

REMEMBER MY NAME: CHOREOGRAPHING THE FIT OF SECTION 43 (A) TO AN AUTHOR'S RIGHT OF ATTRIBUTION [FNA1]

“You got big dreams? You want fame? Well, fame costs. And right here is where you start paying—in sweat.” Voice of Debbie Allen as dance instructor Lydia Grant, opening narration from the TV series, *Fame* [FNA2]

I. BACKGROUND AND INTRODUCTION

John Locke's labor theory of property has greatly influenced the American model of government, spurring the evolution of libertarian thought in our nation.¹ His philosophy refers to the notion that a person may claim ownership of whatever he has produced through his own labor.² At an even more basic level, the labor theory is a mirror for human behavior, reflecting the reality that an individual works hard precisely because he or she seeks to stake an affirmative, proprietary claim over that which he or she accomplishes (i.e. produces) through his or her manual and intellectual exertions. Authors are among the group of individuals who seek to lay a claim of right over their work. A key way in which this is done is by affording an author the proper

[FNA1] I would like to thank Professor Frank Politano for his invaluable help and support in assisting me with this comment.

[FNA2] http://www.tvacres.com/begin_dramas.htm (last visited Jan. 31, 2004).

1. John Rothbard, *The Growth of Libertarian Thought in Colonial America*, <http://www.mises.org/cil2ch33.asp>, (last visited January 25, 2004).

2. See *Of Property*, CH. 5 SECOND TREATISE ON GOVERNMENT, cited at <http://www.swan.ac.uk/poli/texts/locke/locke04.html> (last visited Apr. 5, 2004) (Locke makes the following provocative statements: “The Labour of [Man’s] Body, and the Work of his hands. . . are properly his. Whatsoever then he removes out of the State that Nature hath provided, and left it in, he hath mixed his Labour with, and joyned to it something that is his own, and thereby makes it his Property. It being by him removed from the common state Nature placed it in, hath by this labour something annexed to it, that excludes the common right of other Men).

right of accreditation.³ The author's battle to have his name attached to his work is pronounced because American copyright law rejects the "sweat of the brow" doctrine that forms the core of the labor theory.⁴ The Convention for the Protection of Artistic and Literary Works, signed at Berne, Switzerland on September 8, 1886 ("the Berne Convention") seeks to meet the aforementioned gap in the protection of authors' rights.⁵ Article 6 bis specifies the rights upon which an author may depend:

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

With extreme caution and reservation,⁶ the United States acceded to international pressure and joined the Berne Convention in 1989.⁷ As a party to this treaty, it has implemented⁸ *limited* measures to comply with the treaty's twin polestars cited above: the rights of attribution and integrity.⁹ The latter, which will be discussed in Section V.B, refers to the right of a creator to have his work represented in its original

3. This points to what is known in copyright law as the "right of attribution," which is alternatively phrased as the "right of paternity." See Keith A. Attlesley, *The Visual Artists Rights Act of 1990: The Art of Preserving Building Owners' Rights*, 22 GOLDEN GATE U. L. REV. 371, 372 n.6 (Spring 1992) (explaining that the right of attribution allows an author to claim credit for a work, or under certain circumstances, to remove his name from a work).

4. See *Feist Publ'n, Inc. v. Rural Tel. Serv Co.*, 499 U.S. 340, 359-360 (1991) (rejecting the theory that a work should be protected merely for the labor involved in the collection of data: "[T]he 1976 revisions to the Copyright Act leave no doubt that originality, not 'sweat of the brow,' is the touchstone of copyright protection. . . Nor is there any doubt that this was true under the 1909 Act").

5. See Robert Davenport, *Screen Credit in the Entertainment Industry*, 10 LOY. ENT. L.J. 129 n.2. (1990)

6. See discussion *infra* Part V.C.

7. Gerald Dworkin, *The Moral Right of the Author: Moral Rights and the Common Law Countries*, 19 COLUM.-VLA J.L. & ARTS 229, 239 (Spring/Summer 1995).

8. Domestic (i.e. enabling) legislation is specified as a prerequisite to the official recognition of the rights of attribution and integrity. See discussion regarding the non self-executing nature of the Berne Convention *infra* Part IV.C.

9. Michael B. Gunlicks, *A Balance of Interests: The Concordance of Copyright Law and Moral Rights in the Worldwide Economy*, 11 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 601, 608-609 (Spring 2001).

context, without severe distortion or mutilation.¹⁰ American adherence to Berne is problematic in that our copyright and trademark law, as will be shown below, are not in compliance with the text of the Convention. This dearth in the protection of artists' creative endeavors leads to the fashioning of ill-fitting remedies and distorted interpretations of the law, in particular—the Lanham Act. This comment will focus on the misapplications of the Lanham Act in the context of an artist's right of attribution.

American copyright law does not have liberal provisions¹¹ for an author's right of attribution. Visual artists are given some protection,¹² but this does not apply to other authors. Section 106A of the Copyright Act provides some respite to a visual artist seeking credit for his or her work by explaining that the rights conferred by subsection (a) subsist in the creator of tangible expression, whether or not that creator happens to be the copyright owner. However, the reality is that

10. See discussion *infra* notes 176-195.

11. § 106A (a) cite as: 17 U.S.C.S. § 106 A (a) (2004) of the Copyright Act describes the rights of attribution and integrity:

The author of a *work of visual art*—

- (1) shall have the right—
 - (A) to claim authorship of that work, and
 - (B) to prevent the use of his or her name as the author of visual art which he or she did not create;
- (2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and
- (3) ...shall have the right—
 - (A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and
 - (B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right
(emphasis added).

12. 17 U.S.C.S. § 106 A of the Copyright Act is known as the Visual Artists' Rights Act (VARA). cite See discussion *infra* notes 34-40 and accompanying notes.

legal action predicated on the alleged infringement of an author's work by a late comer will encounter the formidable defense of fair use.¹³ Given this difficulty in pursuing a successful copyright cause of action, authors look to the Lanham Act in a last ditch effort to protect their rights of attribution. However, as will be explicated in the course of this comment, this statute is not intended to protect artists' moral rights.

The section of the Lanham Act that is often improperly implemented by artists in the course of vindicating their rights is 15 U.S.C. § 1125, § 43 (a) (1) (A), which prohibits, among other things, "false designations of origin":

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. . . shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.¹⁴

Not only has § 43 (a) been used by authors whose copyright protection has expired or is nonexistent,¹⁵ but plaintiff creators have often implemented it to fashion a catchall request for relief where they believe that later comers have violated their moral

13. §107 of the Copyright Act explains that notwithstanding the provisions of 106A, fair use is a limitation on the exclusive rights conferred by copyright.

14. 15 U.S.C. § 1125, § 43 (a). The full text of this section is as follows:

- (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 with another person, or as to the origin, sponsorship or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities or geographic origin of his or her or another person's goods, services, or commercial activities,
 shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act (emphasis added).

15. This is the factual basis of *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041, 2042 (2003). See discussion *infra* Part IV.B-C.

rights.¹⁶ These artists *improperly* implement § 43 (a) as a springboard for litigation by presenting the injuries to their moral rights as unfair competition claims and this distorts the original purpose of the statute.¹⁷

This comment addresses the often-unrestrained use of § 43 (a) by plaintiff creators and analyzes the legal deficiencies in their moral rights arguments as they have been typically framed. Part II provides a sketch of the evolving scope of moral rights under American law. Part III examines the inconsistent approach among the circuits in ascertaining how § 43 (a) has been violated in right of attribution cases. This section underscores the marked lack of support for recognizing viable causes of action under this provision of the Lanham Act. Part IV focuses on the recent United States Supreme Court decision that has effectively limited the wide reach of § 43 (a) in vindicating an author's right of attribution.¹⁸ Part V explores the implications of *Dastar Corp. v. Twentieth Century Fox Film Corp.* This section explains what remains viable of the current circuit court approaches in Part III and points out that the right of integrity may still be a legally cognizable claim for authors to

16. See generally Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught in the Crossfire between Copyright and Section 43 (a)*, 77 WASH. L. REV. 985 (Oct. 2002) [hereinafter *Caught in the Crossfire*]. The author explains the two main ways in which a plaintiff creator uses § 43 (a). There may either be a complete omission of authorial credit or a misattribution. See generally Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught in the Crossfire between Copyright and Section 43 (a)*, 77 WASH. L. REV. 985 (Oct. 2002) [hereinafter *Caught in the Crossfire*].

17. It is important to note that litigants often broadly construe § 43 (a) in order to gain relief, even when such relief is not contemplated by the text of the statute. See *Scholastic, Inc., J.K. v. Stouffer*, 124 F. Supp. 2d 836, 842 n.5 (S.D.N.Y. 2000) (explaining that “[s]ection 43 (a) is an enigma, but a very popular one. Narrowly drawn and intended to reach false designations or representations as to the geographical origins of products, the section has been interpreted to create, in essence, a federal law of unfair competition,” (quoting The United States Trademark Association, Trademark Review Commission Report and Recommendations to USTA President and Board of Directors, 77 TRADEMARK REP. 375, 426 (1987)); See also, Randolph Stuart Sergent, *Building Reputational Capital: The Right of Attribution under Section 43 of the Lanham Act*, 19 COLUM-VLA J.L. & ARTS 45 (Fall 1994/Winter 1995) [hereinafter *Building Reputational Capital*] (explaining that § 43 (a) is aimed at preventing actual consumer confusion).

18. *Dastar v. Twentieth Century Fox*, 123 S.Ct. 2041 (2003).

pursue. Finally, Part VI suggests solutions that may be implemented in the wake of the recent curtailment of the right of attribution under §43 (a). These proposed changes are more in line with the American legal conception of moral rights for authors.

II. MORAL RIGHTS: A BRIEF SKETCH

The term “moral rights” is a translation of the French phrase “*le droit moral*,”¹⁹ which is meant to signify rights of a spiritual, personal, and non-pecuniary nature.²⁰ The wellspring for these rights is the belief that a work of art is a unique extension of an author—a veritable reflection of his or her individual personality.²¹ According to this natural law principle, moral rights stand on their own, independent of the creator’s copyright in his or her work.²² Although long recognized in European countries such as France and Germany,²³ moral rights legislation is of relatively recent vintage in the United States. An early and explicit rejection of moral rights by the common law can be seen in *Crimi v. Rutgers Presbyterian Church in the City of New York*.²⁴ In this case, the court decided that the plaintiff creator, who had been paid for painting a mural on the wall of the defendant’s church, had no legal right to demand the removal of obliterating paints, which had been applied by individuals objecting to his artistic rendering of Christ.²⁵ In so ruling, the court explicitly rejected the moral rights’ arguments presented to it, reasoning that the United States did not subscribe to the

19. See Natalie C. Suhl, *Moral Rights Protection in the United States under the Berne Convention: A Fictional Work?* 12 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 1203, 1210-1211 (Spring 2002) [hereinafter *A Fictional Work?*] (explaining France’s role in the early days of moral rights’ protection).

