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Brief of Amici Curiae Intellectual Property Law Professors in Support of Appellees

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Brief of Amici Curiae Intellectual Property Law Professors in Support of Appellees, *Phoenix Entm't v. Rumsey*, No. 15-2844 (7th Cir. Nov. 30, 2015).

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No. 15-2844

In the
United States Court of Appeals
for the Seventh Circuit

PHOENIX ENTERTAINMENT PARTNERS, LLC and SLEP-TONE
ENTERTAINMENT CORPORATION,

Plaintiffs-Appellants,

v.

DANNETTE RUMSEY and BASKET CASE PUB, INCORPORATED,

Defendants-Appellees.

Appeal from the United States District Court
for the Central District of Illinois, No. 1:15-cv-01009-JBM-JEH.
The Honorable **Joe Billy McDade**, Judge Presiding.

**BRIEF OF AMICI CURIAE INTELLECTUAL PROPERTY LAW
PROFESSORS IN SUPPORT OF APPELLEES**

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Federal Rule of Appellate Procedure 26.1, the undersigned states that none of the Amici is a corporation or has a parent corporation.

Dated: November 30, 2015

By: _____

Counsel for Amici Curiae

CERTIFICATE OF COMPLIANCE WITH RULE 29(c)(5)

Counsel for the parties did not author this brief in whole or in part. The parties have not contributed money intended to fund preparing or submitting the brief. No person other than Amici Curiae or their counsel contributed money to fund preparation or submission of this brief.

Dated: November 30, 2015

By: _____

Counsel for Amici Curiae

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IDENTITY AND INTEREST OF THE AMICI CURIAE

Amici are law professors who teach and have written extensively about trademark law and other intellectual property law subjects. Our sole interest in this case is in the orderly development of trademark law in a way that serves the public interest.*

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CONSENT OF THE PARTIES

Counsel for Appellees consented to the filing of this brief. Counsel for Appellants declined to consent. Amici's motion for leave to file this Amicus Brief is enclosed herewith.

I. Summary of Argument

The District Court correctly determined that Phoenix failed to state a trademark claim because Basket Case’s activities cannot have caused any relevant confusion.¹ Phoenix’s fundamental complaint is about unauthorized use of its intangible content—karaoke tracks. Under *Dastar v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003), however, only confusion regarding the source of physical goods is actionable under the Lanham Act; confusion regarding the source of the karaoke tracks or their authorization is not actionable. Phoenix cannot avoid *Dastar* just because Basket Case creates digital copies of those tracks, as Basket Case does not sell digital files or any other physical product bearing the SOUND CHOICE mark. Indeed, the only way consumers ever encounter Phoenix’s marks is during playback of the karaoke tracks, so any “confusion” could only be the result of the content itself. *Dastar* clearly precludes such a claim.

Nor can Phoenix avoid *Dastar* by pointing to other commercial services offered by Basket Case, such as its sale of food and beverages. Basket Case does not use the Sound Choice mark to designate any such services, and source indication cannot be inferred from the use of Phoenix’s marks within the karaoke tracks.

¹ Phoenix acquired Slep-Tone after Slep-Tone filed its original complaint. *See* Motion for Substitution of Party, March 31, 2015, R.14. For purposes of this brief, we refer to Phoenix and Slep-Tone collectively as Phoenix.

Finally, Phoenix's marks cannot be separated from the content. Phoenix chose to embed its marks in creative works, and *Dastar* teaches that control over creative works is the province of copyright law, not the Lanham Act. Accepting Phoenix's argument would open the door to exactly the kind of "mutant copyright" rejected by the Supreme Court.

II. Argument

A. Phoenix Fails to Allege Confusion Regarding the Source of Relevant Tangible Goods, as *Dastar* Requires

The gravamen of Phoenix's complaint is that, without its authorization, Basket Case created and used digital copies of Phoenix's karaoke accompaniment tracks. Br. of Appellant at 5. Phoenix alleges that, because the karaoke tracks display Phoenix's SOUND CHOICE marks and its claimed trade dress during playback, consumers will be confused about the origin of the karaoke tracks on Basket Case's computer hard drive. *See* Br. of Appellant at 24.

