Many scholars have characterized Dastar as a case about the use of trademark law to avoid copyright law’s limits, and particularly its durational limits. See, e.g., Christopher Sprigman, Indirect Enforcement of the Intellectual

serve the same role in policing the trademark/copyright

interface as TrafFix plays in the trademark/patent context¹⁰—such

Property Clause, 30 Colum. J.L. & Arts 565, 584 (2007) (suggesting that

“Dastar’s purposive interpretation of the Lanham Act” was most likely

“driven by constitutional principles--specifically, a conception of

the public domain that issues from the Intellectual Property Clause

injunction directing that the federal copyright be for ‘limited

Times.’”).

¹⁰ TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23

(2001) (holding that expired utility patents have “vital significance”

in functionality determination and articulating a view of

functionality that focuses on the relationship between trademark and

patent law); see also Mark P. McKenna, (Dys)Functionality, 48 **Hous. L.**

Rev. 823 (2011) (discussing TrafFix and its “right to copy” view of

that Dastar would supply the rules by which courts determine when parties can use trademark claims to protect works of authorship or aspects thereof. And such an expectation would not be entirely unmet: A number of courts have in fact read Dastar to bar false designation of origin claims where the claims were based on the defendant's misattribution of creative content.¹¹ Courts have even regularly relied on Dastar to bar functionality, and the appellate courts' inconsistent application of the doctrine).

¹¹ See, e.g., Romero v. Buhimschi, 396 Fed. App'x 224 (6th Cir. 2010) (rejecting both false designation of origin and false advertising claims based on alleged wrongful denial of authorship credit); Dutch Jackson IATG, LLC v. Basketball Mktg. Co., No. 4:11-CV-277, 2012 WL 124579 (E.D. Mo. Jan. 17, 2012) (barring plaintiff's

false advertising claims where the alleged falsity related to the “origin” of content,¹² despite the fact that Dastar itself

claim that was based on defendants’ use of the plaintiff’s musical work as part of the soundtrack to a basketball DVD); Dorchen/Martin Assocs., Inc. v. Brook of Cheboygan, Inc., No. 11-10561-BC, 2012 WL 137829 (E.D. Mich. Jan. 18, 2012) (rejecting plaintiff’s false designation of origin claim where the defendant’s alleged use of a design for an assisted living facility was based on a design the plaintiff had presented to the defendant and which the plaintiff did not authorize the defendant to reuse).

¹² See, e.g., Romero, 396 Fed. App’x 224; Dutch Jackson, 2012 WL 124579 (also rejecting the plaintiff’s false advertising claim on the ground that characterizing defendant’s inclusion of the musical work as an implicit misrepresentation of the originality of the work (its

expressly left the door open to some false advertising claims.¹³

"nature and characteristics") was an "impermissible workaround" of Dastar); ZS Assoc., Inc. v. Synegy, Inc., No. 10-4274, 2011 WL 2038513 (E.D. Pa. May 23, 2011) (rejecting plaintiff's false advertising claims that were based on allegedly false attribution in a press release of the authorship of "sales performance management solutions").

¹³ Dastar, 539 U.S. at 38 ("If, moreover, the producer of a video that substantially copied the Crusade series were, in advertising or promotion, to give purchasers the impression that the video was quite different from that series, then one or more of the respondents might have a cause of action—not for reverse passing off under the 'confusion . . . as to the origin' provision of § 43(a)(1)(A), but for misrepresentation under the 'misrepresents the nature, characteristics

Yet *Dastar's* reach remains unclear,¹⁴ largely because of the case's unique facts and the nature of the plaintiff's claim. Not only did the case involve formerly copyrighted material that had fallen into the public domain, but Fox appeared to be using the Lanham Act to avoid the consequences of having slept on its rights.¹⁵ Perhaps more significantly, the Court clearly felt that

[or] qualities' provision of § 43(a)(1)(B).").

¹⁴ See Graeme B. Dinwoodie, *Concurrence and Convergence of Rights: The Concerns of the U.S. Supreme Court 14*, in Grosheide & Brinkhof (eds), *Crossing Borders: Between Traditional and Actual* (Hart Publishing 2005) (noting that *Dastar's* scope is unclear, and noting many open questions: "Does it preclude actions under Section 43(a) only when the work could be (or was) protected by copyright? Would a product that failed to be sufficiently original to qualify for copyright be similarly treated? Does *Dastar* preclude actions only when the work is in the public domain by virtue of failure to renew copyright? ... If a plaintiff can frame its action without using the phrase "origin" in Section 43(a), does *Dastar* have any effect?").

¹⁵ *Dastar*, 539 U.S. at ("The creative talent of the sort that lay behind the Campaigns videos is not left without protection. The original film footage used in the Crusade television series could have been copyrighted, see [17 U.S.C. § 102](#)(a)(6), as was copyrighted (as a compilation) the Crusade television series, even though it included material from the public domain, see §103(a). Had Fox renewed the copyright in the Crusade television series, it would have had an easy claim of copyright infringement.").

Fox's claim put Dastar in an impossible double bind: Fox claimed false designation of origin for failing to attribute the content, but there was a real risk, under another line of cases, that Dastar would have been exposed to a claim under §43(a) if it *had* attributed.¹⁶ For these reasons at least, one could (wrongly, I think) see Dastar as a fairly unusual case with limited precedential value.

And many are inclined to read Dastar narrowly, because its

¹⁶ Dastar, 539 U.S. at 36 ("On the one hand, [Dastar] would face Lanham Act liability *for failing* to credit the creator of a work on which their lawful copies are 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."). See also Justin Hughes at 682; Michael Landau, Dastar v. Twentieth Century Fox: The Need for Stronger Protection of Attribution Rights in the United States, 61 N.Y.U. Ann. Surv. Am. L. 273, 303 (2005) ("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."); Dinwoodie, *supra* note _ at 15 (noting the same "risk of being sued no matter what attribution strategy they followed").

holidng remains deeply controversial. Several scholars fault the Court for failing to recognize the importance of authorial attribution to authors and consumers.¹⁷ And many criticize the decision on the ground that it put the United States (further) out of compliance with the Berne Convention.¹⁸

This Essay argues that, whatever the merits of a general attribution requirement, the Supreme Court was right to reject

¹⁷ Laura Heymann, *The Birth of Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 Notre Dame L. Rev. 1377 (2005); Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. Rev. 1117 (2005); Michael Landau, *Dastar v. Twentieth Century Fox: The Need for Stronger Protection of Attribution Rights in the United States*, 61 N.Y.U. Ann. Surv. Am. L. 273 (2005).

¹⁸ See, e.g., Justin Hughes, *American Moral Rights and Fixing the Dastar "Gap"*, 2007 Utah L. Rev. 659 (arguing that, while "[t]he *Dastar* ruling was unquestionably important for a robust public domain, [] the reasoning the Court employed makes American compliance with Article 6bis [of the Berne Convention] considerably more problematic."); Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 **Hous. L. Rev.** 263 (2004) (arguing that the right of attribution was severely limited in *Dastar*). In my view, to the extent it is a problem that the US fails to meet its Berne obligations, it is a copyright, and not a trademark, problem.

the attempt to apply trademark law to designations of authorship. Indeed, in my view, Dastar should be understood, or at least should be extended, to **rule out** categorically Lanham Act claims that are based on the content of the defendant's creative work. And while there may be reasons to be particularly concerned about cases that involve confusion that allegedly results from use of the plaintiff's creative work, I argue that the better approach is to focus on the content of the defendant's work. Specifically, Dastar should bar any claim that alleges confusion because of the content of the defendant's creative work. Courts, in other words, should refuse to infer anything about the source of a work, or of any goods embodying that work, from its creative content.

Part I sets the stage by describing the Dastar decision and situating it in the doctrinal landscape. Part II then describes the ambiguities about Dastar's preemptive sweep, and Part III argues specifically for expansive interpretation and/or extension of Dastar.

