



7-1-2003

# Introduction: Rights of Attribution, Section 43(A) of the Lanham Act, and the Copyright Public Domain

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## Automated Citation

Tyler T. Ochoa, *Introduction: Rights of Attribution, Section 43(A) of the Lanham Act, and the Copyright Public Domain*, 24 WHITTIER L. REV. 911 (2003),

Available at: <http://digitalcommons.law.scu.edu/facpubs/84>

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# INTRODUCTION: RIGHTS OF ATTRIBUTION, SECTION 43(A) OF THE LANHAM ACT, AND THE COPYRIGHT PUBLIC DOMAIN

TYLER T. OCHOA \*

In *Dastar Corporation v. Twentieth Century Fox Film Corporation*,<sup>1</sup> the U.S. Supreme Court will decide whether the former owner of the copyright in a “work made for hire” has a federal right of attribution that continues to exist even after the formerly copyrighted work has entered the public domain.

Although the facts of the case are complex, the issues raised by the case are extremely important for several reasons. First, the case will determine whether we will have an *effective* public domain;<sup>2</sup> i.e., whether a public domain work can be freely copied by all, or whether a former copyright owner can hinder such copying by threatening and

\* Professor of Law and Co-Director, Center for Intellectual Property Law, Whittier Law School. A.B. 1983, J.D. 1987, Stanford University. Copyright © 2003 Tyler T. Ochoa. The author would like to thank David Welkowitz for his comments on a draft of this article. This introduction was drafted as background to the Brief *Amici Curiae* of Intellectual Property Law Professors in Support of Petitioner following this piece. The material for this discussion is drawn in large part from appendices to the Petition for Certiorari, which incorporate the district court’s Order Granting Summary Judgment (App. C) and its Findings of Fact and Conclusions of Law (App. B).

1. *Twentieth Cent. Fox Film Corp. v. Ent. Distribg.*, 34 Fed. Appx. 312 (9th Cir. Apr. 19, 2002), *cert. granted, sub nom. Dastar Corp. v. Twentieth Cent. Fox Film Corp.*, \_\_\_ U.S. \_\_\_, 123 S. Ct. 816 (2003).

2. *See generally* Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. Dayton L. Rev. \_\_\_ (forthcoming 2003).

bringing lawsuits based on an alleged lack of proper attribution.<sup>3</sup> Second, the case will determine whether section 43(a) of the Lanham Act may be used as a “back door” to recognize a moral right of attribution that Congress expressly rejected for motion pictures in enacting the Visual Artists Rights Act of 1990.<sup>4</sup> Third, in deciding the second question, the case may indirectly decide whether the United States is complying with its obligation under Article 6*bis* of the Berne Convention to provide authors of all “literary and artistic works” protected by the Convention with “the right to claim authorship of the work.”<sup>5</sup> Finally, if such a cause of action is allowed under the Lanham Act, the Court will have to resolve a split between the circuits as to the appropriate standard to be applied in “reverse passing off” cases where copyrightable works are concerned.

Fifteen intellectual property law professors filed an *amicus* brief in the case in support of the Petitioner.<sup>6</sup> The brief, which is reprinted following this introduction, attempts to place the *Dastar* case in its historical context, as merely the latest effort on the part of former copyright owners to use trademark and unfair competition law to punish and deter the copying of public domain works. The purpose of this introduction is to explain the factual and procedural background of the case, and to explain the importance of the case in terms of its potential impact on U.S. and international intellectual property law.

3. See Br. *Amici Curiae* Intellectual Property Law Professors in Support of Petitioner at 944-45, *Dastar Corp. v. Twentieth Cent. Fox Film Corp.*, \_\_\_ U.S. \_\_\_, 123 S. Ct. 816 (2003) [hereinafter *Amicus Brief*].

4. 17 U.S.C. § 106A (2000); see *infra*, nn. 94-98 and accompanying text.

5. *Berne Convention for the Protection of Literary and Artistic Works*, art. 6*bis*(1) (July 24, 1971), 828 U.N.T.S. 221 (Paris Revision) [hereinafter *Berne Convention*] (available at <<http://www.wipo.int/treaties/ip/berne/index.html>> (accessed Apr. 8, 2003)); see *id.* at art. 2(1) (defining “literary and artistic works”), 2(3) (defining “derivative works”), 2(5) (defining “collective works”). For further discussion of the Berne Convention, see *infra* notes 89-93 and accompanying text.

6. The fifteen law professors are listed in the Appendix to the *Amicus Brief*, *infra* at pages 950-51.

## I. FACTUAL BACKGROUND

The *Dastar* case involves a television series based on the memoirs of General Dwight David Eisenhower, commander of U.S. troops in Europe during World War II, Supreme Commander of the Allied Expeditionary Forces during the D-Day invasion, and later 34th President of the United States.<sup>7</sup> In 1948, Eisenhower wrote a book about his experiences during the war entitled *Crusade in Europe*.<sup>8</sup> The book was published by Doubleday & Company, Inc. on November 22, 1948,<sup>9</sup> and excerpts from the book were also serialized in the New York Herald Tribune.<sup>10</sup> On December 8, 1948, Eisenhower assigned “all rights of every nature pertaining thereto” to Doubleday for the lump sum of 635,000 dollars.<sup>11</sup> Doubleday registered the copyright with the Copyright Office in 1948.<sup>12</sup>

Under the 1909 Copyright Act, the copyright in the book had an initial duration of twenty-eight years, and could be renewed for another twenty-eight years if a timely application for renewal was filed by the proper renewal claimant during the twenty-eighth year of the copyright.<sup>13</sup> The purpose of the renewal term was to give the author of a work the chance to obtain additional compensation if the work proved to be popular.<sup>14</sup> The renewal term could be assigned in

7. Pet. for Cert. at app. B 8a., *Dastar Corp. v. Twentieth Cent. Fox Film Corp.*, \_\_\_ U.S. \_\_\_, 123 S. Ct. 816 (2003).