Since Basket Case does not sell its digital karaoke tracks, however, it is implausible that consumers would be confused about their origin; indeed, consumers almost certainly have no idea whether the tracks are being performed from a CD or from digital copies. But even if Phoenix were right that consumers are likely to believe that Phoenix is the origin of Basket Case's tracks, *Dastar* makes clear that any such confusion is irrelevant for Lanham Act purposes.

Dastar copied footage from the *Crusade in Europe* television series originally released by Time-Life and re-used that footage in its own video series without attribution to Fox (Time-Life's successor in interest). *Dastar*, 539 U.S. at 26–27. According to Fox, this constituted reverse passing off. Dastar 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. *Id.* at 27. 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.*

15 U.S.C. § 1125(a)(1)(A) (2012) (emphasis added).

The Court held that, as used in the statute, “origin of goods” refers only to “the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods.” *Dastar*, 539 U.S. at 37. Thus, while the concept of origin “might be stretched to include not only the actual producer” but the party who stood behind production of the physical product, “origin of goods” is “incapable of connoting the person or entity

that originated the ideas or communications that ‘goods’ embody or contain.” *Id.* at 31–32.²

The Court’s construction of the Lanham Act was animated by its concern about a conflict between trademark and copyright law, and particularly its concern that Fox might use trademark law to gain control over content for which it no longer had copyright protection. *Dastar*, 539 U.S. at 33 (“The right to copy, and to copy without attribution, once a copyright has expired...passes to the public.”). But *Dastar*’s holding is not limited to cases involving formerly copyrighted works, or even cases in which a valid copyright exists. *See Bretford Manufacturing, Inc. v. Smith System Manufacturing Corp.*, 419 F.3d 576 (7th Cir. 2005); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003).³

Phoenix’s claim here differs from Fox’s claim in *Dastar* in that Phoenix is complaining about the *use* of its Sound Choice marks rather than a *lack* of attribution. But that difference is immaterial under *Dastar* because Phoenix still does not allege confusion about the source of any *physical goods*, only confusion

² While the Court in *Dastar* was interpreting the language of § 43(a) specifically, 15 U.S.C. § 1125(a)(1)(A), the same rule applies in cases of infringement of registered marks under § 32 despite that section’s slightly less specific language. 15 U.S.C. § 1114 (2012). It is well established that the principles applicable to registered and unregistered marks are largely the same. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992); *Dunn v. Gull*, 990 F.2d 348, 351 (7th Cir. 1993).

³ A broader range of misrepresentations, if made in “commercial advertising or promotion,” are actionable as false advertising under § 43(a)(1)(B). 15 U.S.C. § 1125(a)(1)(B) (2012). There is no false advertising claim in this case.

about the source of the intangible creative content displayed on Basket Case’s machines. Indeed, the Supreme Court anticipated—and rejected—precisely the distinction Phoenix urges here. Describing the double bind in which would-be users of creative content might find themselves if the Lanham Act were interpreted to allow claims of false designation of the origin of content, the Court noted that if “Dastar had simply copied the television series as Crusade in Europe and sold it as Crusade in Europe, without changing the title or packaging (including the original credits to Fox),” Fox likely would have brought a passing off claim. *Dastar*, 539 U.S. at 36. That claim would have been the same one Phoenix is making here: it would have alleged confusion based on the credits to Fox, just as Phoenix alleges confusion based on the inclusion of the SOUND CHOICE marks within the content.

Far from endorsing such a claim, the Court invoked this hypothetical to demonstrate why “origin” must be understood to refer only to the origin of tangible goods. *See Dastar*, 539 U.S. at 36 (noting that adopting a definition of “origin” that would include the origin of creative content would place “manufacturers of those products in a difficult position”). The Court’s interpretation of “origin” ruled out not only claims for failing to credit the creator of a work, but also claims based on crediting the creator, “if that [crediting] should be regarded as implying the

creator's 'sponsorship or approval' of the copy." *Id.* (quoting 15 U.S.C. § 1125(a)(1)(A)).

