September 2003

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Recommended Citation

Strauch, Bruce (2003) "Cases of Note -- When Copyright and Trademark Collide," *Against the Grain*: Vol. 15: Iss. 4, Article 23.
DOI: <https://doi.org/10.7771/2380-176X.4490>

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Cases of Note

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When Copyright And Trademark Collide

Dastar Corporation v. Twentieth Century Fox Film Corporation Et Al., Supreme Court of the United States, 123 S. Ct. 2041, 2003 Lexis 4276 (2003).

In 1948, with the war still fresh in his memory, **Dwight Eisenhower** wrote *Crusade in Europe* published by **Doubleday** which registered copyright and then sold exclusive T.V. rights to **Twentieth Century Fox**. **Fox** then hired **Time Inc.** to do the T.V. series with **Time** assigning its copyright to **Fox**. The 26 episode series was aired in 1949.

Which is curious. I thought there were only three T.V.s in existence then.

Doubleday renewed its copyright on the book in 1975, but **Fox** didn't, dumping the T.V. series into the public domain. However, **Fox** reacquired T.V. rights in the book in 1988 including the exclusive right to distribute the series on video. And **Fox** turned it into video.

This re-acquisition of rights is not discussed in the case. So you have to pretty much wipe it from your thoughts and focus on the public domain.

With the 50th anniversary of VE Day coming up, **Dastar Corp** (petitioner — see caption above) saw the *Crusade* series sitting there quietly in the public domain. It bought the **Fox** video series on the open market, copied and then heavily edited it down to about half the original length.

Betting on the diminished attention span of today's WW II buffs.

Some new sequencing and narration was done, and the result put out as the video set *World War II Campaigns in Europe* — as a **Dastar** product. And **Dastar** ruthlessly undercut **Fox's** price. It was after all only half the length.

Knowing they were trumped on the copyright issue due to the public domain thing, **Fox's** high-priced lawyers had to come up with another cause of action. And so they did.

Fox sued saying that **Dastar** was pulling a "reverse passing off" — § 43(a) of the **Lanham Act** — by not giving proper credit to the *Crusade* T.V. series. You pass or palm off when you misrepresent your goods as those of someone else. See, e.g., *O. & W. Thum Co. v. Dickinson*, 245 F. 609, 621 (CA6 1917). A reverse passing off is — you got it — the reverse. You claim someone else's goods are yours. See, e.g., *Williams v. Curtis-Wright Corp.*, 691 F.2d 168, 172 (CA3 1982).

The Ninth Circuit did not care for what it termed the "bodily appropriation" of the **Fox** work and affirmed a District Court award of two times **Dastar's** profits. And then the case went to the Supremes.

Our Old Friend the Lanham Act

The **Lanham Act** was written to make "actionable the deceptive and misleading use of marks." § 43(a), 15 U.S.C. § 1125(a) allows a federal suit against anyone who makes "a false designation of origin, or any false description or representation" vis-à-vis goods or services.

The **Supreme Court** immediately cited the Second Circuit that § 43(a) "does not have boundless application as a remedy for unfair trade practices." *Alfred Dunhill, Ltd. v. Interstate Cigar Co.*, 499 F.2d 232, 237 (1974). "Because of its (???) inherently limited wording (???)", § 43(a) can never be a federal 'codification' of the overall law of 'unfair competition,'" 4 J. McCarthy *Trademarks and Unfair Competition* § 27:7, p. 27-14 (4th ed. 2002).

(???) added by author to express his bafflement over what seems like pretty gosh-darn broad wording. The confusion here perhaps lies in the Lanham language that the act was intended "to protect persons engaged in ... commerce against unfair competition." Which sounds hugely broad. But the act plainly says it's about the improper use of trademarks. Which must be the inherently limited wording.

issues as it resolves. A large part of the decision revolved around the ability of adult users to request that the filtering software be disabled. This decision, however, means that libraries should review and revise their Internet use policies as soon as possible.

When looking at an Internet use policy, the most important part of the policy involves the procedure that a patron should follow when he or she wishes to have the filtering software disabled. In addition, libraries should look at their policies concerning the use of computers in the adult room by children if they opt to provide unfiltered access to adult computers.

