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AMERICAN MORAL RIGHTS AND FIXING THE *DASTAR* “GAP”

Justin Hughes*

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I. INTRODUCTION

Until 1988, people who worked in copyright law lived with the fact that the biggest national producer of copyrighted works, the United States, lived outside the dominant multilateral system of copyright norms. Although an American delegation had participated in the drafting of the Berne Convention in 1886, the United States remained stubbornly distant from the “Berne Union.”¹ Arguably this

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¹ See, e.g., Melville B. Nimmer, *Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 STAN. L. REV. 499, 500 (1967).

distance grew when moral rights were added to the Berne Convention as Article 6bis in 1928.²

Moral rights, or *droit moral*, are a constellation of rights that ensure an ongoing relationship between the author and the creative work outside economic issues. Two of these rights—the right of attribution and the right of integrity—are the core moral rights recognized in Berne Article 6bis.³ The right of attribution guarantees that the author’s selected form of identification with the work remains—whether the author used her own name, used a pseudonym, or wanted to remain anonymous. The right of attribution is also generally understood to include a right against misattribution. The right of integrity allows the artist to object to distortions, alterations, or changes in the work; in Article 6bis this right is limited to changes that might damage the artist’s reputation. Although there are other rights in the constellation of *droit moral*,⁴ Berne is only concerned with these two.

When the United States finally acceded to the Berne Convention in 1988, it did not have any federal statutory provision providing the two 6bis moral rights. Yet the U.S. government concluded—and the other Berne signatories seemingly accepted—that the United States provided substantively equivalent protection via a “composite” or “compendium” or “patchwork” of laws.⁵ Of course, the idea that countries can meet their international intellectual property obligations through different types of laws is quite common. For example, the Agreement on Trade-Related Aspects of Intellectual Property Law (TRIPS) expressly accepts substantively equivalent, but formally varied, protection for plant varieties.⁶

² See H.R. REP. NO. 101-514, at 7 (1990), reprinted in 1990 U.S.C.C.A.N. 6915, 6917; see also Orrin G. Hatch, *Better Late than Never: Implementation of the 1886 Berne Convention*, 22 CORNELL INT’L L.J. 171, 184 (1989) (“At the outset of the 100th Congress, the ‘moral rights’ obstacle remained in the path of legislation to implement the [Berne] Convention.”).

³ Berne Convention for the Protection of Literary and Artistic Works, art. 6bis, Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended in 1979, S. TREATY DOC. NO. 99-27 (1986), 1161 U.N.T.S. 30 [hereinafter Berne Convention].

⁴ Other moral rights include a right of “first publication” and a right of “withdrawal.” See, e.g., PAUL GOLDSTEIN, INTERNATIONAL COPYRIGHT 289–90 (2001) (discussing rights of withdrawal and “divulcation”) [hereinafter GOLDSTEIN, INTERNATIONAL COPYRIGHT]; A. LUCAS & H.-J. LUCAS, PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE 299 (1994); MAREE SAINSBURY, MORAL RIGHTS AND THEIR APPLICATION IN AUSTRALIA 6–12 (2003) (describing same four moral rights).

⁵ All these terms come from the legislative history. See, e.g., H.R. REP. NO. 100-609, at 37 (1988); FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION 39, reprinted in 10 COLUM.-VLA J.L. & ARTS 513 (1986) [hereinafter WORKING GROUP FINAL REPORT]. I first used the “patchwork” notion in Justin Hughes, *The Line Between Work and Framework, Text and Context*, 19 CARDOZO ARTS & ENT. L.J. 19, 21 (2001). One could also call it a “mélange of legal theories.” Ilhyung Lee, *Toward an American Moral Rights in Copyright*, 58 WASH. & LEE L. REV. 795, 800 (2001).

⁶ TRIPS Article 27(3)(b) provides that “Members shall provide for the protection of plant varieties either by patents or by an effective *sui generis* system or any combination thereof.” Agreement on Trade-Related Aspects of Intellectual Property Rights art. 27(3)(b),

Agreement on the TRIPS provisions covering geographical indications was only possible with the understanding that some countries would fulfill the obligations with their *appellations d'origine* systems and others through trademark law.⁷ Yet even in such a liberal framework for implementing treaty obligations, to many, the American claim of Article 6bis compliance was, at best, a stretch.⁸

Within this patchwork of protection, Lanham Act claims were arguably the keystone of the United States' claim to provide protection substantively equivalent to Article 6bis' right of attribution. In 2003, the Supreme Court appeared to shred that portion of the patchwork with its ruling in *Dastar Corp. v. Twentieth Century Fox Film Corp.*⁹ In *Dastar*, the Court unanimously held that, vis-à-vis works in the public domain, there is no Lanham Act obligation to credit the original creator or copyright owner as the origin of the work.¹⁰ The *Dastar* ruling was unquestionably important for a robust public domain,¹¹ but the reasoning the Court employed makes American compliance with Article 6bis considerably more problematic.

Section II provides a brief context for the discussion that follows, while Section III explores the American patchwork approach to compliance with Berne Article 6bis. Section IV aims to convince the reader that (a) the reasoning in *Dastar* is fundamentally unstable as an interpretation of § 43(a) of the Lanham Act, (b) that lower courts have further expanded the *Dastar* holding with neither need nor justification, and (c) that a narrower, more stable approach could have reached the same result for the public domain with no negative impact on our Berne Article 6bis compliance. Section V provides a simple, politically tenable statutory fix for *Dastar*. Section VI of this Article returns to the general issue of

Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, vol. 31, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994).

⁷ See Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate about Geographical Indications*, 58 HASTINGS L.J. 299, 311–20 (2006).

⁸ As anthropologist Michael Brown wrote in 2003, "the moral rights dimension of copyright law is underdeveloped in the United States, a situation that seems unlikely to change." MICHAEL F. BROWN, WHO OWNS NATIVE CULTURE? 74 (2003). Brown goes on to note, "[t]he doctrine of moral (or authors') rights represents a feeble nod in the direction of non-economic concerns, but it is limited in scope, problematic from a free-speech perspective, and almost completely absent from the legal system of the United States, the single largest actor on the world's commercial stage." *Id.* at 235. David Nimmer also believes that "it is a stretch to maintain that the law in the United States as of the enactment of the Berne Convention Implementation Act of 1988 was congruent with Article 6bis of the Berne Convention." David Nimmer, *The Moral Imperative Against Academic Plagiarism (Without a Moral Right Against Reverse Passing Off)*, 54 DEPAUL L. REV. 1, 22 (2004).

⁹ 539 U.S. 23 (2003).

¹⁰ *Id.* at 38.

¹¹ See, e.g., Lynn McLain, *Thoughts on Dastar from a Copyright Perspective: A Welcome Step Toward Respite for the Public Domain*, 11 U. BALT. INTELL. PROP. L.J. 71, 72 (2002); Ruth L. Okediji, *Through the Years: The Supreme Court and the Copyright Clause*, 30 WM. MITCHELL L. REV. 1633, 1636 (2004).

patchwork protection, concluding that American scholars who have been critical of the argument have been generally unfamiliar with Berne Convention implementation in other countries and have not judged the United States' Berne compliance by public international-law standards.

II. MORAL RIGHTS IN DIFFERENT, BUT NOT SO DIFFERENT, SYSTEMS

Commentators often observe that Anglo-American copyright law is driven principally by consequentialist, economic, and incentive-based justifications,¹² while continental European copyright law is informed to a greater degree by natural rights and concern to protect the personality interests of the author.¹³ But neither this difference nor the role moral rights play in it should be sketched in caricature.

The two *6bis* moral rights were introduced into the Berne Convention during the 1928 Rome revision of the treaty,¹⁴ with some modification of the treaty language in the Stockholm revision in 1967.¹⁵ First, Article 6*bis*(1) obliges member states to provide the author with "the right to claim authorship of the work."¹⁶ Narrowly understood, this could be construed as only an author's right to have the work attributed to her by her legal or commonly-known name: in other words, a right to prevent nonattribution. But the *6bis* wording has also generally been understood to give the author (a) a right to enjoy nonattribution—to publish anonymously or pseudo-anonymously—and a two-pronged right to prevent

¹² See H.R. REP. NO. 100-609, at 17 (1988) ("Under the U.S. Constitution, the primary objective of copyright law is not to reward the author, but rather to secure for the public the benefits derived from the authors' labors."). See generally Peter S. Menell, *Intellectual Property: General Theories*, reprinted in 2 *ENCYCLOPEDIA OF LAW AND ECONOMICS: CIVIL LAW AND ECONOMICS* 129, 129 (Boudewijn Bouckaer & Gerrit De Geest, eds., 2000) (discussing utilitarian intellectual property rights), available at <http://encyclo.findlaw.com/1600book.pdf> (last visited Nov. 28, 2007).

¹³ See PAUL GOLDSTEIN, *COPYRIGHT'S HIGHWAY* 137–38 (rev. ed. 2003) (explaining European copyright focus on author); GOLDSTEIN, *INTERNATIONAL COPYRIGHT*, *supra* note 4, at 283–84 ("Civil law systems, with their ostensible deference to authors' natural rights, are commonly thought to provide more rigorous moral rights protection than common law systems, with their reputed utilitarian bent."); SAINSBURY, *supra* note 4, at 19 ("Moral rights originated in civil law jurisdictions, which traditionally place more emphasis on the natural rights of the author than his or her economics rights as the basis for intellectual property protection. In common law jurisdictions, intellectual property protection is more to do with economic protection for the author than natural rights." (footnote omitted)).

¹⁴ See INTERNATIONAL UNION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS, *PROCEEDINGS OF THE CONFERENCE HELD AT ROME FROM MAY 7 TO JUNE 2 1928*, vol. 1 at 106-07, vol. 2. at 173-82, 200-04 (Pierre Tuisseyre trans., 1929).

¹⁵ See WIPO, *GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (PARIS ACT, 1971)* 43 (1978) [hereinafter *WIPO, GUIDE TO THE BERNE CONVENTION*].

¹⁶ Berne Convention, *supra* note 3, at art. 6*bis*(1).

misattribution; (b) to prevent her name from being attached to works that are not hers, and (c) to prevent others' names from being attached to her works.¹⁷

Under Article 6*bis*(1), the right of integrity is the author's right "to object to any distortion, mutilation or other modification of, or another derogatory action in relation to, the said work, which would be prejudicial to [the author or artist's] honor or reputation."¹⁸ Again, this right could be understood broadly or narrowly. Under some interpretations, 6*bis* does not create an obligation to allow artists to stop the complete destruction of their work, because disappearance from the cultural landscape would not necessarily be prejudicial to the author's honor or reputation.

These moral rights are often portrayed as quite alien and distinct from the economic or patrimonial rights associated with copyrighted works, even to the point of touching off an almost metaphysical discussion in Europe over whether authors' rights are dualistic or unitary in nature.¹⁹ Adding to their otherness, these legal notions appeared late, congealing in France as *droit moral* only at the end of the nineteenth century²⁰—well after economic rights had been defined and established in copyright laws in France (1791 and 1793), England (1710), and the United States (1780s). In 1976, Professor John Henry Merryman noted that the "moral right of the artist [is] still comparatively young even in the nation of its origin" and that it probably "has not reached anything like its full development."²¹

Yet there is no question that moral rights reflect some basic equitable ideas of human relations—and have parallels in both general legal norms and nonjuridical norms. The right of attribution, and against misattribution, is clearly akin to our social norm against plagiarism. In fact, the earliest French cases that are now identified as moral rights cases—in the 1820s and 1830s—condemned false

¹⁷ See WIPO, GUIDE TO THE BERNE CONVENTION, *supra* note 15, at 41; WORKING GROUP FINAL REPORT, *supra* note 5, at 547–52. Stephen Ladas divided the right of attribution into three subrights, not including the right of anonymity. STEPHEN P. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 585 (1938). Australia's 2000 codification specifically separates the right of attribution (section 193) from the right to prevent false attribution (section 195AC). Copyright Act, 1968, §§ 193, 195AC, available at http://www.austlii.edu.au/au/legis/cth/consol_act/ca1968133/.

¹⁸ Berne Convention, *supra* note 3, at 235.

¹⁹ See BERNARD EDELMAN, LA PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE 44 (1989) (noting a "dialectic" between economic and moral rights); LUCAS & LUCAS, *supra* note 4, at 300 (noting dualist or unitary debate); ALAIN STROWEL & JEAN-PAUL TRIAILLE, LE DROIT D'AUTEUR, DU LOGICIEL AU MULTIMÉDIA para. 62, at 46–47 (contrasting "une vision dualiste" with German law's "doctrine moniste" in which "le droit d'auteur n'est pas la somme des éléments patrimoniaux et personnels, mais un droit unique").

²⁰ See LUCAS & LUCAS, *supra* note 4, at 15–18, 299 ("[O]n est presque surpris de constater qu[e le droit moral] n'est apparu qu'assez tardivement."); ALAIN STROWEL, DROIT D'AUTEUR ET COPYRIGHT: DIVERGENCES ET CONVERGENCES para. 371, at 481 (1993).

²¹ John Henry Merryman, *The Refrigerator of Bernard Buffet*, 27 HASTINGS L.J. 1023, 1026 (1976).

attribution of authorship under general principles of law.²² There is also no question that American copyright law has always had strong secondary strains of natural justice²³ and concern for the author's personality interests.²⁴ Whether common law or civil law, the economic side of copyright often includes nonmarket or antimarket mechanisms to protect authors—reversionary rights in the United States and best-seller rights in Germany. Meanwhile, the moral rights of attribution and integrity are often “monetized” by authors—as when a court awards money damages for lack of attribution, when a famous architect sells the rights to put his name on a building separate from his creative services, and when an artist negotiates a monetary payment to support further works as recompense for the integrity of some existing work being compromised.

²² Cour de Paris [Court of Appeals], March 20, 1826, *Periodique Sirey* 1827.2.155 (false attribution case); Civ. Trib. Seine, December 17, 1838, *Gazette des Tribunaux*, December 18, 1838; Civ. Trib. Seine, March 12, 1836, *reprinted in* EUGENE POUILLET, *TRAITE THEORIQUE ET PRATIQUE DE LA PROPRIETE LITTERAIRE ET ARTISTIQUE ET DU DROIT DE REPRESENTATION* (Georges Maillard & Charles Claro eds., 3d ed. 1908). Then, from the 1880s onwards, French courts built up a large body of cases elaborating the rights of attribution and integrity. *See* William Strauss, *The Moral Right of the Author* (July 1959), *reprinted in* 2 *STUDIES ON COPYRIGHT* 963, 965–76 (Arthur Fisher ed. 1963) [hereinafter Strauss, *The Moral Right of the Author*].

²³ *See, e.g.,* Massachusetts Copyright Act of March 17, 1783, *reprinted in* THORVALD SOLBERG, *COPYRIGHT ENACTMENTS OF THE UNITED STATES, 1783–1906*, at 14 (2d ed. 1906) (saying that security in the “fruits of [authors’] study and industry is one of the natural rights of all men, there being no property more peculiarly a man’s own than that which is produced by the labour of his mind”); New York Act of April 26, 1786, *reprinted in* SOLBERG, *supra*, at 29 (“[I]t is agreeable to the principles of natural equity and justice that every author should be secured . . .”). *See also* Thomas B. Nachbar, *Constructing Copyright’s Mythology*, 6 *GREEN BAG* 20, 37, 44 (2002) (noting that in state copyright acts preceding the 1790 federal law “authors’ natural rights are mentioned as frequently as society’s benefit as the justification for protection”). Even in *Mazer v. Stein*, 347 U.S. 201 (1954), a case widely cited for the Supreme Court espousing the economic incentive theory of copyright, the Court’s economic incentive statement—“[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors . . .”—is promptly followed by a natural rights-sounding comment: “Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.” *Id.* at 219.

²⁴ “The personality theory of intellectual property had been present in the Anglo-American tradition since the eighteenth century . . .” Carla Hesse, *The Rise of Intellectual Property, 700 B.C.–A.D. 2000: An Idea in the Balance*, *DAEDALUS*, Spring 2002, at 26, 42.

III. THE AMERICAN PATCHWORK FOR BERNE ARTICLE 6*bis*

When the United States finally joined the Berne Convention in 1988,²⁵ Congress made clear that the treaty was not self-executing, i.e., that authors would not enjoy causes of action directly arising from the treaty:

The provisions of the Berne Convention, the adherence of the United States thereto, and satisfaction of United States obligations thereunder, do not expand or reduce any right of an author of a work, whether claimed under Federal, State, or common law—(1) to claim authorship of the work; or (2) to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the work, that would prejudice the author’s honor or reputation.²⁶

As a result, the few courts that have considered the issue have found that authors have no claims arising from the Berne Convention independent of domestic law.²⁷

While it was absolutely clear in 1988 that moral rights of the Article 6*bis* sort did not exist in the U.S. copyright statute,²⁸ there was an understandable impulse to minimize any needed changes in statutory copyright law.²⁹ To that end, the House

²⁵ On October 31, 1988, President Ronald Reagan signed the Berne Convention Implementation Act (BCIA), Pub. L. No. 100-568, 102 Stat. 2853 (1988) (codified at 17 U.S.C. §§ 101, 104, 116, 116A, 205, 301, 401-08, 411, 501, 504, 801, 803 (2006)).

²⁶ 17 U.S.C. § 3(b), 102 Stat. 2853, 2854; *see also id.* §§ 3(a), 4(c), 120 Stat. 2853, 2855. Section 4(c) is now codified at 17 U.S.C. § 104(c).

²⁷ *See Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 195 (S.D.N.Y. 1999) (“Although the Supreme Court has not yet decided the point, it seems quite clear at this point that the Berne Convention is not self-executing.”); *Choe v. Fordham Univ. Sch. of Law*, 920 F. Supp. 44, 49 (S.D.N.Y. 1995) (holding that the “Convention itself, as adopted, does not create federal common law action for violation of author’s moral rights”); *Rodriguez v. Casa Salsa Rest.*, 260 F. Supp. 2d 413, 422 (D.P.R. 2003); *see also* 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8D.02[D] (2006) [hereinafter NIMMER ON COPYRIGHT]. Australian courts have also ruled that Berne is not self-executing. *See Minister of State for Immigration and Ethnic Affairs v. Toeh* (1995) 183 C.L.R. 273; *Dietrich v. The Queen* (1992) 177 C.L.R. 292; *New S. Wales v. Commonwealth* (1975) 135 C.L.R. 337.

²⁸ *See, e.g., Vargas v. Esquire, Inc.*, 164 F.2d 522, 526 (7th Cir. 1947) (concluding that there are no moral rights under American copyright law); *Crimi v. Rutgers Presbyterian Church*, 89 N.Y.S.2d 813, 819 (N.Y. Sup. Ct. 1949) (holding that an artist had no customary rights to stop destruction of church mural); LADAS, *supra* note 17, at 802 (“The conception of ‘moral right’ of authors . . . has not yet received acceptance in the law of the United States. No such right is referred to by legislation, court decisions or writers.”); *see also Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 82 (2d Cir. 1995) (stating that the limited rights recognized under the Visual Artists Rights Act (VARA) “are of recent vintage in American jurisprudence” and that courts have rejected “attempts to inject” such rights into U.S. law more generally).

