

## **International Trademark Association**

### **Comments in Response to:**

### **Study on the Moral Rights of Attribution and Integrity**

The International Trademark Association (“INTA”) appreciates the opportunity to provide comments in response to the United States Copyright Office Notice of Inquiry, dated January 23, 2017, regarding the moral rights of attribution and integrity. INTA’s Copyright Committee prepared the following comments.

INTA is a not-for-profit membership association of more than 6,400 trademark owners and professionals from more than 190 countries, dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce. INTA’s key goals are to protect the good will of businesses embedded in their trademarks and to prevent consumer confusion. INTA serves as a leading voice for trademark owners. INTA is thus very concerned that the Lanham Act be interpreted in a way that does not undermine the purposes of trademark law.

INTA is submitting these comments to convey three distinct points: (1) copyright and trademark are independent causes of actions and the presence or absence of one should not impact the availability of the other; (2) confusion as to misattribution should be within scope of the Lanham Act; and (3) the Supreme Court’s definition of origin in the *Dastar* decision should be limited to the unusual facts of that case and not expanded to claims for forward confusion, which would have untoward results for both trademark owners and consumers. The following explains each of these points in more detail.

#### **(1) Copyright and Trademark are Distinct Doctrines**

It is a basic tenet of intellectual property law that copyright and trademark serve distinct purposes, cover different types of rights, and should be considered separately in questions of infringement. The Supreme Court stressed that there are “fundamental differences between copyright law and trademark law.” *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439 n. 19 (1984). Furthermore, other courts have noted, “[t]he two legal doctrines are distinct, different, and separate.” *Warner Bros. v. Dae Rim Trading, Inc.*, 677 F. Supp. 740, 760 (S.D.N.Y. 1988). See also *Bach v. Forever Living Products U.S., Inc.*, 473 F. Supp. 2d 1110, 1117–1118 (W.D. Wash. 2007) (“Trademark and copyright law have fundamentally different purposes ...”); *McDonald’s*

*Corp. v. Shop at Home, Inc.*, 82 F. Supp. 2d 801, 814 (M.D. Tenn. 2000) (holding that “copyright and trademark law serve different purposes.”).

As the Supreme Court recognized in *Park 'N Fly, Inc.*, the goal of the Lanham Act is to “secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” 469 U.S. at 198. Specifically, “Trademark law is concerned with protection of the symbols, elements or devices used to identify a product in the marketplace and to prevent confusion as to its source.” *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolos Inc.*, 228 F.3d 56, 63 (2d Cir. 2000). On the other hand, “Copyright law has its roots in the Constitution. It protects ‘fruits of intellectual labor,’ such as literary or dramatic works, musical compositions, motion pictures, sound recordings, architectural works, and other similar original works of authorship.” *EMI Catalogue P'ship*, 228 F.3d at 63–64 (citing U.S. Const. art. I, sect. 8(8)).

As a result of these differences, leading trademark scholars have noted that copyright and trademark offer “separate and independent forms of protection.” 1 McCarthy on Trademarks and Unfair Competition § 6:5 (4th ed.). Yet, some courts have interpreted the Supreme Court’s decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.* to mean that copyright and trademark principles are intertwined. 539 U.S. 23 (2003). The Supreme Court held that permitting certain trademark claims under § 43(a) after a copyrighted work entered the public domain would create a “species of mutant copyright law.” *Id.* at 34. This has led to confusion in the lower courts and yielded court opinions that conflict with the basic principle that copyright and trademark are independent doctrines.

Certain courts have construed the *Dastar* decision to mean that copyright and trademark rights are not independent. As noted by the Second Circuit in *Chosun Intern., Inc. v. Chrisha Creations, Ltd.*, “[t]his 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—has been suggested by the Supreme Court in recent years.” 413 F.3d 324, 328 n.2 (2d Cir. 2005). See also *Phoenix Entm't Partners v. Rumsey*, 829 F.3d 817, 826 (7th Cir. 2016) (“The Supreme Court’s decision in *Dastar* nonetheless makes clear that the law of trademark cannot be invoked to assert what in fact is really a claim of copyright infringement.”). Yet, other courts continue to maintain separation between the two legal doctrines. The Eighth Circuit in *Warner Bros. Entm't v. X One X Prods.*, recently held that “Copyright law and trademark law are distinct from each other . . . As a result, an action that does not infringe a copyright may still infringe a trademark.” 840 F.3d 971, 982 (8th Cir. 2016).