I. The Dastar Decision

The facts of Dastar were not complicated, even if they were relatively unique. Twentieth Century Fox owned the copyright for a television series that was based on President Dwight Eisenhower's book *Crusade in Europe*, published by Doubleday.¹⁹ Though the book remained in copyright, Fox failed to timely

¹⁹ Dastar, 539 U.S. at 25-26.

renew the copyright on the television series, thereby inadvertently allowing it to fall into the public domain.²⁰ As the fiftieth anniversary of the end of World War II approached, Dastar sought to capitalize on renewed interest in the war by creating a video set entitled World War II Campaigns in Europe.²¹ As the Court explained:

To make Campaigns, Dastar purchased eight beta cam tapes of the *original* version of the Crusade television series, which is in the public domain, copied them, and then edited the series. Dastar's Campaigns series is slightly more than half as long as the original Crusade television series. Dastar substituted a new opening sequence, credit page, and final closing for those of the Crusade television series; inserted new chapter-title sequences and narrated chapter introductions; moved the "recap" in the Crusade television series to the beginning and retitled it as a "preview"; and removed references to and images of the book. Dastar created new packaging for its Campaigns series and (as already noted) a new title.²²

²⁰ Id. at ____.

²¹ Id. at 26.

²² Id. at 26-27 (emphasis in original). The Court emphasized that Dastar used tapes of the original television series because, after having failed to renew the copyright in Crusade, Fox reacquired the television rights in Eisenhower's book, and then, through a licensee, restored the original series, repackaged the series on videotape, and

Dastar then manufactured and sold its Campaigns video set as its own product, advertising it as "Produced and Distributed by: Entertainment Distributing", a Dastar subsidiary. The screen credits included the statements "DASTAR CORP presents" and "an ENTERTAINMENT DISTRIBUTING Production", and the credits identified employees of Dastar as executive producer, producer, and associate producer.²³ Neither Dastar's advertising nor the videos themselves made any reference to Fox or the Crusade television series.²⁴

Fox claimed that Dastar's use of footage from the Crusade

distributed them. Id. at 26. Thus, the Court meant to make clear that Dastar copied the public domain footage, not the restored footage later created by Fox.

²³ Id. at 25.

²⁴ Id. at 27.

television series without attribution constituted reverse passing off - Dastar, it claimed, was passing off Fox's content as though it were Dastar's own - thereby falsely designating the origin of the video series in violation of §43(a) of the Lanham Act.²⁵ That section makes actionable use of "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 . . . 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

²⁵ Id. at 27.

commercial activities by another person.”²⁶ .

Though there was some precedent to support Fox’s claim,²⁷ the Supreme Court rejected was not impressed. According to the Court, since the material at issue had fallen into the public domain, Dastar had an unqualified right to use it, even without attribution.²⁸ But importantly, the Court did not limit its holding to claims involving public domain material; it instead resolved the case through a general construction of §43(a), and particularly the phrase “origin of goods”. According to the

²⁶ 15 U.S.C. § 1125(a)(1)(A) (emphasis added).

²⁷ Previous Ninth Circuit cases had held that “bodily appropriation” of creative content was sufficient to establish reverse passing off. See, e.g., *See Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir.1994); *Summit Mach. Tool Mfg. Corp. v. Victor CNC Systems, Inc.*, 7 F.3d 1434, 1436-37 (9th Cir.1993). Prior cases also had held that slight modifications to the material were not sufficient to avoid liability. See *Summit Mach. Tool Mfg. Corp.*, 7 F.3d at 1437 (“A defendant may also be guilty of reverse palming off by selling or offering for sale another’s product that has been modified slightly and then labeled with a different name.”).

²⁸ *Dastar*, 539 U.S. at 33.

Court, as used in the Lanham Act, "origin of goods" refers only to the origin of physical goods. Most basically, this means the party that actually made the goods at issue - the actual, historical origin. But the concept of origin "might be stretched," the Court allowed, "to include not only the actual producer," but the party who "stood behind production of the physical product."²⁹ Here the Court presumably meant to acknowledge that "source" or "origin" in modern trademark law include parties who did not themselves produce the goods, but which have sponsored or are affiliated with the actual producer or its goods..³⁰ Yet according to the Court, "origin of goods"

²⁹ Dastar, 539 U.S. at 31-32.

³⁰ It is notable, however, that the Court referred to those parties as "standing behind" the physical good, a formulation that suggests a

is "incapable of connoting the person or entity that originated the ideas or communications that 'goods' embody or contain."³¹

Whatever the range of legitimate relationships that might count as source relationships, those relationships must be tied to the physical goods and not merely the intellectual content they embody.

This construction was fatal to Fox's claim because there was no doubt that Dastar (and not Fox) was the actual source of its videotapes, even if Dastar was not the source of the footage embodied in those tapes. Thus, when it designated the source of its tapes with its own name, Dastar was not falsely designating

somewhat narrower understanding of "sponsorship" and "affiliation" than lower courts have generally accepted. See Lemley & McKenna, Irrelevant Confusion, 62 **Stan. L. Rev.** 413 (2009-2010) (arguing for a narrower interpretation of sponsorship or affiliation, one focused on responsibility for quality of goods).

³¹ Dastar, 539 U.S. 23, 24.

their origin: it was telling the truth. On the other hand, Fox's claim of reverse passing off "would undoubtedly [have been] sustained if Dastar had bought some of New Line's Crusade videotapes and merely repacked them as its own."³² In that case, Dastar would have been misrepresenting the origin of the physical tapes.

Clearly this construction was motivated to a significant degree by the Court's concern that a broader reading of the statute would have created a significant conflict with copyright law. But the Court also suggested that a different rule under which "origin" might refer also to the creator of the expressive

³² Id.

content, would create significant practical difficulties.³³

Because most creative works are the result of many contributions, and because those contributions are often cumulative, identifying the intellectual origin(s) of creative content would prove an impossible task.. Thus, a court's attempt to identify the "true" intellectual origin of a work would degenerate into absurdity.

In many cases, figuring out who is in the line of "origin" would be no simple task. Indeed, in the present case it is far from clear that respondents have that status. Neither SFM nor New Line had anything to do with the production of the Crusade television series-they merely were licensed to distribute the video version. While Fox might have a claim to being in the line of origin, its involvement with the creation of the television series was limited at best. Time, Inc., was the principal if not the exclusive creator, albeit under arrangement with Fox. And of course it was neither Fox nor Time, Inc., that shot the film used in the Crusade television series. Rather, that footage came from the United States Army, Navy, and Coast Guard, the British

³³ Id. at 35-36.

Ministry of Information and War Office, the National Film Board of Canada, and unidentified "Newsreel Pool Cameramen." If anyone has a claim to being the *original* creator of the material used in both the Crusade television series and the Campaigns videotapes, it would be those groups, rather than Fox.³⁴

As the Court said, the Lanham Act does not require a "search for the source of the Nile and all its tributaries."³⁵

This reasoning provoked considerable reaction, for at least two reasons. First, parts of the Court's discussion seemed to rest, not on the legal conclusion that the language of the Lanham Act does not deal with intellectual origins, but on the dubious empirical claim that consumers do not care about such origins.³⁶ To many scholars, this smacked of "amateur consumer

³⁴ Id. at _
³⁵ Id.

³⁶ Id. at 32-33 ("The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to

psychology" undeserving of the Court.³⁷

Second, the Court's detailed description of the origins of the content at issue seemed to many commentators to reflect either ignorance about the concept of source in trademark law or deliberate mischaracterization.³⁸ Trademark law generally is not concerned with identification of actual contributors to a product or service; it is instead concerned only with the contributions of a legal source.³⁹ It does not matter, for

purchasers.").

³⁷ See, e.g., Hughes at 688 ("In other words, the strict holding of *Dastar* is founded on an unproven empirical claim that we have no good reason to believe.").

