

2012

Dastar's Next Stand

Mark McKenna

Notre Dame Law School, markmckenna@nd.edu

Follow this and additional works at: https://scholarship.law.nd.edu/law_faculty_scholarship



Part of the [Entertainment, Arts, and Sports Law Commons](#), and the [Intellectual Property Law Commons](#)

Recommended Citation

Mark McKenna, *Dastar's Next Stand*, 19 J. Intell. Prop. L. 357 (2011-2012).

Available at: https://scholarship.law.nd.edu/law_faculty_scholarship/621

This Article is brought to you for free and open access by the Publications at NDLScholarship. It has been accepted for inclusion in Journal Articles by an authorized administrator of NDLScholarship. For more information, please contact lawdr@nd.edu.

DASTAR'S NEXT STAND

Mark P. McKenna*

TABLE OF CONTENTS

I.	THE <i>DASTAR</i> DECISION.....	364
II.	<i>DASTAR</i> 'S LIMITATIONS, AND OPEN QUESTIONS	373
III.	CONTENT-BASED CLAIMS AND THE SPIRIT OF <i>DASTAR</i>	380
IV.	CONCLUSION.....	387

* Professor of Law and Notre Dame Presidential Fellow, Notre Dame Law School. Thanks to Stacey Dogan, Glynn Lunney, Mike Madison, and Rebecca Tushnet for helpful discussions of the ideas in this Essay, and to the participants at the University of Georgia School of Law's Symposium on the Future of Intellectual Property and the 2012 Intellectual Property Scholars Conference at Stanford Law School for feedback on earlier drafts.

A number of recent cases have involved Lanham Act claims against unauthorized uses of the plaintiff's creative works. The magician Teller, for example, sued another magician for copyright infringement and false designation of origin for the latter's alleged copying of one of Teller's well-known magic tricks—the “highly innovative and unusual dramatic work ‘Shadows.’”¹ Edgar Rice Burroughs sued the publisher of *Warlord of Mars*, a comic book series “based on” the John Carter of Mars series. Despite apparent accusations that the publisher had created unauthorized derivative works, ERB's complaint notably did not allege copyright infringement under United States law; with the exception of a claim of copyright infringement under the law of the United Kingdom, all of ERB's claims were Lanham Act claims.² The owner of the copyrights in the Darkover series of novels sued the author of *Molly of Darkover* and *Women of Darkover* for copyright and trademark infringement for her unauthorized use of “Darkover” in the titles of her books and her setting of the books on the planet of Darkover.³ And perhaps most famously, Fleischer Studios, owner of the formerly copyrighted Betty Boop character, sued the seller of t-shirts that depicted Betty Boop for trademark infringement.⁴

Another group of recent cases involved claims of trademark infringement where the marks at issue originated more conventionally—meaning the claimed marks did not arise out of creative works themselves—but the defendant's allegedly infringing use was within the content of an expressive work. Louis Vuitton sued the producers of the movie *The Hangover Part II*, for example, alleging that inclusion of fake Louis Vuitton bags in the movie and a reference to one of the bags as a “Lewis Vuitton” constituted false designation of origin under § 43(a), as well as common law unfair competition and trademark dilution under New York law.⁵ The University of Alabama sued Daniel Moore, an artist

¹ Complaint, *Teller v. Dogge*, 2:12-cv-00591 (D. Nev. Apr. 11, 2012), available at <http://james.grimmelmenn.net/files/legal/teller-v-dogge-complaint.pdf>.

² Complaint, *Edgar Rice Burroughs, Inc. v. Dynamic Forces Entm't, Inc.*, 1:2012-cv-01192 (S.D.N.Y. Feb. 12, 2012) (alleging infringement of various Tarzan and John Carter of Mars marks).

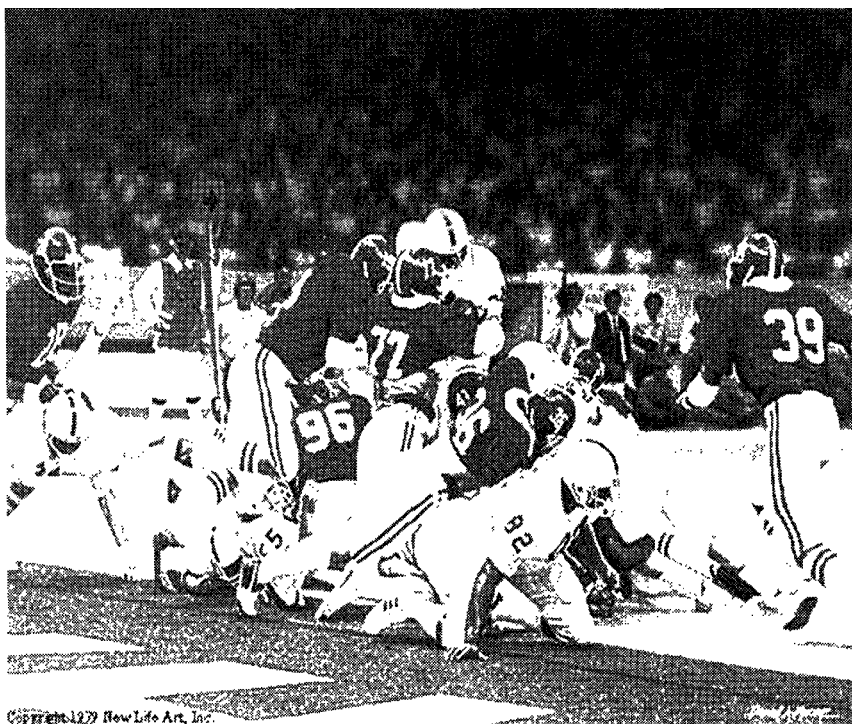
³ Complaint, *Marion Zimmer Bradley Literary Works Trust v. Battle*, 3:2012-cv-00073 (N.D. Cal. Jan. 5, 2012).

⁴ *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115 (9th Cir. 2011), *withdrawn*, *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011).

⁵ *Louis Vuitton Malletier S.A. v. Warner Bros. Entm't Inc.*, 11 Civ. 9436 (slip op. June 15, 2012) (<http://www.nysd.uscourts.gov/cases/show.php?db=special&id=189>). According to the court, Louis Vuitton alleged that

in one early scene in the Film the “four main characters in Los Angeles International Airport before a flight to Thailand for the character Stu's bachelor party and wedding.” “[A]s the characters are walking through the airport, a porter is pushing on a dolly what appears to be Louis Vuitton trunks, some

who paints scenes from Alabama football games (like the one below), claiming that Moore infringed its trade dress rights in the design of its football uniforms by depicting the uniforms in his paintings.⁶

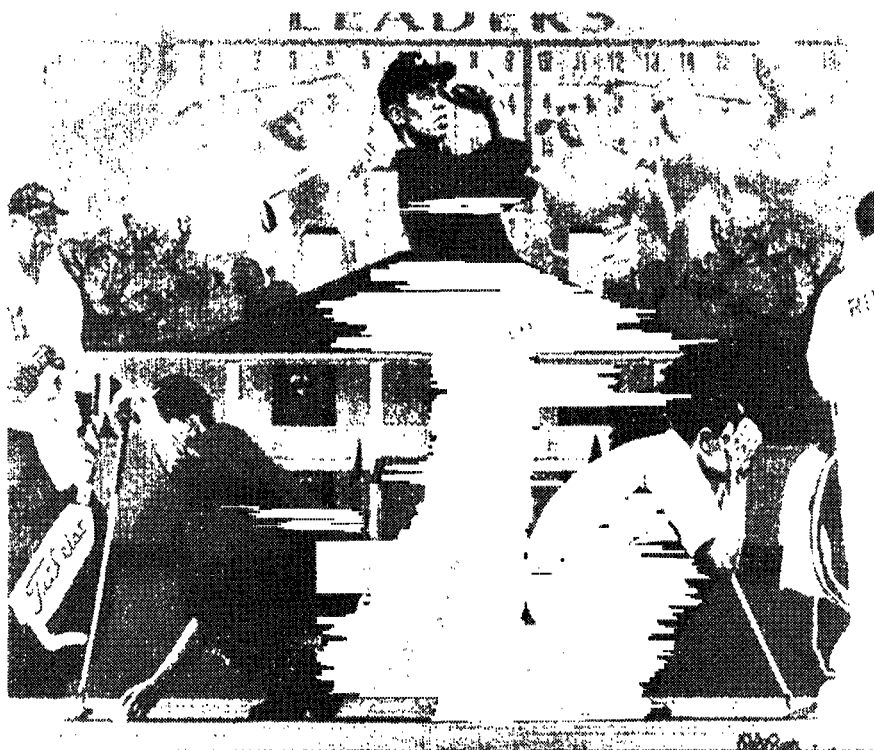


The University's lawsuit was reminiscent of Tiger Woods's trademark infringement and right of publicity suit against artist Rick Rush for depicting

hard-sided luggage, and two Louis Vuitton Keepall travel bags." Alan, one of the characters, is carrying what appears to be a matching over-the-shoulder Louis Vuitton "Keepall" bag, but it is actually an infringing Diophy bag. Moments later, Alan is seen sitting on a bench in the airport lounge and places his bag (i.e., the Diophy bag) on the empty seat next to him. Stu, who is sitting in the chair to the other side of the bag, moves the bag so that Teddy, Stu's future brother-in-law, can sit down between him and Alan. Alan reacts by saying: "Careful that is . . . that is a Lewis Vuitton." No other reference to Louis Vuitton or the Diophy bag is made after this point.