20. *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 81 (2^d Cir. 1995); See also H.R. Rep. No. 514, at 5 (1990), “The theory of moral rights is that they result in a climate of artistic worth and honor that encourages the author in the arduous act of creation (quoted in *Carter*, 71 F.3d at 83).

21. *Kwall, Caught in the Crossfire*, *supra* note 16, at 986.

22. *Carter*, 71 F.3d at 81.

23. Dworkin, *supra* note 7, at 232-233; See also Gunlicks, *supra* note 9, at 608 (explaining that French and German law recognize four basic moral rights as inhering in the artist: (i) the right to publish; (ii) the right of attribution; (iii) the right of integrity; and the artist’s (iv) right to retract).

24. 89 N.Y.S.2d 813 (1949).

25. *Id.* at 818.

policy of protecting the moral rights of creators.²⁶ Deference was given to freedom of contract principles so that the artist, who wanted to preserve his moral rights beyond the sale of the fresco, should have done so by means of specific agreement with the defendant church.²⁷ While this rejection of moral rights was rarely so blunt in years to come, it is important to recognize that the changes made this arena have been minor and tentative.²⁸

When the United States joined the Berne Convention, which as mentioned above, protects authors' moral rights, it did so on a conditional basis.²⁹ Acceptance was effected by means of the Berne Convention Implementation Act (BCIA), which held that domestic law remained dominant over the obligations dictated in the treaty. The BCIA essentially paid lip service to the Berne Convention, as bolstered by "Congress' assertion that American law *already* protected authors' [m]oral [r]ights adequately through the areas of unfair competition, copyright, contract, defamation, and privacy.³⁰" This view colored Congress' reactions to legislation aimed at furthering artists' rights, causing it to craft very narrowly tailored statutory provisions.³¹ In

26. *Id.* at 817.

27. *Id.* at 819.

28. Despite the slow ebb of incremental and lukewarm changes in the area of moral rights, strong sentiments from artists themselves have been presented to Congress. In lobbying for the Visual Artists Right Amendment of 1986, Alfred Crimi tried to effect change in the moral rights area by expounding on the often nebulously construed definition of moral rights: "A work of fine art . . . is a one of a kind creation expressing the spirit and the mood of the time of its conception and the psychological characteristics of the mind that conceives it. It is an inner expression of the soul . . . Because of its very nature, a work of fine art is a precious expression of the heart and mind of the artist and should be protected." *Hearings on S. 2796 Before the Subcomm. on Patents, Copyrights, & Trademarks of the Comm. on the Judiciary, 99th Cong., 2d Sess. 12-13 (1986)* (testimony of Alfred Crimi, plaintiff in *Crimi v. Rutgers Presbyterian Church*).

29. Suhl, *A Fictional Work?*, *supra* note 19, at 1212.

30. *Id.* at 1212-13 (emphasis added).

31. It is important to note here that in constructing such legislation as the Visual Artists Rights Act (VARA), Congress was heavily influenced by market forces, particularly by industry groups such as the Motion Picture Association of America (MPAA), an economically powerful group that opposed expansive rights for artists. See PAUL C. WEILER, *ENTERTAINMENT MEDIA AND THE LAW* 492 (West Group, 2d ed. 2002) (indicating that the final version of VARA excluded motion pictures due to strong opposition from such groups such as the MPAA); See also Roberta Rosenthal Kwall, 'Author Stories': *Narrative Implications for Moral Rights and Copyright's Joint Authorship*

addition to being applied to a *limited* class of artistic subject matter, as will be discussed, the rights of attribution and integrity specifically enumerated in the Berne Convention³² were further circumscribed by other copyright law doctrines.³³

Visual Arts was one of the areas³⁴ in which Congress saw the need to enact legislation in order to comply with the Berne Convention. The Visual Artists' Rights Act of 1990 (VARA)³⁵ was implemented so as to protect the rights of attribution and integrity for a limited category³⁶ of visual media. It is important to note that the protection offered to visual artists is further compromised by the fair use exception.³⁷ Fair use is a doctrine that says a copyrighted work is not infringed if it is used for "purposes such as criticism, comment, news reporting, teaching, scholarship, or research."³⁸ Fair use, as applied as a limiting factor to moral rights, is problematic because it is largely

Doctrine, 75 S. CAL. L. REV. 1, 28-30 (November 2001) (explaining that "because of the great odds against a motion picture ever recouping its enormous costs, it is imperative that film producers have the unencumbered freedom to adapt their productions to the differing needs of various markets." Kwall also elaborates that authors' desires to maintain their moral rights often conflicts with economic imperatives to disseminate creative products. This is a situation that must be grappled with in regards to various media, including motion pictures and book publishing industries).

32. See *supra* quotation of Article 6bis.

33. The work for hire theory is an important limitation on the rights provided for in Berne. See Carter, 71 F.3d at 85. As per § 101(1)B of the Copyright Act, if a work is "prepared by an employee within the scope of his or her employment," it is excluded from the protection afforded by § 106A.

34. Congress also amended the Copyright Act in 1990 to comply with the Berne requirement of protection for "illustrations, maps, plans and three dimensional works relative to geography, topography, architecture or science" by adding architectural works as the eighth category of copyrightable works under § 102 (a). See COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 273 (Julie E. Cohen et al. eds., 2002).

35. Codified at 17 U.S.C. § 106A.

36. The Copyright Act at § 101 defines a work of visual art as "a painting, drawing, print or sculpture, existing in a single copy" or in a limited edition of 200 copies or fewer. Moreover, a work of visual art excludes "any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work." *Id.*; See also Carter, 71 F.3d at 84 (explaining that Congress wanted to distinguish works of visual art from audio-visual and filmic works, due to the different circumstances in which works of each genre are created or disseminated).

37. See *supra*, note 13 and accompanying text.

38. § 107 of the Copyright Act

concerned with economics.³⁹ This is evidenced by § 107 (4) of the Copyright Act, which states that one of the elements to be analyzed in determining whether or not fair use may be substantiated is the effect of the allegedly offensive use on the market for the underlying copyrighted work. In stark contrast, moral rights, at least as phrased in the Berne Convention, are intended to be inalienable because they are supposed to exist “independently of the author’s economic rights.⁴⁰” This dichotomy in the observance of American copyright law creates inhospitable results for plaintiff creators, forcing them to look elsewhere for remedies to injuries to their moral rights. Section 43 (a) of the Lanham Act is one such place where respite is sought, although inappropriately.

III. THE INTERSECTION OF THE RIGHT OF ATTRIBUTION WITH SECTION 43 (A) OF THE LANHAM ACT

Before analyzing how plaintiff creators implement section 43 (a) in order to vindicate injuries to rights of attribution, it will be useful to explore the general parameters of this statutory provision. Section 43 (a) was enacted to codify the common law trademark doctrine of passing off, which refers to the representation of a defendant’s goods as those of the plaintiff.⁴¹ Examples of passing off occur where (1) one orders a Coke and gets a different, but identical-looking beverage in a

39. See Michael G. Anderson and Paul F. Brown, *The Economics Behind Copyright Fair Use: A Principled and Predictable Body of Law*, 24 LOY. U. CHI. L.J. 143, 174 (Winter 1993) (explaining the economic theory underlying fair use law); See also Kenneth D. Crews, *Fair Use of Unpublished Works, Burdens of Proof and the Integrity of Copyright*, 31 ARIZ. ST. L.J. 1, 71 (Spring 1999) (explaining the diverse transaction costs that are involved in allowing uses of copyrighted works and how these uses practically affect the authors of the underlying copyrighted works); See also Maureen Ryan, *Fair Use and Academic Expression: Rhetoric, Reality and Restriction on Academic Freedom*, 8 CORNELL J.L. & PUB. POL’Y 541, 552-555 (Spring 1999) (elucidating the United States Supreme Court’s stance that fair use cases should be resolved by means of the consideration of economic factors).

40. See *supra*, quotation of Article 6bis. In evaluating the purported inalienability of moral rights, it should be noted that in many Berne-observing countries whose copyright statutes contain analogues to the American fair use exception, provisions mandating the recognition of the authorship of a copied source are included therein. See, e.g., Dane S. Ciolino, *Rethinking the Compatibility of Moral Rights and Fair Use*, 54 WASH. & LEE L. REV. 33, 51 n. 95 (Winter 1997).

41. Kwall, *Caught in the Crossfire*, *supra* note 16, at 1003.

glass, and (2) where one orders a Coke and gets a different cola in a Coke-labeled bottle.⁴² Essentially, the seller is trying to ride on the coat tails of the purveyor who was first in time with respect to using a trademarked product in commerce.

Reverse passing off gradually evolved⁴³ as a separate cause of action to recognize a false designation of origin where a defendant appropriates, by varying degrees, a plaintiff's good or service and markets it as his or her own. An example of such an occurrence is when the seller of a radio, whose product is not yet ready for the market, advertises its product to the public by using a photo of a competitor's radio, but scratches out the latter's name and substitutes its own name.⁴⁴ It should be noted that reverse passing off may either be express, as in the example given, or implied.⁴⁵ Using the example of a plaintiff doctor who originated a surgical procedure, a claim alleging implied reverse passing off in the traditional trademarks context would involve a defendant doctor who simply used the novel procedure without mentioning who originated it.⁴⁶

42. This is an example derived from Professor E. Judson Jennings' lectures in Intellectual Property Law, Spring 2003. See also *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 530 (1924) (Manufacturer of *Quin-Coco* a drug containing quinine, colored and flavored with chocolate, similar to other substance named *CocoQuinine*, though entitled to use such name and manufacture such product, committed unfair competition by inducing druggists to purchase *Quin-Coco* in order to palm it off as *Coco-Quinine*).

43. *Caught in the Crossfire*, *supra* note 16, at 1004 (citing *John Wright, Inc. v. Casper Corp.*, 419 F. Supp. 292 (E.D.Pa. 1976) as the first case to hold that "section 43 (a) should be applied to reverse passing off in addition to passing off. . . [because] a misbranded product always constitutes a false designation of origin." This case held that liability under the Lanham Act could be sustained because the defendant used a confusingly similar certificate to that of the plaintiff's and he advertised that his product was a copy of the good produced by the plaintiff). *Id.* at 1004 n. 113.

44. This is an example derived from Professor Frank Politano's lectures in Trademarks and the Law of Unfair Competition, Fall 2003.

45. See 4 J. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25, at 6 (2003) (explaining that "'express reverse passing off' typically happens when a defendant removes or obliterates the original trademark without permission and rebrands the item with the defendant's own mark. . . 'Express reverse passing off' has been held. . . in certain factual settings to be a violation of Lanham Act §43 (a)"); See also *id.* at 8 (noting that "'implied reverse passing off' occurs when defendant, without permission, removes the original trademark and sells plaintiff's item in an unbranded state, thus leading the ultimate consumer to assume that the product has been created by defendant").