³⁸ See, e.g., Heymann, *supra* note __ at 1440-44.

³⁹ *Id.* at 1442 ("trademark law does not concern itself with the actual source of any good or service (or its progenitors) ... [but] concerns itself with maintaining the integrity of the organizational system"). See also 1 McCarthy on Trademarks and Unfair Competition § 3:8, 3:9 (4th ed.) (referring to the rule that a trademark refer to the "physical source or origin of the product or service in connection with which the mark was used" as the "early rule" eventually phased

example, that an APPLE computer is comprised of many parts that Apple, Inc. does not make. For trademark law's purposes, it only matters that Apple stands behind the computers bearing the APPLE mark. Apple, and none of the individual component contributors, is the legal "origin" of APPLE computers. In this sense, the Court's focus on the underlying contributions to the Crusades footage seemed disconnected from trademark law's ordinary practice.

There is something to both of these criticisms. Consumers, it seems, often care very much who authored, directed, or produced a work. It likely matters, for example, that Steven Spielberg was involved in a movie's production, or that JK Rowling

out in trademark law in favor of the rule that a trademark refer to a single, and possibly anonymous, source).

authored a new book. And the Court's focus on actual, physical sources does seem anachronistic - indeed, the modern practices of licensing and outsourcing depend on a legal rule that views a trademark only as an indicator of consistent quality rather than physical source.

But I think both of the criticisms ultimately are unfair on the facts of the Dastar case. First, it is clear that the Court itself recognized that intellectual origins might matter to consumers in context of creative works. As the Court said, "[t]he purchaser of a novel is interested not merely, if at all, in the identity of the producer of the physical tome (the publisher), but also, and indeed primarily, in the identity of

the creator of the story it conveys (the author)."⁴⁰ Thus, it seems clear that the Court's holding did not depend to any significant extent on an empirical claim that consumers do not care about intellectual origins.⁴¹ Rather, the Court simply rejected the significance of such source associations as a *matter of trademark law*. It did so in large part because construing the statute to account for such associations would create a conflict with copyright law,⁴² but it also did so

⁴⁰ Dastar, 539 U.S. at 33; see also id. ("For such a communicative product (the argument goes) 'origin of goods' in § 43(a) must be deemed to include not merely the producer of the physical item ... but also the creator of the content that the physical item conveys").

⁴¹ Cf. Lastowka, *supra* note __ at 1207-08 (noting that the Court's opinion in Dastar did not depend on the claim that consumers "do not care" about statements of authorship). Indeed I think the Dastar decision depends much less on an assumption about consumer understanding than did Wal-Mart v. Samara, which declared product configuration trade dress incapable of being inherently distinctive partly on the ground that consumers are not as inclined to see product configuration as source indicating. See

⁴² Id. ("The problem with this argument according special treatment to communicative products is that it causes the Lanham Act to conflict

because it was wary of creating special rules for creative works.

This last point deserves some elaboration, because the Court is often accused of having *created* a special rule in *Dastar* (in order to avoid conflict with copyright) rather than resisting special rules. To see that it was Fox that was seeking the special rule, imagine that I were to start selling soda under the name of my new company (NewCo) and in packaging that was clearly distinguishable from any other company's product. If I were to go to the store, buy Coca-Cola, pour it into my NewCo cans, and sell it as if it were NewCo soda, Coca-Cola would have an easy case against me for reverse passing off. I would be

with the law of copyright, which addresses that subject specifically.").

passing off Coca-Cola's soda as though it were NewCo soda.⁴³ But if instead I were to buy Coca-Cola, take it home to my lab to analyze chemically, and then reverse engineer the drink - producing my own soda that was identical in every way to Coca-Cola - would Coca-Cola have a reverse passing off claim? Would it have a passing off claim if consumers recognized the flavor of the soda as that of Coca-Cola, perhaps even believing the soda in NewCo cans was Coca-Cola?

The formula for Coca-Cola is not patented; it is, famously, protected by trade secret.⁴⁴ But trade secret rights do not prevent me from reverse engineering Coca-Cola, as long as I

⁴³ Cf. **Universal Furniture Intern., Inc. v. Collezione Europe USA, Inc.**, 2007 WL 2712926

(M.D.N.C. 2007) (finding defendant's display of plaintiff's furniture without branding or with labels removed and marketing the furniture as either its own collection or a collection manufactured by Art Heritage for Defendant constituted reverse passing off)..

⁴⁴ <http://www.worldofcoca-cola.com/secret-vault.htm>

acquire the product lawfully.⁴⁵ So if Coca-Cola were to have some form of unfair competition claim against me for selling NewCo soda that was reverse engineered from Coca-Cola, it would be able to avoid a fundamental precept of trade secret law. Once upon a time, it would have been pretty clear that such unfair competition claims were categorically unavailable in this situation. Cases like *Crescent Tool Co. v. Kilborn & Bishop Co.* made clear that a party was entitled to copy another's product "slavishly down to the minutest detail" since no one was entitled to "monopolize an [unpatented] design or pattern,

⁴⁵ See Uniform Trade Secrets Act § 1 Comment ("Proper means [of acquiring the information protected by trade secret] include: 2. Discovery by "reverse engineering", that is, by starting with the known product and working backward to find the method by which it was developed. The acquisition of the known product must, of course, also be by a fair and honest means, such as purchase of the item on the open market for reverse engineering to be lawful").

however trifling.”⁴⁶ Nor would those courts have required attribution - indeed, courts in these cases made clear that the copyists should clearly label their products as coming from themselves, and not the party from which they copied.⁴⁷

Modern courts would more likely resolve a standard passing off case - one in which consumers recognized the flavor of NewCo soda and associated it with Coca-Cola - by finding the flavor of

⁴⁶ 247 F. 299, 300-01 (2d Cir. 1917). See also *Flagg Manufacturing Co. v. Holway*, 59 N.E. 667, 667 (Mass. 1901) (“the defendant has the same right that the plaintiff has to manufacture instruments in the present form, to imitate the arrangement of the plaintiff’s strings or the shape of the body. In the absence of a patent the freedom of manufacture cannot be cut down under the name of preventing unfair competition.”). This approach was dominant, but not universal. See *George G. Fox Co. v. Hathaway*, 85 N.E. 417 (Mass 1908) (enjoining the defendant’s sale of bread loaves that were similar to the plaintiff’s in size, shape, color, and general visual appearance”).

⁴⁷ *Crescent Tool*, 247 F. at 300 (“[the defendant] may not represent himself as the plaintiff in [the sale of the copied goods]”); *Flagg Mfg.*, 59 N.E. at 667 (“All that can be asked is that precautions shall be taken, so far as are consistent with the defendant’s fundamental right to make and sell what it chooses, to prevent the deception which no doubt it desires to practice.”).

a soda to be functional and therefore unprotectable.⁴⁸ That workaround would be easier for courts that interpret the *TraFFix* decision⁴⁹ to mean that a feature is “essential to the use or purpose of the article”, and therefore functional, whenever the feature plays a role in making the product work.⁵⁰ It would be more difficult for courts that maintain that functionality refers to competitive necessity,⁵¹ but even then it is hard to imagine a claim succeeding. Indeed, as far as I am aware, no

⁴⁸ See *In re N.V. Oreganon*, 79 U.S.P.Q.2d 1639 (T.T.A.B. 2006) (finding “an orange flavor” functional for “pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills.”)

⁴⁹ *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) (defining a functional feature as one “essential to the use or purpose of the article, or that affects its cost or quality”).

⁵⁰ See, e.g., *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351 (5th Cir. 2002).