Some Seventh Circuit cases have not been precise about *Dastar*'s holding. *Eastland Music Corp. v. Lionsgate Entertainment, Inc.*, for example, acknowledged that, for Lanham Act purposes, "origin" means the "producer of the tangible product sold in the marketplace." 707 F.3d 869, 872 (7th Cir. 2013). Yet the Court did not explicitly distinguish physical copies of defendant's movie from the intangible creative work embodied in those copies. *See id.* (suggesting that "the title of a work of intellectual property" would infringe another's mark "if the title falsely implie[d] that the latter author is its origin"). Thus the Court said that the plaintiff musical group's claim would have survived if it could plausibly have alleged that "consumers would treat it as the producer or source of the film 50/50, or treat Lionsgate as the producer of the 2003 album." *Id.*

However, the distinction between tangible goods and their intangible content was central to *Dastar*'s holding: allegations of confusion regarding the origin of content (but not those about the origin of tangible goods) are barred. Indeed, Fox's claim in *Dastar* was precisely that consumers would be confused about who created the content of *Dastar*'s movies. *Dastar*, 539 U.S. at 31 ("the gravamen of respondents' claim is that, in marketing and selling *Campaigns* as its own product"

without attribution, Dastar falsely designated the origin of its video).⁴ *Fortres Grand Corp. v. Warner Bros. Entm't* made the same conflation—treating Warner Bros.’ movie, an intangible creative work, as the relevant good. 763 F.3d 696, 703 (7th Cir. 2014).⁵

Likewise, *Gensler v. Strabala* focused on whether an individual can claim to have designed a complex architectural work, or whether instead such buildings are team jobs that *no one* designs. 764 F.3d 735, 738 (7th Cir. 2014) (emphasis in original). But that question is about the origin of an intangible work—the *Gensler* court even referred to Gensler’s claim as one about the origin of intellectual property. *Id.* at 737. That is wrong under *Dastar*. Though some false claims about actual participation in the design process might be actionable as false advertising under §43(a)(1)(B) rather than false designation of origin under §43(a)(1)(A),⁶ claims regarding authorship of the intangible work are barred.

⁴ Eastgate should not have been able to avoid this result simply by alleging that the title of the movie was likely to cause confusion about the physical copies of the movie, as that allegation would simply be an attempt to evade *Dastar* by focusing on irrelevant physical goods. See Section II.B.

⁵ The Court in *Fortres Grand* was considering what goods of Warner Bros. it should compare to the plaintiff’s software product in evaluating reverse confusion. *Id.* The court spoke of the relevant “goods” as the “movie,” without specifying tangible copies thereof. *Id.* (suggesting that the Supreme Court’s interpretation of “goods” in *Dastar* “likely compels lower courts to look to the movie, since it is the junior user’s only tangible product in the marketplace about which consumers could be confused”).

⁶ The Court even contemplated such a claim when it identified the ways in which an architect’s assertion that he designed a building might be false, referring to a

B. Basket Case’s Digital Files are not Relevant Goods

Phoenix attempts to avoid the *Dastar* problem by arguing that its marks do designate the source of physical goods—the digital files in which the karaoke tracks are fixed. Br. of Appellant at 13 (“The accused goods at issue in this litigation are the media-shifted karaoke tracks stored on hard drives....”).

But Basket Case does not sell copies of the karaoke tracks to its customers, so it makes no representation to consumers, correct or incorrect, about the source of the physical medium in which those videos are fixed. All that Basket Case provides to its customers is playback of the karaoke videos while they perform. There is therefore no meaningful sense in which Basket Case uses the Sound Choice marks “in connection with the sale, offering for sale, distribution, or advertising” of *the digital files*, as the statute requires. 15 U.S.C. § 1114(1)(a); *see also id.* at § 1125(a)(1) (requiring that the allegedly infringing mark be used “in connection with” goods or services); *N.A.A.C.P. v. Radiance Foundation, Inc.*, 786 F.3d 316, 324 (4th Cir. 2015) (holding that “in connection with” requires a nexus between the use and a commercial transaction, not just the presence of a mark).

case in which the “architect did not have anything to do with the design, never having worked on the project.” *Id.* at 737. That type of claim should be framed as false advertising, not false designation of origin. *Gensler*’s failure to distinguish between false advertising claims under §43(a)(1)(B) and false designation of origin claims under §43(a)(1)(A) likely explains its reference to *POM Wonderful LLC v. Coca-Cola Co.*, 134 S.Ct. 2228 (2014), a false advertising case, in interpreting the statute.