²⁹ *See, e.g.,* 134 CONG. REC. S14, 552 (daily ed. Oct. 5, 1988) (statement of Sen. Leahy) (“I encouraged my colleagues to make only those changes necessary to our laws

Report on Berne implementation concluded that no amendment of U.S. law was needed because “there is a composite of laws in this country that provides the kind of protection envisioned by Article 6bis.”³⁰ According to the legislative history,³¹ those existing causes of action include:

- 17 U.S.C. § 106 right to prepare derivative works
- 17 U.S.C. § 115 prohibition on distortion of musical compositions³²
- 17 U.S.C. § 203 restriction on termination of licenses and transfers
- Section 43(a) of the Lanham Act
- State right of publicity laws
- State unfair competition laws
- State contract laws
- State fraud and misrepresentation laws
- State defamation laws
- State moral rights legislation³³

This patchwork protection was not an ingenious, last minute creation of Capitol Hill staff in 1988; it had a long conceptual and practical history. The earliest appearance of the patchwork argument in American legal literature may have been in a 1940 article by Martin Roeder.³⁴ William Strauss subsequently wrote a detailed study on the issue in 1959 as part of the long review of American copyright law that contributed to the 1976 Act.³⁵

which are necessary to comply with Berne.”). Reluctance to modify the copyright law may have stemmed from simple conservatism against fiddling with an established law or fresh memories on Capitol Hill from the painfully protracted effort to revise U.S. copyright law in the 1960s and 1970s.

³⁰ H.R. REP. NO. 100-609 at 34 (1988).

³¹ *Id.*

³² *Id.* Section 115(a)(2) of the Copyright Act forbids the party republishing a musical composition in a new sound recording under a compulsory license from changing the basic melody or fundamental character of the work. 17 U.S.C. § 115(a)(2) (2006).

³³ The House report recognized that “eight states have recently enacted specific statutes protecting the rights of integrity and paternity in certain works of art.” H.R. REP. NO. 100-609 at 34.

³⁴ Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554 (1940). Roeder recognized that common law provided some moral rights-like protections. He noted that “[t]he right to prevent deformation has been recognized by English and American courts and theorists. . . . The theories advanced have been manifold.” *Id.* at 565–66 (footnote omitted). Nonetheless, Roeder generally considered these inadequate substitutes for true moral rights provisions. *See id.* at 574.

³⁵ Strauss, *The Moral Right of the Author*, *supra* note 22. Strauss had earlier explored the same issues in William Strauss, *The Moral Right of the Author*, 4 AM. J. COMP. L. 506 (1955).

William Strauss's 1959 monograph concluded that "protection of the moral right varies considerably from one [Berne] member country to another,"³⁶ but, nonetheless, that "[w]ithout using the label 'moral right,' . . . the courts in the United States arrive at much the same results as do European courts."³⁷ Strauss discussed the examples of Britain and Switzerland to describe how countries could provide *6bis* protection without establishing specific *droit moral* causes of action.³⁸ In the case of Great Britain, a 1952 report—preceding the U.K.'s revision of copyright law in 1953—noted that *droit moral* was "a term unknown in our jurisprudence" and opined that many of the concerns addressed by moral rights reasoning "do not lend themselves to cure by legislative action, but are of a type that can best be regulated by contract between the parties concerned."³⁹ Concerning Switzerland, Strauss concluded that *droit moral* was secured only by a general provision of the Civil Code giving injunctive relief to "[a]nyone whose personal rights are violated by an unlawful act" and that "authors as a class enjoy no preferential treatment as regards their personal rights."⁴⁰ He judged such claims to be similar to privacy causes of action under the common law.⁴¹

In a 1967 article, Professor Melville Nimmer had similarly concluded that the moral rights barrier to U.S. accession to Berne was "in part based on a misconception."⁴² Professor Nimmer found that "the substantive content of Article *6bis* is left largely to the determination of domestic legislation"; that "a number of the so-called moral rights receive protection in United States courts"; and, therefore, that "[i]t could be said that the United States does comply with a narrow construction of the requirements of Article *6bis*."⁴³ The credibility of the patchwork argument has been strengthened recently by Cyril Rigamonti's careful study concluding that "the European concept of moral rights itself is just a

³⁶ Strauss, *The Moral Right of the Author*, *supra* note 22, at 966.

³⁷ *Id.* at 991.

³⁸ *Id.* at 976–78.

³⁹ *Id.* at 976–77 (quoting The Report of the Copyright Committee of 1952, presented by the President of the Board of Trade to Parliament by Command of Her Majesty, October 1952). Immediately following this cryptic comment, the 1952 report recommended that a provision of the Fine Arts Copyright Act giving "artists a measure of protection against unauthorized alteration of their drawings or the fraudulent affixing of signatures to them" be extended to "literary and musical works." *Id.* at 977.

⁴⁰ See, e.g., *id.* at 977 n.71 (describing a Swiss case upholding the right of privacy for an artist's widow and another case recognizing protection for an "artist's personal honor" but not "artistic reputation"). Swiss law of this period was not unique for its use of general civil law provisions this way. In China, the right of attribution can currently be exercised under specific provisions of the copyright law *or* the general civil law principle that everyone has the right to protect his or her name. In a celebrated case in the 1990s, the writer Jia Pingao used the general civil law provisions to successfully sue a publisher who had misattributed a novel to Jia. Xue Hong & Guo Shoukang, *China*, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at CHI-57 to CHI-58 (Paul Edward Geller ed., 2006).

⁴¹ Strauss, *The Moral Right of the Author*, *supra* note 22, at 977–78.

⁴² Nimmer, *supra* note 1, at 518.

⁴³ *Id.* at 522.

patchwork of rules, albeit a highly theorized one”⁴⁴ and that statutory moral rights regimes in the United States and United Kingdom “have likely reduced rather than increased the aggregate level of authorial protection”⁴⁵ compared to the patchworks that preceded conscious efforts to address the moral rights problem.

A. *How the Gilliam Decision Made this Credible*

All this commentary before U.S. accession to Berne was not purely speculative. Clever lawyering had produced moral rights—like protection from existing causes of action in a handful of cases in the 1940s, 50s, and 60s.⁴⁶ Indeed, by 1985, Professor Roberta Rosenthal Kwall could credibly note that “[t]he increasingly liberal applications of unfair competition law generally and § 43(a) of the Lanham Act in particular” had made these causes of action popular “vehicles for redressing alleged violations of interests protected elsewhere by the right of integrity and paternity.”⁴⁷

⁴⁴ Cyrill P. Rigamonti, *Deconstructing Moral Rights*, 47 HARV. INT’L. L.J. 353, 412 (2006).

⁴⁵ *Id.* at 355.

⁴⁶ See *Autry v. Republic Prods.*, 213 F.2d 667, 669 (9th Cir. 1954) (holding that sufficiently severe editing of film could undermine artist’s work); *Granz v. Harris*, 198 F.2d 585, 588–89 (2d Cir. 1952) (finding that sale of abbreviated jazz recordings without producer’s permission constituted breach of contract or the tort of unfair competition); *Carroll v. Paramount Pictures*, 3 F.R.D. 95, 96 (S.D.N.Y. 1942) (holding that false imputation of an inferior work to a producer is libelous per se); *Stevens v. NBC*, 148 U.S.P.Q. 755, 758 (Cal. Super. Ct. 1966) (enjoining the broadcast of an edited version of *A Place in the Sun*); see also *Smith v. Montoro*, 648 F.2d 602, 603, 608 (9th Cir. 1981) (finding violation of § 43(a) of Lanham Act for “reverse passing off” where actor who appeared in the film *Convoy Buddies* had his name replaced).

One could complain that even when artists prevail in these actions, the court’s reasoning shows that moral rights are not being provided. For example, in *Smith v. Montoro*, the Ninth Circuit held that the substitution of one actor’s name for that of another in a film’s credits was improper because “being accurately credited for films in which they have played would seem to be of critical importance in enabling actors to sell their ‘services,’ i.e., their performances.” 648 F.2d at 607. But an actual right of attribution would apply regardless of any economic effect. (We will leave to one side the problem that an actor is not considered a true artist in the continental European legal systems with the strongest moral rights.)

⁴⁷ Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 18 (1985) (describing possible causes of action, although finding some deficient); see also Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 354–65 (1988) (discussing how moral rights-like protection might be provided under a compendium of common law causes of action); Comment, *Toward Artistic Integrity: Implementing Moral Rights Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1545–61 (1972) (presenting alternative common law and contract law theories to protect the same rights that paternity and integrity protect). But see, e.g., Merryman, *supra* note 21 (critiquing “moral rights equivalents” arguments).

This observation about "increasingly liberal application" of the Lanham Act to protect moral rights was anchored in the Second Circuit's 1976 decision in *Gilliam v. ABC, Inc.*⁴⁸ Indeed, no case gave more credence to the patchwork idea than *Gilliam*, a case in which members of Britain's Monty Python comedy troupe sought to stop ABC from broadcasting bowdlerized versions of *Monty Python's Flying Circus*.⁴⁹ The shows were written and taped by Monty Python.⁵⁰ By contract, the BBC was allowed to make only "minor alterations" and such changes "as in its opinion are necessary in order to avoid involving the BBC in legal action or bringing the BBC into disrepute."⁵¹ The same agreement further—and critically—provided that "subject to the terms therein, the group retains all rights in the script."⁵²

The BBC subsequently licensed U.S. broadcasting rights for the recorded Monty Python shows to Time-Life, who in turn licensed them to ABC.⁵³ ABC cut 24 minutes from 90 minutes of the original comedy skits in order to make room for commercials and remove material that ABC deemed objectionable.⁵⁴ When the Monty Python writers saw the 27% leaner ABC version, they were "appalled."⁵⁵

Monty Python's claims against ABC were a cocktail of copyright infringements, breach of contract, and a "false light" unfair competition claim—two of these being central to the "patchwork" argument.⁵⁶ The Second Circuit reversed the district court's denial of Monty Python's motion to enjoin ABC from broadcasting the edited programs. First, the court ruled that Monty Python was likely to succeed on a derivative-work claim against ABC.⁵⁷ Because the troupe had reserved all rights to the Monty Python scripts except those expressly granted to the BBC, each BBC show was a derivative work on a script that still belonged to Monty Python; the substantial editing for ABC's special made the ABC show a derivative work of the BBC shows and, therefore, also a second-generation derivative-work of the Monty Python scripts. The court concluded that vis-à-vis

⁴⁸ 538 F.2d 14 (2d Cir. 1976).

⁴⁹ *Id.* at 17.

⁵⁰ *Id.* at 17 n.2, 22.

⁵¹ *Id.* at 17 n.2.

⁵² *Id.* at 17.

⁵³ *Id.* at 17–18. The BBC/Time-Life agreement allowed the latter to "edit the programs only 'for insertion of commercials, applicable censorship or governmental . . . rules and regulations'" and for National Association of Broadcasters requirements. *Id.* at 18. Of course, the BBC probably did not even have the authority to grant this limited editing right to Time-Life since insertion of commercials and addressing U.S. censorship would not be needed to keep the BBC out of legal action absent some preexisting duty to Time-Life. And it would make no sense to interpret the contractual provision so as to allow the BBC to use the subsequent contractual obligations to argue that they were permitted to do such editing under the BBC/Monty Python contract.

⁵⁴ *Id.* at 18.

⁵⁵ *Id.*

⁵⁶ *Id.* at 24.

⁵⁷ *Id.* at 19, 23.

the BBC shows, the ABC shows were authorized derivative works, but vis-à-vis the Monty Python scripts, the ABC shows were wholly unauthorized.⁵⁸

The court then went on to consider whether Monty Python had stated a cause of action under the Lanham Act.⁵⁹ While acknowledging in 1976 that “American copyright law, as presently written, does not recognize moral rights,”⁶⁰ Judge Lumbard concluded that it was possible that ABC’s editing “mutilated the original work and that consequently the broadcast of those programs *as the creation* of Monty Python violated the Lanham Act.”⁶¹ According to Lumbard’s reasoning, ABC’s attributing the ninety minute shows to Monty Python was “a representation [that] . . . although technically true, creates a false impression of the product’s origin.”⁶² In other words, Monty Python could prevail on a Lanham § 43(a) cause of action based on a misattribution claim.

Gilliam’s direct progeny was limited in the courts, but its reasoning was respected, if not controlling, in a number of cases. For example, finding against a copyright licensee for having exceeded permissible derivations from the original work, a 1980 Texas district court cited *Gilliam* for the proposition that “an author should have control over the context and manner in which his or her work is presented.”⁶³ *Gilliam* was similarly cited by the D.C. Circuit in its 1988 *Community for Creative Non-Violence v. Reid* decision for the proposition that the artist in that case “may have rights against [plaintiff] should it publish an excessively mutilated or altered version” of the artist’s work.⁶⁴ And, of course, in the Second Circuit, courts accepted the *Gilliam* approach even when they found that an editor, publisher, or broadcaster’s actions did not rise to the level of actionable *Gilliam* distortion or misrepresentation. In *King v. Innovation Books*, the Second Circuit confirmed that “a false reference to the origin of a work, or a reference which, while not literally false, is misleading or likely to confuse”⁶⁵ was grounds for a Lanham Act § 43(a) claim, but the court concluded that a credit that the derivative work was “based upon” Stephen King’s short story was not

⁵⁸ *Id.* at 19 (“Appellants first contend that the question of ownership is irrelevant because the recorded program was merely a derivative work taken from the script in which they hold the uncontested copyright. Thus, even if BBC owned the copyright in the recorded program, its use of that work would be limited by the license granted to BBC by Monty Python for use of the underlying script. We agree.”). Later the court noted that “[s]ince the copyright in the underlying script survives intact despite the incorporation of that work into a derivative work, one who uses the script, even with the permission of the proprietor of the derivative work, may infringe the underlying copyright.” *Id.* at 20.

⁵⁹ *Id.* at 24.

⁶⁰ *Id.*

⁶¹ *Id.* (emphasis added).

⁶² *Id.*

⁶³ *Nat’l Bank of Commerce v. Shakelee Corp.*, 503 F. Supp. 533, 544 (W.D. Tex. 1980).

⁶⁴ 846 F.2d 1485, 1498–99 (D.C. Cir. 1988), *aff’d*, 490 U.S. 730 (1989).

⁶⁵ 976 F.2d 824, 828 (2d Cir. 1992).

misleading in the way a possessory credit—for instance, "Stephen King's Lawnmower Man"—would have been.⁶⁶

With its double-barrel derivative work and Lanham Act rationales, it is easy to see how *Gilliam* became a darling of the moral rights contingent. Inspired by *Gilliam*, many commentators have opined on how and when § 43(a) of the Lanham Act could be used by authors and artists to safeguard their right of attribution.⁶⁷ And all this seemed consistent with the intent of the 1976 Copyright Act. The copyright statute expressly provides that it does not limit any other federal cause of action,⁶⁸ while the legislative history of the 1976 Act expressly states that it would not preempt a state law cause of action for misattribution of an audiovisual work.⁶⁹ In a post-*Gilliam* world—including the moment when the Berne Convention was ratified—the patchwork did not look so bad.

B. The Patchwork Thickens

In the years following 1988, the patchwork of protection grew thicker. In 1990, Congress passed the Visual Artists Rights Act (VARA),⁷⁰ establishing § 106A of the Copyright Act, a straightforward moral rights provision for works of fine art. Section 106A creates rights of attribution and integrity that (a) belong to the author of the work "whether or not the author is the copyright owner"⁷¹ and (b) "endure for the term consisting of the life of the author."⁷² The moral rights created by VARA are not quite coextensive with those established by Berne Article 6bis.

The first and most obvious problem is an odd relationship between the term of moral rights required in Article 6bis and the term of moral rights created by

⁶⁶ *Id.* at 831; see also *Choe v. Fordham Univ. Sch. of Law*, 920 F. Supp. 44, 48 (S.D.N.Y. 1995) (noting that Choe's allegation of mutilation "pales" in comparison to the actionable editing in *Gilliam* and other cases); *Considine v. Penguin, U.S.A.*, No. 91 Civ. 4405, 1992 WL 183762, at *4 (S.D.N.Y. July 20, 1992) (stating that the *Gilliam* reasoning was more appropriate where "the mangling of the artist's work was more flagrant than in the case before us, or the misrepresentation of the artist's role in producing the material was more outrageous").

⁶⁷ See, e.g., Marie V. Driscoll, *The "New" 43(a)*, 79 TRADEMARK REP. 238, 243–44 (1989); Diana Elzey Pinover, *The Rights of Authors, Artists, and Performers Under Section 43(a) of the Lanham Act*, 83 TRADEMARK REP. 38, 48 (1993); Randolph Stuart Sergeant, *Building Reputational Capital: The Right of Attribution Under Section 43 of the Lanham Act*, 19 COLUM.-VLA J.L. & ARTS 45, 57 (1995).

⁶⁸ 17 U.S.C. § 301(d) (2006).

⁶⁹ H.R. REP. NO. 94-1733, at 78 (1976) (Conf. Rep.), reprinted in 1976 U.S.S.C.A.N. 5810, 5819.

⁷⁰ Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5128 (1990) (codified as 17 U.S.C. § 106A (2006)).

⁷¹ 17 U.S.C. § 106A(b). The separateness of the rights is further elaborated in § 106A(e)(2).

⁷² 17 U.S.C. § 106A(d)(1). Section 106A(d)(2) actually provides for *longer* moral rights for a work that was created before VARA where the artist still holds the copyright to that work. For those works, the moral rights are coterminous with the § 106 rights.

VARA. Berne Article 6*bis* requires that moral rights “shall, after [the author’s] death, be maintained at least until the expiry of the economic rights.”⁷³ But it then creates an exception for countries whose “legislation, at the moment of their ratification or accession to this Act, does not provide for the protection after the death of the author of all the rights set out in the preceding paragraph.”⁷⁴ Such countries “may provide that *some* of these rights may, after [the author’s] death, cease to be maintained.”⁷⁵ A reasonable reading of this odd provision is that when a country codifies moral rights—as France and the United Kingdom did *after* Berne accession—the country can allow one, but not both, of the Article 6*bis* rights to expire on the author’s death. For works created after VARA’s effective date, June 1, 1991, § 106A rights of both attribution and integrity expire on the author’s death.⁷⁶ This means that VARA, by itself, is not a Berne-compliant moral rights regime for works of fine art.

There are other, subtler ways VARA is probably not coextensive with what Article 6*bis* requires. For example, § 106A(a)(3)(A) seems to establish an irrebuttable presumption that “*any* intentional distortion, mutilation, or . . . modification of [a] work” is “prejudicial [to the artist’s] honor or reputation.”⁷⁷ Because not every distortion is prejudicial to an artist’s honor or reputation, this VARA provisions arguably goes beyond what Berne Article 6*bis* requires. On the other hand, if a distortion or mutilation is not intentional, VARA offers no protection, while Berne Article 6*bis* is not limited to intentional acts.⁷⁸

But the real problem with VARA is not the strength of its provisions, but their limited scope. Section 106A creates moral rights only for “works of visual art,” defined as a painting, photograph, sculpture, drawing, or print that exists in a single copy or a “limited edition of 200 copies or fewer” that are individually signed by the artist.⁷⁹ The legislation, according to one of its co-sponsors, “covers only a very select group of artists.”⁸⁰ Moreover, it covers only the original.⁸¹

⁷³ Berne Convention, *supra* note 3, at art. 6*bis*(2).

⁷⁴ *Id.*

⁷⁵ *Id.* (emphasis added).

⁷⁶ See GOLDSTEIN, INTERNATIONAL COPYRIGHT, *supra* note 4, at 284 n.789.

