



## Kentucky Law Journal

Volume 93 | Issue 3

Article 7

2005

# The Supreme Court's Mixed Messages on the Public Domain: Cases Interpreting Section 43 of the Lanham Act

William Scott Hunt  
*University of Kentucky*

Follow this and additional works at: <https://uknowledge.uky.edu/klj>

 Part of the [Intellectual Property Law Commons](#)

**Click here to let us know how access to this document benefits you.**

### Recommended Citation

Hunt, William Scott (2005) "The Supreme Court's Mixed Messages on the Public Domain: Cases Interpreting Section 43 of the Lanham Act," *Kentucky Law Journal*: Vol. 93 : Iss. 3 , Article 7.  
Available at: <https://uknowledge.uky.edu/klj/vol93/iss3/7>

This Note is brought to you for free and open access by the Law Journals at UKnowledge. It has been accepted for inclusion in Kentucky Law Journal by an authorized editor of UKnowledge. For more information, please contact [UKnowledge@lsv.uky.edu](mailto:UKnowledge@lsv.uky.edu).

# The Supreme Court's Mixed Messages on the Public Domain: Cases Interpreting Section 43 of the Lanham Act

BY WILLIAM SCOTT HUNT\*

## INTRODUCTION

In his trademark and unfair competition treatise, Professor J. Thomas McCarthy confidently states that “‘public domain’ is the status of an invention, creative work, commercial symbol, or any other creation that is not protected by any form of intellectual property. Public domain is the rule; intellectual property is the exception.”<sup>1</sup> While still true on one level, today many scholars contend that rights in intellectual property have expanded to the point of endangering the continuing vitality of the public domain.<sup>2</sup> For these scholars, “the public domain and copyright are inversely correlated: If one grows, the other must shrink. Intellectual property must therefore be restricted if the public domain is to be large and robust.”<sup>3</sup>

Of course, there are opposing opinions. Professor R. Polk Wagner argues that it is possible to increase control over intellectual property and for the public domain to flourish even more greatly than without such

---

\* J.D. expected 2005, University of Kentucky; B.S. 2001, Centre College. I would like to thank Professor Harold Weinberg for his assistance in selecting this topic and in editing portions of this note. I would also like to thank my wife, family, and friends for their support and immense patience during my law school career.

<sup>1</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 1:2 (4th ed. 2003).

<sup>2</sup> See, e.g., James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 SPG LAW & CONTEMP. PROBS. 33 (2003) (comparing the contemporary expansion of intellectual property with the English enclosure movement, concluding that both have few, if any, positive effects); Rosemary J. Coombe, *Fear, Hope, and Longing for the Future of Authorship and a Revitalized Public Domain in Global Regimes of Intellectual Property*, 52 DEPAUL L. REV. 1171, 1173 (2003) (recognizing that “[l]egal protections for intellectual property [may be] expanding to the detriment of new creators”); see also Paul M. Schwartz & William Michael Treanor, Eldred and Lochner: *Copyright Term Extension and Intellectual Property as Constitutional Property*, 112 YALE L.J. 2331, 2337–38 (2003) (discussing scholars who believe intellectual property rights require close scrutiny in the context of copyright term extension).

<sup>3</sup> Schwartz & Treanor, *supra* note 2, at 2337.

controls.<sup>4</sup> Wagner theorizes that the real impact of many intellectual property proposals on the public domain depends not on the direct effect upon the public domain, but on the effect upon incentives generally.<sup>5</sup> At first blush, a policy that restricts the public domain could, the argument goes, create incentives that ultimately encourage a more expansive public domain.<sup>6</sup>

Both lines of thought primarily emphasize the perceived (and arguably real)<sup>7</sup> increases in authorial intellectual property rights.<sup>8</sup> The many developments in digital technology over the last fifteen years and the fallout from the Supreme Court's decision in *Eldred v. Ashcroft*<sup>9</sup> focus attention in this direction. However, because emphasis is placed on the expansion of these rights and its effect on the public domain, little is said about concurrent efforts to protect the public domain.

This note argues that, despite the expansion of intellectual property rights, the Court is actively protecting the public domain in defined ways. This general argument is made in the context of the Court's approach to recent cases interpreting § 43 of the Lanham Act; a section that is particularly vulnerable to use as a means to extend the scope or period of intellectual property protections.<sup>10</sup> Careful analysis of these cases illustrates the Court's concern for the continuation of a vibrant public domain despite notable expansions to the scope and time period for certain protections. The recent Supreme Court decisions discussed in this note reinforce the idea that, "[i]n general, unless an intellectual property right . . . protects an item, it will be subject to copying."<sup>11</sup> Some of these decisions make it harder to assert intellectual property rights,<sup>12</sup>

---

<sup>4</sup> See R. Polk Wagner, *Information Wants to be Free: Intellectual Property and the Mythologies of Control*, 103 COLUM. L. REV. 995, 997 (2003).

<sup>5</sup> See *id.* at 1023.

<sup>6</sup> *Id.*

<sup>7</sup> See, e.g., Boyle, *supra* note 2, at 38. Boyle provides specific examples of increased intellectual property protection, commenting that "[t]he expansion of intellectual property rights has been remarkable—from business method patents, to the Digital Millennium Copyright Act, to trademark antidilution rulings, to the European Database Protection Directive. The old limits to intellectual property rights—the anti-erosion walls around the public domain—are also under attack." *Id.* (footnotes omitted).

<sup>8</sup> See *supra* notes 2–4 and accompanying text.

<sup>9</sup> *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (extending the term of existing and new copyrights by twenty years, thus creating extensive public and scholarly debate about Congress' power to take this action and its effect on the public domain).

<sup>10</sup> Lanham Act, 15 U.S.C. § 1125 (2004). For a discussion of the unique causes of action provided under § 43 and the reasons this section is particularly vulnerable to abuse for the improper extension of intellectual property rights, see *infra* Part III.A.

<sup>11</sup> MCCARTHY, *supra* note 1, at § 1:2.

<sup>12</sup> See e.g., *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) (holding that the Federal Trademark Dilution Act requires proof of actual dilution); *Wal-Mart Stores*,

while others strengthen the lines between the bodies of intellectual property law to prevent overlapping protection that will impermissibly extend the time it takes the subject matter to enter the public domain.<sup>13</sup> These cases do not refute that intellectual property rights have expanded, but rather demonstrate that, concurrent with this expansion, the Court remains conscious of the need to protect the public domain.

Part I of this note addresses the basic tradeoffs inherent in intellectual property law and the policy objectives of each area of that law.<sup>14</sup> Copyright, trademark, and patent law each involve unique considerations regarding public domain policy because of the core differences between them. This section also gives a basic overview of what concerns drive each part of intellectual property law and begins to relate those concerns to important policy questions about the public domain. Part II defines the scope of the public domain and addresses the changing views of its importance over time.<sup>15</sup> Part III then discusses a number of cases construing the Lanham Act that may be read as attempts by the Supreme Court to strengthen the public domain, making it more difficult to claim intellectual property protections.<sup>16</sup> These cases stand in contrast to highly publicized expansions of authorial or property rights in intellectual property. Particular attention is given to *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>17</sup> and to the Court's refusal to allow indefinite protection to previously copyrighted or patented materials via the Lanham Act. Finally, Part IV discusses the repercussions of these decisions by analyzing their effect on the future of the public domain.<sup>18</sup>

## I. BASIC FEDERAL INTELLECTUAL PROPERTY TRADEOFFS AND POLICY

### A. *Tension between Ownership Rights in Intellectual Property and Public Access*

Within patent, copyright, and trademark law, there exists a tension between the exclusive rights granted to the owner of the intellectual

---

Inc. v. Samara Bros., 529 U.S. 205 (2000) (holding that a claim of trade dress infringement under the Lanham Act requires a showing of secondary meaning).

