

## THE TRADEMARK/COPYRIGHT DIVIDE

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*The stories told by critics of U.S. copyright law are filled with examples of overextension of copyright, in which content owners use the broad remedies copyright law provides to limit reimagining of or commentary on their works with which they disagree. Such critics often propose a solution that sounds in the restructuring of copyright law itself, such as a more expansive reading of the law's fair use provisions or a limitation of the copyright term. While the concerns of these critics are justified, their focus might be turned elsewhere. A solution to the cudgel of copyright law already exists in the realm of U.S. trademark law. The content owners who are the subject of commentators' criticism are not, when their claims are correctly characterized, seeking to control the exploitation of the work for which copyright law provides them a limited monopoly; they are seeking to control the associations of attribution that subsequent use of the work suggests. This interest — an interest in accurate source identification and the desire to avoid consumer confusion in the marketplace — is, if anything, the domain of trademark law-related regimes and should be so addressed. Despite this allocation of harms within the intellectual property law scheme, courts and commentators have generally been resistant to allowing trademark law-related claims a place at the table with respect to copyrighted (or formerly copyrighted) goods, a resistance that seems much weaker at other intellectual property law interfaces. The dominant justification for this resistance — that recognition of trademark-based interests for communicative goods will work an even greater extension of copyright — misconceives the nature of the relationship between copyright law and trademark law, which address different economic harms, albeit occasionally with respect to the same goods. Thus, a recognition (and reinvigoration) of the trademark/copyright divide can enable us to think more creatively about how to stem the overuse of copyright: namely, by requiring content owners to state attributional and related claims as trademark law-related claims, not as copyright claims, by characterizing the refusal to do so as copyright misuse, and by strictly construing the alternative regime to ensure only legally cognizable claims survive. Copyright law doesn't forbid such a move and, indeed, may well be enhanced by it.*

### I. INTRODUCTION

In the mid-1980s, the well-known postmodern artist Jeff Koons displayed a sculpture called "String of Puppies" in a New York gallery. The sculpture was based wholly on a photograph, taken by a man named Art Rogers, of a couple with their arms

full of puppies; Koons's sculpture, intended as a commentary on how mass-produced art has caused societal deterioration, caricatured the subjects of the photograph by placing flowers in their hair and clown noses on the puppies they were holding. Rogers, perhaps not surprisingly, brought suit against both Koons and his gallery and won a grant of summary judgment, which the U.S. Court of Appeals for the Second Circuit affirmed. Perhaps even less surprisingly, Rogers' successful claim was one for copyright infringement: Rogers alleged that Koons had created an unauthorized derivative work, and the Second Circuit rejected Koons's attempt to take advantage of copyright law's fair use provisions.<sup>1</sup> But the ease with which Rogers brought, and the Second Circuit analyzed, Rogers' copyright infringement claim masks the fact that the interest Rogers was seeking to protect was probably not a copyright interest at all. Rogers was not contending that Koons was interfering with Rogers' exploitation of his own photograph, or that he was appropriating a market open to Rogers without Rogers' authorization<sup>2</sup> — indeed, the sculpture had value in the marketplace only because Koons's name was attached to it. Rather, Rogers seemed concerned more with whether Koons's sculpture altered viewers' association with Rogers' work or, more generously, whether Koons's sculpture somehow conveyed to viewers that Rogers authorized or sponsored Koons's work.<sup>3</sup> These interests, however deeply felt, may be described as interests in the integrity of one's work, in (mis)attribution, or in a right of publicity — but they are not copyright interests. And yet the current state of copyright law permitted — perhaps even encouraged — Rogers to couch his claim as a copyright law one.

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<sup>1</sup> *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992). The Second Circuit concluded that despite Koons's claim that his work was a commentary on, and not merely a copy of, Rogers' work, Koons had not sufficiently communicated this message to the public. *Id.* at 310.

<sup>2</sup> See Andrew R. Bechtel & Arati R. Korwar, *Copyright and the Creative Use of Visual Artworks in the 1990s*, 4 COMM. L. & POL'Y 431, 460 (1999) (“[I]t seems unlikely that the value of the works of the visual artists who sued Jeffrey Koons would suffer as a result of his uses.”).

<sup>3</sup> Anecdotal evidence suggests that this was Rogers' true motivation in bringing suit. See, e.g., John M. Leighty (UPI), Feb. 9, 1990 (quoting Rogers as saying, “I kept looking at the photograph and his sculpture and it was outrageous how he exploited my work and called it his art. It was my idea, my concept and my visual image.”); Liz Lufkin, *Art World's Tradition of Subtle Plagiarism*, S.F. CHRON., Jan. 18, 1990, at B4 (quoting Donald Prutzman, Rogers' attorney, as saying, “I was shocked by the similarity and the fact that he'd done it without any acknowledgment to Art or business relationship with him.”).

Commentators, too, describe similar conflation as they consider the assertion of copyright law claims in the second-generation creator world. In 2005, Prof. Larry Lessig presented a lecture at the Michigan State University College of Law in which he described (and showed to his audience) various creative endeavors involving copyrighted works (what he termed “remix culture”) that presumably could not have been created had the original content owner exercised the full extent of its rights under U.S. copyright law. Lessig described, for example, a video in which the Lionel Richie/Diana Ross song “Endless Love” is played over video clips of U.S. President George W. Bush and U.K. Prime Minister Tony Blair. “Whatever you think of Tony Blair, whatever you think of the War, whatever you think of President Bush,” Lessig related, “the one thing you cannot question about that clip is what the lawyers for the Lionel Richie estate said when [copyright] permission was sought to synchronize Richie’s music with that set of images. The lawyer said, No we won’t give you permission because ‘it is not funny.’”<sup>4</sup> Whether the story is true or apocryphal, two points seem relevant: U.S. copyright law would allow Richie to assert such a claim to prohibit use of the work, and the claim is not, at heart, a claim that aligns with copyright law’s interests. As with Rogers, Richie’s claim is not that the video’s creator has engaged in an impermissible economic exploitation of the work that interferes with Richie’s actual or potential market for the work. Rather, Richie’s claim (at least, as articulated by Lessig) is that the work is being used to convey a particular (political) message, one with which Richie does not wish to be associated. A deeply felt interest, perhaps, but probably not a copyright law–based one.

We can find many other stories like these: examples of first-generation creators using the blunt tool of copyright law to restrict use of their works by second generation creators, even where the interests sought to be protected inhere in integrity, reputation, or false association rather than exploitation, market substitution, or incentive destruction.<sup>5</sup>

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<sup>4</sup> Lawrence Lessig, *Creative Economies*, 2006 MICH. ST. L. REV. 33, 39 (transcription of the Second Annual Distinguished Lecture in Intellectual Property and Communications Law). Lessig continued, “So, we set up a system requiring permission, yet permission is not coming. And so people are faced with the choice to obey the law or not to obey the law, to create or not to create.” *Id.*

<sup>5</sup> See, e.g., *Jackson v. Warner Bros, Inc.*, 993 F. Supp. 585, 592 (E.D. Mich. 1997) (African American artists protesting use of his artwork in Warner Bros. film); *Clean Flicks of Colorado, LLC v. Soderbergh*, No. 1:02-cv-01662-RPM (July 6, 2006) (copyright infringement claim brought against distributors of edited copies of plaintiffs’ films); see also generally Andrew R. Bechtel & Arati R. Korwar, *Copyright and the Creative Use of Visual Artworks in the 1990s*, 4 COMM. L. & POL’Y 431 (1999) (citing numerous examples). The Church of Scientology is a notorious, and much excoriated, user of copyright law to restrict dissemination of church documents by critics. See, e.g., *Religious Tech. Ctr. v. F.A.C.T.N.E.T., Inc.*, 907 F. Supp. 1468 (D. Colo. 1995); *Religious Tech. Ctr. v. Lerma*, 908 F. Supp. 1362 (E.D. Va. 1995); *Religious Tech. Ctr. v. Netcom On-Line Communication Servs.*, 907 F. Supp. 1361 (N.D. Cal. 1995). As to *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997), in particular (involving a satire on the O.J. Simpson trial written in the style of the children’s book author), see Alex Kozinski & Christopher Newman, *What’s So Fair About Fair Use?*, 46 J. COPYRIGHT SOC’Y U.S.A. 513, 518 (1999) (“The presumption that an injunction is available to stop copyright infringement is particularly troubling in this case, because the only real harm was the prospect of

And, not surprisingly, cases like these arouse great concern on the part of copyright minimalists, who quite rightly fear that the overuse of copyright law to restrict use and dissemination of copyrighted works thwarts the creativity of second-generation creators. But, properly recounted, these stories are not about creators who are seeking to control the use of the work *qua* work: the number of copies that are distributed or the exploitation of the work in derivative form (such as in a movie or a translation). In other words, these creators are not truly seeking to trade on the incentives given to them by copyright law and the economic rights that come from the limited monopoly copyright law grants. Rather, the motivating factor for these artists appears to be something quite distinct: perhaps a concern that the public will mistakenly conclude that the artists have authorized the use of their work in the manner at issue or perhaps a concern that the political or other message being conveyed by the second-generation creator will disrupt consumer associations with the original artist. If this is the case, then what is motivating these plaintiffs aren't truly copyright concerns at all — if anything, they are trademark-type concerns (although whether they are *strong* or *legally cognizable* trademark-type concerns is another matter). Trademark law is, after all, concerned not with controlling the distribution of goods *qua* goods; it is concerned with the way in which the source (or sponsorship) of those goods is presented to the public. But because U.S. copyright law currently accommodates these interests indirectly (by allowing a copyright owner to bring suit to enjoin most unauthorized uses of a work), neither courts nor creators are forced to recognize this distinction.

We might care, however, about correctly sorting these interests into their respective categories for one reason beyond mere doctrinal integrity: By allowing copyright to reach beyond its core purpose — to offer incentives for creation that resolve the free-rider/nonrivalrous goods problem — courts grant first-generation creators the very power to thwart second-generation creators that Lessig and others fear. Were courts to be more vigilant about policing the line between copyright claims and non-copyright claims — in other words, forcing content owners to assert under copyright law only those claims that are concerned with the use of the work *qua* work — we might see a world in which the broad injunctive relief available to prevailing copyright owners appears less frequently, replaced by narrower forms of injunctive relief tailored to the reputational harms content owners are asserting, such as disclaimers or credit lines.

But content owners not only currently have no motivation to abandon their copyright claims in these situations; they also currently cannot easily assert their reputational or attributional interests under any other regime. Although a cornerstone of the European moral rights regime, a right to attribution (or, relatedly, a right to a disclaimer of nonattribution) has never had more than a toehold in U.S. intellectual property law. And whatever rights federal courts had been willing to find in the Lanham Act have now largely been eviscerated after the U.S. Supreme Court's 2003 decision in

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the author's work being associated with something unsavory. After all, it's not likely that a lot of parents would decide to pass up *Green Eggs and Ham* and bring *Dr. Juice* home to their kids instead."); *id.* at 519 (suggesting, without further comment, that trademark law might be the better vehicle for Seuss Enterprises' claims).

*Dastar v. Twentieth Century Fox*,<sup>6</sup> in which the court rejected the plaintiff’s attempt to use the Lanham Act to require attribution for a film in the public domain (and thus free from copyright). Part of the Court’s resistance in *Dastar* arose from its conclusion the bargain inherent in U.S. copyright law requires unfettered access to the work once the copyright term ends in exchange for the benefits afforded the creator during the term.<sup>7</sup> Any requirement of attribution or disclaimer would impose a restriction on the public domain that copyright law cannot tolerate; accordingly, trademark law–based claims must give way. But this view mischaracterizes both the nature of the copyright bargain and the scope of trademark law. Properly construed, the copyright bargain cedes to the public only the rights given to the creator during the copyright term: the exclusive right to control copies, distribution, display, performance, and derivative works. Enforcement of other interests based on other legal regimes shouldn’t necessarily interfere with the public’s ability to exploit any of the rights it receives as part of the copyright bargain.

In this Article, I want to explore the notion that one solution to the threat copyright law poses to “remix culture” is not to reform copyright law — at least, not in the ways that are typically proposed, such as expanding notions of fair use. Instead, we might ask courts to pay more attention to the types of claims content owners are asserting as copyright claims and force those that are really about non–copyright law concerns into a separate regime. (As I will discuss, I propose the doctrine of copyright misuse as the mechanism by which to accomplish this reallocation of claims.<sup>8</sup>) The “separate regime” resides, I think, in trademark law’s realm,<sup>9</sup> although it is not necessarily coextensive with trademark law properly construed; accordingly, it depends to some extent on both the willingness to recognize the possibility of an attributional-type right in trademark’s domain for the relatively small category of claims for which a harm can be articulated and the responsibility of ensuring that this recognition does not duly expand trademark law. Not every perceived harm that sounds in reputational or attributional interests is, in fact, a viable legal claim — indeed, very few such claims may survive once they are reconceptualized, and this is the point. In other words, we should not simply recast conceptually problematic copyright claims as doctrinally problematic trademark claims.<sup>10</sup>

Under such a construct, it seems, then, that assertion of this trademark/copyright divide should not be limited to works under copyright but should also continue into the

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<sup>6</sup> 539 U.S. 23 (2003).

<sup>7</sup> *Id.* at 34.

<sup>8</sup> Greg Lastowka has identified much the same issue but proposes an amendment to copyright law’s fair use provisions as the solution. See Greg Lastowka, *Digital Attribution: Copyright and the Right to Credit*, at 41–46, [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=917396](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=917396) (proposing that the fair use factors of 17 U.S.C. § 107 be amended to include consideration of whether the alleged infringer has provided attribution to the author of the work).

<sup>9</sup> Throughout this Article, the term “trademark” should be read as a shorthand that encompasses the variety of interests addressed under the Lanham Act, including unfair competition and false advertising interests.

<sup>10</sup> Thanks to Fred Yen for helping to refine this point. As others have noted, attention must also be paid to assertions of trademark infringement built on slender reeds. See, e.g., BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 57, 96 n.49 (1966).

post-copyright realm of the public domain. Once we conclude that the attributional or associational interests content owners are attempting to vindicate are not properly asserted as copyright claims, there is no coherent reason to let notions of the public domain disturb this distinction.

This renewed attention to some form of a limited attribution-type right — whether accomplished judicially or legislatively — might well have a salutary effect on U.S. intellectual property law more generally by benefiting both sides of the copyright maximization debate. First, it provides content owners with a more legitimate, and more robust, method of asserting the associational claims that motivate the kinds of actions I describe here, rather than effecting a doctrinal misfit by shoehorning those claims into the copyright format.<sup>11</sup> And second, it eliminates the need (and therefore, the ability) of content owners to use copyright law to achieve these associational goals, thus eliminating the ability to restrict dissemination of the work outright in favor of (one hopes) a more limited remedy of disclosure and/or disclaimer.<sup>12</sup>

Despite the benefits that might accrue to the public if there existed a greater recognition of the different goals of copyright and trademark, intellectual property scholars have tended to be skeptical of overlapping protection schemes or a legal analysis that would appear to work an expansion of the limited term of copyright.<sup>13</sup> And given the

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<sup>11</sup> Again, this is not to say that even when asserted under trademark law principles, such claims will, or should, always succeed; it is only to say that if they are asserted at all, they should be asserted under the correct legal doctrine.

<sup>12</sup> Indeed, given that content owners of the type I am describing are essentially seeking to control the message of source conveyed with the communicative good, rather than the good itself, the use of copyright law to obtain an injunction against further dissemination of the work tends to look like an impermissible prior restraint. See, e.g., Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147 (1998); Alex Kozinski & Christopher Newman, *What's So Fair About Fair Use?*, 46 J. COPYRIGHT SOC'Y U.S.A. 513, 516 (1999).

<sup>13</sup> See, e.g., Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1476 (2004) (contending that “the availability of overlapping intellectual property protection in all of its forms presents a serious threat to the goals and purposes of federal intellectual property policy”); Lee B. Burgunder, *Trademark and Copyright: How Intimate Should the Close Association Become?*, 29 SANTA CLARA L. REV. 89, 92 (1989) (“[N]either the copyright nor the trademark system should allow the creator of a useful or ornamental idea to earn monopoly profits since protection under these systems is easier to obtain and has a longer life.”). But see Gideon Parchomovsky and Peter Siegelman, *Towards an Integrated Theory of Intellectual Property*, 88 VA. L. REV. 1455, 1502–03 (2002) (contending that the “Supreme Court’s hostility to leveraged patents [through trademark law] is ill-conceived” because “[a]ny diminution in the scope of trademark protection available to patentees increases the relative value of their patent monopoly, and correspondingly, forces them to rely on monopolistic rents to recover their investment in R&D”); A. Samuel Oddi, *The Tragicomedy of the Public Domain in Intellectual Property Law*, 25 HASTINGS COMM. & ENT. L.J. 1, 48 (2002) (“The expiration of one of the federal titles of protection cannot drag another extant title into the public domain. If a general rule is suggested, it would be that the public may exploit any creation in the public domain provided there is no extant form of protection that would otherwise preclude this exploitation.”); Doris Estelle Long, *First*, “Let’s Kill All the Intellectual

ways in which copyright holders often use copyright law to restrict the speech of others that is critical of the copyright holder's work, this skepticism is understandable and warranted. Intellectual property law of any stripe should not be used to, as Wendy Gordon has described it, "impermissibly inhibit others from turning the original works to their own aesthetic, cultural and political advantage."<sup>14</sup> But the current state of copyright law seems to foster this result more than it does discourage it.

