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COMMENT

“EVERY ARTIST IS A CANNIBAL, EVERY POET IS A THIEF”:¹ WHY THE SUPREME COURT WAS RIGHT TO REVERSE THE NINTH CIRCUIT IN *DASTAR CORP. V. TWENTIETH CENTURY FOX FILM CORP.*

*Joshua K. Simko**

I. INTRODUCTION

Traditionally, trademark infringement has arisen out of a likelihood of confusion in the marketplace.² Likelihood of confusion occurs when the average consumer will be confused as to the origin of a product so that she may buy the wrong thing because the infringing trademark too closely resembles another product's mark. Section 43(a) of the Lanham Act incorporates this test and

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¹ U2, *The Fly*, on ACHTUNG BABY (Island Records 1991).

² See, e.g., *Murray Hill Publ'ns, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, 60 U.S.P.Q.2d (BNA) 1080 (6th Cir. 2001); *Lipscher v. LRP Publ'ns, Inc.*, 266 F.3d 1305, 60 U.S.P.Q.2d (BNA) 1468 (11th Cir. 2001); *Batiste v. Island Records, Inc.*, 179 F.3d 217, 51 U.S.P.Q.2d (BNA) 1107 (5th Cir. 1999); *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556, 32 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1078 (1995); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 224 U.S.P.Q. (BNA) 185 (4th Cir. 1984); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 128 U.S.P.Q. (BNA) 411 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961); *CBS Inc. v. Liederman*, 866 F. Supp. 763, 33 U.S.P.Q.2d (BNA) 1333 (S.D.N.Y. 1994), *aff'd per curiam*, 44 F.3d 174 (2d Cir. 1995); *Blockbuster Entm't Group v. Laylco, Inc.*, 869 F. Supp. 505, 33 U.S.P.Q.2d (BNA) 1581 (E.D. Mich. 1994); *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198, 8 U.S.P.Q.2d (BNA) 1633 (D. Md. 1988).

Each circuit has developed its own unique test, usually consisting of a list of factors to be considered, for finding a likelihood of confusion. See 4 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION §§ 24:30-24:43 (4th ed. 1996) (providing the factors and the cases from which the factors are taken). See also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 (1995) (identifying the standard of infringement as a “designation that causes a likelihood of confusion”).

imposes liability for false designations of origin, false or misleading descriptions, or representations of fact that are “likely to cause confusion, mistake, or to deceive” as to the source of the product. Protection under the Lanham Act is perpetual. Meanwhile, the Constitution’s Intellectual Property Clause grants copyrighted materials protection only for a limited term.³ The question then is whether the perpetual protection granted under section 43(a) of the Lanham Act can be used on an otherwise copyrightable work to avoid copyright’s limited term.

To achieve Lanham Act protection, producers of potentially copyrightable works may stretch the identifying features of a work such that they (allegedly) become distinctive and serviceable as trademarks. For example, most readers familiar with the style of J.D. Salinger can tell by the end of the first sentence of a work if Salinger is the text’s author. Under copyright law, however, another writer could adopt Salinger’s style without misappropriating his stories or characters. That is, an author could adopt Salinger’s style without infringing Salinger’s copyright in *The Catcher in the Rye* or *Raise High the Roof Beams, Carpenters*. Could Salinger (or, more likely, his heirs) claim a trademark in his style and impose liability on anyone mimicking it for creating confusion or deceiving as to the origin of the story, even after Salinger’s copyrights have expired and his books have entered the public domain? Could Salinger prevent someone else from editing a condensed or abridged version of his public domain work under his or her own name? I argue that this should not be the case and that the Supreme Court got it right in *Dastar Corp. v. Twentieth Century Fox Film Corp.*,⁴ when it held as much.

II. FACTUAL BACKGROUND

In *Dastar Corp.*, Twentieth Century Fox (“Fox”) retained Time, Inc. to produce *Crusade in Europe*, a World War II television series based on a book by General Dwight D. Eisenhower.⁵ Time assigned the copyright in the series to Fox, and Fox failed to renew it.⁶ Thus, the *Crusade in Europe* series entered the public domain.⁷ Dastar Corp. obtained a copy of the series, copied and edited it into a shorter version, and called it *Campaigns in Europe*.⁸ The Dastar version also had new footage, a new title sequence, and chapter heading sequences.⁹ Dastar’s

³ U.S. CONST. art. I, § 8, cl. 8.

⁴ 123 S. Ct. 2041, 66 U.S.P.Q.2d (BNA) 1641 (2003).

⁵ *Id.* at 2044.

