

# DASTAR CORP. V. TWENTIETH CENTURY FOX FILM CORP.: WIDENING THE GAP BETWEEN UNITED STATES INTELLECTUAL PROPERTY LAW AND BERNE CONVENTION REQUIREMENTS

Since its inception, the United States has recognized rights in creative works.<sup>1</sup> But its version of intellectual property protection of creative works differs from many other countries because the United States does not provide all creators<sup>2</sup> with express moral rights.<sup>3</sup> Many of these countries are part of the Berne Convention's union of countries that are dedicated to providing a broad form of international copyright that bestows certain rights, including moral rights, on creators in its member countries.<sup>4</sup> Although the United States joined the Berne Convention in 1988, it has been slow to adjust its law to conform expressly to Berne Convention requirements. At first, Congress felt that existing United States law was sufficient to meet Berne Convention requirements.<sup>5</sup> Two years later, Congress expanded copyright law by enacting the Visual Artists Rights Act (VARA), which expressly adopted Berne Convention requirements for protecting moral rights, but only for a narrow category of creators.<sup>6</sup>

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1. The Constitution allows Congress to create laws "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. This clause forms the basis for federal patent and copyright law.

2. "Creator" as used in this paper refers to inventors, originators and authors of ideas.

3. Although copyright law provides some express moral rights through the Visual Artists Rights Act, 17 U.S.C. § 106A (2004) [hereinafter VARA], these rights are limited to a narrow class of creators.

4. Berne Convention for the International Union for the Protection of Literary and Artistic Works, Article 1, *reprinted in* Nimmer on Copyright, app. 27 (2003) [hereinafter Berne Convention].

5. Pub. L. No. 100-568, § 2(3), 102 Stat. 2853 (1988).

6. Specifically, only works of visual art as defined in Copyright Act, 17

Recognizing the limitations of current copyright law in protecting moral rights, creators have looked to other legal theories for protection. Specifically, creators have tried to use trademark law's<sup>7</sup> unfair competition<sup>8</sup> statute, Lanham Act § 43(a), as a backdoor approach<sup>9</sup> to protecting the moral right of attribution. Creators invoked § 43(a)'s protection as an alternative theory of protection in case copyright infringement claims failed, or as a way to protect a work's attribution when no copyright was held. But, like copyright law, trademark law offers only incomplete protection for creators' right of attribution.<sup>10</sup>

Whatever limited protection § 43(a) offered was severely restricted, if not destroyed altogether<sup>11</sup>, in June 2003 when the Supreme Court decided that the federal unfair competition statute<sup>12</sup> could not be

U.S.C. § 101 (2003), are protected by VARA. See note 54 and accompanying text.

7. See generally Lanham Act §§ 1-46, 15 U.S.C. §§ 1051-1127 (2003).

8. See note 63 and accompanying text.

9. Howard J. Susser, *Supreme Court: Federal Lanham Act No Help to Owners of Expired Copyrights*, 10 No. 6 Andrews Intell. Prop. Litig. Rep. 13 (July 22, 2003) (calling Lanham Act relief a "back door" when copyright infringement relief cannot be obtained).

10. The three main categories of federal intellectual property protect patents, trademarks, and copyrights. The Patent Act, 35 U.S.C. §§ 1-376 (2003), codifies a close equivalent to a right of attribution because it requires patent applications must be filed by the inventor(s) of the invention, even if the invention has been assigned to a person or entity other than the actual inventor(s). 35 U.S.C. § 116. This distinguishes patent rights in the United States from many other countries which allow patent applications to be filed by the assignee instead of the inventor. However, the works discussed in this paper are generally protected by trademark and copyright law, so any right of attribution equivalents afforded by the Patent Act are of little consequence in the present context.

11. It is disputed among commentators whether the Supreme Court's decision put an end to only § 43(a)(1)(A) claims for passing off, or also § 43(a)(1)(B) claims for false advertising. See *infra* notes 183-189 and accompanying text.

12. Lanham Act § 43(a) codifies what was originally the common law basis for unfair competition:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the

used as a backdoor approach for protecting a creator's right of attribution.<sup>13</sup> With one legal theory that had been used to protect rights of attribution rejected by the Supreme Court, available methods of moral rights protection have been further narrowed. Rather than twisting existing legal theories to fit a moral rights cause of action, moral rights proponents should seek a remedy in a separate statute codifying a right to attribution for all creators.<sup>14</sup>

This article seeks to demonstrate that creators' moral rights are not adequately protected by current law. Part I explains current intellectual property schemes. First, it explains the role of copyright law in the United States. Next, it examines the Berne Convention's requirements and the United States' limited response to them in enacting VARA. Lastly, trademark law's use as a backdoor approach to protecting moral rights is introduced. Part II expands on this backdoor approach by recounting § 43(a)'s role in attribution rights protection and the resulting three-way circuit split. It also explains how the Supreme Court's decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.* clarified that § 43(a) could not be used to protect a creator's right of attribution. Part III points out that although the *Dastar* case was correctly decided, it has left certain classes of creators with little recourse to protect their moral rights. It then examines other possible methods of protecting moral rights and their limitations. The article concludes that, due to the limitations inherent in the possible methods of protecting moral rights, existing law does not fulfill Berne Convention requirements. Thus, legislation expressly protecting moral

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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 or is likely to be damaged by such act.

Lanham Act § 43(a).

13. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041 (2003).

14. Recognizing that even federal unfair competition rights were imperfect protection of a creator's right of attribution, this view was adopted by some intellectual property commentators before the *Dastar* decision. See, e.g., 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 (2002) [hereinafter *Crossfire*].

rights for all classes of creators required by the Berne Convention is needed to bring the United States into compliance with its requirements.

## I. BACKGROUND

### A. MORAL RIGHTS

Moral rights theory is based on the notion that a creator pours certain elements of her personality into her creation.<sup>15</sup> The creator naturally wants to protect the work's identity and integrity since the created work is, in a sense, an embodiment of the creator.<sup>16</sup> Moral rights recognize this intimate link between the creator and the work and protect it through a bundle of rights including the right of attribution<sup>17</sup>, right of integrity<sup>18</sup>, and right of paternity.<sup>19</sup> This paper focuses mainly on the right of attribution, which functions to both recognize the identity of the creator of a particular work and to prevent another from falsely receiving credit for the work's creation.<sup>20</sup>

United States intellectual property rights exist independently from moral rights because each is based on different incentives.<sup>21</sup> United States' intellectual property rights are based, at least to some extent, on economic incentives.<sup>22</sup> Moral rights, on the other hand, are

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15. Colleen Creamer Fielkow, *Clashing Rights Under United States Copyright Law: Harmonizing an Employer's Economic Right with the Artist-Employee's Moral Rights in a Work Made for Hire*, 7 DePaul-LCA J. Art & Ent. L. 218, 221 (1997) [hereinafter *Clashing Rights*].

16. *Crossfire*, supra note 14, at 985.

17. The right of attribution protects a work from being credited to someone other than the author. *Crossfire*, supra note 14, at 986.

18. The right of integrity protects a work from being marred or altered so that it no longer represents the author's personal expression. *Id.*

19. The right of paternity gives the author the right to associate her name with the work. Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 Vand. L. Rev. 1, 5 (1985) [hereinafter *American Marriage*]. Sometimes the right of withdrawal, the right to prevent excessive criticism, and the right to prevent assaults upon one's personality are also protected. *Id.* at 5.

20. *Crossfire*, supra note 14, at 985.

21. *Clashing Rights*, supra note 15, at 221.

22. Although patent and copyright law rest on constitutional provisions that make the progress of science and the arts their chief objective, the monopoly conferred for patent and copyright protection is evidence of an economic incentive for inventors and authors - if they disclose their work,

non-economic rights that protect the natural impulse of a creator to protect her work simply because she has invested part of herself in its creation. Thus, the rights stemming from economic incentives are separable from the rights stemming from moral incentives. While United States intellectual property law protects economic rights, it does not fully protect noneconomic rights such as moral rights. Many other countries have adopted some form of protection for creators' moral rights. For example, countries may join the Berne Convention's union of countries that agree to protect the moral rights of creators in member countries. Historically, the United States was resistant to law that expressly protected creators' moral rights and did not enact any such law until two years after it joined the Berne Convention.

## B. BERNE CONVENTION

The Berne Convention is an agreement among its member countries to form a "Union" that protects the rights of creators of literary and artistic works.<sup>23</sup> This protection generally takes the form of a species of copyright law.<sup>24</sup> Article 6bis of the Berne Convention establishes moral rights for a creator in her work including the right of attribution and the right of integrity.<sup>25</sup> The right of attribution allows the creator to require acknowledgment of her authorship in the work, while the right of integrity allows the creator to prevent distortion or mutilation of the work itself, including alterations which would compromise her reputation.

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they are rewarded with having a monopoly over the work's economic return.

23. Berne Convention, *supra* note 4.

24. The Berne Convention uses language similar to the United States' Copyright Act. For example, both call creators "authors" and their creations "works". See Berne Convention, *supra* note 4. Both authorize protection to be denied unless the work is fixed in some medium of expression. Berne Convention, *supra* note 4, at Article 2(2); Copyright Act, 17 U.S.C. § 102(a) (2003).

25. "Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation." Berne Convention, *supra* note 4, at Article 6bis.

The United States remained an outsider to the Berne Convention for over 100 years,<sup>26</sup> quite possibly because its intellectual property law did not comply with the requirements of the Berne Convention.<sup>27</sup> Recognizing its interest in protecting its copyrights in the international market and the leverage associated with joining the union, however, the United States became a member of the Berne Convention in 1988.<sup>28</sup>

In a first step towards compliance, President Reagan signed into law the Berne Convention Implementation Act of 1988.<sup>29</sup> This law recognized that the Berne Convention is not self-executing and needs United States legislation to give effect to its provisions.<sup>30</sup> Yet Congress did not immediately enact new legislation to do that. Instead, the Implementation Act declared that “[t]he amendments made by this Act, together with the law as it exists on the date of the enactment of this Act, satisfy the obligations of the United States in adhering to the Berne Convention and no further rights or interests shall be recognized or created for that purpose.”<sup>31</sup> Congress reasoned that moral rights were already protected by existing law including “various provisions of the Copyright Act and Lanham Act, various state statutes, and common law principles such as libel, defamation, misrepresentation, and unfair competition, which have been applied by courts to redress authors’ invocation of the right to claim authorship or the right to object to distortion.”<sup>32</sup>

26. The Berne Convention was first written in 1886 and has been revised seven times. William Belanger, *U.S. Compliance with the Berne Convention*, 3 *Geo. Mason Indep. L. Rev.* 373, 373 (1995) [hereinafter *U.S. Compliance*].