The goal of this Article is not to argue for trademark or intellectual property expansionism as such; as noted, any recognition given to a more robust attributional right in trademark's realm must be cabined by at least the limitations that would apply to other trademark law-based claims. Nor am I challenging the belief that a rich public domain spurs creativity or in any way suggesting that more raw materials should be propertized. To the contrary, I am seeking a way to preserve the core of the public domain — the ability to use the materials in question in the production of other works — in light of an ever-expanding copyright law. In short, I am suggesting that the solution to overreaching copyright law already exists; it simply exists outside of copyright law itself.<sup>15</sup>

Part II sets the stage for my proposal by illustrating the fundamental differences between copyright law and trademark law — in their incentives, their goals, and the range of their remedies. It then goes on to trace the jurisprudence at the other intellectual property interfaces, in which courts have recognized distinctions they seem unwilling to recognize at the trademark/copyright interface. Part III considers issues relating to (and possible objections to) my proposal posed by conceptions of the public domain and proposes a different reading of the public domain that is more consonant with the nature of the copyright term that precedes it. Part IV sets forth the proposal: a recognition of the attribution interest in communicative goods during both the term of copyright and in the public domain, coupled with greater scrutiny of trademark-based claims masquerading as copyright-based ones. In essence, I suggest that courts should pay more attention when plaintiff content owners attempt to use an overbroad notion of copyright law to assert trademark-based claims and restrict assertion of copyright claims to those instances in which plaintiffs are seeking to vindicate copyright interests. Thus, where the

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*Property Lawyers!": Musings on the Decline and Fall of the Intellectual Property Empire*, 34 J. MARSHALL L. REV. 851, 891 (2001) ("[Hostility to intellectual property rights] ignores the different nature of each form of intellectual property: each form was created to protect a particular aspect of intellectual productivity."); Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 627 (1999) ("As a general rule . . . cumulative legal causes of action to sustain different interests or to secure different relief are not regarded as inherently objectionable."); BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 50 (1966) (noting, in admittedly something of an aside, that a later author that gave his characters the same name as those in *Twelfth Night*, might be engaged in "passing off").

<sup>14</sup> Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1536 (1993).

<sup>15</sup> David Lange, who is supportive of a robust public domain, notes along similar lines. See David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147, 177 (1981) ("There can be little damage to the public domain in requiring precautions designed to prevent genuine deception or confusion . . .").

plaintiff is not seeking to prevent competitive uses of the work but is really seeking attribution or disassociation, courts should allow them to do so, but require content owners to seek relief only through something akin to trademark law (and, indeed, should view the use of copyright law in such circumstances as a form of copyright misuse). Next, I contend that because this construct should apply even when the copyright term ends for a work, courts should pay more attention when defendant content users attempt to use an overbroad notion of the public domain to blunt these trademark-type claims. Copyright law and trademark law are different regimes, with different motivations and different remedies, and there should be no reason why a properly stated trademark law-based claim should have to fall by the wayside simply because no valid copyright claim exists.

## II. THE TRADEMARK/COPYRIGHT INTERFACE

Before considering how copyright law and trademark law came to be seen as duplicative schemes, it might be helpful to reinforce the separate economic foundations underlying each of copyright law and trademark law. From there, we can consider how similar distinctions have been recognized at other intellectual property law interfaces and why the line is considerably blurrier at the trademark/copyright interface.

### A. *The Goals of Copyright Law and Trademark Law*

Although both are today typically explained in terms of economics, U.S. copyright law and U.S. trademark law are motivated by different concerns and, therefore, are directed toward different goals. Copyright's economic story is one of incentives.<sup>16</sup> In this (the most dominant) telling, the rights provided by copyright law are necessary in order to induce the appropriate amount of creative product; without these incentives, creators would presumably underproduce. In this regard, copyright law is aligned with patent law: both embody a set of rights used to induce creators and inventors to share their work with the public by granting a limited period of time during which the creator or inventor can exact monopoly prices.<sup>17</sup>

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<sup>16</sup> See, e.g., Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 COLUM. L. REV. 1600, 1610–12 (1982); but see, e.g., Roberta Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. \_\_ (forthcoming 2006) (challenging this view as neglecting “inspirational and spiritual motivations for creativity”). Other justifications — a Lockean theory of deserts or a sense of moral rights — have been proffered but have not won overwhelming favor in U.S. jurisprudence or scholarship. See, e.g., John Shepard Wiley, Jr., *Copyright at the School of Patent*, 58 U. CHI. L. REV. 119, 139 (1991).

<sup>17</sup> See, e.g., Brett Frischmann & Dan Moylan, *The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and Its Application to Software*, 15 BERKELEY TECH. L.J. 865, 876 n.32 (2000) (“Both [patent and copyright law] represent a legislatively determined trade-off between

The set of rights copyright law offers creators all relate to exploitation of the work. Assuming the work clears the constitutional hurdles of originality and fixation, the copyright owner enjoys for the statutory period the exclusive right to control the reproduction, distribution, public performance and display of the work in addition to control over whether any derivative works are created.<sup>18</sup> Each of these rights relates to the use of the work itself and particularly in the market exploitation of the work in its various forms.<sup>19</sup> Essentially, the nature of the incentive tells creators, much as it does in the patent scheme, “The world will be a better place for your creations. If you bring them forth, we will give you, for a limited time period, the exclusive right to profit from them.” Infringement, too, is explained largely in terms of these market-based rights in that infringement, put simply, is a use of the copyrighted work during the copyright term in violation of one of these rights. In other words, infringement is an attempt by the infringer to appropriate for himself the economic due that is the author’s,<sup>20</sup> rendering the infringer potentially subject to payment of damages and/or an injunction.<sup>21</sup>

Copyright law does, of course, provide a significant carveout from this general principle in the form of a “fair use” provision, in which parties who are engaging in transformative (as opposed to substitutive) uses of the work, such as commentary or criticism, are deemed not to have committed infringement even though the use of the work has not been authorized by the copyright holder.<sup>22</sup> Here, too, the analysis is driven largely by whether the defendant’s use is a substitute in the marketplace for the plaintiff’s work.<sup>23</sup> The focus on this question makes sense given the economic nature of the rights granted to the copyright holder: If the rights are largely about the exclusive ability of the copyright holder to monetize the work at issue, a concurrent, unauthorized use of the

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increased ex ante incentives for investment and reduced ex post utilization through an exclusive property right, where in a rough sense, it is accepted that the social benefits of increased supply exceed the social costs of short term inefficient use.”).

<sup>18</sup> 17 U.S.C. § 106.

<sup>19</sup> See, e.g., Pierre N. Leval, *Fair Use Rescued*, 44 UCLA L. REV. 1449, 1452 (1997) (“Copyright is a commercial doctrine; the reasonable commercial expectations of the original author needed to be protected from one who would quote in order to compete by offering a substitute for the original.”) (describing historical view). It may be useful to note that the Statute of Anne (U.S. copyright law’s ancestor) granted exclusive rights only in the “printing and reprinting” of a book, with infringement being the act of “print[ing], reprint[ing], or import[ing]” without consent. BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 7 (1966).

<sup>20</sup> 17 U.S.C. § 501(a); see also *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984) (describing an infringer as “anyone who trespasses into [the copyright owner’s] exclusive domain by using or authorizing the use of the copyrighted work in one of the five ways set forth in the statute”).

<sup>21</sup> 17 U.S.C. §§ 502–505.

<sup>22</sup> 17 U.S.C. § 107.

<sup>23</sup> See, e.g., *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 590–93 (1994); *Harper & Row, Pubs., Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985); Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 COLUM. L. REV. 1600, 1639–40 (1982).

work by another party during the copyright term can be permissible only if it doesn't compete with the copyright owner's work in the market.<sup>24</sup>

Thus, despite the pervasive trope of the Romantic author throughout copyright law commentary — a view that has never quite accurately described authorship vis-à-vis copyright law in any event<sup>25</sup> — it would seem to be the dominant view that market-based interests (rather than moral or personality interests) are what are at the heart of U.S. copyright law. Copyright law, in other words, appeals to creators' interest in monetizing their cultural production by offering them certain exclusive rights to do so for a limited time.<sup>26</sup>

Although it also can be explained in economic terms, trademark law, by contrast, has historically not been justified in terms of promoting creativity. Unlike copyright and patent law, trademark law is not designed to offer incentives to create to the trademark holder; indeed, the prevailing view (but probably not among marketers) is that virtually no creativity at all is required to develop a trademark.<sup>27</sup> Rather, trademark law is typically justified in terms of the public interest — protecting consumers from deception in the marketplace by prohibiting the use of source-identifying marks if such use is likely

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<sup>24</sup> See, e.g., *Rogers v. Koons*, 960 F.2d 301, 312 (2d Cir. 1992) (“It is plain that where a use has no demonstrable impact on a copyright owner[’s] potential market, the use need not be prohibited to protect the artist’s incentive to pursue his inventive skills.”); BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 53 (1966) (suggesting that “cross-lifting among serious musical works” should be permitted under copyright law because of, *inter alia*, “the unlikelihood that borrowing diverts profit from the original composer”).

<sup>25</sup> See, e.g., Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1384–94 (2005) (describing conceptions of authorship).

<sup>26</sup> In *Eldred v. Reno*, in which the Court held the Copyright Term Extension Act of 1998 valid, the Court quoted with approval the statement of the court in *American Geophysical Union v. Texaco Inc.*, that “copyright law celebrates the profit motive, recognizing that the incentive to profit from the exploitation of copyrights will redound to the public benefit by resulting in the proliferation of knowledge.” *Eldred v. Reno*, 537 U.S. 186, 212 n.18 (2003) (quoting *American Geophysical Union v. Texaco Inc.*, 802 F. Supp. 1 27 (S.D.N.Y. 1992), *aff’d*, 60 F.3d 913 (2d Cir. 1994)). Of course, there is much creation subject to copyright that is not motivated by the possibility of profit — some scholarly writing, many of the user-created videos on sites like YouTube, and no doubt a large number of existing blogs. Indeed, for these creators, the sole interest they may have in their creation is the non-copyright interest in attribution for their efforts.

<sup>27</sup> See, e.g., *Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (“The ordinary trade-mark has no necessary relation to invention or discovery. . . . The trade-mark does not depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation.”); Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 630 (1999). Not all scholars agree with this assessment. See, e.g., Gideon Parchomovsky & Peter Siegelman, *Towards an Integrated Theory of Intellectual Property*, 88 VA. L. REV. 1455, 1472 (2002) (“[T]he insistence [by the Supreme Court] on viewing copyright, patent, and trademarks as protecting distinct social goals — a position shared by many Law and Economics scholars — is in many cases simply wrong. As we will show, trademark protection also spurs innovation and can complement the incentive provided by patents to expend resources on R&D.”).

to confuse consumers as to the source of the item. In economic parlance, the protection of trademarks both “reduce[s] the customer's costs of shopping and making purchasing decisions” by allowing the consumer to easily find (or avoid) the product he used last time and “helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.”<sup>28</sup> An entity that uses another’s valid trademark in a way that evidences a likelihood of confusion among the relevant consumer market is deemed to have infringed that trademark.<sup>29</sup>

Although trademark infringement cases typically involve what the average member of the public would think of as a trademark (a word, a logo, or a slogan), the unfair competition provisions of the Lanham Act are not so limited nor are they limited to protection for things registered with the U.S. Patent and Trademark Office as trademarks. Section 43(a) of the Lanham Act permits a cause of action against any person who, “in connection with any goods or services” uses 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” that is likely to cause confusion as to the “affiliation, connection, or association of such person with another person” or as to the “origin, sponsorship, or approval” of his goods or services.<sup>30</sup> By its terms, this is considerably broad language, and so cases have involved trademark-like elements as disparate as the distinctive sound of a singer’s voice and a famous author’s name.<sup>31</sup> In such cases, the plaintiff’s claim is not that the defendant is using the plaintiff’s mark to confuse consumers into thinking that the defendant’s products are made by the plaintiff (as would, say, the maker of “Popsi Cola”) but rather that the defendant is using some distinctive (and source-identifying) aspect of the plaintiff himself in order to suggest (deceptively) to consumers that the plaintiff has some connection with the defendant or the defendant’s products (i.e., a sponsorship or authorization).<sup>32</sup>

Thus (and this is something of an oversimplification), while copyright law gives the rights holder the ability to control distribution of the work itself, trademark law, properly enforced, gives the right holder the ability to control the manner in which that

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<sup>28</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) (internal quotation marks and citation omitted); *see also, e.g.*, Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2105–07 (2004).

<sup>29</sup> U.S. trademark also provides for a cause of action for dilution of a famous mark, *see* 15 U.S.C. § 1125(c), but I have focused on that cause of action elsewhere. *See* Laura A. Heymann, *Metabranding and Intermediation: A Response to Prof. Fleischer*, 12 HARV. NEG. L. REV. (forthcoming 2006).

<sup>30</sup> 15 U.S.C. § 1125(a)(1)(A).

<sup>31</sup> *See, e.g.*, *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (singer’s voice); *King v. Innovation Books*, 976 F.2d 824 (2d Cir. 1992) (author’s name).

<sup>32</sup> Indeed, until the Court’s 2003 decision in *Dastar*, courts were willing to consider a cause of action under section 43(a) for a failure to attribute source in connection with communicative goods although many, if not most, of these cases involved misattribution rather than simply lack of any attribution at all. *See, e.g.*, *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981); *Waldman Publ’g Corp. v. Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994).

work is presented to the public and, specifically, the ability to attempt to control the association consumers make when they encounter the mark. Because the two regimes are motivated by different concerns and are aimed at different goals, there should be no doctrinal reason why a plaintiff couldn't enforce both claims concurrently or separately, as appropriate.<sup>33</sup> Yet many scholars seem resistant to this concept for reasons that don't seem to arise in consideration of other areas of the law in which there are overlapping rights.<sup>34</sup> A tract of real property, for example, can be protected both by the law of trespass and by the law of nuisance, and no one would suggest that the landowner must choose one legal scheme to the exclusion of the other. In intellectual property, by contrast, an “information wants to be free” trope is more pervasive, such that any restrictions on the use of creative material beyond those provided by copyright are seen as “additional” and therefore improper.

This discomfort seems to be limited to, or at least focused on, communicative goods — in other words, at the trademark/copyright interface as opposed to other intersections in intellectual property law. At both the patent/trademark interface and at the patent/copyright interface, by contrast, the courts seem more solicitous of the coexistence of both intellectual property schemes, based on the same kind of distinction among goals and remedies that I have just discussed here.

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<sup>33</sup> The Supreme Court has often noted that copyright law and trademark serve distinct goals. *See* Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 439 n.19 (1984) (noting that the Court has “consistently rejected the proposition that a similar kinship exists between copyright law and trademark law” as exists between copyright law and patent law); *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (noting that the rights available under trademark law bear “little or no analogy” to those available under copyright or patent law); *The Trade-Mark Cases*, 100 U.S. 82, 91–92 (1879); *McLean v. Fleming*, 96 U.S. 245, 254 (1878); *Canal Co. v. Clar*, 13 Wall. 311, 322 (1872). *See also, e.g.*, *EFS Mkt'g, Inc. v. Russ Berrie & Co., Inc.*, 76 F.3d 487, 493 (2d Cir. 1996) (“[T]he Copyright Act and the Lanham Act address different harms. The first follows from a lack of originality, the second from a likelihood of confusion.”) (internal quotation marks omitted).

<sup>34</sup> *See supra* note 14. *But see, e.g.*, Marci A. Hamilton, *A Response to Professor Benkler*, 15 BERKELEY TECH. L.J. 605, 623 (2000) (suggesting that Congress could enact database legislation under the Commerce Clause so long as the legislation did not “create copyright rights in information”); Jane C. Ginsburg, *No “Sweat”?: Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 371 (1992) (“[T]he federal trademarks law affords protection not against copying per se, but against falsehoods in the marketplace. As a result, the protection afforded under the Lanham Act is not substantively equivalent to copyright or patent protection.”). Yochai Benkler, who is a strong proponent of an expansive public domain, has also recognized this distinction, although he characterizes it as a concern subordinate to copyright law rather than a co-equal regulatory scheme. *See* Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundation of the Public Domain*, 66 LAW & CONTEMP. PROBS. 173, 178 (2003) (“While Congress may regulate information markets under the Commerce Clause, it may not do so by creating exclusive private rights in information in a way that circumvents the substantive limitations placed on its power by [Article I, Section 8, Clause 8 of the Constitution].”).