⁶ *Id.*

⁷ *Id.*

⁸ *Id.*

⁹ *Dastar Corp.*, 123 S. Ct. at 2044.

Campaigns video did not credit Fox or any of the other parties in the case; Dastar credited only those Dastar employees who produced the series.¹⁰

Fox sued Dastar under section 43(a) of the Lanham Act, claiming that Dastar's failure to credit those involved in the New Line videos was a "false designation of origin."¹¹ The Ninth Circuit found Dastar liable for reverse passing off under section 43(a) of the Lanham Act because Dastar committed a "bodily appropriation" of Fox's series and "marketed it without attribution to Fox."¹² The Ninth Circuit rejected Dastar's claim that an independent showing of likelihood of confusion is required for liability under section 43(a) because the "bodily appropriation test subsumes the less demanding consumer confusion standard."¹³

The Ninth Circuit's ruling presented the Supreme Court with the opportunity to resolve the circuit split as to the proper test for finding trademark infringement and to resolve an important issue it previously had reserved: whether the Lanham Act can be used as an end-run around the Intellectual Property Clause of the Constitution to grant authors or creators of works in the public domain perpetual, copyright-like protection.¹⁴

¹⁰ *Id.*

¹¹ *Id.* at 2045 n.2. The claim of copyright infringement for General Eisenhower's book was not at issue before the Supreme Court. Also, although the Court heard arguments about the punitive damages award against Dastar, it did not address them in its decision. Likewise, this Comment addresses only the issue of whether section 43(a) of the Lanham Act can be used to extend protection over works within the public domain.

¹² *Twentieth Century Fox Film Corp. v. Ent. Distrib.*, 34 Fed. Appx. 312, 314 (9th Cir. 2002), *cert. granted*, 537 U.S. 1099 (Jan. 10, 2003).

¹³ *Id.* (internal quotations and citations omitted).

¹⁴ *See Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 35, 58 U.S.P.Q.2d (BNA) 1001 (2001). In *Traffix*, the Court stated, "Traffix and some of its [amici] argue that the Patent Clause of the Constitution, Art. I, § 8, cl. 8, of its own force, prohibits the holder of an expired utility patent from claiming trade dress protection We need not resolve this question." *Id.* Of course, the "Patent Clause" and the Intellectual Property Clause are the same thing. Once protection under that clause has expired, the work—be it something that was patented or copyrighted—enters the public domain. The question, then, is whether that public domain work is entitled to Lanham Act protection at all. That is, can the creator of the public domain work use the Lanham Act to obtain protection after its constitutionally protected term has expired? Does the Lanham Act permit the creator to get protection beyond constitutional limits?

III. DISCUSSION

A. LIKELIHOOD OF CONFUSION VERSUS BODILY APPROPRIATION AS APPROACHES TO TRADEMARK INFRINGEMENT UNDER THE LANHAM ACT

1. *Likelihood of Confusion.* The purpose of trademark law is to identify goods, to prevent fraud and deception in the marketplace, and to protect consumers.¹⁵ The traditional approach to trademark infringement is likelihood of confusion,¹⁶ and that test has been incorporated into section 43(a) of the Lanham Act, under which Fox sued Dastar.¹⁷ At issue in *Dastar Corp.* is a case of “reverse passing off”—a situation where an individual sells an item as his own after removing the actual manufacturer’s name or mark. Regardless of the method of the alleged trademark infringement, however, the test under section 43(a) should be the same. Dastar’s petition for writ of certiorari argued that likelihood of confusion is nothing more than adherence to the language of the statute, which “prohibits false designations of origin only if they are ‘likely to cause confusion, or to cause mistake, or to deceive as to . . . the origin’ of the goods.”¹⁸ Therefore, Dastar argued, the proper analysis for courts to adopt in trademark infringement cases—including cases of reverse passing off—is the traditional set of non-exclusive factors.¹⁹

2. *The Ninth Circuit’s Bodily Appropriation Test.* In holding Dastar liable for reverse passing off under section 43(a) of the Lanham Act, the Ninth Circuit followed the bodily appropriation test as set out in *Smith v. Montoro*.²⁰ In *Montoro*, the Ninth Circuit held that reverse passing off violates the Lanham Act because the “ultimate purchaser (or viewer) is also deprived of knowing the true source of the product and may even be deceived into believing that it comes from a different source.”²¹ The Ninth Circuit reasoned in its *Dastar Corp.* opinion that “Dastar’s ‘bodily appropriation’ of Fox’s original series is sufficient to establish

¹⁵ Lanham Act § 45, 15 U.S.C. § 1127 (2000).