⁵¹ At this point, however, only the Federal Circuit appears to take that view. See *Valu Engineering, Inc., v. Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002). See generally Mark P. McKenna, (Dys)Functionality, 48 Hous. L. Rev. 823, 832-36 (2011) (distinguishing between a “right to copy” approach to functionality, under which competitive need is not explicitly considered, and a “need to copy” approach, in which competitive need determines whether a feature is “essential”).

court has protected the taste of a food product on unfair competition grounds.

Ultimately, then, it seems quite unlikely that I would be liable for passing off just because NewCo soda tasted like Coca-Cola; indeed, it's very unlikely I'd be liable even if consumers believed NewCo soda *was* Coca-Cola.⁵² But resolving such a case with the functionality doctrine is not ideal, as that approach would entail some amount of uncertainty and enforcement costs even in the "right to copy" courts.

More significantly here, it is not even clear that the

⁵² Chances are that consumers would *not* believe NewCo soda tasted just like Coca-Cola, since the taste of Coca-Cola in fact depends to a substantial degree on the soda being called Coca-Cola. See, e.g., Samuel M. McClure et al., *Neural Correlates of Behavioral Preference for Culturally Familiar Drinks*, 44 NEURON 379 (2004) (finding that exposure to the Coca-Cola brand stimulates a region of the brain not stimulated in blind taste tests; as a result, despite the fact that people tend to prefer Pepsi over Coke in blind taste tests, those exposed to the brand names during the test tend to prefer Coke). But the legal point would hold even if consumers did believe the soda was Coca-Cola.

functionality doctrine applies in reverse passing off cases.

Functionality arises in cases involving the protectability of some feature(s) claimed by a plaintiff as protectable trade dress. The plaintiff in a reverse passing off case is not claiming features as source indicators - if the features indicated source such that consumers would be likely to be confused about the source of the defendant's product, then the claim would be for passing off and not reverse passing off. In a reverse passing off claim against me for pouring Coca-Cola into NewCo soda cans, for example, Coca-Cola would not be asserting that it owned rights in the flavor of its soda. It would instead simply be claiming that I was falsely designating the origin of the soda in the can. Unsurprisingly, then, functionality simply

does not come up in reverse passing off cases.

Yet even if functionality doctrine is not relevant to such a reverse passing off case, it is difficult to imagine that any court would find me liable for reverse passing off if I sold soda reverse engineered from Coca-Cola, even if my soda were chemically identical to Coca-Cola. In fact, this was precisely why the Court was concerned that a contrary ruling in *Dastar* would allow parties to evade *TraFFix*: it believed that the "plaintiff [in *TraFFix*], whose patents on flexible road signs had expired, and who could not prevail on a trade-dress claim under § 43(a) because the features of the signs were functional, would have had a reverse-passing-off claim for unattributed

copying of his design" were such claims not ruled out.⁵³

This instinct may help explain Justice Scalia's invocation of Coca-Cola in the *Dastar* decision:

But the brand-loyal consumer who prefers the drink that the Coca-Cola Company or Pespico sells, while he believes that that company produced (or at least stands behind the production of) that product, surely does not necessarily believe that that company was the "origin" of the drink in the sense that it was the very first to devise the formula. The consumer who buys a branded product does not automatically assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product - and typically does not care whether it is.⁵⁴

Here too the Court might be faulted for making this point in empirical terms, suggesting that consumers do not know or care who developed the formula for Coca-Cola or Pepsi.⁵⁵ Indeed, as an empirical matter, the Court may well have been wrong. But in the context of the decision it seems quite likely that the Court

⁵³ *Dastar*, 539 U.S. at 37.

⁵⁴ *Dastar*, 539 U.S. at 32.

⁵⁵ And scholars have criticized the Court on precisely this ground. See Hughes, *supra* note _ at 686-87.

here was really just making a simplifying assumption in service of a normative legal rule. Rather than assuming that consumers might care about intellectual origins and finding a doctrinal route to the conclusion of “no liability”, the Court simply determined that the game wasn’t worth the candle and ruled out claims relating to intellectual origin altogether. In this sense, *Dastar* is reminiscent of *Wal-Mart v. Samara* (another Scalia opinion), in which the Court supported its holding that product design could not be inherently distinctive with the assertion that consumers do not regularly rely on product design to indicate source.⁵⁶

⁵⁶ *Wal-Mart*, 529 U.S. at _ (distinguishing product design from product packaging and stating: “In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a

Criticisms of the seeming woodenness of the Court's discussion of relevant "sources" is also unfair in the context of *Dastar's* facts. It is true that trademark law typically is concerned only with the legal source of products rather than their actual, historical source.⁵⁷ But Fox did not assert a standard trademark claim; it alleged reverse passing off.

This distinction matters since one brings a reverse passing off claim when it cannot allege secondary meaning: Fox sued for reverse passing off because the content for which it sought attribution did not indicate source. And precisely because consumers in these cases have no reason to associate the content with anyone other than the defendant, they are exceedingly

cocktail shaker shaped like a penguin-is intended not to identify the source, but to render the product itself more useful or more appealing.").

⁵⁷ See Heymann, *supra* note _ at 1442.

unlikely to be confused in any of the ways trademark law typically is concerned with. Consumers will not, for example, think that Fox sponsored Dastar's production because of the content, nor will they wonder about a relationship between Fox and Dastar. If consumers did think any of those things, it would be because the content indicated to them something about source, and Fox's claim would have been for passing off rather than reverse passing off. Indeed, this is why it was critical to the Ninth Circuit's finding of false designation of origing that the Dastar's "bodily appropriation" of the content obviated the need for evidence of likelihood of confusion.⁵⁸

⁵⁸ Id. at 29 ("With respect to the Lanham Act claim, the Court of Appeals reasoned that 'Dastar copied substantially the entire Crusade

Reverse passing off claims, then, are not really like ordinary trademark claims at all. Liability for reverse passing off turns simply on the falsity of the statement of origin, and in that sense reverse passing off is more akin to false advertising than ordinary trademark infringement. It should therefore not be a surprise that ordinary trademark principles do not fit well.

in Europe series created by Twentieth Century Fox, labeled the resulting product with a different name and marketed it without attribution to Fox [and] therefore committed a 'bodily appropriation' of Fox's series." It concluded that 'Dastar's 'bodily appropriation' of Fox's original [television] series is sufficient to establish the reverse passing off.' ").

Indeed, in a significant sense, it was Fox that pressing an argument that focused on factual, rather than legal, sources. Thus, Fox was seeking a ruling that would have forced Dastar to attribute to Fox content that did not indicate to consumers anything about origin (intellectual or physical). Fox was asking, in other words, for something akin to a rule that would require Apple to attribute all of the component parts of its computers, regardless of whether the sources of those parts were known to consumers.

Yet even if the criticisms of *Dastar* have largely been overdrawn, some significant questions about the decision's scope and significance remain. That is the subject of the next section.

II. Dastar's Limitations, and Open Questions

Despite the specific context of the decision, Dastar's holding is not limited to cases in which the defendant makes use of public domain material (as Dastar did).⁵⁹ If the Court meant for the case to apply that narrowly, it could have resolved the case by accepting that "origin" could refer to the origin of creative content but creating an exception where the content at issue was in the public domain.⁶⁰ Likewise the Court could have

⁵⁹ See *Dorchen/Martin Assocs., Inc. v. Brook of Cheboygan, Inc.*, No. 11-10561-BC, 2012 WL 137829 (E.D. Mich. Jan. 18, 2012) (rejecting the argument that Dastar only dealt with works in the public domain).

⁶⁰ Such a rule would operate similarly to the way the functionality doctrine limits protection of useful, and potentially patentable, product features: those features may indicate source, but but some source-indicating features are nevertheless ineligible for protection.

decided the case more narrowly by carving out from the scope of §43(a) claims relating to copyrighted (or copyrightable) works of authorship.⁶¹ But the Court didn't limit its decision in either of those ways; it instead adopted a general interpretation of "origin of goods" in which "origin" refers only to the source of physical goods. That interpretation of "origin of goods" applies generally, regardless of whether the content at issue in a particular case is or was protected by copyright.⁶² Misrepresentations of the origin of physical goods

See *TrafFix*, 532 U.S. at 28-29 (noting the eligibility for trade dress protection of product features and the functionality limitation). .