Every decision has its nuances, but a plurality decision is even trickier to interpret than most. As a result, I recommend that you consult with your library, city, or school board attorney before finalizing your final Internet use policy.

But sticking to our issue of false designation or origin, the word 'origin' does not just mean geographical locale, but also source or manufacture. *Federal-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 408 (1963). So that makes **Lanham** broad enough to encompass reverse passing off.

Which strikes me as what that inherently limited wording says with "false description or representation."

But then, incredibly, the Court goes on to say that the **Trademark Law Revision Act of 1988** makes it clear that it covers origin of production as well as geography. See, e.g., *Alpo Petfoods, Inc. v. Ralston Purina Co.*, 286 U.S. App. D.C. 192, 913 F.2d 958, 963-964, n. 6 (CA DC 1990) (Thomas, J.).

So why did we need the above stuff? Do those S.Ct. clerks not have enough to keep them busy? Or are they the law review pedants you always suspected them to be? And why am I making you read this?

Anyhow

Let's cut to the gravamen as they say. Using **Lanham** language, **Fox** argued that **Dastar** made a "false designation of origin ... which ... is likely to cause confusion ... as to the origin ... of his or her goods."

The Court didn't — dare I say — buy that, holding instead that had **Dastar** repackaged *Crusade* it would indeed be a no-no. By repackaging, it means acquire the **Fox** video, strip the **Fox** cellophane off, and put **Dastar** cellophane on.

Instead, **Dastar** took a work out of the public domain, finessed some (trivial) alterations and came up with its own series of videotapes. If "origin" means manufacturer, then **Dastar** was the origin. But can "origin" mean the creator of the underlying work that was brutally edited?

Origin: "that from which anything primarily proceeds; source." Webster's New International Dictionary 1720-1721 (2d ed. 1949).

Don't they have a more up-to-date dictionary in the S. Ct. library? Or did they want the dictionary that Dwight Eisenhower would have used?

Anyhow, they conclude on that slim basis that origin means "producer of the tangible product sold in the marketplace" which is to say the physical *Campaigns* video made by **Dastar**.

Section 43(a) strikes at trademark infringements that impair a producer's goodwill or trade on his reputation. The loyal consumer who is buying your icky brown cola that has been falsely labeled **Coca-Cola** believes that **Coke** produced your brew and hence was the origin. But he does not necessarily believe that **Coke** was the first to

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Legally Speaking from page 89

www.pen.k12.va.us/go/VDOE/Technology/AUP/home.shtml

- *Library Internet Use Policies*. InfoPeople Project, California State Library and Peninsula Library System, September 16, 2002. <http://www.infopeople.org/about/policies/>
- *Develop an "Acceptable Use Policy" (AUP) for Schools and Public Libraries*. The Internet Advocate, May 11, 2000. <http://www.monroe.lib.in.us/~lchampell/netadv3.html>

Conclusion

The plurality opinion from the United States Supreme Court brings up as many is-

devise the formula in that sense of origin.

Except in the case of Coke he surely does. But that was the example that our imagination-challenged Court actually used.

When Copyright Bumps Up Against Trademark

But there is the problem of publisher versus author. The consumer might value either or both in making a purchase. By not attributing the artistic creator at **Time/Fox**, this creative soul would be deprived of a righteously earned reputation. That, however, would bring us into a head-on clash with the law of copyright which is designed to handle the matter. When copyrights and patents expire, the right to copy without attribution passes to the public. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1938).

Which perhaps explains the Court's initial caution about over-extending the Lanham Act.

"The **Lanham Act** does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of ex-

clusivity." *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34 (2001). Or copyright of course.

Lanham is designed to prevent your competitors from using your source-identifying mark and thereby reduce consumer shopping costs, and guarantee that the producer will reap the gain from his reputation of making a fine product. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995).

And Congress has already addressed the author attribution issue with great specificity in the **Visual Artists Rights Act of 1990**, § 603(a), 104 Stat. 5128. It gives the author of an artistic work the right "to claim authorship of that work." 17 U.S.C. § 106A(a)(1)(A). It is limited to works of visual art, is personal to the artist (not **Time/Fox**), and lasts only for the life of the artist.