⁶ Univ. of Ala. Bd. of Trs. v. New Life Art, 683 F.3d 1266 (11th Cir. 2012). In the interest of full disclosure, I was the primary author of an amicus brief of intellectual property law professors supporting New Life Art in this case, and I argued before the Eleventh Circuit on behalf of amici. See *Brief of Amici Curiae Intellectual Property Law Professors in Support of Appellant*, Board of Trustees of the University of Alabama v. New Life Art, et al. (11th Cir. 2010).

Woods in limited edition prints celebrating champions of the Masters golf tournament.⁷



These cases put significant pressure on the boundary between copyright and trademark law, all of them raising, more or less directly, the question of the extent to which trademark law can be used to control expressive content.

One might have thought that the Supreme Court's decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.* would control these cases, or at least would give some clear guidance as to their resolution.⁸ After all, despite the fact that the Court resolved the case by interpreting the statutory language *origin of goods*, *Dastar* was animated in large part by the Court's concern that requiring attribution for creative content would turn trademark law into some "mutant" form of copyright protection.⁹ Thus, one might expect *Dastar* to serve the same

⁷ *ETW, Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

⁸ 539 U.S. 23 (2003).

⁹ See *id.* at 34 ("[A]llowing a cause of action under § 43(a) for that representation would create a species of mutant copyright law that limits the public's federal right to copy and to use expired

role in policing the trademark/copyright divide as *TrafFix* plays in the trademark/patent context¹⁰—such that *Dastar* would supply the rules by which courts determine when parties can use trademark claims to protect works of authorship. And such an expectation would not be entirely unmet: A number of courts have in fact read *Dastar* to bar false designation of origin claims where the claims were based on the defendant's misattribution of creative content.¹¹ Courts have even relied on *Dastar* to bar false advertising claims where the allegedly false statement related to the "origin" of content,¹² despite the fact that *Dastar* itself expressly left the door open to some types of false advertising claims.¹³

copyrights." (internal quotation marks omitted)). Many scholars have characterized *Dastar* as a case about the use of trademark law to avoid copyright law's limits, and particularly its durational limits. See, e.g., Christopher Sprigman, Indirect Enforcement of the Intellectual Property Clause, 30 COLUM. J.L. & ARTS 565, 584 (2007) (suggesting that "*Dastar*'s purposive interpretation of the Lanham Act" was most likely "driven by constitutional principles—specifically, a conception of the public domain that issues from the Intellectual Property Clause injunction directing that the federal copyright be for 'limited Times'").

¹⁰ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001) (holding that expired utility patents have "vital significance" in functionality determination and articulating a view of functionality that focuses on the relationship between trademark and patent law); see also Mark P. McKenna, (Dys)Functionality, 48 HOUS. L. REV. 823 (2011) (discussing *TrafFix* and its "right to copy" view of functionality, and the appellate courts' inconsistent application of the doctrine).

¹¹ See, e.g., *Romero v. Buhmschi*, 396 Fed. App'x 224 (6th Cir. 2010) (rejecting both false designation of origin and false advertising claims based on alleged wrongful denial of authorship credit); *Dutch Jackson IATG, LLC v. Basketball Mktg. Co.*, 846 F. Supp. 2d 1044 (E.D. Mo. 2012) (barring plaintiff's claim that was based on defendants' use of the plaintiff's musical work as part of the soundtrack to a basketball DVD); *Dorchen/Martin Assocs., Inc. v. Brook of Cheboygan, Inc.*, 838 F. Supp. 2d 607 (E.D. Mich. 2012) (rejecting plaintiff's false designation of origin claim where the defendant's alleged use of a design for an assisted living facility was based on a design the plaintiff had presented to the defendant and which the plaintiff did not authorize the defendant to reuse).

¹² See, e.g., *Romero*, 396 Fed. App'x 224; *Dutch Jackson*, 846 F. Supp. 2d at 1044 (also rejecting the plaintiff's false advertising claim on the ground that characterizing defendant's inclusion of the musical work as an implicit misrepresentation of the originality of the work (its "nature and characteristics") was an "impermissible workaround" of *Dastar*); *ZS Assoc., Inc. v. Synegy, Inc.*, No. 10-4274, 2011 WL 2038513 (E.D. Pa. May 23, 2011) (rejecting plaintiff's false advertising claims that were based on allegedly false attribution in a press release of the authorship of "sales performance management solutions").

¹³ *Dastar*, 539 U.S. at 38 ("If, moreover, 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, then one or more of the respondents might have a cause of action—not for reverse passing off under the 'confusion . . . as to the origin' provision of § 43(a)(1)(A), but for misrepresentation under the 'misrepresents the nature, characteristics [or] qualities' provision of § 43(a)(1)(B).").

Yet *Dastar's* reach remains unclear, largely because of the case's relatively unique factual context.¹⁴ Not only did the case involve formerly copyrighted material that had fallen into the public domain, but Fox appeared to be using the Lanham Act to avoid the consequences of having slept on its rights.¹⁵ Perhaps more significantly, the Court clearly felt that Fox's claim put *Dastar* in an impossible double bind: Fox claimed false designation of origin for failing to attribute the content, but there was a real risk, under another line of cases, that *Dastar* would have been exposed to a claim under § 43(a) if it *had* attributed.¹⁶ For these reasons at least, one could (wrongly, I think) see *Dastar* as a fairly unusual case with limited precedential value.

And many are inclined to read *Dastar* narrowly, because its holding remains deeply controversial. Several scholars fault the Court for failing to recognize the importance of authorial attribution to both authors and consumers.¹⁷ And

¹⁴ See Graeme B. Dinwoodie, *Concurrence and Convergence of Rights: The Concerns of the U.S. Supreme Court* 14, in *CROSSING BORDERS: BETWEEN TRADITIONAL AND ACTUAL* (Grosheide & Brinkhof eds., Hart Publ'g 2005) (noting that *Dastar's* scope is unclear, and noting many open questions: "Does it preclude actions under Section 43(a) only when the work could be (or was) protected by copyright? Would a product that failed to be sufficiently original to qualify for copyright be similarly treated? Does *Dastar* preclude actions only when the work is in the public domain by virtue of failure to renew copyright? . . . If a plaintiff can frame its action without using the phrase 'origin' in Section 43(a), does *Dastar* have any effect?").

¹⁵ *Dastar*, 539 U.S. at 37 ("The creative talent of the sort that lay behind the Campaigns videos is not left without protection. The original film footage used in the Crusade television series could have been copyrighted, see 17 U.S.C. § 102(a)(6), as the Crusade television series was copyrighted (as a compilation), even though it included material from the public domain, see § 103(a). Had Fox renewed the copyright in the Crusade television series, it would have had an easy claim of copyright infringement.").

¹⁶ *Id.* at 36 ("On the one hand, [*Dastar*] would face Lanham Act liability for *failing* to credit the creator of a work on which their lawful copies are based; and on the other hand they could face Lanham Act liability for *crediting* the creator if that should be regarded as implying the creator's 'sponsorship or approval' of the copy."). See also Justin Hughes, *American Moral Rights and Fixing the Dastar "Gap,"* 2007 UTAH L. REV. 659, 682; Michael Landau, *Dastar v. Twentieth Century Fox: The Need for Stronger Protection of Attribution Rights in the United States*, 61 N.Y.U. ANN. SURV. AM. L. 273, 303 (2005) ("Although it sounds cliché, bad facts do make bad law. In *Dastar*, the facts were terrible; they presented the quintessential 'damned if you do, damned if you don't' conundrum. At first blush, it seems that *Dastar* probably would have been sued for 'false designation of origin' under section 43(a) of the Lanham Act whether it gave credit to Twentieth Century Fox or not."); Dinwoodie, *supra* note 14, at 15 (noting the same "risk of being sued no matter what attribution strategy they followed").

¹⁷ See, e.g., Laura Heymann, *The Birth of Authorship: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1378 (2005) ("[I]n its decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.* eight years later, the Supreme Court largely denied authors the ability to compel attribution of their works (and thereby preserve their authorial choice) through the Lanham Act and thus denied readers the accurate attribution required for organized and efficient literary consumption."); Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1117, 1171 (2005) ("Authorial attribution acts as an incentive to authorial production, provides valuable

many criticize the decision on the ground that it put the United States (further) out of compliance with the Berne Convention.¹⁸

This Essay argues that, whatever the merits of a general attribution requirement, the Supreme Court was right to reject the attempt to apply trademark law to designations of authorship. Indeed, in my view, *Dastar* should be understood, or at least should be extended, to rule out categorically Lanham Act claims that are based on the content of the defendant's creative work. And though cases involving allegations of confusion arising from use of the plaintiff's creative work most directly implicate concerns about evading copyright's limitations, I argue that the better approach is to focus on the content of the defendant's work. Specifically, *Dastar* should bar any claim that alleges that consumers will be confused because of the content of the defendant's creative work. Courts, in other words, should refuse to infer anything about the source of a work, or of any goods embodying that work, from its creative content.

Part I sets the stage by describing the *Dastar* decision and situating it in the broader doctrinal landscape. Part II then describes the ambiguities about *Dastar*'s preemptive sweep, and Part III argues specifically for expansive interpretation or extension of *Dastar*.

information to consumers, and provides additional social benefits that go beyond issues of market efficiency. However, the use of authorial marks, like the use of trademarks, can create social harms. Just as counterfeiters place illegitimate trademarks on goods, exploiters of entertainment markets may be tempted to misattribute authorship. In the United States, such deceptive practices were traditionally subject to the remedial mechanisms of trademark and unfair competition laws. However, in a 2003 decision, *Dastar Corporation v. Twentieth Century Fox Film Corporation*, the United States Supreme Court held that federal trademark law does not address the misattribution of authorship.”); Landau, *supra* note 16, at 275 (“In *Dastar*, the Supreme Court held that section 43(a) of the Lanham Act was ‘incapable of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain’ and that attribution claims for communicative works belong under copyright law. Because the right of attribution under copyright law applies only to a very limited category of works, the Supreme Court in *Dastar* effectively ended most causes of action for false or misleading attribution of artistic works. This will encourage plagiarism and misattribution, especially when there is so much material available that is so easy to reproduce and distribute.”).