¹⁶ See *supra* note 2 (providing a list of cases deciding the issue of trademark infringement based on a likelihood of confusion standard).

¹⁷ Originally, section 32(1) specifically included likelihood of confusion in its language, and section 43(a) did not. However, courts read the requirement of likelihood of confusion into section 43(a), and in 1989, Congress incorporated the courts’ readings and expressly included the likelihood of confusion test. See Lanham Act § 43(a)(1)(A), 15 U.S.C. § 1125(a)(1)(A) (2000).

¹⁸ Appellant’s Petition for a Writ of Certiorari at 11, *Dastar Corp. v. Twentieth Century Fox Film*, 539 U.S. 23 (2003) (No. 02-428) (quoting Lanham Act § 43(a)), available at 2002 WL 32101095 [hereinafter *Dastar’s Writ of Certiorari*].

¹⁹ *Id.* at 11-12. See also 4 MCCARTHY, *supra* note 2 (providing a list of circuits and the factors adopted).

²⁰ 648 F.2d 602, 211 U.S.P.Q. (BNA) 775 (9th Cir. 1981).

²¹ *Id.* at 607.

reverse passing off, because the 'bodily appropriation' test subsumes the 'less demanding consumer confusion standard.'²² In *Cleary v. News Corp.*,²³ the Ninth Circuit explained that the bodily appropriation test "recognizes that slight modifications of a product might cause customer confusion."²⁴ In opposing Dastar's petition for writ of certiorari, Fox argued that the "multi-factor analysis may show no likelihood of confusion even where there [has] been a bodily appropriation of the underlying work"²⁵ and that the bodily appropriation test conflicts with other circuits²⁶ is illusory.²⁷ Fox further argued that bodily appropriation is "merely a tool to see if confusion is likely."²⁸ Beyond that, however, Fox's argument that the bodily appropriation test does not replace the likelihood of confusion analysis relied on the red herrings of misappropriation and that the *Dastar Corp.* opinion was unpublished and *per curiam*,²⁹ without fully elaborating on the lack of real difference between the two tests.³⁰

²² *Twentieth Century Fox Film Corp. v. Ent. Distrib.*, 34 Fed. Appx. 312, 314 (9th Cir. 2002) (citing *Cleary v. News Corp.*, 30 F.3d 1255, 1261-62, 31 U.S.P.Q.2d (BNA) 1760, 1765 (9th Cir. 1994)), *cert granted*, 537 U.S. 1099 (Jan. 10, 2003).

²³ 30 F.3d 1255, 31 U.S.P.Q.2d (BNA) 1760 (9th Cir. 1994).

²⁴ *Id.* at 1261.

²⁵ *Dastar's Writ of Certiorari*, *supra* note 18, at 12.

²⁶ *Id.* at 9-13.

²⁷ Respondent's Brief in Opposition at 14, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 537 U.S. 1099 (2003) (No. 02-428), *available at* 2002 WL 32101095 [hereinafter *Fox Brief in Opposition*].

²⁸ *Id.* at 17.

²⁹ *Id.* at 16-17. Fox states that Dastar

derives its implausible reading of Ninth Circuit law from the court's failure in its unpublished *per curiam* opinion to recite and apply all the factors traditionally considered in the likelihood of confusion analysis. In light of the evidence and arguments presented by the parties and the district court's conclusions, that omission is unsurprising. The finding of likely confusion rested on undisputed evidence that petitioner made a substantially identical copy of the Series and identified persons other than respondents as the creators of its product. This finding received further support from the willfulness of petitioner's appropriation and the evidence of shared consumers. . . . With such a strong record of likely confusion, and petitioner's failure to point to any facts contradicting that conclusion, it would be a mistake to read the Ninth Circuit's brief, unpublished opinion as creating a new rule that "bodily appropriation," without more, can establish likely confusion.

Id. One interesting question that arises under any approach that includes willfulness in its analysis is whether that inquiry is even necessary under the likelihood of confusion standard. The intent of the allegedly infringing party is irrelevant to the likelihood of consumer confusion. Therefore, if likelihood of confusion is indeed the correct approach, misappropriation should not be a consideration at all. *See infra* Part III.A.3 and accompanying text.

³⁰ *See Fox Brief in Opposition*, *supra* note 27, at 16-17.