INTA stresses that copyright and trademark law should not be conflated. As expressed above, copyright and trademark law serve different purposes and “the presence or absence of one does not automatically preclude protection under another.” 1 J. Thomas McCarthy, McCarthy on Trademarks & Unfair Competition § 6:5 (4th ed. 2016). Any other result would cause harm to intellectual property owners and consumers.

There are numerous practical reasons for supporting INTA's position. For example, if an intellectual property owner loses its rights due to an untimely copyright renewal, tying trademark rights to copyright rights would negate otherwise valid trademark rights. It is hard to see how that could be good for either consumers or intellectual property owners. It could also lead to unnecessarily complicated litigation. Moreover, to tie the doctrines together would be inconsistent with the Supreme Court's prior holdings that the various intellectual property doctrines are independent and must rise and fall on their own. In *Compco Corp. v. Day-Brite Lighting, Inc.*, for example, the Court held that while unpatented articles may be copied, those who "make and sell copies" can be required to identify the products as their own such that they cannot "deceive the public by passing off their copies as the original." 376 U.S. 234, 238 (1964).

## **(2) Confusion as to Misattribution of Authorship Should Be Within the Scope of Trademark Law**

The *Dastar* decision also poses problems for the policy goals that U.S. trademark law was designed to accomplish. By creating causes of action for unfair or deceptive business practices that can cause consumer confusion as to origin or sponsorship of a product, the Lanham Act protects both consumers and businesses by "foster[ing] competition and the maintenance of quality." *Park 'N Fly, Inc.*, 469 U.S. 189, 198 (1985) (citing to Lanham Act legislative history).

The fundamental question under all of the causes of action contained in the Lanham Act, including reverse passing off, is whether or not consumers are confused. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 780 (1992) (Stevens, J., concurring) ("[U]nder the Lanham Act [§ 43(a)], the ultimate test is whether the public is likely to be deceived or confused by the similarity of the marks. . . . Whether we call the violation infringement, unfair competition or false designation of origin, the test is identical—is there a 'likelihood of confusion?'" (citing *New West Corp. v. NYM Co. of California, Inc.*, 595 F.2d 1194, 1201 (9th Cir. 1979).). Prior to *Dastar*, the courts recognized that misrepresenting the author of a creative work could very easily cause consumer confusion and frustrate the purposes of the Lanham Act. In *Smith v. Montoro*, for example, the Ninth Circuit held that removing an actor's name and substituting the name of another actor could be cognizable as reverse passing off because, among other things, the "originator of the misidentified product is involuntarily deprived of the advertising value of its name and of the goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product" and because the "ultimate purchaser (or viewer) is [] deprived of knowing the true source of the product and may even be deceived into believing that it comes from a different source." 648 F.2d 602, 607 (9th Cir. 1981).

This approach makes sense because consumers care about knowing who created the works of authorship that they acquire. When authorship is misattributed, consumers can be lured into making purchases that they would not otherwise make, unfairly depriving the actual author of the name-recognition she may have accumulated, and deceptively causing consumers to acquire creative products that might not be up to the quality-standards they expect. For example, if someone is able to hold themselves out as the author of a book he or she did not write merely

because the book has fallen into the public domain, the consequences to consumers could be significant. Such harm to consumers and true authors should be within the scope of the policy goals of trademark law.