¹⁸ See, e.g., Hughes, *supra* note 16, at 659 (arguing that, while “[t]he *Dastar* ruling was unquestionably important for a robust public domain, [] the reasoning the Court employed makes American compliance with Article 6bis [of the Berne Convention] considerably more problematic.”); Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263 (2004) (arguing that the right of attribution was severely limited in *Dastar*). In my view, to the extent current law fails to meet the United States’ Berne obligations, that is a copyright, and not a trademark, problem, and the solution should therefore be a copyright, and not a trademark, solution.

I. THE *DASTAR* DECISION

The facts of *Dastar* were not complicated, even if they were relatively unique. Twentieth Century Fox owned the copyright for a television series that was based on President Dwight Eisenhower's book *Crusade in Europe*, published by Doubleday.¹⁹ Though the book remained in copyright, Fox failed to timely renew the copyright on the television series, thereby inadvertently allowing it to fall into the public domain.²⁰ As the fiftieth anniversary of the end of World War II approached, Dastar sought to capitalize on renewed interest in the war by creating a video set entitled "World War II Campaigns in Europe."²¹ As the Court explained:

To make Campaigns, Dastar purchased eight beta cam tapes of the *original* version of the Crusade television series, which is in the public domain, copied them, and then edited the series. 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 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.²²

Dastar then manufactured and sold its Campaigns video set as its own product, advertising it as "Produced and Distributed by: Entertainment Distributing," a Dastar subsidiary. The screen credits included the statements "DASTAR CORP presents" and "an ENTERTAINMENT DISTRIBUTING Production," and the credits identified employees of Dastar as executive producer, producer, and associate producer.²³ Neither Dastar's advertising nor

¹⁹ *Dastar*, 539 U.S. at 25–26.

²⁰ *Id.* at 26.

²¹ *Id.*

²² *Id.* at 26–27. The Court emphasized that Dastar used tapes of the original television series because, after having failed to renew the copyright in *Crusade*, Fox reacquired the television rights in Eisenhower's book, and then, through a licensee, restored the original series, repackaged the series on videotape, and distributed them. *Id.* at 26. Thus, the Court meant to make clear that Dastar copied the public domain footage, not the restored footage later created by Fox.

²³ *Id.* at 25.

the videos themselves made any reference to Fox or to the Crusade television series.²⁴

Fox claimed that Dastar's use of footage from the Crusade television series without attribution constituted reverse passing off; Dastar, it claimed, was passing off Fox's content as though it were Dastar's own, thereby falsely designating the origin of the video series in violation of § 43(a) of the Lanham Act.²⁵ That section makes actionable use of "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."²⁶

Though there was some precedent to support Fox's claim,²⁷ the Supreme Court was not impressed. Since the material at issue had fallen into the public domain, Dastar had an unqualified right to use it, even without attribution.²⁸ But importantly, the Court did not limit its holding to claims involving public domain material; it instead resolved the case by interpreting § 43(a) of the Lanham Act, and particularly the phrase "origin of goods." According to the Court, as used in the statute, "origin of goods" refers only to the origin of physical goods. Most basically, this means the party that actually made the goods at issue—the actual, historical origin. But the concept of origin "might be stretched," the Court allowed, "to include not only the actual producer," but the party who "stood behind production of the physical product."²⁹ Here, the Court presumably meant to acknowledge that "source" and "origin" in modern trademark law include parties who did not themselves produce the goods, but which have sponsored or are affiliated with the actual producer or its goods.³⁰

²⁴ *Id.* at 27.

²⁵ *Id.*

²⁶ 15 U.S.C. § 1125(a)(1)(A) (emphasis added).

²⁷ Previous Ninth Circuit cases held that "bodily appropriation" of creative content was sufficient to establish reverse passing off. *See, e.g., Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994); *Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d 1434, 1436–37 (9th Cir. 1993). Prior cases also held that slight modifications to the material were not sufficient to avoid liability. *See Summit Mach. Tool Mfg. Corp.*, 7 F.3d at 1437 ("A defendant may also be guilty of reverse palming off by selling or offering for sale another's product that has been modified slightly and then labeled with a different name.").

²⁸ *Dastar*, 539 U.S. at 33.

²⁹ *Id.* at 31–32.

³⁰ It is notable, however, that the Court referred to those parties as "standing behind" the physical good, a formulation that suggests a somewhat narrower understanding of "sponsorship" and "affiliation" than lower courts have generally accepted. *See Mark A. Lemley & Mark*

Yet according to the Court, “origin of goods” is “incapable of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain.”³¹ Whatever the range of relationships that might legitimately count as source relationships, those relationships must be tied to the physical goods and not merely the intellectual content they embody.

This construction was fatal to Fox’s claim because there was no doubt that Dastar (and not Fox) was the actual source of its physical videotapes, even if Dastar was not the source of the footage embodied in those tapes. Thus, when it designated the source of its tapes with its own name, Dastar was not falsely designating their origin: It was telling the truth. By contrast, Fox’s claim of reverse passing off “would undoubtedly [have been] sustained if Dastar had bought some of New Line’s Crusade videotapes and merely repacked them as its own.”³² In that case, Dastar would have been misrepresenting the origin of the physical tapes.

This construction clearly was motivated to a significant degree by the Court’s concern that a broader reading of the statute would have created a significant conflict with copyright law by enabling Fox to gain through trademark law some measure of control over content for which there was no copyright protection. But the Court also suggested that a different rule, under which “origin” might refer also to the creator of the expressive content, would create difficult practical problems.³³ Because most creative works are the result of many contributions, and because those contributions are often cumulative, efforts to identify the “true” intellectual origin(s) of creative content would degenerate into absurdity.

In many cases, figuring out who is in the line of “origin” would be no simple task. Indeed, in the present case it is far from clear that respondents have that status. Neither SFM nor New Line had anything to do with the production of the Crusade television series—they merely were licensed to distribute the video version. While Fox might have a claim to being in the line of origin, its involvement with the creation of the television series was limited at best. Time, Inc., was the principal if not the exclusive creator, albeit under arrangement with Fox. And of course it was neither Fox nor Time, Inc., that shot the film used in the Crusade television series. Rather, that footage came from the United

McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413 (2010) (arguing for a narrower interpretation of sponsorship or affiliation, one focused on responsibility for quality of goods).

³¹ *Dastar*, 539 U.S. at 24.

³² *Id.*

³³ *Id.* at 35–36.

States Army, Navy, and Coast Guard, the British Ministry of Information and War Office, the National Film Board of Canada, and unidentified "Newsreel Pool Cameramen." If anyone has a claim to being the *original* creator of the material used in both the Crusade television series and the Campaigns videotapes, it would be those groups, rather than Fox.³⁴

As the Court said, the Lanham Act does not require a "search for the source of the Nile and all its tributaries."³⁵

This reasoning provoked considerable reaction, for at least two reasons. First, parts of the Court's discussion seemed to rest not on the legal conclusion that the language of the Lanham Act does not deal with intellectual origins but on the dubious empirical claim that consumers do not care about such origins.³⁶ To many scholars, this smacked of amateur consumer psychology undeserving of the Court.³⁷

Second, the Court's detailed description of the origins of the content at issue seemed to many commentators to reflect ignorance about the concept of source in trademark law, or possibly deliberate mischaracterization.³⁸ Trademark law generally is not concerned with the identities of actual contributors to a product; it is instead concerned only with who is responsible for the quality of that product—its *legal* source.³⁹ It does not matter, for example, that an Apple computer is comprised of many parts that Apple, Inc. does not make. For trademark law's purposes, it only matters that Apple stands behind the computers bearing the "Apple" mark. Apple, and none of the individual component manufacturers, is the legal "origin" of Apple computers. In this sense, the Court's focus on the underlying contributions to the Crusades footage seemed disconnected from a core principle of modern trademark law.

³⁴ *Id.* at 35.

³⁵ *Id.*

³⁶ *Id.* at 32–33 ("The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.").

³⁷ See, e.g., Hughes, *supra* note 16, at 688 ("In other words, the strict holding of *Dastar* is founded on an unproven empirical claim that we have no good reason to believe.").

³⁸ See, e.g., Heymann, *supra* note 17, at 1440–44.

³⁹ *Id.* at 1442 ("[T]rademark law does not concern itself with the actual source of any good or service (or its progenitors) . . . [but] concerns itself with maintaining the integrity of the organizational system."). See also 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 3:8, 3:9 (4th ed.) (referring to the rule that a trademark refer to the "physical source or origin of the product or service in connection with which the mark was used" as the "early rule" eventually phased out in trademark law in favor of the rule that a trademark refer to a single, and possibly anonymous, source).