27. See Tyler T. Ochoa, *Introduction: Rights of Attribution, Section 43(a) of the Lanham Act, and the Copyright Public Domain*, 24 *Whittier L. Rev.* 911, 924 (2003) [hereinafter *Ochoa's Introduction*].

28. 134 CONG. REC. H10091-02 (daily ed. October 12, 1988) (Statement of Mr. Fish). See also Dana L. Burton, *Artists' Moral Rights: Controversy and the Visual Artists Rights Act*, 48 *SMU L. Rev.* 639, 640 (1995) [hereinafter *Artists' Moral Rights*]; *U.S. Compliance*, *supra* note 26, at 373.

29. Pub. L. No. 100-568, 102 Stat. 2853 (1988).

30. “The Convention . . . and all acts, protocols, and revisions thereto . . . are not self-executing under the Constitution and laws of the United States.” *Id.* at § 2(1).

31. Pub. L. No. 100-568, § 2(3), 102 Stat. 2853 (1988).

32. SEN. RPT. NO. 100-352, at 9-10 (1988), reprinted in 1988 U.S.C.C.A.N. 3706, 3714-15. “Far from being a congressional endorsement of the use of section 43(a) to vindicate any moral right of attribution, these provisions reek of a self-serving declaration of compliance, combined with express provisions

## C. COPYRIGHT LAW

In the United States, most moral rights protection generally takes the form of a species of copyright law.<sup>33</sup> Traditional copyright law is the closest equivalent to an implied right of attribution for creative works because it grants creators a monopoly over the bundle of rights associated with a creative work.<sup>34</sup>

The Copyright Act has broad coverage over many types of creative works, requiring only that the works it protects be original and “fixed in any tangible medium of expression.”<sup>35</sup> Its coverage encompasses works of literature, music, drama, pantomime, choreography, pictures, sculptures, graphics, motions pictures, sounds recordings, and architecture.<sup>36</sup> It withholds protection from facts, ideas, and methods.<sup>37</sup>

The Copyright Act also gives copyright holders the rights of reproduction, preparation of derivative works, distribution, public performance, display, and transmission.<sup>38</sup> Although the law confers a

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intended to prevent the legal recognition of moral rights in copyrighted works.” *Ochoa’s Introduction, supra* note 27, at 926.

33. See generally Copyright Act, 17 U.S.C. §§ 101-1332 (2003).

34. *Id.* at § 106.

35. “Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” *Id.* at § 102(a).

36. *Id.* at § 102(a)(1-8).

37. *Id.* at § 102(b). Facts are part of the public domains, while ideas and methods may be protected by patent law rather than copyright law.

38. [T]he owner of copyright under this title has the exclusive rights to

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

good number of rights on copyright holders, it falls short of expressly conferring moral rights. With only implied moral rights, copyright law does not provide full coverage of creators' moral rights. First, the monopoly on the rights conferred by copyrights last for a limited time.<sup>39</sup> After the copyright expires and the creative work is in the public domain, the original creator's right of attribution vanishes. Second, certain statutory schemes actually deprive the true creator of the right of attribution. The work-for-hire doctrine, for example, provides that the employer, not the creator, owns the copyright to a creative work made in the scope of employment.<sup>40</sup> Similarly, works derived from the creator's original copyrighted work that are not similar enough to be considered derivative works owe no attribution to the creator of the original work under the current copyright scheme.<sup>41</sup>

Recognizing some of the deficiencies in the ability of the pre-Berne Convention Copyright Act to comply with Berne Convention requirements, Congress adopted legislation creating narrow moral rights two years after the Berne Convention Implementation Act of 1988.

#### D. VISUAL ARTISTS RIGHTS ACT

The United States enacted a single piece of legislation, the Visual Artists Rights Act (VARA)<sup>42</sup>, in response to joining the Berne Convention. VARA represents the United States' first attempt to comply with the Berne Convention's requirements for moral rights protection in Article 6bis by expressly granting rights of attribution and integrity to the authors of certain types of works. While the Berne Convention specifies that moral rights in all types of artistic and literary works are protectable under its provisions,<sup>43</sup> VARA grants such protection to only a narrow class of creations.

VARA's right of attribution includes positive and negative rights. The positive right gives the author of a certain work the right to

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means of a digital audio transmission.

*Id.* at § 106.

39. *Id.* at §§ 301-305.

40. *Id.* at § 101.

41. Recall that if these new works were considered derivative works, the original creator would be able to prevent their creation under § 106(2).

42. See generally VARA § 106A, *supra* note 3.

43. *Berne Convention*, *supra* note 4, at Article 2(1).



have her name associated with that work.<sup>44</sup> The negative right allows that author to prevent her name from being associated with works in which she had no authorship.<sup>45</sup>

VARA's right of integrity allows creators of certain types of works to prevent those works from being distorted, mutilated, destroyed, or modified.<sup>46</sup> The goal of the right of integrity in a work is to prevent the creator's honor and reputation from being tarnished.<sup>47</sup> This reflects the concept of moral rights that part of the creator's personality or beliefs are embodied in a work. Protecting the integrity of the work thus protects the image of herself that the artist chooses to reveal to society through that work.

Consistent with the constitution's Intellectual Property Clause conferring monopolies on authors' writings for limited times,<sup>48</sup> VARA allows moral rights to endure for the life of the author<sup>49</sup> or, in the case of joint authors, until the end of the last surviving author's life.<sup>50</sup> The moral rights protected by VARA may not be transferred by any method, and a waiver of its protection is only available if the author expressly agrees to it in writing.<sup>51</sup>

44. VARA § 106A(a)(1)(A).

45. *Id.* at § 106A(a)(1)(B).

46. The author has the right

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 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.

*Id.* at § 106A(a)(3)(A,B). VARA also links the two moral rights together, providing that an author "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". *Id.* at § 106A(2).

47. *Carter v. Helmsley-Spear, Inc.*, 861 F. Supp. 303, 323 (S.D.N.Y. 1994), *aff'd in part, vacated and rev'd in part*, 71 F.3d 77 (2d Cir. 1995) (finding "injury or damage to plaintiffs' good name, public esteem, or reputation in the artistic community" evidence of alteration of a work that damages an author's honor or reputation).

48. U.S. CONST. art. I, § 8, cl. 8.

49. VARA § 106A(d)(1).

50. *Id.* at § 106A(d)(3).

51. The rights conferred by subsection (a) may not be transferred, but

those rights may be waived if the author expressly agrees to

Although the Berne Convention requires moral rights protection for a wide range of “literary and artistic works”<sup>52</sup> and VARA acknowledges that “[o]wnership in [moral rights] . . . are distinct from ownership of any copy of that work, or of a copyright or any exclusive right under a copyright in that work”,<sup>53</sup> VARA exempts certain works from moral right protection. VARA only protects “visual art” consisting of paintings, drawings, sculptures, and some photos.<sup>54</sup>

such waiver in a written instrument signed by the author. Such instrument shall specifically identify the work, and uses of that work, to which the waiver applies, and the waiver shall apply only to the work and uses so identified. In the case of a joint work prepared by two or more authors, a waiver of rights under this paragraph made by one such author waives such rights for all such authors.

*Id.* at § 106A(e)(1).

52. The expression ‘literary and artistic works’ shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show; musical compositions with or without words; cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.

Berne Convention, *supra* note 4, at Article 2(1).

53. “Transfer of ownership of any copy of a work of visual art, or of a copyright or any exclusive right under a copyright, shall not constitute a waiver of the rights conferred by subsection (a).” VARA § 106A(e)(2).

54. A ‘work of visual art’ is (1) a painting, drawing, print, or sculpture,

existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or (2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author. A work of visual art does not include (A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine,

Creators of nonvisual art, such as poetry, are not given moral rights protection.<sup>55</sup> VARA also specifically excludes works made for hire and uncopyrightable works.<sup>56</sup>

VARA was a positive addition to United States law in view of its membership in the Berne Convention because VARA expressly gives moral rights to certain works where such rights were not adequately protected by other United States laws. However, while VARA was an important step towards Berne Convention compliance, its limited moral rights protection does not fulfill all the requirements of the Berne Convention.

#### E. TRADEMARK LAW

Since intellectual property law prior to VARA did not recognize an express right of attribution and VARA itself still limits express conferral of moral rights, creators have looked to other areas of law to protect their moral rights. In fact, Congress encouraged this roundabout approach to preserving moral rights when they declared existing United States law to be sufficient to protect the moral rights required by the Berne Convention.<sup>57</sup> Despite Congressional approval, however, the intellectual property law in place before the United States joined the Berne Convention is an indirect and inadequate route to protecting creators' moral rights.

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newspaper, periodical, data base, electronic information service, electronic publication, or similar publication; (ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container; (iii) any portion or part of any item described in clause (i) or (ii); (B) any work made for hire; or (C) any work not subject to copyright protection under this title.

Copyright Act § 101.

55. Additionally, some types of works that are arguably visual art, such as paper art, woodwork, tapestries and quilts, are not included in the § 101's definition of visual art nor its exclusions from visual art.

56. *Id.* See *supra* note 35. The exception for works made for hire is most alarming. For example, imagine giving no right of attribution to Michelangelo for his famous painting of scenes from the Bible on the ceiling of the Sistine Chapel. Under VARA Michelangelo would have no way to insure that his name was associated with the painting because he was commissioned to paint it by the Sistine Chapel.