<sup>13</sup> See, e.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (holding that § 43(a) of the Lanham Act does not prevent unaccredited copying of uncopyrighted work); *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001) (allowing expired utility patent to serve as strong evidence of functionality in trade dress infringement suit).

<sup>14</sup> See *infra* notes 19–44 and accompanying text.

<sup>15</sup> See *infra* notes 45–64 and accompanying text.

<sup>16</sup> See *infra* notes 65–180 and accompanying text.

<sup>17</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

<sup>18</sup> See *infra* notes 181–200 and accompanying text.

property and the degree to and manner in which the property will be available to the public.<sup>19</sup> Generally, this tension defines public domain material free for public use and the important intellectual property rights that attach, which allow the holder of the right to control, to varying degrees, the activities of others in relation to the material.<sup>20</sup> Due to the different purposes and the specific nature of each body of intellectual property law, the considerations factoring into this tension are not uniform among them.<sup>21</sup>

### 1. *Patent Law*

The basis for both patent and copyright law is constitutional. The Intellectual Property Clause of the United States Constitution allows Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . .”<sup>22</sup> The language of this grant of power means that both patents and copyrights must be limited in the length of time they are effective.

The primary tension in patent law exists between rewarding and protecting the patent grantee while avoiding limitations on potential future advancements that may arise because of these exclusive rights.<sup>23</sup> Patent law operates on the “assumption that a period of exclusivity is needed to induce the optimum level of innovation.”<sup>24</sup> This tension has been apparent since the birth of Constitution: “the drafters . . . understood that patent law seeks to strike a balance between the promotion of technological creativity and the dissemination of its fruits.”<sup>25</sup>

As a result, patents granted today are limited to twenty-year terms.<sup>26</sup> During this period, inventors possess the exclusive right, among other rights, to prevent anyone from making, using, offering to sell, or selling the patented invention without authority.<sup>27</sup> Thus, a balance in patent law

---

<sup>19</sup> See ROCHELLE COOPER DREYFUSS & ROBERTA ROSENTHAL KWALL, *INTELLECTUAL PROPERTY* 1–2 (1996).

<sup>20</sup> See *id.* at 3.

<sup>21</sup> See *id.* at 1–3.

<sup>22</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>23</sup> See DREYFUSS & KWALL, *supra* note 19, at 553.

<sup>24</sup> *Id.*

<sup>25</sup> SHELDON W. HALPERN ET AL., *FUNDAMENTALS OF UNITED STATES INTELLECTUAL PROPERTY LAW: COPYRIGHT, PATENT, AND TRADEMARK* 181 (1999).

<sup>26</sup> DREYFUSS & KWALL, *supra* note 19, at 552 (“For most patents filed on January 1, 1995 or later, the term of protection is 20 years from the date the patent application was filed.”).

<sup>27</sup> See Patent Act, 35 U.S.C. § 271(a) (2004).

allowing for public access is sought via a number of factors: 1) the limited term; 2) the stringent requirements to receive a patent; and 3) a mandate that patents be included on a public registry to “describe to the world the metes and bounds of the registered invention.”<sup>28</sup>

## 2. Copyright Law

The authority for the copyright system also rests in the Intellectual Property Clause of the Constitution.<sup>29</sup> Not surprisingly, the basic goals of copyright, rewarding the author and ensuring public access, are very similar to those of patent. Both “attempt to balance the private benefits of exclusivity against these social costs” of keeping new ideas from society and allowing the potential for monopoly prices.<sup>30</sup> Thus, copyright primarily seeks to secure public access while also encouraging creativity by providing some rewards to individuals “by securing for limited Times to Authors . . . the exclusive Right to their respective Writings.”<sup>31</sup>

Copyright protection may generally be viewed as weaker than patent protection. A copyright carries with it the exclusive rights listed in § 106 of the 1976 Copyright Act,<sup>32</sup> which “are subject to the highly specific limitations and exemptions set out in Sections 108 through 121.”<sup>33</sup> These exclusive rights and accompanying exceptions create a system that does

---

<sup>28</sup> DREYFUSS & KWALL, *supra* note 19, at 554. Dreyfuss and Kwall note that the patent registry system solves the problem of “Arrow’s disclosure paradox.” Arrow’s disclosure paradox deals essentially with the problem faced by an inventor who has an idea that may be expensive to build, thus requiring outside financing, but is reluctant to disclose the idea for fear the idea will be appropriated. Patent law assuages this fear and encourages disclosure and invention. *See id.*

<sup>29</sup> *See* U.S. CONST. art. I, § 8, cl. 8.

<sup>30</sup> DREYFUSS & KWALL, *supra* note 19, at 553.

<sup>31</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>32</sup> 17 U.S.C. § 106 (2004) grants the owner of a copyright “the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

*Id.*

<sup>33</sup> HALPERN ET AL., *supra* note 25, at 66–67.

not allow the copyright holder to exert as much control over the subject material as a patent holder. The term of a copyright depends on its method of creation, but it is longer than the term of a patent—typically a certain number of years after publication, creation, or death of the author.<sup>34</sup> It is through the Fair Use Doctrine<sup>35</sup> and the exemptions in sections 108–121 of the Copyright Act<sup>36</sup> that access to copyrighted works is protected.

### 3. Trademark Law

Trademark law is fundamentally different from patent and copyright. Trademark does not spring from an explicit constitutional grant, but rather is based on Congress' Commerce Clause powers.<sup>37</sup> As a result, "[w]hile copyrights (and patent rights) expire before falling into the public domain—regardless of use or nonuse by the owner—trademarks do not terminate so long as the user continues to use them and maintain proper registration" under the federal system.<sup>38</sup> This difference in the term of trademarks, when considered alongside the public's "right to copy, and to copy without attribution, once a copyright" or a patent expires, has important implications for the scope of the public domain.<sup>39</sup>

The primary access issue in trademarks is also different. Trademarks carry no requirement "to promote the Progress of Science and useful Arts."<sup>40</sup> As a result, the requirements to obtain a trademark do not inquire into the original or creative aspects of the work.<sup>41</sup> Instead, obtaining a trademark requires only use of the mark and that the mark serve some source identifying function.<sup>42</sup> The tradeoff thus comes from a desire to

---

<sup>34</sup> Copyright Act of 1976, 17 U.S.C. §§ 302–305 (2004) cover the various terms of copyrights. The term of all copyrights, both existing and future, was extended by twenty years by the Copyright Term Extension Act, Pub. L. No. 105-298, §102(b), 102(d), 112 Stat. 2827–2828 (amending 17 U.S.C. §§302–304), which was upheld in *Eldred v. Ashcroft*, 537 U.S. 186, 194 (2003).

<sup>35</sup> See 17 U.S.C. § 107 (2004).

<sup>36</sup> §§ 108–121.

<sup>37</sup> See HALPERN ET AL., *supra* note 25, at 275.

<sup>38</sup> Jessica Bohrer, iBrief, *Strengthening the Distinction between Copyright and Trademark: The Supreme Court Takes a Stand*, 2003 DUKE L. & TECH. REV. 23, ¶ 8 (Sept. 30, 2003), at <http://www.law.duke.edu/journals/dltr/articles/2003dltr0023.html> (footnote omitted).

<sup>39</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33 (2003). The potential importance of this difference for the public domain becomes even clearer in the discussion of the intersection of the bodies of intellectual property law in Part III, *infra* notes 65–180.

<sup>40</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>41</sup> DREYFUSS & KWALL, *supra* note 19, at 6.