There is something to both of these criticisms. Consumers often care very much about who authored, directed, or produced a work. It surely matters to consumers, for example, that Steven Spielberg was involved in a movie's production, or that J.K. Rowling authored a new book. And we have good reason to believe that attribution matters to authors.⁴⁰ The Court's focus on actual, physical sources also does seem anachronistic. Indeed, liberalization of the concept of source was the key to legitimizing licensing and reaching cases in which consumers do not believe the defendant actually produced the goods at issue—developments that occurred nearly one hundred years ago.⁴¹

But I think both of the criticisms ultimately are unfair on the facts of the *Dastar* case. First, the Court itself recognized that intellectual origins might matter to consumers in the context of creative works. As the Court said, "[t]he purchaser of a novel is interested not merely, if at all, in the identity of the producer of the physical tome (the publisher), but also, and indeed primarily, in the identity of the creator of the story it conveys (the author)."⁴² Thus, it seems clear that the Court's holding did not depend to any significant extent on an empirical claim that consumers do not care about intellectual origins.⁴³ The Court simply held that those origins are irrelevant to trademark law. It did so because construing the statute to apply to statements about intellectual origins

⁴⁰ Christopher Jon Sprigman, Christopher J. Buccafusco & Zachary C. Burns, Valuing Attribution and Publication in Intellectual Property (Va. L. & Econ. Research Paper No. 2012-02, 2012), available at <http://ssrn.com/abstract=2011403> (reporting results of an experimental study showing that creators are willing to significantly reduce the amount of money they demand to license their IP rights in exchange for the opportunity to receive a attribution for their work). Indeed, because approximately 98% of people who used Creative Commons Licenses for their works required attribution, Creative Commons changed its default and no longer even offers a license that does *not* include an attribution requirement. See Glen Otis Brown, Announcing (and explaining) our new 2.0 licenses, May 25, 2004, available at <http://creativecommons.org/weblog/entry/4216>.

⁴¹ See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1904–12 (2007) (describing expansion of actionable confusion and liberalization of licensing rules).

⁴² *Dastar*, 539 U.S. at 33; see also *id.* ("For such a communicative product (the argument goes) 'origin of goods' in § 43(a) must be deemed to include not merely the producer of the physical item . . . but also the creator of the content that the physical item conveys . . .").

⁴³ Cf. Lastowka, *supra* note 17, at 1207–08 (noting that the Court's opinion in *Dastar* did not depend on the claim that consumers "do not care" about statements of authorship). Indeed I think the *Dastar* decision depends much less on an assumption about consumer understanding than did *Wal-Mart v. Samara*, which declared product configuration trade dress incapable of being inherently distinctive partly on the ground that consumers are not as inclined to see product configuration as source indicating.

would create a conflict with copyright law,⁴⁴ and because it was wary of creating special rules for creative works.

This last point deserves some elaboration, because the Court is often accused of having *created* a special rule in *Dastar* (in order to avoid conflict with copyright) rather than trying to maintain conceptual consistency. To see that it was Fox that was seeking the special rule, imagine that I were to start selling soda under the name of my new company (NewCo) in packaging that was clearly distinguishable from any other company's product. Coca-Cola obviously would have a passing off claim against me if I were to go to the store, buy Coca-Cola, pour it into my NewCo cans, and sell it as NewCo soda. In that case, I would be passing off Coca-Cola's soda as though it were NewCo soda.⁴⁵ But it is equally obvious, in my view, that Coca-Cola would have no claim against me if I were instead to buy Coca-Cola, take it home to my lab to analyze, and then reverse engineer the drink to produce my own soda that was identical in every way to Coca-Cola.

The formula for Coca-Cola is not patented; it is, famously, protected by trade secret.⁴⁶ But trade secret rights do not prevent me from reverse engineering Coca-Cola, as long as I acquire the product lawfully.⁴⁷ So if Coca-Cola were to have some form of unfair competition claim against me for selling NewCo soda that was reverse engineered from Coca-Cola, it would be able to avoid a fundamental principle of trade secret law. Once upon a time, it would have been pretty clear that such unfair competition claims were categorically unavailable in this situation. Cases like *Crescent Tool Co. v. Kilborn & Bishop Co.* made clear that a party was entitled to copy another's product "slavishly down to the minutest detail" since no one was entitled to "monopolize an [unpatented] design or pattern, however trifling."⁴⁸ Nor would those courts

⁴⁴ *Id.* ("The problem with this argument according special treatment to communicative products is that it causes the Lanham Act to conflict with the law of copyright, which addresses that subject specifically.").

⁴⁵ *Cf. Universal Furniture Intern., Inc. v. Collezione Europe USA, Inc.*, 2007 WL 2712926 (M.D.N.C. 2007) (finding defendant's display of plaintiff's furniture without branding or with labels removed and marketing the furniture as either its own collection or a collection manufactured by Art Heritage for Defendant constituted reverse passing off).

⁴⁶ VAULT OF THE SECRET FORMULA, <http://www.worldofcoca-cola.com/secret-vault.htm> (last visited Sept. 16, 2012).

⁴⁷ *See* UNIFORM TRADE SECRETS ACT § 1 Comment ("Proper means [of acquiring the information protected by trade secret] include: . . . 2. Discovery by 'reverse engineering', that is, by starting with the known product and working backward to find the method by which it was developed. The acquisition of the known product must, of course, also be by a fair and honest means, such as purchase of the item on the open market for reverse engineering to be lawful.").

⁴⁸ 247 F. 299, 300–01 (2d Cir. 1917). *See also* *Flagg Mfg. Co. v. Holway*, 59 N.E. 667, 667 (Mass. 1901) ("[T]he defendant has the same right that the plaintiff has to manufacture instruments in the present form, to imitate the arrangement of the plaintiff's strings or the shape

have required attribution—to the contrary, courts in those cases demanded that the copyists clearly label their products as coming from themselves, and *not* the party from which they copied.⁴⁹

Modern courts would more likely resolve a standard passing off case—one in which consumers recognized the flavor of NewCo soda and associated it with Coca-Cola—by finding the flavor of a soda to be functional and therefore unprotectable.⁵⁰ That workaround is easier for courts that interpret the *TrafFix* decision⁵¹ such that that a feature is “essential to the use or purpose of the article,” and therefore functional, whenever the feature plays a role in making the product work.⁵² It would be more difficult for courts that maintain that functionality is primarily concerned with competitive necessity,⁵³ though it is hard to imagine a claim like the one I have described succeeding even in those courts. Indeed, as far as I am aware, no court has ever found the taste of a food product to be protectable.

Ultimately, then, it seems quite unlikely that I would be liable for passing off just because NewCo soda tasted like Coca-Cola; indeed, it is very unlikely that I would be liable, even if consumers believed NewCo soda *was* Coca-Cola.⁵⁴ But

of the body. In the absence of a patent the freedom of manufacture cannot be cut down under the name of preventing unfair competition.”). This approach was dominant, but not universal. *See* *George G. Fox Co. v. Hathaway*, 85 N.E. 417 (Mass. 1908) (enjoining the defendant’s sale of bread loaves that were similar to the plaintiff’s in size, shape, color, and general visual appearance).

⁴⁹ *Crescent Tool*, 247 F. at 300 (“[The defendant] may not represent himself as the plaintiff in [the sale of the copied goods].”); *Flagg Mfg.*, 59 N.E. at 667 (“All that can be asked is that precautions shall be taken, so far as are consistent with the defendant’s fundamental right to make and sell what it chooses, to prevent the deception which no doubt it desires to practice.”).

⁵⁰ *See In re N.V. Oregon*, 79 U.S.P.Q.2d 1639 (T.T.A.B. 2006) (finding “an orange flavor” functional for “pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills”).

⁵¹ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) (defining a functional feature as one “essential to the use or purpose of the article, or that affects its cost or quality”).

⁵² *See, e.g., Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351 (5th Cir. 2002).

⁵³ At this point, however, only the Federal Circuit appears to take that view. *See* *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002). *See generally* Mark P. McKenna, *(Dys)Functionality*, 48 HOUS. L. REV. 823, 832–36 (2011) (distinguishing between a “right to copy” approach to functionality, under which competitive need is not explicitly considered, and a “need to copy” approach, in which competitive need determines whether a feature is “essential”).

⁵⁴ Chances are that consumers would *not* believe NewCo soda tasted just like Coca-Cola, since the taste of Coca-Cola in fact depends to a substantial degree on the soda being called Coca-Cola. *See, e.g.,* Samuel M. McClure et al., *Neural Correlates of Behavioral Preference for Culturally Familiar Drinks*, 44 NEURON 379 (2004) (finding that exposure to the Coca-Cola brand stimulates a region of the brain not stimulated in blind taste tests; as a result, despite the fact that people tend to prefer Pepsi over Coke in blind taste tests, those exposed to the brand names during the test tend to prefer Coke). But the legal point would hold even if consumers did believe the soda was Coca-Cola.

resolving such a case with the functionality doctrine is not ideal, as that approach would entail some amount of uncertainty and enforcement costs, even in the courts that apply *TrafFix* broadly.

More significantly here, it is not even clear that the functionality doctrine applies in reverse passing off cases. Functionality arises in cases involving the protectability of some feature(s) claimed by a plaintiff as protectable trade dress. The plaintiff in a reverse passing off case is not claiming features as source indicators; if the features indicated source such that consumers would be likely to be confused about the source of the defendant's product, then the claim would be for passing off and not reverse passing off. In a reverse passing off claim against me for pouring Coca-Cola into NewCo soda cans, for example, Coca-Cola would not be asserting that it owned rights in the flavor of its soda. It would instead simply be claiming that I was falsely designating the origin of the soda in the can. There is simply no reason for functionality to come up in reverse passing off cases.