⁷⁷ 17 U.S.C. § 106A(a)(3)(A) (emphasis added).

⁷⁸ Another small example: § 106A(a)(3)(B) gives the artist the right to “prevent any destruction of a work of recognized stature,” including “grossly negligent destruction,” but Article 6*bis* is only concerned with destruction that is prejudicial to the artist’s honor or reputation. One could argue that VARA is only superficially different from 6*bis* on this count since destruction of “a work of recognized stature” will almost certainly be detrimental to the artist’s reputation.

⁷⁹ 17 U.S.C. § 101 (2006) (definition of a “work of visual art”). The definition has slightly different descriptions for different types of art. A limited edition print, drawing, or photograph must be “signed and consecutively numbered by the author,” while a sculpture cast in two hundred copies or less must “bear the signature or other identifying mark of the author.” *Id.*

⁸⁰ H.R. REP. NO. 101-514, at 11 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6915, 6921 (quoting Rep. Edward Markey); *see also id.* at 6919 (stating that the Congressional debate “revealed a consensus that the bill’s scope should be limited to certain carefully defined

Imagine that an artist sells a VARA-covered sculpture to be installed in a building foyer and the building developer commissions a photographer to produce a quality postcard of the sculpture. If the postcard fails to credit the sculptor, there is no VARA cause of action. If the postcard distorts the sculpture, there is also no VARA cause of action. As Professor Jane Ginsburg puts it colorfully, VARA “reach[es] only the slasher”—someone who distorts the *original* of the work of fine art.⁸²

Thus, VARA put a steel plate into the patchwork—establishing explicit, roughly Berne-compliant moral rights for the original copy in the classical fine arts⁸³—while inevitably accentuating the lack of such rights for other expressive works. On this count, one could criticize VARA as a kind of half-way, checkerboard approach lacking the integrity that gives legitimacy to legislation.⁸⁴ And yet first addressing moral rights for works of fine art made some sense and, as in many policy areas such as health care, environmental protection, and voting rights, surely incremental improvement is better than none at all.

The 1998 Digital Millennium Copyright Act (DMCA) also made an incremental, if unintentional, addition to the patchwork.⁸⁵ Article 12 of the 1996 World Intellectual Property Organization (WIPO) Copyright Treaty (WCT) requires treaty countries to prohibit the removal or alteration of “electronic rights management information” when the actor knows or reasonably should know that the removal or alteration “will induce, enable, facilitate, or conceal an infringement of any right covered by this Treaty or the Berne Convention.”⁸⁶ Section 1202 of the U.S. Copyright Act implements this obligation, broadening the WCT’s “electronic rights management information” into “copyright management information” (CMI) and applying the prohibition on removal or alteration of the information to all physical media or digital copies.⁸⁷

types of works and artists, and that if claims arising in other contexts are to be considered, they must be considered separately”).

⁸¹ 17 U.S.C. § 102(a).

⁸² Jane C. Ginsburg, *Have Moral Rights Come of (Digital) Age in the United States?*, 19 CARDOZO ARTS & ENT. L. J. 9, 11 (2001) [hereinafter Ginsburg, *Have Moral Rights Come of Age*].

⁸³ Or the first two hundred copies in the case of prints. 17 U.S.C. § 106A.

⁸⁴ RONALD DWORKIN, *LAW’S EMPIRE* 176–224 (1986).

⁸⁵ Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended in scattered sections of 17 U.S.C.).

⁸⁶ WIPO Copyright Treaty (WCT) art. 12, Dec. 20, 1996, S. TREATY DOC. NO. 105-17 (1997), 36 I.L.M. 65, available at http://www.wipo.int/treaties/en/ip/wct/pdf/trtdocs_wo033.pdf. There is a parallel provision in the WIPO Performances and Phonograms Treaty (WPPT), Dec. 20, 1996, S. TREATY DOC. NO. 105-17 (1997), 36 I.L.M. 76, available at http://www.wipo.int/treaties/en/ip/wppt/pdf/trtdocs_wo034.pdf.

The Diplomatic Conference on Certain Copyright and Neighboring Rights Questions in Geneva adopted both treaties on Dec. 20, 1996, available at <http://www.copyright.gov/wipo/100dc.html> (last visited Nov. 28, 2007).

⁸⁷ 17 U.S.C. § 1202(c) (including “copies or phonorecords . . . including in digital form” within the definition of CMI).

CMI can include “[t]he name of, and other identifying information about, the author of the work.”⁸⁸ When it does, this often provides a kind of right of attribution,⁸⁹ particularly because “[a]ny person injured by a violation of [§ 1202] may bring a civil action in an appropriate United States district court,”⁹⁰ i.e., the cause of action is not limited to the copyright holder. Nonetheless, there are a couple wrinkles in § 1202 providing a right of attribution.

First, what counts as CMI depends on what “information [is] conveyed in connection with copies or phonorecords of a work or performances or displays of a work,” presumably meaning the initial authorized publication, distribution, or performances.⁹¹ In the initial release, the copyright holder does not have to include any CMI or might decide not to include the name of the author. More generally, because the CMI content would be decided by the copyright holder, § 1202 does nothing for the author vis-à-vis the copyright holder, a common fact pattern in attribution disputes. Second, even if the CMI includes the name of the author, the erasure or alteration of the author’s name is only actionable if the eraser reasonably should have known that the result “will induce, enable, facilitate, or conceal an infringement.”⁹² So far, we have no case law interpreting § 1202, so the facilitate/conceal standard could be very low or very high. Practically speaking, since most publishers do indicate the names of authors,⁹³ § 1202 will generally establish liability against third-party copiers for authorial nonattribution or misattribution as long as the facilitate/conceal standard is not too strict.⁹⁴

⁸⁸ 17 U.S.C. § 1202(c)(2).

⁸⁹ Hughes, *supra* note 5, at 21.

⁹⁰ 17 U.S.C. § 1203(a).

⁹¹ 17 U.S.C. § 1202(c).

⁹² Ginsburg, *Have Moral Rights Come of Age*, *supra* note 82, at 12 (quoting WCT, *supra* note 86). Professor Ginsburg has pointed out that this statutory language technically falls short of the WIPO Treaty obligation—precisely because of our “patchwork” argument. *Id.* at 10. She argues that WCT article 12(1) requires us to prohibit any removal of CMI that would enable or facilitate “an infringement of any right covered by this Treaty or the Berne Convention.” *Id.* at 12. Since Berne includes Article 6*bis*, that means we must prohibit any removal of CMI that would facilitate an infringement of moral rights. But our supposed patchwork puts moral rights protection outside copyright law, so § 1202 does not prohibit removal of CMI that would only enable or facilitate violation of 6*bis* moral rights. Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademark Laws*, 41 HOUS. L. REV. 263, 284–85 (2004) [hereinafter Ginsburg, *Right to Claim Authorship*].

⁹³ The statutory list of CMI includes “[s]uch other information as the Register of Copyrights may prescribe by regulation.” 17 U.S.C. § 1202(c)(8). Professor Ginsburg has suggested that, in the case of works made for hire, the Register could require the names of the contributors to be included. *See* Ginsburg, *Have Moral Rights Come of Age*, *supra* note 82, at 15. This is an intriguing suggestion, but it also opens a larger can of worms. With works for hire, the employer is the author under American law, and the contributors are not authors at all.

⁹⁴ Section 1202(c) does create some exemptions from a right of attribution. 17 U.S.C. § 1202(c) (2006). Under § 1202(c)(4), radio and television broadcasters do not have to provide information about performers of musical compositions when the recorded music is

Beyond these two statutory additions to the patchwork, in the post-1988 period there was what Judge Posner characterized as "glimmers" and "creepings" of moral rights making their way into American law.⁹⁵ On the other hand, Judge Leval—and later Judge Easterbrook—have found themselves holding the fort against the advance of judge-created moral rights.⁹⁶ Easterbrook's role came in the A.R.T. cases, an inconclusive set of skirmishes fought in the late 1980s and early 1990s over whether a purchaser of copies of an artwork could affix those copies to ceramic tiles and resell the tiles.⁹⁷

In the 1988 *Mirage Editions v. Albuquerque A.R.T. Co.* case, the defendant had taken artwork from pages of a commemorative book of Patrick Nagel's art and mounted each image on a ceramic tile with a protective film over the image and exposed tile surface.⁹⁸ In *Munoz v. Albuquerque A.R.T.*, the same defendant engaged in the same mounting activities vis-à-vis notecards carrying the Alaska-themed art of artist Rie Munoz.⁹⁹ In both cases, the Ninth Circuit found that

broadcast; under §1202(c)(5), only the "writer, performer, or director who is credited in [an] audiovisual work" forms part of the CMI when a television station broadcasts a film or television show. The Nimmer treatise discusses "influence during the lobbying process," and points out that cable and Internet stations do not enjoy the 1202(c) limitations. NIMMER ON COPYRIGHT, *supra* note 27, at § 12A.09[A][1]. Although these exceptions may need to be written more widely than they are now drafted, they make sense. A television station cannot be expected to run the three minutes of credits that commonly follow a feature film; a radio station cannot announce all the detailed information found in a CD jewel box. If anything, the § 1202(c)(4) and (5) exceptions point out the work that needs to be done in figuring out what should count as basic CMI that must be carried through different media and delivery channels.

⁹⁵ See *Seshardi v. Kasraian*, 130 F.3d 798, 803–04 (7th Cir. 1997) ("[T]here are glimmers of the moral-rights doctrine in contemporary American copyright law."); *Ty, Inc. v. GMA Accessories*, 132 F.3d 1167, 1173 (7th Cir. 1997) (stating that preliminary injunction "draws additional sustenance from the doctrine of 'moral rights' . . . a doctrine that is creeping into American copyright law"). Posner's remarks, like the mention of moral rights in *Gilliam* itself, seem the sort of jurisprudential musings intended to "stimulate informed commentary" and "provoke future consideration of emerging issues." *United States v. Oshatz*, 912 F.2d 534, 540 (2d Cir. 1990). This understanding of moral rights language in federal case law was suggested by Judge Michael Mukasey in *Choe v. Fordham University School of Law*, 920 F. Supp. 44, 49 (S.D.N.Y. 1995) ("There is no federal claim for violation of Plaintiff's alleged 'moral rights' . . . such emergence should occur in the first instance, if at all, at the circuit level, and not in this court.").

⁹⁶ Pierre N. Leval, *Commentaries: Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1128–29 (1990) (arguing against development of moral rights in copyright law and that "[i]f we wish to create such rights for the protection of artists, we should draft them carefully as a separate body of law, and appropriately define what is an artist and what is a work of art").

⁹⁷ See *Lee*, 125 F.3d at 582–83.

⁹⁸ See *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1342 (9th Cir. 1988). The artworks were single pages taken from *NAGEL: THE ART OF PATRICK NAGEL* (Jeffery Book ed., 1985).

⁹⁹ See *Munoz v. Albuquerque A.R.T.*, 829 F. Supp. 309, 310–311 (D. Alaska 1993).

mounting an artwork to a ceramic tile produced a new derivative work in which the original artwork had been “recast, transformed, or adapted.”¹⁰⁰ In the 1993 *Munoz* case, the district court expressly recognized that while variations in traditional means of framing art do not create derivative works, the ceramic tiles were derivative works because they permanently bound the art to a new medium.¹⁰¹

A few years later, Judge Easterbrook faced the same basic fact pattern and reached the opposite result in *Lee v. A.R.T. Co.*, concluding that the ceramic tiles with epoxy affixed prints lacked “editorial revision, annotations, elaborations, or other modifications”; thus, the tiles were not “original work[s] of authorship”; and, thus, the tiles were not derivative works.¹⁰² Whatever the pro-artist inclinations of his Ninth Circuit brethren, Judge Easterbrook was very clear that he was unwilling to see the derivative-work right as a “back door [for] an extraordinarily broad version of authors’ moral rights.”¹⁰³

The tension in the A.R.T. cases is nothing new. It is found in the contrast between two classic cases commonly taught copyright students. In *Fawcett Publications v. Elliot Publishing*, the defendant bound together multiple second-hand comic books (with different storylines and different copyright owners), and resold them as “Double Comics.”¹⁰⁴ The court concluded that this was permissible because “[t]he exclusive right to vend is limited. It is confined to the first sale of any one copy and exerts no restriction on the future sale of that copy.”¹⁰⁵ Contrast this thinking with the earlier case of *National Geographic Society v. Classified Geographic* in which National Geographic succeeded in stopping the defendant from purchasing copies of the magazine, tearing up the magazines, bringing together articles of the same subjects (horses, birds, fish), and reselling these newly rebound thematic compilations.¹⁰⁶ Conceding that the defendant owned the physical copies of the articles, the court still found that these activities violated the derivative-work right to control compilations, adaptations, and new arrangements of the copyrighted material.¹⁰⁷

In contrast to *Fawcett Publications*, *National Geographic* and the A.R.T. cases, in *Gilliam* the distorted/mutilated work at issue was a different copy than what Monty Python transferred to the BBC. So in *Gilliam* the derivative-work right was not impeded by a first sale in its control of downstream integrity. All this suggests that in present American law, the existence of a right of integrity within copyright law can be understood this way:

¹⁰⁰ *Id.* at 314. See *Mirage Editions*, 856 F.2d at 1343–44.

¹⁰¹ *Munoz*, 829 F. Supp. at 314.

¹⁰² 125 F.3d at 581–83.

¹⁰³ *Id.* at 582. Perhaps to assuage this concern, Ms. Lee had “disclaimed any contention that the sale of her works on tile ha[d] damaged her honor or reputation.” *Id.* at 583.

¹⁰⁴ 46 F. Supp. 717, 718 (S.D.N.Y. 1942).

¹⁰⁵ *Id.* at 718.

¹⁰⁶ 27 F. Supp. 655, 657–62 (D. Mass. 1939).

¹⁰⁷ *Id.* at 659.

Table 1: The Right of Integrity

	Original Copy of Work	Additional Copies of Work
Work of Fine Art	VARA	No VARA Derivative Work Right [if author has ©]
All Other Works	Derivative Work Right [if author has ©] <i>has to battle</i> First Sale Doctrine	Derivative Work Right [if author has ©]

Table 1 substantiates Andre Lucas’s comment from a French perspective that “by exploiting all the resources of economic rights, in particular the right of adaptation, American law can partly compensate for the absence of specific moral rights.”¹⁰⁸ And this substantial interplay between the derivative work right and the moral right of integrity is hardly unique to American copyright law. For example, in *Konami K.K. v. Ichiro Komami*, the Tokyo District Court found the right of integrity in an audiovisual work had been violated by the defendant’s derivative audiovisual work.¹⁰⁹ Plaintiff Konami was the creator of a videogame “simulat[ing] life at ‘Kirameki High’ for a Japanese boy” and featuring, as its principal character, an attractive female student named Shiori Fujisaki.¹¹⁰ The defendant created and distributed a work that lifted the Shiori Fujisaki character—in visual appearance, not name—and “portray[ed] her engaged in sexual conduct as a form of adult entertainment.”¹¹¹ The court concluded that “the defendant ha[d] violated the plaintiff’s right to preserve the integrity of the work by portraying the plaintiff’s character in a context where she is performing sex acts.”¹¹² In short, the case uses the right of integrity to control a derivative work—the converse of the result in *National Geographic*, *Gilliam*, and the *A.R.T.* cases.

¹⁰⁸ LUCAS & LUCAS, *supra* note 4, at 303 (“C’est d’ailleurs en exploitant toutes les ressources des droits patrimoniaux, notamment du droit d’adaptation, que le droit américain peut compenser en partie l’absence de droit moral spécifique.”) (internal citations omitted).

¹⁰⁹ See Konami, 1696 HANREI JIHŌCHI, 145 (Tokyo Dist. Ct., Aug. 30, 1999), translated in Kenneth L. Port, *Japanese Intellectual Property Law in Translation: Representative Cases and Commentary*, 34 VAND. J. TRANSNAT’L L. 847, 852–53 (2001).

¹¹⁰ Port, *supra* note 109, at 849.

¹¹¹ *Id.* at 850.

¹¹² *Id.* at 853. Kenneth Port has pointed out some of the peculiar aspects of this case, including that it seems to center around damages over “the reputation of a cartoon character.” *Id.* at 855.

IV. THE BROAD *DASTAR* DECISION AND ARTICLE 6BIS

The Supreme Court's *Dastar* opinion unquestionably changed our understanding of the Lanham Act's coverage and, accordingly, the moral rights topography of American law. I hope to convince the reader that the *Dastar* analysis reached the right result, but that the Court's opinion both rests on completely unproven assumptions about consumer expectations and produces an unstable result. This section will also discuss how the Court missed an opportunity to draw a simple, bright line that would have protected copyright's policy of a robust public domain while allowing the Lanham Act to do the same Article 6bis right of attribution work that it had previously done. In this sense, as Graeme Austin has observed, the Court failed to adhere to the basic principle of judicial interpretation that "acts of Congress should never be construed to violate international laws if another interpretation is available."¹¹³ Nonetheless, we will also see that the damage done to the "patchwork" may or may not be as great as some think.

The *Dastar* case is familiar to many readers of this article. In the late 1940s, Time, Inc. produced a television series based on Dwight Eisenhower's book *Crusade in Europe*.¹¹⁴ The television series used narration based on the book and footage from several Allied sources.¹¹⁵ The copyright assignee, Twentieth Century Fox (Fox), failed to renew copyright and the series lapsed into the public domain in 1977.¹¹⁶ Presumably conscious of their lost copyright in the television series, Fox relicensed the television rights to the Eisenhower book in 1988.¹¹⁷ That effectively protected them from any nontransformative reproduction, distribution, or public performance of the television series.¹¹⁸ On the fiftieth anniversary of the end of World War II, Dastar released a low-priced video set called *World War II Campaigns in Europe (Campaigns)*, made by shortening and remixing the now public-domain television series.¹¹⁹

Dastar substituted a new opening sequence, credit page, and final closing for those of the *Crusade* television series; inserted new chapter-title

¹¹³ Graeme W. Austin, *The Berne Convention as a Canon of Construction: Moral Rights after Dastar*, 61 N.Y.U. ANN. SURV. AM. L. 111, 111–12 (2005).

¹¹⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 25–26 (2003).

¹¹⁵ *Id.* at 26.

¹¹⁶ *Id.*

¹¹⁷ *Id.*; see also Brief for the United States as Amicus Curiae Supporting Petitioners at 2, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02-428), 2003 WL544536 [hereinafter United States Amicus Brief] (discussing respondents "exclusive right to distribute the *Crusade* television series on video, and to sublicense others to do so").

¹¹⁸ See *Dastar*, 539 U.S. at 26. In other words, as long as the *Crusade* television series was a derivative work on the book and Fox had the exclusive license to broadcast or distribute any television derivative works on the book, Fox could stop someone from distributing or broadcasting the *Crusade* show proper.