Dastar's reply brief picked up on the weakness of Fox's argument and noted how Fox relied on the opposite argument—that the Ninth Circuit does *not* require a showing of likelihood of confusion—when arguing before the Ninth Circuit.³¹ Indeed, Fox stated that “*this* Circuit does not require an independent showing of confusion to establish reverse passing off. . . . Confusion is assumed when there is bodily appropriation.”³² Dastar went on to state that the question is not whether the Lanham Act requires consumer confusion but whether copying serves as a proxy for confusion.³³

3. *The Difference Between the Two and Why Likelihood of Confusion is the Proper Inquiry.* Dastar was correct to distinguish the Ninth Circuit's bodily appropriation test from the traditional likelihood of confusion analysis. Although the lines have blurred as of late, trademark and unfair competition are, historically, a separate type of protection from copyright. Therefore, authors of previously copyrighted works in the public domain have, historically, been prevented from using trademark to obtain perpetual protection.³⁴ One particularly powerful example is *Merriam v. Holloway Publishing Co.*,³⁵ where the court affirmed the right of any publisher “to reprint and sell any editions of ‘Webster’s Dictionary’ which were in the public domain, so long as in doing so they did not falsely suggest that the reprints were more recent editions which were still under copyright.”³⁶ In that case, Merriam’s assertion of trademark in the name or content of “Webster’s Dictionary” was rejected. Justice Miller said,

[I]t occurs to me that this proceeding is an attempt to establish the doctrine that a party who has had the copyright of a book until it has expired, may continue that monopoly indefinitely, under the pretense that it is protected by a trade-mark, or something of that sort. . . . When a man takes out a copyright, for any of his writings or works, he impliedly agrees that, at the expiration of that copyright, such writings or works shall go to the public and become

³¹ Dastar Reply Brief at 6, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 537 U.S. 1099 (2003) (No. 02-428), available at 2002 WL 32101103 [hereinafter Dastar Reply Brief].

³² See *id.* (quoting Appellee’s Answering Brief at 50, *Twentieth Century Fox Film Corp. v. Ent. Distrib.*, 34 Fed. Appx. 312 (9th Cir. 2002) (No. 00-56703) (emphasis in original)).

³³ *Id.* at 7.

³⁴ See, e.g., *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 39 U.S.P.Q. (BNA) 296 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896); *Black v. Ehrich*, 44 F. 793 (C.C.S.D.N.Y. 1891); *Clemens v. Belford, Clark & Co.*, 14 F. 728 (C.C.N.D. Ill. 1883).

³⁵ 43 F. 450 (C.C.E.D. Mo. 1890).

³⁶ Brief of Amici Curiae Intellectual Property Law Professor in Support of Petitioner at 5, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 537 U.S. 1099 (2003) (No. 02-428), available at 2003 WL 367727 [hereinafter Amicus Brief of Professor Ochoa].

public property. . . . The copyright law gives an author or proprietor a monopoly of the sale of his writings for a definite period, but the grant of a monopoly implies that, after the monopoly has expired, the public shall be entitled ever afterwards to the unrestricted use of the book.³⁷

In other words, once a work has entered the public domain, it is the property of no one specifically and everyone generally, and it may be used in any way. Alleged trademark infringement is a pretense to obtain what copyright specifically refuses to grant.

The Ninth Circuit's *Dastar Corp.* analysis relied on misappropriation without adequately distinguishing it from confusion.³⁸ Instead, the court allowed Dastar's alleged misappropriation of *Crusade in Europe* to cloud the issue. A quick look at misappropriation's history is helpful. Misappropriation got its start in the famous case of *International News Service v. Associated Press*.³⁹ In *INS*, Justice Pitney framed the harm as "taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, and which is salable by complainant for money, and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown . . ."⁴⁰

Reaping where one has not sown is the crux of why misappropriation is not the same as likelihood of confusion. Reaping where one has not sown focuses on the appropriator's action and moral culpability. A second-comer's opportunistic gain from another's effort is, indeed, irksome. But it is not confusing. Confusion disregards the alleged infringer's intent and focuses on the consumer's ability to know whose product she is purchasing. The allegedly infringing party could have every intention of creating a mark similar to that of the party bringing the action—the "infringing" party could even have the intent to confuse, mislead, and deceive the consuming public. If the public is not confused or likely to be confused though, there is no trademark infringement.

Given that confusion and misappropriation are distinct inquiries, why not use trademark law to protect against misappropriation? That is, why not require attribution under trademark law? After all, attribution is a useful way of identifying origins and antecedents in the marketplace, and the public is served by

³⁷ *Merriam*, 43 F. at 451.

³⁸ Amicus Brief of Professor Ochoa, *supra* note 36, at 12 (noting that under the Ninth Circuit's bodily appropriation test, "a Lanham Act case, which is supposed to focus on consumer confusion, instead becomes a case about whether copying has occurred, and the amount of copying that has occurred").