Phoenix obfuscates by arguing that Basket Case “uses” the Sound Choice marks not in connection with the tangible goods, but in connection with its *commercial operations* more broadly. Br. of Appellant at 20. This, however, is not a case about “use in commerce” as a jurisdictional prerequisite—it is instead about whether Phoenix alleges relevant confusion. And on the confusion question, Phoenix focuses on the *digital tracks*, suggesting that consumers will be confused about their origin in the same way consumers are confused by counterfeit Rolex watches. Br. of Appellant at 24–25. But that analogy is obviously flawed; watches are tangible objects sold to consumers, whereas consumers never interact with Basket Case’s digital files as tangible objects, only experiencing playback of the content. Had Basket Case streamed the files from YouTube (in which case Phoenix’s argument about the physical files would no longer apply), the gravamen of Phoenix’s complaint would be exactly the same. (To the extent Phoenix alleges confusion about sponsorship or endorsement of Basket Case’s bar and restaurant services, its theory of confusion would be the same even if it had alleged that Basket Case had purchased used CDs produced by Slep-Tone.)

Unlike the physical marking of a counterfeit watch, the only possible representation of origin encountered by Basket Case’s consumers is in the video content itself—through the appearance of the SOUND CHOICE marks on the screen. *Dastar*, properly understood, bars any Lanham Act claim in which the

alleged confusion could only be the result of use of a mark within the creative content of a work. *See Dastar*, 539 U.S. at 33 (rejecting an interpretation of “origin of goods” that would include “not merely the producer of the physical item...but also the creator of the content that the physical item conveys”).

This is true even though much expressive material is conveyed in physical form, and so strategic plaintiffs might often claim that their case is about the source of irrelevant physical goods. If it were otherwise, Disney could prevent others from selling copies of *Steamboat Willie* even after its copyright expired by arguing that, because Mickey Mouse is in the movie and is Disney’s trademark, consumers will be confused about the source of physical copies of the movie. Under Phoenix’s interpretation, that claim would survive *Dastar* because it is nominally focused on the source of physical goods, even though in truth it hinges on an assertion that consumers will think Disney authorized the reproduction of the content. This would create precisely the sort of “mutant copyright law” the Supreme Court rejected. *Dastar*, 539 U.S. at 34.⁷

⁷ Several recent decisions have understood that, if the plaintiff’s *only* claim of confusion comes from the reproduction of the expressive content of a work, then *Dastar* ought to apply, because origin cannot be inferred from the content alone. *See, e.g., Pulse Entertainment Corp. v. David*, No. CV 14-4732 (C.D. Cal. Sept. 17, 2014) (*Dastar* barred false designation of origin claim based on explicit misattribution of hologram to wrong creator; hologram was creative work like a cartoon); *Masck v. Sports Illustrated*, 5 F. Supp. 3d. 881 (E.D. Mich. 2014) (*Dastar* barred false designation of origin claim based on copying of photos).

Some district courts in this Circuit have concluded that, in copying content into a new format, the defendant created a new “good”—the digital track. *See, e.g., Slep-Tone Entm’t Corp. v. Sellis Enters.*, 87 F. Supp. 3d 897, 905 (N.D. Ill. 2015). Whether or not digital files might sometimes count as goods, *Dastar* precludes arguments that confusion will be caused by the content of the works fixed in those files. Indeed, *Dastar* also created new “goods” in this sense—physical copies of its videos. *Dastar*, 539 U.S. at 27. The Court nevertheless implicitly refused to infer from the creative content anything about the origin of those physical copies when it concluded that *Dastar* had correctly identified the origin of its videos by marking the physical copies with its own name. *Dastar* thus precludes arguments that the origin of copies of creative works can be inferred from their intangible content.