<sup>42</sup> *Id.* at 10–11.

protect and encourage the trademark holder's investment in goodwill (and to lessen the likelihood of consumer confusion at the same time) while allowing sufficient marks to remain available for others to carry on similar businesses.<sup>43</sup> Public access is generally encouraged in this area through the use requirement and through geographic and temporal scope limitations.<sup>44</sup>

## II. THE PUBLIC DOMAIN: THE OPPOSITE OF INTELLECTUAL PROPERTY?

### A. *A Brief Historical Perspective of the Public Domain Concept*

Intellectual property law begins with the proposition that information belongs in the public domain and that the protections afforded by the bodies of intellectual property law are merely exceptions to this general rule.<sup>45</sup> This idea is evident in the Constitution's Intellectual Property Clause.<sup>46</sup> Patents and copyrights may be granted "for limited Times" only.<sup>47</sup> Thus, the clause's language makes it implicitly clear that the Framers ultimately intended the public domain to be enriched by the protected information.<sup>48</sup>

The public domain is not a mere byproduct of the intellectual property system in the United States; it is an integral part of that system, tracing back to the text of the Constitution: "[t]he ultimate purpose of patents and copyrights authorized by the clause is to enlarge the public domain of creative works by authors and inventors, thereby promoting 'the progress of science and useful arts.'"<sup>49</sup> For example, in the context of patents, the Court has stated that "implicit in the Patent Clause itself, [is the idea] that free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception."<sup>50</sup>

### B. *Present Day Concerns about the Vitality of the Public Domain*

Despite the clear importance of the public domain within United States intellectual property law, there is much concern that it is being

---

<sup>43</sup> *Id.* at 6–8.

<sup>44</sup> See generally *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 360 (2d Cir. 1959) (holding that the defendant could continue using a mark registered by the plaintiff because it was used in a different geographic area and different market segment).

<sup>45</sup> MCCARTHY, *supra* note 1, at § 1:2.

<sup>46</sup> U.S. Const. art. I, § 8, cl. 8.

<sup>47</sup> See *id.*

<sup>48</sup> See EDWARD C. WALTERSCHEID, *THE NATURE OF THE INTELLECTUAL PROPERTY CLAUSE: A STUDY IN HISTORICAL PERSPECTIVE* 266 (2002).

<sup>49</sup> *Id.* See also *id.* at 271 (noting that the Framers intended that protected works should enter into the public domain after a period of time).

<sup>50</sup> *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989).



forgotten and even trammelled by changes to the law. As Professor Lawrence Lessig notes concerning this increasing trend, “[s]o invisible is [the] public domain that we don’t even see it when it is everywhere around; so invisible is the idea that the free might matter to creativity, that when it is enclosed we are convinced this is progress.”<sup>51</sup>

A noteworthy example of this trend, and a lightning rod for debate during the past year, is the Supreme Court’s decision in *Eldred v. Ashcroft*,<sup>52</sup> which upheld the extension of the term of both new and existing copyrights by twenty years. Professor Lessig was counsel for the losing side in *Eldred* and is one of many scholars for whom this decision has generated concern about the robustness and continued existence of the public domain.<sup>53</sup> The decision in *Eldred* was without doubt a boost to those who desire greater authorial rights in intellectual property. It is even more noteworthy with regard to the public domain because of the Copyright Term Extension Act’s retroactive effect.<sup>54</sup> While it is true that the copyrighted works will still eventually enter the public domain, the tradeoff balancing these authorial rights and public access has been changed in the copyright holder’s favor.

With regard to changes in property or ownership rights in intellectual property, at least two opposing views are predominant. The group most concerned about developments like that seen in *Eldred* is the “IP Restrictors.”<sup>55</sup> Scholars in this camp believe in “the need to preserve a rich public domain; . . . that the Copyright Clause enshrines a quid pro quo theory . . . and that the Framers . . . opposed copyright term extension as rent-seeking.”<sup>56</sup> The IP Restrictors value the public domain as a way to reduce costs for consumers and to help creators and innovators produce more intellectual property.<sup>57</sup> These beliefs lead to the

---

<sup>51</sup> Lawrence Lessig, The Architecture of Innovation, Lecture at the Duke University School of Law Conference on the Public Domain (Nov. 9–12, 2001), in 51 DUKE L.J. 1783, 1799 (2002) [hereinafter Lessig, *Architecture of Innovation*] (referring specifically to the Walt Disney Company’s use of large amounts of public domain material which it now seeks to protect as its own and which the public largely does not question as belonging to it).

<sup>52</sup> *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

<sup>53</sup> See, e.g., Schwartz & Treanor, *supra* note 2, at 2338–39.

<sup>54</sup> *Eldred*, 537 U.S. at 193 (noting that the CTEA applied to existing as well as future copyrights).

<sup>55</sup> See Schwartz & Treanor, *supra* note 2, at 2332–33 (applying this moniker to scholars who fear encroachment on the public domain by expansion in the copyright laws).

<sup>56</sup> *Id.* at 2337. Rent-seeking is defined as “[e]conomic behavior motivated by an incentive to overproduce goods that will yield a return greater than the cost of production.” BLACK’S LAW DICTIONARY 1300 (7th ed. 1999).

<sup>57</sup> Schwartz & Treanor, *supra* note 2, at 2337–38.

common conclusion that intellectual property rights must be carefully controlled in order to ensure a healthy public domain.<sup>58</sup>

Professor R. Polk Wagner takes a position directly opposed to the IP Restrictors.<sup>59</sup> Wagner argues that the changes to United States intellectual property law (granting more control or ownership rights) do not inevitably lead to a reduction in material that enters the public domain.<sup>60</sup> Wagner particularly takes issue with the line of thought expressed by Professor James Boyle, that we are witnessing an “enclosure movement” in intellectual property via the extension of greater authorial rights.<sup>61</sup> The idea that none of the bodies of intellectual property law actually capture, or are even capable of completely capturing, the value of the thing sought to be protected leads to this conclusion.<sup>62</sup> Wagner instead advances the argument that the true measure of a policy’s effect on the public domain depends upon whether it increases or decreases incentives to create new intellectual property.<sup>63</sup> According to Wagner, the potential exists for a net increase in public domain information despite increasing rights in the intellectual property itself.<sup>64</sup>

It is widely agreed that property rights in intellectual property are expanding. As seen in this discussion, concern is expressed over the effect this increase will have on the public domain and the intellectual property system. A number of recent Supreme Court decisions limiting intellectual property rights in the trademark and trade secret arenas are central to determining the scope of the public domain.

### III. STRENGTHENING THE PUBLIC DOMAIN BY MAKING IT HARDER TO CLAIM PROTECTION

#### A. *The Changing Role of Lanham Act Section 43*

Recent Supreme Court decisions involving § 43 of the Lanham Act<sup>65</sup> have demonstrated an intention to protect the public domain and curb its use to extend authorial rights. Section 43 provides for several causes of action, some of which have been abused to extend intellectual property protection to material that belongs in the public domain.<sup>66</sup> Additionally,

---

<sup>58</sup> *Id.*

<sup>59</sup> See Wagner, *supra* note 4, at 997.

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* at 996, 1034. See generally Boyle, *supra* note 2, at 37 (referring to the expansion of intellectual property rights as “the second enclosure movement”).

<sup>62</sup> See Wagner, *supra* note 4, at 1002–03.

<sup>63</sup> *Id.* at 1023.

<sup>64</sup> *Id.* at 1023–24.

<sup>65</sup> Lanham Act, 15 U.S.C. § 1125 (2004).

<sup>66</sup> See *infra* Part III.B–C.

several circuit splits that resulted from interpretation of claims under this section have been resolved by recent Supreme Court decisions.<sup>67</sup>

Section 43(a) is particularly unique within the trademark statute because it provides a cause of action for *unregistered* marks.<sup>68</sup> Section 43(a) allows the owner of an unregistered mark to bring suit “against one who uses that mark in a manner which may cause confusion as to the origin or sponsorship of goods or services” or makes false representations about the goods or services.<sup>69</sup> Trade dress, the overall appearance, packaging, and design of an item, has found protection under this section of the Lanham Act.<sup>70</sup>

The traditional model for trademark infringement cases involves “passing off,” which occurs when the potential infringer attempts to persuade others that his goods are actually the trademark holder’s goods.<sup>71</sup> “Reverse passing off” also exists. In this situation, the potential infringer misrepresents the trademark holder’s goods as his own.<sup>72</sup> Historically, reverse passing off arose in situations where goods were stripped of their labels, relabeled, and then sold.<sup>73</sup> A more interesting, and controversial, form known as “authorial reverse passing off” has arisen under § 43. Authorial reverse passing off involves the “misleading attribution of authorship.”<sup>74</sup> Under this approach, “reverse passing off in violation of section 43(a) was found in fact patterns in which a defendant copied a work” to which copyright protection was available.<sup>75</sup> This approach could essentially extend the term of protection for a copyright holder indefinitely or provide protection for non-copyrightable subject

---

<sup>67</sup> *See id.*

<sup>68</sup> HALPERN ET AL., *supra* note 25, at 336.