46. See *Building Reputational Capital*, *supra* note 17, at 74 (Sergent applies

As will be further elucidated by a discussion of the relevant case law, implied reverse passing off in the context of a right of attribution case takes place where the creator produces a work that is a close, yet not exact, copy of the prior work that was completed by another party.⁴⁷ Implied reverse passing off presents many more complex issues than the traditional action for passing off and is therefore, subject to varying judicial interpretations.⁴⁸ Despite the fact that there is a disparity with regard to the tests implemented by the circuit courts⁴⁹ in adjudicating these types of cases, there is one practical constant—every circuit (except the First) has held that the language of §43 (a) supports a claim for reverse passing off.⁵⁰ This wide recognition provides fertile legal ground for artists who feel that they have been wronged by individuals who have built on the creative corpus of their prior works in some way but have then failed to provide proper authorial credit.

It is important to note that because the product in dispute in a right of attribution case constitutes subject matter that can be copyrighted, such as art or literature, the judicial inquiry is complicated by the necessity of squaring the policies of § 43 (a) with those of copyright infringement.⁵¹ As will be explored, there is a growing concern that the Lanham Act will be manipulated to effect an end run around the Copyright Act.⁵² The fear is that a plaintiff will try to

this example in order to underscore that an implied reverse passing off claim seeks to vindicate loss to the creator of potential reputational benefits, because there has been no diversion of those benefits to the person who actually developed the procedure).

47. John T. Cross, *Giving Credit where Credit Is Due: Revisiting the Doctrine of Reverse Passing Off in Trademark Law*, 72 Wash. L. Rev. 709, 724-725 (1997) [hereinafter *Giving Credit where Credit Is Due*].

48. *Caught in the Crossfire*, *supra* note 16, at 1008; See also discussion *infra* Parts IV.A-D.

49. See discussion *infra* Parts III. A-D.

50. Brandy A. Karl, *Reverse Passing Off and Database Protections: Dastar Corp. v. Twentieth Century Fox Film Corp.* 9 B.U. J. SCI. & TECH. L. 481, 483 (Summer 2003) [hereinafter *Reverse Passing Off and Database Protections*].

51. *Caught in the Crossfire*, *supra* note 6, at 1004.

52. See *Building Reputational Capital*, *supra* note 17, at 62 (posing the question of whether the courts should be using § 43 (a) in a claim of false designation of authorial credit at all, "given the express statutory remedy provided by the Copyright Act"); See also *Giving Credit where Credit Is Due*, *supra* note 47, at 709 (sharply criticizing the use of §43 (a) to support reverse passing off claims); See also, *Brief of Amici Curiae*. Professor Eugene Clark, et al. 2002 WL 32101078 at *5, *Dastar*, 123 S.Ct. 2041 (2003) [hereinafter *Brief of Amici Curiae*] (underscoring the constitutional infirmity raised by implementing the

enforce an *invalid* copyright by means of § 43 (a),⁵³ a provision that was not designed to vindicate moral rights, but rather is a section that centers on preventing consumer confusion in a commercial context.⁵⁴ Furthermore, a sharp yet functional dichotomy between copyright and trademark law exists and this should be recognized by plaintiff creators who try to vindicate their rights through the Lanham Act.⁵⁵

While interpretation is the hallmark of our common law system, when a cause of action is predicated upon a statute, its plain meaning⁵⁶ shall inform the analysis. As will be illustrated, the right of attribution cases framed in terms of § 43 (a) of the Lanham Act do not form a cohesive pattern of attention to the statutory text.⁵⁷ Different tests are

Lanham Act so as to protect someone who has failed to fulfill the required formalities to secure copyright in a copyrightable work); *See also*, Bull Publ'g v. Sandoz Nutrition Corp., 13 U.S.P.Q.2d 1678, 1683 (N.D.Ca. 1989) (stating the reluctance to expand the scope of §43 (a) where the Copyright Act provides an adequate remedy); *See also* discussion of Scalia's opinion in *Dastar infra* Part IV.C.

53. *See, e.g.*, Moore Publ'g, Inc. v. Big Sky Mktg, Inc., 756 F. Supp. 1371, 1380 (Idaho 1990) (explaining that plaintiff publisher did not have valid copyrights in the real estate advertising logos that appeared in his magazine and that it was wrong for him to press a Lanham Act claim as a "backdoor method" of enforcing defective copyright claims).

54. *See Caught in the Crossfire, supra* note 16, at 1020 (further explaining that § 43 (a)'s focus on the prevention of consumer deception prevents it from adequately addressing suits regarding proper accreditation, which fall under the category of an author's reputational (i.e. moral) rights).

55. *See* Jessica Bohrer, *Strengthening the Distinction Between Copyright and Trademark: The Supreme Court Takes a Stand*, 2003 DUKE L. & TECH. REV. 23 (explaining how copyright law and trademark law are disparate because they spring from different sources in the U.S. Constitution. The Intellectual Property Clause forms the foundation for copyright law. It obligates Congress to "promote the Progress of Science and the Useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." In contrast, trademark law originates in the Commerce Clause and has no relation to invention or discovery).

56. *See* Hartford Underwriters Ins. Co. v. Union Planters, 120 S.Ct. 1942, 1947 (2000) (explaining that Congress' intent is reflected by the actual language that appears in the statute (citing *Conn. Nat. Bank v. Germain*, 503 U.S. 249, 254, 112 S.Ct. 1146, 117 L.Ed.2d 391 (1992)).

57. *See, e.g.*, *Reverse Passing Off and Database Protection, supra* note 50, at 486 (explaining that the Second and Ninth Circuit tests diverge from the text of section 43 (a)); *See also Giving Credit where Credit Is Due, supra* note 47, at 737-742; *See also* Smith v. Montoro, 648 F.2d 602, 604 (9th Cir. 1981) (quoting 2 J. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:2 (1973) (explaining that the law of unfair competition and trademarks has far surpassed the traditional concept of fraudulently passing off another person's product as one's own to encompass *any form* of competition that contravenes

implemented to discern whether or not the right of attribution has been violated, the circuit courts providing their own unique linguistic spin of § 43 (a). The following sections explore the tests applied and their respective shortcomings in light of the Lanham Act's overall scope.⁵⁸

A. The Bodily Appropriation Test

The Ninth Circuit implements the most restrictive view in addressing plaintiff creators' reliance on §43 (a) in litigating their attribution claims. Bodily appropriation occurs where "the defendant completely duplicat[es] the plaintiff's material"⁵⁹ without giving credit to the plaintiff. In *Cleary v. News Corp.*, this definition was further refined to include the "copying or unauthorized use of substantially the entire item"⁶⁰. In the notable case of *Smith v. Montoro*,⁶¹ the plaintiff actor alleged that the defendant film distributors deleted his name and substituted the name of another actor in both the screen credits and advertising material, which resulted in a false designation of origin. The court decided in the plaintiff's favor and held that the mislabeled motion picture created a viable ground for his Lanham Act claim.⁶² As reflected by the outcome of this case, it appears that Ninth Circuit courts will recognize a cause of action for reverse passing off only in the relatively straightforward cases in which there has been a deletion of proper credit and a contemporaneous false substitution.⁶³ In contrast, where an artist has built upon the work of another in some

social notions of fairness).

58. It cannot be kept very far from one's legal understanding that the Lanham Act's central purpose is to bar individuals from misleading the public "by placing their competitors' work forward as their own." *Shaw v. Lindheim*, 919 F.2d 1353, 136 (9th Cir. 1990).

59. *Caught in the Crossfire*, *supra* note 16, at 1004.

60. 30 F.3d 1255, 1261 (9th Cir. 1994) (quoting *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989)).

61. 648 F.2d at 603.

62. *Smith*, 648 F.2d at 603. In vindicating the plaintiff's right to be acknowledged in the film, the court said: "Since actors' fees for pictures, and indeed, their ability to get any work at all, is often based on the drawing power their name may be expected to have at the box office, being accurately credited for films in which they have played would seem to be of critical importance in enabling actors to sell their 'services,' i.e. their performance."

63. *But see Lamothe v. Atl. Recording Co.*, 847 F.2d 1403, 1407 (9th Cir. 1988) (finding express reverse passing off and rejecting the defense that a partially correct attribution is not actionable in a case in which two artists were not credited for their contributions to a rock group's songs).

fashion such as, liberally incorporating ideas, concepts and schemes that are present in the prior work, this circuit draws a line and prohibits recovery for the plaintiff creator.⁶⁴ For example, the plaintiff writer of a television pilot script entered into an option contract with the defendant executive to develop a script into a series for NBC.⁶⁵ However, the network declined to produce the project and the defendant later commenced work at another company, where he wrote a “television series treatment”⁶⁶ similar to plaintiff’s, which was ultimately broadcast. While the court found substantial similarity between the two works for copyright infringement purposes, it declined to support the original creator’s § 43 (a) claim, reasoning that the likelihood that the two scripts would be confused was minimal.⁶⁷

The *Shaw* case further elucidated the application of §43 (a) by underscoring the *limited* purpose of the Lanham Act.⁶⁸ By implication of the holding, it should also be understood that § 43 (a) does not intrinsically recognize the right of attribution. A cause of action under this section only arises when certain statutory triggers are present. One commentator further explains that a “plaintiff may recover if defendant’s false statement of origin or fact is (i) ‘likely to cause confusion, or to cause mistake, or to deceive’ (ii) concerning either “the affiliation, connection or association of defendant ‘with another person, or as to the origin, sponsorship, or approval’ of a defendant’s product by another person.”⁶⁹ It is the second part that cannot be satisfied in

64. See Lori H. Freedman, *Reverse Passing Off: A Great Deal of Confusion*, 83 TRADEMARK REP. 305, 316 (1993) (explaining the reluctance of Ninth Circuit courts in extending the doctrine of reverse passing off to factual scenarios where the reverse passing off claim is in close juxtaposition with a copyright infringement claim). See also *Cleary*, 30 F.3d at 1261 (suggesting that the substantial similarity test does not sufficiently ensure the requisite likelihood of consumer confusion).

65. *Shaw*, 919 F.2d at 1355

66. *Id.* at 1355.

67. *Id.* at 1364.

68. *Bull Publ'g*, 13 U.S.P.Q.2d at 1683. Plaintiff creators are manipulating § 43 (a) to vindicate copyright claims, thus obviating this provision’s core purpose of protecting against consumer confusion: “[T]he real harm alleged is the use of protected work without permission rather than the potential confusion caused by the placing of defendants’ copyright notice on the publication containing plaintiff’s text.”

69. *Giving Credit where Credit Is Due*, *supra* note 47, at 739 (quoting § 43(a) (1) (A) of the Lanham Act).

cases where misattribution occurs.⁷⁰ Additionally, *Shaw* demonstrates the overlap between the analysis of substantial similarity as it applies in the copyright context and as it applies to a § 43 (a) claim for false designation of authorial origin. As will be discussed in the next subsection, the questions asked when administering the substantial similarity test under § 43 are the same as those asked when copyright infringement on the basis of substantial similarity is at bar. This redundancy is judicially wasteful, because it provides the plaintiff creator with another bite at the apple when his or her copyright claim fails.