C. Dastar Bars Claims of Confusion Regarding the Origin of Services That Are Based Solely on the Content of Creative Works

Dastar also bars claims of confusion regarding the origin of services to the extent the alleged confusion could only be caused by the content of a creative work. *Gensler* was correct that *Dastar* does not rule out all claims of confusion regarding the source of services. *Gensler*, 764 F.3d at 736. But even if there may be other contexts in which use of Phoenix’s marks would cause actionable confusion regarding the source of the Basket Case’s services, such claims cannot be based solely on allegedly unauthorized use of content. A movie theater that

shows a public domain movie produced by MGM cannot be subject to an infringement claim if MGM simply alleges that the presence of the MGM lion at the beginning of the film causes confusion about the source or sponsorship of the theater's entertainment services. *Cf. Bretford*, 419 F.3d at 580–81 (noting that consumers might see marks embedded in other products, and holding that *Dastar* bars claims based solely on that embedding). For the same reason, Phoenix cannot succeed on its claims that consumers are likely to be confused about whether Basket Case's shows are sponsored by Phoenix because of the content of the karaoke tracks.⁸

⁸ Phoenix also cannot avoid *Dastar* by claiming confusion about whether the tracks or karaoke performances are “authorized.” The legitimacy of use of content is an issue for copyright law, not for the Lanham Act. If Phoenix owns a copyright in its tracks, it can bring a copyright infringement claim; otherwise Basket Case does not need Phoenix's authorization to show the videos. Fox could not have succeeded in *Dastar* simply by claiming that Dastar's use of the Fox content falsely implied that Dastar had the right to use that material – that is the same thing, in Lanham Act terms, as saying that the content falsely implied source. *See Smith v. BarnesandNoble.com, LLC*, No. 1:12-cv-04374, 2014 BL 263099 (S.D.N.Y. Sept. 23, 2014) (barring claims of false representation of affiliation between an author and a distributor based merely on sale of copies of author's book, even if the distributor was distributing unauthorized copies); *Antidote Int'l Films, Inc. v. Bloomsbury Publ'g, PLC*, 467 F. Supp. 2d 394, 399 (S.D.N.Y. 2006) (holding that *Dastar* bars a false affiliation claim 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 in this manner”).

D. Phoenix’s Marks Cannot Be Separated From the Content

Phoenix’s marks cannot be separated from the creative content of the karaoke tracks.⁹ For one thing, Phoenix has claimed trade dress rights in the graphical displays of its karaoke tracks, particularly the “typeface, style, and visual arrangement in displaying the lyrics, the style of displaying entry cues, and other elements.” (R.20:¶46). That trade dress obviously cannot be disentangled from the audiovisual work—it *is* the audiovisual work. Thus, accepting Phoenix’s claim would conflict directly with *Dastar*’s holding that copyright law, not trademark law, governs copying of expressive content.¹⁰

More fundamentally, separability is not a workable standard. Creative works routinely contain recognizable trademarks. The owners of those marks could argue that background uses, such as uses of Coca-Cola cans as props, should be edited out, or that characters should be morphed to make them look different from trademarked characters, while leaving the sequence of events the same. Given the

⁹ Even if the marks could somehow be separated from the content, they would not designate the origin of any tangible good, and that is the only designation that matters under *Dastar*.

¹⁰ See *Ho v. Tafllove*, 696 F. Supp. 2d 950, 956 (N.D. Ill. 2010) (holding that communicative use for expressive purposes is not the kind of use trademark law targets), *aff’d*, 648 F.3d 489 (7th Cir. 2011); *Cyber Websmith, Inc. v. American Dental Association*, 2010 WL 3075726, No. 09-CV-6198 (N.D. Ill., Aug. 4, 2010) (holding that “the inherent misrepresentation that accompanies the unauthorized copying and distribution of another’s copyrighted work” is not enough to create a Lanham Act cause of action).

existence of powerful digital editing tools that can now be used to replace individual elements in a work, these demands could be endless.