³⁹ 248 U.S. 215 (1918).

⁴⁰ *Id.* at 239.

knowing the history of certain ideas or original works.⁴¹ As readers, we are accustomed to having certain factual claims substantiated with citations. If someone makes a claim with which we are unfamiliar with or likely to disagree, we want to know from where the information came.

The article "*The Public Domain: Two Relationships to a Cultural Public Domain*,"⁴² by the experimental art and music group (and advocate for a larger public domain) Negativland provides an example. The article makes a number of interesting claims and supports them with apparent facts. Because there are only two footnotes in the twenty-three page article though, a skeptical reader is left with unanswered questions. For example, when Negativland says that "Disneyland claims copyright on any photos taken inside its imagineered landscapes,"⁴³ one response is, "Can that be true?" As readers of Negativland's article, we have to take Negativland at its word. A footnote attributing the source of that information would be useful for at least two reasons. First, a hostile reader may be won over by good citations or at least be convinced that Negativland is not making things up—that it is using reliable sources. Second, the reader may want to use the Negativland article as a repository of research for a further inquiry, but our hypothetical reader has no clues of where else he might go if he wants to read more. Thus, too few attributions can be a disservice. In the sense that attribution is useful to readers, I am an advocate of it. Nonetheless, I would argue that this attribution, if it involves public domain works, should be a voluntary courtesy on the part of the work's producer.

The problem with taking the misappropriation doctrine too seriously, however, is its ability to take something not protectable as property—something in the public domain—and give it property-like protection through the Lanham Act. The problem lies not with the principle of granting attribution but with the inability of divining where one must stop in order to avoid liability.⁴⁴ In *Smith v. Montoro*,⁴⁵ a movie distributor was held liable for making a false designation of

⁴¹ There may also be a moral right to attribution. See generally David L. Lange, *The Intellectual Property Clause in Contemporary Trademark Law: An Appreciation of Two Recent Essays and Some Thoughts About Why We Ought to Care*, 59 LAW & CONTEMP. PROBS. 213, 221 (1996). But one should not take that to mean the law should endeavor to protect that moral right. See Oliver Wendell Holmes, *The Path of the Law*, 10 HARV. L. REV. 457, 460 (1897) (stating "nothing but confusion of thought can result from assuming that the rights of man in a moral sense are equally rights in the sense of the Constitution and the law").

⁴² Negativland, *The Public Domain: Two Relationships to a Cultural Public Domain*, 66 LAW & CONTEMP. PROBS. 239, 251 (2003).

⁴³ *Id.* at 251.

⁴⁴ See David Nimmer, "*Fairest of them All*" and Other Fairy Tales of Fair Use, 66 LAW & CONTEMP. PROBS. 263, 265-66 (2003) (discussing the burden of clearing rights of all potential claimants to a copyrighted work).

⁴⁵ 648 F.2d 602, 211 U.S.P.Q. (BNA) 775 (9th Cir. 1981).

origin under section 43(a) by deleting a *single* actor's name from the film credits and putting another actor's name in its stead.⁴⁶ If a single actor is enough to impose liability, what about the screenwriter, editor, costume designer, or cameraman who also participated in the creation of the work? It simply becomes too difficult for an individual or company seeking to use public domain works to ferret out every individual who has participated in the creation of an original work. Imposing such a burden does not make sense with works that are in the public domain and ostensibly free for the taking.

The unique issue of reverse passing off in *Dastar Corp.* raised the issue not of whether Dastar misled the public by labeling its video series as its own and giving credit to Dastar employees, but by failing to give Fox attribution as the original producer.⁴⁷ Again, the implication for users of public domain works is serious. Fox argued that the mere fact that the Copyright Act's protections have expired

does not create a license to market public domain works in a manner likely to deceive consumers. . . . For example, though anyone can publish a new edition of Leo Tolstoy's *War and Peace*, or make a film or a derivative work based upon it, an aspiring novelist could not rename that book *War in Russia* and sell it under his own name.⁴⁸

This assertion potentially limits creative works of art or literature that self-consciously appropriate earlier works. For example, in the story "Pierre Menard," Borges hypothesizes, through a fictional author, that a work that recreates, word for word (not "copies"), Cervantes' *Don Quixote* would have meaning separate from the original work and would indeed be an original work in and of itself,

⁴⁶ *Id.* at 606-08.