57. SEN. RPT. NO. 100-352, at 9-10 (1988), *reprinted in* 1988 U.S.C.C.A.N. 3706, 3714-15. See *supra* note 32 and accompanying text.

Trademark law is one roundabout avenue used by creators to protect their right of attribution. This method of protection is indirect because trademark law was never intended to benefit the creators of works. Yet, until recently,<sup>58</sup> creators were often able to successfully twist trademark law so it could be used to protect the right of attribution.

Trademark law is based on the Commerce Clause<sup>59</sup> and its goals are economic in nature. The purpose of trademark law is to provide protection and consistency for consumer decisions by legally protecting the relationship between a good or service and the mark of the producer of that good or service.<sup>60</sup> While trademark law was formulated with consumers in mind, the benefits of its enforcement generally helps the producers and mark-holders more directly since they profit from the reputation or goodwill associated with their mark.<sup>61</sup> However, consumers are indirectly the ultimate beneficiaries of trademark law because consumer decisions easier and more accurate when marks are reliable as indicators of quality and producer.<sup>62</sup>

Trademark law is codified in the Lanham Act. Causes of action under trademark law include federal unfair competition<sup>63</sup> claims under Lanham Act § 43(a). Under that section, there are two alternative foundations for bringing a civil action against a defendant for using a mark that is a false designation of the origin of goods or services. Section 43(a)(1)(A) prevents use of a mark in connection with goods or services that misrepresents the origin of the goods and is likely to cause confusion among consumers as to the producer or sponsor of those

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58. The June 2003 Supreme Court decision *Twentieth Century Fox Film Corp v. Dastar Corp.*, 123 S. Ct. 2041 (2003), reigned in the roundabout use of trademark law for protecting moral rights.

59. U.S. CONST. art. 1, § 8, cl. 3.

60. See David A. Gerber, *Copyright Reigns Supreme: Notes on Dastar Corp. v. Twentieth Century Fox Film Corp.*, 93 Trademark Rep. 1029, 1031 (2003) [hereinafter *Copyright Reigns*].

61. *Id.*

62. Randolph Stuart Sergent, *Building Reputational Capital: The Right of Attribution Under Section 43 of the Lanham Act*, 19 Colum.-VLA J.L. & Arts 45, 45 (1995) [hereinafter *Building Reputational Capital*].

63. Unfair competition is a commercial tort that is not readily definable in the abstract. While courts allow competition in the marketplace, that competition must be reasonable and fair. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 1:8 (4th ed. 2004) [hereinafter *McCarthy on Trademarks*].

goods or services.<sup>64</sup> Section 43(a)(1)(B) prevents the use of a mark in connection with goods or services that misrepresents the origin of the goods or services via “commercial advertising or promotion.”<sup>65</sup> Actions under the former section are passing off and reverse passing off claims,<sup>66</sup> while actions under the latter section are false advertising claims.

Passing off occurs when an actor misrepresents that the goods or services that he produces were produced by another.<sup>67</sup> Passing off

64. The full text of that section reads:

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 is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Lanham Act § 43(a)(1)(A).

65. The full text of that section reads:

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 . . . 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 or is likely to be damaged by such act.

Lanham Act § 43(a)(1)(B).

66. Sometimes these claims are also called “palming off” and “reverse palming off”. Although § 43(a)(1)(A) only explicitly provides for passing off claims, reverse passing off claims brought under that section have also been recognized by every circuit except the First Circuit. 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 (2003) [hereinafter *Database Protections*].

67. One is subject to liability to another under the rule stated in § 2 if, in

connection with the marketing of goods or services, the actor makes a representation likely to deceive or mislead prospective purchasers by causing the mistaken belief that the actor's business is the business of the other, or that the

may be express or implied. Express passing off occurs when a good or service is mislabeled so the label falsely represents who the actual producer is.<sup>68</sup> Implied passing off involves the use of samples or such advertising material to imply that the goods or services were produced by another.<sup>69</sup> Reverse passing off occurs when an actor represents that goods or services were produced by him rather than another.<sup>70</sup> Reverse passing off is implied if an actor removes the mark or label from a good or service to represent that it is unbranded.<sup>71</sup> If, after removal of the

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actor is the agent, affiliate, or associate of the other, or that the goods or services that the actor markets are produced, sponsored, or approved by the other.

Restatement (Third) of Unfair Competition § 4 (2003).

68. *Smith v. Montoro*, 648 F.2d 602, 604 (9th Cir. 1981). Express passing off is "the classic form of trademark infringement." *McCarthy on Trademarks* § 25:5. For example, a defendant committed express passing off when it copied plaintiff's "Tea Rose" mark for flour and sold its own flour under the same mark. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916).

69. For example, in *Truck Equipment Service Co. v. Fruehauf Corp.*, 536 F.2d 1210 (8th Cir. 1976), a defendant that copied the design of plaintiff's trucks and then advertised its own trucks with the copied design using a photo of plaintiff's trucks was liable for implied passing off. *See McCarthy on Trademarks* § 25:7.

70. One is subject to liability to another under the rule stated in § 2 if, in

marketing goods or services manufactured, produced, or supplied by the other, the actor makes a representation likely to deceive or mislead prospective purchasers by causing the mistaken belief that the actor or a third person is the manufacturer, producer, or supplier of the goods or services if the representation is to the likely commercial detriment of the other.

Restatement (Third) of Unfair Competition § 5 (2003). The Restatement of Unfair Competition gives the following example:

A manufactures precision machine parts. B, a former distributor of A's products, is in the process of constructing its own manufacturing facility for the production of similar parts. B relabels its remaining supply of A's parts to misrepresent that the parts were manufactured by B. B sells the parts to customers and solicits orders for the manufacture of additional parts. The misrepresentation is to the likely commercial detriment of A since it threatens to divert future trade from A to B. B is subject to liability to A.

*Id.*

71. *Smith*, 648 F.2d at 605. *See McCarthy on Trademarks* § 25:8 (noting that some courts have held that implied reverse passing off is not actionable because the injury to the mark-holder is very subtle).

mark or label, the actor had replaced it with his own mark or label, the reverse passing off would be express.<sup>72</sup>

Reverse passing off claims under § 43(a)(1)(A)'s unfair competition provisions have been used as a "backdoor" approach<sup>73</sup> for enforcing a creator's right of attribution. Proponents of this method of moral rights protection argue that violation of attribution rights fit within the reverse passing off scheme for two reasons. First, if a creator is not recognized for her contribution to a work, consumers will be confused as to the creator of the work. Second, the lack of attribution will prevent the creator's reputation from being enhanced proportionate to the success of her work.<sup>74</sup> However, this backdoor method of protecting attribution rights expands the traditional reverse passing off claim because its protection is not limited to misrepresentation of the party that *manufactured* the physical goods through a traditional mislabeling scheme. Rather, the backdoor approach extends § 43(a)(1)(A)'s protection to misrepresentation of a party that *designed* the goods that were manufactured by another.<sup>75</sup>

## II. § 43(A) AS A PROTECTOR OF MORAL RIGHTS

### A. CIRCUIT SPLIT

Section 43(a) provides a cause of action for false designation of origin when consumers are likely to be confused about the origin of a seller's goods.<sup>76</sup> Using § 43(a) to try to protect moral rights, some courts examining the issue of whether § 43(a) protected rights of attribution had treated the "origin of goods" as referring to the "originator" or creator of the original design or idea for the goods.<sup>77</sup>

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72. *Id.* at 607. See McCarthy on Trademarks § 25:6.

73. *Ochoa's Introduction*, *supra* note 27, at 912. See McCarthy on Trademarks § 25:6.

74. *Building Reputational Capital*, *supra* note 62, at 46.

75. *Id.* at 51-52.

76. Lanham Act § 43(a).

77. *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 783 (2d Cir. 1994) (finding that "[f]alse 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"); *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1072 (1996) (dismissing false designation of origin claim because the defendant "did not represent that it had *designed* these sweaters" (emphasis added)). In retrospect, it may seem obvious that § 43(a)'s origin of goods would refer to the producer and

The Supreme Court clarified in *Dastar* that “origin” of goods referred to the producer who manufactured the goods or provided the services at issue.<sup>78</sup>

The seminal case of *Smith v. Montoro* was among the first to find a right of attribution for creators under § 43(a).<sup>79</sup> In that case, the plaintiff, Paul Smith, was an actor who contracted with an Italian film company to star in a movie they produced. He was to receive from that company and any of their licensees “star billing in the screen credits” and full acknowledgement in any advertising for the film.<sup>80</sup> But when the Italian company licensed defendants to distribute the movie in the United States, they removed Smith’s name from the credits and advertising and replaced it with the name of another actor.<sup>81</sup> Smith complained that this action constituted a false designation of origin under § 43(a).<sup>82</sup> Although the District Court dismissed Smith’s complaint,<sup>83</sup> the Court of Appeals for the Ninth Circuit found that Smith had stated a claim for reverse passing off since Smith believed he was likely to be damaged by the name substitution in the credits and

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seller of goods since the Lanham Act functions to protect consumers by associating products with their *manufacturers*, not with their *conceptual designers*. The confusion prior to the *Dastar* decision is possibly attributed to the fact that cases dealing with this issue often had both copyright and trademark claims and in some ways copyright and trademark statutory language seem to overlap. For example, copyright law gives rights to authors for their *original* works. Copyright Act § 102(a). Section 43(a) claims were often brought by copyright holders with original works who hypothesized that another’s failure to attribute their creativity in a work amounted to a false designation of the *origin* of the work. Since creative works can be turned into goods sold for profit, it is not surprising that the origin of goods in these types of cases was a puzzling question.

78. *Twentieth Century Fox Film Corp v. Dastar Corp.*, 123 S. Ct. 2041, 2047 (2003) (Finding “the most natural understanding of the ‘origin’ of ‘goods’ – the source of wares – [to be] the producer of the tangible product sold in the marketplace”).

79. *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981).

80. *Id.* at 603.