8. Dwight D. Eisenhower, *Crusade in Europe* (Doubleday & Co. 1948). Eisenhower began writing the book on February 8, 1948. Pet. for Cert., *supra* n. 7, at app. C 42a.

9. *Id.* at apps. B 8a, C 43a.

10. *Id.* at apps. B 8a-9a, C 43a. Thirty excerpts appeared in the Herald Tribune, beginning November 7, 1948. *Id.* at app. C 43a.

11. *Id.* at app. C 42a.

12. *Id.* at apps. B 9a, C 43a.

13. 17 U.S.C. § 24 (repealed 1976). This section was originally enacted as section 23 in 1909. In the 1947 codification, a new section 6 was inserted, and all subsequent sections were renumbered. See *Act of July 30, 1947*, ch. 391, 61 Stat. 652 (1947).

14. *Stewart v. Abend*, 495 U.S. 207, 217 (1990) (“The right of renewal found in § 24 [of the 1909 Act] provides authors a second opportunity to obtain remuneration for their works.”); 218-19 (“The renewal term permits the author, originally in a poor bargaining position, to renegotiate the terms of the grant once the value of the work has been tested.”); 220 (“The renewal provisions were intended to give the author a second chance to obtain fair remuneration for his creative efforts and to provide the author’s family a ‘new estate’ if the author died before the renewal period arrived.”).

advance of the twenty-eighth year;<sup>15</sup> however, courts generally have held that in order to be effective, such an assignment had to expressly mention the renewal term.<sup>16</sup> Even the assignment of “all right, title, and interest” has been held to be insufficient to convey the renewal term.<sup>17</sup> If, however, the work was a work “made for hire” under the 1909 Act,<sup>18</sup> then the proper renewal claimant would be the “proprietor” of the copyright (i.e., the employer or commissioning party, or its assignee), rather than the individual author of the work.<sup>19</sup>

In 1975, Doubleday filed a renewal application for the book as the “proprietor of copyright in a work made for hire.”<sup>20</sup> It is conceded that if the work was in fact a work “made for hire” under the 1909 Act, the renewal copyright is valid; and under the Sonny Bono Copyright Term Extension Act of 1998 (*CTEA*),<sup>21</sup> the renewal term will last until

15. *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643, 657-59 (1943).

16. *Epoch Producing Corp. v. Killiam Shows, Inc.*, 522 F.2d 737, 747 (2d Cir. 1975) (“[T]here is no specific reference in either assignment to the renewal term. This deficiency has generally been held, as a matter of law, absent contrary evidence, to preclude a holding that a transfer of renewal rights was intended.”); *Edward B. Marks Music Corp. v. Charles K. Harris Music Publg. Co.*, 255 F.2d 518, 521 (2d Cir. 1958) (“The cases are clear that a copyright renewal creates a separate interest distinct from the original copyright and that a general transfer by an author of the original copyright without mention of renewal rights conveys no interest in the renewal rights without proof of a contrary intention.”).

17. See e.g. *Edward B. Marks Music Corp.*, 255 F.2d at 520.

18. Although section 24 of the 1909 Act refers to “an employer for whom such work is made for hire,” this clause was judicially interpreted to include virtually any commissioned work. 17 U.S.C. § 24 (repealed 1976) (emphasis added); see e.g. *Forward v. Thorogood*, 985 F.2d 604, 606 (1st Cir. 1993):

Although initially confined to the traditional employer-employee relationship, the doctrine has been expanded to include commissioned works created by independent contractors, with courts treating the contractor as an employee and creating a presumption of copyright ownership in the commissioning party at whose “instance and expense” the work was done.

*Id.* By contrast, for works created on or after January 1, 1978, the phrase “work made for hire” is specifically defined to limit the types of commissioned works which qualify, and to require a signed writing for works commissioned from independent contractors. 17 U.S.C. § 101 (2000); see *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989).

19. 17 U.S.C. § 24 (repealed 1976).

20. Pet. for Cert., *supra* n. 7, at apps. B 9a, C 43a.

21. Pub. L. No. 105-298, 112 Stat. 2827 (1998). The *CTEA* was upheld against constitutional challenges under the Patent and Copyright Clause and the First Amendment in *Eldred v. Ashcroft*, \_\_\_ U.S. \_\_\_, 123 S. Ct. 769 (2003).

December 31, 2043.<sup>22</sup> However, if the work was not a work “made for hire” under the 1909 Act, then the renewal application filed by Doubleday is invalid. Since no renewal application was filed by Eisenhower’s heirs,<sup>23</sup> if the book was not a work “made for hire” it entered the public domain on November 23, 1976.

On November 20, 1948, Doubleday granted to Twentieth Century Fox the exclusive television rights in the book.<sup>24</sup> Fox, in turn, commissioned the “March of Time” film unit of Time, Inc. to produce a television series based on the book.<sup>25</sup> The series, also entitled *Crusade in Europe*, consisted of twenty-six half-hour episodes that combined pre-existing newsreel and film footage with original connecting material, accompanied by a soundtrack consisting of narration and background music.<sup>26</sup> The series was broadcast on the ABC television network beginning May 5, 1949, and concluding on October 27, 1949.<sup>27</sup> The copyright in the television series was assigned to Fox by Time, Inc.,<sup>28</sup> and in 1953 Fox registered the copyright, listing Time as the author;<sup>29</sup> but neither Time nor Fox filed an

22. 17 U.S.C. § 304(b) (2000). “Any copyright still in its renewal term at the time that the Sonny Bono Copyright Term Extension Act becomes effective shall have a copyright term of [ninety-five] years from the date copyright was originally secured.” *Id.* Section 305 provides that “[a]ll terms of copyright provided by sections 302 through 304 run to the end of calendar year in which they would otherwise expire.” 17 U.S.C. § 305.