<sup>69</sup> *Id.* Lanham Act § 43(a)(1)(B), codified at 15 U.S.C. § 1125(a)(1)(B), also provides a cause of action for false advertising but is not relevant to the cases discussed in this note.

<sup>70</sup> *See, e.g.,* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 775 (1992) (holding that “secondary meaning is not required to prevail on a claim under § 43(a) of the Lanham Act where the trade dress at issue is inherently distinctive”); Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 209 (2000) (explaining that trade dress “originally included only the packaging or ‘dressing,’ of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product[]”) (citations omitted).

<sup>71</sup> *See* DREYFUSS & KWALL, *supra* note 19, at 75.

<sup>72</sup> David A. Gerber, *Copyright Reigns—Supreme: Notes on Dastar Corp. v. Twentieth Century Fox Film Corp.*, 93 TRADEMARK REP. 1029 (2003).

<sup>73</sup> *See id.* at 1030 (“the pre-Act cases generally sought to redress the deceptive physical removal or obliteration of labels”).

<sup>74</sup> *Id.* Gerber notes that one of the first instances of this occurring was in *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir. 1981), “in which a film distributor substituted a fictitious name for that of a real actor in a feature motion picture.” Gerber, *supra* note 72, at 1030.

<sup>75</sup> *Id.*

matter, thus creating a potential overlap and conflict between trademark and copyright.<sup>76</sup>

Section 43(c) provides a cause of action for dilution. This cause of action was long recognized at common law, but a federal codification of the right occurred only when it was added to the Lanham Act in 1996 by the Federal Trademark Dilution Act.<sup>77</sup> “Dilution” is defined in the Lanham Act as “the lessening of the capacity of a famous mark to identify and distinguish goods or services.”<sup>78</sup> Application of this standard also resulted in a recently resolved circuit split.<sup>79</sup> The circuits were unclear whether, “Congress intended ‘actual dilution’ or ‘likelihood of dilution’” under the Lanham Act.<sup>80</sup> The Supreme Court resolved this question in favor of an “actual dilution” requirement in *Moseley v. Victoria’s Secret Catalogue, Inc.*, wherein Victoria’s Secret was required to prove actual economic harm inflicted by another business using a similar name.<sup>81</sup> Therefore, the Court strengthened its commitment to the public domain by making it more difficult to claim dilution.

## *B. Specific Requirements Making Section 43 Claims More Difficult*

### *1. Requirements Imposed to Receive Trade Dress Protection*

In its 2000 decision, *Wal-Mart Stores, Inc. v. Samara Bros.*,<sup>82</sup> the Supreme Court imposed limitations on how certain types of unregistered trade dress may be granted protection under § 43(a) of the Lanham Act. The Court noted in *Samara* that many courts of appeals had interpreted § 43(a):

to embrace not just word marks, such as “Nike,” and symbol marks, such as Nike’s “swoosh” symbol, but also “trade dress”—a category that originally included only the packaging, or “dressing,” of a product, but in recent years has been expanded by many courts of appeals to encompass the design of a product.<sup>83</sup>

---

<sup>76</sup> See *infra* Part III.C for a more in-depth discussion of this point.

<sup>77</sup> See GLEN BELVIS, 2003 INTELLECTUAL PROPERTY LAW UPDATE 256 (2003).

<sup>78</sup> Lanham Act, 15 U.S.C. § 1127 (2004).

<sup>79</sup> *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) (resolving the circuit split by requiring “actual” dilution under the Lanham Act).

<sup>80</sup> JEROME GILSON & ANNE GILSON LALONDE, *THE LANHAM ACT: TIME FOR A FACE LIFT?* 16–17 (2002). See also BELVIS, *supra* note 77, at 256–59.

<sup>81</sup> See *infra* notes 82–105 and accompanying text for a discussion of this decision.

<sup>82</sup> *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000).

<sup>83</sup> *Id.* at 209.

The Court granted certiorari to clarify the proper scope of the protection offered by § 43(a).<sup>84</sup>

In *Samara*, Samara Brothers manufactured a children's clothing line sold to J.C. Penney.<sup>85</sup> The line included one-piece seersucker outfits with appliqués of certain designs on them.<sup>86</sup> Wal-Mart requested that one of its suppliers copy the designs for Wal-Mart to sell, even providing the supplier with pictures of the outfits made by Samara Brothers.<sup>87</sup> The supplier then manufactured copies, which Wal-Mart sold.<sup>88</sup> Samara Brothers subsequently filed suit against Wal-Mart claiming trade dress infringement under § 43(a).<sup>89</sup>

The *Samara* Court found for Wal-Mart, holding that product design had been copied, that product design is only protectable on a showing of secondary meaning, and that Samara Brothers failed to establish secondary meaning.<sup>90</sup> In so holding, the Court noted that "trade dress constitutes a 'symbol' or 'device'" and that "human beings might use as a 'symbol' or 'device' almost anything at all that is capable of carrying meaning."<sup>91</sup> However, the Court found that "[i]n the case of product design, as in the case of color . . . consumer predisposition to equate the feature with the source does not exist."<sup>92</sup> As a result, the Court in *Samara* held that, for product design to be granted protection under § 43(a) of the Lanham Act, the claimant must make a showing of secondary meaning.<sup>93</sup>

Further, the *Samara* Court made clear in dictum that, where it is not altogether clear whether the subject matter being addressed is product design trade dress or product packaging, "courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning."<sup>94</sup> The Court expressed this position after

---

<sup>84</sup> *Id.* at 208.

<sup>85</sup> *Id.* at 207.

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* at 207-08.

<sup>89</sup> *Id.* at 208.

<sup>90</sup> *See id.* at 215-16.

<sup>91</sup> *Id.* at 209-10 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995), which held that color could serve as a trademark upon a showing of secondary meaning).

<sup>92</sup> *Id.* at 213.

<sup>93</sup> *Id.* at 216. Secondary meaning in this context refers to whether consumers would interpret the design features as serving source identification functions. This differs from secondary meaning in other contexts of trademark law because, unlike with word and symbol marks, no primary meaning may exist in the case of design. *See id.* at 211.

<sup>94</sup> *Id.* at 215. The Court distinguished between three types of trade dress: 1) product design, 2) product packaging, and 3) "some *tertium quid* that is akin to product packaging." *Id.* at 214-15. Along with recognizing these different types of trade dress, the Court notes that each communicates a different level of distinctiveness to the consumer, and they vary according to whether a showing of secondary meaning is required for protection. *See id.* at 214.

distinguishing *Two Pesos, Inc. v. Taco Cabana, Inc.*<sup>95</sup> *Two Pesos* extended protection under § 43(a) to the trade dress of a chain of Mexican-themed restaurants without requiring a showing of secondary meaning, on the grounds that it involved a form of trade dress other than product design.<sup>96</sup> The respondent in *Samara* feared it would be too difficult in some cases to distinguish between product design and product packaging trade dress.<sup>97</sup> In response, the Court adopted a presumption in favor of product design in close cases.<sup>98</sup> This choice broadens the scope of subject matter that requires a showing of secondary meaning to receive protection under § 43(a), thus emphasizing protection of the public domain.