81. *Id.*

82. *Id.* Smith’s complaint also alleged breach of contract, false light of publicity and appropriation of personal likeness.

83. *Id.* The dismissal was based on Smith’s lack of standing to bring a Lanham Act claim because the judge found no palming off of goods or misuse of trademarks and that Smith was not in direct competition with the defendants. The Court of Appeals for the Ninth Circuit reversed the dismissal, finding that Smith need not be in direct competition with the defendants to bring a Lanham Act claim and that § 43(a) supported an action for palming off of services. *Id.* at 605, 607.



advertising.<sup>84</sup> The court considered the defendant's deletion and substitution of Smith's acting services "economically equivalent"<sup>85</sup> to a traditional § 43(a) claim of reverse passing off of the origin of goods or services because Smith was deprived of goodwill that would come from consumers associating his name with his acting service and because consumers were deceived into believing that the source of the acting in the film came from someone other than Smith.<sup>86</sup>

*Smith v. Montoro* began a judicial trend for claims for false designation of origin under § 43(a) when a party's creative work was copied by another without credit.<sup>87</sup> The *Smith* decision laid the groundwork for a wave of cases protecting a creator's right of attribution when her contribution to a work was not attributed or only partially attributed.<sup>88</sup> Even placing a copyright notice on an item that

84. *Id.* at 607. Smith alleged that the name substitution had "damaged . . . his reputation as an actor and . . . [resulted in the loss of] specific employment opportunities." *Id.* at 603.

85. *Id.* at 605.

86. *Id.* at 607. The court focuses Smith's § 43(a) claim on the Lanham Act's ultimate purpose: to protect consumers from false information about the goods or services they purchase so they may have confidence in the consistency of those goods or services. Under this logic, by omitting Smith's name, the defendants had given consumers false information about the acting services used in the film.

87. *Dodd v. Fort Smith Special Sch. Dist. No. 100*, 666 F. Supp. 1278, (W.D. Ark. 1987) (mem.) (enjoining defendant school district for failing to credit a teacher who conceived the idea for and helped prepare a book about a local historical figure); *East/West Venture v. Wurmfeld Assoc., P.C.*, 722 F. Supp. 1064, 1068 (S.D.N.Y. 1989) (denying plaintiff's motion to dismiss § 43(a) claim where name of defendant, the original designer of architectural plans, was omitted from plaintiff's similar plans copied from the defendant); *F.E.L. Publications, Ltd. v. Catholic Bishop of Chicago*, 214 U.S.P.Q. 409, 416 (BNA) (7th Cir. 1982) (finding defendants had falsely designated the origin of songs contained in a hymnal "[b]y printing its own name on the hymnals and excluding F.E.L.'s"); *Joseph J. Legal Architects, P.C. v. United States Dev. Corp.*, 625 F. Supp. 293, 299 (N.D. Ill. 1985) (enjoining defendants that put the name of their architect on plans the plaintiff created); *Preta v. Collectibles Inc.*, 62 U.S.P.Q.2d 1360, (BNA) (S.D.N.Y. 2002) (finding reverse passing off when defendants represented themselves as the authors and performers of two songs on an album that the plaintiffs had actually authored and performed); *Debs v. Meliopoulos*, 1993 WL 566011, at \*12 (N.D. Ga. Dec. 18, 1991) (holding that "[a] failure to attribute authorship to a person . . . constitutes a violation of section 43(a)").

88. *Johnson v. Jones*, 149 F.3d 494, 503 (6th Cir. 1998) (finding that when the defendant copied plaintiff architect's drawings and replaced the plaintiff's name with the name of another company, "It is difficult to imagine how a designation of origin of a product could be more false, or could be more likely

had been copied from another party could be considered a violation of § 43(a).<sup>89</sup>

Finding a reverse passing off claim when a copyrighted work was copied without attribution to the original creator had the effect of providing every copyright infringement action with a corresponding § 43(a) action that essentially duplicated the claim of copyright infringement. To prevent this double dipping of intellectual property law protection, the circuits began defining § 43(a) actions for right of attribution more strictly. A three way circuit split emerged as courts fought over whether § 43(a) required bodily appropriation of a work, substantial similarity to the work, or likelihood of confusion about the creator of the work.<sup>90</sup>

The Ninth Circuit adopted the bodily appropriation approach. This approach originated with the *Smith v. Montoro* decision, which held that replacing an actor's name with another's in a film's credits was actionable because it amounted to misappropriation of the actor's

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to cause confusion or mistake as to the actual origin of the product . . . Few are the cases demonstrating a more obvious and imminent likelihood of confusion.”); *Rosenfeld v. W.B. Saunders*, 728 F. Supp. 236, 243 (S.D.N.Y. 1990) (holding “[a]ny false attribution of principal authorship constitutes a section 43(a) violation if it misrepresents the contributions of the person designated as author . . . Thus, failure to attribute authorship to a co-author resulting in only a partially accurate designation of origin constitutes reverse palming off within the ambit of section 43(a) . . . Copyright ownership of lack of such ownership is not dispositive on the issue of unfair competition under the Lanham Act.”); *R.H. Donnelley Corp. v. Ill. Bell Tel. Co.*, 595 F. Supp. 1202, 1206 (N.D. Ill. 1984) (finding § 43(a) violated and defendant was free-riding on goodwill partially generated by plaintiff when defendant did not acknowledge the past contributions of its co-author of the Yellow Pages).

89. In *Sunset Lamp Corp. v. Alsy Corp.*, 698 F. Supp. 1146 (S.D.N.Y. 1988), the plaintiff claimed that defendant's copying of its copyrightable lamp design and affixation of a copyright notice to the lamps constituted unfair competition under § 43(a). The court agreed, holding that “[f]alse designation of origin can include false designation of copyright, where the copyright may enhance the cachet of the product as an original.” *Id.* at 1153. *See also* *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 37 (2d Cir. 1982) (finding defendant that copied plaintiff's picture of Paddington Bear with the words “Fred Original” falsely represented that it was the original creator of the bear image); *Greef Fabrics, Inc. v. Spectrum Fabrics Corp.*, 217 U.S.P.Q. 498, 502 (BNA) (S.D.N.Y. 1981) (enjoining defendant form using words “exclusive” and “original” to describe fabrics that copied plaintiff's fabric designs). *But see* *Lipton v. Nature Co.*, 71 F.3d 464, 473 (2d Cir. 1995) (finding “the existence of a false copyright notice designation alone is insufficient” to support at § 43(a) claim).

90. *Copyright Reigns*, *supra* note 60, at 1030.

“talents and workmanship”.<sup>91</sup> Under the bodily appropriation test, § 43(a) may be used to protect a creator’s right of attribution when confusion results from her work being physically taken and her name replaced with another’s. Alternatively, bodily appropriation occurs when confusion results from a creator’s work being copied identically and the copy represented to be someone else’s work.<sup>92</sup> The bodily appropriation requirement limited § 43(a) protection of the right of appropriation because it protected only creative works that were copied identically.<sup>93</sup>

Another segment of cases, led by the Second Circuit, required substantial similarity between the plaintiff’s and defendant’s works before a court was willing to use § 43(a) to protect a creator’s right of attribution.<sup>94</sup> Thus, even if a portion of a creator’s work was copied by the defendant without attribution, the creator had no remedy if that

91. *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981). *Accord Shaw v. Lindheim*, 919 F.2d 1353, 1365 (9th Cir. 1990) (holding § 43(a) claims inappropriate unless the work has been bodily appropriated).

92. *Building Reputational Capital*, *supra* note 62, at 59.

93. *Kregos v. Associated Press*, 795 F. Supp. 1325, 1336 (S.D.N.Y. 1992), *aff’d*, 3 F.3d 656 (2d Cir. 1993) (dismissing § 43(a) claim because “a copyright notice must contain some falsity beyond simply the falsity of infringement in order to support plaintiff’s Lanham Act claim. Otherwise, all copyright infringement claims could automatically be converted into Lanham Act violations.”). *See, e.g., Armstrong v. Virgin Records, Ltd.*, 91 F. Supp. 2d 628, 633 (S.D.N.Y. 2000) (rejecting § 43(a) claim as duplicative of the copyright infringement claim because “[a]ny claim of false originality on the part of the defendants . . . does not venture beyond that implicit in any allegedly false copyright”); *Cognotec Serv. Ltd. v. Morgan Guar. Trust Co. of N.Y.*, 862 F. Supp. 45, 51 (S.D.N.Y. 1994) (mem.) (dismissing plaintiff’s § 43(a) claim as duplicative of copyright infringement); claims could automatically be converted into Lanham Act violations.”); *Marvulo v. Gruner & Jahr*, 105 F. Supp. 2d 225, 232 (S.D.N.Y. 2000) (rejecting a § 43(a) claim when copyright credit was not given to the author); *Morita v. Omni Publ’n Int’l, Ltd.*, 741 F. Supp. 1107, 1114 (S.D.N.Y. 1990), *vacated*, 760 F. Supp. 45 (S.D.N.Y. 1991) (rejecting § 43(a) action because “[t]he Lanham Act should not be distorted to provide a remedy for a failed claim of copyright infringement”); *Richard Feiner & Co. v. H.R.I. Indus, Inc.*, 10 F. Supp. 2d 310, 316 (S.D.N.Y. 1998) (rejecting § 43(a) claim as duplicative of copyright infringement claim).