23. Eisenhower died on March 28, 1969. Chester J. Pach Jr. & Elmo Richardson, *The Presidency of Dwight D. Eisenhower* 237 (U. Press of Kan. 1991). In such a case, the right to renewal passed to “the widow, widower, or children of the author, if the author be not living.” 17 U.S.C. § 24 (repealed 1976).

24. Pet. for Cert., *supra* n. 7, at app. B 9a. Under the 1909 Act, a federal copyright was measured “from the date of first publication.” 17 U.S.C. §24 (repealed 1976). Although excerpts were published in the New York Herald Tribune beginning November 7, 1948, the entire book was not published until November 22. Pet. for Cert., *supra* n. 7, at apps. B 8a-9a, C 42a-43a. Technically, then, Doubleday granted the television rights in the book to Fox before the federal copyright came into existence, and before Eisenhower assigned his rights in the book to Doubleday. *Id.* at app. C 42a.

25. *Id.* at apps. B 9a, C 43a.

26. *Id.* at apps. B 10a, B 13a, C 45a.

27. Tim Brooks & Earle Marsh, *The Complete Directory to Prime Time Network TV Shows 1946–Present* 190 (3d ed., Ballantine Books 1985).

28. Pet. for Cert., *supra* n. 7, at app. C 55a.

29. App. for Reg. No. MP 3429 (Apr. 10, 1953) (on file with *Whittier Law Review*). The district court’s opinion on summary judgment erroneously states that “Time, Inc. registered the original *Crusade* series.” Pet. for Cert., *supra* n. 7, at app. C 55a.

application to renew the copyright.<sup>30</sup> Therefore, each episode of the television series entered the public domain in 1977.

Under section 7 of the 1909 Copyright Act, the television series was an “adaptation” or “dramatization” of Eisenhower’s book, which was entitled to a separate copyright; but the expiration of the copyright in the television series would have no effect on the copyright in the underlying work.<sup>31</sup> Under the U.S. Supreme Court’s decision in *Stewart v. Abend*,<sup>32</sup> a derivative work based on a copyrighted work may not continue to be exploited during the renewal term of the pre-existing work without the permission of the copyright owner in the pre-existing work.<sup>33</sup> Therefore, if Eisenhower’s book was a work made for hire, the renewal copyright of Doubleday would be valid, and copying any portions of the television series that were based on the book would be an infringement of the copyright in the book. However, if the book was not a work made for hire, then the book entered the public domain in 1976; and after the television series entered the public domain in 1977, any person could lawfully copy the television series without liability under the Copyright Act.

In 1980, SFM Entertainment, LLC (SFM) purchased from Time-Life Films, Inc. the *March of Time* film library, which included the original negatives of the *Crusade in Europe* series.<sup>34</sup> In 1984, SFM entered into an agreement with Embassy Home Entertainment to distribute the *Crusade* series on videotape.<sup>35</sup> SFM located the negatives and had them restored at a cost of seventy-five thousand

30. Pet. for Cert., *supra* n. 7, at 5 (Fox), app. C 55a (Time).

31. 17 U.S.C. § 7 (repealed 1976). This section was originally enacted as section 6 in 1909. In the 1947 codification, a new section 6 was inserted, and all subsequent sections were renumbered. See *Act of July 30, 1947*, ch. 391, 61 Stat. 652, 654 (1947).

32. 495 U.S. 207 (1990).

33. *Id.* at 237-38. *Stewart* involved the motion picture *Rear Window* (Paramount 1954), which was based upon a short story first published in 1942. See Cornell Woolrich, *It Had to Be Murder*, Dime Detective Mag. (Feb. 1942). Woolrich died in 1968, before the copyright could be renewed; after his death, his executor, Chase Manhattan Bank, renewed the copyright and assigned it to Sheldon Abend. *Stewart*, 495 U.S. at 211-12. The Supreme Court held that even though Woolrich had promised to assign the copyright in the renewal term to the movie’s producers, that promise was not enforceable when Woolrich died before the renewal term vested; therefore, the re-release of *Rear Window* during the renewal term without Abend’s permission was infringing. *Id.* at 219-21.

34. Pet. for Cert., *supra* n. 7, at app. B 1 la.

35. *Id.*

dollars.<sup>36</sup> Under the holding in *Stewart*, however, if the copyright in the underlying book was still valid, SFM could not distribute the television series on video without clearing the rights with Doubleday.<sup>37</sup>

In 1988, Fox acquired from Doubleday the “exclusive” right to distribute the *Crusade* series on video, and to license and sublicense others to do the same.<sup>38</sup> Fox then granted distribution rights in the series to SFM,<sup>39</sup> which reproduced the series in a package of six videocassettes for sale to consumers.<sup>40</sup> The home video series was distributed by New Line Home Video, Inc., the successor-in-interest to Embassy.<sup>41</sup> There are numerous credits on the cover of the home video version of the series, including the following: “Eisenhower’s Crusade in Europe Based on the Book by Dwight D. Eisenhower,” “A March of Time Production By Arrangement with 20th Century Fox,” “SFM,” and “New Line Home Video.”<sup>42</sup> The copyright notice reads: “The Exclusive Picturization of General Dwight D. Eisenhower’s book CRUSADE IN EUROPE published by Doubleday & Company Inc. © 1948 Doubleday & Company Inc.”<sup>43</sup>

In 1995, Dastar purchased eight “beta cam” tapes of the original television series of sufficient quality to enable them to be reproduced.<sup>44</sup> Lanny Tarter, a Dastar employee, then produced a derivative work based on the original television series, which Dastar titled *Campaigns in Europe*.<sup>45</sup> In creating the videos, Dastar:

[S]ubstituted a new opening title sequence, credit page and closing [sequence; . . .] substituted 26 new chapter-title sequences . . . , deleted references to the Book . . . that appeared at the beginning of each of the [episodes (approximately twenty minutes of footage)]; moved the *Crusade* “recap” to the beginning of

36. *Id.* at apps. B 11a, C 44a.