⁴⁷ Some courts have required that a subsequent publisher disclaim any association with the original publisher of a work. *See, e.g., G. & C. Merriam Co. v. Saalfeld*, 190 F. 927 (6th Cir. 1911), *on reh'g*, 198 F. 369 (6th Cir. 1912); *Ogilve v. G. & C. Merriam Co.*, 149 F. 858 (C.C.D. Mass. 1907), *aff'd as modified*, 159 F. 638 (1st Cir. 1908), *on appeal after remand*, 170 F. 167 (1st Cir. 1909). However, more recent cases suggest that a subsequent purchaser must only label the public domain work with its own name. *See Maljack Prods., Inc. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996) (stating

When a public domain work is copied, along with its title, there is little likelihood of confusion when even the most minimal steps are taken to distinguish the publisher of the original from that of the copy. The public is receiving just what it believes it is receiving—the work with which the title has become associated. The public is not only unharmed, it is unconfused.

(quoting Leslie A. Kurtz, *Protection for Titles of Literary Works in the Public Domain*, 37 RUTGERS L. REV. 53, 77 (1984))).

⁴⁸ Fox Brief in Opposition, *supra* note 27, at 21.

despite its exact duplication. Of course, the second version *would* have meaning separate from the original *Don Quixote* since the interpretive assumptions surrounding the text are now completely altered from those surrounding the original.⁴⁹ The self-conscious reference to the original and presenting the copied work as a work unmoored from the ties of the original historical context give rise to new meanings that could never have been contemplated initially, even though the two works contain exactly the same words. Although Borges' idea has not (to my knowledge) literally taken place, other art forms such as "found art" that do bodily appropriate objects and, by placing them in a different context, give them new meaning. That art, had the Ninth Circuit's test been adopted, would not be possible.

Dastar's reply to Fox's argument was that since *War and Peace* has been in the United States public domain for over 135 years, "Tolstoy's heirs had no claim against anyone who used his work for any purpose. Now, thanks to *Montoro*, they do."⁵⁰ Had the Supreme Court allowed the *Montoro* doctrine to stand, users of public domain works would be faced with liability no matter how they proceeded—either by omitting the names of the work's originators or by including the originators' names to an edited work.⁵¹ Justice Scalia saw this danger and rightly emphasized the serious practical difficulties that would arise if attribution was required for public domain works. He noted both the difficulty in figuring out to whom attribution is owed⁵² and the prospect of facing liability both for crediting the original creator and for failing to credit the original creator.⁵³ Therefore, if misappropriation is to continue as a viable trademark doctrine,⁵⁴ it should continue as a distinct way of protecting trademark proprietors' investment in their mark and no more. Misappropriation should return to its place as a separate inquiry from likelihood of confusion. It should, at most,

⁴⁹ See generally STANLEY FISH, IS THERE A TEXT IN THIS CLASS?: THE AUTHORITY OF INTERPRETIVE COMMUNITIES 303-21 (1980) (discussing of the origins of meaning surrounding the same text).

⁵⁰ Dastar Reply Brief, *supra* note 31, at 3.

⁵¹ See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 6:27, at 6-55 (4th ed. 2002); Amicus Brief of Professor Ochoa, *supra* note 36, at 12-13 (noting that both a failure to give attribution and the giving of attribution could be deemed a deception as to origin).

⁵² *Dastar Corp.*, 123 S. Ct. at 2049 (stating "we do not think the Lanham Act requires this search for the source of the Nile and all its tributaries").

⁵³ *Id.*

⁵⁴ It should be noted that the Restatement (Third) of Unfair Competition has rejected the doctrine of misappropriation. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 38, cmt. b (1995) ("The better approach, and the one most likely to achieve an appropriate balance between the competing interests [of protection and access], does not recognize a residual common law tort of misappropriation.").

allow the trademark proprietor to recoup and protect the investment made in creating and promoting the mark.⁵⁵

Beyond (or before) that recoupment, however, lies the separate inquiry of consumer confusion. In *Dastar Corp.*, the question is whether Dastar's alleged misappropriation and admitted copying of Fox's video series has prevented Fox from recouping its investment in the product.⁵⁶ My argument is that any work in the public domain should, by definition, be deemed to have recouped its investment through its limited monopoly granted by the Copyright Clause of the Constitution.⁵⁷ In the case of *Dastar Corp.* then, Fox should have no claim for recoupment of its expenses since its video series was in the public domain at the time of Dastar's appropriation of it. Since Dastar had full access to Fox's public domain video series, in what sense would Dastar's *Campaigns* videos be anything other than Dastar's product?

By focusing on the definition of "origin" under section 43(a), the Court reached essentially the same conclusion. Justice Scalia declared that for purposes of section 43(a), "the most natural understanding of the origin of goods, the source of wares, is the producer of the tangible product sold in the marketplace."⁵⁸ This understanding renders the "origin of goods . . . incapable of connoting the person or entity that originated the ideas or communications that 'goods' embody or contain."⁵⁹ This understanding re-centers the section 43(a) analysis on likelihood of consumer confusion.