94. *Waldman Publ’g Corp. v. Landoll, Inc.*, 43 F.3d 775, 781 (2d Cir. 1994) (using § 43(a) to protect the right of attribution of an author whose books were copied by the defendant); *Mfr. Tech., Inc. v. Cams, Inc.*, 706 F. Supp. 984, 1004 (D. Conn. 1989) (upholding a false designation of origin claim when defendant represented it was the creator of a computer program so similar to plaintiff’s that it infringed plaintiff’s copyright); *CD Law, Inc. v. LawWorks, Inc.*, 35 U.S.P.Q.2d 1352, 1357 (BNA) (W.D. Wash. 1994) (dismissing § 43(a) claim because plaintiff’s and defendant’s work was not substantially similar).

copying did not result in identity or at least substantial similarity between the two works. This theory was illustrated in *Waldman Publishing Corp. v. Landoll, Inc.*, where the defendants sold books of classic children's stories<sup>95</sup> that were substantially similar to those sold by the plaintiff without giving attribution to the plaintiff.<sup>96</sup> Although the Court of Appeals for the Second Circuit recognized that reverse passing off generally involved products, it extended the purpose of § 43(a) to written works to protect the right of attribution of the author, specifically noting that the § 43(a) action prohibits "misappropriation . . . of the artistic talent required to create the work, not of the manufacturing talent required for publication."<sup>97</sup> *Waldman* restricted reverse passing off actions to situations in which no attribution was given for a work, but only if there was substantial similarity between the original work and the passed off work. Thus, the Second Circuit's substantial similarity test was more protective of moral rights than the Ninth Circuit's bodily appropriation test because the Ninth Circuit required identical copying while Second Circuit required mere substantial similarity.

A third approach to limiting § 43(a)'s use for attribution rights, used by the Fifth,<sup>98</sup> Sixth<sup>99</sup> and Eleventh<sup>100</sup> Circuits, was to require consumer confusion. This approach was illustrated by *Campbell v. Osmond*, where Campbell, a designer of doll head sculptures, sued Osmond for using Campbell's doll heads to make its own doll head

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95. Since the subject of the plaintiff's books were classic children's stories, the defendants argued that they could not have falsely designated the origin of their books because the stories were in the public domain. The court, however, found that the plaintiff's books were sufficiently original to be copyrightable, so the defendant's substantially similar books could still be the subject of a § 43(a) claim. *Id.* at 781-82.

96. *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 778 (2d Cir. 1994).

97. *Id.* at 780-81. The court treats § 43(a) as a vehicle for preventing misappropriation of an author's due credit.

98. *See* *Batiste v. Island Records, Inc.*, 179 F.3d 217, 225 (5th Cir. 1999) (finding no violation of § 43(a) when plaintiffs did not establish consumer confusion when defendant sampled plaintiff's song without credit).

99. *Murray Hill Publ'ns, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, 634 (6th Cir. 2001) (failing to show confusion when defendants incorporated plaintiff's song into its own song precluded recovery based on § 43(a)).

100. *Lipscher v. LRP Publications, Inc.*, 266 F.3d 1305, 1313-14 (11th Cir. 2001) (finding strong similarity of products insufficient to support reverse passing off claim without evidence of consumer confusion).

molds.<sup>101</sup> The district court held that § 43(a) claims would be “subsumed by copyright law only in so far as it attempts to protect against copying or is a claim based on a right equivalent to the exclusive rights within the scope of the copyright”.<sup>102</sup> The § 43(a) cause of action would not be subsumed, however, when the plaintiff’s damage was the result of consumer confusion, which is the focus of trademark claims.<sup>103</sup> In so holding, the court rejected a bodily appropriation or substantial similarity requirement because either of these situations could lead to consumer confusion.<sup>104</sup>

Although each of these approaches requires a likelihood of confusion according to the statutory language of § 43(a), only the bodily appropriation and substantial similarity tests put additional limitations on § 43(a) protection of moral rights. The bodily appropriation approach has the strictest standards and therefore offers the least protection to the right of attribution when original works are copied. The substantial similarity approach has a slightly lower standard because it does not require identical copying, so it offers more protection of moral rights than the bodily appropriation approach. But the third approach merely requiring a likelihood of confusion offers the broadest protection to moral rights because it imposes no other restrictions about how much of a work is copied.

The three approaches to § 43(a) protection of moral rights were designed to prevent trademark law from duplicating copyright claims. Yet, as the *Dastar* decision demonstrated, the Supreme Court favored an even more restrictive reading of § 43(a) as a protector of moral rights.

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101. *Campbell v. Osmond*, 917 F. Supp. 1574, 1577 (M.D. Fla. 1996).

102. *Id.* at 1583. The defendant’s motion for summary judgment on the Lanham Act claim was denied. *Id.*

103. *Id.* To prevail on a trademark claim for unfair competition or infringement, a party must show, among other things, that consumers are likely to be confused between two similar marks to prove trademark infringement. Lanham Act § 43(a)(1)(A). To prove copyright infringement, a party must show, among other things, substantial similarity between the protectable elements of the original and the copied work. *Steinberg v. Columbia Pictures Indus., Inc.*, 663 F. Supp. 706, 711 (S.D.N.Y. 1987).

104. The court explained that “just as a bodily appropriation could lead to consumer confusion as to the actual authorship of the good, so too could a defendant’s production of a work which is ‘substantially similar’ to the plaintiff’s.” *Campbell*, 917 F. Supp. at 1582.

## B. SUPREME COURT RESOLUTION

The Supreme Court's decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.* has emptied Lanham Act § 43(a) of much, if not all, of its power to protect a creator's attribution right.

The story behind the conflict between petitioner Dastar and respondent Fox began in 1948, when General Dwight D. Eisenhower wrote *Crusade in Europe*, a memoir of his experiences as the overall leader of the allied military in Europe during World War II.<sup>105</sup> The memoir was published and copyrighted in 1948 by its publisher, Doubleday, which then granted Fox exclusive television rights in the book.<sup>106</sup> Fox, in turn, hired Time, Inc. to develop a television series based on the book.<sup>107</sup> Time's television series, called *Crusade in Europe* like the book, was produced as a series of episodes containing film footage from various military and news media sources<sup>108</sup> and a narration based on Eisenhower's memoir. The series first aired in 1949.<sup>109</sup> Although Doubleday renewed its copyright in the book, Fox let its copyright in the television series lapse and it entered the public domain in 1977.<sup>110</sup> In 1988, Fox again acquired rights to the television series and granted SFM Entertainment and New Line Home Video exclusive distribution rights to restore the original television series and to sell it.<sup>111</sup>

Dastar, anticipating renewed interest in the events of the allied forced in Europe on the eve of the fiftieth anniversary of the conclusion of World War II, acquired the original 1949 television series, which was in the public domain, made arguably minor variations to it<sup>112</sup> and

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105. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 124 S. Ct. 2041, 2044 (2003).

106. *Id.*

107. *Id.* Time assigned the copyright in the television series to Fox.

108. *Id.* The sources of the film footage included "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'."

109. *Id.*

110. *Id.*

111. *Id.*

112. Dastar's Campaigns series is slightly more than half as long as the

original *Crusade* television series. Dastar substituted a new opening sequence, credit page, and final closing for those of the *Crusade* television series; inserted new chapter-title

called it “Campaigns in Europe.” Dastar sold this new version of the Crusade in Europe videos as its own product without mentioning respondents or the original Crusade in Europe video series.<sup>113</sup> In response, Fox and other respondents sued Dastar for copyright infringement on the Crusade in Europe book, reverse passing off under Lanham Act § 43(a), and state unfair competition law.<sup>114</sup>

Both parties moved for summary judgment, but the District Court sided with Fox on all three claims.<sup>115</sup> On appeal, the Court of Appeals for the Ninth Circuit reversed and remanded the judgment regarding the copyright infringement claim, but affirmed the federal and state unfair competition claims. Specifically, the Ninth Circuit found that Dastar’s extensive copying of Fox’s Crusade in Europe television series while representing that the new series was its own amounted to a bodily appropriation of that creative work.<sup>116</sup> The Supreme Court granted certiorari to resolve the three-way circuit split regarding the elements of a § 43(a) reverse passing off claim.<sup>117</sup>

The Court’s analysis began with defining the term “origin” in § 43(a)’s reference to falsely designating a good’s origin.<sup>118</sup> The Court kept in mind that the purpose of trademark law is to protect the marks that consumers associate in their minds with a particular manufacturer. Origin in § 43(a) was defined as the producers of the physical goods sold on the market.<sup>119</sup> In choosing this “natural understanding” of the

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sequences and narrated chapter introductions; moved the “recap” in the Crusade television series to the beginning and retitled it as a “preview”; and removed references to and images of the book. Dastar created new packaging for its Campaigns series and (as already noted) a new title.

*Id.*

113. Dastar’s advertising specified: “ ‘Produced and Distributed by: Entertainment Distributing’ (which is owned by Dastar)” and its video’s “screen credits state ‘DASTAR CORP presents’ and ‘an ENTERTAINMENT DISTRIBUTING Production,’ and list as executive producer, producer, and associate producer, employees of Dastar.” *Id.*

114. *Id.* at 2044–45.

115. *Id.* at 2045.

116. *Id.*

117. Dastar Corp. v. Twentieth Century Fox Film Corp., 537 U.S. 1099 (2003).

118. See Lanham Act § 43(a).

119. In this case, the physical goods were the videos of Campaigns in Europe sold by Dastar. Dastar Corp. v. Twentieth Century Fox Film Corp., 123 S. Ct. 2041, 2047 (2003).

word “origin,” the Court departed from many past circuit and district court decisions that had used “origin” to indicate the first creator of a work, not the producer of it.<sup>120</sup> The Court sharply disagreed with the definition of origin as creator since “the phrase ‘origin of goods’ . . . is incapable of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain.”<sup>121</sup> Moreover, the Court noted, consumers are generally not interested in who created or invented a product that they purchase. They are more concerned with whether the quality of a product will be consistent with what they have grown to expect from a particular producer or manufacturer.<sup>122</sup> Trademark law is designed to give that interest protection.

Although the Court recognized that the situation might be different and consumers may indeed care about the creator of a work if the product is a “communicative” one, such as a book or play, it quickly declined to make such a distinction because doing so would blur the lines of the various types of intellectual property protection.<sup>123</sup>

The United States intellectual property schemes provide no protection against copying without proper attribution when a work is unprotected by either copyright or patent law.<sup>124</sup> This, the Court explains, is part of the “carefully crafted bargain” wherein Congress has agreed to give a limited-time monopoly over a certain invention or work of authorship in exchange for disclosure of that invention or work.<sup>125</sup> But after that limited-time monopoly has expired or, in the *Dastar* case, been allowed to lapse, the invention or work may be copied without credit and without mention of the original creator by anyone. The Court found that trademark law’s § 43(a) cannot

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120. *Id.*

121. *Id.*

122. *Id.*

123. *Id.* at 2047-48. See Jessica Bohrer, *Strengthening the Distinction Between Copyright and Trademark: The Supreme Court Takes a Stand*, 2003 Duke L. & Tech. Rev. 23, \*9 (2003) (observing that “the Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; because that is the purpose of patent law and its period of exclusivity”).