37. 495 U.S. at 237-38; *see supra*, nn. 32-33 and accompanying text.

38. Pet. for Cert., *supra* n. 7, at app. B 10a.

39. *Id.* at app. B 10a-11a.

40. *Id.* at app. B 11a-12a.

41. *Id.*

42. *Id.* at apps. B 11a, C 44a.

43. *Id.* at app. B 12a.

44. *Id.* at apps. B 12a, C 45a.

45. The district court’s initial reference states that the title of Dastar’s version was titled *Campaign in Europe*. *Id.* at app. C 31a. All subsequent references use the plural *Campaigns*, and Dastar’s Petition identifies the work as *Campaigns in Europe*. *Id.* at 5.

*Campaigns*, and retitled it as a “preview”; and . . . inserted narrated chapter introductions written by Tarter.<sup>46</sup>

*Campaigns in Europe* was released in October 1995.<sup>47</sup> In 1996, Dastar also added new segments of two to three minutes each to the beginning of each tape.<sup>48</sup>

The only corporate entities credited on the cover of the *Campaigns in Europe* series are Dastar and Marathon Music & Video, Dastar’s distributor.<sup>49</sup> The credits on the series itself identify Norman Anderson, Dastar’s President, as Executive Producer; Barbara Kaye, Tarter’s former assistant, as Associate Producer; and Tarter as Producer.<sup>50</sup> The cover does not mention Eisenhower, Doubleday, Fox, Time, SFM, or New Line.<sup>51</sup> However, on some copies of the *Campaigns in Europe* videos, Dastar placed a sticker that read: “Contains Film Footage from the Previously Released *Crusade in Europe*.”<sup>52</sup>

## II. PROCEDURAL BACKGROUND

In 1998, Fox, SFM, and New Line sued Dastar, Marathon, and Entertainment Distributing<sup>53</sup> in the Central District of California for “copyright infringement, reverse passing off under [section 43(a) of] the Lanham Act, and unfair competition under California [state law].”<sup>54</sup> Dastar responded with a counterclaim against the three

46. *Id.* at apps. B 13a, C 45a. Dastar also added music to *Campaigns*. *Id.* at C 45a.

47. *Id.*

48. *Id.* at app. B 15a.

49. *Id.* at app. B 18a. The author infers the distributor relationship from Findings of Fact Nos. 60-61. *Id.* at app. B 16a.

50. *Id.* at apps. B 12a, B 18a, C 44a-45a.

51. *Id.* at app. B 18a.

52. *Id.* at apps. B 18a, C 53a n. 5.

53. The exact status of Entertainment Distributing is a little unclear. The district court found that it was an Oregon corporation, but later it refers to “EDI” as a “d.b.a. of Dastar.” *Id.* at app. B 8a, 16a.

54. *Id.* at app. C 31a. In a related proceeding, on May 12, 1999, Dastar tendered the defense of the action to its insurers, American States Insurance Company and American Economy Insurance Company. *See Am. States Ins. Co. v. Dastar Corp.*, 318 F.3d 881, 884 (9th Cir. 2003). American filed an action for a declaratory judgment that it had no duty to defend or indemnify Dastar, and Dastar filed a counterclaim for breach of the duties to defend and to indemnify. *Id.* The district court granted partial summary judgment in favor of American on the issue of the duty to defend. *Id.* Dastar then amended its complaint to remove the claim for breach of the duty to indemnify,

plaintiffs and against Random House, Doubleday's successor-in-interest,<sup>55</sup> seeking a declaration that both the book and television series were in the public domain and could be freely copied.<sup>56</sup> Both parties moved for summary judgment.<sup>57</sup> U.S. District Judge Florence-Marie Cooper<sup>58</sup> granted summary adjudication on liability to the plaintiffs on the copyright infringement claim, holding that the book was a work made for hire, that Doubleday's renewal was therefore valid, and that the book was infringed by the revised series produced by Dastar.<sup>59</sup>

With regard to the Lanham Act claim, Judge Cooper held first that the plaintiffs had standing to assert a claim:

Even if the *Crusade* television series is in the public domain, plaintiffs are not precluded from asserting a claim. "The dispositive question is whether the party has a reasonable interest to be protected against false advertising." *Lamothe [v. Atlantic Recording]*, 847 F.2d [1403, 1405 (9th Cir. 1988)]. Plaintiffs are the producers and sellers of the *Crusade* video series. They are the holders of the exclusive license to produce and distribute the *Crusade* television series on video. They have a clear interest in preventing defendants from misleading the public in the sale of the *Campaign* videos.<sup>60</sup>

This paragraph demonstrates a fundamental misunderstanding of the basis of Dastar's standing argument. First, if both the film and the book on which it is based are in the public domain, the plaintiffs do not have an *exclusive* license to produce and sell the television series; anyone is permitted to do so. Second, and more important, none of the plaintiffs (Fox, SFM, and New Line) are the authors of the copyrighted

and the parties stipulated to the dismissal without prejudice of American's claim for declaratory relief with respect to the duty to indemnify. *Id.* The Ninth Circuit dismissed the subsequent appeal by Dastar on the grounds that "the parties have engaged in manipulation to manufacture appellate jurisdiction." *Id.*; *see also id.* at 891 (finding that "[o]verall, the parties appear to have colluded to manufacture appellate jurisdiction by dismissing their indemnity claims after the district court's grant of partial summary judgment").