¹¹⁹ *Id.* at 26–27.

sequences and narrated chapter introductions; moved the “recap” in the Crusade television series to the beginning and retitled it as a “preview”; and removed references to and images of the book. Dastar created new packaging for its Campaigns series and (as already noted) a new title.¹²⁰

Dastar then marketed the video set as its own product, making reference to neither the Fox series nor the Eisenhower book.¹²¹

Fox brought suit against Dastar alleging copyright infringement of its rights to the Eisenhower book and reverse passing off of the origin of the television series in violation of § 43(a) of the Lanham Act.¹²² The trial court granted summary judgment for Fox on both claims.¹²³ The Ninth Circuit reversed on the copyright issues, but affirmed judgment for Fox on the reverse-passing-off claim.¹²⁴ The Ninth Circuit concluded that Dastar’s “label[ing] the resulting product with a different name and . . . without attribution to Fox” constituted a “bodily appropriation” of the Fox series “sufficient to establish reverse passing off.”¹²⁵ The Supreme Court granted certiorari to resolve the scope of § 43(a) of the Lanham Act in regards to a previously copyrighted work that has fallen into the public domain.¹²⁶

Section 43(a) is a complex provision, offering two possible prongs of liability. The first, § 43(a)(1)(A), creates liability where:

A false designation of origin, false or misleading description of fact, or false or misleading representation of fact . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person¹²⁷

¹²⁰ *Id.*

¹²¹ *Id.* at 27.

¹²² *Id.* at 27, 29. The suit was brought under 15 U.S.C. § 1125(a)(1)(A) (2006). *See Dastar*, 539 U.S. at 27, 36. Fox also sued Dastar for reverse passing off under state unfair competition law, but the trial court folded resolution of the state law claims into the Lanham Act analysis, and the Ninth Circuit was silent on the issue. *Id.* at 27–28.

¹²³ *Id.*

¹²⁴ *Id.* at 28.

¹²⁵ *Id.* (quoting *Twentieth Century Fox Film Corp. v. Entm’t Distrib.*, 34 Fed. App’x 312, 316 (9th Cir. 2002)).

¹²⁶ *See Dastar*, 539 U.S. at 31 (“At bottom, we must decide what § 43(a)(1)(A) of the Lanham Act means by the ‘origin’ of ‘goods.’”).

The United States’ amicus brief described the question before the Court more broadly as “[w]hether and to what extent the Lanham Act, 15 U.S.C. 1125(a), prevents the uncredited copying of a work.” United States Amicus Brief, *supra* note 117, at *1.

¹²⁷ Trademark (Lanham) Act of 1946 § 43(a)(1), Pub. L. 79-489, 60 Stat. 441 (current version at 15 U.S.C. § 1125(a)(1) (2006)). In full, §43(a) of the Lanham Act, as amended, now provides:

We will turn shortly to the complexity which results from embedding so many terms into this provision. The second prong, § 43(a)(1)(B) does not require a likelihood of confusion, but is limited to advertising or promotion that has a false claim of “origin” or “fact” that “misrepresents the nature, characteristics, qualities, or geographic origin” of the goods.¹²⁸ Without relying on 43(a)(1)(B), Fox’s argument was limited to the claim that Dastar’s labelling of the video set as its own “without acknowledging its nearly wholesale reliance on” the Fox series created a “false designation of origin . . . likely to cause confusion . . . as to the origin” of the goods under § 43(a)(1)(A).¹²⁹

The unanimous *Dastar* opinion begins by framing the question very simply: does “origin” in § 43(a) mean “the manufacturer or producer of the physical ‘goods,’” and/or does it include “the creator of the underlying work”?¹³⁰ If the former, there is no problem in Dastar’s taking all the credit for the video set, because it was the manufacturer. If the latter, then whereas copyright policy seeks the unimpeded use of works in the public domain, the Lanham Act could chill such uses by requiring proper attribution of the origin of public domain materials. There is no statutory definition of “origin” in the Lanham Act and, to complicate matters, the posture of the case depended on a long-standing judicial gloss that § 43(a) also applies to omissions of designation of origin.¹³¹ The Copyright Act itself expressly

-
- (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . ,
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1) (2006).

¹²⁸ *Id.* at § 1125(a)(1)(B).

¹²⁹ *Dastar*, 539 U.S. at 31 (quoting Lanham Act § 43(a)(1)(A)).

¹³⁰ *Id.* Scalia originally suggests that a very restrictive understanding of “origin”—limited to “geographic origin”—was the proper interpretation of the original § 43(a), but recognizes that all circuit courts interpreted the phrase to include “origin of source or manufacture” and Congress confirmed that reading of the statute in 1998. *Id.* at 29–30.

¹³¹ This is typically half of the reverse-passing-off claim: the defendant used their own name and omitted the plaintiff’s name. *See* *Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir. 1981). As David Nimmer notes:

Although it certainly had the opportunity to track *Montoro*’s language in the Trademark Law Revision Act of 1988, Congress declined to do so. Indeed,

provides that it does not limit any other federal cause of action;¹³² the Lanham Act is silent on its relationship to copyright law. Thus, the whole case was framed as being about reconciling trademark law with fundamental copyright policy.¹³³

One available means to reconcile the statutes—a path not taken by the Court—was to allow the § 43(a) cause of action for nonattribution to creative origin to stand, but to correct the Ninth Circuit’s wandering away from a genuine likelihood-of-confusion standard. In a series of cases beginning in 1981, both the Ninth Circuit¹³⁴ and the Second Circuit¹³⁵ permitted likelihood of confusion in the case of expressive works to be shown by similarity of the plaintiff’s and defendant’s products, without the traditional multi-factor test applied in all other Section 43(a) cases. As the amicus brief of the International Trademark Association (INTA) noted, “the Ninth Circuit has never explained why it believes the mere replication of a product, literary or industrial, will likely produce consumer confusion irrespective of the commercial context.”¹³⁶ The Court could have rejected this Ninth Circuit “bodily appropriation” standard, remanded for application of a *Sleekcraft* analysis, and expressed doubt that confusion as to origin is ever likely from a failure to name a prior copyright holder who was never an author of the work.¹³⁷

Congress considered and rejected a proposal to expand section 43(a) to prohibit any “omission of material information.” It rejected that suggestion because it “raised difficult questions [of] freedom of speech.”

Nimmer, *supra* note 8, at 33–34 (citations omitted). Omission of this ‘omissions of material fact’ proposal was also explained in the Senate Report as being because the proposal “could be misread to require that all facts material to a consumer’s decision to purchase a product or service be contained in each advertisement.” S. REP. NO. 100-515, at 41 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5603.

¹³² 17 U.S.C. § 301(d) (2006) (“Nothing in this title annuls or limits any rights or remedies under any other Federal statute.”).

¹³³ Richard Posner has put it bluntly: “[t]he Court based this holding on its belief that the copyright statute itself creates a right to such copying [without attribution].” Richard A. Posner, *Misappropriation: A Dirge*, 40 HOUS. L. REV. 621, 639 (2003).

¹³⁴ *Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994) (stating bodily appropriation “might cause customer confusion”); *Shaw v. Lindheim*, 919 F.2d 1353, 1364 (9th Cir. 1990) (first case to use “bodily appropriation” as a phrase; nonattribution in the form of failure to give writing credit); *Smith v. Montoro*, 648 F.2d 602, 606–07 (9th Cir. 1981) (holding nonattribution and misattribution where the plaintiff actor’s name was removed from film credits and another actor’s name substituted).

¹³⁵ *Waldman Publ’g Corp. v. Landoll, Inc.*, 43 F.3d 775, 784 (2d Cir. 1994).

¹³⁶ Brief of Amicus Curiae The International Trademark Association in Support of Neither Party at *15–16, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02-428), 2003 WL 367725; *see also* United States Amicus Brief, *supra* note 117, at *26–28.

¹³⁷ On this count, the *Dastar* fact pattern gave the Court an easy out. Fox had taken the copyright by assignment; it was not a Fox work for hire. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 25–26 (2003).

But this approach would not have dissipated the cloud of possible Lanham Act claims over public-domain works. Perhaps intentionally ignoring the fact that Fox was only a copyright assignee, the Court believed that Fox's claim interpreted § 43(a) of the Lanham Act as creating a cause of action for, in effect, plagiarism."¹³⁸ On the other hand, if Dastar had credited Fox on the Dastar video set, the kind of credit that would obviate plagiarism/reverse passing off, Fox would still have had a § 43(a) cause of action:

On the one hand, [Dastar] would face Lanham Act liability for *failing* to credit the creator of a work on which their lawful copies are based; and on the other hand they could face Lanham Act liability for *crediting* the creator if that should be regarded as implying the creator's "sponsorship or approval" of the copy.¹³⁹

Fox's ability to jump either way on § 43(a)—suing for nonattribution of origin or suing for misattribution of sponsorship or approval—would chill uses of a work otherwise in the public domain. The Court rejected this interpretation of § 43(a) because it would create a cause of action against "the use of otherwise unprotected words and inventions without attribution."¹⁴⁰

Since the Scylla and Charybdis facing Dastar were two distinct notions within § 43(a)—"origin" and "sponsorship" (or "approval"), one might have thought that the *Dastar* opinion would say more about how the complex wording of section 43(a) is to be construed. The truth is that we have had surprisingly little jurisprudence—from either courts or commentators—trying to unpack all the notions crammed together in § 43(a).¹⁴¹ For example, there are at least sixteen "or"s in § 43(a)(1)(A), producing a liability provision completely unencumbered by clarity.

¹³⁸ *Id.* at 36.

¹³⁹ *Id.*

¹⁴⁰ *Id.* The Court said that this would be "akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do." *Id.* at 37.

¹⁴¹ For example, the McCarthy treatise makes almost no attempt. 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:13, at 27-26 to 27-27 (4th ed. 2007) [hereinafter MCCARTHY ON TRADEMARKS] (showing very limited parsing of a § 43(a)(1)(A) claim without any explanation of various terms). *But see* Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 274-75.

Table 2: The Mess of Section 43(a)

Instrumentality	Caused State of Mind	Nature or Object of the State of Mind
<p><i>Any:</i></p> <ul style="list-style-type: none"> • word, • term, • name, • symbol, • device, • [or any combination thereof], or • false designation of origin, • false or misleading description of fact, • false or misleading representation of fact, • [or omission thereof]; 	<p><i>Which is likely:</i></p> <ul style="list-style-type: none"> • to cause confusion, • to cause mistake, or • to deceive; 	<p><i>As to the:</i></p> <ul style="list-style-type: none"> • affiliation [of such person with another person], • connection [of such person with another person], or • association for such person with another, or • origin, sponsorship, or approval [by another] of the goods, services, or commercial activities.

Table 2 shows an initial untangling of the grammatical thicket of §43(a)(1)(A). Column one of Table 2 shows the instrumentality of a § 43(a) claim, basically divided into two groups: (a) signifiers in the simplest sense—any word or any symbol—and (b) three specific types of false/misleading assertions: false designations of origin, false or misleading descriptions of fact, and false or misleading representations of fact. In addition to the statutory language found in § 43(a), courts have added an additional “or” by including omission on the list of instrumentalities. An instrumentality in the first column causes an error—likelihood of confusion, mistake, or deceit (in the second column) as to some state of affairs (shown in the third column). The state of affairs includes the origin of the goods, but it also includes confusion as to affiliation, connection, or association—of one person with another, or sponsorship or approval—of goods, services, or commercial activities.

Fox’s claim was for “false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . as to the origin . . . of his or her goods.”¹⁴² Notice this claim

¹⁴² *Dastar*, 539 U.S. at 31 (quoting Brief for Respondents at *8, 11, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02–428), 2003 WL 1101321) (emphasis added).

uses origin on both sides, but exclusively so on the state of affairs side. That is the core nature of a passing-off or reverse-passing-off claim: the state of affairs for which confusion has been made probable is the origin of the goods or services.

Untangling § 43(a) helps clarify the damned-if-you-do, damned-if-you-don't argument that seems to put such a chill over public-domain materials. To the degree that *Campaigns'* packaging or screen credits said "DASTAR Corp. presents," or "Produced and Distributed by Entertainment Distributing," there was no § 43(a) offending effect, because these descriptions or representations of fact were true.¹⁴³ Similarly, Fox would not have had a § 43(a) misattribution claim against Dastar if Dastar has labeled their videotape boxes "prepared from materials previously copyrighted by Twentieth Century Fox, who did not approve this video set and is not affiliated with Dastar," that description of fact would have been true also. In other words, the "damned-if-you-do" side is not as potent as the Court makes out.

The real problem is the "damned-if-you-don't" side. The problem arises from our addition of omissions to the § 43(a) instrumentalities list. Including omissions creates labelling duties of unknown scope; this is the Court's how-far-up-the-Nile problem.¹⁴⁴ To avoid a nonattribution claim, would the origin portion of the label have to include Time, Inc.?¹⁴⁵ And all the Allied government agencies whose newsreels had been included?¹⁴⁶ And the unidentified "Newsreel Pool Cameramen"?¹⁴⁷

In its amicus brief on behalf of the United States, the Department of Justice (DOJ) recognized the perpetual protection problem that figured so strongly in the Court's opinion,¹⁴⁸ but properly focused on the liability being generated by nonattribution. The DOJ reasoned that the Ninth Circuit's decision was based on the videotapes being marketed "without attribution to Fox" and therefore the case was only about nonattribution, not misattribution.¹⁴⁹ The DOJ argued that the

¹⁴³ *Id.* at 27 (noting that Entertainment Distributing was an entity owned by Dastar). This made the *Dastar* fact pattern quite distinct from a fact pattern in which there is an active misrepresentation (like a snuff movie marketed as "directed by George Lucas"). See *supra* Part III.A.

¹⁴⁴ *Dastar*, 539 U.S. at 36.

¹⁴⁵ *Id.* at 25–26.

¹⁴⁶ *Id.* (noting that the *Crusade* television series contained "footage from the United States Army, Navy, and Coast Guard, the British Ministry of Information and War Office, [and] the National Film Board of Canada").

¹⁴⁷ *Id.*

¹⁴⁸ See United States Amicus Brief, *supra* note 117, at *6 (arguing that if § 43(a) were construed to "establish a generalized duty on the part of producers to credit the original creators of works" such a construction would "overextend the Lanham Act by giving the original creators of works a perpetual *trademark* right to prevent the uncredited copying of a work."); *id.* at *21 (noting that "the Court should avoid construing the Lanham Act in a manner that would enable creators to extend in perpetuity the protections available to creators for only a limited time under the patent and copyright laws").

¹⁴⁹ *Id.* at *7. So, by the DOJ's lights, Fox's only complaint, in the posture of the case, was for the omission of their name, not the inclusion of Dastar's name, meaning Fox could

Lanham Act protects against (a) claiming credit for someone when no credit is due that person, but not (b) failing to give credit to someone when credit is due that person.¹⁵⁰ When only (b) occurs, the DOJ argued that there is no Lanham cause of action.¹⁵¹

But neither INTA’s nor the DOJ’s arguments would have served the political purpose of the *Dastar* opinion, as the Court’s 2003 Term counterweight to *Eldred v. Ashcroft*.¹⁵² Where *Eldred* accepted Congress’s twenty-year extension of copyright—thereby sharply curtailing what will go into the public domain for decades¹⁵³—*Dastar* shows the Court to be highly protective of the public domain. A decision based on failure to prove likelihood of confusion or narrowly focused on nonattribution would not have given the Court a platform to speak boldly about the public domain. To get that platform for copyright policy, the Court offered us a new, borderline-surreal interpretation of “origin” in § 43(a).

The Court concluded that “the most natural understanding of the ‘origin’ of ‘goods’ . . . is the producer of the tangible product sold in the marketplace” and that “as 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.”¹⁵⁴ Thus, *Dastar* holds that § 43(a) “origin” means the manufacture of the physical product and never means “the person or entity that originated the ideas or communications”¹⁵⁵ embodied or contained in the physical product. *Dastar* “manufactured and sold the set of *Campaigns* videotapes as its own good.”¹⁵⁶ Fox was not involved in any way in the manufacture of the videotapes. This seemed like a remarkably clean way to close the matter, particularly against the view that Fox’s “argument accord[ed] special treatment to communicative products,” although the very examples the Court used

not object when *Dastar* used its own name because that was accurate as to the physical origin of the tapes.

¹⁵⁰ *Id.* at *18, (“[T]he case law does suggest that the Lanham Act does not create a duty of express attribution, but does protect against misattribution.” (quoting *Cleary v. News Corp.*, 30 F.3d 1255, 1260 (9th Cir. 1994))).

¹⁵¹ The DOJ distinguished *Smith v. Montoro* on this ground because it involved the removal of actor Paul Smith’s name from a film’s credits and the substitution of another actor’s name, Bob Spencer, although Spencer did not appear in the film. See United States Amicus Brief, *supra* note 117, at *6 (citing *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981)). The McCarthy treatise similarly notes that *Montoro* “holds only that mis-attribution violations § 43(a), not that the mere removal of a credit created falsity and not that every actor and everyone that worked on a film is entitled under § 43(a) to receive screen credit.” 5 MCCARTHY ON TRADEMARKS, *supra* note 141, § 27:85, at 27-202 to 27-203 (4th ed. 2007). This is also the position taken by the Restatement of Unfair Competition. RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 2–4 (1995).

¹⁵² 537 U.S. 186 (2003).

¹⁵³ *Id.* at 205–06.

¹⁵⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 24 (2003).

¹⁵⁵ *Id.*

¹⁵⁶ United States Amicus Brief, *supra* note 117, at *3.

show that the court was aware its holding applies far beyond the copyright realm.¹⁵⁷

But the line(s) drawn by *Dastar* may not be easy to defend. For example, the Court used VARA to support its limitation on § 43(a) origin.¹⁵⁸ The Court reasoned that interpreting § 43(a) to protect against artistic misattribution and nonattribution would render both the substance and the time limitations of the VARA right of attribution “superfluous.”¹⁵⁹ This would be a fine argument, except that VARA does not involve any likelihood-of-confusion requirement.¹⁶⁰ The VARA 17 U.S.C. § 106A(a)(1)(A) cause of action is a genuine, straightforward nonattribution claim. Indeed, remanding on the grounds that the Ninth Circuit had failed to apply a real likelihood-of-confusion test would have contrasted Lanham § 43(a) with § 106A.

More importantly, the Court tells a strange, strange tale about the psychology of consumers:

[T]he brand-loyal consumer who prefers the drink that the Coca-Cola Company or PepsiCo sells, while he believes that that company produced (or at least stands behind the production of) that product, surely does not necessarily believe that that company was the “origin” of the drink in the sense that it was the very first to devise the formula. The consumer who buys a branded product does not automatically assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product—and typically does not care whether it is.¹⁶¹

Perhaps consumers do not always “automatically” assume that the brand-name company “came up with the idea for the product,” but it is hard to think of worse examples for Scalia’s argument.

There is a robust folklore about the Coca-Cola formula: it was invented by Dr. John Pemberton, who, along with his accountant, also created the Coca-Cola name and classic logo.¹⁶² There is an unbroken line between the persons who devised the formula, name, and logo—all the key ideas—and the modern Coca-Cola corporation. The same with Pepsi, a formula originally concocted by pharmacist Caleb Bradham, who christened it “Pepsi-Cola” and formed the Pepsi Cola

¹⁵⁷ *Dastar*, 539 U.S. at 33; see, e.g., Tom W. Bell, *Misunderestimating Dastar: How the Supreme Court Unwittingly Revolutionized Copyright Preemption*, 65 MD. L. REV. 206, 208 (2006) (observing how the *Dastar* ruling applies to trade secrecy-protected works, patented works, and services).

¹⁵⁸ *Dastar*, 539 U.S. at 34–35.

¹⁵⁹ *Id.* (quoting 17 U.S.C. § 106A(d)(1) (2006)).

¹⁶⁰ See also Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 283 (discussing why “section 43(a) does not make VARA superfluous”).

¹⁶¹ *Dastar*, 539 U.S. at 32.