B. *The Patent/Trademark Interface*

The *Dastar* Court relied for its conclusion that it is trademark law, and not copyright law, that must give way when the two are in apparent conflict on a series of patent cases that, as the Court described them, evince the Court's efforts to be "careful to caution against misuse or over-extension of trademark and related protections into areas traditionally occupied by patent or copyright."<sup>35</sup> But a review of these opinions (which fall entirely into the patent realm) shows that, almost uniformly, the Court was careful to leave some room for trademark law-related interests in fields largely occupied by patent — specifically, it imposed on the entity copying the now patent-free product an obligation to provide whatever disclaimers or disclosures were necessary to eliminate consumer confusion.

In *Singer Manufacturing Co. v. June Manufacturing Co.*,<sup>36</sup> the Court held that a company that had copied the plaintiff's sewing machine after the patent on it had expired had the right not only to copy the machine but also to call the machine a "Singer," given that the word had, over time, become the generic term for that type of sewing machine. (To the extent that the Court determined that "Singer" was a generic term and not a trademark, its conclusion that makers of similar machines could call their products by that name is uncontroversial.) Nevertheless, it was still incumbent on the defendant and others in similar situations, the Court held, to avoid creating any consumer confusion in the marketplace that might result from its lawful exercise of its public domain rights under the expired patent:

It is self evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. . . . It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public, that along with the public ownership of the device there must also necessarily pass to the public the generic designation for the thing which has arisen during the monopoly . . . . But it does not follow, as a consequence of a dedication, that the general power, vested in the public, to make the machine and use the name imports that there is no duty imposed, on the one using it, to adopt such precautions as will protect the property of others and prevent injury to the public interest, if by doing so no substantial restriction is imposed on the right of freedom of use. This principle is elementary and applies to every form of right, and is generally expressed by the aphorism *sic utere tuo ut alienum non loedas*. This qualification results from the same principle upon which the dedication rests, that is, a regard for the interest of the public and the rights of individuals.<sup>37</sup>

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<sup>35</sup> *Dastar*, 539 U.S. at 34.

<sup>36</sup> 163 U.S. 169 (1896).

<sup>37</sup> *Id.* at 185–86.

Thus, the *Singer* Court recognized that patent law and trademark law respond to two distinct interests: the interest in monopoly over production and use (and similarly, in copyright, the interest in monopoly over creation and distribution) and the interest in preserving source attribution or, at the very least, minimizing consumer confusion. And, as the Court noted, the public interest is concerned with both: in the use that results once the limited monopoly of patent or copyright expires, and in a marketplace free of confusion as to source.

Similarly, in *Kellogg Company v. National Biscuit Company*,<sup>38</sup> the Court held that after the patent on shredded wheat expired, the former patent holder could not stop the defendant from making the product and from calling it by the now generic name “shredded wheat,” but it could exercise its right to stop the defendant from confusing consumers as to the source of its product (or, more particularly, to require the defendant to specifically identify its own product).<sup>39</sup>

Other cases follow a similar theme. In *Sears, Roebuck & Co. v. Stiffel Co.*<sup>40</sup> and its companion case, *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>41</sup> the Court rejected the plaintiffs’ attempt to use state unfair competition law to prevent the defendants in each case from copying the plaintiffs’ formerly patented design and selling that copy in the marketplace.<sup>42</sup> As the Court noted in *Sears*, the federal patent scheme involves a tradeoff between the limited monopoly over production and use given to the patent over for the ability to copy once the patent expires: “[W]hen the patent expires the monopoly created by it expires, too, and the right to make the article — including the right to make it in precisely the shape it carried when patented — passes to the public.”<sup>43</sup> Accordingly, the Court concluded, a state could not create additional patent rights that would be invoked post-expiration without coming into conflict with the Supremacy Clause of the Constitution.<sup>44</sup> But the Court’s language was targeted only at alternative statutory schemes (in this case, state unfair competition law) that would create a shadow *patent* scheme. The Court took pains to state that state unfair competition law could be invoked

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<sup>38</sup> 305 U.S. 111 (1938).

<sup>39</sup> *Id.* at 119. Indeed, the Court noted that the defendant was under such an obligation no less than four separate times in its opinion. *See id.* at 119–21 (describing the defendant’s obligation as being to “use every reasonable means to prevent confusion”). Graeme Dinwoodie has quite correctly characterized this admonition from the Court as “an assessment of the manner in which the defendant was exercising its right to copy . . . to determine congruence with principles of unfair competition.” Graeme B. Dinwoodie, *The Story of Kellogg Co. v. National Biscuit Co.: Breakfast with Brandeis*, in *INTELLECTUAL PROPERTY STORIES* 220, 233 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006).

<sup>40</sup> 376 U.S. 225 (1964).

<sup>41</sup> 376 U.S. 234 (1964).

<sup>42</sup> In *Sears*, the item was a pole lamp; in *Compco*, the item was a lighting fixture.

<sup>43</sup> *Sears*, 376 U.S. at 230 (citing *Kellogg* and *Singer*).

<sup>44</sup> *Id.* at 231 (“Obviously a State could not, consistently with the Supremacy Clause of the Constitution, extend the life of a patent beyond its expiration date or give a patent on an article which lacked the level of invention required for federal patents. To do either would run counter to the policy of Congress of granting patents only to true inventions, and then only for a limited time.”).

to enforce trademark- or unfair competition–based rights, so long as the requirements of that law were met:

Doubtless a State may, in appropriate circumstances, require that goods, whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to the source, just as it may protect businesses in the use of their trademark, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as the source of the goods. But because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying.<sup>45</sup>

The Court made much the same point in *Compro*:

[W]hile the federal patent laws prevent a State from prohibiting the copying and selling of unpatented articles, they do not stand in the way of state law, statutory or decisional, which requires those who make and sell copies to take precautions to identify their products as their own. A State of course has power to impose liability upon those who, knowing that the public is relying upon an original manufacturer’s reputation for quality and integrity, deceive the public by palming off their copies as the original.<sup>46</sup>

In other words, state unfair competition law may be invoked, *even as to an article for which the patent has expired*, to protect trademark-based rights involving source identification and labeling, so long as the law is not used to create an extension of patent-law based rights (i.e., the right to prevent use or sale of the item full-stop).<sup>47</sup> Thus, a putative plaintiff under these circumstances could not simply point to the existence of the defendant’s identical article as proof of a violation of its trademark law–based rights; it

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<sup>45</sup> *Id.* at 232 (footnote omitted).

<sup>46</sup> *Compro*, 376 U.S. at 238; *see also* Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN. L. REV. 595 (1996) (“By linking its holding directly to the Intellectual Property Clause, *Compro* recognized a constitutional foundation for the right to copy product configurations, with liability possible only if a defendant’s labeling failed to eliminate the risk of confusion caused by its copying of distinctive nonfunctional elements of the plaintiff’s design.”). For a discussion about the parallels between consideration of federal intellectual property schemes and federal/state preclusion analysis, *see* Edward Samuels, *The Public Domain in Copyright Law*, 41 J. COPYRIGHT SOC’Y U.S.A. 137, 167–68 (1993).

<sup>47</sup> *Id.*; *see also* *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152 (1989) (“Where the public has paid the congressionally mandated price for disclosure, the States may not render the exchange fruitless by offering *patent-like protection* to the subject matter of the expired patent.”) (emphasis added); *Compro*, 376 U.S. at 238 (“[R]egardless of the copier’s motives, neither these facts [as to secondary meaning] nor any others can furnish a basis for imposing liability for or prohibiting the actual acts of copying and selling.”); *cf. Compro*, 376 U.S. at 239 (Harlan, J., concurring) (stating that where the defendant copied with the dominant purpose of palming off, the plaintiff’s remedy should include “reasonable restrictions” on the copying itself).

would have to demonstrate that a likelihood of confusion existed separate and apart from the mere act of copying, which was entirely lawful.<sup>48</sup>

If there was any question as to the correct reading of these cases, the Court answered that question in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*<sup>49</sup>:

Read at their highest level of generality, [*Sears and Compco*] could be taken to stand for the proposition that the States are completely disabled from offering any form of protection to articles or processes which fall within the broad scope of patentable subject matter. . . . That the extrapolation of such a broad pre-emptive principle from *Sears* is inappropriate is clear from the balance struck in *Sears* itself. . . . [O]ur decision in *Sears* clearly indicates that the States may place limited regulations on the circumstances in which such designs are used in order to prevent consumer confusion as to source. Thus, while *Sears* speaks in absolutist terms, its conclusion that the States may place some conditions on the use of trade dress indicates an implicit recognition that all state regulation of potentially patentable but unpatented subject matter is not *ipso facto* pre-empted by the federal patent laws.<sup>50</sup>

Thus, the Florida statute at issue in *Bonito Boats*, which prohibited the commercial use of a direct molding process to duplicate a manufactured vessel hull without authorization, was impermissible because, although it could be described as an “unfair competition” statute, its effect was not to protect consumers from deception by, for example, requiring accurate labeling or disclosures, but rather was to restrict the use of the article itself. The Florida statute did not contain any requirement that the vessel hull functioned as a source indicator or possessed secondary meaning, nor was the statute concerned with preventing consumer deception.<sup>51</sup> Instead, it allowed the manufacturer to assert patent-like rights over the design even though it had already disclosed that design to the public and thus rendered it unpatentable under federal law.

Taken together, then, the Court’s decisions at the patent/trademark interface indicate where the line is drawn: Neither federal nor state trademark or unfair competition law may provide patent-like rights for articles that cannot be patented under

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<sup>48</sup> In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), the Court characterized the appellate court’s decision affirming the district court’s injunction as “coming to the conclusion that the Illinois law of unfair competition prohibited product simulation even in the absence of evidence that the defendant took some further action to induce confusion as to source.” *Id.* at 153.

<sup>49</sup> 489 U.S. 141 (1989).

<sup>50</sup> *Id.* at 154; *see also id.* at 165 (“States may place limited regulations on the use of unpatented designs in order to prevent consumer confusion as to source.”).

<sup>51</sup> *Id.* at 158 (“In contrast to the operation of unfair competition law, the Florida statute is aimed directly at preventing the exploitation of the design and utilitarian conceptions embodied in the product itself.”). Respectfully, I find this reading of the Court’s holding in *Bonito Boats* to be less controversial than do other commentators. *See, e.g.,* Jane C. Ginsburg, *No “Sweat”?: Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 364–65 (1992).

federal patent law — in other words, rights that grant the inventor the ability to prohibit use or sale of the article itself — but they may certainly provide trademark-like rights for those same unpatentable articles — rights that do not restrict use *per se* but do place some limitations on the way that use is presented to the public.<sup>52</sup> So long as the purportedly competing statutory scheme promotes goals that are different from those promoted by the federal patent system, both schemes can peacefully co-exist.<sup>53</sup> As the Court noted in *Bonito Boats*: “[T]he law of unfair competition . . . [has] coexisted harmoniously with federal patent protection for almost 200 years, and Congress has given no indication that [its] operation is inconsistent with the operation of the federal patent laws.”<sup>54</sup>

These general statements as to the interaction between patent law and trademark law have been given practical effect in the lower courts. In *In re Mogen David Wine Corp.*,<sup>55</sup> to take just one example, the Court of Customs and Patent Appeals (the predecessor to the Federal Circuit) held that the manufacturer of a distinctive wine bottle could assert trademark rights in the bottle even though it also held a design patent in the bottle. In rejecting the argument that the manufacturer could assert rights only under one scheme or the other, the court rejected the argument that the potentially perpetual nature of trademark rights might improperly extend the patent monopoly:

In our opinion, trademark rights, or rights under the law of unfair competition, which happen to continue beyond the expiration of a design patent, do not “extend” the patent monopoly. They exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other. When the patent monopoly ends, it ends. The trademark rights do not extend it. . . . Patent expiration is nothing more than the cessation of the patentee’s right to exclude held under the patent law. Conversely, trademark conceivably could end through non use during the life of a patent. We

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<sup>52</sup> The Court has engaged in a similar discussion regarding preemption of state intellectual property schemes by federal law. *Cf.* *Goldstein v. California*, 412 U.S. 546 (1973); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 493 (1974) (“[State t]rade secret law and [federal] patent law have co-existed in this country for over one hundred years. Each has its particular role to play, and the operation of one does not take away from the need for the other.”); *see also Kewanee*, 416 U.S. at 494 (“[T]he question presented in this case is whether Congress, in enacting the patent laws, intended merely to offer inventors a limited monopoly in exchange for disclosure of their invention or instead to exert pressure on inventors to enter into this exchange by withdrawing any alternative possibility of legal protection for their inventions. I am persuaded that the former is the case.”) (Marshall, J., concurring in the judgment).

<sup>53</sup> *See Bonito Boats*, 489 U.S. at 166 (noting that in *Sears and Kewanee*, “state protection was not aimed exclusively at the promotion of invention itself, and the state restrictions on the use of unpatented ideas were limited to those necessary to promote goals outside the contemplation of the federal patent scheme”); *see also, e.g.,* Graeme W. Austin, *The Berne Convention as a Canon of Construction: Moral Rights After Dastar*, 61 N.Y.U. ANN. SURV. AM. L. 111, 125–26 (2005).

<sup>54</sup> *Id.*

<sup>55</sup> *In re Mogen David Wine Corp.*, 328 F.2d 925 (CCPA 1964).

doubt it would be argued that the patent rights should also expire so as not to “extend” them.<sup>56</sup>

Similarly, in *Kohler Co. v. Moen Inc.*,<sup>57</sup> the Seventh Circuit rejected the argument that to allow trademark protection for product configurations would contravene the limitations inherent in the Patent Clause:

Compared to patent protection, trademark protection is relatively weak because it precludes competitors only from using marks that are likely to confuse or deceive the public. . . . [W]hile a patent creates a type of monopoly pricing power by giving the patentee the exclusive right to make and sell the innovation, a trademark gives the owner only the right to preclude others from using the mark when such use is likely to cause confusion or to deceive. . . . [P]erpetual trademark protection under the Lanham Act for a product configuration or design is not the equivalent of impermissible perpetual patent protection.<sup>58</sup>

Thus, building on the Court’s guidance in the cases just outlined, the lower courts have even more explicitly concluded that the enforcement of trademark law–based rights is independent of the enforcement of rights under patent law,<sup>59</sup> just as the enforcement of, say, emission standards as to a particular automobile is independent of efforts to enforce the common law of theft as to that same vehicle.

As in copyright, patent law involves a certain *quid pro quo*: the disclosure of the invention to the public in exchange for a limited monopoly during the term of the grant. One important bulwark at the trademark/patent interface that derives from this exchange is the functionality doctrine. Under this doctrine, a defendant is free to copy functional

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<sup>56</sup> *Id.* at 930.

<sup>57</sup> 12 F.3d 632 (7th Cir. 1993).

<sup>58</sup> *Id.* at 637, 643. The Supreme Court’s subsequent decision in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000), which held that product designs could not be protected as trademarks without a showing of secondary meaning, does not render the conclusion of the *Kohler* court incorrect; *Samara Bros.* merely requires evidence of trademark status for product designs, rather than assuming it.

<sup>59</sup> *See, e.g.*, *Ferrari S.P.A. Esercizio Fabriche Automobili Corse v. Roberts*, 944 F.2d 1235, 1241 (6th Cir. 1991) (“[T]rademark protection does not unduly extend the seventeen-year monopoly guaranteed by the patent laws because the two sources of protection are totally separate . . . . Thus, Lanham Act protection is available to designs which also might have been covered by design patents as long as the designs have acquired secondary meaning.”); *W.T. Rogers Co., Inc. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985) (Posner, J.) (“The trademark owner has an indefinite term of protection, it is true, but in an infringement suit must also prove secondary meaning and likelihood of confusion, which the owner of a design patent need not do; there is therefore no necessary inconsistency between the two modes of protection.”); *Truck Equipment Service Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1215 (8th Cir. 1976) (“The protection accorded by the law of trademark and unfair competition is greater than that accorded by the law of patents because each is directed at a different purpose. The latter protects inventive activity which, after a term of years, is dedicated to the public domain. The former protects commercial activity which, in our society, is essentially private. . . . Free competition is served in both cases.”).

features of an item no longer under patent even if those items developed a source-identifying function during the term of the patent. To take one well-known judicial example, once the patent on a spring mechanism for road signs expired, competitors could freely copy that design even if the exclusive use enjoyed by the patentee during the term resulted in the development of secondary meaning.<sup>60</sup> The theory behind the doctrine is that features that are functional in nature may be copied freely post-patent term because it is precisely those features that were the subject of the patent in the first place. The bargain inherent in the patent law requires this result; if competitors could not use the very elements of the item that make the item work, then they essentially cannot use the item at all, rendering the public domain on the other side of the patent term ephemeral. But even here, the courts have been careful to note that a competitor cannot use those nonfunctional elements that indicate the source of the original creator if to do so would sow consumer confusion;<sup>61</sup> moreover, even the use of the functional aspects of the invention may, in limited instances, be required to be accompanied with a disclaimer or other method of dispelling any false intimation of association or sponsorship.<sup>62</sup> Thus, the functionality doctrine does its own work at policing the trademark/patent divide and does not prohibit the second user from making use of the very thing guaranteed to him under the patent laws; it places restrictions only on the way that use is presented to the public.