⁶¹ Cf. Greg Lastowka (suggesting "[p]erhaps the best subset of the possible scope of "tangibility" would be to restrict the limit of Dastar to information products potentially covered by copyright law.").

⁶² Nor is Dastar limited to cases in which the defendant merely copied ideas as opposed to expression, as some courts have wrongly

are actionable under the Lanham Act; other sorts of misrepresentations, including but not limited to misrepresentations of the source of creative content, are not actionable.⁶³ To put it differently, in the Supreme Court's estimation, use of a trademark only represents that the party whose trademark adorns the goods has produced those goods (or at

suggested. *General Scientific Corp. v. SheerVision, Inc.*, No. 10-CV-13582, 2011 WL 3880489 (E.D. Mich. Sept. 2, 2011) (refusing to apply *Dastar* where the plaintiff alleged "a misrepresentation by [defendant] regarding the origin and nature of media used in marketing, as opposed to a misrepresentation regarding mere ideas").

⁶³ A broader range of misrepresentations (regarding the "the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities") are actionable as false advertising under § 43(a)(1)(B). 15 U.S.C. § 1125(a)(1)(B). But, in my view, courts are right to reject false advertising claims based on misrepresentation of the origin of creative content as well.

least is responsible for the production of those goods). A trademark cannot be taken to indicate anything about the origin of the intellectual creation embodied in that good.⁶⁴ Hence, a

⁶⁴ Indeed, several courts have rightly understood Dastar to bar claims based on misrepresentation of invention. See, e.g., ZS Assocs. v. Synygy, Inc., No. 10-427-4, 2011 WL 2038513 (E.D. Pa. May 23, 2011) (“[P]laintiff may not base a false advertising claim on its allegation that [defendant’s] press release ‘falsely suggest[s] and impl[ies] that [defendant] Synygy was the market innovator and that ZS’s products and services are knock-offs of products and services that Synygy developed.’ Nor may it base a false advertising claim on Synygy’s assertions that ‘we have invested many years and a lot of money in product development, which led to Synygy creating the SCM software that has propelled our success year after year.’ Such

statements by Synygy, and any others like them, can only be false insofar as they assert that Synygy, and not ZS, created the products and services offered by Synygy. Such claims of false attribution of authorship are barred by the reasoning underlying Dastar."); *Sidem, S.A. v. Aquatech Int'l Corp.*, No. 10-81, 2010 WL 2573882, at *8 (W.D. Pa. June 23, 2010) (concluding that "it would be inappropriate to ignore the main thrust of plaintiffs' allegations that [defendant] Aquatech passed off Synygy's trade secret information as its own, i.e. that Quatech—not plaintiffs—originally developed or created the design and construction of large MED units, and under those circumstances Dastar bars plaintiff's Lanham Act claim asserted under § 43(a)(1)(B)"); *Robert Bosch LLC v. Pylon Mfg. Corp.*, 632 F. Supp. 2d 362, 366 (D. Del. 2009) (the defendant's website stated: "[The defendant]'s expertise . . . has inspired the development of a high

party that merely repackages someone else's physical good

performance, frameless all-weather wiper blade with many innovative features and benefits, including . . . Advanced Frameless Design . . . and Integrated High-Downforce Spoiler," and "[t]he latest [of the defendant's] wiper blades on the market are all new and improved . . . adding functional features such as spoilers for improved wiper performance." The plaintiff sued, asserting a claim pursuant to § 43(a)(1)(B). The court stated: "Plaintiff's first claim for false advertising boils down to defendant's advertisement that it developed a 'frameless all-weather wiper blade' and, by implication, Bosch did not develop the said frameless wiper blade. This court, and other courts, have found that 'false attribution of the authorship' of an invention or innovation is not an actionable false advertisement under § 43(a) of the Lanham Act.").

falsely designates the origin of that good, but one that creates its own physical good does not falsely designate its origin. The latter conclusion is true even if the party creates the good by copying intellectual content - by, for example, copying the work of authorship contained therein or copying the formula of the drink.

Some courts have struggled with this distinction in the digital context because they have had difficulty determining what it means merely to repackage a digital good. In Cable v. Agence France Presse,⁶⁵ for example, Cable alleged that defendant AFP displayed on its web site reproductions of Cable's photographs without Cable's photo credit and copyright notice.

⁶⁵ 728 F. Supp. 2d 977 (N.D. Ill. 2010).

Cable, in other words, claimed that the AFP falsely designated the origin of the works of authorship AFP displayed on its site.

That claim should have been barred under Dastar because AFP created its own copies of the photographs.⁶⁶ The court, however, allowed the claim because it believed that AFP's actions were akin to mere repackaging of the photos without revision. This opinion misses the mark because the photos displayed on AFP's site were not the plaintiff's photos. They were, to be sure, reproductions of the plaintiff's photos. But that is a critical distinction post-*Dastar*: if reproduction of the content was the same thing as repackaging a physical product, then *Dastar*'s

⁶⁶ See *Abarca Health, LLC v. Pharmpix Corp.*, 2012 WL 112 3611 (D.P.R. 2012) (dismissing 43(a) claims that alleged false designation of origin based on defendant's assertion in advertising that it offered a "proprietary software application," which the plaintiff alleged was actually copied from its software, and distinguishing that claim from one based on defendant's claim that the software application was "innovative," which might fall outside *Dastar*).

reproduction of Fox's footage undoubtedly would have qualified.

Once AFP reproduced the photos, it was no longer selling Cable's photos—it was selling its own photos. Those photos may have infringed Cable's copyright, but they were not merely repackaging Cable's photos.⁶⁷

The harder question regarding the scope of Dastar is whether the holding is limited to cases in which the content at issue (which originates with the plaintiff and is used by the defendant) lacks secondary meaning. A number of courts have acted as if Dastar is not so limited, ignoring altogether the question of whether the plaintiff's work has secondary meaning.

⁶⁷ Cf. *General Universal Sys., Inc. v. Lee*, **379 F.3d 131, 149** (5th Cir. 2004) ("GUS has not accused HAL of taking tangible copies of its software, removing its trademarks, and selling them as its own. Rather, GUS asserts that HAL copied the ideas, concepts, structures, and sequences embodied in its copyrighted work. In sum and substance, GUS's claim is simply a claim that HAL has infringed its copyright in LOPEZ COBOL. *Dastar* makes clear that such claims are not actionable under § 43(a).").

In these cases, courts have simply held that claims alleging confusion based on the content of a work are barred under Dastar.

This is, as I will argue below, how Dastar should be applied. But there is room for some reasonable disagreement about whether Dastar itself must be so read. *Dastar* was a reverse passing off case: Fox claimed that Dastar falsely designated the origin of its video series by including in its videos unattributed footage from the Crusades in Europe television series. Fox did not assert a more conventional (forward) passing off claim, presumably because it could not demonstrate that the footage itself served to indicate source. Fox therefore did not allege (and presumably could not have alleged) that Dastar's inclusion

of the content implicitly suggested that Fox was the source of, or sponsored or was affiliated with, Dastar's movie series. Nor could Fox avoid the Dastar holding simply by recharacterizing its claim as one for passing off, alleging that the mere inclusion of the content falsely designated the origin of the physical product (there, the tapes).