55. Pet. for Cert., *supra* n. 7, at app. C 31a.

56. *Id.* at app. C 54a.

57. *Id.* at app. C 31a.

58. Coincidentally, Judge Cooper is an alumna of Whittier Law School, Class of 1975.

59. Pet. for Cert., *supra* n. 7, at app. C 46a-50a.

60. *Id.* at app. C 52a.

work at issue. Even if the Lanham Act should be construed to give authors a right of attribution, that right would belong to Eisenhower, the author of the book, or Time, Inc., which produced the television series based on the book. Fox is, at best, only a former copyright owner of the television series, and a licensee of the copyright in the book. SFM and New Line are merely the manufacturer and distributor of a home video version of the television series. While the plaintiffs may be competitors of the defendants, it is not the omission of the plaintiffs' names which would be actionable. The question is whether the plaintiffs should be permitted to stand in the shoes of Eisenhower's heirs and/or Time, Inc., in order to assert a right of attribution which neither has chosen to assert.

Next, Judge Cooper granted summary adjudication on liability to the plaintiffs on the Lanham Act claim.<sup>61</sup> Under the relevant Ninth Circuit precedent, an action for reverse passing off may be maintained based upon the "bodily appropriation" of another's work of authorship.<sup>62</sup> Judge Cooper held that "defendants have copied substantially all of the television series,"<sup>63</sup> and that the "minor changes" made by Dastar "are insufficient to avoid liability under the Lanham Act."<sup>64</sup> Judge Cooper also granted summary adjudication for plaintiffs under a California state law of unfair competition,<sup>65</sup> and against defendants on their counterclaims.<sup>66</sup>

Judge Cooper held a trial to determine damages on the plaintiff's claims. She found that defendants earned net profits of 783,606.83 dollars on the sale of *Campaigns in Europe* videos.<sup>67</sup> Exercising her discretion to increase the award under Title 15 of the United States Code section 1117(a), she awarded plaintiffs double the defendant's profits, or a total of 1,567,213.66 dollars.<sup>68</sup>

61. *Id.* at app. C 52a-53a.

62. *Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994).

63. Pet. for Cert., *supra* n. 7, at app. C 53a.

64. *Id.* at app. C 52a.

65. Cal. Bus. & Prof. Code Ann. §§ 17200, 17500 (West 1997); Pet. for Cert., *supra* n. 7, at app. C 53a-54a.

66. *Id.* at app. C 54a-55a.

67. *Id.* at app. B 19a-20a.

68. *Id.* at app. B 27a. 15 U.S.C. § 1117(a) (2000) states:

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

On appeal, the U.S. Court of Appeals for the Ninth Circuit, in an unpublished disposition,<sup>69</sup> reversed the summary judgment on the copyright infringement claim, finding a triable issue of fact as to whether General Eisenhower's book was a work "made for hire" under the 1909 Act.<sup>70</sup> Despite this reversal, the Court affirmed the district court's summary judgment and award of double profits under section 43(a) of the Lanham Act, saying:

Dastar copied substantially the entire *Crusade in Europe* series created by Twentieth Century Fox, labeled the resulting product with a different name and marketed it without attribution to Fox. Dastar therefore committed a "bodily appropriation" of Fox's series. *See Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994) . . . .

We reject Dastar's contention that Twentieth Century Fox must make an independent showing that the series manufactured by Dastar resulted in consumer confusion. Dastar's "bodily appropriation" of Fox's original series is sufficient to establish reverse passing off, because the "bodily appropriation" test subsumes the "less demanding 'consumer confusion' standard." *Cleary*, 30 F.3d at 1261-62.<sup>71</sup>

of the case. Such sum . . . shall constitute compensation and not a penalty.

*Id.* The Supreme Court also granted certiorari to consider whether the district court's doubling of profits constituted an improper penalty under this section. Pet. for Cert., *supra* n. 7, at (i). This issue is not addressed in this introduction or in the Amicus Brief.

69. *Twentieth Cent. Fox Film Corp. v. Ent. Distribg.*, 34 Fed. Appx. 312 (9th Cir. Apr. 19, 2002), *cert. granted, sub nom. Dastar Corp. v. Twentieth Cent. Fox Film Corp.*, \_\_\_ U.S. \_\_\_, 123 S. Ct. 816 (2003). For those who have not yet encountered the Federal Appendix, it is a series of bound volumes in which West Publishing Company publishes the opinions of the U.S. Courts of Appeals which are designated as "Not For Publication."

70. 34 Fed. Appx. at 314.

71. *Id.* The Ninth Circuit's opinion specifically states that Dastar marketed the allegedly infringing videos "without attribution to Fox," indicating that Dastar owed a duty of attribution either to the former owner of a copyrighted work (the television series), which was in the public domain, or to the exclusive licensee of a copyrighted work (the book), which was alleged to be in the public domain. *Id.* Thus, under the Ninth Circuit's "bodily appropriation" theory, the right of attribution attaches to copyright owners, rather than authors; and it continues to exist even if the work allegedly copied is in the public domain.