Yet even if the functionality doctrine is not relevant to such a reverse passing off case, it is difficult to imagine that any court would find me liable for reverse passing off if I sold soda reverse engineered from Coca-Cola, even if my soda were chemically identical to Coca-Cola. In fact, this was precisely why the Supreme Court was concerned in *Dastar* that a contrary ruling would allow parties to evade *TrafFix*: It believed that, were such claims not barred, the "plaintiff [in *TrafFix*], whose patents on flexible road signs had expired, and who could not prevail on a trade dress claim under § 43(a) because the features of the signs were functional, would have had a reverse passing off claim for unattributed copying of his design."⁵⁵

This instinct may help explain Justice Scalia's invocation of Coca-Cola in the *Dastar* decision:

But the brand-loyal consumer who prefers the drink that the Coca-Cola Company or PepsiCo sells, while he believes that that company produced (or at least stands behind the production of) that product, surely does not necessarily believe that that company was the "origin" of the drink in the sense that it was the very first to devise the formula. The consumer who buys a branded product does not automatically assume that the brand-name company is the same entity that came up with the idea for

⁵⁵ *Dastar*, 539 U.S. at 37.

the product, or designed the product—and typically does not care whether it is.⁵⁶

Here again the Court might be faulted for making its point in empirical terms, suggesting that consumers do not know or care who developed the formula for Coca-Cola or Pepsi.⁵⁷ Indeed, as an empirical matter, the Court may well have been wrong. But in the context of the decision, it seems quite likely that the Court here was really just making a simplifying assumption in service of a normative legal rule. Rather than entertaining the possibility that consumers will care about intellectual origins and finding some doctrinal mechanism to insulate the defendant from liability in individual cases, the Court simply determined that the game was not worth the candle and ruled out claims relating to intellectual origin altogether. In this sense, *Dastar* is reminiscent of *Wal-Mart v. Samara* (another Scalia opinion), in which the Court asserted in support of its holding that product design could not be inherently distinctive that consumers do not regularly rely on product design to indicate source.⁵⁸

Criticism of the seeming woodenness of the Court's discussion of "origin" in trademark law is also unfair in the context of *Dastar's* facts. It is true that trademark law typically is concerned only with the legal source of products rather than their actual, historical source.⁵⁹ But Fox did not assert a standard trademark claim; it alleged *reverse* passing off.

This distinction matters because one brings a reverse passing off claim when it cannot allege secondary meaning: Fox sued for reverse passing off because the content for which it sought attribution did not indicate source. And precisely because consumers in these cases have no reason to associate the content with anyone other than the defendant, they are exceedingly unlikely to be confused in any of the ways with which trademark law typically is concerned. Consumers will not, for example, think that Fox sponsored *Dastar's* production because of the content, nor will they wonder about a relationship between Fox and *Dastar*. If consumers did think any of those things, it would be because the content indicated to them something about source, and Fox's claim would have

⁵⁶ *Id.* at 32.

⁵⁷ And scholars have criticized the Court on precisely this ground. See Hughes, *supra* note 16, at 686–87.

⁵⁸ *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 213 (2000) (distinguishing product design from product packaging and stating: "In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful or more appealing."). I thank Rebecca Tushnet for helping me see this connection.

⁵⁹ See Heymann, *supra* note 17, at 1442.

been for passing off rather than reverse passing off. Indeed, this is why it was critical to the Ninth Circuit's finding of false designation of origin that Dastar's "bodily appropriation" of the content obviated the need for evidence of likelihood of confusion.⁶⁰

Reverse passing off claims, then, are not really like ordinary trademark claims at all. Liability for reverse passing off turns simply on the falsity of the statement of origin, and in that sense reverse passing off is more akin to false advertising than trademark infringement. It should therefore not be a surprise that ordinary trademark principles do not fit well.

Indeed, in a significant sense, it was Fox that was pressing an argument that focused on factual, rather than legal, sources. Fox was seeking a ruling that would have forced Dastar to attribute to Fox content that did not indicate to consumers anything about origin (intellectual or physical). Fox was asking, in other words, for something akin to a rule that would require Apple to attribute all of the component parts of its computers, regardless of whether the sources of those parts were known to consumers.

Yet, even if the criticisms of *Dastar* have largely been overdrawn, some significant questions about the decision's scope and significance remain. Those are the subject of the next section.

II. *DASTAR*'S LIMITATIONS, AND OPEN QUESTIONS

Despite the specific context of the decision, *Dastar*'s holding is not limited to cases in which the defendant makes use of public domain material (as Dastar did).⁶¹ If the Court meant to rule that narrowly, it could have accepted that "origin" also referred to the origin of creative content and then created an exception for cases in which the content at issue was in the public domain.⁶² Likewise the Court could have decided the case more narrowly by carving out from the scope of § 43(a) claims based on lack of (or improper) attribution of

⁶⁰ *Dastar*, 539 U.S. at 28 ("With respect to the Lanham Act claim, the Court of Appeals reasoned that 'Dastar copied substantially the entire *Crusade in Europe* series created by Twentieth Century Fox, labeled the resulting product with a different name and marketed it without attribution to Fox [and] therefore committed a 'bodily appropriation' of Fox's series.'" It concluded that 'Dastar's 'bodily appropriation' of Fox's original [television] series is sufficient to establish the reverse passing off.'").

⁶¹ See *Dorchen/Martin Assocs., Inc. v. Brook of Cheboygan, Inc.*, 838 F. Supp. 2d 607 (E.D. Mich. 2012) (rejecting the argument that *Dastar* only dealt with works in the public domain).

⁶² Such a rule would operate similarly to the way the functionality doctrine limits protection of useful, and potentially patentable, product features: Those features may indicate source, but some source-indicating features are nevertheless ineligible for protection. See *Traffix*, 532 U.S. at 28–29 (noting the eligibility for trade dress protection of product features and the functionality limitation).

copyrighted (or copyrightable) works.⁶³ But the Court did not limit its decision in either of those ways; it instead interpreted “origin of goods” to mean only the origin of physical goods. That interpretation applies generally, regardless of whether the content at issue in a particular case is or was protected by copyright.⁶⁴ Misrepresentations of the origin of physical goods are actionable under the Lanham Act; other sorts of misrepresentations, including but not limited to misrepresentations of the origin of creative content, are not actionable.⁶⁵ To put it differently, in the Supreme Court’s estimation, use of a trademark represents only that the party whose trademark adorns the goods has produced those goods (or at least is responsible for the production of those goods). A trademark cannot be taken to indicate anything about the origin of the intellectual creation embodied in that good.⁶⁶ Hence, a party that merely

⁶³ Cf. Lastowka, *supra* note 17 (suggesting “[p]erhaps the best subset of the possible scope of ‘tangibility’ would be to restrict the limit of *Dastar* to information products potentially covered by copyright law.”).

⁶⁴ Nor is *Dastar* limited to cases in which the defendant merely copied ideas as opposed to expression, as some courts have wrongly suggested. General Scientific Corp. v. SheerVision, Inc., No. 10-CV-13582, 2011 WL 3880489 (E.D. Mich. Sept. 2, 2011) (refusing to apply *Dastar* where the plaintiff alleged “a misrepresentation by [defendant] regarding the origin and nature of media used in marketing, as opposed to a misrepresentation regarding mere ideas”).

⁶⁵ A broader range of misrepresentations (regarding the “the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities”) are actionable as false advertising under § 43(a)(1)(B). 15 U.S.C. § 1125(a)(1)(B). But, in my view, courts are right to reject false advertising claims that allege that misrepresentation of the origin of content is a misrepresentation of the “nature”, “characteristics”, or “qualities” of the goods..

⁶⁶ Indeed, several courts have rightly understood *Dastar* to bar claims based on misrepresentation of *invention*. See, e.g., ZS Assocs. v. Synegy, Inc., No. 10-427-4, 2011 WL 2038513 (E.D. Pa. May 23, 2011)

[P]laintiff may not base a false advertising claim on its allegation that [defendant’s] press release ‘falsely suggest[s] and impl[ies] that [defendant] Synegy was the market innovator and that ZS’s products and services are knock-offs of products and services that Synegy developed.’ Nor may it base a false advertising claim on Synegy’s assertions that ‘we have invested many years and a lot of money in product development, which led to Synegy creating the SCM software that has propelled our success year after year.’ Such statements by Synegy, and any others like them, can only be false insofar as they assert that Synegy, and not ZS, created the products and services offered by Synegy. Such claims of false attribution of authorship are barred by the reasoning underlying *Dastar*.

Sidem, S.A. v. Aquatech Int’l Corp., No. 10-81, 2010 WL 2573882, at *8 (W.D. Pa. June 23, 2010) (concluding that “it would be inappropriate to ignore the main thrust of plaintiffs’ allegations that [defendant] Aquatech passed off Synegy’s trade secret information as its own, i.e. that Quatech—not plaintiffs—originally developed or created the design and construction of large MED units, and under those circumstances *Dastar* bars plaintiff’s Lanham Act claim asserted under § 43(a)(1)(B)”); Robert Bosch LLC v. Pylon Mfg. Corp., 632 F. Supp. 2d 362, 366 (D. Del. 2009) (the defendant’s website stated: “[The defendant]’s expertise . . . has inspired the development of

repackages physical goods made by someone else falsely designates the origin of those goods, but a party that creates its own physical goods cannot falsely designate their origin by using its own mark. The latter conclusion is true even if the party creates the good by copying intellectual content—by, for example, copying the work of authorship contained therein or copying the formula of the drink.

Some courts have struggled with this distinction in the digital context because they have had difficulty determining what it means merely to repackage a digital good. In *Cable v. Agence France Presse*,⁶⁷ for example, Cable alleged that defendant AFP falsely designated the origin of the photographs on its site, which were reproductions of Cable's photographs, displayed without Cable's photo credit and copyright notice. That claim should have been barred under *Dastar* because AFP created its own copies of the photographs.⁶⁸ The court, however, allowed the claim, concluding that AFP's actions were akin to mere repackaging of the photos without revision. This opinion misses the mark because the photos displayed on AFP's site were not the plaintiff's photos. They were, to be sure, *reproductions* of the plaintiff's photos. But that is a critical distinction post-*Dastar*. If reproduction of the content was the same thing as repackaging a physical product, then *Dastar*'s reproduction of Fox's footage undoubtedly would have qualified. Once AFP reproduced the photos, it was no longer selling Cable's photos—it was selling its own photos. Those photos may have infringed Cable's copyright, but they were not merely repackaged goods.⁶⁹

a high performance, frameless all-weather wiper blade with many innovative features and benefits, including . . . Advanced Frameless Design . . . and Integrated High-Downforce Spoiler," and "[t]he latest [of the defendant's] wiper blades on the market are all new and improved . . . adding functional features such as spoilers for improved wiper performance." The plaintiff sued, asserting a claim pursuant to § 43(a)(1)(B). The court stated: "Plaintiff's first claim for false advertising boils down to defendant's advertisement that it developed a 'frameless all-weather wiper blade' and, by implication, Bosch did not develop the said frameless wiper blade. This court, and other courts, have found that 'false attribution of the authorship' of an invention or innovation is not an actionable false advertisement under § 43(a) of the Lanham Act.")