### C. *The Copyright/Patent Interface*

Much the same analysis is seen at the copyright/patent interface, despite the fact that copyright and patent, as two regimes designed to encourage creative production in exchange for eventual ceding to the public domain, might be seen as closer to overlapping. Nevertheless, as the Supreme Court noted in *Mazer v. Stein*, “Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted.”<sup>63</sup> Although Congress’s power to enact both schemes derives from the same clause of the Constitution,<sup>64</sup> and both are justified by the public interest in creativity or invention, patent and copyright address different aspects of the creative process: Patent protects the invention of a new idea, while copyright specifically does not protect the underlying idea but rather protects only a particular expression of that idea. Or, as the *Mazer* Court put it, “The dichotomy of protection for the aesthetic is not beauty and

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<sup>60</sup> *TrafFix Devices, Inc. v. Mkt’g Displays, Inc.*, 532 U.S. 23, 29–30 (2001).

<sup>61</sup> *See, e.g., Cheney Bros. v. Doris Silk Corporation*, 35 F.2d 279, 280 (2d Cir. 1929) (Hand, J.)

<sup>62</sup> *See Thomas F. Cotter & Angela M. Mirabole, Written on the Body: Intellectual Property Rights in Tattoos, Makeup, and Other Body Art*, 10 UCLA ENT. L. REV. 97, 125–31 (2003); Robert C. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C. L. REV. 603, 614 n.69 (1984).

<sup>63</sup> 347 U.S. 201, 217 (1954).

<sup>64</sup> *See* U.S. CONST. art I, section 8, clause 8 (giving Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”).

utility but art for the copyright and the invention of original and ornamental design for design patents.”<sup>65</sup>

Similarly, as at the trademark/patent interface, copyright law has a functionality doctrine that works to render unto copyright what is copyright’s and unto patent what is patent’s. Pursuant to this provision, any design that is “dictated solely by a utilitarian function of the article that embodies it”<sup>66</sup> — that is, a design that is more idea than expression — may not receive copyright protection (although it may, if it qualifies, be protected by patent). But the ornamental or design elements of an object that exist independently of the functional aspects of the item may receive copyright protection,<sup>67</sup> just as the source-identifying elements of a functional article that exist separately from the functional aspects may qualify for protection under the Lanham Act. Thus, in *Mazer v. Stein*, the Court held that the creator of a small china statuette of male and female dancing figures could maintain its copyright in the work even after the statuette had been used as the base for a table lamp. The two schemes, the Court concluded, served different goals, such that the availability of protection under one could not preclude protection under the other:

We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law. Nor do we think the subsequent registration of a work of art published as an element in a manufactured article is a misuse of the copyright. This is not different from the registration of a statuette and its later embodiment in an industrial article.<sup>68</sup>

The question of whether a creator could avail himself of both copyright protection and patent protection simultaneously did not directly arise in *Mazer*; because the creator had not in fact obtained a design patent, the issue in that case was whether the functional nature of the statuettes barred protection as a work of art under copyright. But the question did arise directly before the U.S. Court of Customs and Patent Appeals twenty years later. In *In re Yardley*,<sup>69</sup> the court relied on *Mazer*’s foundational point to hold that the creator of a watch face design could indeed avail himself of the protections

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<sup>65</sup> *Id.* at 218; *see also, e.g.*, *Baker v. Selden*, 101 U.S. 99, 105 (1880) (“The description of [a bookkeeping method] in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, it can be secured at all, by letters-patent.”)

<sup>66</sup> See 17 U.S.C. § 1302 (excluding from copyright protection a design “dictated solely by a utilitarian function of the article that embodies it”).

<sup>67</sup> See 17 U.S.C. § 101 (“The design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”).

<sup>68</sup> *Mazer*, 347 U.S. at 218–19; *see also* *Chosun Int’l Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005).

<sup>69</sup> *In re Application of Richard Q. Yardley*, 493 F.2d 1389 (C.C.P.A. 1974).

of both doctrines; any requirement that the creator elect one or the other, the court held, would be “in direct conflict with the clear intent of Congress” to provide both design patent protection and copyright protection, given that nothing in either statutory scheme requires a creator to choose.<sup>70</sup> In particular, the *Yardley* court rejected the Commissioner of Patents’ argument (citing *Sears*) that to allow a creator to enjoy the protection of both copyright law and patent law for the same article would subvert Congress’s goals in the patent scheme because when the patent expired, the invention would still be subject to the longer term of copyright, although no longer subject to the restrictions of patent law:

We agree that the copyright secured by appellant’s assignee will outlive any design patent appellant may secure. . . . But the mere fact that the copyright will persist beyond the term of any design patent which may be granted does not provide a sound basis for rejecting appellant’s design patent application. . . . If anything, the concurrent availability of both modes of securing exclusive rights aids in achieving the stated purpose of the constitutional provision.<sup>71</sup>

Given this seemingly uncontroversial line of cases at both the patent/trademark interface and at the patent/copyright interface holding that there is no fatal conflict between the two regimes in each pair, properly circumscribed, one might wonder whether a different answer should necessarily obtain when the inquiry is at the trademark/copyright interface. The answer, curiously, now seems to be yes.

#### D. *The Trademark/Copyright Interface*

This was not always the case, however. For example, in *Frederick Warne & Co., Inc. v. Book Sales Inc.*,<sup>72</sup> the court rejected the defendant’s argument that because the books at issue (several children’s books by Beatrix Potter, including *The Tale of Peter Rabbit*) had fallen into the public domain, the defendant was free not only to republish the stories themselves but also to use the same cover illustrations as had been used for the plaintiff’s series:

The fact that a copyrightable character or design has fallen into the public domain should not preclude protection under the trademark laws

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<sup>70</sup> *Id.* at 1394; *see also id.* at 1395 (“To paraphrase the Supreme Court in *Mazer v. Stein*: Neither the copyright statute nor the patent statute says that because a thing is copyrighted it may not be patented as a design. We should not so hold.”).

<sup>71</sup> *Id.* at 1395–96; *see also id.* (rejecting the argument that permitting copyright protection to continue after the patent term ends effects a “failure of consideration”; “[a] patent is not a contract”). To be clear, my argument here is an attempt to engage in a reading of the existing statutory scheme, not to propose alternatives to it. Whether it was wise for Congress to permit certain articles to avail themselves of both patent and copyright law, despite the differing terms, is a discussion I leave to others. *See, e.g.*, Julie E. Cohen & Mark A. Lemley, *Patent Scope and Innovation in the Software Industry*, 89 Calif. L. Rev. 1, 27 (2001) (noting the potential conflict between patent law and copyright law in the reverse engineering of software context).

<sup>72</sup> 481 F. Supp. 1191 (S.D.N.Y. 1979).

so long as it is shown to have acquired independent trademark significance, identifying in some way the source or sponsorship of the goods. Because the nature of the property right conferred by copyright is significantly different from that of trademark, trademark protection should be able to co-exist, and possibly to overlap, with copyright protection without posing preemption difficulties.<sup>73</sup>

The same was true in *Consumers Union of the United States, Inc. v. General Signal Corp.*,<sup>74</sup> in which the plaintiff publisher of *Consumer Reports* brought suit against the defendant manufacturer of a vacuum cleaner that was favorably reviewed in the magazine; the manufacturer had included quotations from the review in its television advertising. The complaint alleged causes of action both under copyright law and under the Lanham Act. The Second Circuit held that the defendant's use of material from the review constituted fair use,<sup>75</sup> yet this finding did not preclude consideration of the plaintiff's Lanham Act claim, which was assessed on its own merits. The court did not suggest, for example, that because the material used in the advertisement fell into the realm of material free from the restrictions of copyright law (in this case, because of the fair use finding), the Lanham Act could not apply because any restrictions from trademark law would impermissibly encroach on the rights guaranteed to the defendant as part of the copyright bargain. Indeed, the court noted that the trademark-based claims were really what were at stake: "CU is not really objecting to Regina's copying CU's expression. The statement of policy in its magazine and its position in its brief before us in that any mention of CU in commercial advertising will diminish its effectiveness as an unbiased evaluator of products."<sup>76</sup> Although it ultimately concluded that there was no likelihood of confusion in this case sufficient to support a preliminary injunction, the court further recognized the difference between copyright law and trademark law when it noted, in dicta, that had such a finding been made, the proper remedy would have been a disclaimer, not an injunction.<sup>77</sup> This is entirely consistent with a reasoned view of the separate spheres that copyright law and trademark law occupy: copyright law controls

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<sup>73</sup> *Id.* at 1196 (citation omitted). See also Doris Estelle Long, *First, "Let's Kill All the Intellectual Property Lawyers!": Musings on the Decline and Fall of the Intellectual Property Empire*, 34 J. MARSHALL L. REV. 851, 878 (2001) ("The right to such dual protection [in *Frederick Warne*] was premised on a clear acknowledgement that each arena of intellectual property law served its own special goals, and on the incongruity of limiting protection to works that were more creative.").

<sup>74</sup> *Consumers Union of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044 (2d Cir. 1983).

<sup>75</sup> The court concluded that the material copied, although used for commercial purposes, was factual and informational; that the amount of material copied was "relatively insubstantial; and that the defendant's use did not compete in the market with the plaintiff's use. *Id.* at 1049–50.

<sup>76</sup> *Id.* at 1050; see also *id.* at 1051 n.7 ("Truthful excerpting of CU's ratings cannot hurt CU unless the public perceives that CU sponsored the use. In such a case § 43(a) of the Lanham Act and the privacy statutes which prevent unauthorized product endorsements are more appropriate.").

<sup>77</sup> *Id.* at 1033 ("The First Amendment demands use of a disclaimer where there is a reasonable possibility that it will suffice to alleviate consumer confusion.").

distribution of the material *qua* material; trademark law controls how the source of that material is presented to the public.<sup>78</sup>

This is not to say, however, that this view of the copyright/trademark interface was universal. In *Comedy III Prods., Inc. v. New Line Cinema*,<sup>79</sup> for example, the Ninth Circuit rejected the plaintiff's attempt to use the Lanham Act to restrain use of a clip from a Three Stooges movie that had fallen into the public domain; the clip played on a television in the background of a scene in the film *The Long Kiss Goodnight*. While purporting to deny the plaintiff's claim on the ground that it had failed to show that the film clip functioned as the plaintiff's trademark,<sup>80</sup> the court made a much broader statement about the viability of Lanham Act claims post-expiration of copyright: "[T]he footage at issue here was clearly covered by the Copyright Act, and the Lanham Act cannot be used to circumvent copyright law. If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity."<sup>81</sup>

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<sup>78</sup> See also, e.g., *Brandi Int'l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1148-1149 (2d Cir. 1987) (rejecting copyright claim as to bicycle rack for failure to meet conceptual separability requirement but remanding for additional findings on trademark law claim, noting that functionality in trademark doctrine differs); *Independent Baking Powder Co. v. Boorman*, 130 F. 726, 728 (3d Cir. 1904) ("The complainant in this case is not seeking [by filing a trademark infringement case] to prevent the manufacture of baking powder by the defendant, but only to prevent him from using a mark or brand that would tend to induce purchasers to believe that defendant's article was really the manufacture and production of complainant.").

<sup>79</sup> *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000).

<sup>80</sup> Indeed, the court later noted that the plaintiff might well have had a viable claim if the defendant had "used the likeness of The Three Stooges on t-shirts which it was selling." *Id.* at 595.

<sup>81</sup> *Id.* In my view, the court reached the right result but for the wrong reason. *Comedy III* should not have lost its suit because copyright law and trademark law are irreconcilable, and not even necessarily because the clip could not serve a trademark function; it should have lost its case because, as the court initially indicated, the use of the film clip for 30 seconds in the background of another film did not indicate sponsorship or authorization (i.e., there was no likelihood of confusion). Cf. *Clemens v. Belford, Clark & Co.*, 14 F. 728 (C.C.N.D. Ill. 1883) (holding that a publisher was free to publish the works of Mark Twain that were in the public domain in any form it chose, including by (accurately) stating the name of the author on the compilation); *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 639 n.9 (7th Cir. 1993):

The [Clemens] court did not rule out trademark protection to the author's use of his pen name. Rather, the court simply held that because Twain had not obtained a copyright in his works, his writings had been dedicated to the public and anyone could publish them if they properly identified the writings as Twain's. Twain's trademark infringement claim was a loser because he did not (and could not) allege that the defendants had falsely identified the origin of the published works. There was minimal risk that the public would be confused as to the source because the defendants clearly identified Mark Twain as the author; Twain simply resented that the publisher would profit due to his failure to obtain copyright protection.

Although the Supreme Court had previously considered the issues at the patent/trademark and patent/copyright interfaces, it had not paid much attention to whether the same considerations held at the trademark/copyright interface. *Dastar Corporation v. Twentieth-Century Fox Film Corporation*<sup>82</sup> presented that opportunity. Twentieth-Century Fox, the holder of the exclusive television rights for Dwight D. Eisenhower's book about the Allied campaign in Europe during World War II, failed to retain rights in the television series eventually produced when it did not renew the copyright, leaving the television series in the public domain.<sup>83</sup> Dastar, a producer of music CDs looking to capitalize on the 50th anniversary of the end of World War II, acquired the tapes of the series, edited them, and released the series as its own product, without any reference to the producers of the original series.<sup>84</sup> Dastar's offering competed with a reissue of the original Fox series (for which Fox had reacquired the television rights in the book), and so Fox and its affiliates brought suit, alleging that the Dastar series infringed both the copyright in the book and Fox's rights under section 43(a) of the Lanham Act.<sup>85</sup>

The Court, in a unanimous opinion by Justice Scalia,<sup>86</sup> held that the Ninth Circuit had erred by affirming the district court's award of summary judgment on the Lanham Act claim in favor of Fox. Section 43(a)(1)(A) of the Lanham Act, the provision under which Fox had asserted its claims, creates a cause of action against one who uses in commerce "any word, term, name, symbol, or device, or any combination thereof," or "any false designation of origin," or a "false or misleading description of fact, or false or misleading representation of fact" that is likely to cause confusion as to "the affiliation, connection, or association of such person with another person" or as to "the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person."<sup>87</sup> Fox's allegation that Dastar had made a false representation as to the "origin" of the goods, the Court held, was unfounded: "Goods" in section 43(a)(1)(A) referred not to the intellectual property contained on the videotapes Dastar distributed but to the physical videotapes themselves, and Dastar was indisputably the source of the physical

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<sup>82</sup> 539 U.S. 23 (2003).

<sup>83</sup> *Id.* at 26.

<sup>84</sup> "Dastar's Campaigns series [was] 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." *Id.* at 26–27.

<sup>85</sup> Fox's Lanham Act claim was brought as a "reverse passing off" claim in violation of 15 U.S.C. § 1125(a)(1)(a); Fox alleged, in essence, that Dastar violated the Lanham Act by misrepresenting that Dastar, rather than Fox, was the source of the television series. *Id.* at 27 & n.1.

<sup>86</sup> Justice Breyer, whose brother heard the case by designation at the appellate court level, did not participate in the case.

<sup>87</sup> 15 U.S.C. § 1125(a)(1)(A). Section 1125(a)(1)(B) prohibits the same activities in "commercial advertising or promotion" if they "misrepresent[ ] the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities." 15 U.S.C. § 1125(a)(1)(B).

product.<sup>88</sup> The case therefore turned, in the Court’s view, on a simple statutory analysis: the Lanham Act prohibits misleading statements in connection with the sale of “goods”; “goods” in this context refers to physical, not intellectual, items; and *Dastar* made no false representation with respect to the source of origin of the physical item.<sup>89</sup>

But the *Dastar* Court went beyond this textual analysis to address more fundamental issues at the copyright/trademark interface. The possibility, the Court noted, that a trademark-based interest might even exist as to the intellectual property (as opposed to the physical vehicle) was unlikely: “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 the product, or designed the product — and typically does not care whether it is. The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.”<sup>90</sup> This was also the view of some commentators before the time of the *Dastar* opinion. Gideon Parchomovsky and Peter Siegelman, for example, suggested in 2002 that there would be little need for a copyright owner to assert trademark rights in the same material because consumer interests would not be served thereby.<sup>91</sup> First, they contended that consumers of communicative products aren’t much concerned with source. Once material falls into the public domain, they argued, consumers will refuse to pay more for authentic goods.<sup>92</sup> Second, they asserted that consumers of copyrighted works are not repeat customers and so don’t have the need for consistent use of trademarks that consumers of tangible goods do.<sup>93</sup>

Both of these contentions, it seems to me, are misaligned with how consumers experience communicative goods. A film buff is almost certainly willing to pay more for

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<sup>88</sup>As the Court described:

We think the most natural understanding of the “origin” of “goods” — the source of wares — is the producer of the tangible product sold in the marketplace, in this case the physical Campaigns videotape sold by *Dastar*. . . . [A]s used in the Lanham Act, the phrase “origin of goods” is in our view incapable of connoting the person or entity that originated the ideas or communications that “goods” embody or contain. Such an extension would not only stretch the text, but it would be out of accord with the history and purpose of the Lanham Act and inconsistent with precedent.