¹⁶² See generally MARK PENDERGRAST, *FOR GOD, COUNTRY, AND COCA-COLA* (1993).

Company. The Pepsi formula was changed in the 1930s, but, again, by a person who owned the Pepsi Cola Company. And neither company actually produces most of the cola products marketed under their names—almost all the cans and bottle say so. With these products, it is not clear whether “origin” to a consumer would mean manufacturing entity or entity that “came up with the idea.”

Trademarks no longer identify the manufacturing or productive origin of many consumer products today in the sense that products are often physically fabricated in facilities that belong to someone besides the trademark holder. Consider the view in a leading businessperson’s book on intellectual property: “[f]irms such as Coca-Cola and Sara Lee extract the bulk of their IP value (and even their corporate value) from their trademarks. Neither of them is a classic ‘manufacturer.’ Instead, they licence their brand to selected companies who make the actual Coca-Cola or Sara Lee products.”¹⁶³

Ford may still make its own Mustangs and Proctor & Gamble may still make its own Ivory soap, but Apple does not make its own computers;¹⁶⁴ none of the consumer electronics marked “RCA” are made by Radio Corporation of America (which no longer exists); Gap clothes are made in east Asian factories; and most fast food is prepared, on location, by independent franchisees using products from independent fast food chain contractors.¹⁶⁵ What makes a Big Mac a Big Mac is that it is made to McDonald’s Big Mac specifications, McDonald’s being “the very first to devise the [Big Mac] formula.”¹⁶⁶

And it is reasonable—as or more reasonable than Justice Scalia’s assumptions—to believe that a very large percentage of consumers know much of this. Indeed, many large companies that purvey ideas-based products are quite public about others doing the manufacturing. For example, in the Washington, D.C. area, both McDonald’s and Pepsi advertise their local African-American franchisees.¹⁶⁷ When a consumer purchases a Dior dress or a Perry Ellis shirt or a

¹⁶³ JULIE L. DAVIS & SUZANNE S. HARRISON, *EDISON IN THE BOARDROOM* 74 (2001).

¹⁶⁴ Technology companies like Apple, Sun, Cisco, IBM, Dell, and Hewlett-Packard do less and less actual manufacturing these days. Instead, they rely on electronic manufacturing services (EMS) companies like Soletron, Flextronics, Sanmina-SCI, Celestica, and Jabil Circuit (the top five EMS companies). See Bernard Levine, *EMS Elite in Billionaire Club: Soletron Leads Pack with \$16b in 2001 Revenue-Packaging*, *ELECTRONIC NEWS*, May 13, 2002, at 1–2, http://www.findarticles.com/p/articles/mi_m0EKF/is_20_48/ai_86039426 (last visited Nov. 28, 2007). Meanwhile, laptop PCs for Dell, IBM, Apple, Compaq, Gateway, and, probably, Toshiba and Sony, have been made by Quanta—a company most American consumers have never heard of. See Robert Blincoe, *Quanta Laptop Dances in Pole Position*, *THE REGISTER*, November 19, 2001, at 2, http://www.theregister.co.uk/2001/11/19/quanta_laptop_dances_in_pole/ (last visited Nov. 28, 2007).

¹⁶⁵ For a disturbing fictionalized account of a fast food chain’s hamburger patties coming from a contractor, see the film *FAST FOOD NATION* (BBC Films 2006).

¹⁶⁶ See *Dastar*, 539 U.S. at 32.

¹⁶⁷ There are 327 franchisees in the National Black McDonald’s Operators Association with 800 restaurants and \$1 billion in annual sales, facts that McDonald’s

Chanel handbag, is Scalia correct that the consumer does not “assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product”? Is Scalia correct that this consumer “typically does not care whether it is”? Many of us have a different understanding of what consumers expect from branded products: consumers expect that Apple designed its products, expect that Microsoft designed its products, and expect that Perry Ellis, Chanel, and Yves St. Laurent designed their products.¹⁶⁸

Of course, the Justices have some sense of modern brand and trademark licensing. Hence the Court’s locution that the modern consumer “believes that that company produced (or at least stands behind the production of) that product.”¹⁶⁹ The Court repeats this point, acknowledging that the origin of the goods “might be stretched . . . to include not only the actual producer, but also the trademark owner who commissioned or assumed responsibility for (‘stood behind’) production of the physical product.”¹⁷⁰ By the time Scalia has stretched “origin” this far, the term begins to look like “sponsorship” or “approval,” other bases for likelihood of confusion under § 43(a)(1)(A).

In other words, the strict holding of *Dastar* is founded on an unproven empirical claim that we have no good reason to believe. Indeed, survey data shows that most Americans do not believe that McDonald’s restaurants are owned and operated by McDonald’s—meaning they expect that the burger they pick up is not “produced” (in the sense of cooked and prepared) by the trademark holder.¹⁷¹ There is extensive case law that assumes consumers know that providers of some services—franchise businesses—are not the actual trademark holders.¹⁷² To make

publicly trumpets. See <http://www.mcdonalds.com/corp/about/factsheets.html> (follow “Commitment to African-American Community” hyperlink) (last visited Nov. 28, 2007).

¹⁶⁸ I chose those examples intentionally because, of course, Coco Chanel and Perry Ellis are dead. Yves St. Laurent retired from designing. But it is unclear whether expectations are related to the individual person or the “design house,” making Chanel more like Apple. In recent decades, fashion design houses have had no problem trumpeting their new designers, as with Karl Lagerfeld restoring the glamour to Chanel in the 1980s and Tom Ford doing the same for Gucci in the 1990s.

¹⁶⁹ *Dastar*, 539 U.S. at 32.

¹⁷⁰ *Id.* at 31–32.

¹⁷¹ In an early 1990s survey of 307 people, 54.6% believed that most McDonald’s restaurants are “locally and nationally owned and operated.” Robert W. Emerson, *Franchisors’ Liability When Franchisees Are Apparent Agents: An Empirical and Policy Analysis of “Common Knowledge” About Franchising*, 20 HOFTSRA L. REV. 609, 680 (1992). In another survey of 328 college students, when asked “[i]f a fast-food restaurant is a ‘McDonald’s,’ in your opinion does that mean it is owned by the McDonald’s Corporation?” 49.1% of college students said “Probably No” or “Definitely No,” while 5.8% said they “Did Not Know.” *Id.* at 672–73.

¹⁷² As the Florida Supreme Court wrote in 1995, “[i]n today’s world, it is well understood that the mere use of franchise logos . . . does not necessarily indicate that the franchisor has actual or apparent control over any substantial aspect of the franchisee’s business.” *Mobil Oil Corp. v. Bransford*, 648 So. 2d 119, 120 (Fla. 1995). This line of cases extends back to at least 1939; while concentrated on gasoline stations, the reasoning

even this noncorroborated empirical claim sound credible, the court stretches the manufacturing notion of “origin” so that it blends into distinct notions found in § 43(a): sponsorship or approval.

A. Dastar Hurts the Patchwork Where It Was Already Weak

What is the effect of this ruling on the Lanham Act element of our *6bis* composite? To recap, the *6bis* right of attribution has been interpreted as establishing a small constellation of rights:

- (a) the right for the author to be attributed on the author’s own work—that is, a right against nonattribution;
- (b) the right to remain anonymous or use a pseudonym, in relation to (a);
- (c) the right against misattribution, that is, to stop attachment of the author’s name to a work that is not the author’s; and
- (d) the right against misattribution, considered as attachment of another’s name to a work that is the author’s.

One could organize these rights in different ways, but the Berne treaty language foremost secures (a): the right to be attributed and to prevent nonattribution.¹⁷³

But the American patchwork is arranged in the opposite way, offering the surest protection against (c) and (d), which focus on misattribution, while offering

has included car dealerships and hotels. *See, e.g.,* Apple v. Standard Oil, Div. of Am. Oil Co., 307 F. Supp. 107, 114 (N.D. Cal. 1969) (finding it a “matter of common knowledge” that trademarks are displayed by independent dealers (quoting *Reynolds v. Skelly Oil Co.*, 287 N.W. 823, 827 (Iowa 1939))); Wood v. Shell Oil Co., 495 So. 2d 1034, 1039 (Ala. 1986) (noting that the “vast majority” of courts have assumed common knowledge among consumers about independent dealers); Trust Co. of Chi. v. Sutherland Hotel Co., 58 N.E.2d 860, 863 (Ill. 1945) (concerning a Howard Johnson motel, “[i]t is common knowledge that the names by which hotels are known to the public are often those of an individual who has no interest in the management of the business or the ownership of the building”); Reynolds v. Skelly Oil Co., 287 N.W. 823, 827 (Iowa 1939) (rejecting the argument that “because the word ‘Chevrolet’ or ‘Buick’ is displayed in front of a place of business, General Motors would be estopped to claim that it was not the owner of the business. It is a matter of common knowledge that these trademark signs are displayed throughout the country by independent dealers.”); Chevron, U.S.A., Inc. v. Lesch, 570 A.2d 840, 846 (Md. 1990) (noting that a majority of courts have assumed common knowledge among consumers about independent dealers). For thoughtful criticism of these cases, see Emerson, *supra* note 171, at 638–45; Lynn M. LoPucki, *Toward a Trademark-Based Liability System*, 49 UCLA L. REV. 1099 (2002).

¹⁷³ According to the Lucas treatise, “it is universally recognized that the author can demand that the work be distributed under his name.” The Lucas treatise goes on to note that the suing for the right of attribution is possible in the case of “omission;” that the right applies to derivative works; and that it applies to collective works. LUCAS & LUCAS, *supra* note 4, at 326.

the weakest protection against (a). The dominant default value in U.S. copyright law is that the author does not have a right to prevent nonattribution, although they can demand such a right contractually when they license or transfer copyright.¹⁷⁴ The only way that William Strauss could claim in 1959 that “both here and abroad . . . [a]n author has the right to be given credit in the publication, performance, adaptation, or other use of his work,”¹⁷⁵ was by seeing this right of attribution as latent in the control of an unfettered copyright. But as Melville Nimmer noted, contract law provides “no right at all, since a right dependent upon the voluntary agreement of individual contracting parties . . . hardly satisfies the [Berne] Convention requirement of obligatory recognition.”¹⁷⁶

In contrast, the misattribution claims, (c) and (d), can trigger strong background concerns in U.S. law against deception of consumers, unfair competition, defamation, and invasion of privacy.¹⁷⁷ Thus the most successful cases have been claims against putting someone else’s name on a work, like in *Smith v. Montoro*,¹⁷⁸ or against putting an author’s name on a work that is not hers,

¹⁷⁴ See *Harris v. Twentieth Century Fox Films*, 35 F. Supp. 153, 155 (S.D.N.Y. 1940) (holding that absence of contractual provision for author’s credit eliminated “all rights generally known as the moral rights of authors, which rights include the right to credit as author of a work”); *Morton v. Raphael*, 79 N.E.2d 522, 524 (Ill. App. Ct. 1948) (“As the author has no inherent common law right to have his name used in connection with his work, his name may be wholly omitted from the work, if the proprietor of it sees fit so to do.”) (quoting 18 C.J.S. *Copyright & Literary Property* § 12, at 147 (1939)); *De Bekker v. Stokes Co.*, 153 N.Y.S. 1066, 1068 (N.Y. App. Div. 1915) (finding contract that chose title for work, but did not stipulate that author must be named, implied waiver of right to be named); Laurie Stearns, *Copy Wrong: Plagiarism, Process, Property, and the Law*, 80 CAL. L. REV. 513, 529 (1992) (“Where copying is authorized, the author has no common law right to attribution; such a right is nonexistent unless created by contract.”). But see *Clemens v. Press Publ’g Co.*, 122 N.Y.S. 206, 208 (N.Y. App. Div. 1910) (Seabury, J., concurring) (“The purchaser cannot garble it, or put it out under another name than the author’s; nor can he omit altogether the name of the author, unless his contract with the latter permits him so to do.”).

¹⁷⁵ Strauss, *The Moral Right of the Author*, *supra* note 22, at 992 (adding “but he may waive this right. For some types of publications, such as an author’s contribution to a collective work, this right is presumed to be waived unless specifically reserved.”).

¹⁷⁶ Nimmer, *supra* note 1, at 520.

¹⁷⁷ See *id.* at 520–21. This seems right, although it merits pointing out that Cyrill Rigamonti has made a persuasive case that continental European systems may not achieve much more. Thus, while Ilhyung Lee is concerned that “the moral rights rule would effectively cancel a negotiable term from the parties’ deliberations,” Lee, *supra* note 5, at 813, Cyrill Rigamonti concludes that “[i]n the context of copyright contracts, the Continental emphasis on moral rights tends to favor a moderate regulatory system over pure freedom of contract,” Rigamonti, *supra* note 44, at 376, and that the inalienability of moral rights “although absolutely central to Continental moral rights consciousness, boils down to little more than a handful of rather narrow limitations on the content of copyright contracts.” *Id.* at 380.

¹⁷⁸ 648 F.2d 602 (9th Cir. 1981).

either because it never was hers,¹⁷⁹ or because it has been so distorted it can no longer properly be called hers.¹⁸⁰

This means that the *Dastar* result hurts us where the American patchwork was already weak: a reverse-passing-off claim available under Lanham Act § 43(a) can no longer be grounded on nonattribution of the creative source of the good. In explaining the U.S. approximation of moral rights, Paul Goldstein wrote in 2001 that "[c]ourts have . . . held that distributing a work without attributing authorship violates the [Lanham] Act because it implies that the publisher rather than the actual author created the work."¹⁸¹ Clearly that is no longer true. Fearful of the Article 6bis implications, Marybeth Peters, the Register of Copyright, has called the decision "ill-considered."¹⁸² Perhaps the one person who gets the last laugh is Judge Murray Gurfein. Judge Gurfein filed a concurrence in *Gilliam* in which he noted that the Lanham Act is "not a substitute for *droit moral* which authors in Europe enjoy"¹⁸³ because the "Lanham Act does not deal with artistic integrity. It only goes to misdescription of origin and the like."¹⁸⁴

¹⁷⁹ See, e.g., *D'Altamonte v. New York Herald*, 102 N.E. 1101 (N.Y.1913); *Ellis v. Hurst*, 66 Misc. 235 (N.Y. Sup. Ct. 1910).

¹⁸⁰ In addition to *Gilliam*, see, for example, *Granz v. Harris*, 198 F.2d 585, 589 (2d Cir. 1952) (Frank, J., concurring) ("Whether the work is copyrighted or not, the established rule is that, even if the contract with the artist expressly authorizes reasonable modifications (e.g., where a novel or stage play is sold for adaptation as a movie), it is an actionable wrong to hold out the artist as author of a version which substantially departs from the original."); *Neyland v. Home Pattern Co.*, 65 F.2d 363 (2d Cir. 1933).

¹⁸¹ GOLDSTEIN, *INTERNATIONAL COPYRIGHT*, *supra* note 4, at 286–87.

¹⁸² *The Family Movie Act: Hearing on H.R. 4586 Before the S. Comm. on Courts, the Internet and Intellectual Property of the H. Comm. on the Judiciary*, 108th Cong. 2d Sess. 5 (2004) (Statement of Marybeth Peters, Register of Copyrights), available at <http://www.copyright.gov/docs/regstat061704.html> (last visited Nov. 28, 2007). After calling *Dastar* an "ill-considered decision by our Supreme Court," Peters notes:

While the *Dastar* decision is not the subject of this hearing, I believe that the subcommittee should examine whether section 43(a) of the Lanham Act should be amended to reflect what was the longstanding understanding prior to *Dastar*—that section 43(a) is an important means for protecting the moral rights of attribution and integrity. Although I will comment no further on *Dastar* at this hearing, and although I will not comment on the portion of the proposed legislation that would provide an exemption from liability under the Lanham Act, it is worth noting that in the wake of *Dastar* (and, for that matter, even under pre-*Dastar* law), there may be little reason to be concerned that the conduct proposed to be covered by the proposed Family Movie Act would violate the Lanham Act in any event.

Id. at n.2. See also Austin, *supra* note 113, at 119 ("[T]he Court's holding, interpreted broadly, swept away most of the protections against misattribution of the creative content of works of authorship that the Lanham Act was once assumed to provide.").

¹⁸³ *Gilliam v. ABC, Inc.*, 538 F.2d 14, 27 (2d Cir. 1976) (Gurfein, J., concurring).

¹⁸⁴ *Id.*

B. It Gets Worse When It Need Not Have

Driven by an admirable, albeit very broad, policy goal for copyright, the Court crafted a narrow, albeit very strange, statutory interpretation of trademark law. If subsequent lower courts had stuck to one or the other issues—the policy goal or statutory interpretation—the resulting gap in our right of attribution might not be so bad. But blinded by the policy goal, lower courts have vastly expanded statutory interpretation in two ways. First, instead of understanding *Dastar* to be strictly about origin in § 43(a), they have interpreted it to be about § 43(a) in its entirety—a result that we will see does not make sense. It is also a result that ignores a cardinal rule of statutory interpretation that each word of a statute is assumed to have separate meaning.¹⁸⁵ Second, courts have interpreted *Dastar* to apply to state unfair competition laws. These were state laws that it was widely agreed were not preempted by federal copyright law before *Dastar*. The result of this second expansion of *Dastar* is that these state laws—also cited by Congress in 1988 as part of the United States’ compliance with Berne—are now more limited in their capacity to contribute to the American patchwork of Article 6bis protection.

1. The Broadening of Dastar to Wipe Out § 43(a)

A broad reading of *Dastar* is that § 43(a) *in toto* is unconcerned with “the author of any idea, concept, or communication embodied in . . . goods” because of the Lanham Act’s “common law . . . foundations (which were not designed to protect originality or creativity).”¹⁸⁶ The adherent to a broad reading of *Dastar* is not troubled by the different concepts packed into both ends of the § 43(a) equation (not to mention three states of mind in the middle—confusion, mistake, and deception).¹⁸⁷ Unfortunately, this is how many lower courts have now interpreted *Dastar*. One announced that “the Supreme Court left the protection to the creative talent behind communicative products to the copyright laws.”¹⁸⁸ Another stated

¹⁸⁵ See *Discover Bank v. Vaden*, 396 F.3d 366, 369 (4th Cir. 2005) (“[C]ourts must ‘give effect to every provision and word in a statute and avoid any interpretation that may render statutory terms meaningless or superfluous.’” (quoting *United States v. Ryan-Webster*, 353 F.3d 353, 366 (4th Cir. 2003))).

¹⁸⁶ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

¹⁸⁷ See David A. Gerber, *Copyright Reigns—Supreme: Notes on Dastar Corp. v. Twentieth Century Fox Film Corp.*, 93 TRADEMARK REP. 1029, 1029–34 (2003). See also Nimmer, *supra* note 8, at 43 (characterizing the “broad reading” as being “that the opinion negates any regulation by the Lanham Act that is geared at works of authorship, rather than being limited to the domain under review of reverse passing off”). But Nimmer disagrees with this because “nothing in the opinion overtly inclines towards that earthquake.” *Id.*, at 43.