The *Samara* decision curbed the expansion of protection afforded unregistered trade dress in the lower courts. By doing so, and allowing blatant copying by Wal-Mart, the Court reaffirmed that in many cases copying is permissible, and that intellectual property protection is the exception and not the rule. This decision, though in a narrow context, demonstrates the Court's commitment to strengthening the public domain. Additionally, and perhaps even more significantly for the present discussion, *Samara* reflects a change in the direction of the Court's own jurisprudence toward strengthening the public domain. The Court decided *Two Pesos* in 1992;<sup>99</sup> three years later, in *Qualitex Co. v. Jacobson Products Co.*, it held that color could function as a trademark with a showing of secondary meaning.<sup>100</sup> In light of these two earlier decisions, *Samara* indicates a slowing and refining of the Court's own willingness to expand intellectual property protections. *Samara* clarifies and retreats from the *Two Pesos* trend toward expanding rights by treating as inherently distinctive the types of trade dress that may be protected under § 43(a), and by expanding the scope of those that may require secondary meaning.<sup>101</sup>

---

<sup>95</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

<sup>96</sup> *Samara*, 529 U.S. at 215. The trade dress of the Mexican restaurants included festive decorations, paintings and murals. *See id.* The Court stated:

*Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive, but it does not establish that *product-design* trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the décor of a restaurant, seems to us not to constitute *product design*.

*Id.* (citation omitted).

<sup>97</sup> *Id.*

<sup>98</sup> *Id.*

<sup>99</sup> *See supra* notes 95–96 and accompanying text.

<sup>100</sup> *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161 (1995).

<sup>101</sup> *See Samara*, 529 U.S. at 214–15 (“drawing the line” by holding that product design trade dress requires a showing of secondary meaning). *See also Two Pesos*, 505

Similarly, *Samara* provides more protection to the public domain by refusing to go as far as *Qualitex*. Both *Samara* and *Qualitex* support the Court's stance requiring secondary meaning for characteristics that do not automatically have source-identifying functions in consumers' minds.<sup>102</sup> However, while *Qualitex* extended the right to register color with a showing of secondary meaning as a trademark under the Lanham Act,<sup>103</sup> *Samara* did not allow the same for product design with a showing of secondary meaning.<sup>104</sup> In *Samara*, the Court was only willing to allow protection through § 43(a) for product design.<sup>105</sup> This difference, though slight, also supports the idea that the Court is becoming less willing to extend property rights in intellectual property.

## 2. Requirements Imposed for Dilution Claims

Recently the Supreme Court resolved a circuit split interpreting a relatively new addition to the Lanham Act: the Federal Trademark Dilution Act of 1996.<sup>106</sup> The split concerned what must be shown to prove dilution under the federal statute. The *2003 Intellectual Property Law Update*<sup>107</sup> notes that, prior to the Supreme Court's decision in *Moseley v. Victoria's Secret Catalogue, Inc.*,<sup>108</sup> the Fourth<sup>109</sup> and Fifth<sup>110</sup> Circuits followed an "actual dilution" standard. Meanwhile, the Second,<sup>111</sup> Third,<sup>112</sup> Sixth,<sup>113</sup> and Seventh<sup>114</sup> Circuits all required a

---

U.S. at 773–74 ("expanding the scope" through recognition of trade dress as inherently distinctive and protected by § 43(a)).

<sup>102</sup> *Samara*, 529 U.S. at 215; *Qualitex Co.*, 514 U.S. at 171.

<sup>103</sup> *Qualitex Co.*, 514 U.S. at 163.

<sup>104</sup> *Samara*, 529 U.S. at 215.

<sup>105</sup> *Id.*

<sup>106</sup> Lanham Act, 15 U.S.C. § 1125(c) (2004).

<sup>107</sup> BELVIS, *supra* note 77, at 258–59.

<sup>108</sup> *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) (holding that proof of "actual" dilution is required for recovery).

<sup>109</sup> See *Ringling Bros.—Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 461 (4th Cir. 1999) (holding that proof of "actual" dilution is required).

<sup>110</sup> See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 670 (5th Cir. 2000) (adopting the Fourth Circuit requirement of "actual" dilution for Fifth Circuit cases).

<sup>111</sup> See *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 223–25 (2d Cir. 1999) (rejecting the requirement of "actual" dilution and authorizing actions based on "likelihood" of dilution).

<sup>112</sup> See *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 168–69 (3d Cir. 2000) (adopting a "likelihood" of dilution standard).

<sup>113</sup> See *V Secret Catalogue, Inc. v. Moseley*, 259 F.3d 464, 476 (6th Cir. 2001), *rev'd*, 537 U.S. 418 (2003).

<sup>114</sup> See *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 459 (7th Cir. 2000) (requiring only "likelihood" of dilution).

showing of “likelihood of dilution.”<sup>115</sup> The Court in *Moseley* sided with the Fourth and Fifth Circuits, holding that actual dilution in the consumer’s mind must be shown.<sup>116</sup>

In *Moseley*, the petitioners ran a small business called “Victor’s Little Secret,” located in a strip mall in Elizabethtown, Kentucky.<sup>117</sup> The store primarily sold lingerie and adult novelties.<sup>118</sup> To announce the store’s grand opening, the owners of Victor’s Little Secret placed an ad in a publication at a nearby Army base, Fort Knox.<sup>119</sup> An Army lawyer, Colonel John E. “Jeb” Baker, claimed to be offended by what he saw as the store’s use of another’s trademark and notified Victoria’s Secret Catalogue Company.<sup>120</sup> Victoria’s Secret requested that Victor’s Little Secret stop using the name because of potential dilution of its mark.<sup>121</sup> When Victor’s Little Secret refused to stop, Victoria’s Secret filed a complaint alleging federal dilution under § 43(c) of the Lanham Act.<sup>122</sup>

In *Moseley*, the Supreme Court examined the legislative history and approaches of the lower circuits,<sup>123</sup> but the Court based its final decision on the plain language of the statute, saying, “[t]his text unambiguously requires a showing of actual dilution, rather than a likelihood of dilution.”<sup>124</sup> Victoria’s Secret failed to make the requisite showing of actual dilution resulting from Moseley’s use of the name “Victor’s Little Secret.”<sup>125</sup> Accordingly, the Court reversed the Sixth Circuit and allowed Moseley to continue using his at least partially borrowed mark.<sup>126</sup>

By landing in the actual dilution camp, the Supreme Court made it more difficult to prove dilution in many cases under § 43(c) of the Lanham Act. The Court dismissed this concern, saying, “[w]hatever difficulties of proof may be entailed, they are not an acceptable reason for dispensing with proof of an essential element of a statutory

---

<sup>115</sup> BELVIS, *supra* note 77, at 258 (citing cases *supra* notes 109–115).

<sup>116</sup> See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432–33 (2003).

<sup>117</sup> *Id.* at 422.

<sup>118</sup> *Id.* at 424.

<sup>119</sup> *Id.* at 423.

<sup>120</sup> Bill Adair, *Victor vs. Victoria*, ST. PETERSBURG TIMES, Nov. 17, 2002, at 1A, available at [http://www.sptimes.com/2002/11/17/Worldandnation/Victor\\_vs\\_Victoria.shtml](http://www.sptimes.com/2002/11/17/Worldandnation/Victor_vs_Victoria.shtml).

<sup>121</sup> *Moseley*, 537 U.S. at 423.

<sup>122</sup> *Id.*

<sup>123</sup> *Id.* at 425–31.

<sup>124</sup> *Id.* at 433 (referring to the language of 15 U.S.C. § 1125(c)(1) (2004)).

<sup>125</sup> *Id.* at 434.