In so holding, the Ninth Circuit perpetuated a conflict with the Second Circuit, which has held that a “reverse passing off” claim may be maintained when a plaintiff merely shows “substantial similarity” between the plaintiff’s work and the defendant’s work;<sup>72</sup> and with three other circuits, which have held that copying of a work of authorship does not by itself give rise to a Lanham Act violation without an independent showing of consumer confusion.<sup>73</sup> The Supreme Court granted certiorari to resolve the conflict.<sup>74</sup>

### III. IMPLICATIONS OF THE CASE FOR INTELLECTUAL PROPERTY LAW

Traditionally, unfair competition law was based on the defendant “passing off” its goods as those of the plaintiff, by using the plaintiff’s mark on goods manufactured by the defendant.<sup>75</sup> Over time, however, courts came to include within the scope of unfair competition the concept of “reverse passing off,” i.e., using the defendant’s mark on goods manufactured by the plaintiff.<sup>76</sup> In *Dastar*, the allegedly

72. See *Waldman Publ. Corp. v. Landoll, Inc.*, 43 F.3d 775, 784 (2d Cir. 1994); but see *Amicus Brief*, *supra* n. 3, at 947 n. 10 (noting conflicting opinions among courts within the Second Circuit).

73. *King v. Ames*, 179 F.3d 370, 374 (5th Cir. 1999); *Batiste v. Island Recs.*, 179 F.3d 217, 225 (5th Cir. 1999); *Murray Hill Publications, Inc. v. ABC Communs., Inc.*, 264 F.3d 622, 634 (6th Cir. 2001); *Lipscher v. LRP Publications, Inc.*, 266 F.3d 1305, 1313-14 (11th Cir. 2001).

74. *Dastar Corp. v. Twentieth Cent. Fox Film Corp.*, \_\_\_ U.S. \_\_\_, 123 S. Ct. 816 (2003).

75. *E.g. Restatement (Third) of Unfair Competition* § 4 (1995). To this end, the Restatement states:

One is subject to liability to another . . . if, in connection with the marketing of goods and services, the actor makes a representation likely to deceive or mislead prospective purchasers by causing the mistaken belief that . . . the goods or services that the actor markets are produced, sponsored, or approved by the other.

*Id.* at § 4, cmt. b (explaining the historical development of the principle, and noting that “[t]he fraudulent conduct was frequently described as ‘passing off’ or ‘palming off’ ”); *id.* at § 20, cmt. b (“An actor is subject to liability for infringement only if it uses another’s mark or name in identifying the actor’s own goods, services, or business . . .”).

76. *Id.* at § 5:

One is subject to liability to another . . . if, in marketing goods or services manufactured, produced, or supplied by the other, the actor makes a representation likely to deceive or mislead prospective purchasers by causing the mistaken belief that the actor or a third person is the manufacturer, pro-

misabeled videos were in fact manufactured by Dastar. Thus, the question is whether Fox can hold Dastar liable for “reverse passing off” based on Dastar’s *copying* of material in which Fox formerly owned a copyright (the television series) or in which Fox formerly owned an exclusive license (the book),<sup>77</sup> without attribution to Fox.

As is explained more fully in the *amicus* brief below, the standards of liability for “reverse passing off” adopted by the Ninth Circuit and the Second Circuit depend entirely on the amount of copying in which the defendant has engaged.<sup>78</sup> Any such standard would in effect duplicate copyright law in the guise of reverse passing off under the Lanham Act, except without the express constitutional requirement that copyright be granted only “for limited Times.”<sup>79</sup> Moreover, a standard based on copying is wholly unnecessary to address any legitimate interest relating to consumer protection (as opposed to protection of former copyright owners). If the work is still under copyright, liability will attach for copyright infringement, and there is no need for separate liability for misattribution. If, on the other hand, the work is in the public domain, anyone should be able to copy it, in whole or in part, without being subject to suit from the former copyright owner for misattribution.<sup>80</sup> If a right of attribution for *authors* is to be recognized, either for reasons of consumer protection or in order to recognize “moral rights” similar to those recognized in

ducer, or supplier of the goods or services if the representation is to the likely commercial detriment of the other . . . .

*See id.* at § 5, cmt. a (noting that “[t]his form of misrepresentation is sometimes referred to as ‘reverse passing off’ ”); *see also* 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, 1003-04 (2002) (explaining the development of the doctrine).

77. This discussion assumes that Dastar can demonstrate on remand that the book was not a work made for hire, and that it is therefore in the public domain. If the book is not in fact in the public domain, the harm to the public interest from recognizing a right of attribution under section 43(a) would be minimal, since the copyright owner can generally prevent the distribution of the derivative work using copyright law alone.

78. *Amicus Brief*, *supra* n. 3, at 946-47.

79. U.S. Const. art. I, § 8, cl. 8; *see Amicus Brief*, *supra* n. 3, at 947-48.

80. John T. Cross, *Giving Credit Where Credit Is Due: Revisiting the Doctrine of Reverse Passing Off in Trademark Law*, 72 Wash. L. Rev. 709, 766 (1997) (“As long as the defendant is free to copy the good—an issue governed by the copyright laws—it should be free to claim credit for its copies. The author should only receive credit for the works produced by the author, not by other parties.”).

other countries,<sup>81</sup> it should be done legislatively, instead of being fabricated through a strained judicial interpretation of the Lanham Act.<sup>82</sup>

The implications of the case for international copyright law are perhaps even more important than the implications for domestic law. The United States declined to join the Berne Convention for more than one hundred years after its creation in 1886,<sup>83</sup> in part because U.S. copyright law was incompatible with the minimum standards required by Berne.<sup>84</sup> In particular, U.S. law did not recognize the “moral rights” required by Article 6*bis* of the Berne Convention, which 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 or reputation.<sup>85</sup>

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81. See *Restatement (Third) of Unfair Competition* § 5, cmt. c (1995). The Restatement explains:

The rule of this Section can operate to prevent the misappropriation of credit properly owed to the original creator or performer, thus offering protection analogous in some respects to the “paternity” right recognized in favor of authors and artists under Civil Law.