¹⁸⁸ *Carroll v. Kahn*, No. 03-CV-0656, 2003 WL 22327299, at *6–7 (N.D.N.Y. Oct. 9, 2003). Other post-*Dastar* decisions often do not provide enough information in the opinions to determine whether the plaintiff is complaining of a false description or representation of fact. In one case, the alleged offending attribution does not sound like a

that "[t]he Court concluded that claims of false authorship and reverse passing off, when raised to protect an author's interest in the intellectual content of communicative products, were not actionable under § 43(a)."¹⁸⁹ It appears that most, if not all, federal courts interpret *Dastar* as applying to all of § 43(a).¹⁹⁰

Interpreted this way, *Dastar* likely means that *Gilliam v. ABC* is no longer good law.¹⁹¹ But, the *Dastar* opinion need not disturb *Gilliam* because *Dastar* is about nonattribution, while *Gilliam* was based on misattribution. At this point, it is important to keep in mind all of the different concepts packed into § 43(a). Whatever the merits of the Justice Scalia's exegesis on the meaning of "origin," that analysis does not expressly apply to § 43(a)'s positive, intentional "false or misleading description of fact, or false or misleading representation of fact,"¹⁹² which is likely to produce confusion in the mind of the consumer as to approval, sponsorship, affiliation, or the like.¹⁹³ It would not make any sense to apply Scalia's tight, physical manufacturing definition of "origin" to these much broader § 43(a) terms that sit on both sides of the § 43(a) equation. To apply *Dastar* properly, then, it is imperative to pay attention to some distinctions that have been blurred in the past: assertion versus omission, passing off versus reverse passing

false description of fact. See *Zyla v. Wadsworth*, 360 F.3d 243, 246–51 (1st Cir. 2004) (involving a plaintiff who had removed herself as a coauthor, but objected to the acknowledgements as inadequate). In another case, *Bretford Manufacturing, Inc. v. Smith System Manufacturing Co.*, 286 F. Supp. 2d 969, 971–73 (N.D. Ill. 2003), the court inappropriately applied *Dastar* to the defendant's use of a physical component from the plaintiff. While there are legitimate questions about origin attributions for physical subcomponents, they definitely are not addressed by *Dastar*.

¹⁸⁹ *General Universal Sys., Inc. v. Lee*, 379 F.3d 131, 149 (5th Cir. 2004).

¹⁹⁰ See *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1116–17 (W.D. Wash. 2004) (interpreting *Dastar* to preempt reverse passing off claim for copyrighted images); *Aagard v. Palomar Builders, Inc.*, 344 F. Supp. 2d 1211, 1218 (E.D. Cal. 2004) (interpreting *Dastar* to preempt reverse passing off claim for copyrighted architectural plans); *Smith v. New Line Cinema*, No. 03 Civ. 5274 (DC), 2004 WL 2049232, at *3–4 (S.D.N.Y. Sept. 13, 2004) (interpreting *Dastar* to preempt reverse passing off claim for copyrighted screenplay); *Bob Creeden & Assocs. v. Infsoft, Inc.*, 326 F. Supp. 2d 876, 878–80 (N.D. Ill. 2004) (interpreting *Dastar* to preempt reverse passing off claim for copyrighted software). In addition to these, there are cases applying *Dastar* beyond the realm of copyright. See, e.g., *Keane v. Fox Televisions Stations, Inc.*, 297 F. Supp. 2d 921, 934–37 (S.D. Tex. 2004) (interpreting *Dastar* to bar § 43(a) claim for reverse passing off of uncopyrightable idea); *Tao of Sys. Integration, Inc. v. Analytical Servs. & Materials, Inc.*, 299 F. Supp. 2d 565, 571–72 (E.D. Va. 2004) (interpreting *Dastar* to preempt reverse passing off claim for trade secrets). These two cases are discussed extensively by Tom Bell. See Bell, *supra* note 157, at 217–19; see also Roberta Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. 1945, 1994–95 (2006) ("These courts have applied *Dastar* absent explicit analysis of the implications of the Court's opinion for non-public domain works.").

¹⁹¹ See Greg Lastowka, *Digital Attribution: Copyright and the Right to Credit*, 87 B.U. L. REV. 41, 74 n.182 (2007).

¹⁹² 15 U.S.C. § 1125(a)(1) (2006).

¹⁹³ *Id.*

off, and origin versus affiliation, connection, association, approval, or sponsorship.¹⁹⁴

The 1980 case of *Follett v. New American Library, Inc.*¹⁹⁵ is exemplary. In *Follett*, the defendant intended to publish a nonfiction book that had a complicated authorship history. The original book had been written pseudonymously by three French journalists.¹⁹⁶ Follett was brought on board to edit and, then, substantially revise this original work; his role morphed from editor to someone who “in fact rewrote the work.”¹⁹⁷ Indeed, when the book was first published in England, Follett “sought and obtained some authorship credit” with the byline “Rene Louis Maurice with Ken Follett.”¹⁹⁸ Years later, after Follett had become a famous fiction author, the book’s copyright holder announced plans to publish it in America, dramatically emphasizing Follett and deemphasizing the original, primary authors.¹⁹⁹ Since there was no question that Follett was part of the origin of the book in the pre-*Dastar* sense, the court properly understood the § 43(a) issue as whether the book jacket had a description or representation that was false.²⁰⁰ The court concluded that “the representation that Follett [was] the principal author of the book is literally false.”²⁰¹ It did not expressly decide what kind of confusion had been engendered other than origin, but arguably using Follett’s name so prominently would confuse his readership base and others as to affiliation, connection, association, sponsorship, or approval.

Follett and Monty Python made parallel claims: Follett did not want to be named as the principal creator of a work that was not his principal creation. The Monty Python troupe did not want to be named as the principal creator of a work that was no longer their creation. In each case, the labelling was a false representation of facts leading to likely confusion as to affiliation, connection, association, sponsorship, or approval. Such claims should survive *Dastar* as long as the misattribution can reasonably be characterized as a description or representation of fact. In other words, if I publish a defense of big government and lavish welfare programs and label it “written by Sean Hannity,” are we prepared to say that this is not an actionable “misrepresentation of fact” likely to confuse consumers as to affiliation, connection, sponsorship, or approval? How about a pornographic film that credits Steven Spielberg as the director? These are passing

¹⁹⁴ And, of course, § 43(a)(1)(A) and § 43(a)(1)(B) codified at 15 U.S.C. § 1125(a)(1)(A) and § 1125(a)(1)(B). See Nimmer, *supra* note 8 at 41–42.

¹⁹⁵ 497 F. Supp 304 (S.D.N.Y. 1980).

¹⁹⁶ *Id.* at 306.

¹⁹⁷ *Id.* at 309.

¹⁹⁸ *Id.* Rene Louis Maurice was a combined pseudonym for the three French journalists. *Id.* at 305.

¹⁹⁹ The new edition would have had a jacket that said “by the author of TRIPLE and EYE OF THE NEEDLE: KEN FOLLETT with Rene Louis Maurice,” *id.* at 308, with the French name “printed in much smaller type . . . only 6 mm. in height,” *id.* at 312, and not appearing on the spine of the book at all, *id.* at 308.

²⁰⁰ *Id.* at 312.

²⁰¹ *Id.*

off cases, plain and simple. If we take *Dastar* broadly and assume § 43(a) does not concern the origin of ideas, can I market my new high-energy drink as "formulated by the people at Coca-Cola" or my new line of clothing as "designed by Karl Lagerfeld" without § 43(a) ramifications? Such a broad reading of *Dastar* means that there is no Lanham Act cause of action against wildly false, indeed fraudulent, assertions of facts whenever they bear on "the author of any idea, concept, or communication embodied in . . . goods."²⁰² It seems unlikely this is what the Court intended.²⁰³

2. *The Broadening of Dastar to Wipe Out State Laws*

Prior to *Dastar* there had been general agreement that copyright law, through 17 U.S.C. § 301 (2006), did not preempt state unfair competition claims that sounded in failure of attribution.²⁰⁴ Now, as Professors Michael Landau and Tom Bell have separately explored,²⁰⁵ all this is in doubt. As Tom Bell has observed, after *Dastar*, for a state law to be vulnerable to preemption "[i]t suffices . . . that a state law risks limiting public use of fixed works of authorship for a period exceeding the limits imposed by federal copyright law."²⁰⁶

In *Dastar* itself, the district court on remand concluded with absolutely no analysis that the Supreme Court's holding applied to claims brought under California's unfair competition law.²⁰⁷ At least two other district courts have also concluded that the *Dastar* reasoning controls claims under state unfair competition laws, either on the grounds (a) that the state unfair competition claims have always been interpreted as "congruent" with Lanham Act claims,²⁰⁸ or (b) that the

²⁰² *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

²⁰³ Other commentators seem to believe that this sort of false representation of material fact claim has survived *Dastar*. See, e.g., 5 MCCARTHY ON TRADEMARKS, *supra* note 141, § 27:77.1, at 27-175 to 27-185 (4th ed. 2007); Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 275-77 (proposing that misrepresentations material to the consumer would survive *Dastar*).

²⁰⁴ See, e.g., *Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d 1434, 1441 (9th Cir. 1993) ("State unfair competition laws which seek to prevent reverse palming off are not preempted by federal law."); GOLDSTEIN, *supra* note 5, §§ 15.2.1.2, 15:15; NIMMER ON COPYRIGHT, *supra* note 27, § 1.01[B][1], at 1-13 n.62. For a discussion of some contrary cases, see Bell, *supra* note 157, at 240-43.

²⁰⁵ See Bell, *supra* note 157; Michael Landau, *Dastar v. Twentieth Century Fox: The Need for Stronger Protection of Attribution Rights in the United States*, 61 N.Y.U. ANN. SURV. AM. L. 273, 304-06 (2005).

²⁰⁶ Bell, *supra* note 157, at 232.

²⁰⁷ The sum total of the analysis was "[t]he Supreme Court's finding that Defendants' actions were not misleading under the Lanham Act controls the resolution of their California unfair competition claim." *Twentieth Century Fox Film Corp. v. Dastar Corp.*, No. CV98-07189FMC(EX), 2003 WL 22669587, at *5 (C.D. Cal. Oct. 14, 2003).

²⁰⁸ *Bob Creeden & Assocs. v. InfoSoft, Inc.*, 326 F. Supp. 2d 876, 878-80 (N.D. Ill. 2004) (citing congruence between Illinois unfair competition law and Lanham Act to conclude that Lanham Act reverse passing off claim that fails because of *Dastar* also states

copyright policy considerations that limited the definition of “origin” in the Lanham Act must similarly curb state unfair competitions laws.²⁰⁹

Both paths of reasoning are flawed. Lanham Act and state law congruence has certainly been good for an efficient legal system, but when the Supreme Court changes the understood meaning of a term in a federal statute, we should not assume that parallel state laws remain congruent in their coverage. The parallel state laws were drafted by different people at different times, and perhaps with a *Gilliam*-esque understanding of the Lanham Act’s coverage. In that kind of situation, there is not much to the congruence argument except as a stand-in for the copyright policy/preemption argument. And the copyright policy considerations affect only works that have fallen out of copyright (and materials that are uncopyrightable), not works still protected by copyright. So a healthy and desirable embrace of the *Dastar* policy concerns does not mean embracing the odd *Dastar* analysis of origin and certainly does not require applying it in blanket fashion to different statutory language in state laws.

C. *There Was a Simpler Way to Protect the Public Domain*

The Court had a number of options available in *Dastar* that could have avoided the uncertainties embedded in the opinion. For example, the Court could have narrowly ruled that, whatever the meaning of § 43(a) origin, it could not mean Fox. It appears that Time, Inc. was the first author of *Crusade in Europe* under the work-for-hire doctrine. Fox was just a subsequent assignee. The last owner of an unowned thing is not its origin. We don’t look at an abandoned farmhouse and say that the last family to own it was the “origin” of the house unless they built it.²¹⁰ But overturning the Ninth Circuit’s holding on these grounds would have left intact the spectre of § 43(a) nonattribution claims by true originators/creators when the work is in the public domain. Was there any way to remove the spectre of nonattribution Lanham Act claims on public-domain works while leaving untouched such claims on works still under copyright?

The answer is yes. In this sense, the Court is to be faulted for having failed to interpret an act of Congress consistent with the United States’ international

“no claim under Illinois’ statutory unfair competition laws”); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1186 (C.D. Cal. 2003) (plaintiff’s state unfair competition claims fail because “[t]he Ninth Circuit has consistently held that state law unfair competition claims are ‘congruent’ with Lanham Act claims”).

²⁰⁹ *Aagard v. Palomar Builders, Inc.*, 344 F. Supp. 2d 1211, 1218 (E.D. Cal. 2004). Although this court also mentions the Lanham Act and state unfair competition law being “substantially congruent,” it seems more explicitly to rely on preemption by copyright policy considerations.

²¹⁰ For more on the use of “originating” and “creating,” see Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 99–104 (1998).

obligations.²¹¹ The Court could have established a simple interpretation of the otherwise undefined statutory term “origin”: when the materials come from the public domain there is no legally-cognizable obligation to attribute origin to any person, natural or juridical. This was the obvious way to go—as noted by many commentators.²¹² What has been less noted is the overarching principle that justifies this bifurcation: there should be no obligation to attribute origin when the material comes from the public domain or any other recognized zones of nonproperty. This principal should apply well beyond intellectual property. If the Pepsi Cola Bottling Company wants to start bottling air, there is no need to attribute the origin of the air to anyone. Similarly, if they decided to build an art collage out of materials abandoned as trash on the sidewalks of New York, there would also be no need to attribute the origins of the materials to anyone.²¹³

The virtue of this approach is that it provides a fairly bright line concerning nonattribution. The bright line may be most visible with materials that have fallen into the public domain, but the rule can apply across the board to clearly unowned tangible and intangible materials. Leonard Bernstein does not need to credit Shakespeare with the idea for *West Side Story* because the idea is, and always was, clearly unowned. The Weather Channel does not have to credit the National Oceanic and Atmospheric Administration (NOAA) as the origin of its weather data because the data is clearly unowned, both under *Feist*²¹⁴ and 17 U.S.C. § 105. A manufacturer of bottled hydrogen, nitrogen, or oxygen does not have to credit the gases with any particular origin because the atmosphere is unowned. The *Dastar* opinion can be discussed without mentioning Justice Scalia because judicial opinions are unowned by operation of 17 U.S.C § 105 and *Wheaton v. Peters*.²¹⁵ None of the desalination plants in the United States extracting fresh water from seawater²¹⁶ need to attribute any origin to their final product because seawater is

²¹¹ *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804); *see also* Austin, *supra* note 113, at 113.

²¹² *See e.g.*, Austin, *supra* note 113, at 148 (“It would be more consistent with the international obligations of the United States to view the *Dastar* holding as applying only to misattribution claims for works whose copyrights have expired.”).

²¹³ This is true assuming that the abandoned materials are not covered by intangible property rights, such as a copyright on an abandoned painting leading to a derivative-work claim when the painting is integrated into the collage.

²¹⁴ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361–62 (1991).

²¹⁵ 33 U.S. (8 Pet.) 591, 668 (1834).

²¹⁶ There are approximately 1200 desalination plants in the United States, *see* Eliza Barclay, *Thirsty States Turning to Desalination*, UPI Wire Service, April 23, 2004, available at http://www.upi.com/NewsTrack/Science/2004/04/23/thirsty_states_turning_to_desalination/4161/ (last visited Nov. 28, 2007), but almost all of them convert brackish groundwater to drinkable freshwater. However, seawater conversion is on the way: “[a] major reverse-osmosis desalting plant is already in operation in Tampa, Fla., along with smaller ones in California” and state funding approved in Texas for pilot projects in Brownsville, Corpus Christi, and Freeport. *See* Phil Magers, *Analysis: States Seek New Water Sources*, UPI Wire Service, Aug. 5, 2004, available at <http://www.upi.com/>

unowned under international law. If you shoot a wild boar as it is crossing the street from my property into a park and you serve the medallions of wild pig in your restaurant, you don't have to attribute the origin of the meat to me or anyone else.²¹⁷ The same is true for wild ducks and fish caught at sea.²¹⁸ In short, if it comes from the commons—if it is *ferae naturae* or *terra nullius*—you should have no obligation of attribution.

Of course, there are at least two differences between a creative work now in the public domain and ocean water, air, and wild boar meat. First, the audiovisual work previously had an owner, while the materials did not. Second, the creation or origination of the audiovisual work can be pinned to particular, identifiable human(s), while the materials cannot. But neither of these differences is a powerful argument against the principle that if it comes from the commons, there is no obligation of attribution. We have already explored how ownership is not origin; as for the second difference, we have to make a policy decision about how far reputational interests should extend.

There is no question that Pepsi can take unowned materials, process and package them, and label them Pepsi Air, Pepsi Seawater, Pepsi Literature, and Pepsi Art. Similarly, Dastar could have labeled the television series “Dastar Corp. presents” even if they had not manufactured the tapes, because the “Dastar” label would be accurate as to sponsorship or approval. But what if Pepsi releases a new edition of *Taming of the Shrew* labeled “by Uncle Pepsi” or, more playfully, “by Neville Isdell,” the Chairman of the Board of the Coca-Cola Company?²¹⁹

Here, we can see how narrow this commons principle is. The elimination of attribution duties for materials in the commons does not create misattribution rights for the same materials. To return to Table 2, we have eliminated any line going from the omission of designation of origin to likely confusion over origin of goods, but we have not changed the obligations to avoid false/misleading descriptions/representations of fact which lead to likely confusion over origin of goods or sponsorship of the goods or approval of the goods or affiliation, connection, or association of a named person with the good or its producer. If *Deep Throat*²²⁰ falls into the public domain, you still cannot package it with a label that says “Walt Disney presents” because that is a false description of fact likely to

International_Intelligence/Analysis/2004/08/05/analysis_states_seek_new_water_sources/8689/ (last visited Nov. 28, 2007).

²¹⁷ As all lawyers remember, the boar, like the fox in *Pierson v. Post*, is an animal *ferae naturae*. 3 Cai. 175, 177–78 (N.Y. Sup. Ct. 1805).

²¹⁸ 3 BENEDICT ON ADMIRALTY § 158, at 11–15 (1992) (stating that “[t]he recovery of marine life such as ambergris, whales, or other large fish entitles the finder to keep the property or the proceeds from the sales of that property”).

²¹⁹ See <http://www.thecoca-colacompany.com/ourcompany/executivei.html> (last visited Nov. 28, 2007).

²²⁰ DEEP THROAT (P.D. Inc. & Vanguard Films Production 1972).

subvert a whole range of § 43(a) concerns besides the physical origin of the goods.²²¹

V. FIXING THE *DASTAR* GAP

That path—a clean cleaving of origin obligations once things become unowned—is the path that was not chosen. *Dastar* does knock out § 43(a) as a device to prevent nonattribution of owned works, either through a broad reading that § 43(a) *in toto* is “not designed to protect originality or creativity”²²² or a narrow reading that § 43(a) origin is never concerned with the source of creativity and originality embodied in a product or service. Yet if we work through all the possibilities, the practical hole created by *Dastar* may be operatively modest. *Dastar* creates a gap in protection for those works and circumstances where there is a failure of appropriate attribution and no cause of action under VARA, under state moral rights laws,²²³ under 17 U.S.C. § 1202 for failure to include copyright management information, or under state unfair competition laws in states where the courts hold that *Dastar* should not control,²²⁴ and where contract law does not

²²¹ Similarly, the 1948 *Shostakovich v. Twentieth-Century Fox* case concerned works in the public domain, but the issue was *attribution* to the composer, not nonattribution. 80 N.Y.S.2d 575 (N.Y. App. Div. 1948). Again, the elimination of attribution duties for materials in the commons does not create misattribution rights for the materials in the commons. (Although in the *Shostakovich* case, the musical compositions had been written by the composer and the misattribution argument was more attenuated. *Id.*)

²²² *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 36 (2003).