<sup>126</sup> *Id.* Victor Moseley apparently was not always certain the Court would reach this result, saying on his way into the Supreme Court before the oral argument in his case, “‘See that up there—it says ‘Equal Justice Under Law.’ They’ve got to convince me . . . I have no faith in the justice system whatsoever. I think money buys you whatever you want.’” Adair, *supra* note 120.



violation.”<sup>127</sup> This decision shows the Supreme Court again taking a position favoring public access and the public domain. A likelihood-of-dilution standard not only would have made it significantly easier to claim dilution because the level of proof would be much lower, but it also would have protected marks more strongly as a type of property since only the *likelihood* of harm would need to be shown. A standard that allowed dilution without any damage to the mark’s source-identifying function or the goodwill engendered by the owner would punish simple use of the mark itself, which does not further the true purpose of trademark law.<sup>128</sup> By requiring such a high standard of proof for parties claiming dilution, the Court effectively denies protection to the mark itself while also protecting the public’s ability to use marks by narrowing the scope of the trademark holder’s rights.

### C. *Strengthening the Lines between the Bodies of Intellectual Property Law*

Recent Supreme Court decisions have prevented § 43(a) of the Lanham Act from being used to extend the protection of expired patents indefinitely<sup>129</sup> or as a limitation on the public’s right to copy and use expired copyrights.<sup>130</sup> Such decisions guard the public domain by narrowing any potential overlap between the bodies of intellectual property law that would permit matter to be protected longer than envisioned under the tradeoffs underlying our system. As the following cases illustrate, the Supreme Court is conscious that some may try to obtain more protection than permissible, and it is unwilling to allow the potential consequences this may have for the public domain.<sup>131</sup>

#### 1. *The Line between Trademark and Patent*

The Supreme Court made clear in *TraFFix Devices, Inc. v. Marketing Displays, Inc.*<sup>132</sup> that, in a claim for trade dress infringement, an expired utility patent will serve as “*strong evidence that the features*” claimed in

---

<sup>127</sup> *Moseley*, 537 U.S. at 434.

<sup>128</sup> See *supra* notes 37–44 and accompanying text.

<sup>129</sup> See *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30–31 (2001) (holding that an expired patent covering a functional feature cannot receive trade dress protection).

<sup>130</sup> See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 529 U.S. 23, 32 (2003) (holding that the Lanham Act does not prevent the unaccredited copying of an uncopyrighted work).

<sup>131</sup> See *infra* notes 132–180 and accompanying text.

<sup>132</sup> *TraFFix*, 532 U.S. at 23.

the patent are functional.<sup>133</sup> This, in turn, creates a rebuttable presumption that the features do not enjoy trade dress protection.<sup>134</sup> The rationale behind this approach lies in the functionality doctrine of trademark law.<sup>135</sup> Functional features are not subject to protection under the Lanham Act.<sup>136</sup> As the Court noted, this is partially because “[t]he Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of patent law and its period of exclusivity.”<sup>137</sup> Since there is a high likelihood that a utility patent covers functional features, the presumption against trade dress protection arises.<sup>138</sup>

*Traffix* involved Marketing Displays, Inc. (“MDI”), a company that sold temporary outdoor road signs incorporating a dual-spring design.<sup>139</sup> The unique design allowed the signs to stay upright in strong winds.<sup>140</sup> Patents on the dual-spring design had expired and MDI held the expired patents.<sup>141</sup> *Traffix* reverse engineered the design used by MDI and began selling copies of the signs.<sup>142</sup> MDI filed a complaint alleging trade dress infringement under § 43(a) of the Lanham Act as one of its claims.<sup>143</sup> This case was also heard in the Sixth Circuit and involved a circuit split on “whether the existence of an expired utility patent forecloses the possibility of the patentee’s claiming trade dress protection in the product’s design.”<sup>144</sup> The Court granted certiorari and proceeded, once again, to reverse the Sixth Circuit.<sup>145</sup>

The Court held that MDI could not bring an action for trade dress infringement against *Traffix*.<sup>146</sup> This holding hinged on the fact that MDI was seeking to protect, via § 43(a), material claimed in the expired

---

<sup>133</sup> *Id.* at 29–30 (emphasis added) (“If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise.”).

<sup>134</sup> *Id.*

<sup>135</sup> Functional features of products may not receive trademark protection. In making the functionality determination, the Court distinguishes between and applies different tests for those features that are useful and those that are aesthetic. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–70 (1995).

<sup>136</sup> *Id.* at 165.

<sup>137</sup> *Traffix*, 532 U.S. at 34.

<sup>138</sup> *See id.* at 29–30.

<sup>139</sup> *Id.* at 25.

<sup>140</sup> *Id.*

<sup>141</sup> *Id.*

<sup>142</sup> *Id.* at 26.

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* at 28.

<sup>145</sup> *Id.* at 35.

<sup>146</sup> *Id.* at 34–35.

patents.<sup>147</sup> The expired patents raised a presumption of functionality for the material claimed, making trademark protection unavailable.<sup>148</sup> Further, allowing MDI to have protection under § 43(a) for the same features claimed in the expired patents would extend the expired monopoly, thus disturbing the tradeoff inherent in the issuance of any patent.<sup>149</sup> At least in part, the desire to protect the basic policy tradeoff behind the patent system motivated this decision,<sup>150</sup> but the *TrafFix* Court was also explicit in its desire to protect the public domain and allow copying.<sup>151</sup> The Court reiterated that “copying is not always discouraged or disfavored by the laws which preserve our competitive economy.”<sup>152</sup> The Court continued: “Allowing competitors to copy will have salutary effects in many instances. Reverse engineering of . . . articles in the public domain often leads to significant advances in technology.”<sup>153</sup>

The standard of functionality adopted in *TrafFix* is a testament to the Court’s desire to protect copying. Patent protection requires a showing of utility for the features claimed.<sup>154</sup> By holding that expired utility patents carry strong evidentiary significance that a device for which trade dress protection is sought is functional,<sup>155</sup> the Court imposed a high threshold for such patents. Thus, this inquiry complements and adds to the functionality considerations for trademarks discussed in *Qualitex* which already narrow the scope of material that may be protected and removed from the public domain.<sup>156</sup>

The *TrafFix* Court was even more concerned with clarifying the lines between the bodies of intellectual property law than it was in its earlier

---

<sup>147</sup> *Id.* at 34.

<sup>148</sup> It is worth noting that the Court in *TrafFix* distinguished the situation where the material sought to be protected under § 43(a) was not functional, stating:

In a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain. There the manufacturer could perhaps prove that those aspects do not serve a purpose within the terms of the utility patent.

*Id.*

<sup>149</sup> *Id.* at 35.

<sup>150</sup> *Id.* at 34–35.

<sup>151</sup> *Id.* at 29.

<sup>152</sup> *Id.* (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 160 (1989)).

<sup>153</sup> *Id.*

<sup>154</sup> MARTIN J. ADELMAN ET AL., *CASES AND MATERIALS ON PATENT LAW* 133 (2d ed. 2003).

<sup>155</sup> See *TrafFix*, 532 U.S. at 29–30.

<sup>156</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–69 (1995) (discussing the “functionality doctrine”). See *supra* notes 67–71, 101–106 and accompanying text.

*Samara* decision.<sup>157</sup> This ruling helps preserve the tradeoff between public access and inventor's rights, which remains at the core of patent law. Trademark is not allowed, in this particular instance, to snatch and protect public domain material relinquished by the patent system.