B. The Substantial Similarity Test

The Second Circuit implements this test in evaluating creators' right of attribution claims. *Waldman Publishing Corp. v. Landoll, Inc.* is the seminal case in which the plaintiff publisher of a line of children's books adapted from classic literary works that existed in the public domain brought suit against a defendant publisher of competing children's books that contained adaptations of the same works that were stylistically comparable to plaintiff publisher's books.⁷¹ Waldman did not originally bring a cause of action for copyright infringement because at the time that it sought preliminary injunctive relief, it had not registered its copyright.⁷² In vindicating plaintiff publisher's § 43 (a) claim, the court explained that because the later work is substantially similar⁷³ to plaintiff's work, a false designation of

70. "A defendant who engages in reverse passing off in no way suggests that it is in any way affiliated, connected, or associated with plaintiff, or that its product originates from or is sponsored or approved by plaintiff. To the contrary, defendant has intentionally omitted any reference to the plaintiff." *Id.* at 739.

It should be noted that while Cross rejects § 43 (a) as supportive of a cause of action for reverse passing off, he does recognize that artists should be granted a limited cause of action for reverse passing off, but that this should occur under the framework of copyright law. *Id.* at 766.

71. 43 F.3d 775, 778-779 (2 Cir. 1994).

72. *Id.* at 778 n.1. Waldman and the distributor of its works amended their complaint later in the litigation. The absence of a registered copyright in the first instance lends further support to the argument that plaintiffs are implementing § 43 (a) so as to effect a copyright-like remedy. *See supra* note 52.

73. *See Waldman*, 43 F.3d at 781-782 (explaining that the close similarities between plaintiff's and defendant's books with respect to their abridgment, simplification and illustrations were enough for this court to uphold the

authorial⁷⁴ origin was substantiated. The court borrowed the standard used to prove copyright infringement and asked whether the defendant had access to the work and whether the material in the later work was so closely patterned upon the prior work as to constitute copying.⁷⁵ By answering in the affirmative to both questions, the *Waldman* court expanded the scope § 43 (a), reading into this provision a cause of action for failing to give credit to a prior creator.⁷⁶ Furthermore, its holding untied § 43 (a) from its traditional moorings by stripping proof of consumer confusion of its status as the sine qua non of a reverse passing off cause of action.⁷⁷ These problems are brought to the forefront by the circuit courts implementing the substantial similarity

district court's assessment that "[t]he Landoll adaptations are copies of the Waldman adaptations, with minimal changes intended to disguise the copying." (quoting *Waldman*, 848 F.Supp. 498, 502-503 (S.D.N.Y. 1994)). It should also be noted that the Court of Appeals specifically rejected the bodily appropriation test in its analysis, viewing it as too rigid. *Id.* at 784.

74. "False designation of origin, as applied to written work, deals with false designation of the creator of the work; the 'origin' of the work is its author." *Id.* at 783.

75. *Id.*

76. "The Lanham Act prohibits not only...the relabeling of a printed work, as by tearing the cover off a book and selling it with a false cover, but also the reproduction of a work with a false misrepresentation as to its creator. The misappropriation is of the artistic talent required to create the work. . .Through a Lanham Act action, an author may ensure that his or her name is associated with a work when the work is used." *Waldman*, 43 F.3d at 781. It is crucial to realize that prior to *Waldman*, the Second Circuit held that the defendant's use of false copyright notice was insufficient to constitute false designation of origin. See *Kregos v. Associated Press*, 937 F.2d 700, 710-711 (2^d Cir. 1991); See also, *Merchant v. Lymon*, 828 F.Supp. 1048, 1060 (S.D.N.Y. 1993). In *Kregos*, the court rejected the claim that the defendants violated § 43 (a) by copying a form created by plaintiff and subsequently publishing it with their copyright notice. 937 F.2d at 7711. The court found that plaintiff's claim was nothing but a masked copyright claim and declared that it "would reject his attempt to convert all copyright claims into Lanham Act violations." *Kregos*, 937 F.2d at 711.

77. *Waldman*, 43 F.3d at 784. Consumer confusion is presented as a foregone conclusion in this case. All that is said on the matter is that: "consumers are likely to be confused by Landoll's misrepresentation as to the source of its books, even though the Landoll books are 'substantially similar' to but not 'bodily appropriations' of the Waldman books." ; See also *Caught in the Crossfire*, *supra* note 16, at 1013 (Kwall appears to dispense with the requirement of proving consumer confusion, or at the very least of demonstrating a likelihood of confusion in § 43 (a) cases, explaining that "it is simply natural for people to assume that the purported copyright owner is the same entity as the creator, originator, or owner of the work"). (emphasis added)

test.⁷⁸ Basically, the markers for determining liability are devised in an ad hoc manner, without close attention being paid to the statutory language and legislative purpose of the Lanham Act. Courts sometimes chafed at the redundancy created by implementing § 43 (a) to vindicate copyright-like claims have developed new-fangled approaches to deal with the problem.

C. The “Extra Element” Approach

In *Lipton v. The Nature Co.*, the Second Circuit reined in the substantial similarity test by indicating that something beyond a false copyright notice affixed to a work must be proven in order for liability based upon § 43 (a) to be effectively substantiated.⁷⁹ As supported by other courts, there must be an “extra element”⁸⁰ that sets apart the claim from the copyright context. A New York court stood by this nebulous test in *Weber v. Geffen Records, Inc.*⁸¹, when a former band mate sued the other members of his rock group, Guns N’ Roses, for failing to give him co-authorship credit for two of their copyrighted songs. In holding against the plaintiff, the court explained that for §43 (a) to apply in such a factual context, “an author must make a greater showing that the designation of origin was false, was harmful and stemmed from ‘some affirmative act whereby [defendant] falsely represented itself as the owner.’⁸²” But for a few examples that are sometimes factually inapposite⁸³ with the claim of authorial misattribution, what exactly this affirmative showing entails is too

78. *Caught in the Crossfire*, *supra* note 16, at 1007-1008. The author acknowledges that both courts in the Second Circuit and beyond have applied the substantial similarity test and in doing so have “reveal[ed] inconsistencies and difficulties in the application of this theory.”

79. 71 F.3d 464, 473 (2^d Cir. 1995).

80. *See, e.g.* *Dahlen v. Michigan Licensed Beverage Ass’n*, 132 F.Supp.2d 574, 590 (E.D.Mi. 2001).

81. 63 F.Supp.2d 458, 460 (S.D.N.Y. 1999).

82. *Id.* at 463 (citing *Lipton*, 71 F.3d at 473-474, which quotes *Cognotec Servs., Ltd. v. Morgan Guar. Trust Co.*, 862 F.Supp. 45, 51 (S.D.N.Y. 1994)); *See also, Caught in the Crossfire*, *supra* note 16, at 1014 (proposing that the requisite extra element is demonstrated when the “defendant falsely implies that he is the originator, creator, or owner of the copyrighted work”).

83. *See, e.g. Lipton*, 71 F.3d at 473-474 (citing *Eden Toys, Inc. v. Floralee Undergarment Co.*, 697 F.2d 27, 37 (2^d Cir. 1982), a case in which the court substantiated liability under § 43 (a) due to defendant’s false and misleading claim of origin, made when it asserted that its nightshirt was an original design, when it blatantly copied plaintiff’s design).

shrouded in mystery to be of much practical use. As correctly noted by Kwall,⁸⁴ it is problematic for courts to decide what will satisfy the extra element of misrepresentation that is needed for a §43 (a) attribution claim to stand. The courts that occupy this position are apt to fashion their rulings out of whole cloth and fail to cite statutory and legislative authority as support.⁸⁵ This is not judicial discretion run amok; rather, it is a mere symptom of the underlying ailment—the use of § 43 (a) to vindicate the right of attribution in the first place. To further complicate matters, because these cases often come to the bar at preliminary injunction, summary judgment or motion to dismiss stages, it is very difficult to effectively elucidate a plaintiff creator's burden of proof.⁸⁶

D. The Consumer Confusion Approach

All of the tests discussed above require to varying degrees judicial consideration of consumer confusion--- the linchpin of the Lanham Act. However, the approach described in this section travels closer than any other in putting concrete, rational parameters around the application of § 43 (a) to right of attribution cases. Eschewing the verbal niceties of the tests that came before, this analytical framework focuses exclusively on the likelihood of consumer confusion in analyzing an offending work.⁸⁷ Courts in The Fifth, Sixth and Eleventh circuits⁸⁸ all hold that this element must be established in order for a reverse passing off claim to stand.

84. Kwall, *Caught in the Crossfire*, *supra* note 16, at 1010.

85. See *Scholastic*, 124 F.Supp.2d at 845 (making the blanket statement that plaintiff's Lanham Act claim is not duplicative of her copyright claim because she is able to successfully allege "affirmative misrepresentation of trademark ownership" through the plaintiff's "promotion and sale of their various products and services," with a false designation of authorial origin attached thereto); See also *Dahlen*, 132 F.Supp.2d at 590 (substantiating affirmative acts of misrepresentation based solely on defendant's actions: replacing plaintiff's copyright notice with its own logo, asserting that it was responsible for the information contained on the poster, and disseminating the poster to its membership without accrediting the plaintiff creator in any way).

86. Kwall, *Caught in the Crossfire*, *supra* note 16, at 1010.

87. See *Debs v. Meliopoulos*, 1993 WL 566011, at *6 (N.D. Ga. 1991).

88. *Reverse Passing Off and Database Protections*, *supra* note 50, at 486 n. 53.

In *Rosenfeld v. W.B. Saunders*,⁸⁹ the plaintiff claimed that the editor of a medical treatise's third edition failed to properly accredit the author of the treatise's first edition, which had formed the basis of the later editions. Plaintiff's plea for injunctive relief⁹⁰ under § 43 (a) was denied because a likelihood of consumer confusion could not be substantiated.⁹¹ The court reasoned that any modicum of confusion was mitigated because the second edition had appropriately acknowledged the author of the first edition in the preface and dedication.⁹² Also, the holding was justified because the purchasers of the work are members of the medical community, individuals who are sophisticated enough to realize that "a medical treatise by definition typically builds upon previous works in the field."⁹³

The consumer confusion approach was similarly applied in *Archie Comics Publications, Inc. v. DeCarlo*.⁹⁴ In this case, a cartoonist pressed counterclaims in which he argued that his original comic strip of *Sabrina, the Teenage Witch* was being infringed because the publisher portrayed the television and animated cartoon series falsely as being its own creation by means of broadcasting the shows with a credit line stating, "Based on Characters Appearing in Archie Comics."⁹⁵ The court ruled against the cartoonist and reasoned that "any attribution required under the Lanham Act arises out of source confusion"⁹⁶ and not out of the duty to accredit his creative labor as an author, as DeCarlo argued. Because the credit line at issue in this case does not misrepresent the origin of the characters contained in the programs, there is no likelihood that viewers will be confused.⁹⁷ Building on the reasoning of *Archie Comic Publications*, the *Debs v. Meliopolous* court extended the likelihood of consumer confusion

89. 15 U.S.P.Q.2d (BNA) 1423, 1425 (S.D.N.Y. 1990).