And it seems clear that the Supreme Court was conscious of the possibility of a party strategically recharacterizing its claims to avoid its rulings. This was the import of the Court's discussion of Wal-Mart Stores, Inc. v. Samara Brothers, Inc.⁶⁸ Specifically, the Dastar court worried that, if Fox could assert a reverse passing off claim alleging that it was the original

⁶⁸ 529 U.S. 205 (2000).

producer of the content used by Dastar, then parties could easily evade Wal-Mart's holding that product configuration trade dress can only be protected with evidence of secondary meaning: "Samara would merely have had to argue that it was the 'origin' of the designs that Wal-Mart was selling as its own line."⁶⁹

The Court's particular concern about evasion of Wal-Mart is apt, however, only where the content at issue lacks secondary meaning. Wal-Mart did not reject protection of product configuration altogether, but instead required that any such trade dress have secondary meaning. Thus, a party that asserted a passing off claim where the content itself indicated source would not be evading Wal-Mart's requirements.

⁶⁹ Dastar, 539 U.S. 23, 36-37 (2003).

One could therefore read Dastar narrowly, such that it would have nothing to say about standard passing off claims where the content has secondary meaning. In those cases, plaintiffs may be able to avoid Dastar simply by focusing their claims on confusion regarding the source of the goods into which the content is embodied. Rather than claiming that consumers are likely to be confused about the origin of the content of the videos, such a plaintiff would allege confusion about the source of the videotapes themselves. That would, of course, not be a meaningfully different claim: any confusion about the source of the videotapes in such a case would be the result of implicit source indication coming from their content.

But, in my view, such a narrow reading would be

inappropriate. The Court's concern about strategic recharacterization was not merely a technical matter; it clearly reflected the Court's sense of the proper domains of trademark, copyright, and patent law, respectively. Hence the Court's concern about the possibility of evading *Wal-Mart* and *TraFFix*, even though expressed in terms of the possibility of avoiding the additional requirements of secondary meaning and non-functionality, was grounded in citations to *Sears*, *Bonito Boats*, and even *Kellogg*, and their shared concern about being_''careful [in construing the Lanham Act] to caution against misuse or overextension of trademark and related protections into areas traditionally occupied by patent or copyright."⁷⁰

⁷⁰ Dastar, 539 U.S. at 33, quoting TraFFix, 532 U.S. at 29, and citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964), *Kellogg*

Most courts thus far seem to have understood the Court's broader purpose of demarcating the domain of trademark law and have not interpreted *Dastar* narrowly. In *Rudovsky v. West Publishing*,⁷¹ for example, the court dismissed the plaintiff's false designation of origin claim, which was based on the defendant's publication of a supplemental text that listed the

Co. v. National Biscuit Co., 305 U.S. 111, 121-122 (1938), and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151 (1989)

⁷¹ No. 09-CV-00727-JF, 2010 WL 2804844 (E.D. Pa. July 15, 2010).

Somehow the court managed to allow state law defamation claims to go forward, however, and the plaintiffs ultimately prevailed on those claims. *Id.* No. 09-CV-00727-JF, 2011 WL 1155159 (E.D. Pa. Mar. 30, 2011).

plaintiffs as authors even though they had no involvement in putting that material together.⁷² According to the court, because the plaintiffs had, in fact, been authors of the primary materials and of previous supplements, the defendant faced precisely the same double-bind as Dastar:

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 [have] face[d] Lanham Act liability for crediting the creator if

⁷² Rudovsky, 2010 WL 2804844, at *2. The court also dismissed the plaintiffs' false advertising claims on the ground the defendant's use was not in "advertising or promotion." Id.

that should be regarded as implying the creator's

"sponsorship or approval" of the copy.⁷³

Thus, the plaintiffs' claims were barred, even though they were asserting passing off rather than reverse passing off.

Courts' tendency to read Dastar to bar false advertising claims also suggests that they understand that the purpose of the decision was broader than to bar reverse passing off claims. These courts have, in my view, gone too far in barring all false advertising claims. After all, the Dastar decision plainly states that some false representations should remain actionable as false advertising. But the courts that have barred false advertising claims have rightly understood Dastar to demarcate

⁷³ Id.

the limited domain of the Lanham Act, and to reserve certain kinds of claims to other areas of law.

Just as one example, in Agence France Presse v. Morel,⁷⁴ the court rejected the false representation and false advertising claims of photographer Daniel Morel, who alleged that AFP represented that “AFP/Getty” was the source of the photographs, that AFP had the right to license those images, and that a third party who posted Morel’s photographs without authorization was the author of the photographs.⁷⁵ Notably, the Agence France

⁷⁴ 769 F. Supp. 2d 295 (S.D.N.Y. 2011).

⁷⁵ Id. The court held here that, though “Dastar concerned a misrepresentation of origin claim,” the decision’s “reasoning applies with equal force to bar claims, also brought under section

43(a)(1)(A), for false representation of 'affiliation' between the author and a distributor of communicative products." Id. at 307; see also Antidote Int'l Films, Inc. v. Bloomsbury Publ'g, PLC, 467 F. Supp. 2d 394, 399 (S.D.N.Y. 2006) (holding that Dastar applies to affiliation claims where "one person is the publisher of a novel and the other is the author of the novel, because the holding of Dastar would be meaningless if a false authorship claim could be recast" merely in sponsorship or affiliation terms). In my view, this aspect of the holding has to be correct. First, *Dastar* is primarily about how to define the thing for which the defendant's use must indicate source; it is a determination that "origin of goods" means only "origin of *physical* goods." The decision is less about the meaning of "origin", notwithstanding the Court's musings about the difficulty of identifying the actual creator of expressive content. In fact, the

Presse v. Morel court believed that “the allegations supporting

Court even acknowledged that origin “might be stretched to include, not only the actual manufacturer of physical goods, but the entity that stands behind them.” That language was clearly intended to make room for a sponsorship or affiliation claim, though the holding insists that the only relevant question is whether some entity might be seen to stand behind the physical goods. And this it must have recognized, since the text of § 43(a) expressly refers to sponsorship or affiliation. Thus, even if the word “origin” cannot carry such broad meaning, there is plenty of other text in the statute that can. And as a matter of fact, most claims under § 43(a) are sponsorship or affiliation claims, so it would be strange indeed if courts were, only in this limited circumstance, to insist that “origin” referred only to the actual source.

Morel's false advertising claim [were] identical to those supporting his false representation claim," and the false advertising claim was therefore barred for the same reason as the false representation claim.⁷⁶ "The import of Dastar that an author's recourse for unauthorized use is in copyright cannot be avoided by shoe-horning a claim into section 43(a)(1)(B) rather than 43(a)(1)(A)."⁷⁷

On this last point, the *Agence France Press* court was undoubtedly correct: it would be inconsistent with the whole

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⁷⁷ *Agence France Presse v. Morel*, 769 F. Supp. 2d 295, 308 (S.D.N.Y. 2011) ("If authorship were a 'characteristic' or 'quality' of a work, then the very claim Dastar rejected under § 43(a)(1)(A) would have been available under § 43(a)(1)(B).").

spirit of *Dastar* to allow parties to avoid the decision simply by recharacterizing as false advertising a claim that is really about use of content. And, in my view, it would be equally inconsistent with the spirit of *Dastar* to allow a party to avoid *Dastar* by recharacterizing its claim as passing off, alleging that the defendant's use of content would cause confusion about the source of the goods into which the content was embodied. *Dastar* meant to channel claims about the content of works to copyright.