124. *Id.* at 2048 citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 121- 122 (1938); *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001).

125. *Id.* citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151 (1989). This “carefully crafted bargain” is the mechanism by which the constitutional goal to “progress science & Useful arts” is attained. U.S. CONST. art. 1, § 8, cl. 8.



circumvent this carefully crafted bargain by creating a cause of action for an uncredited creator because in doing so it “would create a species of mutant copyright law that limits the public’s” right to copy without credit works and inventions in the public domain.<sup>126</sup> Thus, anyone could copy and sell “Hamlet” without attributing it to Shakespeare and do so without violating United States intellectual property law. Even when the creator of a communicative work is valuable to the public, this value is only protected through copyright or patent schemes, not the § 43(a) “backdoor” approach of trademark law.

Weighing heavily against § 43(a) protection for rights of attribution is the fact that trademark law was created with a consumer focus, not a creator focus. The Lanham Act is meant to protect consumers from deception about goods’ source of production so they can rely on a mark to indicate consistent quality. Creators’ right of attribution is not protected by § 43(a).

On a more practical level, the Court considered two problems copiers would face if § 43(a) created a right of attribution for creative works that had fallen into the public domain.<sup>127</sup> First, it would be difficult for copiers to determine who should receive an attribution credit and how far back into the genealogy of a work it would need to acknowledge contributors.<sup>128</sup> Even in *Time’s* original *Crusades in Europe* television series, the film footage was derived from a number of different sources.<sup>129</sup> Justice Scalia doubted that “the Lanham Act requires this search for the source of the Nile and all its tributaries.”<sup>130</sup> Second, allowing § 43(a) to impose a right of attribution for copied works in the public domain puts copiers between a figurative rock and a hard place. They could choose to credit the originators of the work, but

126. *Id.* at 2048.

127. *Id.* at 2049.

128. Justice Scalia gives a convincing example of this practical problem: A video of the MGM film *Carmen Jones*, after its copyright has expired, would presumably require attribution not just to MGM, but to Oscar Hammerstein II (who wrote the musical on which the film was based), to Georges Bizet (who wrote the opera on which the musical was based), and to Prosper Merimee (who wrote the novel on which the opera was based).

*Id.*

129. *See supra* note 108.

130. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 124 S. Ct. 2041, 2049 (2003).

then they would be liable for implying that the creator sponsored or approved of the copy under Lanham Act § 43(a)(1)(A). Or, they could choose not to credit the originators of the work, but then they would be liable for false designation of origin under § 43(a).<sup>131</sup> This could effectively deprive the public of their right to copy a work in the public domain altogether.

Lastly, the Court pointed out that using “origin” to refer to the creator of a work so that § 43(a) protected a creator’s right to attribution would conflict with several of the Court’s other decisions.<sup>132</sup> For example, in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* the Court held that Samara’s clothing designs were not inherently distinctive trade dress<sup>133</sup> that would support a reverse passing off claim against Wal-Mart for selling knockoffs of Samara’s designs. Although Samara was the creator of the clothing designs, it also needed to demonstrate that its trade dress identified Samara as the source or manufacturer of the clothing designs before it could sustain a cause of action under § 43(a) against Wal-Mart for copying those clothing designs. If creating the clothing designs automatically made Samara the “origin” or source of the clothing, the Court would not have required a separate finding that the trade dress identified Samara as the manufacturer.<sup>134</sup> Likewise, the respondent’s definition of origin would undermine the Supreme Court’s decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* that plaintiffs had no § 43(a) cause of action when defendants copied their unpatented boat hulls.<sup>135</sup> Without patent or copyright protection, Bonito Boats could not protect its design with § 43(a) because it was not source-indicating. The holding in *Traffix Devices, Inc. v. Marketing Displays, Inc.* would also be voided by allowing § 43(a) to indicate creation rather than production. In that case, Traffix Devices reverse engineered and copied Marketing Display’s road signs once their patent expired and they were in the

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131. Dastar, 124 S. Ct. at 2049.

132. *Id.*

133. Trade dress is the term given to the design or packaging of a product that is distinctive or has acquired secondary meaning so that it serves as a source identifier. *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 121 S.Ct. 1255, 1259-60 (2001).

134. Dastar, 124 S. Ct. at 2049, citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

135. *Id.* at 1250 citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

public domain. If respondent's definition of origin in § 43(a) applied, Traffix would have had to credit the original inventor of the road signs or the firm to which the road signs' patent was assigned.<sup>136</sup> But the Court held that Traffix's road signs that were not protected by patent could also not be protected from copying under § 43(a) since they were functional and not source-indicating.

Although the *Dastar* decision left no doubt that § 43(a) would not support a creator's right of attribution through a reverse passing off claim, the Court did not go so far as to say that Fox could have no recourse at all for the copying. Fox would have had a simple case for copyright infringement, the Court chided, if it had not neglected to renew its copyright in the television series in 1977.<sup>137</sup> Whether Fox could prevent the copying of its television series via a claim for copyright infringement on the *Crusade in Europe* book, for which Doubleday still held a copyright, was left unanswered by the Court.<sup>138</sup> The Court also suggested that the creator may have a cause of action against a copier under § 43(a)(1)(B) for false advertising "[i]f . . . the producer of a video that substantially copied the *Crusade* series were, in advertising or promotion, to give purchasers the impression that the video was quite different from that series."<sup>139</sup>

### III. RAMIFICATIONS OF DASTAR

The Supreme Court's *Dastar* opinion sets forth an unambiguous interpretation of reverse passing off under § 43(a) of the Lanham Act that sounds the death knell for § 43(a)(1)(A) protection of moral rights. The Supreme Court established a brightline rule rejecting any action seeking credit for authorship through the Lanham Act, for both works that have entered the public domain (like *Time's Crusade in Europe* television series) and works that are still copyrighted.<sup>140</sup> It is

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136. Transcript of Oral Argument for *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 2003 WL 1876459, at \*23-4 (Apr. 2, 2003).

137. *Id.*

138. *Id.* at 2045 n.2 (expressing "no opinion as to whether petitioner's product would infringe a valid copyright in *General Eisenhower's book*"). At the time this paper was written, the Ninth Circuit had determined on remand that *Dastar* had not violated state unfair competition law, but the copyright infringement claim was still undecided. *Twentieth Century Fox Film Corp. v. Dastar Corp.*, 68 U.S.P.Q.2d 1536 (BNA) (C.D. Cal. 2003).

139. *Id.* at 2050.

140. *Copyright Reigns*, supra note 60, at 1031.

uncertain, however, what legal options the decision leaves intact for creators seeking authorship credit.

With one of the backdoor methods of protecting moral rights gone, and only one legislatively-created right of attribution (VARA), creators are forced to try to fit claims for their moral rights promised by the United States membership in the Berne Convention into ill-fitting legal theories. Though there are several options through which creators may seek attribution rights, each has severe drawbacks.

#### A. STATEMENT OF ATTRIBUTION AFFIXED TO WORK

One solution might be to implement a mandatory system of attribution by affixing a label to a good or service acknowledging its creator while disclaiming that creator's certification of the good or service so that § 43(a)(1)(A) liability will not be invoked. This mimics the old copyright scheme where affixing a notice of copyright ownership to the work was a prerequisite to bringing an infringement claim.<sup>141</sup> While this may seem like an obvious solution to the problem of attribution rights, it has several flaws.

First, it ignores the practical problem Justice Scalia described in *Dastar*: how far into the history of a work does one have to credit its creators?<sup>142</sup> Drawing a hard line between which creators' derivative works are too far back in history and which are close enough to be attributed would be difficult and arbitrary. To take a simplistic example, *Dastar*'s video series was a derivative work of Time's original *Crusade in Europe* television series, which was a derivative work of General Eisenhower's book.<sup>143</sup> Would the notice of attribution require Time alone to be credited, or both Time and Eisenhower?

Second, requiring a notice of attribution when a work is copied disrupts the "carefully crafted bargain"<sup>144</sup> between species of federal intellectual property law. Since copyright law is meant to prohibit copying a creator's work, trademark law should not be used to require attribution of a work.<sup>145</sup> Using the Lanham Act to prevent unaccredited

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141. Nimmer on Copyright § 7.02(C) (2003).

142. See *supra* notes 127-131 and accompanying text.

143. *Ochoa's Introduction*, *supra* note 27, at 917

144. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1989).

145. *Database Protections*, *supra* note 66, at 489.

copying of a copyrighted work obscures the boundaries of copyright and trademark protection by creating an overlap that will automatically convert copyright actions into trademark actions. This is the kind of blurring of the types of intellectual property law that the courts repeatedly strive to avoid.

A third problem is that affixing a notice of attribution based on knowledge of a work's copyright owner does not necessarily protect the creator of the work. This situation could arise if copyright ownership has been assigned or otherwise transferred to someone other than the creator. For example, under the work for hire doctrine an employer owns the copyrights to works "prepared by an employee working in the scope of his or her employment".<sup>146</sup> Thus, the work for hire doctrine treats the employer as the author of the copyrighted work<sup>147</sup> and entitles the employer to the economic benefit associated with the work even though the employer was not the creator of the work.<sup>148</sup> In these situations where the copyright holder is different than the creator, it is questionable whether mere ownership of copyright should allow a party to stand in the shoes of the creator and sue on her behalf, even when the original creator did not herself choose to sue.<sup>149</sup> This would blur the

146. Copyright Act § 101. A work for hire may also be work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

*Id.*

147. Copyright Act § 201(b). This designation may be altered if the parties expressly agree otherwise in writing. *Id.*

148. *Clashing Rights*, supra note 15, at 234.