To permit suit for misrepresentation of authorship of non-copyrighted works would blow away these limitations.

And then there would be the practical problems of attribution. The **MGM film Carmen Jones** was based on a musical by **Oscar Hammerstein II**, which was based on the opera by **Georges Bizet** which was based on the novel by **Prosper Merimée**.

Time/Fox were not the creative souls behind *Crusade*. That credit belonged to all the camera folks in the armies and navies of the U.S., Canada and Britain.

And then there's a nice quip. "We do not think the **Lanham Act** requires this search for the source of the Nile and all its tributaries." [Lexis *2049].

Although it would seem that Visual Artists Rights Act would were they still alive.

Further, if we followed the **Fox** theory, a manufacturer would face Lanham liability for not crediting the creator of *Crusade* — and — also face Lanham liability if it did credit the creator, and the credit seemed to imply the creator's approval or sponsorship.

To follow that, you must keep reminding yourself this is for a public domain work. Repeat. Public domain work.

The creative talent behind *Crusade* could have been protected by copyright if **Fox** hadn't flubbed it and not renewed. AND if **Dastar** had advertised that its video *Campaigns* was "quite different" from *Crusade*, then **Fox** could sue not for reverse passing off but under the "misrepresents the nature, characteristics [or] qualities" part of § 43(a)(1)(B).

Questions & Answers — Copyright Column

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Question: *The institution recently sponsored a film festival at which a staff member took photographs which are to be posted on the library's Website. Some of the photos depict members of the library staff, all of whom have agreed to have their likeness posted on the Website. For other festival goers who can be*

identified, does the library need to get their permission for posting the photos? Do they have to be identified by name?

Answer: This is not really a copyright question but is a right to privacy or, if the person is famous, a right of publicity question. My usual advice is not to worry about it when photos are taken at a public event. If someone complains about their photo being on the Website, the library can then remove that photograph. However, if the individual is a student, the library may want to seek permission because of the **Federal Educational Rights and Privacy Act (FERPA)** concerns. This is a situation in which university counsel should be consulted.

Question: *A for-profit service sells and distributes, via the Web, a coursepack of journal articles for college courses. Most of the articles the service distributes are contained within databases to which the service has subscribed, so copyright should be covered in their*

contract agreement with publishers. Occasionally, an article is not available in one of these databases and the for-profit service has requested that the library provide it with a copy. The service then obtains copyright clearance from the CCC "before" making the work available online in the coursepack. Is there any problem with the library providing the service with a copy? Should the library require an official request? What does the for-profit service need to do to be compliant with the copyright law?

Answer: No, there is no problem in providing the service with a copy. The for-profit service is handling the copyright permissions and royalties. Under section 108(d) of the **Copyright Act**, a library may provide a copy to a user upon request. If royalties are due because of the use the patron will make of the material, either the supplying library or the requesting entity must pay them. In this instance, the for-profit service is handling the royalties. It is unclear what is meant by an "official request." Does this mean an interlibrary loan request?

The only responsibility of the library that provides the copy upon request is to give the section 108(d) warning to the requestor, make sure the copy contains the real notice of copyright and that the request is for not more than one article from a periodical issue. It is the for-profit service that must ensure its own compliance. The university library should not

be concerned about the for-profit service's compliance but instead should worry about its own compliance.

Question: *The school choir director is under the impression that a work of music can be reproduced for each member of the choir for a college choir performance without penalty as long as the photocopies are collected and destroyed within forty-five days. This sounds like flagrant infringement, is it?*

Answer: It sounds pretty suspect to me also. The **Educational Uses of Music Guidelines** which were developed in 1976 and published in *House Report 94-1476* allows photocopying sheet music for performance but for emergency purposes only. For example, one of the performers has lost the music and the performance is imminent. According to those guidelines, even after the performance the school still has to purchase the music. I would require the faculty member to bring in some proof of an agreement from music publishers before committing the school to such a practice.

Question: *Some members of the library staff have compiled a glossary with common terms taken from various sources. The definitions have not been copied verbatim but have been rewritten. Is it necessary to cite the sources for these terms?*

Answer: The answer to your question is no, but it is not really a copyright question since you have indicated that the material was not

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