## 2. *The Line between Trademark and Copyright*

*Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>158</sup> has two distinctions: it is one of the most significant recent affirmations of the importance of the public domain, and it ensures that subject matter protected by the Intellectual Property Clause of the Constitution actually passes into the public domain when its protection expires. The issue resolved by *Dastar* was “whether section 43(a) of the Lanham Act . . . prohibits the unaccredited copying of a work no longer under copyright.”<sup>159</sup>

In *Dastar*, the Supreme Court addressed a claim by Twentieth Century Fox that Dastar Corporation copied a formerly copyrighted television series without giving proper credit and was thus guilty of reverse passing off prohibited by § 43(a) of the Lanham Act.<sup>160</sup> The work at issue was a television series, “Crusade in Europe,” in which Fox held the copyright until 1977, when it was allowed to expire.<sup>161</sup> “Crusade in Europe” was based on General Dwight D. Eisenhower’s book of the same name, telling of the Allied campaign in World War II. Fox did reacquire “the exclusive right to distribute the Crusade television series on video and to sub-license others to do so” in 1988.<sup>162</sup> In 1995, Dastar produced its own video series entitled “World War II Campaigns in Europe.”<sup>163</sup> All of the footage used for Dastar’s series was obtained from beta cam tapes of the original Crusade television series (now in the

---

<sup>157</sup> Though the Court in *Traffix* recognized that *Samara* was “careful to caution against misuse or over-extension of trade dress,” *Traffix*, 532 U.S. at 29, the *Samara* Court did not specifically differentiate between the bodies of intellectual property law. The Court in *Traffix*, however, made its concerns about overlap between the bodies of intellectual property law much more explicit, noting that the “Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.” *Id.* at 34.

<sup>158</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

<sup>159</sup> Stuart G. Richeson, *Unattributed Copying of Work No Longer Protected by Copyright*, 51 LA. B.J. 218 (2003).

<sup>160</sup> *Dastar Corp.*, 539 U.S. at 27.

<sup>161</sup> *Id.* at 26.

<sup>162</sup> *Id.*

<sup>163</sup> *Id.*

public domain).<sup>164</sup> *Dastar's* series did not recognize the Crusade television series.<sup>165</sup>

The Ninth Circuit held that “*Dastar's* ‘bodily appropriation’ of Fox’s original [television] series [was] sufficient to establish the reverse passing off.”<sup>166</sup> The Supreme Court, however, reversed this decision.<sup>167</sup> Central to the Court’s holding was its determination that “origin of goods,” as used in § 43(a)(1)(A) of the Lanham Act, “refers only to the manufacturer or producer of the physical ‘goods’ that are made available to the public” rather than to “the creator of the underlying work” as well.<sup>168</sup>

Section 43(a) of the Lanham Act allows a civil action, like the one in *Dastar*, when:

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

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.<sup>169</sup>

The *Dastar* Court noted that § 43(a) has been interpreted to cover both geographic origin and origin of production, as well as reverse passing off as it is interpreted by many of the federal circuit courts.<sup>170</sup> The Court was, however, quick to note that, “[b]ecause of its inherently limited wording, § 43(a) can never be a federal ‘codification’ of the overall law of ‘unfair competition.’”<sup>171</sup> As a result, the Court rejected Fox’s argument that “origin” should be read to include the creator of the underlying work.<sup>172</sup> The Court held that “the phrase refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods.”<sup>173</sup>

<sup>164</sup> *Id.*

<sup>165</sup> *Id.* at 27.

<sup>166</sup> *Id.* at 28 (citations and footnote omitted).

<sup>167</sup> *Id.* at 38.

<sup>168</sup> *Id.* at 31.

<sup>169</sup> Lanham Act, 15 U.S.C. § 1125(a) (2004).

<sup>170</sup> See *Dastar Corp.*, 539 U.S. at 29–30.

<sup>171</sup> *Id.* at 29 (quoting 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:7 (4th ed. 2002)).

<sup>172</sup> *Dastar Corp.*, 539 U.S. at 37.

<sup>173</sup> *Id.*

If Fox had been allowed to assert rights of attribution over this expired copyright, the Court believed the situation would be akin to creating “a species of mutant copyright law that limits the public’s federal right to ‘copy and to use,’ expired copyrights.”<sup>174</sup> The policy concerns of implying this right of attribution under § 43(a) for works currently in the public domain are twofold: 1) the reputational interests protected by a copyright would be extended by this approach far beyond what is envisioned by the Copyright Act; and 2) a burden would be placed on the public’s ability to use and copy public domain material because disclaimers would have to be included to avoid claims of deception as to origin under § 43(a).<sup>175</sup> This decision was motivated by concerns about the public domain and to avoid overlapping protection between the bodies of intellectual property law. As the Court noted, “in construing the Lanham Act, we have been ‘careful to caution against misuse or over–extension’ of trademark and related protections into areas traditionally occupied by patent or copyright.”<sup>176</sup> *Dastar* was intended to protect the “‘carefully crafted bargain’ under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution.”<sup>177</sup>

*Dastar* preserves the bargain that runs through the branches of intellectual property law. Had Fox won, the company would have obtained part of the rights afforded it by the expired copyright via the potentially perpetual protection of the Lanham Act. Not only does this conflict with the underlying rationale behind the Act,<sup>178</sup> it also runs contrary to the idea of “a limited time” as expressed in the Intellectual Property Clause.<sup>179</sup> Further, copyright’s bargain with material entering the public domain, and the full richness of the public domain envisioned by this bargain, is protected by not requiring attribution.<sup>180</sup>

---

<sup>174</sup> *Id.* (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989)).

<sup>175</sup> See Brandy A. Karl, Legal Update, *Reverse Passing Off and Database Protections: Dastar Corp. v. Twentieth Century Fox Film Corp.*, 9 B.U. J. SCI. & TECH. L. 481, 487 (2003) (addressing issues raised by *Dastar* prior to the Court’s decision in that case).

<sup>176</sup> *Dastar Corp.*, 539 U.S. at 34 (quoting *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001)).

<sup>177</sup> *Id.* (internal citation omitted).

<sup>178</sup> Trademark law’s primary purpose is generally characterized as reducing consumer confusion. See DREYFUSS & KWALL, *supra* note 19, at 7–8.

<sup>179</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>180</sup> See Howard J. Sussner, *Commentary: Supreme Court: Federal Lanham Act No Help to Owners of Expired Copyrights*, ANDREWS INTELL. PROP. LITIG. REP., July 22, 2003, at 13 (discussing the Supreme Court’s holding in *Dastar*).

## IV. CONCLUSION

The aforementioned cases illustrate a trend by the United States Supreme Court toward protecting the right to copy public domain material under § 43 of the Lanham Act. It is unclear whether this trend will extend beyond § 43, with its inherent danger of abuse and overreaching, to other areas of intellectual property law. Regardless, the decisions discussed in this note prevent erosion of the public domain, emphasize the permissible role of copying, and indicate a focused effort by the Court to protect the public domain on at least one defined front.

However, some scholars seem to downplay the significance of these decisions. For example, Professor Rosemary J. Coombe cautions that “[p]roponents of the public domain should be aware that if we focus too exclusively upon concepts of fair use and the jurisprudence interpreting the intersection of copyright, patent, trademark, and the First Amendment, we are concerning ourselves with local ordinances in a world of global interconnections.”<sup>181</sup> Coombe’s argument addresses larger ideas of a global “creative commons”<sup>182</sup> and concerns about appropriating, through intellectual property rights, the essence and value of other cultures.<sup>183</sup> On a theoretical level the public domain should, and does, extend this far. However, in the context of the material discussed in this note, Coombe’s argument is inapposite.

From a practical point of view, courts do well to gently guide the policy underlying intellectual property law. Courts must decide specific issues within the confines of the statutory system established by Congress to protect intellectual property. The cases in this note do not address what may be larger problems in the realm of intellectual property law, like protecting the global “creative commons”<sup>184</sup> or reconciling American law on moral rights<sup>185</sup> with the rest of the world. Doing so

---

<sup>181</sup> Coombe, *supra* note 2, at 1182 (discussing the expansion of authorial rights in intellectual property as harming the public domain and appropriating from other cultures their value and essence).

<sup>182</sup> *Id.* at 181.