149. Even if the Lanham Act should be construed to give authors a right

of attribution, that right would belong to Eisenhower, the author of the book, or Time, Inc., which produced the television series based on the book. Fox is, at best, only a former copyright owner of the television series, and a licensee of the copyright in the book. SFM and New Line are merely the manufacturer and distributor of a home video version of the television series. While the plaintiffs may be competitors of the defendants, it is not the omission of the plaintiffs' names which would be actionable. The question is whether the plaintiffs should be permitted to stand in the shoes of Eisenhower's heirs and/or Time, Inc., in order to assert a

lines between trademark (where competitors sue each other for diminishing the competitive value afforded by their marks due to confusion or dilution) and copyright (where authors sue each other for copying copyrighted works). Thus, a creator's right of attribution would escape protection when a notice of attribution was based on copyright ownership of a work that had been assigned or transferred, such as a work for hire.

## B. VISUAL ARTISTS RIGHTS ACT

A second approach to protecting moral rights is through VARA, the only federal United States statute that provides express rights of attribution and integrity to creators of certain works. But VARA's scope is very limited,<sup>150</sup> providing protection only to qualifying paintings, drawings, prints, sculptures, and exhibition photographs. Thus, VARA is inadequate to make up for the loss of trademark protection because it protects only certain works of "fine art."<sup>151</sup> In the *Dastar* case, for example, neither General Eisenhower's book nor Time's television series would have acquired moral rights through VARA.

Second, VARA provides inadequate protection because it is trumped by the work for hire doctrine. The economic rights in a work's commercial value and the moral rights in the work's authorship are separate and should not both have to vest in one entity.<sup>152</sup> But even though VARA recognizes the separability of copyright ownership and moral right ownership, it does not allow them to be separated in work for hire situations.<sup>153</sup> Thus, even if a work is within the category of paintings, prints, drawings, sculptures, and exhibition photographs that VARA protects, it may be denied protection because it was created during the course of employment.<sup>154</sup>

Third, it is not always certain when a work will be considered a work for hire<sup>155</sup> and when a work will be considered an otherwise

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right of attribution which neither has chosen to assert.  
*Ochoa's Introduction, supra* note 2727, at 920.

150. See notes 42-56 and accompanying text.

151. *Artists' Moral Rights, supra* note 2828, at 642.

152. *Id.* at 260-61.

153. See *supra* notes 52-56 and accompanying text.

154. *Id.* at 261.

155. *Clashing Rights, supra* note 15.

protectable work of visual art.<sup>156</sup> Thus, there is lack of certainty at the outset of a project regarding copyright ownership.

The Supreme Court clarified what comprised a work made for hire in *Community for Creative Non-Violence v. Reid*.<sup>157</sup> In that case, CCNV commissioned Reid, a sculptor, to make a sculpture of a homeless family as a modern day version of the traditional Nativity scene.<sup>158</sup> Although CCNV conceived the idea for the sculpture and both parties collaborated on deciding its details, Reid actually produced the work.<sup>159</sup> The parties' dispute began when CCNV wanted to take the sculpture on a tour around the country and Reid opposed the tour because he feared the sculpture's composition would not hold up against the rigors of nationwide touring.<sup>160</sup> Since CCNV would not recast the sculpture in a more durable material, Reid refused to give it back to them to take on the tour.<sup>161</sup> Both parties subsequently filed competing copyright registrations, and CCNV filed suit against Reid seeking a declaration of copyright ownership.<sup>162</sup>

The District Court determined that the copyright belonged to CCNV because the sculpture was a work made for hire,<sup>163</sup> but the Court of Appeals for the District of Columbia disagreed, finding Reid the proper owner of the copyright since it was not a work made for hire.<sup>164</sup> The Supreme Court granted certiorari<sup>165</sup> to decide the proper test for defining employment for purposes of the work for hire doctrine and to resolve a four-way circuit split. In a unanimous decision, the Court decided that the terms "employee" and "scope of employment" in the work for hire provision of the Copyright Act should be construed according to common law agency principles.<sup>166</sup> Noting that, for

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156. *Carter v. Helmsley-Spear, Inc.*, 861 F. Supp. 303 (S.D.N.Y. 1994), *aff'd in part, vacated and rev'd in part*, 71 F.3d 77 (2d Cir. 1995).

157. 490 U.S. 730 (1989).

158. *Id.* at 733.

159. *Id.* at 733-35.

160. *Id.* at 735.

161. The sculpture was cast in "Design Cast 62" rather than Reid's initial recommendation of casting in bronze because of CCNV's budget constraints. *Id.* at 733-34.

162. *Id.* at 735.

163. *Id.* See 652 F. Supp. 1453 (D.D.C. 1987).

164. *Id.* at 736. See 846 F.2d 1485 (D.C. Cir. 1988).

165. *Id.* See 488 U.S. 940 (1988).

166. *Id.* at 739-40. The court found that other proposed definitions of "employee", such as the right of the hiring party to control the product, the

purposes of defining employment under the work for hire doctrine, common law agency principles must be in a sense “federalized,” the Court pronounced thirteen factors (the so-called “Reid factors”) used to determine whether a hired party is an employee according to common law agency, including:

the hiring party’s right to control the manner and means by which the product is accomplished . . . ; the skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party’s discretion over when and how long to work; the method of payment; the hired party’s role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party.<sup>167</sup>

But it is questionable whether a list of thirteen factors really enhances the certainty of copyright ownership at the outset of a commissioned project. Indeed, the circuit courts have not been

hiring party’s actual control over a particular work and formal salaried employees only were “[in]consistent with the text of the Act.” *Id.* at 741.

167. *Id.* at 751-52 (footnotes omitted). The Court found that, according to these factors, Reid’s sculpture was not a work made for hire, so Reid owned the copyright.

CCNV members directed enough of Reid’s work to ensure that he produced a sculpture that met their specifications. But the extent of control the hiring party exercises over the details of the product is not dispositive. Indeed, all the other circumstances weigh heavily against finding an employment relationship. Reid is a sculptor, a skilled occupation. Reid supplied his own tools. He worked in his own studio in Baltimore, making daily supervision of his activities from Washington practicably impossible. Reid was retained for less than two months, a relatively short period of time. During and after this time, CCNV had no right to assign additional projects to Reid. Apart from the deadline for completing the sculpture, Reid had absolute freedom to decide when and how long to work. CCNV paid Reid \$15,000, a sum dependent on completion of a specific job, a method by which independent contractors are often compensated. Reid had total discretion in hiring and paying assistants. ‘Creating sculptures was hardly ‘regular business’ for CCNV.’ Indeed, CCNV is not a business at all. Finally, CCNV did not pay payroll or Social Security taxes, provide any employee benefits, or contribute to unemployment insurance or workers’ compensation funds.

*Id.* at 752-53 (citations omitted).



consistent in their application of the *Reid* factors, leading to varying determinations on the work for hire doctrine among the circuits.<sup>168</sup> Thus, the laundry list of factors used to determine who will retain copyright ownership at the outset of a project has not fulfilled its goal of making copyright ownership certain.

*Carter v. Helmsley-Spear, Inc.* is notable because it is the first case examining VARA and the work for hire doctrine in the same setting. In that case, the plaintiffs were three sculptors who contracted with the defendants to build a large walk-through sculpture in the lobby of defendants' building.<sup>169</sup> But when defendants filed for Chapter 7 Bankruptcy, they ordered the plaintiffs to cease work on the sculpture.<sup>170</sup> Fearing that their work would be altered or removed, the plaintiffs sued defendants based on VARA rights. The District Court decided that the plaintiffs' moral rights in the sculpture were protected by VARA because the sculpture was a work of visual art.<sup>171</sup> Relevant to this determination was that the sculpture was considered a single work of art,<sup>172</sup> was not applied art,<sup>173</sup> and was not a work made for hire.<sup>174</sup>

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168. See *Clashing Rights*, *supra* note 15, at 256-60.

Some of the circuits that have confronted the Reid Factors have added new factors or shaped the list of Reid Factors into some type of structured or weighted approach. For example, in 1992, the Third Circuit in *Marco v. Accent Publishing Co.* added three more agency principles to the Reid Factors, as well as, an 'actual control' factor. The Sixth Circuit has also considered factors not enumerated in Reid. In *Hi-Tech Video Productions Inc. v. Capital Cities/ ABC Inc.*, the Sixth Circuit gave great weight to the parties' own perception of their relationship. Another approach, formulated by the Second Circuit, was a weighted application consisting of five relevant Reid Factors. This approach, articulated in *Aymes v. Bonelli* and followed in *Carter*, focuses on the significant factors and discards the irrelevant or indeterminate factors. These different approaches, while all employing some type of weighting system, continue to evolve with work for hire case law.

*Id.* at 257 (footnotes omitted).

169. *Carter v. Helmsley-Spear, Inc.*, 861 F. Supp. 303, 312 (S.D.N.Y. 1994), *rev'd in part, aff'd in part*, 71 F.3d 77 (2d Cir. 1995).

170. *Id.* at 313.

171. *Id.* at 322.

172. Although the elements of the sculpture were attached to various locations in the lobby, the effect was to have a single sculpture incorporating many interrelated parts. *Id.* at 314. Thus, the sculpture fits into the statutory definition of works of visual art covered by VARA, which requires the work to exist as a "single copy". Copyright Act § 101.

The Court of Appeals for the Second Circuit disagreed.<sup>175</sup> In examining the District Court's ruling that the plaintiffs were not employees under the work made for hire doctrine, the Court of Appeals found the plaintiffs were in full control of the "manner and means of production" of the work and their sculpture required a high degree of skill.<sup>176</sup> Although these two factors weigh against finding the plaintiffs were employees, the Court of Appeals also found that defendants put plaintiffs on the payroll, paid their social security taxes, and gave them benefits.<sup>177</sup> Additionally, the employment contract specified that the defendants could assign additional projects, which occurred on three separate occasions without increasing plaintiffs' pay.<sup>178</sup> These latter factors led the Court of Appeals to find that the plaintiffs were employees within the work for hire doctrine.<sup>179</sup> The plaintiffs' status as employees rendered their sculpture outside the definition of a work of visual art and thus it was not protected by VARA.<sup>180</sup>

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173. In so holding, the court found that the sculpture did not become applied art simply because pieces of the sculpture were attached to otherwise utilitarian objects. *Id.* at 315-16.