90. *Id.* at 1427 n.2. It should be noted that a finding of actual consumer confusion is needed in order to substantiate the claim for injunctive relief.; See also *Debs*, 1993 WL 566011, at *15.

91. *Rosenfeld*, 15 U.S.P.Q.2d at 1428.

92. *Id.*

93. *Id.* at 1429.

94. 141 F.Supp.2d 428 (S.D.N.Y. 2001).

95. *Id.* at 430.

96. *Id.* at 434.

97. "It simply (and truthfully) states that the characters, whoever created them, appear in Archie comics." *Id.*

analysis by applying the multi-pronged test⁹⁸ that forms the backbone of the traditional judicial resolution of trademark claims under § 43 (a). Although this test is widely known in the field of trademarks, its application is strained here, because a claim that would typically arise in the context of copyright was at issue in *Debs*⁹⁹. Once again, this is a case of a copyright claim dressing up in the costume of trademarks.¹⁰⁰

Although the consumer confusion approach is relatively straightforward and lacks overt, self-serving manipulations of the language in §43 (a), it still falls short of the mark in the analysis of right of attribution claims. This is because this line of cases, as well as those discussed in subsections A through C, are buttressed by an underlying premise that has been unequivocally¹⁰¹ rejected by the United States Supreme Court in *Dastar*— that the “origin” of a work under the Lanham Act refers to its artistic creator.¹⁰² This misconstrued interpretation of origin circumvents copyright¹⁰³ and hearkens back to the sweat of the brow doctrine. Progress in the law of intellectual

98. “At least seven factors should be considered: (1) the distinctiveness of the plaintiff’s goods; (2) the degree of similarity between plaintiff’s and defendant’s goods; (3) the similarity between plaintiff’s and defendant’s services; (4) the similarity between plaintiff’s and defendant’s outlets for businesses and customers; (5) the similarity between plaintiff’s and defendant’s advertising; (6) whether defendant intended that purchasers would confuse its goods with plaintiff’s goods; and (7) whether consumers were actually confused by the similarity.” *Debs* 1993 WL 566011, at *13 (construing *Jellibears, Inc. v. Skating Clubs of Georgia, Inc.*, 716 F.2d 833, 840 (11th Cir. 1983)).

99. See the discussion of the factual context of *Debs* at *infra* Part IV.A.

100. See *Brief of Amici Curiae*, *supra* note 46, *5-*6 for the proposition that (Congress has not legislated the use of the Lanham Act to extend copyright protection).

101. By a margin of 8-0. *Dastar*, 123 S. Ct. at 2043. It should be noted that Justice Breyer took no part in the consideration or decision of the case.

102. See discussion *infra* Part IV.C.

103. It has also been argued that unfair competition claims that are legally structured outside the ambit of copyright law violate § 301 (a) of the Copyright Act, which states that “all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright. . . are governed exclusively by this title.” See, e.g. *Hoffheinz v. AMC Productions, Inc.*, 147 F. Supp. 2d 127, 135-136 (E.D.N.Y. 2001). This argument must be taken with a grain of salt because preemption is usually discussed in the context of the supremacy over state law claim. See also *LaCour v. Time Warner, Inc.*, 2000 WL 688946 at *3 (N.D.Ill. 2000) (stating that “the question of whether one federal law takes precedence over another does not implicate the Supremacy Clause”).

property cannot be achieved if this ill-conceived doctrine continues to hold influence.

IV. JUDICIAL INDECISION IS BANISHED IN *DASTAR V. TWENTIETH CENTURY FOX*

A. Last Straws

Before an analysis of *Dastar* is conducted, it is useful to examine a few “breaking point” cases that very likely precipitated the curtailment of section 43 (a)’s applicability to cases involving intellectual property.¹⁰⁴ These are cases where plaintiffs use § 43 (a) as a primary source from which attribution rights flow rather than implementing it as a secondary¹⁰⁵ litigative device. *Dodd v. Fort Smith Special School District*¹⁰⁶ is a useful case in point. In *Dodd*, a junior high school teacher, Mrs. Dodd, along with members of her class, authored a book regarding the life of a local World War II hero.¹⁰⁷ After a funding problem occurred, the uncopyrighted manuscript was physically circulated in order to gain additional financial backing.¹⁰⁸ The book was then substantially changed in format and enhanced, while portions of it were “lifted”¹⁰⁹ from the manuscript. Mrs. Dodd and her students sued the school district for lack of proper authorship accreditation.¹¹⁰ The court granted preliminary injunctive relief, finding that there was consumer confusion since potential purchasers would believe that the incorrect name on the book, Mrs. Farrar,¹¹¹ was the actual author. In so finding, the court never discussed, nor was troubled by the lack of a copyright registration. Here, the Lanham Act

104. The case law discussed in Part III. A-D is largely made inapplicable by *Dastar*, as reverse passing off is held to apply in only very limited circumstances. See *infra* Part V.A.

105. Tony Mauro, *No Copyright? No Credit Court Rules: High Court Says Lanham Act Doesn't Require Copiers to Acknowledge Creators of Works Now in the Public Domain*, 26 LEGAL TIMES 23 at, 12 (June. 9, 2003) [hereinafter *No Copyright?*] (explaining that the Lanham Act was just a part of the arsenal of legal weapons used by copyright owners against infringers).

106. 666 F. Supp. 1278 (W.D.Ark. 1987).

107. *Id.* at 1280.

108. *Id.* at 1281.

109. *Id.*

110. *Dodd*, 666 F. Supp. at 1282.

111. *Id.* at 1285.

is being used as a means to gain a copyright-like remedy and once again, consumer confusion is presented as a foregone conclusion.¹¹² According to the *Dodd* court, any author whose work is published without his name has a viable Lanham Act cause of action.¹¹³

Another case in which the Lanham Act is ripped from its traditional context and made to sustain a generalized right of authorial attribution is *Debs v. Meliopolous*.¹¹⁴ In *Debs*, one professor of electrical engineering sued another for using and distributing his uncopyrighted class notes, thus passing them off as a product of his own unique conception. The plaintiff professor also took umbrage at the fact that in an article defendant authored, he referred to himself as the creator and developer of a certain course in the field, thereby implicitly denying the ground-laying work that plaintiff had earlier completed in the same scholarly area.¹¹⁵ In this case, although the plaintiff lost on the merits due to a finding of the lack of consumer confusion,¹¹⁶ the court sustains the theory that an independent § 43 (a) cause of action is potentially viable. Once again, the law of unfair competition is painted with broad brushstrokes to encompass the right of authorial attribution, a moral right that forms part of the black letter law already addressed in the Copyright Act, albeit in a limited fashion.¹¹⁷

The United States Supreme Court's opinion in *Dastar* presents the closing of the back door to relief previously allowed by the Lanham Act. As noted by Professor Quinn, *Dastar* reaffirms the perspective that "trademark law cannot be used as a subterfuge to extend the limited exclusivity enjoyed by copyright."¹¹⁸ Moreover, *Dastar* is a vital case because it radically departs from case law propounded in the divided circuits, making it clear that section 43 (a) should not be used to vindicate artists' moral rights.

112. See *supra* note 47.

113. 666 F. Supp.at 1285 (citing M. NIMMER, NIMMER ON COPYRIGHT § 8.21(e)).

114. 1993 WL 566011, at *1-*2 (N.D.Ga. 1991).

115. *Id.* at *3.

116. *Id.* at *15.

117. See *supra* note 11 and accompanying text.

118. Eugene Quinn, *Dastar v. Fox: Public Domain Wins in the US Supreme Court*, THE JURIST, <http://www.jurist.law.pitt.edu/forum/forumnew112.php> (last visited Oct.10, 2003) [hereinafter *Public Domain Wins*].

B. Dastar: Factual Background and Procedural History

The factual foundation for *Dastar* was laid in 1948 when then General Eisenhower completed *Crusade in Europe*, his memoirs of the allied campaign in World War II.¹¹⁹ In 1948, Twentieth Century Fox (hereinafter “Fox”) acquired the exclusive television rights in the books from publisher, Doubleday.¹²⁰ Fox produced a television series based on the work, also entitled *Crusade in Europe* (hereinafter “*Crusade*”).¹²¹ Doubleday properly renewed its copyright in the book, while Fox failed to do the same for the television series, and as a result, the latter piece fell into the public domain in 1977.¹²² In 1995, Dastar released a videocassette for commercial distribution entitled *World War II Campaigns in Europe* (hereinafter “*Campaigns*”).¹²³ Seeking to capitalize on the fiftieth anniversary of the war’s end, Dastar purchased the tapes of the original version of the *Crusade* television series, copied them and then edited the series.¹²⁴ *Campaigns* was approximately half the length of *Crusade* and was formatted with new title sequences and chapter headings.¹²⁵ Dastar removed all references to the television series as well as to Eisenhower’s book, exclusively crediting its own employees as being responsible for producing the video.¹²⁶

Fox’s suit against Dastar was two-pronged.¹²⁷ It first claimed that selling the video infringed Doubleday’s copyright in Eisenhower’s book, thus impinging on its exclusive television rights in the book, and then amended their pleadings to add their second claim that sale without proper attribution constitutes reverse passing off under § 43 (a).¹²⁸ The district court ultimately found for the respondents, awarding them Dastar’s profits and doubling them as allowed by § 35 of the Lanham Act.¹²⁹ The Court of Appeals for the Ninth Circuit affirmed

119. 123 S.Ct. at 2044.

120. *Id.*

121. *Id.*; It should be also noted that Fox hired Time, Inc. to film and produce the series, but that Time, Inc. assigned its copyright in the series to Fox and was thus not a party to the suit. *Id.*

122. *Dastar*, 123 S.Ct. at 2044.

123. *Id.*

124. *Id.*

125. *Id.*

126. *Dastar*, 123 S.Ct. at 2044.

127. *Id.*

128. *Id.* at 2044-2045.

129. *Id.* at 2045; See also, Madhavi Sunder, *In a Trademark Case, Supreme*

the judgment for respondents on the Lanham Act claim, but reversed and remanded as to the copyright claim.¹³⁰ The Court explained that Dastar bodily appropriated Fox's original television series in creating its video and that this substantiated a finding of liability for Fox's false designation of origin claim.¹³¹ The Court also affirmed the judgment as to the enhanced damages. The United States Supreme Court granted certiorari in order to resolve the dispute.¹³²

C. Discerning the Meaning of "Origin" in Copyright and Trademark Contexts

Justice Scalia, who wrote the *Dastar* opinion on behalf of a unanimous¹³³ United States Supreme Court, examined the meaning of "origin"¹³⁴ in § 43 (a) (1) (A) to decide whether or not this often-manipulated term encompasses the creative source of a work. The Court found "that the most natural understanding of the 'origin' of 'goods' . . . is the producer of the tangible product sold in the marketplace, in this case the physical Campaigns videotape sold by Dastar."¹³⁵ In so ruling, the Court emphasized the fundamental distinctions¹³⁶ between copyright and trademark law and the importance of prohibiting crossbreeding¹³⁷ between the two.