*Id.* at 31–32.

<sup>89</sup>One commentator has suggested that the Court’s reading of the statute can be interpreted fairly narrowly given that it focused only on the word “origin” and not on the statute’s additional references to “sponsorship” or “approval.” Rick Mortensen, *D.I.Y. after Dastar: Protecting Creators’ Moral Rights Through Creative Lawyering, Individual Contracts and Collectively Bargained Agreements*, 8 VAND. J. ENT. & TECH. L. 335, 342 (2006).

<sup>90</sup>*Dastar*, 539 U.S. at 32–33.

<sup>91</sup>Gideon Parchomovsky and Peter Siegelman, *Towards an Integrated Theory of Intellectual Property*, 88 VA. L. REV. 1455, 1499–1500 (2002).

<sup>92</sup>*Id.* at 1499.

<sup>93</sup>*Id.*

a video of a film titled *M* if he can be sure that he is getting Fritz Lang’s 1931 classic and not the panned 1951 remake, and the reader who enjoys John Grisham novels and who wants to read more of them will almost certainly look for the “John Grisham” brand the next time she is at the bookstore.<sup>94</sup> (Indeed, Parchomovsky and Siegelman ultimately concede that because “most copyrighted goods are experience goods, the purchasing decisions of consumers will, to some extent, be influenced by past consumption of other products of the same brand.”<sup>95</sup>). Similarly, buyers of Fox’s and Dastar’s products<sup>96</sup> are very likely motivated not by the quality of the physical product when making purchasing decisions but by the quality of the creative product contained on the videotapes; it is for this reason that Fox’s claim, properly interpreted, concerned Dastar’s statement as to the source of origin for the intellectual property, whatever Fox’s real motivation for bringing suit. As I have mentioned elsewhere,<sup>97</sup> consumers of the *New York Times* or the *New York Post* do not view those titles as indicating a source or origin for the newsprint — the physical good on which the newspaper is printed — but rather use those titles as indications of the source of the intellectual property contained in those newspapers.

The *Dastar* Court acknowledged that communicative products might function differently in this way but ultimately concluded that to revise its conclusion as to the scope of the statutory meaning of the word “goods” in the Lanham Act (or, as the Court put it, to accord “special treatment” to communicative products<sup>98</sup>) would create a conflict with copyright law: “The right to copy, *and to copy without attribution*, once a copyright has expired, like ‘the right to make [an article whose patent has expired] — including the right to make it in precisely the shape it carried when patented — passes to the public.’”<sup>99</sup> Thus, the Court concluded, where the goals of trademark law (preventing confusion as the source among consumers) conflict with the goals of copyright law (granting the freedom to copy once material enters the public domain), trademark law must give way.

Although it never says so directly, the Court’s conclusion in this regard seems to proceed from a belief that, as between the two, copyright law enjoys a natural preeminence. But why this is the case is not entirely clear. The Court noted that copyright law and trademark law have different goals and are motivated by different concerns. Copyright law, as I have noted earlier, is designed to induce creators to create;

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<sup>94</sup> Laura A. Heymann, *The Birth of the Authonym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1416–17 (2005).

<sup>95</sup> Gideon Parchomovsky and Peter Siegelman, *Towards an Integrated Theory of Intellectual Property*, 88 VA. L. REV. 1455, 1500 (2002) (“For example, Blue Note, the famous jazz label, may rationally reduce the price of copyrighted recordings to entice jazz lovers to purchase the label’s other recordings.”).

<sup>96</sup> I use here the designation of the parties, fully aware that neither Fox nor Dastar, as corporate entities, were the actual creators of the material at issue.

<sup>97</sup> Laura A. Heymann, *The Birth of the Authonym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1440–41 (2005).

<sup>98</sup> *Dastar*, 539 U.S. at 33.

<sup>99</sup> *Id.* (quoting *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964)) (emphasis added). The emphasized phrase appears to be the Court’s addition in *Dastar*; it does not appear in the cases the Court cites for this principle. See *supra* text accompanying notes 36–51.

trademark law, by contrast, is designed to “reduce[ ] the customer’s costs of shopping and making purchasing decision” and to “help[ ] assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.”<sup>100</sup> But this difference in motivations does not suggest on its own that when the two are in conflict, copyright should prevail. Having apparently reached this conclusion, however, the Court easily moves to its remaining justifications. First, because, like patent law, copyright law embodies a “carefully crafted bargain” in which, once the monopoly granted the copyright holder expires, the public may use the work “at will and without attribution,”<sup>101</sup> limiting this right in any way through trademark law would be inappropriate. This can be true, however, only if one assumes that it is copyright law’s interests that must be preserved over trademark law’s interests, and not vice versa. Second, the Court noted, Congress created a limited attribution right in the form of the Visual Artists Rights of Act of 1990, which provides that the author of an artistic work shall, in very limited circumstances, “have the right . . . to claim authorship of that work.”<sup>102</sup> Having created only this limited attributional right in the copyright law scheme, the Court concluded, Congress couldn’t have intended the Lanham Act to provide additional attributional rights.<sup>103</sup> But this argument seems to ignore the historical point that the United States, upon acceding to the Berne Convention in 1988, asserted that it need not enact new legislation to comply with the Convention’s requirement that members provide authors with attribution rights. The U.S. took the position that existing federal laws, including the Lanham Act, already afforded authors such protections.<sup>104</sup>

Next, the Court turned to difficulties in implementation, noting, first, that even if “origin” in section 43(a) were applied with respect to communicative products, it would be difficult to determine to whom that definition should apply<sup>105</sup> and, second, that even if

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<sup>100</sup> *Id.* at 34 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 163–64 (1995)).

<sup>101</sup> *Id.* (internal quotation marks omitted). Again, it is unclear from where the Court derives its conclusion that the public domain encompasses not only the right to use the work but to do so without attribution. See Graeme W. Austin, *The Berne Convention as a Canon of Construction: Moral Rights After Dastar*, 61 N.Y.U. ANN. SURV. AM. L. 111, 126 (2005) (“[T]he premise that the public domain is good for the public does not lead inexorably to the conclusion that the public is also well served by misleading information about authorship being affixed to public domain material.”).

<sup>102</sup> 17 U.S.C. § 106A(a)(1)(A). The attributional right is limited to “works of visual art,” which must exist only in a single copy or in a “limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.” See *id.*; 17 U.S.C. § 101.

<sup>103</sup> *Id.* at 34–35 (“When Congress has wished to create such an addition to the law of copyright, it has done so with much more specificity than the Lanham Act’s ambiguous use of ‘origin.’ . . . Recognizing in §43(a) a cause of action for misrepresentation of authorship of noncopyrighted works (visual or otherwise) would render [VARA’s] limitations superfluous.”).

<sup>104</sup> Graeme W. Austin, *The Berne Convention as a Canon of Construction: Moral Rights After Dastar*, 61 N.Y.U. ANN. SURV. AM. L. 111, 112–17 (2005).

<sup>105</sup> *Id.* at 35–36 (“A video of the MGM film *Carmen Jones*, after its copyright has expired, would presumably require attribution not just to MGM, but to Oscar Hammerstein II (who wrote the musical on which the film was based), to Georges Bizet (who wrote the opera on which the musical was based), and to Prosper Merimée (who wrote the novel on which the opera was based).”)

this hurdle could be overcome, plaintiffs like Fox would resist application of the very remedy they ostensibly sought because, in the Court's view, they would not want any modifications of the work to be attributed to them and, indeed, might view such attribution as an equally false representation of authorization or sponsorship. These practical difficulties, while not insignificant, do not seem on their own to justify the Court's decision. Experience with situations such as orphan works<sup>106</sup> demonstrates that many areas of intellectual property law face hurdles in implementation relating to source identity issues, and there is no reason why the Lanham Act should stand alone in that regard.

Ultimately, the consideration that seems to most motivate the Court in *Dastar* is the idea that to recognize the application of trademark-type rights in areas where copyright may be the dominant form of protection leads to a "mutant" form of copyright law that impermissibly "limits the public's federal right to copy and to use expired copyrights"<sup>107</sup> by encroaching on the public domain. But, just as at the other intellectual property law interfaces, there would seem to be nothing that particularly distinguishes the public domain in copyright law such that trademark law has no place there.

### III. TRADEMARK AND THE PUBLIC DOMAIN

#### A. *The Public Domain*

The usual argument for why trademark law cannot have a place at the table post-copyright is because to permit such intrusion would be to restrict the public domain. In this vision, the public domain is seen as something of a sacred and wholly inviolate realm, a source of raw material for future creators that can be taken without restriction and without regard to any other legal regime. This view of the public domain is an attractive one and has much to commend it. Surely the world is a better place for *West Side Story* and the many other variations of *Romeo and Juliet* that have followed, all of

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. . . We do not think the Lanham Act requires this search for the source of the Nile and all its tributaries." Strangely, the Court seemed to think that this effort would be much easier when the work is copyrighted (as opposed to formerly copyrighted): "Without a copyrighted work as the basepoint, the word 'origin' has no discernable limits." *Id.* at 35. The Court does not indicate why the task of identifying the source becomes more difficult the moment a work falls out of copyright.

<sup>106</sup> The Copyright Office's report on its approach to orphan works (works still under copyright but for which the copyright holder cannot be located easily or at all) is available at <http://www.copyright.gov/orphan/orphan-report-full.pdf>. Of particular note is that the Copyright Office has proposed that so long as an accused infringer engaged in a "good-faith, reasonably diligent search" to locate the copyright holder and, "throughout the course of the infringement, provided attribution to the author and copyright owner of the work, if possible and as appropriate under the circumstances," the remedies for the infringement should be limited to reasonable compensation for the use of the work and/or injunctive relief. *Id.* at 127.

<sup>107</sup> *Dastar*, 538 U.S. at 34.

which could not have been created had Shakespeare's work not been in the public domain. And were we creating an intellectual property regime from whole cloth, we might want to affirmatively create a commons where users could be confident that material drawn from that sphere could be used wholly without restriction from any source, "as free as the air to common use."<sup>108</sup> But it's not at all clear that this is the intellectual property regime we now have.

Although the term admits of many definitions,<sup>109</sup> when courts and scholars talk about the "public domain" in copyright law, they typically describe it as consisting of two elements: speech that can never be subject to copyright law (such as facts or ideas),<sup>110</sup> and speech that was once subject to copyright law but for which the copyright term has expired.<sup>111</sup> The latter element is usually situated as part of the "copyright bargain" inherent in U.S. copyright law: The public is entitled to free use of material in the public domain because it granted rights to the creator during the copyright term.<sup>112</sup> The public domain, so described, constitutes consideration in a contract between the public and the creator, where the public's consideration (in the form of the federal statutory scheme) gives the creator certain legal rights over her creation that allow her to restrict the public's use of the work.

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<sup>108</sup> *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting); *see also, e.g.,* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999).

<sup>109</sup> The fuzziness of the term, despite the longevity of the concept, has been a subject of note to many commentators. *See, e.g.,* David Lange, *Reimagining the Public Domain*, 66 LAW & CONTEMP. PROBS. 463, 463 (2003) (calling the term "elastic and inexact"); Mark Rose, *Nine-Tenths of the Law: The English Copyright Debates and the Rhetoric of the Public Domain*, 66 LAW & CONTEMP. PROBS. 75, 85 (2003) ("The conclusion that one is forced to reach, then, is that in the early period in which modern copyright was forming in England, the legal discourse related to the public domain was feeble when compared to the strong arguments for authors' property rights.").

<sup>110</sup> *See, e.g.,* James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 LAW & CONTEMP. PROBS. 33, 39 (2003); *cf. Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1966) ("Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.").

<sup>111</sup> Some commentators would also include material that is currently subject to copyright but is free from copyright restrictions due to the particular use being made of the work (e.g., fair use under 17 U.S.C. § 107). *See, e.g.,* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 362 (1999).

<sup>112</sup> *See, e.g., Eldred v. Reno*, 537 U.S. 186, 214–215 (2003) (describing the bargain as exchanging the creation of the work for a monopoly lasting for the best available (i.e., constantly updated) term). In *Eldred*, the Court made an attempt to distinguish copyright law from patent law, stating that its references to a "*quid pro quo* typically appear in the patent context," *id.* at 216, but the attempt is rather a secondary argument. Thomas Nachbar has noted, however, that the construction of U.S. copyright law as a bargain may not be historically accurate. Thomas B. Nachbar, *Constructing Copyright's Mythology*, 6 GREEN BAG 37, 44 (2002) (noting that state copyright laws enacted contemporaneously with the Constitution mention authors' natural rights as much as the benefit to society as the justification for copyright protection).

How, then, should we describe the creator's consideration — the public domain? Most courts and commentators appear to conceptualize the creator's agreement as effecting an affirmative dedication of the material to the public.<sup>113</sup> The prevailing view of the public domain is that of a commons, where material is free for anyone to take and use without restriction.<sup>114</sup> Restrictions on material thought to be in the public domain are seen as restrictions on creativity: A creator who has some limitations on the "raw materials" he can use to create is thwarted in the creative process.<sup>115</sup> Thus, even the fair use rights that are built into the copyright statute can be seen as one aspect of the public domain in that they constitute a deliberately created realm in which copyright owners cannot assert copyright-based restrictions on use.<sup>116</sup>

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<sup>113</sup> See, e.g., Diane Leenheer Zimmerman, *Is There a Right to Have Something to Say? One View of the Public Domain*, 73 *FORDHAM L. REV.* 297, 356 (2004) (contending that the First Amendment generally requires a "mandatory speech commons"); David Lange, *Reimagining the Public Domain*, 66 *LAW & CONTEMP. PROBS.* 463, 474 (2003) (arguing for a consideration of the public domain as "a status independent and affirmatively recognized in law").

<sup>114</sup> See, e.g., Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 *N.Y.U. L. REV.* 354, 360 (1999) ("Information is 'in the public domain' to the extent that no person has a right to exclude anyone else from using the specified information in a particular way. In other words, information is in the public domain if all users are equally privileged to use it."); Jessica Litman, *The Public Domain*, 39 *EMORY L.J.* 965, 975 (1990) (describing the public domain as "a true commons comprising elements of intellectual property that are ineligible for private ownership" and that "may be mined by any member of the public"). The increase in communication and creation via the Internet has undoubtedly reinvigorated interest in a broad description in the public domain. See, e.g., Negativland, *Two Relationships to a Cultural Public Domain*, 66 *LAW & CONTEMP. PROBS.* 239, 249 (2003).

<sup>115</sup> Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 *YALE L.J.* 1533, 1570 (1993). But see, e.g., R. Polk Wagner, *Information Wants to Be Free: Intellectual Property and the Mythologies of Control*, 103 *COLUM. L. REV.* 995, 997 (2003) (challenging the claim that "control will reduce the availability of information in the public domain"); Marci A. Hamilton, *A Response to Professor Benkler*, 15 *BERKELEY TECH. L.J.* 605, 620 (2000) (noting that some enclosure of information is consistent with the concept of the public domain); Edward Samuels, *The Public Domain in Copyright Law*, 41 *J. COPYRIGHT SOC'Y U.S.A.* 137, 182 (1993) (rejecting the argument that the "public domain" is a useful concept and contending that copyright law "has within it the limiting doctrines that protect the public interest").

<sup>116</sup> See *supra* note 106; cf. James Boyle, *A Politics of Intellectual Property: Environmentalism for the Net*, 47 *DUKE L.J.* 87 (1997) ("[S]ince there is no 'natural' absolute intellectual property right, the doctrines which favor consumers and other users, such as fair use, are just as much a part of the basic right as the entitlement of the author to prevent certain kinds of copying."). Whereas Boyle appears to characterize fair use as an oppositional right of the user, Justin Hughes characterizes it as establishing the boundary of the author's right. See Justin Hughes, *Copyright and Incomplete Historiographies: Of Piracy, Propertization, and Thomas Jefferson*, 79 *S. CAL. L. REV.* 993, 1081 (2006) ("To put this in property parlance, section 107 fair use draws a border on the property rights granted under section 106. Everything on the fair use side is not just fair use, it is outside the property right.").