Similarly, prominent recording artists often include their names or nicknames in their songs.¹¹ Their names may be valid trademarks. Because of statutory copyright licenses, those artists do not have the power under copyright law to control all uses of their songs.¹² If separability were countenanced, recording artists could nonetheless assert trademark claims, demanding that songs be altered to remove allegedly source-identifying information.¹³

Phoenix chose to embed its claimed marks in expressive works in order to bootstrap a claim to control goods into a claim to control content. If there is confusion, it is not the kind of confusion trademark law aims to stop, and it is

¹¹ See, e.g., EMINEM, *The Real Slim Shady*, on THE MARSHALL MATHERS LP (Interscope Records 2000) (using both “Eminem” and “Slim Shady”); DESTINY'S CHILD, *Dot*, on THIS IS THE REMIX (Columbia Records 2002) (“If something's wrong blame it on me/B-E-Y-O-N-C-E”).

¹² See, e.g., 17 U.S.C. §§ 110 (exempting various performances of musical works), 114(d) (providing for statutory licenses for non-interactive uses of sound recordings); 115 (providing for compulsory licenses to make and distribute phonorecords of musical works).

¹³ Indeed, artists whose names are in their works, or who claim trademark rights in song titles or phrases, see, e.g., Kory Grow, *Taylor Swift Trademarks ‘This Sick Beat’ and Other ‘1989’ Phrases*, ROLLING STONE, Jan. 28, 2015, available at <http://www.rollingstone.com/music/news/taylor-swift-trademarks-this-sick-beat-and-other-1989-phrases-20150128>, could create exactly the Scylla and Charybdis problem identified in *Dastar*: the statutory license for musical works does not allow a licensee to make fundamental changes to the work. 17 U.S.C. § 115(a)(2) (2010). Complying with copyright law would force a statutory licensee to risk a trademark claim under Phoenix’s theory.

confusion of Phoenix’s own deliberate creation. Its attempt to circumvent copyright’s limitations—given Phoenix’s apparent lack of a copyright interest in the music tracks at issue—should not succeed. *Cf. Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000) (rejecting Comedy III’s argument that “the [video] clip at issue falls under the protection of the Lanham Act because it contains elements that in other contexts might serve as trademarks”).

In fact, even assuming that consumers expected to get karaoke tracks arranged by Phoenix, that is exactly what they got. Trademark law gives Coca-Cola the right to police the authenticity of its tangible goods, because a soda that is not made by Coca-Cola is not Coca-Cola. But Phoenix does not have the right to police the authenticity of its creative works under the Lanham Act. For that it must rely on copyright law.

III. Conclusion

For the foregoing reasons, the judgment of the District Court should be affirmed.

Dated: November 30, 2015

RESPECTFULLY SUBMITTED,

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CERTIFICATE OF COMPLIANCE.

I hereby certify that, pursuant to Fed. R. App. P. 32(a)(7)(C) and Seventh Circuit Rule 32, this brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and (6), because it is written in 14-pt Times New Roman font, and with the page limitations of Fed. R. App. P. 29(d) and Seventh Circuit Rules 28.1(e)(1) and 29(d), because it contains 15 pages of text, excluding the portions excluded under Fed. R. App. P. 32(a)(7)(B)(iii).

Dated: November 30, 2015

By: _____

Counsel for Amici Curiae

CERTIFICATE OF SERVICE

I hereby certify that I filed the foregoing MOTION FOR LEAVE TO FILE BRIEF OF AMICUS CURIAE INTELLECTUAL PROPERTY LAW PROFESSORS IN SUPPORT OF APPELLEES on November 30, 2015, by sending the original and fifteen (15) copies thereof by UPS to The Office of the Clerk, United States Court of Appeals for the Seventh Circuit

I further certify that I served the foregoing MOTION FOR LEAVE TO FILE BRIEF OF AMICUS CURIAE INTELLECTUAL PROPERTY LAW PROFESSORS IN SUPPORT OF APPELLEES on November 30, 2015, by sending a copy thereof by UPS to the address of each counsel, as listed below:

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