Court Recognizes that Art Flows from Multiple Sources, <http://writ.news.findlaw.com/commentary/20030612sunder.html>, (last visited Aug. 31, 2003) [hereinafter *Art Flows From Multiple Sources*] (explaining that Fox won a \$1.5 million verdict in the lower courts).

130. *Art Flows From Multiple Sources*, *supra* note 129.

131. *Dastar*, 123 S.Ct. at 2045 (citing Fed.Appx. 312, 316 (2002)).

132. *Id.* at 2045.

133. *See supra* note 101.

134. *See supra*, text of § 43 (a) (1) quoted at note 14; *See also Dastar*, 123 S.Ct. at 2046 (readily conceding that origin should not be limited to a geographic context, but also encompasses 'origin of source or manufacture' (quoting *Federal-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 408 (6th Cir. 1963)); *See also* Michael S. Denniston, *Residual Good Will in Unused Marks: The Case against Abandonment*, 90 TRADEMARK REP. 615, 620 (July-August 2000) (explaining that most courts view protection of the public from deception as to the source of origin of goods and services as the most important policy advanced by the Lanham Act).

135. *Id.* at 2047; *See also id.* at 2050 (holding that "the origin of goods" does not refer to "the author of any idea, concept, or communication embodied in those goods").

136. *See Art Flows from Multiple Sources*, *supra* note 129.

137. *Dastar*, 123 S.Ct. at 2048 (explaining that upholding Fox's position would result in a "species of mutant copyright law").

According to Justice Scalia's rationale, the right of attribution should remain within the ambit of copyright law, separate and apart from the field of trademark law, which is unique because it focuses on preventing consumer confusion.¹³⁸ He explained that while copyright laws were created to protect originality and creativity, the Lanham Act was not.¹³⁹ Pursuing this logical strain, he underscored the notion that the Lanham Act should not be construed as a judicial panacea for all variations of what is considered to be unfair competition.¹⁴⁰ The black and white of the matter was that consumers were not misled because Dastar made a bona fide designation of origin by crediting itself as the videotape's producer—it cannot be denied that the company revised the original *Crusade in Europe* piece in some manner.¹⁴¹ Scalia acknowledged that the outcome of case would have been different if Dastar had purchased *Crusade in Europe* and repackaged and sold it as its own, without changing it.¹⁴² Dastar was perfectly within its rights here because it took a work that had indisputably lapsed into the public domain and incorporated parts of it into *its own* subsequent piece.¹⁴³ Legal authority, in terms of copyright law,¹⁴⁴ would be undermined by recognizing a right of attribution under § 43 (a) (1) (A). Doing so would essentially be akin to readjusting the limitations applied to copyright law *without* the legislature's consent.¹⁴⁵ Furthermore, it should be

138. See *Art Flows from Multiple Sources*, *supra* note 129.

139. *Dastar*, 123 S.Ct. at 2050.

140. *Id.* at 2045 (citing *Alfred Dunhill, Ltd. v. Interstate Cigar Co.*, 499 F.2d 232, 237 (2d. Cir. 1974)); See also *Public Domain Wins in the US Supreme Court*, *supra* note 118 (explaining that "the Lanham Act was never intended to have boundless application as a remedy for all trade practices that may seem unfair. The Supreme Court reiterated that the Act must be limited to its terms and cannot be stretched and pulled in a way that allows it to become an omnibus statute to rid the United States of everything considered 'unfair'").

141. *Public Domain Wins in US Supreme Court*, *supra* note 118.

142. *Dastar*, 123 S.Ct. at 2049. This would have been an example of traditional reverse passing off. See explanation and examples *supra* pp. 9-10.

143. *Id.* at 2048 (noting that "once [a] . . . copyright monopoly has expired, the public may use the . . . work at will and without attribution.").

144. See *Dastar* 123 S.Ct. at 2050 (explaining that to hold for Fox "would be akin to finding that § 43 (a) created a species of perpetual copyright, which Congress may not do."); See also *Art Flows From Multiple Sources*, *supra* note 129; Janet Fries and Michael J. Remington, *Who Remembers the Name? Authors' Rights in Flux after Dastar Ruling*, 26 LEGAL TIMES 29, 30 (Jul. 21, 2003) [hereinafter *Authors' Rights in Flux*] (noting that the case negated a right of attribution for works whose copyright had expired).

145. There are those who would argue that *Dastar* stands in opposition to

recognized that when Congress has sought to create a right of attribution it has done so through black letter law such as in VARA; consequently, it is a futile exercise for plaintiff creators to seek credit for their work in § 43 (a).¹⁴⁶

Dastar is also important because it underscored the practical complexities that arise when superimposing the meaning of authorial creation upon the concept of origin. Justice Scalia insightfully noted that an artistic work is a product of creative synergy and that pinpointing the individuals responsible for creating it is an unnecessary, laborious task.¹⁴⁷ Moreover, if origin was made to encompass the right of authorial attribution, manufacturers of the artistic products would still be caught between a proverbial rock and a hard place.¹⁴⁸ If they failed to credit the creators of the work on which their copies were based, they would be liable under § 43 (a); however, if they did properly attribute authorial origin, they could face liability because doing this may imply the prior creator's "sponsorship or approval"¹⁴⁹ of the later-conceived work.

Finally, Justice Scalia argued that "reading § 43 (a). . . as creating a cause of action for, in effect, plagiarism—the use of

Eldred v. Ashcroft, 537 U.S. 186 (2003). This was a case in which the Court readily approved the extensions of the waning time restrictions allotted to copyrighted works. See, e.g., *No Copyright?*, *supra* note 105 (construing *Eldred*). Despite commentary indicating that these two cases are disparate, it must be understood that *Eldred* approves the curtailing of the public domain through the appropriate authoritative body — the legislature. See, e.g., John P. Halfpenny and James L. Griffith, *Supreme Court Expands the Rights of Copyright Holders*, 6 DEL. L. WKLY. 23, at 5 (Jun. 11, 2003) (noting that despite the paradoxical appearance of both cases, there are actually "striking consistencies" between the two opinions and that *Eldred* may be read as setting the stage for *Dastar*); See also *Brief of Amici Curiae*, *supra* note 52, at 2002 WL 32101078, at *8 (explaining how granting certiorari in *Dastar* would assist the Court in resolving *Eldred*).

146. See *Dastar*, 123 S.Ct. at 2048; See *Giving Credit Where Credit is Due*, *supra* note 47, at 760.

147. "The footage came from the United States Army, Navy, and Coast Guard, the British Ministry of Information and War Office, the National Film Board of Canada, and unidentified 'Newsreel Pool Cameramen.' If anyone has a claim to being the *original* creator of the material used in both the Crusade television series and the Campaigns videotape, it would be those groups. . . We do not think the Lanham Act requires this search for the *source of the Nile and all its tributaries*." *Dastar*, 123 S.Ct. at 2049 (emphasis added).

148. *Id.* at 2049.

149. *Id.* at 2049 (citing 15 U.S.C. §1125 (a) (1) (A)).

otherwise unprotected works and inventions without attribution”¹⁵⁰ would squarely contradict the Court’s prior rulings. He explained that the Court generally disfavored end runs around the Patent and Copyright Acts by means of using the Lanham Act.¹⁵¹ Justice Scalia specifically addressed the distinctions between patent and trademark law in three polestars of intellectual property law: *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, *Bonito Boats v. Thunder Craft Boats, Inc.*, and *TrafFix Devices, Inc. v. Marketing Displays, Inc.*¹⁵² He underscored the notion that copying is often an essential and legally sanctioned part of competition, pointing to the reality that “legally protected zones of exclusive rights, such as patents, trademarks and copyrights, are *exceptions* to a general rule of free copying and imitation.”¹⁵³ In *Wal-mart Stores, Inc.*, Wal-Mart produced cheaper versions of children’s clothing designed and manufactured by Samara Brothers, only marginally altering the original designs.¹⁵⁴ The Court held that the designs could not be protected under § 43 (a) based on the theory that Samara was their originator.¹⁵⁵ The Court applied a similar rationale in *Bonito Boats*, when it refused to hold the defendant liable for duplicating the plaintiff’s unpatented boat hulls without giving the company credit for its copied design.¹⁵⁶ Lastly, in *TrafFix*, the Court rejected the plaintiff’s claim of unattributed copying of his functional design for flexible road signs.¹⁵⁷ Justice Scalia rightly expressed the view that concepts of origin that inhere in trademark law should not be extended into the mutually exclusive areas of patent and copyright.

V. THE POST-DASTAR ANALYSIS: QUESTIONS ANSWERED AND

150. *Id.* at 2049.

151. David A. Gerber, *Copyright Reigns Supreme: Notes on Dastar Corp v. Twentieth Century Fox Film Corp.*, 93 Trademark Rep. 1029, 1032 (September-October 2003).

152. *Dastar*, 123 S.Ct. at 2049-2050; *See also* Bohrer, *Strengthening the Distinction between Copyright and Trademark: The Supreme Court takes a Stand*, 2003 Duke L. & Tech. Rev. 23, n. 47-48.

153. Bohrer, *supra* note 152, 23, n.48 (quoting J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §1:2 (4th ed. 2003) (emphasis added)).

154. *Dastar*, 123 S.Ct. at 2049 (explaining *Wal-Mart*, 529 U.S. 205, 208, 120 S.Ct. 1339).

155. *Id.* at 2049 (citing *Wal-Mart*, 529 U.S. at 214, 120 S.Ct. at 1339).

156. *Id.* at 2050 (citing *Bonito Boats*, 489 U.S. 141, 109 S.Ct. 971).

157. *Id.* at 2050 (citing *TrafFix*, 532 U.S. 23, 121 S.Ct. 1255).

QUESTIONS LEFT OPEN

A. Narrowing the Scope of Reverse Passing Off

In the context of artistic works, *Dastar* drastically changed the applicability of reverse passing off by expressly negating a cause of action for “false claims of authorship, invention or creation.”¹⁵⁸ This means that the cases cited in Part II are largely relegated to the trash bin.¹⁵⁹ It should be noted that reverse passing off is still viable as a legal theory under § 43 (a) (1) (A) however, origin is interpreted in a very utilitarian way as the origin of tangible goods and *not* as involving the origin of the creative content of intellectual property.¹⁶⁰

A recent case highlights the circumstances under which § 43 (a) (A) (1) may still survive despite the restrictions imposed by *Dastar*. In *Carroll v. Kahn*, a film producer sued the filmmakers and managers of a film festival for allegedly appropriating a film that he had co-authored and for failing to provide him with credit.¹⁶¹ Citing *Dastar*, the court ruled that the plaintiff’s Lanham Act claim was insupportable because the copyright laws best addressed “the protection [of] the creative talent behind communicative products.”¹⁶² However, the court did recognize that, depending on the proofs submitted, the defendant might be held liable for physically repackaging the plaintiff’s film and then disseminating it as his own.¹⁶³ This case squarely recognized *Dastar*’s invalidation of a putative plaintiff creator’s moral rights claim that a defendant was taking a free ride on his or her prior work. As recently noted by Judge Posner in the related field of misappropriation, the free-riding concept that undergirds the common law of misappropriation has very limited utility in the realm of intellectual property because it

158. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:77.1 (2003).