Under this view, the public domain contains, and is built on, an inherent “right to copy”<sup>117</sup> that precludes other forms of regulation (or, at the very least, other forms of intellectual property regulation).<sup>118</sup> But it’s not clear why this should be the choice over a conception that defines the public domain as simply a state of “not-copyright” — in other words, an area in which copyright law has no truck, but other areas of the law can bear on use of the material, if applicable.<sup>119</sup> Surely the public domain cannot be a state of pure lawlessness; as Yochai Benkler has suggested along similar lines, if an avant-garde New York theatre company decides to put on a production of *Romeo and Juliet* using loudspeakers in the middle of Fifth Avenue at rush hour, they may be subject to laws regulating the flow of traffic or nuisance, and they cannot use the fact that the work is the public domain as a defense.<sup>120</sup> Or, to take another example, one cannot pick up a copy of *Romeo and Juliet* from the local bookstore and walk out the front door without paying on the basis that the work is in the public domain and therefore free to the entire public.<sup>121</sup> One final example involves United Airlines, which currently uses George Gershwin’s *Rhapsody in Blue* as the theme music for its television commercials. If United continues

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<sup>117</sup> Cf. *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 658 (7th Cir. 1995) (“The right to copy is even more robust when the copied product was previously patented by the patent has expired. In that case, the original producer has reaped his reward of a 17-year monopoly and the public has already paid the congressionally mandated price for disclosure.”) (internal quotation marks omitted).

<sup>118</sup> See, e.g., Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 716 (1999) (“More strategically, treating the right to copy as independent of the functionality doctrine permits advocates of minimalist categorical protection to set up design trade dress protection as antagonistic to the purposes of trademark law, rather than reflected within the body of trademark law, and thus posti a hierarchy of intellectual property regimes.”).

<sup>119</sup> Language to this effect appears from time to time in judicial discourse, but it is unclear how deliberately it was intended. See, e.g., *Eldred v. Reno*, 537 U.S. 186, 247–48 (2003) (Breyer, J., dissenting) (describing copyright’s directive as both “creating incentive for authors to produce” and “removing the related restrictions on dissemination after expiration of a copyright’s ‘limited Time’”). In their discussion of “pliability rules” as applied to copyright, Abraham Bell and Gideon Parchomovsky initially appear to adopt this formulation of the copyright bargain but ultimately describe the public domain more broadly. Compare Abraham Bell & Gideon Parchomovsky, *Pliability Rules*, 101 MICH. L. REV. 1, 39 (2002) (describing copyright as a “zero order pliability rule” in which, upon expiration of the copyright term, “the initial entitlement owner loses the ability to exercise property rule protection . . . over her property”) with *id.* at 42 (describing the postcopyright term as a time when “anyone can use, reproduce, and market [the works] freely”).

<sup>120</sup> Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 362 (1999).

<sup>121</sup> Diane Leenheer Zimmerman characterizes this example as the producer’s recovering “the costs associated with the packaging of speech goods,” the charge being “not for the content but its embodiment on paper.” Diane Leenheer Zimmerman, *Is There a Right to Have Something to Say? One View of the Public Domain*, 73 FORDHAM L. REV. 297, 368 (2004). This characterization, which is, of course, entirely correct, illustrates that forms of propertization/monetization not concerned with copyright can coexist with the public domain.

to do so after the song enters the public domain,<sup>122</sup> it would seem logical that a new entrant into the airline services market could not create confusion in the marketplace as to the source of its services by using the song as its advertising theme music and yet successfully defend a suit by United on the ground that the song was now in the public domain and thus free from any legal restrictions on its use. Indeed, many types of creative endeavor free from copyright might be subject to other legal restrictions such as trade secret law or the right of publicity under current doctrine.<sup>123</sup> So the public domain doesn't quite mean free access to formerly copyrighted works; it means, I think, only that one cannot be sued for copyright infringement for making the kinds of use of the material that formerly belonged only to the copyright holder.<sup>124</sup> To be sure, this choice between two visions of the public domain has considerable implications for the resulting view of trademark-like law's (or any other law's) application in the space, as those who take the former view are likely to see even a slightly more robust application of trademark law's attribution function as taking away from the public something to which it was entitled.<sup>125</sup>

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<sup>122</sup> Given the current length of the copyright term, the song will likely not pass into the public domain until 2018, so this hypothetical is indeed such in that it assumes both that United Airlines will continue to use the same theme music in its advertising twelve years hence and that United Airlines will continue to exist twelve years hence. Of course, there are many other issues associated with United's "recoding" of the song, see Justin Hughes, "Recoding" *Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923, 960 (1999); see also Eldred, 537 U.S. at 249 (noting that "the \$500,000 that United Airlines has had to pay for the right to play George Gershwin's 1924 classic *Rhapsody in Blue* represents a cost of doing business, potentially reflected in the ticket prices of those who fly") (Breyer, J. dissenting), none of which I mean to discount by this discussion. My discussion here is intended only to reflect the current allocation of harms among the various intellectual property schemes and not to suggest that internal structure of each of those schemes (for example, the current length of the copyright term) is justified.

<sup>123</sup> See, e.g., Diane Leenheer Zimmerman, *Is There a Right to Have Something to Say? One View of the Public Domain*, 73 FORDHAM L. REV. 297, 318 (2004) (discussing "the number of times that the Court historically has approved direct or indirect commodification of speech goods using a vehicle other than copyright or patent law").

<sup>124</sup> In the debate over the Copyright Term Extension Act in 1998, the House's Committee Report used similar limiting language, albeit to the end of expanding copyright's hold over creative works. See H. REP. NO. 105-452 at § 5 (1998) ("Upon the expiration of the copyright term, the work falls into the public domain. This means that anyone may perform the work, display the work, make copies of the work, distribute copies of the work, and create derivative works based on the work without first having to get authorization from the copyright holder. Essentially, the copyright holder no longer has the exclusive ability to exploit the work to their financial gain and no longer 'owns' the work."); see also Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 DAYTON L. REV. 215, 231 n. 116 ("While these statements may sound neutral, they were part of Congress' justification for enacting term extension and delaying the entry of such works into the public domain. In other words, allowing works to enter the public domain was something to be condemned, or at least only grudgingly tolerated, rather than something to be celebrated.").

<sup>125</sup> See Viva R. Moffat, *Mutant Copyright and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L. J. 1473, 1517-18 (2004); Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 362-63 (1999). But see Diane Leenheer Zimmerman, *Is*

But this is true only if we conceive of the public domain as a limitless grant, free from any legal encumbrance. This is not the case in the public domain of patent; it is not clear why it should be any more true in copyright's public domain.

### B. Trademark Law as Circumvention

Another, albeit far more secondary, basis given for why trademark law should not be viable during the copyright term or during the term of the public domain is the concern that permitting such a cause of action would allow content owners to circumvent well-reasoned restrictions on the scope of trademark law. In *Dastar*, for example, the Court cited three cases — *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*,<sup>126</sup> in which the Court held that product design cannot be protected under the Lanham Act without a showing of secondary meaning; *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,<sup>127</sup> in which the Court rejected Florida's attempt to create a cause of action for unauthorized copying of unpatented boat hull molds, and *Traffix Devices, Inc. v. Marketing Displays, Inc.*,<sup>128</sup> in which the Court held that a maker of road signs whose patent on the sign had expired could not assert a Lanham Act claim against a competitor who copied the functional aspects of the sign design in making its own version of the sign when the patent expired — as cases whose results would have been eviscerated if the plaintiff could simply have asserted a reverse passing off claim of the type asserted in *Dastar*.<sup>129</sup> In the Court's view, each of these cases imposed a limitation on the reach of the Lanham Act necessary to maintain trademark law and patent law (in these cases) in separate spheres.

But to say that a plaintiff cannot simply rename his harm to avoid substantive limitations on the assertion of the right is one thing; to extend that principle to prohibit any related forms of protection is quite another. In the First Amendment context, for example, the Court's decision in *Hustler v. Falwell* tells us that a plaintiff cannot avoid the constitutional limitations on defamation actions simply by renaming the cause of

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*There a Right to Have Something to Say? One View of the Public Domain*, 73 *FORDHAM L. REV.* 297, 371 (2004) (noting that although material in the public domain should be free for all to use, trademark law can still provide "reasonable levels of protection" against consumer confusion). Zimmerman notes further: "[R]ecognition of trademarks as identifiers of the source of goods or services predates the Constitution, and it would be odd, in my view, to argue that a constitutional theory of the public domain precludes continued recognition of them, at least for such limited purposes as identifying the source or preventing consumer fraud." *Id.* at 371 n.309.

<sup>126</sup> 529 U.S. 205 (2000).

<sup>127</sup> 489 U.S. 141 (1989).

<sup>128</sup> 532 U.S. 23 (2001).

<sup>129</sup> *Dastar*, 539 U.S. at 36–37. See also, e.g., *Chosun Int'l Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 n.2 (2d Cir. 2005) (citing *Dastar* and *Traffix* as examples of the "general principle . . . that intellectual property owners should not be permitted to recategorize one form of intellectual property as another, thereby extending the duration of protection beyond that which Congress deemed appropriate for their actual creative efforts").

action as one for intentional infliction of emotional distress.<sup>130</sup> But in such instances, the harm alleged is identical in both instances: an injury to one's reputation caused by an act of speech by the defendant. The Court's decision requires plaintiffs in these circumstances to use the tort designed to address the harm alleged, along with its constitutional (or statutory) limitations.

The same is true in each of the cases the Court cites in *Dastar*. In *Samara Brothers*, the Court merely required the plaintiff to satisfy the requirements of the Lanham Act (i.e., a showing that the article alleged to be eligible for trademark protection actually serves to identify source). In *Bonito Boats*, the Court required statutory schemes designed to address the copying of designs — as opposed to source identification — to align with federal patent law. And in *TrafFix*, the Court held that a plaintiff could not use evidence of copying — again, the province of patent law — to prove a trademark law-based claim. In each instance, the Court was, consistent with cases like *Hustler*, requiring plaintiffs to bring their claims under the appropriate statutory scheme but certainly not barring them altogether.

It is curious, then, why the Court seems to have shifted course at the trademark/copyright interface in *Dastar*. Consistency with these prior decisions would not have required barring the plaintiff's Lanham Act claim altogether in the face of the public domain; rather, it would simply have required confirmation that the plaintiff was seeking to vindicate legally cognizable trademark law-based interests, rather than dressing up a copyright-based harm (unauthorized copying) in Lanham Act clothing. (Indeed, it is probably the case that the fact that Fox was almost certainly attempting to rescue a failed copyright claim contributed to the breadth of the Court's decision.) Rather than effecting an end-run around limitations in trademark law by bringing a Lanham Act suit in the copyright or public domain space, a content owner who does so is avoiding an end-run by correctly characterizing the tort at issue and thereby relinquishing the current advantage of the broad injunctive relief available for copyright infringement.<sup>131</sup>

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<sup>130</sup> See, e.g., *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 56 (1988); see also, e.g., See, e.g., Peter A. Jaszi, *Goodbye to All That — A Reluctant (and Perhaps Premature) Adieu to a Constitutionally Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT'L L. 595, 603–04 (1996) (contending that the public domain has a constitutional dimension).

<sup>131</sup> The same issue might be said to lie at the heart of the debate over whether content owners can use extra-copyright or extra-legal measures to achieve control over their creative products. See, e.g., *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996) (use of contract); Pamela Samuelson, *Why the Anti-Circumvention Regulations Need to Be Revised*, 14 BERKELEY TECH. L.J. 519 (1999). Here, too, the question should be (whether characterized as a preemption question or not) whether the goal of the content owner is to restrict the use of the work in the same way as does copyright law or whether the content owner is seeking to enforce a different, if related, right. Cf. *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 261–62 (1945) (Frankfurter, J., dissenting) (manufacturer should be bound by contract purporting to assign invalid patent (and thus could be sued for infringement of that patent) because “[t]he essence of the principle of fair dealing which binds the assignor of a patent in a suit by the assignee, even

Thus, it seems both doctrinally appropriate and possibly speech-promoting to restrict copyright owners' claims under copyright law to those claims at the core economic justification for copyright: the exploitation of the work *qua* work.<sup>132</sup> Claims relating to the message conveyed by the use of the work — that is, claims relating to implications of sponsorship or endorsement — are better addressed, if at all, by trademark law-based principles.

#### IV. ATTRIBUTIONAL GOALS AND COPYRIGHT MISUSE

##### A. *Copyright Misuse*

Once a claim is determined to fall outside the scope of copyright, the doctrine of copyright misuse can serve as a vehicle for barring further prosecution of the claim. Originally existing as an equitable doctrine only in patent law, the doctrine's viability in copyright law has since been well established, albeit not in every federal circuit.<sup>133</sup> In both intellectual property areas, the doctrine derives from the "unclean hands" doctrine used as an equitable backstop in many areas of the law. The justification is, generally, that a plaintiff who has taken the benefit of the public grant provided by the copyright and/or patent laws should exercise that power only in a responsible manner; concomitantly, he should not be allowed to enforce the limited monopoly in court when,

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though it turns out that the patent is invalid or lacks novelty, is that in this relation the assignor is not part of the general public but is apart from the general public").

<sup>132</sup> Wendy J. Gordon, *Render Copyright Unto Caesar: On Taking Incentives Seriously*, 71 U. CHICAGO L. REV. 75, 81 (2004) ("A focus on harm to the plaintiff's expected plans is . . . central to the standard economic justification of copyright."); *id.* at 88–89 (noting that copyright law currently gives authors "control over how their work is used" through the availability of injunctions, "which is problematic because injunctions are precisely what cause the most extreme free speech difficulties.").

<sup>133</sup> The doctrine has been recognized by courts in almost every circuit (some expressly, some more hypothetically). *See, e.g.*, Chamberlain Group, Inc. v. Skylink Techs., Inc., 391 F.3d 1178, 1201 (Fed. Cir. 2004); Video Pipeline, Inc. v. Buena Vista Home Enter., Inc., 342 F.3d 191, 204–06 (3d Cir. 2003); Assessment Techs. of WI, LLC v. WIREdata, Inc. 350 F.3d 640, 647 (7th Cir. 2003); Alcatel USA, Inc. v. DGI Techs., Inc., 166 F.3d 772, 793 (5th Cir. 1999); Practice Mgmt Info. Corp. v. Am. Med. Ass'n, 121 F.3d 516 520 (9th Cir. 1997); Lasercomb America, Inc. v. Reynolds, 911 F.2d 970, 973–77 (4th Cir. 1990); United Tel. Co. of Mo. v. Johnson Publ'g Co., Inc., 855 F.2d 604, 610–12 (8th Cir. 1988); Shady Records, Inc. v. Source Enters., Inc., No. 03 CIV 9944 (GEL), 2004 U.S. Dist. LEXIS 26143, at \*50 (S.D.N.Y. Jan. 3, 2005); Ass'n of Amer. Med. Colleges v. Princeton Review, Inc., 332 F. Supp. 2d 11, 17–20 (D.D.C. 2004); *In re Ind. Serv. Orgs. Antitrust Litig.*, 114 F. Supp. 2d 1070, 113–14 (D. Kans. 2000). The First, Sixth, and Eleventh Circuits remain more equivocal. *See Garcia-Goyco v. Law Environmental Consultants, Inc.*, 428 F.3d 14, 21 n.7 (1st Cir. 2005); *Telecom Tech. Servs. Inc. v. Rolm Co.*, 388 F.3d 820, 831 (11th Cir. 2004); *Microsoft Corp. v. Compusource Distribs., Inc.*, 115 F. Supp. 2d 800, 810 (E.D. Mich. 2000).

as against the defendant in the case or as against other entities, he has overreached in exercising those rights.<sup>134</sup>

The misuse doctrine in copyright law largely parallels its progenitor in patent law. The case typically identified as the landmark patent misuse doctrine is *Morton Salt Co. v. G.S. Suppiger Co.*,<sup>135</sup> in which the Court held that the holder of a patent on a salt-depositing machine could not assert its patent against an alleged infringer where the patent holder had required licensees to use its machine only in conjunction with the patent holder's (unpatented) salt tablets. Equitable considerations should bar the patent infringement suit, the Court held, because the patent monopoly is granted as a "special privilege" that includes as an unstated term the obligation to assert that privilege only consistent with public policy — specifically, the exclusion from the patent grant of anything not included with the patented invention.<sup>136</sup> Thus, a patentee who is using its monopoly in the patented article to acquire a monopoly in an unpatented article should be forbidden from enforcing its patent at all until the misuse ends, even against a defendant who is not competing in the unpatented good.<sup>137</sup>

Courts that have adopted the misuse doctrine in copyright infringement suits take much the same attitude as the Court in *Morton Salt*: that a copyright holder who attempts, through the licensing of the copyrighted article, to obtain monopoly-like power over items outside the scope of the copyright should be barred from enforcing the copyright at all until the misuse ceases. Thus, as in the patent misuse cases, the equitable defense of copyright misuse allows defendants to eliminate consideration of the infringement issue (and, relatedly, any considerations of whether the statutory fair use defense applies) by focusing on the copyright holder's inequitable conduct rather than on the particulars of the defendant's use of the content at issue. And as with its patent law counterpart, the typical copyright misuse case involves a content owner's use of licensing restrictions to achieve either a longer term of protection than available under statute or a limitation on permissible uses by the licensee that conflict with what would otherwise be available to the licensee pursuant to statute (e.g., an agreement not to engage in certain

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<sup>134</sup> Greater attention has been paid by scholars to copyright misuse in recent years. See, e.g., Brett Frischmann & Daniel Moylan, *The Evolving Doctrine of Copyright Misuse*, in *INTELLECTUAL PROPERTY AND INFORMATION WEALTH* (Peter Yu, ed. forthcoming 2007), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=914535](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=914535); Lydia Pallas Loren, *Slaying the Leather-Winged Demons in the Night: Reforming Copyright Owner Contracting with Clickwrap Misuse*, 30 OHIO N. UNIV. L. REV. 495 (2004); Dan Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095 (2003).