⁶⁷ 728 F. Supp. 2d 977 (N.D. Ill. 2010).

⁶⁸ See *Abarca Health, LLC v. Pharnpix Corp.*, 2012 WL 112 3611 (D.P.R. 2012) (dismissing 43(a) claims that alleged false designation of origin based on defendant's assertion in advertising that it offered a "proprietary software application," which the plaintiff alleged was actually copied from its software, and distinguishing that claim from one based on defendant's claim that the software application was "innovative," which might fall outside *Dastar*).

⁶⁹ Cf. *General Universal Sys., Inc. v. Lee*, 379 F.3d 131, 149 (5th Cir. 2004) ("GUS has not accused HAL of taking tangible copies of its software, removing its trademarks, and selling them as its own. Rather, GUS asserts that HAL copied the ideas, concepts, structures, and sequences embodied in its copyrighted work. In sum and substance, GUS's claim is simply a claim that HAL has infringed its copyright in LOPEZ COBOL. *Dastar* makes clear that such claims are not actionable under § 43(a).").

The harder question regarding the scope of *Dastar* is whether the holding is limited to cases in which the content at issue (which originates with the plaintiff and is used by the defendant) lacks secondary meaning—in other words, whether it is limited to claims of *reverse* passing off. A number of courts have acted as if *Dastar* is not so limited, ignoring altogether the question of whether the plaintiff's work has secondary meaning. In these cases, courts have simply held that claims alleging confusion based on the content of a work are barred under *Dastar*.⁷⁰

This is, as I will argue below, how *Dastar* should be applied. But there is room for some reasonable disagreement about whether *Dastar* itself compels that result. Fox claimed that *Dastar* falsely designated the origin of its video series by including in its videos unattributed footage from the Crusades in Europe television series. Fox did not assert a more conventional (forward) passing off claim, presumably because it could not demonstrate that the footage itself served to indicate source. Fox, therefore, did not allege (and presumably could not have alleged) that *Dastar*'s inclusion of the content implicitly suggested that Fox was the source of, or sponsored or was affiliated with, *Dastar*'s movie series. Nor could Fox have avoided the *Dastar* holding simply by recharacterizing its claim to allege passing off on the ground that inclusion of the content falsely designated the origin of the physical goods (there, the tapes).

And it seems clear that the Supreme Court was conscious in *Dastar* of the possibility that a party might strategically recharacterize its claims to avoid the Court's rulings. That was the import of the Court's discussion of *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*⁷¹ Specifically, the Court worried in *Dastar* that, if Fox were able to assert a reverse passing off claim on the ground that it was the original producer of the content used by *Dastar*, then parties could easily evade *Wal-Mart*'s holding that product configuration trade dress can only be protected with evidence of secondary meaning: "Samara would merely have had to argue that it was the 'origin' of the designs that Wal-Mart was selling as its own line."⁷²

The Court's particular concern about parties evading *Wal-Mart* is apt, however, only if the content at issue lacks secondary meaning. *Wal-Mart* did not reject trade dress protection for product design altogether; it only required

⁷⁰ See, e.g., *Dutch Jackson IATG, LLC v. Basketball Mktg. Co.*, 846 F. Supp. 2d 1044, 1048 (E.D. Mo. 2012) (rejecting plaintiff's claim that defendants' unauthorized use of a musical work as part of the sound track to a basketball DVD constituted false designation of origin, and that failure to reference the plaintiffs' implicitly represented that defendants' created the song, and calling "[t]he plaintiffs' novel misrepresentation-by-implication theory is an impermissible work-around of the holding in *Dastar*").

⁷¹ 529 U.S. 205 (2000).

⁷² *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 36–37 (2003).

that anyone asserting rights in a design prove that the design has secondary meaning. Thus, a party that alleged passing off on the ground that the defendant was using content that indicated source (i.e., had secondary meaning) would not be evading *Wal-Mart's* requirements.

One could therefore conclude that *Dastar* has nothing to say about standard passing off claims where confusion was alleged to arise because of the content's source indication. If *Dastar* were so understood, the decision would have virtually no scope, for plaintiffs could easily evade it simply by focusing their claims on confusion regarding the source of the goods into which the content is embodied. Rather than claiming that consumers are likely to be confused about the origin of the content of the videos, a plaintiff would allege confusion about the source of the videotapes themselves. That would, of course, not be a meaningfully different claim from the one the Court precluded in *Dastar* itself: any confusion about the source of the videotapes in such a case would be the result of implicit source indication coming from their content. Yet a narrow reading of *Dastar* would allow it.

In my view, such a reading would clearly be inappropriate. The Court's concern about strategic recharacterization was not merely a technical matter; it clearly reflected the Court's sense of the proper domains of trademark, copyright, and patent law, respectively. Hence, the Court's concern about the possibility of evading *Wal-Mart* and *TrafFix*, even though expressed in terms of the possibility of avoiding the additional requirements of secondary meaning and non-functionality, was grounded in citations to *Sears*, *Bonito Boats*, and even *Kellogg*, and particularly in those cases' shared concern about being "careful [in construing the Lanham Act] to caution against misuse or overextension of trademark and related protections into areas traditionally occupied by patent or copyright."⁷³

Most courts thus far seem to have understood the Court's broader purpose of demarcating the domain of trademark law and have not interpreted *Dastar* narrowly. In *Rudovsky v. West Publishing Corporation*,⁷⁴ for example, the court dismissed the plaintiff's false designation of origin claim, which was based on the defendant's publication of a supplemental text that listed the plaintiffs as authors even though they had no involvement in putting that material

⁷³ *Id.* at 33, quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 121–22 (1938); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150–51 (1989)).

⁷⁴ No. 09-CV-00727-JF, 2010 WL 2804844 (E.D. Pa. July 15, 2010). Somehow the court managed to allow state law defamation claims to go forward, however, and the plaintiffs ultimately prevailed on those claims. *Rudovsky v. W. Publ'g Corp.*, No. 09-CV-00727-JF, 2011 WL 1155159 (E.D. Pa. Mar. 30, 2011).

together.⁷⁵ According to the court, because the plaintiffs had, in fact, been authors of the primary materials and of previous supplements, the defendant faced precisely the same double-bind as *Dastar*:

On the one hand, they would [have] face[d] Lanham Act liability for failing to credit the creator of a work on which their lawful copies [were] based; and on the other hand they could [have] face[d] Lanham Act liability for crediting the creator if that should be regarded as implying the creator's "sponsorship or approval" of the copy.⁷⁶

Thus, the plaintiffs' claims were barred, even though they were asserting passing off, rather than reverse passing off.

Courts' tendency to read *Dastar* to bar false advertising claims also suggests that they understand that the decision was meant to do more than bar reverse passing off claims. These courts have, in my view, gone too far in barring *all* false advertising claims. After all, *Dastar* plainly states that some false representations—those, for example, relating to whether a work is substantially different from its predecessor—should remain actionable as false advertising. But the courts that have barred false advertising claims have rightly understood *Dastar* to demarcate the limited domain of the Lanham Act and to reserve certain kinds of claims to other areas of law.

In *Agence France Presse v. Morel*,⁷⁷ for example, the court rejected photographer Daniel Morel's false representation and false advertising claims, which were based on the allegations that AFP misrepresented that "AFP/Getty" was the source of photographs Morel had taken, that AFP had the right to license those images, and that a third party who posted Morel's photographs without authorization was the author of the photographs.⁷⁸

⁷⁵ *Rudovsky*, 2010 WL 2804844, at *2. The court also dismissed the plaintiffs' false advertising claims on the ground that the defendant's use was not in "advertising or promotion." *Id.*

⁷⁶ *Id.*

⁷⁷ 769 F. Supp. 2d 295 (S.D.N.Y. 2011).

⁷⁸ *Id.* The court held here that, though "*Dastar* concerned a misrepresentation of origin claim," the decision's "reasoning applies with equal force to bar claims, also brought under section 43(a)(1)(A), for false representation of 'affiliation' between the author and a distributor of communicative products." *Id.* at 307; see also *Antidote Int'l Films, Inc. v. Bloomsbury Publ'g, PLC*, 467 F. Supp. 2d 394, 399 (S.D.N.Y. 2006) (holding that *Dastar* applies to affiliation claims where "one person is the publisher of a novel and the other is the author of the novel, because the holding of *Dastar* would be meaningless if a false authorship claim could be recast" merely in sponsorship or affiliation terms). In my view, this aspect of the holding must be correct. First, *Dastar* is primarily about how to define the goods whose origin is indicated by the defendant's use; it is a determination that "origin of goods" means only "origin of *physical* goods." The decision is less about the meaning of "origin," notwithstanding the Court's musings about the

Notably, the court believed that “the allegations supporting Morel’s false advertising claim [were] identical to those supporting his false representation claim,” and the false advertising claim was therefore barred for the same reason as the false representation claim.⁷⁹ “The import of *Dastar* that an author’s recourse for unauthorized use is in copyright cannot be avoided by shoe-horning a claim into section 43(a)(1)(B) rather than 43(a)(1)(A).”⁸⁰

On this last point, the *Agence France Press* court was undoubtedly correct: It would be inconsistent with the whole spirit of *Dastar* to allow parties to avoid the decision simply by recharacterizing as false advertising a claim that is really about the origin of content. And, in my view, it would be equally inconsistent with the spirit of *Dastar* to allow a party to avoid *Dastar* by recharacterizing its claim as passing off, alleging that the defendant’s use of content would cause confusion about the source of the goods into which the content was embodied. *Dastar* meant to channel claims about the content of works to copyright.