²²³ These state laws vary enough from 17 U.S.C. § 106A that a few additional works will gain a right of attribution under them. VARA only preempts state law “with respect to works of visual art to which the rights conferred by section 106A apply.” 17 U.S.C. § 301(f) (2006). If state moral rights laws apply to any works not covered by VARA, those state laws appear to survive preemption. At least eight states now have such moral rights provisions on their statute books. *See, e.g.*, CAL. CIV. CODE § 987 (West 2007); LA. REV. STAT. ANN. §§ 51:2151–56 (West Supp. 2007); ME. REV. STAT. ANN. tit. 27, § 303 (2007); MASS. GEN. LAWS ANN. ch. 231, § 85S (LexisNexis Supp. 2007); N.J. STAT. ANN. § 2A:24A-1 to -8 (West 2000); N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney Supp. 2007); 73 PA. CONS. STAT. ANN. §§ 2101–10 (Purdon Supp. 2007); R.I. GEN. LAWS § 5-62-2 to -6 (LexisNexis 2005). But 17 U.S.C. § 301(f) may not resolve the question of federal copyright law preempting such state law. For example, copyright’s first sale doctrine could arguably be frustrated by a state law against mutilation of a work, triggering nonstatutory preemption. For a description of this pre-VARA issue see Sophia Davis, *State Moral Rights Law and Federal Copyright System*, 4 CARDOZO ARTS & ENT. L.J. 233, 251–252 (1985).

²²⁴ After writing this passage, I noted that David Nimmer has reached the same conclusion that we should have a better grasp of how much of a real problem we have: “But before mounting a corrective campaign in Congress, what is required is an empirical investigation into whether society currently confronts scores of compositions being vended by their copyright owners in derogation of the true author’s name.” Nimmer, *supra* note 8, at 50. And this goes not just to the scope of the problem, but whether contract law, in the

establish a framework to protect attribution. Whether or not we include contract law in this list may vary from industry to industry.²²⁵

But to eliminate the *Dastar* gap, the Court's reasoning itself must be overturned. Having already opined on the meaning of a very dense statute, it seems unlikely that the Court will revisit the issue. As Justice Ginsburg would say, the ball is now in Congress's court.²²⁶ A simple way to seal the *Dastar* gap would be amendment of the Lanham Act. One might first think to amend the language of § 43(a), but once we reopen a statutory provision as messy as § 43(a), we will likely be besieged by all kinds of questions, phantoms, and rent-seekers. Alternatively, we could take a more surgical approach and add the following partial definition to § 45, the Lanham Act provision which provides the Act's definitions:

The word "origin" as used in 15 U.S.C. § 1125(a) shall, as applied to and only to such works as are protected by copyright, be interpreted to include the person(s) defined as the author(s) of the copyrighted work under Title 17.

This language does not return us to the pre-*Dastar* world because it limits the reexpansion of "origin" to works protected by copyright.

More elegantly we could add the same substantive provision to the Copyright Act, either as an addition to § 106A or a new § 106B. This would further gather our moral-rights provisions in one place. Adding some appropriate bangs and whistles, the whole provision might be:

present author/capital environment, is adequate to protect an author's right of attribution where it is important to the author.

²²⁵ Where the industry has a collective bargaining agreement that secures attribution rights, as in the audiovisual industry, contract law should be considered. For example, both the Screen Actors Guild and the Writers Guild of America require companies doing business with their respective members to provide agreed-upon screen credits. *See, e.g.*, 2004 WRITERS GUILD OF AMERICA-ALLIANCE OF MOTION PICTURE AND TELEVISION PRODUCERS THEATRICAL AND TELEVISION BASIC AGREEMENT art. 8 (Nov. 1, 2004) (entitled "Screen Credits"), available at <http://web1.wgaeast.org/index.php/articles/article/wgreview/xaraya/var/uploads/File/contracts/MBA%202004.pdf>; ALLIANCE OF MOTION PICTURE AND TELEVISION PRODUCERS, PRODUCER-SCREEN ACTORS GUILD CODIFIED BASIC AGREEMENT OF 1995 § 25 (1995) (same). *See also* Writers Guild of America, East, *Minimum Basic Agreement (MBA)* (Jan. 1, 2007) ("The responsibility for determining writing credits was won many years ago [from film producers] by the Guild."), available at <http://www.wgaeast.org/index.php/articles/article/336?startnum=&sort=&letter=&wgc=89#wga336> (last visited Nov. 28, 2007) (an article describing the MBA).

²²⁶ *An Open Discussion with Justice Ruth Bader Ginsburg*, 36 CONN. L. REV. 1033, 1043 (2004) ("[W]hen . . . the Court has made its best guess at what some dense statute means, we are likely to adhere to that reading. . . . We've said what we thought the statute meant. After that, the ball is in Congress' court; Congress can change the law . . .").

§106B Rights of Other Authors to Attribution

- (a) Definition of “Origin” for Works Protected by Copyright. As applied to and only to such works protected by copyright, “origin” as used in 15 U.S.C. § 1125(a) shall be interpreted to include the person(s) defined as the author(s) under this Title.
- (b) Scope and Exercise of Rights. The rights conferred by subsection (a) shall not apply in relation to:
 - (1) acts or omissions against which there is a cause of action under § 106A(a)(1) of this Title;
 - (2) acts or omissions in relation to a work whose author(s) cannot be determined by a person after having performed and documented a reasonably diligent search in good faith to locate the author(s);
 - (3) acts or omissions in relation to transmissions by a broadcast station, or a cable system, or someone who provides programming to such station or system, where providing information as to origin as specified in subsection (a) is not technically feasible or would create an undue financial hardship and the act or omission was not done with intent to conceal the origin of the copyrighted work;
 - (4) acts or omissions where providing attribution to the author of the copyrighted work would be unreasonable under the circumstances.

I am not sure that these are all the needed bangs and whistles—or even the most needed ones. Clause (b)(2) addresses the orphan-works issues, using a standard drawn from H.R. 5439, as introduced in May 2006 in the 109th Congress.²²⁷ Obviously, the standard should be the same as that in any orphan-works law that the United States might adopt. Clause (b)(3) addresses broadcast-media practices and tracks the language used for this purpose in relation to copyright-management information under § 1202(e).

Clause (b)(4) may appear to eviscerate the entire provision, but it is common for national laws to so limit rights of attribution—a point that may not be recognized by commentators who disfavour attribution rights.²²⁸ For example, Canada’s statute expressly provides that an author has “the right, where reasonable in the circumstances, to be associated with the work as its author.”²²⁹ The right of

²²⁷ The Orphan Works Act of 2006, H.R. 5439, 109th Cong. § 514(b)(1)(A) (2006).

²²⁸ See, e.g., Jonathan Band & Matt Schruers, *Dastar, Attribution, and Plagiarism*, 33 AIPLA Q.J. 1, 2 (2005) (arguing that when it comes to the contexts in which attribution is called for “[t]he law is poorly suited to make the nuanced distinctions”).

²²⁹ Copyright Amendment Act, *infra* note 253, at §14.1(1). But the right to remain anonymous does not appear to be subject to measures of reasonableness. See Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 293.

attribution in Israel is statutorily limited to “the accepted manner and extent”;²³⁰ in Senegal, to “the extent and manner that conforms with good practices.”²³¹ Japanese law provides that an author’s name may be omitted when “there is no risk of damage to the author in his claim to authorship” and when the omission follows “fair practice”;²³² Korea has similar provisions.²³³ Danish law gives the author only the right to have her name “stated to the extent and in the manner required by proper usage.”²³⁴ In Brazil, a judge can dismiss de minimis attribution claims.²³⁵ Indeed, a reasonable circumstances test for attribution is built into the 1996 WPPT.²³⁶

As written, the proposal would restore the connection between violation of the right of attribution and Lanham Act remedies, the same remedies allowed prior to *Dastar*. From a pure moral-rights approach, injunctive relief is the right remedy, but persuasive arguments can be made that many minor failures of attribution do

²³⁰ Neil J. Wilkof, *Israel*, in 2 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at ISR-28 (Paul Edward Geller ed., 2006).

²³¹ Article 3(A) (“Le nom de l’auteur doit être indiqué dans la mesure et de la manière conforme aux bons usages sur tout exemplaires . . .”) Law No. 73-52, Protection of Author’s Rights (Loi No. 73-52 Relative à la Protection du Droit d’Auteur) (Sen., 1973), in TEXTES RELATIFS AU DROIT D’AUTEUR ET AU BUREAU SENEGALAIS DU DROIT D’AUTEUR [Texts Concerning Copyright and the Senegal Copyright Bureau] 9 (date unknown).

²³² Copyright Law, Law No. 48 of 1970, art. 19(3), *translated in* Copyright Research and Information Center, Copyright Law of Japan, *available at* http://www.cric.or.jp/cric_e/clj/clj.html (“It shall be permissible to omit the name of the author where it is found that there is no risk of damage to the interests of the author in his claim to authorship in the light of the purpose and the manner of exploiting his work and in so far as such omission is compatible with fair practice.”) (last visited Nov. 28, 2007).

²³³ The right of attribution applies unless omission is “deemed unavoidable in light of the nature of the work as well as the purpose and manner of its exploitation.” Copyright Act, 1989, No. 3916, § 3, *amended by* 1995, No. 5015 (S. Korea), *available at* http://www.wipo.int/clea/docs_new/pdf/en/kr/kr001en.pdf.

²³⁴ Copyright Act, 2001, No. 618, § 3, *amended by* 2003, No. 164 (Den.), *available at* http://www.wipo.int/clea/docs_new/en/dk/dk001en.html (last visited Nov. 28, 2007); *see also* THOMAS RIIS, INTELLECTUAL PROPERTY LAW IN DENMARK, at 38 (2000) (“The duty to state the name of the author is dependent on what is considered as proper use. If it is impossible, unreasonably burdensome or unreasonably disturbing given the context in which the work is used to state the name of the author, it is in compliance with proper use not to do so.”).

²³⁵ *See* T.J.S.P.-3, Ap. No. 6.956-1, Relator: Des. Evaristo dos Santos, 9.12.1980, 555 R.T. 1981, 103 (Brazil) (failure to give an architect of public monuments attribution on postcards of the public monuments was held nonactionable under Brazil’s moral rights statute); *see also* Manoel J. Periera dos Santos & Otto B. Licks, *Brazil*, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at BRA-49 (Paul Edward Geller ed., 2006).

²³⁶ Article 5(1) of the WPPT recognizes that musical performers have a “right to claim to be identified as the performer of his performances, except where omission is dictated by the manner of the use of the performance.” WPPT, *supra* note 86, art. 5, 36 I.L.M. at 82.

not warrant full-tilt injunctive relief. As much as moral rights are conceptually distinct from economic rights, these moral rights are quite often monetized: wronged parties seem to be willing to be made whole with financial payments. In an ideal implementation of the right of attribution, we should somehow take this into account. This proposal also does not address the question of whether, when, and how an author should be able to waive this sort of claim. The Lanham § 43(a) claim exists regardless of whether the defendant successfully raised a fair use defense in relationship to the related authorized reproduction, distribution, or public performance. Jane Ginsburg believes this is an appropriate balance,²³⁷ although I can imagine situations in which the fair use defense should preclude any claim against nonattribution, for instance when small amounts of quotation in a scholarly work or a parody by its very nature already point the viewer to the original. At a minimum, I think the legislative history for this amendment should indicate that where the defendant has a successful fair use defense to the underlying § 106 violation, it is likely to be unreasonable to expect authorial origin to be stated.

Finally, this proposal is more politically tenable for the same reason that moral-rights purists will dislike it.²³⁸ By redefining “origin” to include “the person(s) defined as the author(s) of the copyrighted work under Title 17,” we have integrated the work-for-hire doctrine into the definition. If Disney holds the copyright in an animation as a work for hire, then Disney, not the individual Disney animators, has the right of attribution. There may be circumstances where this deprives someone with genuine authorial interests of their attribution right, but as I have argued elsewhere, in many work-for-hire situations the personality interests involved in a creative work may genuinely be split between the employed and the employer—or even concentrated with the employer.²³⁹

VI. POSTSCRIPT—PATCHWORK APPROXIMATION OR TREATY COMPLIANCE?

In the best of times, the patchwork had at least as many doubters as believers among American legal commentators.²⁴⁰ How, they asked, can this patchwork be

²³⁷ See Ginsburg, *Right to Claim Authorship*, *supra* note 92, at 303.

²³⁸ See, e.g., *id.* at 280.

²³⁹ See Hughes, *supra* note 210, at 154–58.

²⁴⁰ The skeptics have ranged from those sure that the United States does not provide genuine Article 6bis moral rights to those who are very doubtful. See, e.g., Phyllis Amarnick, *American Recognition of the Moral Right: Issues and Options*, 29 COPYRIGHT L. SYMP. (ASCAP) 31, 60–81 (1983) (discussing the right of integrity); Sidney A. Diamond, *Legal Protection For The “Moral Rights” of Authors and Other Creators*, 68 TRADEMARK REP. 244, 280–81 (1978); A. Dietz, *The United States and Moral Rights: Idiosyncrasy or Approximation?*, 142 REVUE INTERNATIONALE DU DROIT D’AUTEUR 222 (1989); Robert E. Hathaway II, *American Law Analogues to the Paternity Element of the Doctrine of Moral Right: Is the Creative Artist in America Really Protected?*, 30 COPYRIGHT L. SYMP. (ASCAP) 121, 152–53 (1983); Flore Kringsman, *Section 43(a) of the*

pacta sunt servanda fulfillment of Article 6*bis* treaty obligations?²⁴¹ The skepticism has been honest, but also arguably myopic, tending to come from intellectual-property experts, not international-law experts. The intellectual-property scholars tend to read the Article 6*bis* obligations and then immediately compare our domestic law to the treaty language. What is missing is an interpretative step in which the words might turn out to mean something nonobvious. This is strange coming from copyright scholars—people who live in a world in which “writings” has accreted interpretation over time to now include photos, sculpture, films, sound recordings, and broadcasts of sports games.²⁴²

The content of an international legal norm—in this case, a particular treaty obligation—depends largely on its interpretation and implementation by nation-states. Memorializing a familiar principle of customary international law,²⁴³ Article 31 of Vienna Convention on the Law of Treaties provides that in interpreting a treaty, account shall be taken of “any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation.”²⁴⁴ As Michael Akehurst notes, “[t]he way in which states perform their obligations under a treaty can be evidence of what they originally intended when they drafted the treaty.”²⁴⁵ Or in the words of the Harvard Research Draft Convention of 1935:

Lanham Act as a Defender of Artists’ “Moral Rights,” 73 TRADEMARK REP. 251, 270–72 (1983); Tyler T. Ochoa, *Introduction: Rights of Attribution, Section 43(A) of the Lanham Act, and the Copyright Public Domain*, 24 WHITTIER L. REV. 911, 925–28 (2003); Deborah Ross, Comment, *The United States Joins the Berne Convention: New Obligations for Authors’ Moral Rights?*, 68 N.C. L. REV. 363–64 (1990). Although Martin Roeder put forward the “composite” theory, his overall conclusion was that American law was inadequate. Roeder, *supra* note 34, at 575–78.

²⁴¹ See Vienna Convention on the Law of Treaties art. 26, *opened for signature* May 23, 1969, 1155 U.N.T.S. 331; see also ARNOLD MCNAIR, THE LAW OF TREATIES 493–505 (1961).

²⁴² It is interesting how infrequently this problem is discussed among copyright scholars prepared to devote thousands of words to the meaning of “progress” or other words in the Copyright and Patent Clause. In his dissent in *Mazer v. Stein*, Justice Douglas raised just this issue, writing “Is a sculptor an ‘author’ and is his statue a ‘writing’ within the meaning of the Constitution? We have never decided the question.” 347 U.S. 201, 220 (1954) (Douglas, J., dissenting).

²⁴³ Although the United States has not ratified the Vienna Convention, for the U.S. Executive’s general recognition of the Convention as an authoritative guide to customary international law regarding treaties, see 1 RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 145 (1986). The Vienna Convention is widely viewed as restating customary principles for treaty interpretation. See IAN SINCLAIR, THE VIENNA CONVENTION ON THE LAW OF TREATIES 153 (2d ed. 1984).

²⁴⁴ Vienna Convention on the Law of Treaties, *supra* note 241, at art. 31(3)(b).

²⁴⁵ MICHAEL AKEHURST, A MODERN INTRODUCTION TO INTERNATIONAL LAW 166 (1984). Lord McNair similarly noted that “when there is doubt as to the meaning of a provision or expression contained in a treaty, the relevant conduct of the contracting parties after the conclusion of the treaty . . . has a high probative value as to the intention of the parties at the time of its conclusion.” MCNAIR, *supra* note 241, at 423.

In interpreting a treaty, the conduct or action of the parties thereto cannot be ignored. If all the parties to a treaty execute it, or permit its execution, in a particular manner, that fact may reasonably be taken into account as indicative of the real intention of the parties or the purpose which the instrument was designed to serve.²⁴⁶

Similarly, the International Court of Justice (ICJ) and its predecessor have repeatedly referred to contracting-state practice in understanding treaty obligations,²⁴⁷ and it does not matter whether we treat this as a principle of interpretation or a rule of evidence as to the parties' intent.²⁴⁸ The evidence here is that in the post-1928 period several Berne members executed their *6bis* obligations in a way similar to what the United States has done since 1988. All the evidence indicates that other Berne members permitted this approach.

Indeed, international tribunals have extended this principle of state practice further such that state practice may inform the content of a treaty obligation, even when the state practice seems at odds with the plain meaning of the treaty provision. In a 1965 decision, *Air Services Agreement of 27 March 1946*, between the United States and France, an arbitration panel concluded that "the practice of the Parties in the application of the Agreement" is "susceptible of either confirming or contradicting, and even possibly of correcting, the conclusions furnished by the interpretation based on an examination of the [treaty] text and the preparatory work."²⁴⁹ The ICJ has confirmed the principle that state practice can both interpret and literally modify a treaty obligation. In the 1962 *Temple of Preah Vihear (Merits)*, the Court wrote:

²⁴⁶ Harvard Research Draft Convention, *Research in Int'l Law Part III: Draft Convention on the Law of Treaties, with Comment*, 29 AM. J. INT'L. 966 (Supp. 1935).

²⁴⁷ Int'l Status of South-West Afr., Advisory Opinion, 1950 I.C.J. 128, 135–36 (July 11) ("Interpretations placed upon legal instruments by the parties to them . . . have considerable probative value . . ."); Corfu Channel (U.K. v. Alb.), 1949 I.C.J. 4, 25 (Apr. 9) ("The subsequent attitude of the Parties shows that it was not their intention, by entering into the Special Agreement, to preclude the Court from fixing the amount of compensation."); Jurisdiction of the Courts of Danzig, Advisory Opinion, 1928 P.C.I.J. (ser. B) No. 15, at 18 (Mar. 3) ("The intention of the Parties, which is to be ascertained from the contents of the Agreement, *taking into consideration the manner in which the Agreement has been applied*, is decisive.") (emphasis added).

²⁴⁸ See Gerald Fitzmaurice, *The Law and Procedure of the International Court of Justice, 1951–54: General Principles and Sources of Law*, 30 BRIT. Y.B. OF INT'L L. 1, 54–58 (1953); Gerald Fitzmaurice, *The Law and Procedure of the International Court of Justice, 1951–54: Treaty Interpretation and Other Treaty Points*, 33 BRIT. Y.B. OF INT'L L. 203, 223–25 (1957).