*Id.*

82. See Cross, *supra* n. 80, at 736-42 (arguing that reverse passing off does not fit within the statutory language of section 43(a)); Kwall, *supra* n. 76, at 1025 (“The foregoing discussion demonstrates the difficulties with reliance on section 43(a) as the legal doctrine through which the attribution interest can be enforced.”); *id.* at 1025-31 (arguing for federal legislation expressly recognizing a right of attribution for authors).

83. Paul Goldstein, *International Copyright: Principles, Law and Practice* 23 (Oxford U. Press 2001) (noting that “[t]he United States was the single, commercially most important country to remain outside the Berne Union for its entire first century”); *id.* at 19-23 (for background on the development of the Berne Convention).

84. See Craig Joyce, William Patry, Marshall Leaffer & Peter Jaszi, *Copyright Law* 34 n. 45 (5th ed., Matthew Bender 2000):

As early as 1935, the U.S. Senate had made an abortive attempt to ratify the Berne Convention, only to rescind ratification when it became clear how significantly U.S. American copyright law would have to be modified to bring it into conformity with the minima of Berne—particularly as to term of protection and copyright formalities. Thereafter, the 1948 Brussels Act of the Convention had the effect of raising the bar still higher.

*Id.*

85. *Berne Convention*, *supra* n. 5, at art. 6*bis*(1); see generally Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 Vand.

When the United States finally acceded to the Berne Convention on March 1, 1989,<sup>86</sup> it did so without any express recognition of the moral rights required by Article *6bis*.<sup>87</sup> Congress's justification was that:

[E]xisting U.S. law[,] includ[ing] various provisions of the Copyright Act and Lanham Act, various state statutes, and common law principles such as libel, defamation, misrepresentation, and unfair competition, . . . have been applied by courts to redress authors' invocation of the right to claim authorship or the right to object to distortion.<sup>88</sup>

Consequently, Congress declared that "[t]he Amendments made by this Act, together with the law as it exists on the date of this Act, satisfy the obligations of the United States in adhering to the Berne Convention *and no further rights or interests shall be recognized or created for that purpose.*"<sup>89</sup> Not content with this general statement, Congress included the following specific disclaimer:

The provisions of the Berne Convention, the adherence of the United States thereto, and satisfaction of United States obligations thereunder, do not expand or reduce any right of an author of a work, whether claimed under Federal, State, or the common law— (1) to claim authorship of the work; or (2) to object to any distortion, mutilation, or other modification of, or derogatory action in relation to the work, that would prejudice the author's honor or reputation.<sup>90</sup>

L. Rev. 1 (1985); Calvin D. Peeler, *From the Providence of Kings to Copyrighted Things (and French Moral Rights)*, 9 Ind. Intl & Comp. L. Rev. 423 (1999) (setting forth the historical development of the doctrine of moral rights).

86. 53 Fed. Reg. 48748, 48748 (Dec. 2, 1988). "As stated in the instrument of accession, the Convention shall enter into force for the United States of America on March 1, 1989." *Id.*

87. *Berne Convention Implementation Act*, Pub. L. No. 100-568, 102 Stat. 2853 (1988) [hereinafter *BCIA*]. Under section 13(a) of the *BCIA*, "[t]his Act and the amendments made by this Act take effect on the date on which the [*Berne Convention*] . . . enters into force with respect to the United States." *Id.* at 2861.

88. Sen. Rpt. 100-352, at 9-10 (May 20, 1988) (reprinted in 1988 U.S.C.C.A.N. 3706, 3714-15).

89. 102 Stat. at 2853 (emphasis added).

90. *Id.* at 2853-54.

Congress also expressly provided that the Berne Convention was not self-executing;<sup>91</sup> that it was to be implemented only pursuant to domestic law;<sup>92</sup> and that it “shall not be enforceable in any action brought pursuant to the provisions of the Berne Convention itself.”<sup>93</sup> Far from being a congressional endorsement of the use of section 43(a) to vindicate any moral right of attribution, these provisions reek of a self-serving declaration of compliance, combined with express provisions intended to *prevent* the legal recognition of moral rights in copyrighted works.

In 1990, Congress enacted the Visual Artists Rights Act (*VARA*),<sup>94</sup> expressly recognizing limited moral rights of attribution and integrity for the first time in U.S. law.<sup>95</sup> However, the rights provided by *VARA* are extremely limited. *VARA* only applies to a “work of visual art,” which is defined to exclude, among many other works, any “motion picture or other audiovisual work,”<sup>96</sup> and “any work made for hire.”<sup>97</sup> Thus, in enacting *VARA*, Congress made it clear that it was not providing any moral rights of attribution for motion pictures (or a television series). To recognize such a claim under section 43(a) of the Lanham Act would be to circumvent the clearly expressed intent of Congress in a much more specific, later-enacted statute.<sup>98</sup>

In 1994, the Uruguay Round of the General Agreement on Tariffs and Trade adopted the Agreement on Trade-Related Aspects of

91. *Id.* at 2853.

92. *Id.*

93. *Id.*; see also *id.* at 2855 (codified in 17 U.S.C. § 104(c) (2000), which states that, “[n]o right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto. Any rights in a work eligible for protection under this title that derive from this title, other Federal or State statutes, or the common law, shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto”).