Yet plaintiffs in many of the cases discussed in the introduction have tried to evade *Dastar* in precisely this way—by alleging that the defendant’s use of content created by the plaintiff will cause confusion because the content has secondary meaning. In *Fleischer Studios v. A.V.E.L.A.*, for example, the plaintiff claimed the defendant’s depiction of the Betty Boop character on t-shirts would cause confusion about the source of the t-shirts.⁸¹ This may have seemed to Fleischer distinguishable from Fox’s claim in *Dastar* because it could conceive of the t-shirts as distinct products (at least more easily than videotapes, which may seem merely to be the medium for the creative content). On this view, Fleischer was not seeking control over content, nor was it merely alleging confusion about the source of the Betty Boop character. Instead, Fleischer was trying to prevent confusion about the source of the merchandise A.V.E.L.A. was selling, even if any such confusion must have been caused by Betty Boop’s presence on the merchandise.

difficulty of identifying the actual creator of expressive content. In fact, the Court even acknowledged that origin “might be stretched” to include, not only the actual manufacturer of physical goods, but the entity that stands behind them. *Dastar*, 539 U.S. at 31–32. That language was clearly intended to make room for sponsorship or affiliation claims, and the Court must have recognized this, since the text of § 43(a) explicitly refers to confusion regarding sponsorship or affiliation. Thus, even if the word “origin” cannot carry such broad meaning, there is plenty of other text in the statute that can. And as a matter of fact, most claims under § 43(a) are sponsorship or affiliation claims, so it would be strange indeed if courts were to insist, only in this limited circumstance, that “origin” referred only to the actual, historical source.

⁷⁹ *Agence France Presse*, 769 F. Supp. 2d at 308.

⁸⁰ *Id.* (“If authorship were a ‘characteristic’ or ‘quality’ of a work, then the very claim *Dastar* rejected under § 43(a)(1)(A) would have been available under § 43(a)(1)(B).”).

⁸¹ 654 F.3d 958 (9th Cir. 2011).

But in fact the plaintiff's claim in *Fleischer Studios* was really no different than a claim by Fox that consumers would be confused about the source of Dastar's videotapes because of their content. In both cases, the claim would be based on the implicit source indication of the creative content embodied in the goods. Thus, in both cases, the claims really are about control of creative content.⁸² The plaintiffs' claims in the John Carter of Mars and Darkover cases attempt even more clearly to avoid *Dastar* by alleging confusion about the source of physical goods, despite the fact that any such confusion could only be caused by the content embodied in those goods. In each of those cases, the plaintiff alleged that inclusion of some element of a copyrighted work (a character or a fictional place) in the defendants' works implicitly indicated source and would likely cause confusion.⁸³

Because *Dastar* itself did not involve a passing off claim in which Fox alleged that the content Dastar copied had secondary meaning, it does not obviously control these cases, at least not on a narrow reading. But, as the following section elaborates, courts should read *Dastar* broadly and rule these claims out categorically because passing off claims of this sort might conflict with copyright law even more significantly than the claim the Court was concerned about in *Dastar* itself.

III. CONTENT-BASED CLAIMS AND THE SPIRIT OF *DASTAR*

Imagine that Steamboat Willie falls into the public domain⁸⁴ and that I begin selling DVDs of the movie, which I have mechanically reproduced onto my own blank DVDs and marked as "distributed by Mark." Mickey Mouse clearly has the secondary meaning Fox's content lacked, so Disney would not need to assert a reverse passing off claim here; it could assert a straightforward passing

⁸² This is why the Ninth Circuit was right when it initially held that Fleischer's claim was barred by *Dastar*, *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115, 1124 (9th Cir. 2011), a ruling it unfortunately backed away from in its substituted opinion. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958, 961, 968 (9th Cir. 2011) (withdrawing and superseding prior opinion and finding questions of fact about existence of secondary meaning of Betty Boop character, which had been licensed for use in toys, dolls, and other merchandise).

⁸³ The plaintiff in the Darkover case also alleged that use of the word "Darkover" in the *Molly of Darkover* and *Women of Darkover* titles would contribute to the alleged confusion. Standing on its own, that allegation would run headlong into *Rogers v. Grimaldi*, under which use of a trademark in the title of an expressive work is deemed non-infringing, "unless title has no artistic relevance to underlying work whatsoever or, if it has some artistic relevance, unless title explicitly misleads as to source or content of work." 875 F.2d 994, 999 (2d Cir. 1989). Assuming that the defendants' Darkover books do, in fact, build on the *Darkover* series, then the titles are clearly artistically relevant. Indeed, the plaintiff claims that the artistic relevance of the title exacerbates the violation of setting the stories on Darkover to begin with.

⁸⁴ I realize this will require suspension of disbelief, but play along.

off claim, arguing that the presence of Mickey Mouse in the content impliedly indicates the source of the physical DVDs.⁸⁵ And by making sure to allege confusion about the source of the actual physical products, Disney purports to avoid *Dastar*.

If Disney could do this, of course, then there would be no meaningful sense in which Steamboat Willie would fall into the public domain when the copyright expires. Any re-use of Steamboat Willie content will necessarily implicate Mickey Mouse's secondary meaning in this sense. If such implicit source indication gives rise to a trademark claim, then trademark law will serve to perpetuate copyright in any case in which the content is recognizable to consumers. That kind of case may not be resolved by *Dastar*'s specific holding, but it clearly would implicate the Court's concern about use of trademark law to gain control over content.⁸⁶

There are two overlapping but distinct ways that courts could deal with claims like Disney's. One approach would be to refuse any trademark claim based on a claim of rights in creative content. This approach would focus on the nature of the feature or content claimed by the plaintiff to indicate source (the use of which is alleged to cause confusion), and it would effectively prohibit copyrightable content from serving as a trademark. So, for example, a court facing a claim like Fleischer Studios' in the *A.V.E.L.A.* case would find the claim barred because it was based on a claim of secondary meaning in a formerly copyrighted character. Teller's claim against another magician for copying his magic trick would be barred because it alleges secondary meaning in a creative work.⁸⁷

Alternatively, courts could focus on the nature of the defendant's use and deny any claim that alleges confusion arising out of the content of the

⁸⁵ This is particularly true since courts generally seem to accept that secondary meaning is just another way of saying that a feature (or content) is recognizable. This is not, of course, an accurate understanding of the concept of secondary meaning. Secondary meaning refers to recognition of a feature *as an indicator of the source of goods or services*, and it is not obvious that recognizable creative content tells consumers anything about the source of goods employing that content. To the extent courts equate secondary meaning with consumer recognition, or that they simply assume that recognizable content must indicate the source of the physical goods, then much well-known content is likely to be treated as a trademark.

⁸⁶ *Cf. Fleischer Studios*, 636 F.3d at 1124 ("If we ruled that A.V.E.L.A.'s depictions of Betty Boop infringed Fleischer's trademarks, the Betty Boop character would essentially never enter the public domain. Such a result would run directly contrary to *Dastar*.").

⁸⁷ I am not suggesting that this approach would hinge on a determination that the work claimed by the plaintiff would actually be protected by copyright. It is not obvious, for example, that a magic trick should be copyrightable subject matter. *See* 17 U.S.C. § 102(b) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.").

defendant's expressive work. On this approach, Disney's passing off claim against a party that reproduced Steamboat Willie would be barred because that claim would be based on an allegation that use of Mickey Mouse within the content would cause consumer confusion.

These two approaches would obviously converge in many cases. Disney's passing off claim against a party that copied Steamboat Willie would be barred, for example, under either approach. Either the court would reject the claim on the ground that the content of Steamboat Willie cannot serve as a source designator, or it would reject the claim because it alleges confusion that results from the content of the defendant's work. Yet despite the potential for overlap in many cases, there are good reasons to view these cases in terms of the nature of the defendant's use.

First, categorical exclusion from trademark law of all material protected by copyright would likely rule out many more claims than is initially apparent. A good deal of material that now receives trademark protection could also be (and likely is) protected by copyright. Most advertising currently receives both copyright and trademark protection, for example, as do characters and sufficiently creative logos.⁸⁸ Trademark protection would be barred for Tony the Tiger under an approach that barred trademark protection for any copyrightable content.⁸⁹

⁸⁸ To be sure, not all such advertising slogans will warrant copyright protection. Some will be refused on the ground that, as short phrases, they are not sufficiently original. *See Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir. 1992) (finding that "short phrases . . . do not exhibit the minimal creativity required for copyright protection"). But some significant amount of advertising will clear the originality hurdle, as will many stylized logos.

⁸⁹ Tony the Tiger is the "advertising cartoon mascot for Kellogg's Frosted Flakes breakfast cereal, appearing on its packaging and advertising." TONY THE TIGER, http://en.wikipedia.org/wiki/Tony_the_Tiger (last visited Sept. 17, 2012).



Even the Lacoste logo is likely sufficiently creative to warrant copyright protection and therefore would be barred from trademark protection.⁹⁰



The problem here may well be that copyright protection has gotten too broad and that logos and advertising material should be only be protected through trademark law, if at all. Copyright protection might be precluded through application of a rigorous originality requirement, perhaps by consistent application of the Copyright Office's rule that "slogans, and other short phrases or expressions cannot be copyrighted."⁹¹ Or courts might categorically exclude advertising matter from copyright, in the manner disapproved of in *Bleistein v. Donaldson Lithographing Co.*⁹² Yet these kinds of limiting doctrines are not likely forthcoming in copyright law; indeed, if anything, categorical restrictions seem to be even more in decline. Thus, under the current copyright rules, an

⁹⁰ LACOSTE, <http://en.wikipedia.org/wiki/Lacoste> (last visited Sept. 17, 2012).