<sup>135</sup> 314 U.S. 488 (1942).

<sup>136</sup> *Id.* at 492.

<sup>137</sup> *Id.* at 493 ("Maintenance and enlargement of the attempted monopoly of the unpatented article are dependent to some extent upon persuading the public of the validity of the patent, which the infringement suit is intended to establish."); see also *Dawson Chemical Co. v. Rohm & Hass Co.* 448 U.S. 176, 193 (1980) (noting that the *Morton Salt* Court "explicitly linked the doctrine of patent misuse to the 'unclean hands' doctrine traditionally applied by courts of equity"). A patentee may acquire a monopoly over an unpatented article sold by another entity where the unpatented article has no commercial noninfringing use and therefore its sale constitutes contributory infringement. See 37 U.S.C. § 271(c); *Dawson Chemical*, *supra*.

fair uses or to develop the idea underlying the copyright).<sup>138</sup> Finally, again as in the patent cases, a finding of misuse is not the death knell for a copyright plaintiff; it simply bars the plaintiff from seeking relief until the misuse is ameliorated.<sup>139</sup>

While the doctrine has often been used at the copyright/antitrust interface or to deter similarly uncompetitive activity, courts have not found that it need be so restricted,<sup>140</sup> and commentators have proposed various other applications for the doctrine in the copyright context, including at the copyright/patent interface<sup>141</sup> and within the field of anticircumvention rights (or “paracopyright”).<sup>142</sup> In particular, courts and commentators have noted that an appropriate application of the doctrine is with respect to assertions of copyright infringement that extend beyond the nature of the grant to the copyright holder or, more broadly, conflict with the policy underlying the Copyright and Patent Clause of the Constitution.<sup>143</sup> These policies, properly described, should include not only the built-in constitutional limitations now known as the idea/expression dichotomy and the statutory fair use provisions, but also the rights at the very nature of the copyright grant that divide the realm of copyright law from the realm of trademark

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<sup>138</sup> Robert P. Merges, *The End of Friction? Property Rights and Contract in the “Newtonian” World of On-Line Commerce*, 12 BERKELEY TECH. L.J. 115, 124 (1997).

<sup>139</sup> Brett Frischmann & Dan Moylan, *The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and Its Application to Software*, 15 BERKELEY TECH. L.J. 865, 867 (2000).

<sup>140</sup> *Video Pipeline, Inc. v. Buena Vista Home Enter., Inc.*, 342 F.3d 191, 205 (3d Cir. 2003); *Assessment Techs. of WI, LLC v. WIREdata, Inc.* 350 F.3d 640, 647 (7th Cir. 2003); *Lasercomb America, Inc. v. Reynolds*, 911 F.2d 970, 978 (4th Cir. 1990).

<sup>141</sup> See Brett Frischmann & Dan Moylan, *The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and Its Application to Software*, 15 BERKELEY TECH. L.J. 865, 920–21 (2000) (regarding software).

<sup>142</sup> See Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095, 1132–40 (2003) (regarding anticircumvention or “paracopyright” rights). Other proposals include using the copyright misuse doctrine to force disclosure of copyrighted works, see Ralph D. Clifford, *Simultaneous Copyright and Trade Secret Claims: Can the Copyright Misuse Defense Prevent Constitutional Doublethink?*, 104 DICK. L. REV. 247, 287 (2000), or to encourage copyright owners to change their contracting behavior to avoid overreaching provisions more generally, see Lydia Pallas Loren, *Slaying the Leather-Winged Demons in the Night: Reforming Copyright Owner Contracting with Clickwrap Misuse*, 30 OHIO N. UNIV. L. REV. 495 (2004).

<sup>143</sup> See, e.g., *Video Pipeline, Inc. v. Buena Vista Home Enter., Inc.*, 342 F.3d 191, 205–06 (3d Cir. 2003) (doctrine potentially appropriate where copyright holder uses infringement suite “to restrict expression that is critical of it”) (dicta); *Assessment Techs. of WI, LLC v. WIREdata, Inc.* 350 F.3d 640, 647 (7th Cir. 2003) (doctrine appropriate where plaintiff uses copyright infringement suit to obtain property protection (e.g., in data) “that copyright law clearly does not confer”); Lydia Pallas Loren, *Slaying the Leather-Winged Demons in the Night: Reforming Copyright Owner Contracting with Clickwrap Misuse*, 30 OHIO N. UNIV. L. REV. 495 (2004); Kathryn Judge, Note, *Rethinking Copyright Misuse*, 57 STAN. L. REV. 901, 904 (2004); Ralph D. Clifford, *Simultaneous Copyright and Trade Secret Claims: Can the Copyright Misuse Defense Prevent Constitutional Doublethink?*, 104 DICK. L. REV. 247, 258 (2000); David Scher, Note, *The Viability of the Copyright Misuse Defense*, 20 FORDHAM URB. L.J. 89, 101 (1993); Note, *Clarifying the Copyright Misuse Defense: The Role of Antitrust Standards and First Amendment Values*, 104 HARV. L. REV. 1289, 1304–07 (1991).

law. Indeed, using the doctrine of copyright misuse to police the trademark/copyright divide mirrors the application of the doctrine at other intellectual property interfaces. As Brett Frischmann and Daniel Moylan have noted, courts have used the doctrine to serve a “coordination function” that mediates between related bodies of intellectual property–related law<sup>144</sup>; more particularly, Dan Burk has suggested that the misuse doctrine has historically been important to “curtail the forays of rights holders beyond the uses intended for those rights.”<sup>145</sup>

Elements of this particular application of the copyright misuse doctrine can be seen lurking in the existing case law, although not at the forefront. For example, in *Rosemont Enterprises, Inc. v. Random House, Inc.*,<sup>146</sup> a 1966 case in the Second Circuit, Chief Judge Lumbard contended (in a concurrence joined by a majority of the panel) that the famous aviator and businessman Howard Hughes should not have been allowed to use a recently acquired copyright in a series of magazine articles about him to thwart publication of a forthcoming biography allegedly based on those articles. Hughes was not using his copyright in the articles to attempt to engage in selective or abusive licensing, nor was he attempting to enjoin a competing distribution of the articles; rather, he was quite clearly using the copyright to restrain publication of the biography altogether. Accordingly, Judge Lumbard concluded, Hughes was asserting what may well have been a valid copyright but was doing so to vindicate rights outside those of the copyright grant:

It has never been the purpose of the copyright laws to restrict the dissemination of information about persons in the public eye even though

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<sup>144</sup> See, e.g., Brett Frischmann & Daniel Moylan, *The Evolving Doctrine of Copyright Misuse*, in INTELLECTUAL PROPERTY AND INFORMATION WEALTH (Peter Yu, ed. 2007), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=914535](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=914535) (noting that courts have used the copyright misuse doctrine “to reinforce subject matter limitations and channeling doctrines that maintain boundaries”); Brett Frischmann & Dan Moylan, *The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and Its Application to Software*, 15 BERKELEY TECH. L.J. 865, 875 (2000). Relatedly, Dan Burk has articulated an additional function for misuse: “preserving the courts from the reputational damage of enforcing legal claims that might be technically legitimate but which would lead to socially perverse outcomes.” Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095, 1123 (2003).

<sup>145</sup> Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095, 1133 (2003); see also *id.* (“The consistent theme of misuse cases is refusal to reward private extension of intellectual property rights contrary to public policy; not simply to ward off antitrust violations, or even to prevent economically anticompetitive activity.”); see also William F. Patry & Richard A. Posner, *Fair Use and Statutory Reform in the Wake of Eldred*, 92 CALIF. L. REV. 1639, 1658 (2004) (terming copyright misuse doctrine acceptable “where litigation is threatened in an effort to extract a licensing fee or other profit when there is no reasonable basis for supposing that the threatener’s copyright has been infringed”); cf. Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. REV. 1026, 1047 (2006) (contending that fraudulent use of copyright occurs when copyright owners attempt to prohibit fair use); *Ty, Inc. v. Publ’ns Int’l*, 292 F.3d 512, 520 (7th Cir. 2002) (noting that the court “need not consider” whether license term controlling speech of licensee constitutes copyright misuse).

<sup>146</sup> 366 F.2d 303 (2d Cir. 1966).

those concerned may not welcome the resulting publicity. . . . [T]he courts should not tolerate any attempted interference with the public's right to be informed regarding matters of general interest when anyone seeks to use the copyright statute which was designed to protect interests of quite a different nature. . . . Here, Rosemont Enterprises acquired the Look copyright and sued upon it six days later asking injunctive relief, not with a desire to protect the value of the original writing but to suppress the Random House biography because Hughes wished to prevent its publication.<sup>147</sup>

Similarly, I am proposing here that greater attention be paid when content owners seek to use copyright law to protect interests “of quite a different nature” from the profit-motivated rights in the work it was designed to protect and an alignment of copyright infringement actions with those economic interests, leaving other interests in communicative goods to other statutory schemes.

The proposal here envisions a slightly different role for the doctrine than the one it has played in the past and one more aligned with the role that Dan Burk has proposed in the field of anticircumvention.<sup>148</sup> Traditionally, even when it is used to curb activity apart from pure anticompetitive actions, the doctrine appears in cases in which the plaintiff is using the vehicle of the license for its copyrighted goods (for which it enjoys a monopoly during the copyright term) to exact from the licensee other commitments to which copyright law does not apply and, indeed, perhaps even affirmatively disowns (the free use of factual data, for example).<sup>149</sup> Here, however, I am proposing that a finding of copyright misuse derive not from the content owner's attempt to control extracopyright material through the use of a license for copyrighted material but rather from the content owner's attempt to control rights outside the scope of those granted under copyright through the use of a copyright infringement suit.<sup>150</sup> To be clear, then, a finding of misuse in this context is not an attempt to punish the content owner for exercising its right to

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<sup>147</sup> *Id.* at 311, 313 (Lumbard, C.J., concurring).

<sup>148</sup> See Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095 (2003).

<sup>149</sup> But not always. See, e.g., *Vogue Ring Creations, Inc. v. Hardman*, 410 F. Supp. 609 (D.R.I. 1976) (noting, in dicta, that had the plaintiff's copyright been otherwise valid, the court would have declined to enforce it due to the plaintiff's conduct, including publishing a misleading “copyright warning”).

<sup>150</sup> For similar suggestions, see, e.g., Justin Hughes, *Copyright and Incomplete Historiographies: Of Piracy, Propertization, and Thomas Jefferson*, 79 S. CAL. L. REV. 993, 1082 (2006) (“We need more courts to adopt the reasoning of *Online Policy Group v. Diebold*, [337 F. Supp. 2d 1195 (N.D. Cal. 2004)]: sometimes a copyright claim . . . is so obviously outside the borders of the copyright owner's rights, the action constitutes an abuse of process.”); JuNelle Harris, *Beyond Fair Use: Expanding Copyright Misuse to Protect Digital Free Speech*, 13 TEX. INTELL. PROP. L.J. 83, 114 (2004) (proposing doctrine of “public policy copyright misuse” based in part on argument that “copyright should not be used to vindicate economic interests unrelated to the marketability of the protected work itself”). The court in *Diebold* held that the corporate plaintiff had no copyright interest in internal e-mails posted to a publicly available website because it did not intend to exploit the e-mails in the marketplace. *Diebold*, 337 F. Supp. 2d at 1203.

protect its copyright by deeming such exercise anticompetitive;<sup>151</sup> indeed, the content owner in this scenario retains all rights to bring such a suit, so long as it does so to vindicate copyright-based interests and not trademark-based ones.

It would, of course, be possible to approximate the goal of this proposal not by turning to trademark law-type concepts but instead by reforming copyright law, and other commentators have suggested such proposals, focusing on the fair use provision.<sup>152</sup> I believe, however, that using the existing Lanham Act is preferable for two reasons. First, as a practical matter, the application of the copyright misuse doctrine can be accomplished judicially within the existing statutory framework, providing both the necessary flexibility and a more immediate solution. (It is probably safe to say that in the current legislative climate, reforms to the fair use provision of the U.S. copyright statutory scheme will be difficult, if not impossible, to achieve.) Second, an amendment to the fair use provision will likely not provide the reassurance that subsequent creators need because its application depends on a preliminary finding of infringement; whether the defendant will enjoy a safe harbor then depends on the whim of the court. By contrast, the copyright misuse doctrine engages in this inquiry by focusing on the plaintiff's conduct;<sup>153</sup> moreover, under this proposal, it does not foreclose a remedy entirely but rather requires the content owner to seek relief under a more appropriate legal regime.

#### B. *Locating the Attributional Interest*

As I have discussed, copyright law, traditionally explained, is aimed at providing the creator an incentive to create by reserving to her for a limited time the right to exploit the work financially — to control the number of copies, the way in which the work is distributed, and whether or not the work is displayed or performed. But for many creators, particularly individual creators, the profit motivation is not paramount. Rather, the creator is motivated most by the public knowledge that she is the creator — by attribution of the work to her. Indeed, as others have noted, such creators value wide

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<sup>151</sup> Thus, this is not the type of situation that is prohibited under patent law by statute, *see* 35 U.S.C. § 271(d)(3), or generally by *Noerr* immunity, *see* *Prof'l Real Estate Investors, Inc. v. Columbia Pictures Indus., Inc.*, 508 U.S. 49, 56 (1993). *Cf.* Aaron Xavier Fellmeth, *Copyright Misuse and the Limits of the Intellectual Property Monopoly*, 6 J. INTELL. PROP. L. 1, 29 (1998).

<sup>152</sup> *See, e.g.*, Greg Lastowka, *Digital Attribution: Copyright and the Right to Credit*, at 41–46, [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=917396](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=917396) (proposing that the fair use factors of 17 U.S.C. § 107 be amended to include consideration of whether the alleged infringer has provided attribution to the author of the work); Alex Kozinski & Christopher Newman, *What's So Fair About Fair Use?*, 46 J. COPYRIGHT SOC'Y U.S.A. 513, 525–26 (1999) (proposing an elimination of Section 107's fair use provisions for derivative works and generally limiting relief to actual damages plus profits attributable to the infringement, except damages attributable to criticism of the copyrighted work).

<sup>153</sup> Note, *Clarifying the Copyright Misuse Defense: The Role of Antitrust Standards and First Amendment Values*, 104 HARV. L. REV. 1289, 1306 (1991) (“Unlike misuse doctrine, however, the fair use inquiry directs courts’ attention to the social value of the defendant’s conduct rather than the social harm caused by the plaintiff’s use of its copyright.”).

dissemination of their work over compensation and so benefit by the fair use doctrine and, even, the movement of their work to the public domain, both of which ensure that their work reaches as many audience members as possible.<sup>154</sup> Although this can probably be supported only anecdotally and not empirically, it seems safe to conclude that the two things that virtually all creators desire is to receive credit when it is appropriate and to eliminate the suggestion of association when it is not.<sup>155</sup>

Despite the personal benefits that accrue from attribution, the stronger value in its recognition comes not from moral or natural rights but rather, as with trademarks, its value to the consumer.<sup>156</sup> Consumers of communicative goods, as I described earlier,

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<sup>154</sup> See, e.g., Catherine L. Fisk, *Credit Where It's Due: The Law and Norms of Attribution*, Duke Law School Working Paper Series 39, available at <<http://sr.nellco.org/duke/fs/papers/39>>, at 1–2 (“Credit matters in an information economy because it is difficult to measure worker knowledge directly in the way that the ability of typists and machinists can be tested simply by watching them perform a task.”); Linda J. Lacey, *Of Bread and Roses and Copyrights*, 1989 Duke L.J. 1532, 1581. Of course, the conclusion that many creators are not motivated by economic incentive, particularly in the academic context, is a bit solipsistic, and others have sounded a cautionary note in this regard. See, e.g., John Shepard Wiley, Jr., *Copyright at the School of Patent*, 58 U. CHI. L. REV. 119, 149 (1991) (“The case of the driven genius immune to financial incentives seems too speculative to treat it as the norm for creation of works of authorship. A safe stance is to assume that creators are generally interested in cash and responds to its lure, perhaps leaving the door open for a contrary showing in the unusual case.”).

<sup>155</sup> One datapoint in this regard comes from Anupam Chander and Madhavi Sunder, who have described how almost all authors releasing works pursuant to the Creative Commons license — including the ones who have little or no copyright-based restrictions on distribution of their work — continue to require attribution as a condition of use. Anupam Chander & Madhavi Sunder, *The Romance of the Public Domain*, 92 CALIF. L. REV. 1331, 1361 (2004). The Copyright Office took note of this statistic in proposing that the limited remedies for infringement of orphan works depend, in part, on the infringer’s having attributed the infringed work. See <http://www.copyright.gov/orphan/orphan-report-full.pdf>, at 110–11. For a discussion of the evolution of Creative Commons, in particular, its move to making attribution a default element of every license, see Greg Lastowka, *Digital Attribution: Copyright and the Right to Credit*, at 35–38, [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=917396](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=917396).