174. Plaintiffs had autonomy to control the manner and means of creation, were skilled artisans who employed their considerable skill in creating the Work, were not subject to assignment of projects unrelated to that which they were hired to accomplish, had no prior relationship with the hiring party and would work for the hiring party only until the completion of the project, had significant discretion to determine when and how long to work, and the creation of works of art was not part of the hiring party's regular business nor a pursuit necessary to the accomplishment of the hiring party's business objectives. . . . [Finding that the plaintiffs are independent contractors] is bolstered by a plus factor: Plaintiffs own the copyright to the Work. This indicates that the hiring and hired parties considered plaintiffs to be independent contractors.  
*Id.* at 322.

175. *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77 (2d Cir. 1995). However, the Second Circuit agreed that the sculpture was a single work of art and was not applied art. *Id.* at 84-5.

176. *Id.* at 86.

177. *Id.* at 86-87.

178. *Id.* at 86.

179. *Id.* at 87.

180. In addition to being on defendants' weekly payroll, plaintiffs under their contract could be and were in fact assigned projects in addition to the work in the lobby; they were paid a weekly salary for over two years for a contracted

This opinion is important because it reinforces the problem introduced by *Community for Creative Non-Violence v. Reid* that whether a work is covered by the work for hire doctrine is far from certain, despite the thirteen *Reid* factors. Moreover, *Carter v. Helmsley-Spear, Inc.* demonstrates that whether a work is considered a work of visual art protected by VARA is also subject to dispute and litigation. For example, whether the sculpture was a “single copy” and whether it was applied art were both disputed. These uncertainties in fitting a particular work into the definition of visual works of art, coupled with disputes about employee status, make copyright ownership and moral rights enforcement quite uncertain.

The ambiguity in determining which works are protectable under VARA because of status as a work of visual art and which works are not protectable because of status as a work for hire fosters unpredictability in copyright law, a result that Congress generally avoids.<sup>181</sup> Therefore, VARA is insufficient to make up for the moral rights lost through *Dastar*.

### C. FALSE ADVERTISING UNDER § 43(a)(1)(B)

Since Fox did not raise claims<sup>182</sup> under § 43(a)’s false advertising prong,<sup>183</sup> whether this portion of federal unfair competition law may be used as a backdoor to give attribution rights to creators is

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40 hours of work per week; they were furnished many of the needed supplies necessary to create the work; and plaintiffs could not hire paid assistants without defendants’ consent.

*Id.* at 88.

181. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 749 (1989).

182. Transcript of Oral Argument for *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 2003 WL 1876459, at \*19 (Apr. 2, 2003).

183. 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 . . . 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 or is likely to be damaged by such act.

Lanham Act § 43(a)(1)(B).

open to interpretation. In fact, the Supreme Court itself suggested in a hypothetical fact pattern that if *Dastar* had not only copied Time's television series but had also represented to consumers that their video collection was "quite different" from Time's series, Fox might have had a claim under § 43(a)(1)(B), the false advertising prong.<sup>184</sup>

It has been speculated that certain cases that had previously used the false designation of origin backdoor would have been successful under the false advertising prong. For example, in *Smith v. Montoro*,<sup>185</sup> the use of a false actor's name in advertising the movie may constitute a false advertising claim.<sup>186</sup>

Although the Supreme Court left this possibility of backdoor attribution rights open, it would be a very limited approach to securing moral rights even if it could be used after the *Dastar* decision. Most importantly, § 43(a) false advertising claims are limited to "commercial advertising and promotion" situations.<sup>187</sup> In other words, the producer would need to falsely represent something about the content of his product during its advertising or promotion. Further, some courts have construed this phrase narrowly, which would make it even less practical.<sup>188</sup>

Other commentators do not believe § 43(a)'s false advertising prong would be helpful to authors seeking attribution because its false

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184. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041, 2050 (2003).

185. See *supra* note 79-86 and accompanying text.

186. *McCarthy on Trademarks* § 27:85.

187. Lanham Act § 43(a)(1)(B), *supra* note 65. Courts have generally interpreted this phrase to require commercial speech made by a party in commercial competition with the plaintiff and disseminated sufficiently to consumers. *Proctor & Gamble Co. v. Haugen*, 222 F.3d 1262, 1274-75 (10th Cir. 2000) (holding that defendant's distribution of message that plaintiff was an agent of Satan not actionable under § 43(a)(1)(B)); *Podiatrist Ass'n, Inc. v. La Cruz Azul De Puerto Rico, Inc.*, 332 F.3d 6, 19 (1st Cir. 2003) (dismissing complaint under § 43(a)(1)(B) because defendant distributed message to particular individuals, not a class of consumers); *Fashion Boutique of Short Hills, Inc. v. Fendi USA, Inc.*, 314 F.3d 48, 58 (2d Cir. 2002) (dismissing claim because plaintiffs had not shown wide distribution to consumers). The speech need not be formal advertising, but may be more informal types of promotion. *Gmurzynska v. Hutton*, 355 F.3d 206, 210 (2d Cir. 2004) (finding statements that art was not authentic not disparaging under the Lanham Act).

188. *McCarthy on Trademarks and Unfair Competition* § 27:77.1 n.14.

designations of origin used in advertising contexts would be restricted to representations regarding the geographic origin of the product.<sup>189</sup> In light of these limitations, the false advertising prong at best provides the mere hope of a residual backdoor approach to moral rights via trademark law after *Dastar*.

#### D. CONTRACT LAW

A fourth method of protecting creators' moral rights after *Dastar* is to do so by contract. Even before *Dastar*, certain industries in which attribution is important have engaged in self regulation through, for example, anti-plagiarism codes and collective bargaining agreements.<sup>190</sup> Likewise, producers of tangible products often contract with distributors to relinquish their own rights of creating the project and allowing the distributor to sell the products with its own mark.<sup>191</sup> The *Dastar* decision did not disturb such private methods of ensuring or relinquishing moral rights. In a contest between contract rights and federal or state intellectual property rights, contracts have preempted intellectual property law.<sup>192</sup>

The problem with a contracts approach to enforcement of moral rights is that it requires a preexisting relationship between the creator and the copier. Without an established relationship, there is no way for a creator to take precautionary measures to protect her creation. In *Dastar*, for example, the parties had no opportunity to contract because they were not in an established relationship before the lawsuit was instituted. Contrariwise, Fox presumably had no way of anticipating that Dastar Corp. was even interested in its Crusade in Europe series. Thus, while use of contracts to protect moral rights may be sufficient when the contract actually exists, contractual moral rights protection is severely limited because it requires parties to have a preexisting relationship. Contract law is therefore an inadequate method to protect moral rights.

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189. *Copyright Reigns*, *supra* note 60, at 1032-33.

190. *Id.* at 1033-34.

191. *Copyright Reigns*, *supra* note 60, at 1034.

192. *See, e.g.,* *Bear Creek Prods., Inc. v. Saled*, 643 F. Supp. 489, 493-94 (S.D.N.Y. 1986); *Aronson v. Quick Point Pencil Co.; Lear*.

## IV. CONCLUSION

The ruling for petitioner *Dastar* calls into question whether the United States is providing adequate moral rights to support its membership in the Berne Convention. When the United States first joined the Berne Convention, Congress reasoned that additional legislation creating an express right of attribution was unnecessary because existing tort and intellectual property law, including unfair competition which is federalized in § 43(a), was sufficient to protect moral rights.<sup>193</sup> But the judiciary seems to have disagreed with the legislature on this point since the Supreme Court ruled that § 43(a) could not be used to protect moral rights. Therefore, if Congress ever thought the Lanham Act helped the United States comply with the Berne Convention, the decision in *Dastar* restricting reverse passing off to offenses against *manufacturers* should serve as a warning that existing law is not adequate to protect creators' moral rights.

The previous use of § 43(a) to protect attribution rights was troubling because it was often used not to protect the creator of the work, but the party that held the copyright to that work.<sup>194</sup> The Berne Convention requires attribution to the creator, regardless of whether the work is copyrighted and whether the creator is indeed the copyright holder. If § 43(a) could have been used to protect moral rights, it would have only worked where the copyright holder and the creator were the same entity. Even in *Dastar*, the party that brought the reverse passing off claim was not the creator of the work whose origin was allegedly falsely designated. If § 43(a) had been able to be used to protect the creator of the work, General Eisenhower's descendants or Time should have been the party asserting the claim against *Dastar*. But though § 43(a) was never an adequate moral rights protector, creators have even less legal recourse to protect their moral rights now that § 43(a) offers no protection at all.

The lack of legal recourse that creators have to protect their moral rights after *Dastar* does not indicate that *Dastar* was decided improperly. Rather, the Supreme Court properly reigned in the expansive readings that circuit courts had been giving to § 43(a)'s

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193. See *supra* notes 31-32 and accompanying text.

194. "Article 6bis of the Berne Convention requires that rights of attribution be given to authors, not former copyright owners." *Ochoa's Introduction, supra* note 27, at 927-28.

“false designation of origin” language. The Court’s decision reinforced that the proper purpose of trademark law is to protect consumers and producers, not creators. In restoring trademark law to its rightful place, the Court drew clearer boundaries between copyright and trademark law.

Thus, although the *Dastar* decision adds to the plight of creators seeking to protect their rights of attribution, their battle is not with the Supreme Court but with Congress. The *Dastar* decision should reinforce the need for legislature that would clearly delineate moral rights for all creators.<sup>195</sup>

*Teresa Laky*

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195. [I]f the United States intends to actually fulfill its obligation under

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

*Id.*, at 928-29.