159. See, e.g., *Williams v. UMG Recordings*, 281 F.Supp.2d 1177, 1184 n.10 (U.S.D.C. for C.A. Ca. 2003) (explaining that the Ninth Circuit cases cited by plaintiff creator would be “overruled to the extent that they find a reverse passing off claim based on the failure to credit the author of any idea, concept or communication embodied in tangible goods”).

160. *Id.*

161. 2003 WL 22327299 at *1 (N.D.N.Y. 2003). It should be further noted that plaintiff’s copyright claim was defective because a copyright suit cannot be sustained against a co-owner. *Id.* at *4.

162. *Id.* at *6 (construing *Dastar*, 123 S.Ct. at 2050).

163. *Id.* at *5-*6.

impedes progress.¹⁶⁴ It cannot be denied that copying from a rich and diversified public domain promotes economic efficiency through competition.¹⁶⁵

Another recent case emphasized the proper scope of reverse passing off in a post-*Dastar* world. In *Keane v. Fox Television Station*, the plaintiff argued that the defendant stole his concept for the popular television series, *American Idol*, and aired it without proper accreditation.¹⁶⁶ The court struck his § 43 (a) claim on the basis of *Dastar*, explaining that this section was intended to protect against consumer confusion in a commercial content and it was not designed to address accreditation issues.¹⁶⁷ This case is particularly relevant because it underscored an important notion that has been given short shrift by the circuit courts cited in Part II—the issue of consumer confusion is married to the predicate of *asserting a trademark* in a good or service and consumer confusion should not be injected into the analysis of a copyright-based¹⁶⁸ claim. The court in *Keane* thoroughly analyzed the plaintiff's claim in terms of trademark law, thus bringing § 43 (a) back to its originally intended focus.¹⁶⁹

A final issue to consider regarding the continued viability of reverse passing off is that *Dastar*'s holding does not extend to claims that are predicated on the grounds of false advertising—43 (a) (1)(B) claims.¹⁷⁰ Justice Scalia explained that if a producer of a video that

164. Richard A. Posner, *Misappropriation: A Dirge*, 40 HOUSTON L. REV. 621, 625 (2003) (explaining that unauthorized copying of works is an efficient means of fostering productivity). See *id.* at 639 (explaining how *Dastar* casts doubt on the proposition that one can secure credit for being the first to offer a new product or service).

165. *Id.* at 624-625. In considering the public domain, it should also be noted that the *Dastar* ruling also applies to copyrighted works. Note that this may not be of much practical significance, since a plaintiff with a properly copyrighted work may seek direct relief under the Copyright Act. See 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:77.1 (2003). See also *Williams v. UMG Recordings, Inc.*, 281F. Supp.2d at 1185.

166. Case name 2004 WL 95758 at *4 (S.D. Tex. 2004).

167. *Id.* at *9 (construing *Dastar*, 123 S.Ct. at 2047).

168. It should be noted that in *Keane*, the plaintiff amended his complaint to remove the copyright infringement claim because he never produced a copyright certification for his *alleged* television show treatment. *Id.* at *4.

169. See *Id.* At *10-*11.

170. See 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:77.1 (4th Ed. 2003). See also text of § 43 (a) (1) (B), *supra* at note 14.

substantially copied Fox's Crusade series were, in advertising or promotion, to give consumers the impression that the video was considerably different from that series, then Fox might have a claim for false advertising for misrepresenting the nature, characteristics or qualities of the original substance of the product in violation of § 43 (a) (1) (B).¹⁷¹ This type of claim was recently advanced in *Tao of Systems Integration, Inc. v. Analytical Services & Materials, Inc.*¹⁷² In this case, the plaintiff was a provider of aeronautical engineering services and it sued its competitor for allegedly misrepresenting to the National Aeronautics and Space Administration (NASA) that it owned intellectual property and specific proficiency that actually belonged to the plaintiff.¹⁷³ Although it dismissed the attribution claim under § 43 (a) (1) (A), the court explained that a colorable claim for false advertising under § 43 (a) (1) (B) was presented.¹⁷⁴ This holding affects plaintiff creators in that, at least theoretically, they have an open avenue of relief with respect to reverse passing off claims. Unfortunately, how effective their claims will be depends on the extent to which their material has been used in commercial advertising.¹⁷⁵

B. The Right of Integrity as a Possible Loophole?

Despite the curtailing of the reverse passing off action, plaintiff creators may still be able to vindicate moral rights, albeit in a different area. *Dastar* does not address what is known as the "right of integrity"¹⁷⁶ in intellectual property law parlance; consequently, it may have a continued legal life under

171. *Dastar*, 123 S.Ct. at 2050.

172. 2004 WL 51322 (E.D.Va. 2004).

173. *Id.* at *1.

174. *Id.* at *5.

175. *Id.* (explaining the factors that must be met in order for offensive representations to fall within the ambit of 'commercial advertising or promotion'). See also 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:77.1 (4th Ed. 2003) (providing a noteworthy example of how *Dastar* affects the reverse passing off analysis under both § 43 (a) (1) (A) and (B): "If Peter Plagiarist takes a poem written by Lauren Laureate, copies it verbatim, removes the author's name and inserts Peter's own name as author, there is clearly a false statement of authorship. But there is no violation of . . . § 43 (a) (1) (B). And there will not be a violation of § 43 (a) (1) (B) unless, as is doubtful, the purloined poem is used 'in commercial advertising or promotion'").

176. See 106A (a) (3) of the Copyright Act, *supra* note 11.

§ 43 (a). This right prevents the making of distorting, mutilating changes to an artist's work that would be prejudicial to his or her honor or reputation in a professional sense.¹⁷⁷ It is preserved even after title in the work has changed hands.¹⁷⁸ It should be further noted that this right is circumscribed by provisions in VARA such as those indicating that modifications due to the passage of time are not considered to be violations.¹⁷⁹

The legal contours of the right of integrity are notably shaped in *Gilliam v. American Broadcasting Co., Inc.*¹⁸⁰ In this case, the court held that ABC's unauthorized broadcasting of a highly edited¹⁸¹ version of Monty Python skits violated § 43 (a), injuring the artists' right to have the work attributed to them in its unadulterated context.¹⁸² While *Gilliam* appears to broadly endorse the use of the Lanham Act as the basis for a right of integrity action, the restrictions on the precedential value of this case must be noted.¹⁸³ Its own concurrence cautions against invoking § 43 (a) in improper contexts: "[T]he Lanham Act does not deal with artistic integrity. It only goes to misdescription of origin and the like."¹⁸⁴

177. Dana L. Burton, *Artists' Moral Rights: Controversy and the Visual Artists' Rights Act*, 48 SMU L.REV. 639, 643. (Mar.-Apr. 1995).

178. *Carter*, 71 F.3d at 81 (citing RALPH E. LERNER & JUDITH BRESLER, ART LAW 420 (1989)).

179. Burton, *supra* note 177, at 643-644 (explaining that modifications resulting from the intrinsic nature of the materials implemented by the artists do not violate the right of integrity. Moreover, acts resulting from conservation or the public display of a work are sanctioned, unless they are conducted with gross negligence. VARA further provides a set of detailed rules that govern the removal of work that is integrated into the structure of a building).

180. 538 F.2d 14 (2^d Cir. 1976). It should be noted that this case does not specifically invoke the right of integrity, as it occurred before the enactment of VARA in 1990.

181. The editing was done so as to remove several bawdy references, thus presenting the climactic punch-lines outside of their creative context. *See, e.g., id.* at 25 n.12. Commenting on the sterility of the edited piece, the district court judge explained that the truncation caused the program " 'to lose its iconoclastic verve.' " *Id.* at 18.

182. *Id.* at 23-24 (also citing 1 M. NIMMER, COPYRIGHT §110.1).

183. *See A Fictional Work?* *supra* note 19, at 1225.

184. *Gilliam*, 538 F.2d at 26-27 (Gurfein, J., concurring) (suggesting that remedies that are the subject of this case are more appropriately sought under the realm of contract and copyright law).

Furthermore, the outcome of this case is a veritable “anomaly”¹⁸⁵ in intellectual property jurisprudence. In essence, in order for a case to fit into *Gilliam’s* framework, the facts constituting a violation of the right of integrity must be so egregious as to represent an unequivocal case of mutilation.¹⁸⁶ One such rare case in which a § 43 (a) action was substantiated was *Benson v. Paul Winley Record Sales Corp.*¹⁸⁷ Here, the defendant record company re-mixed an internationally-acclaimed jazz guitarist’s album, adding sexually suggestive sounds to it and presenting it as if were a current release authored by the prior artist.¹⁸⁸ The court supported the use of § 43 (a) primarily because the relevant purchasing public would likely get the impression that the artist was *sponsoring or approving* of the musical piece.¹⁸⁹ While this looks like a clear win for plaintiff creators, the facts of this case are “overt and extreme”¹⁹⁰ and this, points to the limited applicability of *Gilliam*.

*Choe v. Fordham University School of Law*¹⁹¹ took a pointed, aggressive stance towards the vindication of the moral right of integrity. In this decision, a student author of a comment in a law review brought suit against the school for allegedly mutilating and distorting the presentation of his work, mainly through typographical errors.¹⁹² The court distinguished *Gilliam*,¹⁹³ explaining that the editing did not so alter Choe’s

185. See *A Fictional Work?*, *supra* note 19, at 1224 n.148 (indicating that *Gilliam* has “yet to be followed”); See also, *United States v. Microsoft Corp.*, 1998 WL 61445 at *16 (D.C. 1998) (indicating that decisions from various jurisdictions considering *Gilliam* have rejected arguments based on moral rights); *But see Gunlicks*, *supra* note 9, at 660 (explaining that the First Circuit has been the only one to hold that § 43 (a) protects the integrity of a work).

186. See *A Fictional Work?*, *supra* note 19, at 1224.

187. 452 F.Supp. 516 (S.D.N.Y. 1978).

188. *Id.* at 517.

189. *Id.* at 518 (expressing concern that “prominent use of Benson’s name and picture on the album and in the advertisements creates the false impression that Benson was responsible for the contents of the album”)

190. See *A Fictional Work?*, *supra* note 19, at 1224. It should also be reiterated that such sponsorship or approval is prohibited by the text of § 43 (a).

191. 920 F. Supp. 44 (S.D.N.Y. 1995).

192. *Id.* at 46.

193. *Id.* at 48.

work as to impinge on its overall integrity. The court also went one step further in stating that “[w]hatever language there may be in . . . *Gilliam* to suggest a federal common law claim for deprivation of an author’s ‘moral rights’ is dictum, and has not generated any claim in this Circuit for almost 20 years.”¹⁹⁴ This insightful language should serve as a realistic checkpoint for those who seek to vindicate their right of integrity. Their legal paths are fraught with jurisprudential roadblocks that are not so easily surpassed.