<sup>156</sup> I have discussed the trademark-like aspects of authorship in Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377 (2005). Many commentators, however, justify attributional rights in terms of its intrinsic and/or spiritual value to the creator rather than for its benefits to the consumer. See, e.g., Roberta Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. (forthcoming 2006) (asserting that attribution rights are protected under a moral rights regime “as integral components of a work’s message as conceived by the original author as a result of her endowed creative gift”); Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundation of the Public Domain*, 66 LAW & CONTEMP. PROBS. 173, 193 (2003) (noting that a Hegelian view of intellectual property sees attribution as having to do with “the sense that the value of the thing as an expression of self is in its being an expression of a particular self — its author — and not a fungible expression of human creativity as a general category”). Not all attribution proposals are derived from intellectual property rights, however. See, e.g., Catherine L. Fisk, *Credit Where It's Due: The Law and Norms of Attribution*, Duke Law

have an interest in sorting mechanisms for communicative goods that are free from intentional disruption to the extent possible, and creators seek attributional signals for their work (or disclaimers of nonattribution) most likely not primarily out of personal fulfillment but rather so that their audiences will receive those signals. (Shouting one’s name into the wind is small satisfaction.) Courts (at least pre-*Dastar*) justified locating attributional rights in the Lanham Act on this basis.<sup>157</sup>

This is not to say, however, that a creator obtains a legally cognizable attributional right the moment a work is created. In order to make possible the claim that the defendant is causing confusion as to the “sponsorship or approval”<sup>158</sup> of his goods or services by the plaintiff, the plaintiff’s work (as used in the defendant’s work) must be recognizable as that of the plaintiff. It may well be true — and this is a positive attribute — that few creators will be able to state such a case. Thus, it is possible that, at the threshold, Lionel Richie’s estate has a legally cognizable claim that “Endless Love” satisfies this requirement (although it may ultimately fail to satisfy the requirement that viewers of the Bush/Blair video will believe that Richie sponsored or approved the video); Art Rogers’s case is significantly weaker.<sup>159</sup> The move to trademark law-based principles thus is both doctrinally more coherent and, I think, ultimately speech-enhancing.

Thus, locating attribution as an economic interest of consumers rather than as an economic right of authors — the divide between trademark-type interests and copyright interests — ultimately benefits subsequent creators. As discussed earlier, a copyright infringer will often (although not always) be enjoined from making use of the work at all, assuming that he is not fortunate enough to be graced with a favorable finding from the court as to fair use.<sup>160</sup> But using trademark law as a model yields the possibility of a

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School Working Paper Series 39, available at <http://lsr.nellco.org/duke/fs/papers/39> (proposing that a right of attribution be regarded as an implied term of every employment contract).

<sup>157</sup> See, e.g., *Simon & Schuster, Inc v. Dove Audio, Inc.*, 970 F. Supp. 279 (S.D.N.Y. 1997) (book title); *Warner Bros. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934) (movie title). Cf. *Cyrill P. Rigamonti, Deconstructing Moral Rights*, 47 HARV. INT’L LAW J. 354, 360 (2006) (noting that “moral rights law is considered an integral part of copyright law” because “moral rights are rights in *copyrightable works* similar in structure to economic right”) (emphasis in original).

<sup>158</sup> 15 U.S.C. § 1125(a)(1)(A).

<sup>159</sup> Cf. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 60 (2d Cir. 2001) (noting in dicta that district court correctly dismissed singer’s false implied endorsement claim based on use of song in commercial on the ground that no reasonable jury could have found an implied endorsement); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1107 (9th Cir. 1992) (affirming judgment for singer on false implied endorsement claim for use of imitation of distinctive voice in commercial). The kinds of cases I am addressing in this Article, which seem to have false endorsement, if anything, at their core (and not misappropriation theories), are thus not appropriate candidates for a right of publicity claim. See ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS, AND TRADEMARKS* 266 (2003) (describing the difference).

<sup>160</sup> See, e.g., *ROBERT A. GORMAN & JANE C. GINSBURG, COPYRIGHT* 909–12 (7th ed. 2006) (discussing the circumstances under which injunctions are issued pursuant to 17 U.S.C. § 502); see also *eBay Inc. v. MercExchange, LLC*, 126 S. Ct. 1837, 1840 (2006) (noting that equitable considerations apply); *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 505 (2001) (noting that injunctions

remedy better tailored to the harm: an injunction that allows the defendant to continue to use the work at issue but requires her to address likely consumer confusion as to the sponsorship or authorization of the later work by the author of the former work.<sup>161</sup>

Taking these points together, then, leads to my proposal: The trademark/copyright interface should be treated no differently from other intellectual property interfaces, such that claims asserting harm relating to the interest in exploiting the work itself should be addressed by copyright law, and claims asserting harm relating to the way the source of the work is presented to consumers should be addressed by trademark law-based schemes. Neither claim is duplicative of the other, and both claims

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need not always issue in copyright infringement cases). *See generally* James Thompson, Note, *Permanent Injunctions in Copyright Infringement: Moral and Economic Justifications for Balancing Individual Rights Instead of Following Harsh Rules*, 7 S. CAL. INTERDIS. L.J. 477 (1998); James L. Oakes, *Copyrights and Copyremedies: Unfair Use and Injunctions*, 18 HOFSTRA L. REV. 983 (1990).

<sup>161</sup> The injunction may therefore require the provision of a disclaimer. I acknowledge, however, that the effectiveness of disclaimers is still a matter of debate. *See, e.g.*, *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1144 (3d Cir. 1986) (“[W]here it is not feasible in practice to avoid the potential for confusion through the selection of alternative non-functional elements or the manner in which one combines imitated functional ones, the most that can be required is clear labeling disclosing source or other reasonable steps to minimize the risk of confusion.”); *Consumers Union of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1053 (2d Cir. 1983) (“Disclaimers are a favored way of alleviating consumer confusion as to source or sponsorship. Absolute prohibitions of speech . . . are improper where there is any possibility that an explanation or disclaimer will suffice. . . . The First Amendment demands use of a disclaimer where there is a reasonable possibility that it will suffice to alleviate consumer confusion.”); *Warner Bros. v. Majestic Pictures Corp.*, 70 F.2d 310, 312–13 (2d Cir. 1934) (enjoining distribution of film without disclaimer disassociating plaintiff); *King v. Innovation Books*, 976 F.2d 824 (2d Cir. 1992) (“based on” disclaimer); *Hospital for Sick Children v. Melody Fare Dinner Theatre*, 516 F. Supp. 67, 73 (E.D. Va. 1980) (“based on” or “derived from” disclaimer); *Matrix Essential, Inc. v. Emporium Drug Mart, Inc.*, 756 F. Supp. 280, 282 (D. La. 1991) (“not affiliated” disclaimer); *Soltex Polymer Corp. v. Fortex Indus., Inc.*, 832 F.2d 1325, 1330 (2d Cir. 1987) (“[W]here, as here, the likelihood of consumer confusion is far less than substantial, we believe that it is within the district court’s discretion to grant disclaimer relief.”); Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2182–83 (2004) (proposing use of disclaimers in merchandising cases); Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 728 (1999) (supporting “limited ‘regulatory’ relief (such as confusion-minimizing labeling of defendant’s similar products or corrective advertising by the defendant) being accorded the owner of a distinctive trade dress that is found to be functional”); Robert C. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C. L. REV. 603, 613–14 (1984) (discussing qualified injunctions); *cf. e.g.*, Jacob Jacoby & Robert Lloyd Raskopf, *Disclaimers in Trademark Infringement Litigation: More Trouble Than They Are Worth?*, 76 TRADEMARK REP. 35, 40 (1986) (contending that disclaimers are generally ineffective); Mitchell E. Radin, *Disclaimers as a Remedy for Trademark Infringement: Inadequacies and Alternatives*, 76 TRADEMARK REP. 59, 61 (1986) (same). Prof. Radin suggests, moreover, that a disclaimer might work more harm to the plaintiff by linking her name and the defendant’s name in the consumer’s mind. Radin, *supra*, at 64.

operate independently, such that the availability of a claim under copyright law (i.e., whether the work is under copyright or not, or whether the defendant's incorporation of the work qualifies as fair use) has no bearing on whether a claim is available under trademark law principles.

Having reached this equilibrium, intellectual property law should therefore no longer countenance a content owner's use of copyright law to assert trademark law-based interests. Indeed, where a content owner attempts to take advantage of the broad remedies available under copyright law to restrain uses of his material that do not consist of economic exploitations of the work but instead suggest an affiliation or association with the content owner, courts should consider that attempt an instance of copyright misuse.

I don't pretend, in proffering this suggestion, that the law of unfair competition always maps easily onto communicative products. Consumers may not always think of content creators as "sources" in the traditional, trademark-like sense, and even where this understanding exists, it may be difficult to establish the same "brand equals source" dynamic as exist in the usual goods/services context such that the typical likelihood-of-confusion analysis can be conducted. As commentators have noted, consumers' understanding of whether the use of a name on a communicative good reflects a suggestion of sponsorship or other approval may be something of a feedback loop: consumers will have this understanding if the courts tell them this is what they are to expect, while courts will reach this conclusion if they perceive consumers to have this understanding.<sup>162</sup> In the end, this may mean simply that the point of equilibrium between confusion and lack thereof may shift in tandem with the law and/or consumer perceptions. I don't think, however, that the idea that attribution of source in communicative goods will cease to have relevance for consumers altogether.

## V. CONCLUSION

Intellectual property scholars who are somewhat hesitant to recognize more robust attribution rights via trademark law are, I think, concerned — and correctly so — that such recognition will change the current landscape of the public domain. If Disney is permitted to exercise trademark rights over Mickey Mouse after its copyright in the character expires, then the public will be deprived of some uses of that material, uses to which it thought it was entitled.<sup>163</sup> But the harm is fairly minimal: Disney can exercise these trademark rights only if indeed it can show a likelihood of confusion through the

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<sup>162</sup> See, e.g., Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 485–89 (2005); Jacob Jacoby, *Sense and Nonsense in Measuring Sponsorship Confusion*, 24 CARDOZO ARTS & ENT. L.J. 63, 85 (2006).

<sup>163</sup> See Viva R. Moffat, *Mutant Copyright and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L. J. 1473, 1507–08 (2004).

defendant's use. Parodies, satires, and the like are presumably not candidates for a successful suit, since such uses almost certainly depend on the consumer's recognition that the original author is *not* the source<sup>164</sup>; fan fiction and similar endeavors may also fall into the same category, depending on how the market understands such pursuits. But if the appearance of a Mickey Mouse statute at the front of a non-Disney theme park after the copyright has expired nevertheless suggests to patrons that Disney has some affiliation with or sponsorship of the theme park, it does not seem to be beyond the bounds of rationality to permit Disney to take action.<sup>165</sup>

To be clear, the proposal in this Article is not a limitation on the right to copy as such. To the extent one views the public domain as permitting copying without regard to consumer confusion, this Article's proposal works a more significant incursion.<sup>166</sup> But, properly viewed, the proposal does not permit injunctions against copying, as copyright law would, and thus reduces the tension that occurs if plaintiffs were permitted to use trademark law to prevent copying altogether.<sup>167</sup> Indeed, perhaps one barrier to adoption

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<sup>164</sup> See, e.g., *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997) ("In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of parody is . . . merely a way of phrasing the traditional response that customers are not likely to be confused as to the source, sponsorship or approval."); *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 321 (4th Cir. 1992) ("Although parody necessarily evokes the original trademark, effective parody also diminishes any risk of consumer confusion."); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group*, 886 F.2d 490, 494 (2d Cir. 1989):

A parody must convey two simultaneous — and contradictory — messages: that it is the original, but also that it is not the original and is instead a parody. To the extent that it does only the former but not the latter, it is not only a poor parody but also vulnerable under trademark law, since the customer will be confused.

*Id.*

<sup>165</sup> Cf. Catherine Seville, *Peter Pan's Rights: "To Die Will Be an Awfully Big Adventure,"* 51 J. COPYRIGHT SOC'Y U.S.A. 1, 26 (2003) ("Although the de facto extension of copyright beyond its statutory term is an obvious concern in [passing off] cases, it is probably defensible."); Jessica Litman, *Mickey Mouse Emeritus: Character Protection and the Public Domain*, 11 U. MIAMI ENT. & SPORTS L. REV. 429, 432 (1994) ("[I]f I, the consumer, don't want to see an animated film about Snow White and the Seven Dwarves unless the Disney Company produced it, then Disney should be able to stop Filimation from deceiving me about who made the film, 'Snow White: The Adventure Continues' . . ."); *id.* at 432–33 (expressing concern that trademark law has not been so limited to such instances with respect to protection of characters).

<sup>166</sup> See Margreth Barrett, *Trade Dress Protection for Product Configurations and the Federal Right to Copy*, 20 HASTINGS COMM. & ENT. L.J. 471, 476 (1998) ("[P]ermitting plaintiffs to rely on § 43(a) to prevent the copying of product features creates a distinct tension with Congress' plan in enacting the patent and copyright laws.")

<sup>167</sup> Cf. *Versa Prods. Co., Inc. v. Bifold Co. (Mf'g) Ltd.*, 50 F.3d 189, 207 (3d Cir. 1995) ("It is not unfair competition for someone to trade off the good will of a product; it is only unfair to deceive consumers as to the origin of one's goods and thereby trade off the good will of a prior producer.") (citation omitted); Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN. L. REV. 595, 652 (1996) (noting that the

of this proposal is the now well-accepted inclusion of trademarks within what we call intellectual “property,” a term that suggests the ability to restrict use altogether through injunctive relief.<sup>168</sup> Copyright law, in its provisions that allow content holders to control the use of the property *qua* property and define its metes and bounds, tends to resemble real property more than trademark law, which provides a rights holder not with the ability to control the trademark *qua* trademark but only, at best, with the ability to control certain associations or relationships between trademark meaning and the mark itself.<sup>169</sup>

But allowing trademark law principles to play even this more minor role in the public domain, and to accord it a dominant role as against the use of copyright in appropriate circumstances, has the potential to solve both the concerns of content owners and the concerns of subsequent creators: It provides a vehicle for the attribution claims most creators appear to want (although it is a vehicle only few can drive), and it releases some of copyright’s hold over the dissemination and use of works that creators claim to need. So to recognize the trademark/copyright divide is simply to preserve this distinction: to require content owners to assert attribution claims as such during the term of copyright, and to permit them to continue to do so afterward. Copyright law doesn’t forbid this and, I think, might possibly be enhanced by it.

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Intellectual Property Clause of the Constitution would not preclude liability “if a defendant’s copying of entirely functional features is coupled with separate and independent acts of unfair competition such as ‘palming off,’ false advertising, or deceptive trade practices. On the contrary, relief under these circumstances is not only permissible, but appropriate.”); David S. Welkowitz, *Trade Dress and Patent — The Dilemma of Confusion*, 30 RUTGERS L.J. 289, 306 (1998–1999) (noting that patent law “gives exclusionary rights to the owner,” while trademark law “seeks to make sure that the competitive market operates properly”); Daniel M. McClure, *Trademark and Unfair Competition: A Critical History of Legal Thought*, 69 TRADEMARK REP. 305, 307 (1979) (“Competitors are free to produce identical or similar products, and it would seem that preventing competitors from using each other’s trademarks amounts to only a slight impediment to free competition.”); *cf.* David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147, 177 n.137 (noting a difference between moral rights that ensure recognition and moral rights that protect the “integrity” of the work and suggesting that the latter may conflict with rights in the public domain). In proposing that a right of attribution be considered to be an implied term in every employment contract, Catherine L. Fisk suggests that the remedy for failure to attribute would therefore “not be an injunction against distribution of the work without attribution” but rather “a right to share the reputation benefits of the authorship.” Catherine L. Fisk, *Credit Where It’s Due: The Law and Norms of Attribution*, Duke Law School Working Paper Series 39, available at <<http://lsr.nellco.org/duke/fs/papers/39>>, at 65–66.

<sup>168</sup> David Lange has suggested something similar, although he seems to retreat from this suggestion a paragraph later. *See* David Lange, *Reimagining the Public Domain*, 66 LAW & CONTEMP. PROBS. 463, 470 (2003) (characterizing a former article as embodying a proposal to, *inter alia*, shift in intellectual property law from to a liability regime and a concomitant move to disclaimers rather than injunctions); *id.* (noting that these assertions are “not quite what I would say today”).

<sup>169</sup> *See, e.g.,* Kohler Co. v. Moen Inc., 12 F.3d 632, 643 (7th Cir. 1993) (“[T]rademarks are not monopolies. Others can produce designs similar to the trademark so long as there is no likelihood of consumer confusion.”).