Yet plaintiffs in many of the cases identified at the beginning of the paper have tried to evade *Dastar* precisely by alleging that the content, or some aspect of it, has secondary meaning. In *Fleischer Studios v. A.V.E.L.A.*, for example, the

plaintiff claimed the defendant's depiction of the Betty Boop character on t-shirts would cause confusion about the source of the t-shirts.⁷⁸ This may have seemed to Fleischer distinguishable from Fox's claim in *Dastar* because it could conceive of the t-shirts as distinct products (at least more easily than videotapes, which may seem merely to be the medium for the creative content). On this view, Fleischer was not seeking control over content, nor was it merely alleging confusion about the source of the Betty Boop character itself. Instead, Fleischer was trying to prevent confusion about the source of the merchandise A.V.E.L.A. was selling, even if any such confusion must have been caused by Betty Boop's presence on

⁷⁸ 654 F.3d 958 (9th Cir. 2011).

the merchandise.⁷⁹

But in fact the plaintiff's claim in *Fleischer Studios* was really no different than a claim by Fox that consumers would be confused about the source of Dastar's videotapes because of their content. In both cases the claim would be based on the implicit source indication of the creative content embodied in the goods. Thus, in both cases the claims really are about control of creative content. This is why the Ninth Circuit was right when it initially held that Fleischer's claim was barred by *Dastar*,⁸⁰ a ruling it unfortunately backed away from in its substituted opinion.

⁷⁹ This is the argument the Ninth Circuit ultimately accepted. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958, 961, 968 (9th Cir. 2011) (withdrawing and superseding prior opinion and finding questions of fact about existence of secondary meaning of Betty Boop character, which had been licensed for use in toys, dolls, and other merchandise).

⁸⁰ *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115, 1124 (9th Cir. 2011).

The plaintiffs' claims in the John Carter of Mars and Darkover cases even more clearly attempt to avoid *Dastar* by alleging confusion about the source of goods despite the fact that any such confusion could only result from the content embodied in those goods. In both of those cases the plaintiffs allege that the inclusion of some element of a copyrighted work (a character or a fictional place) in the defendants' works implicitly indicates source and causes confusion.⁸¹

⁸¹ The plaintiff in the Darkover case also alleged that use of the word "Darkover" in the *Molly of Darkover* and *Women of Darkover* titles would contribute to the alleged confusion. Standing on its own, that allegation would run headlong into *Rogers v. Grimaldi*, under which use of a trademark (assuming Darkover qualifies) in the title of an expressive work is shielded from liability under the Lanham Act "unless title has no artistic relevance to underlying work whatsoever or, if it has some artistic relevance, unless title explicitly misleads as to source or content of work." 875 F.2d 994, 999 (2d Cir. 1989). Assuming that the defendants' books do, in fact, build on the Darkover series, then the titles are clearly artistically relevant. Indeed, it is precisely the artistic relevance that the plaintiff contends exacerbates the violation of setting the stories on Darkover to begin with.

Because *Dastar* itself does not involve a passing off claim in which secondary meaning was alleged to exist in the content of the material *Dastar* copied, it does not obviously control these cases, at least not on a narrow reading. But, as the following section elaborates, courts should read *Dastar* broadly, because allowing such claims would create even more significant conflict with copyright law than was at issue in *Dastar* itself.

III. Content-based Claims and the Spirit of Dastar

Imagine that *Steamboat Willie* falls into the public domain⁸²

⁸² I realize this will require suspension of disbelief. But play along.

and I begin selling DVDs of the movie, which I have mechanically reproduced onto my own blank DVDs and marked as "distributed by Mark." Mickey Mouse clearly has the secondary meaning Fox's content lacked, so Disney would not need to assert a reverse passing off claim here -it could assert a straightforward passing off claim, arguing that the presence of Mickey Mouse in the content impliedly indicates the source of the physical DVDs. And by making sure to allege confusion about the source of the actual physical products, Disney purports to avoid Dastar.

If Disney could do this, of course, then there would be no meaningful sense in which Steamboat Willie falls into the public domain on expiration of the copyright. Any re-use of the content would necessarily implicate Mickey Mouse's secondary

meaning.⁸³ So long as source indication can come from content, trademark rights would essentially be equivalent to copyright in any case in which the content is recognizable. And while this kind of case may not be resolved specifically by *Dastar*, the Supreme Court was motivated there by concerns about precisely

⁸³ This is particularly true since courts seem to accept that secondary meaning is just another way of saying that a feature (or content) is recognizable. This is not, of course, what secondary meaning is—secondary meaning refers to recognition of a feature as an indicator of the source of goods or services, and it is not obvious that recognizable creative content tells consumers anything about the source of goods employing that content. To the extent secondary meaning is equated with consumer recognition by itself, however, lots of well-known content may qualify.

this kind of use of trademark law to gain control over content.⁸⁴

There are two overlapping but distinct ways that courts could deal with claims like Disney's. One approach would be to refuse any claim based on alleged confusion that results from use of creative content. This approach would focuss on the nature of the feature or content claimed by the plaintiff to indicate source, and it would effectively prohibit copyrightable content from serving as a trademark. So, for example, a court facing a claim like Fleischer Studios' in the *A.V.E.L.A.* case would find the claim barred because it was based on a claim of secondary meaning in a formerly copyrighted character.

Alternatively, courts could focus on the nature of the

⁸⁴ Cf. *Fleischer Studios*, 636 F.3d at 1124 ("If we ruled that *A.V.E.L.A.*'s depictions of Betty Boop infringed Fleischer's trademarks, the Betty Boop character would essentially never enter the public domain. Such a result would run directly contrary to *Dastar*.").

defendant's use and deny any claim based on confusion that allegedly results from the content of the defendant's expressive work. On this approach, Disney's passing off claim against a party that reproduced Steamboat Willie would be barred because that claim would be based on an allegation of confusion caused by use of Mickey Mouse within the content.

These two approaches would converge in many cases, of course. In Disney's passing off claim against a party that copied Steamboat Willie, for example, it would not matter whether a court barred the claim because the content of Steamboat Willie cannot serve as a source designator or because the claim alleges confusion that results from the content of the defendant's work. The claim would be barred under either approach. But, in my

view, there are some good reasons to view these cases in terms of the nature of the defendant's use.

First, categorical exclusion from trademark law of all material protected by copyright would likely rule out many more claims than is initially apparent. Under current law, a good deal of material gets some trademark protection could also be protected by copyright. Much advertising currently receives both copyright and trademark protection, for example, as do sufficiently creative logos and characters.⁸⁵ Trademark

⁸⁵ To be sure, not all such advertising slogans will warrant copyright protection. Some will be refused on the ground that, as short phrases, they are not sufficiently original. See Arica Inst., Inc. v Palmer, 970 F.2d 1067, 1072 (2d Cir. 1992) (finding that "short

protection would likely be barred for Tony the Tiger under an approach that barred trademark protection for any copyrightable content.⁸⁶



phrases . . . do not exhibit the minimal creativity required for copyright protection"). But some significant amount of advertising will clear the originality hurdle, as will many stylized logos.

⁸⁶ Tony the Tiger is the "advertising cartoon mascot for Kellogg's Frosted Flakes breakfast cereal, appearing on its packaging and advertising." http://en.wikipedia.org/wiki/Tony_the_Tiger.

Even the Lacoste logo may well be sufficiently creative to warrant copyright protection and therefore be barred from trademark protection.⁸⁷



This may be a good reason to conclude that the problem is copyright protection for logos and advertising material. Perhaps those features should instead be protected only through trademark law, if at all. Copyright might be precluded through application of a rigorous originality requirement, perhaps through consistent application of the Copyright Office's view that "slogans, and other short phrases or expressions cannot be

⁸⁷ <http://en.wikipedia.org/wiki/Lacoste>.

copyrighted.”⁸⁸ Or courts might simply categorically exclude advertising matter from copyright, in the manner disapproved of in Bleistein v. Donaldson Lithographing Co.⁸⁹ But those kinds of limiting doctrines do not seem likely in copyright law; indeed, if anything, categorical restrictions seem to be losing even more favor. Thus, under the current copyright rules, an approach that ruled out trademark protection for copyrightable material probably cuts far too broadly.

Secondly, some courts are likely to be disinclined to adopt categorical rules under which all claims against uses of

⁸⁸ See Copyright Protection Not Available for Names, Titles, or Short Phrases, **U.S. Copyright Office**, <http://www.copyright.gov/circs/circ34.pdf> (last visited May 12, 2012).