94. *Visual Artists Rights Act*, Pub. L. No. 101-650, 104 Stat. 5089, 5128-33 (1990). With certain exceptions, “this title and the amendments made by this title take effect [six] months after the date of the enactment of this Act.” *Id.* at 5132. *VARA* was enacted on December 1, 1990; therefore it took effect on June 1, 1991. *Id.* at 5089.

95. 17 U.S.C. §106A.

96. 17 U.S.C. § 101 (defining a “work of visual art”).

97. *Id.*

98. See Br. of *Amici Curiae* Malla Pollack and Other Law Professors Supporting Dastar Corp. as to Question One at 6-9, *Dastar Corp. v. Twentieth Cent. Fox Film Corp.*, \_\_\_ U.S. \_\_\_, 123 S. Ct. 816 (2003) (making this argument more fully).

Intellectual Property Rights, or *TRIPS*.<sup>99</sup> The *TRIPS* Agreement makes the provisions of the Berne Convention enforceable between nations through the dispute-resolution procedure of the World Trade Organization (WTO),<sup>100</sup> with a single exception: Article *6bis*.<sup>101</sup> The exception was insisted upon by the United States,<sup>102</sup> for the obvious reason that U.S. officials knew that we were not in compliance with Article *6bis* and did not want to have our non-compliance officially adjudicated by the WTO, which would result in international embarrassment and possibly severe trade sanctions as well. Nonetheless, a broad ruling in favor of *Dastar*, denying the existence of a federal right of attribution, might be used by other countries to bring the United States' persistent non-compliance with Article *6bis* to the forefront of the international copyright agenda.

Conversely, some may contend that a ruling in favor of Fox in the *Dastar* case would lend some support to the notion that the United States is in compliance with its obligations under Article *6bis* of the Berne Convention. This contention is a red herring. As pointed out above, Fox is merely a former owner of the expired copyright in the television series and a licensee of the perhaps-expired copyright in the book. Article *6bis* of the Berne Convention requires that rights of attribution be given to *authors*, not former copyright owners. If any right of attribution is to be recognized at all, it should be recognized in favor of Eisenhower, the author of the book on which the television series was based.<sup>103</sup> Moreover, if the United States intends to actually

99. *Uruguay Round Agreements Act*, Pub. L. No. 103-465, 108 Stat. 4809, 4815 (1994); see J.H. Reichman, *Universal Minimum Standards of Intellectual Property Protection Under the TRIPS Component of the WTO Agreement*, 29 *Intl. Law.* 345 (1995) (providing an overview of *TRIPS*).

100. *Agreement on Trade-Related Aspects of Intellectual Property* art. 64(1) (Apr. 15, 1994), 33 *I.L.M.* 15 [hereinafter *TRIPS Agreement*]. "The provisions of Articles XXII and XXIII of GATT 1994 as elaborated and applied by the Dispute Settlement Understanding shall apply to consultations and settlement of disputes under this Agreement except as otherwise specifically provided herein." *Id.*

101. *TRIPS Agreement*, *supra* n. 100, at art. 9(1) (stating that "[m]embers shall comply with Articles I through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of rights conferred under Article *6bis* of that Convention or of the rights derived therefrom").

102. Goldstein, *supra* n. 83, at 55 ("Yielding to strenuous objections from the United States, the *TRIPS* Agreement expressly excluded the Berne Convention's moral rights obligations from the obligations enforceable under the *TRIPS* Agreement.").

103. See *Berne Convention*, *supra* n. 5, at *6bis*(2):

fulfill its obligation under Article 6*bis*, it should do so expressly, with a statute specifying what credit is and is not required, so that users of public domain works do not have to guess what credits might or might not be due, at the risk of substantial liability if they are wrong.

#### IV. CONCLUSION

United States copyright law is designed to serve the public interest by giving authors a financial incentive to create and publish original works of authorship, and by permitting those works to be freely copied and disseminated after the “limited Times” provided by copyright law has expired.<sup>104</sup> The public interest is served by permitting competition in the copying and dissemination of public domain works.<sup>105</sup> This policy should not be thwarted by reflexive

The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed. However, those countries whose legislation, at the moment of their ratification or accession to this Act, does not provide for the protection after the death of the author of all the rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained.

*Id.* Because U.S. law did not expressly recognize any moral rights at all at the moment of its accession, it would appear that it can permit moral rights to expire upon the death of the author and still be in compliance with Berne. *E.g.* 17 U.S.C. § 106A(d)(1) (2000) (noting that the duration of moral rights provided under *VARA* “shall endure for a term consisting of the life of the author”). Because Eisenhower died in 1969, well before the U.S. acceded to the Berne Convention, it would not violate the Berne Convention for the U.S. to fail to provide his heirs with a moral right of attribution.

104. U.S. Const. art. I, § 8, cl. 8; *see Sony Corp. of Am. v. Universal City Studios, Inc.*, 429 U.S. 417, 429 (1984):

The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.

*Id.*

105. Edward Rappaport, *Copyright Term Extension: Estimating the Economic Values* 3 (CRS Rpt. for Cong. May 11, 1998) Rappaport concluded:

When a copyright expires, . . . [t]he price of the final product will come down to the economic cost, with the result that it will be more widely distributed and consumed. . . . [T]hus new, cheaper editions can be expected when works come out of copyright.

*Id.*

application of section 43(a) of the Lanham Act to punish copying, which is expressly permitted by the Copyright Act. The Brief *Amici Curiae* that follows expresses the view, shared by fifteen intellectual property law professors, that section 43(a) of the Lanham Act ought not be interpreted to give a perpetual right of attribution to the former copyright owners of works in the public domain.