⁹¹ See Copyright Protection Not Available for Names, Titles, or Short Phrases, U.S. COPYRIGHT OFFICE, <http://www.copyright.gov/circs/circ34.pdf> (last visited Sept. 17, 2012).

⁹² 188 U.S. 239 (1903).

approach that rules out trademark protection for copyrightable material probably cuts too broadly.

Secondly, even if copyright law cooperated, some courts would not be inclined to rule out categorically trademark claims against uses of copyrightable content. And courts that were reluctant to adopt categorical rules would likely be attracted to a distinction between claims against mere re-use of content, on the one hand, and claims against uses of content to designate the source of other goods or services, on the other hand. These courts might be persuaded, as the Ninth Circuit ultimately was in *Fleischer Studios*, by a distinction between re-distribution of copyrighted content and use of some aspect of that content to adorn merchandise. And other uses might seem even more obviously distinguishable from mere re-use of content – where, for example, a company adopted as a trademark a character developed independently of the product and used that character on its packaging or in advertising, as MetLife did when it began using Snoopy and other Peanuts characters in connection with its insurance services.⁹³

Courts facing uses like these are likely to have great difficulty deciding when the use of a copyrightable work bars trademark protection. Their decisions are likely to depend on the extent to which they can conceive of the product with which a party uses the content as distinct from the content itself. In other words, courts will routinely face the nearly impossible task of defining the product at issue and determining whether the copyrightable feature *is* the product or merely adorns or designates the product.

Given these likely difficulties, the more pragmatic approach is for courts to bar any claim that is based on confusion attributable to the content of a defendant's creative work, whether that claim is articulated as one for trademark infringement, passing off, or reverse passing off (like Fox's claim). This bar should be interpreted broadly to rule out claims that allege confusion about the origin of content itself, as well as claims that allege confusion about the source of goods where such confusion arises from implicit source designation of the content. Disney's claim against someone who copied Steamboat Willie would be barred on this approach—even if the claim were articulated as a passing off claim focused on confusion about the source of physical DVDs—because that claim would allege confusion that arises out of the content of the defendant's work. Neither MetLife nor Peanuts Worldwide⁹⁴ would be able to assert a

⁹³ OVERVIEW/INTRODUCTION TO SNOOPY, <http://www.metlife.com/brandcenter/visual/snoopy/index.html#overview> (last visited Sept. 17, 2012).

⁹⁴ Peanuts Worldwide, LLC, a joint venture of the Iconix Brand Group and Charles M. Schulz Creative Associates owns all Peanuts-related copyrights and trademarks. See *Iconix Brand Group Closes Acquisition of Peanuts*, PR NEWswire (June 3, 2012), <http://www.prnewswire.com/news-release/ic>

trademark claim against a party that used Peanuts content in their own creative work, but MetLife would not be barred (on these grounds, at least) from asserting a claim against another company that used Snoopy to advertise its insurance services.

Ruling out claims that allege confusion caused by the content of a defendant's work is not only better for pragmatic reasons, it is also more consistent with the spirit of the *Dastar* decision. As I argued above, contrary to most readings of the case, *Dastar* did not develop a special rule for creative works. Reverse passing off claims generally are available only against misrepresentations of the source of physical goods and not against parties that merely copy someone else's product. Coca-Cola does not have a valid claim against me for selling soda that is reverse engineered from Coca-Cola and called NewCo Soda. Chanel wouldn't have a claim against me for reverse passing off if I were to reverse engineer its perfume and sell it in distinctive bottles under my own trademark.⁹⁵ Nor would lack of attribution matter in either of those cases; indeed, lack of any reference to Coca-Cola or Chanel makes liability *less* likely. *Dastar* merely applies this principle to the context of creative works. Parties do not have valid reverse passing off claims against those who copy their creative works, even if the copiers do not attribute. A legal rule that categorically bars claims based on confusion arising out of the content of a work is most consistent with this understanding. It simply is not trademark law's job to regulate the content of a creative work.

In one sense, this approach does sweep more broadly than would a rule that simply denied trademark protection to copyrightable content. Specifically, ruling out claims based on confusion arising out of the defendant's content will also sometimes bar claims that do not create the same obvious tension with copyright as those in which the defendant reuses the plaintiff's creative content. This approach will, for example, rule out claims based on the defendant's use within its content of features that are not copyrightable (or at least for which copyright protection was not sought). The University of Alabama's claim against Daniel Moore would have been excluded categorically under this approach, as would have Louis Vuitton's claim against the producers of *The Hangover: Part II*. In both of those cases, the plaintiffs alleged that the content of the defendants' creative works would cause confusion.

onix-brand-group-closes-acquisition-of-peanuts-95534994.html; see also PEANUTS BY CHARLES M. SCHULZ: THE OFFICIAL WEBSITE, <http://www.peanuts.com/> (last visited Sept. 17, 2102).

⁹⁵ Scents have sometimes received protection as trademarks but only for products not sold primarily for their scent. *In re Clarke*, 17 U.S.P.Q.2d 1238, 1240 (T.T.A.B. 1990) (noting that the "fragrance [was] not an inherent attribute or natural characteristic of applicant's goods but [was] rather a feature supplied by the applicant").

But the fact that my proposed approach would rule out claims that do not pose the same conflict with copyright does not make it less attractive. This kind of application of *Dastar* would work well with the Darkover claims and with Teller's claim against the other magician—it would rule those claims out categorically, whether they allege passing off (because of purported secondary meaning) or reverse passing off. Additionally, it precludes those claims without also categorically ruling out trademark protection for Tony the Tiger, as would an approach that focused on the copyrightability of the content claimed by the plaintiff. This approach does all of this without imposing serious costs, as the additional claims that involve use within creative content of non-copyrighted material are very unlikely to succeed anyway under the nominative and descriptive fair use doctrines or under *Rogers v. Grimaldi*. Indeed, both Louis Vuitton's and the University of Alabama's claims failed under *Rogers*.⁹⁶ Thus, the error cost from ruling the claims out categorically under *Dastar* accordingly is likely to be quite low here. At the same time, having a mechanism for ruling out these claims categorically is likely to have significant enforcement cost benefits.⁹⁷

To be sure, the approach I advocate here is not free from difficulty. The distinction between MetLife's claim against a party that re-uses Peanuts material in a movie and another claim against a different party that uses Snoopy to advertise its insurance services depends on the conclusion that the former claim alleges confusion arising out of the content of a creative work, while the latter claim does not. That conclusion might be reasonably clear with those two examples, but in other cases it may not be easy to determine whether the alleged confusion is attributable to the content of a creative work. In the Betty Boop case, for example, a court would have to determine whether the alleged confusion arises out of the content of a creative work, and that likely depends on whether defendant's t-shirts and other merchandise count as creative works.

But I think those edge cases are likely to be exceptional ones, and courts already have significant experience in the context of *Rogers v. Grimaldi* with

⁹⁶ See *Louis Vuitton Malletier S.A. v. Warner Bros. Entm't Inc.*, No. 11 Civ. 9436 slip op. (S.D.N.Y. filed June 15, 2012) (<http://www.nysd.uscourts.gov/cases/show.php?db=special&id=189>) (applying *Rogers v. Grimaldi* and dismissing Louis Vuitton's claim on a 12(b)(6) motion); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012) ("In this case, we readily conclude that Moore's paintings, prints, and calendars are protected under the *Rogers* test. The depiction of the University's uniforms in the content of these items is artistically relevant to the expressive underlying works because the uniforms' colors and designs are needed for a realistic portrayal of famous scenes from Alabama football history. Also there is no evidence that Moore ever marketed an unlicensed item as 'endorsed' or 'sponsored' by the University, or otherwise explicitly stated that such items were affiliated with the University.").

⁹⁷ See generally Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099 (2004).

determining whether the defendant is using the mark in an expressive work. *Rogers* only applies in cases involving the title of an expressive work or the content of an expressive work itself, and though there have been other issues regarding the applicability of *Rogers*, courts do not seem to have had difficulty determining when a case involves an expressive work.⁹⁸

IV. CONCLUSION

A series of recent cases implicates the extent to which trademark law can be used to control creative content. The possibility of using trademark law for that purpose obviously creates a potential conflict with copyright law, which ordinarily sets the rules for use of creative material developed by others. Unfortunately, despite its attraction to boundary questions in trademark law, the Supreme Court's *Dastar* decision—its lone decision demarcating trademark and copyright law—remains controversial and its scope somewhat unclear.

This Essay argues that *Dastar* should be understood, or at least should be extended, to rule out any claims based on confusion that is attributable to the content of a creative work, however that claim is denominated. This approach is better than ruling out trademark protection for all copyrightable works, even though it sweeps out some claims that do not raise the same concerns about conflict with copyright, both because it is more consistent with trademark and unfair competition law's traditional role and because those other claims ought to be unsuccessful in virtually all cases in any event. This approach also has the virtue of creating certainty and allowing courts to dispose of cases early. In this respect, *Dastar* could play a role similar to *TrafFix*: *Dastar* would reserve to copyright law the rules for use of creative material, much as *TrafFix* reserves to patent law rules for control of useful features.

⁹⁸ See, e.g., *New Life Art*, 683 F.3d 1266; *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008) (finding defendant's use of "Pig Pen" (a fictitious adult entertainment venue) in a video game was non-actionable under *Rogers v. Grimaldi*); *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003) (finding plaintiff's claim against defendant's use of Barbie dolls in various purported art pieces protected under *Rogers v. Grimaldi*, in addition to other defenses such as nominative fair use).