⁵⁵ *Lange*, *supra* note 41, at 220-21. See generally Frank I. Schecter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

⁵⁶ One problem with such a theory is that it is difficult to define any boundaries to it. That is, as long as Fox continued to market and promote the videocassettes under its own name, it is arguably an investment in the mark and, therefore, protectable. Without the rule that public domain works have, by definition, recouped their investment, the theory is in danger of being no more contained than it is in its current state.

⁵⁷ U.S. CONST. art. I, § 8, cl. 8.

⁵⁸ *Dastar Corp.*, 123 S. Ct. at 2047. Scalia uses the 1949 Webster's New International Dictionary as the beginning of his inquiry to the meaning of section 43(a)'s language. While it makes little difference in the *Dastar* case, such reliance may be misplaced. Although the Lanham Act was adopted in 1949, the dictionary reflects only understandings and definitions of works up to 1949 and may not accurately reflect any current connotations or new associations occurring in 1949, after the 1949 dictionary was published.

Moreover, by attempting to fix the meaning as it existed in 1949 and adopting it wholesale to the present may ignore that current cultural, political, and historical circumstances and thus may validly warrant a new understanding of those same words. Scalia would likely respond that if that is the case, the legislature must make that clear, or he may say language does not change that quickly; it takes years for meanings and connotations to change, even slightly. He may be right. Nonetheless, I will leave that debate, since it is beyond the scope of this Comment, and because I largely agree with the interpretation Scalia adopted.

⁵⁹ *Id.*

This re-centering is a good thing for several reasons. First, it is consistent with the original purpose behind trademark protection, as previously discussed. Second, it produces certainty for producers of products. Anyone using public domain material is free to do so without fear of litigation. This, in turn, assures the public increased competition among publishers and producers of various editions of public domain works. For example, when one buys a Dover Thrift Edition of *The Scarlet Letter* or *Dubliners*, one knows that is what one is getting—there is no confusion as to the source. What is more, one likely does not care. What you get in a Dover Thrift Edition is a cheap version of a book in the public domain; if you want critical material, you go to a different publisher such as St. Martin's Press. Neither of these publishers is obligated to credit Hawthorne's or Joyce's original publishers; they must only identify themselves clearly as the producer of that particular edition of the work so as to avoid confusion in the marketplace—to avoid confusion over a public domain work that has been copied, word for word, bodily appropriated, if you will, from the original. This is exactly what Dastar did—it identified its video series as its own product; there was no way the public could have thought it was Fox's edition.

Third, re-centering the section 43(a) analysis on likelihood of confusion paves the way for artists and producers of creative works to incorporate prior public domain works, thereby enhancing meaning and allowing a richness and complexity of interpretation, which in turn allows how we define and reflect our own culture and understandings of it to flow legitimately from and acknowledge what has gone before.⁶⁰ Artists draw upon the work of their predecessors freely, and even bodily appropriate their predecessors' work, so as to further innovate. One cannot listen to Bob Dylan without hearing echoes of Woody Guthrie, read T.S. Eliot (or James Joyce or Nabokov) without realizing that much of the text's meaning is derived from allusion to characters and themes drawn from other works, or look at a French Impressionist painting without thinking of Monet.⁶¹ The Academy Award™ winning *Shakespeare in Love* incorporated myriad references to Shakespeare's work and adopted many of his lines word for word. Indeed, part of what makes those works worthwhile is their conscious nod to and incorporation of prior practitioners' work. Under *Montoro*, that use could have been disallowed as a false designation of origin. Had the Court adopted *Montoro*, Disney could prevent a competitor from making an animated film based on the Exodus story. The examples are far too numerous to continue listing, but it suffices to say that Justice Scalia and the rest of the Court wisely protected this

⁶⁰ See *Negativland*, *supra* note 42, at 251-57.

⁶¹ The list one could write of works that incorporate prior works is virtually endless, as all creative work necessarily depends on prior work. Even when the subsequent work does so purposefully, the end product is no less original.

interest by restricting the meaning of "origin" for purposes of section 43(a) to the actual producer of the tangible product in the marketplace. If meaning itself depends on cultural situations and what has gone before, why would we not wish to deepen the context against which we can legitimately define ourselves? That is, why turn something valuable—something that has been done throughout history—and make it illicit? To prevent misappropriation—reaping where one has not sown? Maybe. But if that is what we are seeking to prevent, then copyright (not trademark) is the proper avenue for protection.