⁸⁹ 188 U.S. 239 (1903).

copyrighted or formerly copyrighted content must fail. And courts that are reluctant to adopt categorical rules are likely to be attracted to a distinction between claims against re-use of content qua content and claims against uses of content to designate the source of what could be seen as other goods or services. These courts, for example, may be persuaded, as the Ninth Circuit ultimately was in *A.V.E.L.A.*, of a distinction between re-distribution of copyrighted content and use of some aspect of that content to adorn merchandise. Other cases might even seem more obviously distinguishable from a claim against mere re-use of content: where, for example, a company adopts as a trademark a character developed independently of the product and uses on its packaging or in advertising, as MetLife did when

it began using Snoopy and other Peanuts characters in connection with its insurance services.⁹⁰

Courts facing cases like these are likely to have great difficulty deciding when the use of a copyrightable feature bars trademark protection, and the distinction is likely to be based on the extent to which the court perceives the product with which the character is as distinct from the content. In other words, courts will routinely face the difficulty of defining the product at issue and determining whether the copyrightable feature is part of that product or not.

The more pragmatic approach would therefore be to bar any claim that is based on confusion attributable to the content of

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<http://www.metlife.com/brandcenter/visual/snoopy/index.html#overview>.

a defendant's creative work, whether that claim is articulated as one for trademark infringement, passing off, or reverse passing off (like Fox's claim). This bar should be interpreted broadly to rule out claims that allege confusion about the origin of content itself as well as claims that allege confusion about the source of goods where such confusion arises from implicit source designation of the content. On this approach Fox's claim in Dastar would be barred because it alleged confusion about the origin of content, as would Disney's claim against someone who copied Steamboat Willie, even if that claim were articulated as a passing off claim focused on confusion about the source of physical DVDs. Met Life would be barred from asserting a claim against one who used Peanuts content in their

own creative work, but it would not be barred from asserting a claim against another company that used Snoopy to advertise its insurance services.

This approach is not only better for pragmatic reasons, it is actually more consistent with what the Supreme Court was doing in Dastar. As noted above, contrary to most readings of the case, Dastar did not develop an exceptional rule for creative works. Unfair competition ordinarily does not recognize reverse passing off claims against parties that copy consistently with other intellectual property rules. Coca-Cola does not get a claim against me for selling NewCo soda that is reverse engineered from Coca-Cola. Nor would Chanel have a claim against me for reverse passing off if I reverse engineered its perfume

and sold it in distinctive bottles under my own trademark.⁹¹

Dastar is best understood as an extension of this principle:

parties do not get reverse passing off claims against those who

legitimately copy creative work, even if they do not attribute.

There is no special rule for creative content.

This approach will also sometimes sweep out claims that do not create the same obvious tension with copyright as cases in which the defendant reuses creative content. Specifically, this approach will rule out claims based on the defendant's use within its content of features that are not copyrightable (or at

⁹¹ Scents have sometimes received protection as trademarks, but only for products not sold primarily for their scent. [In re Clarke, 17 U.S.P.Q.2d 1238 \(T.T.A.B. 1990\)](#) (noting that the "fragrance [was] not an inherent attribute or natural characteristic of applicant's goods but [was] rather a feature supplied by the applicant").

least for which copyright protection was not sought). The University of Alabama's claim against Daniel Moore would have been excluded categorically under this approach, as would Louis Vuitton's claim against the producers of the Hangover Part II. In both cases the plaintiffs alleged confusion arising out of the content of the defendant's creative work.

But the fact that these claims do not pose the same conflict with copyright does not make this approach less attractive. Approaching cases this way deals well with cases like the Darkover case and Teller's claim against the other magician - it rules them out categorically, whether they allege passing off (because of purported secondary meaning) or reverse passing off. It rules those claims out without also categorically ruling out

trademark protection for Tony the Tiger, as would an approach that focused on the copyrightability of the plaintiff's claimed mark. And the other claims this better approach rules out that involve use within creative content of non-copyright material ought to be very unlikely to succeed anyway. Those claims by definition are asserted against uses within creative content (or are at least based on that content), so they are unlikely to prevail under the nominative and descriptive fair use doctrines and/or *Rogers v. Grimaldi*. Indeed, both Louis Vuitton's and the University of Alabama's claims failed under *Rogers*.⁹² Thus, the

⁹² See *Louis Vuitton Malletier S.A. v. Warner Brothers Entertainment Inc.*, 11 Civ. 9436 (slip op. June 15, 2012) (<http://www.nysd.uscourts.gov/cases/show.php?db=special&id=189>); *Univ. of Alabama v. New Life Art, Inc.*, --- F.3d ----, 2012 WL 2076691 (11th Cir. 2012) (In this case, we readily conclude that Moore's paintings, prints, and calendars are protected under the *Rogers* test. The depiction of the University's uniforms in the content of these items is artistically relevant to the expressive underlying works because the uniforms' colors and designs are needed for a realistic portrayal

error cost from ruling the claims out categorically is likely to be quite low here. At the same time, having a mechanism for ruling out these claims categorically is likely to have significant enforcement cost benefits.⁹³

To be sure, the approach I advocate here is not free from difficulty. The distinction between Met Life's claim against someone that re-used Peanuts material in a movie and another claim against someone that used Snoopy to advertise its insurance services depends on the conclusion that the former involves a creative work and the latter does not. Those examples may be reasonably clear, but in other cases it may not be easy

of famous scenes from Alabama football history. Also there is no evidence that Moore ever marketed an unlicensed item as "endorsed" or "sponsored" by the University, or otherwise explicitly stated that such items were affiliated with the University.")

⁹³ See generally Robert G. Bone, Enforcement Costs and Trademark Puzzles, 90 Va. L. Rev. 2099 (2004).

to determine whether the alleged confusion is attributable to the content of a creative work. In the Betty Boop case, for example, a court would have to determine whether the defendant's t-shirts and other merchandise count as creative works.

But I think those edge cases are likely to be exceptional ones, and courts already have significant experience determining whether the defendant's work is expressive in the context of *Rogers v. Grimaldi*. *Rogers* only applies in cases involving the title of an expressive work or the content of an expressive work itself, and though there have been other difficulties determining the applicability of *Rogers*, courts do not seem to have had difficulty determining when the case involves an

expressive work.⁹⁴

IV. Conclusion

A series of recent cases implicate the extent to which trademark law can be used to control creative content. The possibility of doing so obviously creates potential conflict with copyright law, which ordinarily sets the rules for use of creative material developed by others. Unfortunately, despite the Supreme Court's attraction to boundary questions in trademark law, the Court's *Dastar* lone decision demarcating trademark and copyright law remains controversial and its scope

⁹⁴ See, e.g., *ETW v. Jireh*; *University of Alabama v. New Life Arts*; *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008) (finding defendant's use of "Pig Pen" (a fictitious adult entertainment venue) in a video game was non-actionable under *Rogers v. Grimaldi*); [*Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 \(9th Cir.2003\)](#) (finding plaintiff's claim against defendant's use of Barbie dolls in various purported art pieces protected under *Rogers v. Grimaldi*, in addition to other defenses such as nominative fair use).

is somewhat unclear.

This Essay argues that *Dastar* should be understood, or at least should be extended, to rule out any claims based on confusion that is attributable to the content of a creative work, however that claim is denominated. This approach is better than ruling out trademark protection for all copyrightable works, even though it sweeps out some claims that do not raise the same concerns about conflict with copyright. It is better both because it is more consistent with trademark and unfair competition law's traditional role and because those other claims ought to be unsuccessful in virtually all cases in any event. It also has the virtue of creating certainty and allowing courts to dispose of cases early. In this respect, *Dastar* could

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play a role similar to *TrafFix*: Dastar would reserve to
copyright law the rules for use of creative material, much as
TrafFix reserves to patent law rules for control of useful
features.