Despite the judicial adumbrations noted above, because *Dastar* did not *specifically* rule out the use of § 43 (a) for right of integrity claims, lawsuits of this nature are likely to continue. However, summary dismissal of these cases becomes a stronger proposition considering the overall policy concern against injecting moral rights into the Lanham Act— a statute traditionally associated with economic utility.¹⁹⁵ Cold and unfeeling as it may seem, the morals of the marketplace have a limited recognition of the rights of attribution and integrity.

C. The Viability of Moral Rights under the Berne Convention

Dastar raises the inevitable question of whether or not the United States is in violation of the Berne Convention.¹⁹⁶ This treaty was implemented on the premise that there was existing legislation to adequately provide for moral rights protection, including § 43 (a).¹⁹⁷ Hence, no *new* rights were to be recognized by the Berne Convention

194. *Id.* at 49.

195. See *A Fictional Work?*, *supra* note 19, at 1228-1229 (explaining that the prevention of consumer deception in the marketplace is the goal of the Lanham Act not the protection of creativity); See also, Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (May 1999) (criticizing the use of the Lanham Act in ways not related to an economic context). It should also be noted that the same economic focus may be applied to the Copyright Act. See, e.g., *Caught in the Crossfire*, *supra* note 16, at 1033.

196. See Editors Note, *Supreme Court Rules that Distributor of Video Edited Version of Public Domain Television Series Did Not Violate Lanham Act by Failing to Credit Twentieth Century Fox as Series’ Creator*, 25 ENT. L. REP. 1, at 7 (June 2003); See also *Authors’ Rights in Flux*, *supra* note 144.

197. *A Fictional Work?*, *supra* note 19, at 1212-1213 and accompanying n. 76; See also *supra* note 30.

Implementation Act.¹⁹⁸ What the Supreme Court has done in *Dastar* is to clarify the appropriate scope of protection under § 43 (a), narrowing it so as to exclude an author's right of attribution. An initial reading of Article 6 of the Berne Convention indicates that the U.S. is not in compliance with the inalienable and broadly defined rights of attribution and integrity contained therein.¹⁹⁹ The U.S. essentially failed to become a party that would recognize express moral rights;²⁰⁰ however, it hardly tried to hide this fact.²⁰¹

Despite the perceived objectionable behavior of the U.S. in signing Berne, one cannot deny the simple fact that the Berne Convention is not self-executing—it requires enabling legislation so as to bring its provisions into effect.²⁰² While there are those who view this as nothing more than a quaint, creative evasion,²⁰³ this is a sharp-cut reality with which plaintiff creators must contend. Rail as they may against the injustice of this reality, judicial ears should not bend towards their arguments because these are matters best left up to the legislature. A catch-all remedy for aggrieved authors simply may not be fashioned by piecing together a quilt from discrete provisions that reference moral rights.

198. *Id.* at 1212, n.76.

199. *See supra*, Article 6bis at p.2.

200. William Patry, *The United States and International Copyright Law: From Berne to Eldred*, 40 HOUSTON L. REV. 749, 751 (2003).

201. *But see id.* (explaining that the Reagan administration "engaged in the charade of claiming that the United States already had adequate moral rights to permit adherence" to Berne).

202. *See* LINDLEY, ENTERTAINMENT, PUBL. & THE ARTS §11:88 (Database updated June 2003); *See also* Dworkin, *supra* note 7, at 241-242 (the House of Representatives Committee on the Judiciary states that the wording in the Berne Convention Implementation Act of 1988 informs United States courts that adherence to Berne is not, of itself, a basis for bringing suit, citing H.R. Rep. No. 609); Case law also supports the view that Berne requires separate, domestically-conceived legislation in order to make its provisions effective. *See, e.g.*, *Carell v. Shubert Organization, Inc.*, 104 F.Supp.2d 236, 259 (S.D.N.Y. 2000); *See also* *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 195 (S.D.N.Y. 1999); *See also In re AEG Acquisition Corp.*, 127 B.R. 34, 42 (Bkrcty. C.D. Cal. 1991).

203. *See* Carol G. Ludolph and Gary E. Merenstein, *Author's Moral Rights in the United States and the Berne Convention*, 19 STETSON L. REV. 201, 242 (Fall 1989); *See generally*, *A Fictional Work?* *supra* note 19.

VI. POSSIBLE SOLUTIONS IN THE WAKE OF *DASTAR*

Given the recognized limitations of VARA and the prohibitions announced in *Dastar*, the question as to where artists may seek accreditation persists. One suggested solution is the federal enactment of an explicit right of attribution that is non-waivable.²⁰⁴ Considering Justice Scalia's commentary in *Dastar*, the Lanham Act is not a hospitable place for such legislation. One way to accomplish the goal is to amend § 106A of the Copyright Act.²⁰⁵ Congress could expand upon the nebulous reference to the "right to claim authorship" by explaining that this right encompasses the right to bring an action against a defendant who infringes the prior artist's right of attribution by committing reverse passing off.²⁰⁶ As it currently stands, state statutes preserving artists' rights²⁰⁷ generally provide for more expansive protection because they more specifically outline what the right of attribution entails.²⁰⁸ One further step Congress may take is expanding protection to works of media beyond the realm of the visual and graphic arts.²⁰⁹

Although one scholar maintains that these changes to the Copyright Act can be implemented without great difficulty,²¹⁰ the intricacies involved in initiating the change cannot be denied. Pressure from institutional behemoths will undoubtedly be encountered, as occurred when the VARA was being grafted onto the Copyright Act.²¹¹

204. See *Caught in the Crossfire*, *supra* note 16, at 1027-1028; See also Donald Francis Madeo, *Literary Creation and American Copyright Law: Authors' Wishes Hardly Resting in Peace*, 5 HOFSTRA PROP. L.J. 179, 202, 205 (Fall 1992).

205. *Giving Credit Where Credit is Due*, *supra* note 47, at 767.

206. *Id.*

207. Ten states have passed moral rights legislation for visual arts prior to the passage of VARA. See Gunlicks, *supra* note 9, at 645. New York and California have been pioneers in this area; See also Edward J. Damich, *A Comparison of State and Federal Moral Rights Protection: Are Artists Better off After VARA?* 15 HASTINGS COMM. & ENT. L.J. 953, 954 (Summer 1993).

208. See, Damich, *supra* note 207, at 954 (explaining that the state statutes include more extensive protection for the "subrights" that underly an artist's right of attribution). These subrights can be divided into the following categories: (1) the right to claim authorship; (2) the right to disclaim authorship; (3) the right to prevent the use of an author's name in connection with his or her work (this is the right to prevent attribution altogether); (4) the right of anonymity and the (5) right to make use of a pseudonym. *Id.* at 959.

209. *Giving Credit Where Credit is Due*, *supra* note 47, at 767.

210. *Id.* at 772.

211. See, e.g. *Hearings on S.1253 Before the Subcommittee on Patents, Copyrights*

Moreover, various artists' interest groups would undoubtedly face opposition from other industries²¹² and would have to coordinate their efforts in order to be heard. The Volunteer Lawyers for the Arts (VLA) would be a good vehicle through which support could be garnered.²¹³ Long-established organizations such as the Writers' Guild, the Authors' Guild²¹⁴ and the National Writer's Union²¹⁵ also have strong interests in bolstering the authorial right of attribution. Effecting change through lobbying will undoubtedly be a slow and arduous process, but it has

& Trademarks of the Committee on the Judiciary, 101st Cong., 1st Sess. 568-609 (1989) (statement of the Committee for America's Copyright Community (CACC)) (advocating against injecting moral rights into the copyright law). CACC includes the Motion Picture Association of America as well as the Recording Industry Association of America among its members. *Id.* at 609. In its statement, the CACC expresses the ill effects of formally recognizing the rights of paternity (another term for attribution) and integrity. *See id.* at 584-585, n. 22 (explaining that the practical workings of the radio broadcasting, newspaper, and magazine businesses would be hampered by having to account authors' moral rights); *See also id.* at 586 (explaining that moral rights legislation would impermissibly put judges "in the position of making judgments about the quality of creative works").

212. The film industry, which wields great economic clout, has notably been opposed to expanding the scope of accreditation given to artists. *See, e.g.* WEILER, ENTERTAINMENT MEDIA AND THE LAW 492-493 (noting the consistent opposition posed by the motion picture industry to moral rights).

213. The VLA is a "non-profit legal service organization supported in part with public funds from the National Endowment for the Arts, the New York State Council on the Arts, and the New York City Department of Cultural Affairs" and through charitable contributions. *See* http://www.vlany.org/about_supporters.html. (last visited Oct. 25, 2003). The VLA was represented by John Koegle in the Visual Artist Rights Amendment hearings, conducted on November 18, 1986. *See, Hearings on S. 2796 Before the Subcommittee on Patents, Copyrights, & Trademarks of the Committee on the Judiciary*, 99th Cong., 2d Sess. 12-13 (1986) (testimony of John Koegle).

214. *See Hearings on S.1253 Before the Subcommittee on Patent, Copyrights, & Trademarks of the Committee on the Judiciary*, 101st Cong., 1st Sess. 480-83 (1989) (statement of Helen A. Stephenson, Executive Director of the Author's Guild) (explaining this organization's support for a bill to amend the copyright law regarding work made for hire). This statement, presented to Congress on September 20, 1989, advocates for an inalienable right of ownership with respect to an author's work. *Id.* at 480-81.

215. *See Hearings on S.1253 Before the Subcommittee on Patents, Copyrights, & Trademarks of the Committee on the Judiciary*, 101st Cong., 1st Sess. 485-86 (1989) (testimony of Alec Dubro, President of the National Writers Union) (advocating for the same change in the copyright law as in the above note with respect to the work for hire doctrine). This testimony expresses the economic necessity of preserving an author's ownership of his or her artistic product. *Id.*

proven to be successful in the recent past.²¹⁶ Ultimately, artists must labor twice in order for fuller accreditation rights to be afforded—initially, in actually creating their works and secondly, in ensuring that proper legislation exists to protect them against potential infringers.

VII. CONCLUSION

An author's right of attribution has not been consistently interpreted in American law. Judicial opinions have shoehorned the elements of § 43 (a) of the Lanham Act in order to recognize viable causes of action for plaintiff artists. Different tests have emerged, spattering the legal landscape with eloquent rhetoric that fails to give consistent future guidance. This was the case until Justice Scalia limited the scope of § 43 (a) in *Dastar*. Although those seeking to propound moral rights in the arts may disagree with its ultimate outcome, at the very least, *Dastar* should be respected for its clarity. There should be some comfort in the fact that the darting ping-pong ball of diverging judicial opinion has finally come to rest. As for the plight of artists who seek more well-rounded accreditation rights, one fundamental truth persists—they will continue to sweat so that their names will be remembered.

216. See Eldred, 537 U.S. at 207 n.15 (citing the statements of various musical artists who argued on behalf of the Copyright Term Extension Act as providing an "incentive to create").