<sup>183</sup> *See id.*

<sup>184</sup> *Id.*

<sup>185</sup> Moral rights is a copyright doctrine that essentially “protects a creator’s personal, as opposed to economic interests in her work.” DREYFUSS & KWALL, *supra* note 19, at 319. It is widely recognized throughout most of the world, but only in a very limited fashion in the U.S. The doctrine often provides for a right of disclosure, a right of attribution, and a right of integrity in a work. *Id.* Section 6b of the Berne Convention, which the U.S. joined in 1988, explicitly recognizes moral rights. The United States, however, does not explicitly recognize moral rights, believing that the law as it stands protects artists sufficiently. *Id.* at 320. Congress did make a small move toward the recognition of moral rights through the Visual Artists Rights Act (“VARA”), passed as an amendment to the 1976 Copyright Act in 1990. VARA “provides creators of visual art

would be difficult, possibly even inappropriate. Arguably, Congress or organizations like the World Intellectual Property Organization (“WIPO”), rather than the courts, are in a better position to shape intellectual property policy at the global level. What these cases *do* address is the extent to which people may exercise property rights over ideas and inventions within the framework of statutes like the Lanham Act, and, consequently, how much the public will be free to copy—which is the core concern of many critics of strong intellectual property protections.<sup>186</sup>

Recent years have seen an expansion in some aspects of intellectual property rights. As Professor A. Samuel Oddi notes, this expansion has taken a number of forms:

The duration of protection has been increased for certain titles. Certain terminated copyrights have been given new life . . . [L]ower substantive standards of protection are being applied. There is overlapping protection of the same subject matter by different forms of intellectual protection delaying full entrance of that subject matter into the public domain.<sup>187</sup>

One example of the type of expansion Professor Oddi mentions also appeared in one of the most notable and recent cases: *Eldred v. Ashcroft*. In January 2003, the Supreme Court upheld an increase in the term of pre-1978 copyrights from seventy-five years to ninety-five years.<sup>188</sup> This term extension is a far cry from the fourteen-year term provided by the first Copyright Act or the first extension of the term to twenty-eight years in 1909.<sup>189</sup>

Professor Lawrence Lessig served as the lead attorney on *Eldred*, arguing that the term extension was unconstitutional, as it was inconsistent with the mandate of “limited Times” in the Intellectual

---

. . . with relatively limited rights of attribution and integrity when modifications to their works are made that will prejudice their honor or reputation.” *Id.* at 320–21.

<sup>186</sup> See generally Boyle, *supra* note 2 (arguing that intellectual property may be analogized to real property in many ways and that we are experiencing a “second enclosure movement” restricting the public domain); Coombe, *supra* note 2; Lessig, *Architecture of Innovation*, *supra* note 51; A. Samuel Oddi, *The Tragicomedy of the Public Domain in Intellectual Property Law*, 25 HASTINGS COMM. & ENT. L.J. 1 (2002) (examining the interaction between the public domain and private domain and noting expansions in the private domain). *But cf.* Wagner, *supra* note 4 (arguing that increasing intellectual property controls might not actually lead to a contraction of the public domain).

<sup>187</sup> Oddi, *supra* note 186, at 6–7 (citations omitted).

<sup>188</sup> See *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

<sup>189</sup> See Jason Krause, *The Education of Larry Lessig*, 90 A.B.A. J. 37, 41 (2004).



Property Clause.<sup>190</sup> This argument did not convince the Court, in part because accepting it could result in chaos; carrying the argument to its logical end would require invalidating the 1976 Copyright Act along with its term extensions.<sup>191</sup> Since *Eldred*, Professor Lessig has been thinking about new approaches to revitalize the public domain and protect the balance in intellectual property law as he sees fit. One of his current ideas is to require copyright holders to pay a nominal fee before the end of their current term to maintain the copyright.<sup>192</sup> This system would allow “companies like Disney [to] keep their lucrative properties without putting unused works under restrictive copyright protections.”<sup>193</sup> Whether such initiatives will gain enough support to be put into practice has yet to be seen.

*Eldred* and the § 43 cases discussed in this note exemplify the mixed treatment the public domain receives from the Supreme Court. It is possible to reconcile the two groups, but doing so is often speculative. For instance, it simply may be that the Court views § 43 as particularly vulnerable to use as a backdoor for gaining rights beyond those envisioned by the bargains in the various bodies of intellectual property law. Further, it may be that each case is approached independently, using the overarching tradeoffs and objectives of intellectual property law, including recognition of the role of the public domain, to come to a decision.

Ultimately, what appears to be varying regard for encroachments on the public domain by the Court is most easily explained by the tie that binds the cases in this note: § 43 of the Lanham Act. The nature of § 43 almost invites attempts to protect subject matter not typically protected under the Lanham Act, or subject matter that is amenable to protection under either patent or copyright law. *Eldred* is different because, in that case, the Court was only concerned with the term of the copyright and not with the intersection of the bodies of intellectual property law in a way that could lead to abuse of the system.<sup>194</sup> However, it is worth noting that all of these cases still affect the public domain in terms of when, and

---

<sup>190</sup> *Id.* at 37. See also U.S. CONST. art. I, § 8, cl. 8 (giving Congress the power “to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”).

<sup>191</sup> Krause, *supra* note 189, at 41 (noting this concern as expressed by Justice Breyer during the *Eldred* argument).

<sup>192</sup> Lawrence Lessig, Editorial, *Protecting Mickey Mouse at Art's Expense*, N.Y. TIMES, January 18, 2003, at A17.

<sup>193</sup> Krause, *supra* note 189, at 39. Professor Lessig finds this approach particularly appealing because of “a Congressional Research Service estimate that only 2 percent of works published between 1923 and 1942 have any commercial value. Yet use of the 98 percent of works . . . is restricted to protect the 2 percent.” *Id.* at 39–40.

<sup>194</sup> See *Eldred v. Ashcroft*, 537 U.S. 186, 192 (2003).

how much, material enters it. As seen in the language of cases like *Traffix*,<sup>195</sup> the Court is clearly mindful of the effect its decisions have on the public domain. However, it is also clear that this is not the controlling concern in all cases.

Cases continue to come down in ways that alternately expand and contract the public domain. For example, in the recent case of *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*<sup>196</sup> the Court resolved a circuit split to make it easier for defendants to assert the fair use defense<sup>197</sup> to a claim of infringement of a registered trademark.<sup>198</sup> This decision represents another small step toward safeguarding the right to copy and use material in the public domain, with regard to *registered* trademarks.

Nonetheless, the policy results of recent Supreme Court decisions interpreting § 43 of the Lanham Act clearly favored free copying of public domain material and rejected further expansion of intellectual property rights. This line of cases represents a strong acknowledgement by the Court of the need to maintain a vibrant public domain. Reconciling the cases in this note with other decisions that are widely acknowledged to limit the robustness of the public domain is the difficult part. Whether the trend toward maintaining access to a real public domain, evidenced by the cases in this note and hoped for by scholars like Professor Lessig, will continue to expand has yet to be seen. Regardless, such an emphatic reaffirmation of copying as the *Dastar* decision<sup>199</sup> must lead one to ask whether some are prematurely mourning the demise of the public domain.<sup>200</sup>

---

<sup>195</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (“[a]llowing competitors to copy will have salutary effects in many instances”). See also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (“[f]rom their inception, the federal patent laws have embodied a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy.”).

<sup>196</sup> *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 125 S. Ct. 542 (2004).

<sup>197</sup> See Lanham Act, 15 U.S.C. § 1115(b)(4) (2004) (stating that an affirmative defense of fair use to a claim of infringement is available to a party whose “use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark . . . used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.”).

<sup>198</sup> The circuit split at issue in *KP Permanent Make-Up* involved whether a party asserting the fair use defense under § 1115(b)(4) had to show that there was not a likelihood of confusion in order to prevail on the defense. The Court ruled that such a showing is not required to assert the defense, but that the likelihood of confusion can help inform whether a use is fair or not. See *KP Permanent Make-Up*, 125 S.Ct. at 549–51.

<sup>199</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

<sup>200</sup> See, e.g., *supra* notes 2–3 and accompanying text.