Since *Dastar*, however, the district courts and courts of appeal have found it far more difficult to remedy consumer confusion regarding attribution of creative works. Many courts have read *Dastar* as holding that a creative work can never be subject to a Section 43(a) reverse passing off claim regarding misattribution of authorship. See, e.g., *Kehoe Component Sales Inc. v. Best Lighting Prod., Inc.*, 796 F.3d 576, 586–87 (6th Cir. 2015) (holding that *Dastar* demands that “in the context of a reverse passing off claim, use of a trademark makes a representation regarding only the product’s physical origin, not its intellectual ancestry”); *Zyla v. Wadsworth, Div. of Thomson Corp.*, 360 F.3d 243, 252 (1st Cir. 2004) (Misattribution of textbook authorship did not give rise to Section 43(a) claim, in light of *Dastar*); *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 149 (5th Cir. 2004) (Section 43(a) claim regarding copying of software could not proceed because the defendant “has not accused [plaintiff] of taking tangible copies of its software, removing its trademarks, and selling them as its own. Rather, [defendant] asserts that [plaintiff] copied the ideas, concepts, structures, and sequences embodied in its copyrighted work. . . . *Dastar* makes clear that such claims are not actionable under § 43(a).”); *Chivalry Film Prods. v. NBC Universal, Inc.*, No. 05 CIV. 5627(GEL), 2006 WL 89944, at \*4 (S.D.N.Y. Jan. 11, 2006) (“The right to copy creative works, with or without attribution, is the domain of copyright, not of trademark or unfair competition.”); *Carroll v. Kahn*, No. 03-CV-0656, 2003 WL 22327299, at \*5 (N.D.N.Y. Oct. 9, 2003) (“A Lanham Act claim based on Defendants’ alleged failure to give Plaintiff proper credit as author and/or producer [] is foreclosed by *Dastar*.”); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003) (A claim regarding uncredited contribution to motion picture was “more appropriately addressed under copyright law rather than under the Lanham Act” and, under *Dastar*, the Section 43(a) claim must “fail[] as a matter of law.”).

As these cases demonstrate, *Dastar* has removed a large category of claims from the domain of trademark law, depriving consumers of protection from confusion with respect to the attribution of authorship of creative works. As explained above, however, removing misattribution from the scope of trademark law can only harm consumers and producers and frustrate the goals of trademark law.

### **(3) The Troubling Expansion of *Dastar*’s Definition of Origin**

As legal justification for concluding there had been no reverse passing off in *Dastar*, the Supreme Court narrowly defined “origin” under the the Lanham Act. Specifically, it held that “origin” under the Lanham Act refers to “the producer of the tangible goods that are offered for sale, and not to the author.” *Dastar*, 529 U.S. at 37. In other words, it defined origin as the actual manufacturer

of the good in question, as opposed to applying a broader definition of origin that might encompass the author of the work.

The problem with this approach is that while the Court in *Dastar* was dealing with the unusual facts of that reverse passing off case, the Court's definition of origin has been expanded beyond reverse passing off. See, e.g., *Antidote Int'l Films, Inc. v. Bloomsbury Pub., PLC*, 467 F. Supp. 2d 394, 399 (S.D.N.Y. 2006) (holding that the Supreme Court's definition of "origin" "applies with equal force" to claims for "affiliation, connection, or association of [defendant] with another person."); *Clark v. Walt Disney Co.*, 642 F. Supp. 2d 775, 786 (S.D. Ohio 2009) (holding that despite the fact that plaintiff's claim was not for reverse passing off, the *Dastar* decision's definition of origin forecloses plaintiff's ability to bring a claim for likelihood of confusion as to origin, source and sponsorship). Indeed, it is not difficult to imagine the *Dastar* Court's definition being applied in a forward confusion case. In fact, scholars have questioned whether the Court's reasoning in *Dastar* regarding origin would disturb traditional trademark principles outside of the narrow scope of the facts of *Dastar*. See Justin Hughes, *American Moral Rights and Fixing the Dastar "Gap,"* 2007 Utah L. Rev. 659, 693 (2007) (discussing those claims and concepts for which the Supreme Court's definition of origin should not be applied). *Dastar*, taken to its logical conclusion, could allow an obvious infringer to avoid a trademark forward confusion claim simply by accurately labeling itself as the manufacturer of the good in question even though the infringer's overall presentation would be confusing. This would be inconsistent with the Lanham Act's role in preventing consumer confusion. Any recommendation should clarify that the definition of origin in *Dastar* should be limited to the facts of that case.

We are happy to discuss any of these comments further if that would be helpful to the Copyright Office.