Fourth, re-centering the trademark inquiry to the likelihood of confusion avoids conflict with copyright or patent law and allows the separate legislations to carry their own weight.

Fifth, re-centering the section 43(a) analysis on likelihood of confusion avoids putting the Lanham Act in direct conflict with the Constitution. The Ninth Circuit's protection of creative works from misappropriation under the Lanham Act did the opposite. Authors of original works that had fallen into the public domain could have extended their protection perpetually, despite the Constitution's⁶² and the Copyright Act's mandate for only a limited term.⁶³ Using the Lanham Act in this way puts users of public domain works in danger of liability, regardless of whether they mention the original creator.⁶⁴

⁶² U.S. CONST. art. I, § 8, cl. 8.

⁶³ See 17 U.S.C. § 24 (1909); see also 17 U.S.C. §§ 302-304 (2000). Moreover, section 8 of the 1909 Copyright Act specifically states that "No copyright shall subsist in . . . any work which is in the public domain." 17 U.S.C. § 8 (1909). Although apparently obvious, it seems appropriate to point out that the protections of the Copyright Act apply only to copyrighted works; public domain works receive no copyright protection.

⁶⁴ Professor Tyler T. Ochoa's amicus brief makes this point especially well. He states that using section 43(a) to prevent parties from publishing public domain works under their own name places them in a

'heads I win, tails you lose' situation. If Dastar had chosen to publish a revised version of the public domain work under its original title, giving credit to Fox, SFM and New Line, those entities could have sued, claiming deception as to origin, sponsorship or approval of the revised version under Section 43(a) of the Lanham Act. Instead, Dastar truthfully published the revised version under its own name, as producer of the actual videotapes in question; and Fox, SFM and New Line have sued Dastar for *failing* to credit them as former distributors of the underlying public domain work. If such a cause of action is upheld, those who seek to publish public domain material will be placed in an untenable position. They risk liability if they use the name of the former owner of an expired copyright without permission, and they risk liability if they fail to use the name of the former owner of the expired copyright at all. Such an interpretation of the Lanham Act would essentially guarantee that publishers of public domain material would face a lawsuit and would deter such publishers from copying works in the public domain.

Amicus Brief of Professor Ochoa, *supra* note 36, at 12-13 (citation omitted); see also Dastar Reply

The Copyright Act, under the Intellectual Property Clause of the Constitution, has done the balancing between the individual and public good with regard to creative works and concluded that the goals are best achieved through monopolies granted for limited times only. Thus, Fox was allowed to exploit its monopoly while its video series was protected under copyright and no longer. To allow Fox or any other originator of a public domain work to use the Lanham Act to make an end-run around that constitutional determination and allow perpetual protection for works in the public domain is beyond the power of the Lanham Act and the Intellectual Property Clause.

Finally, allowing the Lanham Act to grant quasi-copyright protection perpetually has First Amendment implications.⁶⁵ The proprietors of a public domain work could prevent any use of that work in ways the proprietor found not to his liking. If we take seriously the premise that artists use what has gone before, and in fact depend on it for their own original creations, then allowing the Lanham Act to exclude some works perpetually from the public domain is akin to removing certain words from the language.

B. CONCLUSION: THE LANHAM ACT CANNOT BE USED TO EXTEND PERPETUALLY COPYRIGHT PROTECTION TO WORKS IN THE PUBLIC DOMAIN

My quarrel is not with the protection of original works of authorship; rather, it is the extension of that protection beyond what is constitutionally permissible under the Intellectual Property Clause. Trademark law cannot and should not be an end-run around copyright protection. Trademark protects consumers; to allow originators of public domain works to use trademark law as a way of continuing their monopoly over a work robs the public domain (and thereby robs artists of valuable source material) and inhibits competition. Congress and the Constitution have already balanced the competing interests of creators and the public in original works via the Copyright Act. Trademark law under the Lanham Act should return to its roots of protecting consumers and makers of competing goods from confusion in the marketplace and not be bootstrapped into doing copyright's work. Copyright has its own strength, and is not the world in need of support from an ersatz Atlas disguising himself as the Lanham Act?

Brief, *supra* note 31, at 11 (arguing that both inclusion and omission could lead to liability under Fox's reading of the Lanham Act).

⁶⁵ See William Van Alstyne, *Reconciling What the First Amendment Forbids With What the Copyright Clause Permits: A Summary Explanation and Review*, 66 LAW & CONTEMP. PROBS. 225 (2003) (discussing First Amendment limits to Copyright Clause Power).