²⁴⁹ *Air Transp. Servs. Agreement Arbitration (U.S. v. Fr.)*, 38 I.L.R. 182, 245–46 (Arb. Tr 1963); see also MICHAEL BYERS, *CUSTOM, POWER, AND THE POWER OF RULES* 171–74 (1999) (discussing this case and offering an alternative interpretation of it as a rule of customary international law modifying treaty obligations).

The Court considers that the acceptance of the Annex I map by the Parties caused the map to enter the treaty settlement and to become an integral part of it. . . . In other words, the Parties at that time adopted an interpretation of the treaty settlement which caused the map line . . . to prevail over the relevant clause of the treaty.”²⁵⁰

This is the long-standing framework²⁵¹ that should be considered in judging American compliance with Article 6*bis*. But this also leads to an interesting question: do we judge American compliance against the weakest compliance with Article 6*bis* historically or against the weakest compliance currently? Our practice appears to be reasonably mainstream compared to historic treatment of the Article 6*bis* obligations, but less so in relation to current practices of Berne member states.

A. Comparative Historical Compliance

Respectable adherence to Berne historically did not require express statutory provisions establishing the two moral rights. While moral rights are commonly identified with French *droit d'auteur*, codification of moral rights did not occur in France until 1957—almost 30 years after 6*bis* was written.²⁵² Although Canada codified moral rights very early,²⁵³ most major common law countries—and several significant civil law countries—were members of the Berne Convention for decades before they passed moral rights statutes for the two Article 6*bis* rights.

²⁵⁰ Temple of Preah Vihear (Thail. v. Cambodia), 1962 I.C.J. 6, 33–34 (June 15).

²⁵¹ In the seventeenth century, the “usage of nations” was recognized as “the best interpreter of the sentiments of the contracting parties.” MCNAIR, *supra* note 241, at 252 (describing *Les Quatre Frères* (1778), Judge of the Admiralty Court, sitting in prize, interpreting a Treaty of 1670 between England and Denmark; and *The Vryheid* (No. 1) (1778), Judge of the Admiralty Court, sitting in prize, interpreting a Treaty of 1674 between England and Holland).

²⁵² Presently, the French statute has several *droit moral* provisions, but only one, Article L. 121-1 of the Intellectual Property Code, secures by itself both of the Article 6*bis* rights, guaranteeing the author a “right to respect for his name, his authorship, and his work.” Code Propriété Intellectuelle [C. PROP. INTELL.] art. L. 121-1 (Fr.). This ambiguous provision is uniformly recognized as embracing both a broad right of attribution and a strong right of integrity. See J.A.L. STERLING, WORLD COPYRIGHT LAW § 8.08, at 284 (1999).

²⁵³ See Copyright Amendment Act, 1931 S.C., ch. 8, § 12(7) (Can.); Copyright Act, R.S.C., ch. C-42, §§ 14.1, 28.1 (1985) (Can.); see also GOLDSTEIN INTERNATIONAL COPYRIGHT, *supra* note 4, at 284. The Canadian Supreme Court had already, without any statute, recognized moral rights surviving transfer of economic interests as early as 1911. See *Morang & Co. v. Le Seuer*, [1911] 45 S.C.R. 95, 97–98 (Can.) (“Nor could the author be denied by the publisher the right to make corrections, in dates or otherwise, if such corrections were found to be necessary for historical accuracy; nor could the manuscript be published in the name of another. After the author has parted with his pecuniary interest in the manuscript, he retains a species of personal or moral right in the product of his brain.”).

In the case of the United Kingdom, we have already discussed the 1952 parliamentary report that concluded that moral rights as such were unknown in English jurisprudence and a matter best left to “contract between the parties concerned.”²⁵⁴ During their 1956 copyright law revision, the United Kingdom codified a small piece of a modern statutory moral-rights system.²⁵⁵ Section 43 of the 1956 Copyright Act addressed false attribution of authorship. Its provisions were narrowly tailored to circumstances where an author’s name was “insert[ed] or affix[ed] . . . in or on a work of which that person is not the author.”²⁵⁶ False-attribution liability expressly extended to distribution of falsely labeled copies,²⁵⁷ public exhibition of a falsely labeled work,²⁵⁸ false attribution in a public performance or broadcast,²⁵⁹ and false attribution of adaptations.²⁶⁰ The 1956 U.K. law provided the author with neither any positive right of attribution (i.e., it did not provide a cause of action against nonattribution) nor any right against false attribution of the author’s work to third persons. An express right of integrity was similarly absent from English law²⁶¹ until an elaborate statute covering both Article 6*bis* rights was passed by Parliament in 1988.²⁶² During this sixty-year period of U.K. adherence to Berne Article 6*bis*, British law “left authors to secure protection for moral interests” through a composite of contract law and common law causes of action—defamation, injurious falsehood, passing-off, and privacy violations.²⁶³ It is also worth recognizing that the common law portion of the British composite

²⁵⁴ See discussion *supra* part III.

²⁵⁵ Copyright Act, 1956, 4 & 5 Eliz. 2, c.74, § 43 (U.K.). The U.K. Fine Arts Copyright Act 1862 had a provision prohibiting the selling of copies of an altered work as or in replacement of the original, unaltered work. 25 & 26 Vict., c. 68, § 7 (1862) (U.K.) This arguably provided some right of integrity protection in the period from 1862 until 1956.

²⁵⁶ Copyright Act, 1956, 4 & 5 Eliz. 2, c.74, § 43(2)(a) (U.K.).

²⁵⁷ *Id.* § 43(2)(a), (c).

²⁵⁸ *Id.* § 43(2)(b).

²⁵⁹ *Id.* § 43(2)(d).

²⁶⁰ *Id.* § 43(3).

²⁶¹ One practitioner guide states that “[p]rior to the [1988 amendments], English law did not recognize moral rights as such. The Copyright Act 1956 simply prohibited the false attribution of authorship in a protected work.” BAKER & MACKENZIE’S GUIDE TO INTELLECTUAL PROPERTY IN THE I.T. INDUSTRY 28 (Robert Hart ed. 1998).

²⁶² Copyright, Designs, and Patents Act (CDPA), 1988, c.48 (U.K.). See also *supra* note 39 and accompanying text.

²⁶³ Lionel Bently, *United Kingdom*, in 2 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at UK-89 (Paul Edward Geller ed., 2006). See *Prince Albert v. Strange*, (1849) 64 Eng. Rep. 293 (disclosure of confidential materials); *Ridge v. English Illus. Mag.*, [1911–16] Mag Cas. 91 (K.B. 1913); *Humphries v. Thompson*, [1905–10] Mag Cas. 148 (K.B. 1908); *Archibold v. Sweet*, [1832] 172 Eng. Rep. 947 (defamatory or injurious falsehood); *Clark v. Assoc. Newspapers*, [1998] 1 All E.R. 959 (Comm.); *Samuelson v. Producer’s Dist.*, (1932) 1 Ch. 201 (passing off). But see *Sweeny v. MacMillan Publishers*, [2002] R.P.C. 651, ¶¶ 78–83 (rejecting passing off claim).

was arguably weaker than its American counterpart because of our more robust right of privacy.²⁶⁴

Since its inception, the Berne Convention has applied to Australia, first as a British colony and then, since 1928, as an independent signatory.²⁶⁵ Until 1956, British imperial copyright applied directly to Australia, so questions of Australia's Berne compliance until that date are generally subsumed under the analysis applied to the United Kingdom. In 1958, the Australian Attorney-General appointed a committee to study copyright issues (the "Spicer Committee") and, not surprisingly, the committee concluded that Australian copyright law complied with Article 6*bis* through the same composite of causes of action that British jurists had embraced.²⁶⁶ And again, this conclusion was reached while the common law portion of the Australian composite was arguably weaker than its American counterpart because "Anglo-Australian [common] law does not recognize privacy interests."²⁶⁷ The Australians did not codify moral rights provisions until their *Copyright Amendment (Moral Rights) Act 2000*.²⁶⁸ New Zealand fell literally midway between its two larger Commonwealth colleagues, more or less adopting the U.K moral rights statute in 1994.²⁶⁹

As mentioned earlier, Switzerland, also an 1887 Berne signatory,²⁷⁰ spent decades fulfilling its Article 6*bis* obligations with only the general provision in its Civil Code protecting an individual's right of personality, including honor,

²⁶⁴ Nimmer, *supra* note 1, at 523 n.132 (noting that "unlike the United States, the United Kingdom does not recognize the right of privacy in the full sense of the United States cause of action").

²⁶⁵ SAM RICKETSON, *INTELLECTUAL PROPERTY: CASES, MATERIALS AND COMMENTARY* 349 (1994).

²⁶⁶ "The Spicer Committee concluded that common law remedies existing at the time, such as contract law and the laws preventing defamation, were adequate to enable Australia to meet the requirements of the Berne Convention by indirectly protecting the author's moral rights." SAINSBURY, *supra* note 4, at 32.

²⁶⁷ 10th *Cantanae Pty Ltd. v. Shoshana Pty Ltd.* (1987) 79 A.L.R. 299. *See also* *Austral. Broad. Comm'n v. Lenah Game Meats Pty Ltd.* (2001) 208 C.L.R. 199, 213 (confirming the lack of a right of privacy under Australian common law).

²⁶⁸ Copyright Amendment (Moral Rights) Act, 2000, No. 159 (Austl.), *available at* [http://www.comlaw.gov.au/ComLaw/Legislation/Act1.nsf/0/EB1A1A9EEC038ABFCA256F72000B5F61/\\$file/159of2000.pdf](http://www.comlaw.gov.au/ComLaw/Legislation/Act1.nsf/0/EB1A1A9EEC038ABFCA256F72000B5F61/$file/159of2000.pdf).

²⁶⁹ *See* Copyright Act 1994, 1994 S.N.Z. No. 143, 4, §§ 94-97; *see also* SUZY FRANKEL & GEOFF MCLAY, *INTELLECTUAL PROPERTY IN NEW ZEALAND* 241-47 (2002) (explaining the development and application of moral rights in New Zealand).

²⁷⁰ For a list of Berne member states, the date they initially became members of the Convention, and the latest version of the Convention to which each member is an adherent, *see* Berne Convention for the Protection of Literary and Artistic Works, Status on April 13, 2007, *available at* <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/berne.pdf> [hereinafter *Berne Status 2007*]. Switzerland is listed as a party to the Paris (1971) revision of the Convention. *Id.* at 11.

reputation, and privacy.²⁷¹ Specific provisions recognizing Article 6*bis* rights were not codified into Swiss law until 1992,²⁷² four years after the United States joined Berne.²⁷³ Belgium also lacked a codified right of attribution until 1994.²⁷⁴

In short, when the then Director-General of WIPO endorsed the view in 1987 that a patchwork of common law causes of action could fulfill Article 6*bis*,²⁷⁵ he had a good foundation in the historic and then current practices of several Berne members. That treaty provisions may be given very broad, almost counterintuitive interpretations is compatible with the principle of *pacta sunt servanda* if that principle is understood “as part of the more general principle of legitimate expectation.”²⁷⁶ By 1988, the members of the Berne Convention should have legitimately expected that an adhering party would comply without express statutory provisions in its copyright law (Switzerland) and with only court-established doctrines, whether civil law (France, Belgium) or common law (Britain, Australia). And the United States could legitimately expect that that is what the other Berne member states would expect. Moreover, since 1988, formal diplomatic objections to the United States’ compliance with Article 6*bis* have been rare and oblique.²⁷⁷

²⁷¹ Schweizerisches Zivilgesetzbuch [ZGB] [Civil Code] Dec. 10, 1907, SR 210, art. 28 (Switz.). For a brief discussion of Swiss moral rights, see Francois Dessemontet, *Switzerland*, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at SWI-56 to SWI-61 (Paul Edward Geller ed., 2006).

²⁷² Dessemontet, *supra* note 271 (discussing art. 9 of the Swiss Copyright Act). See also Rigamonti, *supra* note 44, at 392.

²⁷³ Berne Status 2007, *supra* note 270.

²⁷⁴ The right of paternity is now codified in Article 1(2) of the 1994 Copyright Act, but prior to that “this right did not figure in the [statutory] law.” STROWEL, *supra* note 20, para. 393(2), at 504. Nonetheless, the Berne Convention applied directly to individuals in Belgium, so a right of attribution unquestionably existed. Email from Alain Strowel, Professor of Law, Facultés universitaires Saint-Louis, Belgium to author (Sept. 27, 2004, 06:48 EST) (on file with author).

²⁷⁵ In 1987, WIPO Director-General Dr. Arpad Bogsch sent a letter to Irwin Karp, which became part of the Congressional Record on Berne accession and implementation. Bogsch wrote:

In my view, it is not necessary for the United States of America to enact statutory provisions on moral rights . . . to comply with Article 6*bis* of the Berne Convention. The requirements under this Article can be fulfilled not only by statutory provisions in a copyright statute but also by common law and other statutes.

H.R. REP. NO. 100-609, at 37 (1988).

²⁷⁶ BYERS, *supra* note 249, at 175.

²⁷⁷ In recent years the European Commission has suggested that “problematic” moral rights protection in the United States constitutes a trade barrier, a curious conclusion considering that moral rights are considered paradigmatically non-economic, so much so that the Commission does not even have *competence* in the field of moral rights. See European Commission, *United States Barriers to Trade and Investment: Report for 2006*,

B. Comparative Current Compliance

Yet as Maree Sainsbury notes “[i]n the context of moral rights, there is an overwhelming international trend towards providing direct moral rights protection in legislation specifically designed for the purpose, rather than relying on indirect protection to protect the rights of integrity and attribution.”²⁷⁸ For example, in addition to the countries discussed above, China’s 1990 copyright statute included for the first time rights of integrity, alteration, attribution, and first publication identified as personality rights, separate from property rights.²⁷⁹ Malaysia also promulgated an intricate moral rights provision in 1990 when it acceded to the Berne Convention.²⁸⁰ The current WIPO model law for copyright apparently includes express rights of integrity and attribution, with the latter broken into express language on attribution, anonymity, and pseudonyms.²⁸¹

The question is whether this change in national practices could alter the proper interpretation of Article 6*bis* against a party who joined the treaty before the establishment of the new standard for national implementation of the Article 6*bis* obligation.²⁸²

14 (2007); European Commission, *United States Barriers to Trade and Investment: Report for 2005*, 5, 68–69 (2006); European Commission, *Report on United States Barriers to Trade and Investment 2004*, 8, 65–66 (2004). The 2005 and 2004 reports all but accuse the United States of being out of compliance with Berne Article 6*bis*, while the 2006 report does not explore the issue in depth.

²⁷⁸ SAINSBURY, *supra* note 4, at 16.

²⁷⁹ Zhu zuo quan fa [Copyright Law] (promulgated by the Standing Comm. Nat’l People’s Cong., Sept. 7, 1990, effective June 1, 1991), art. 10 (P.R.C.). The separate rights of “integrity” and to control “alterations” seem duplicative or overlapping.

²⁸⁰ Copyright Act 1987, § 25 (1987) (Malay.). Email from Ida Madieha Abdul Ghani Azmi, Professor, International Islamic University of Malaysia, to author (Sept. 28, 2004, 20:56 EST) (on file with author).

²⁸¹ When consulting with developing countries that are modernizing their copyright laws, WIPO generally claims that they do not use a model law. Understandably, an official model law could become a political football match between the United States and the European Union over provisions like moral rights. But in 2003, Laos, in consultation with WIPO, prepared a draft copyright law which appears to reflect the WIPO model. *See* Draft Law on Copyright and Related Rights for the Lao People’s Democratic Republic (on file with the author).

²⁸² *See, e.g.,* Harold J. Berman & Colin Kaufman, *The Law of International Commercial Transactions* (Lex Mercatoria), 19 HARV. INT’L L. J. 221, 254 (1978) (noting in the context of international *lex mercatoria* that “[i]t is not always easy . . . to determine . . . common understandings, especially as they shift with changing commercial practices” but that American courts have “been more willing than courts of many other countries” to accept shifts in practices as evidence of shifts in common understandings of law and legal obligations). The use of modern practices—as expressly contrasted with different, historic practices—to understand the content of the treaty obligation is different than the suggestion of some scholars that more recent intellectual property treaty provisions are proper evidence for the interpretation of ancestor treaty obligations. *See, e.g.,* Neil W. Netanel, *The Next Round: The Impact of the WIPO Copyright Treaty on TRIPS Dispute*

First, it seems unlikely that the recent change in national practices in recognizing authorial rights of attribution and integrity could tighten the proper interpretation of Article 6*bis*. Whatever the trend of the past twenty-five years, there were decades of state practice following the initial establishment of Article 6*bis*; that early practice is privileged in informing the interpretation of Article 6*bis*; and new practice should only modify such an interpretation after a much longer period of widespread and consistent state action. Related to this point, the amount of leeway contracting states are given in implementing treaty obligations can vary from treaty to treaty. In the case of the Berne Convention, there has been a significant amount of deference to states in permitting them to make their own interpretation of the Convention's obligations.²⁸³ Deference to national interpretation of treaty provisions is embodied in the interpretative canon *in dubio mitius*, if a provision is ambiguous, "the preferred meaning is the one that is the least onerous to the party assuming an obligation . . . or that involves the fewest general restrictions on the parties."²⁸⁴ Deferential interpretation is inextricably linked to, if not founded on, the positivist idea in international law that a state can only be bound to those obligations to which it has consented, consent being strictly construed.²⁸⁵

Settlement, 37 VA. J. INT'L L. 441, 447 (1997) (reasoning that, to some extent, "the WIPO Copyright Treaty and Agreed Statements in fact constitute subsequent agreement and state practice under Berne and TRIPS"); Pamela Samuelson, *The U.S. Digital Agenda at WIPO*, 37 VA. J. INT'L L. 369, 406–07 (1997) (suggesting that the negotiating history of the 1996 WIPO Copyright Treaty could be used in WTO dispute resolution to interpret the proper scope of Article 13 of the TRIPS Agreement).

²⁸³ Graeme B. Dinwoodie, *The Development and Incorporation of International Norms in the Formation of Copyright Law*, 62 OHIO ST. L.J. 733, 740 (2001) (discussing "deference shown member states' own interpretation of what was required to comply with the Convention").

²⁸⁴ Richard H. Steinberg, *Judicial Lawmaking at the WTO: Discursive, Constitutional, and Political Constraints*, 98 AM. J. INT'L L. 247, 258 (2004). See generally 2 OPPENHEIM'S INTERNATIONAL LAW 1278 (Robert Jennings & Arthur Watts eds., 9th ed. 1992); James Cameron & Kevin R. Gray, *Principles of International Law in the WTO Dispute Settlement Body*, 50 INT'L & COMP. L.Q. 248, 254 (2001). WTO panels have recognized this principle in interpreting GATT and WTO obligations. See Appellate Body Report, *European Communities—Measures Concerning Meat and Meat Products (Hormones)*, ¶ 165 n.154, WT/DS26/AB/R, WT/DS48/AB/R (Jan. 16, 1998).

²⁸⁵ The principle of deference to national interpretation seems to have spawned an offshoot in European human rights jurisprudence—the margin of appreciation. See HOWARD C. YOUROW, *THE MARGIN OF APPRECIATION DOCTRINE IN THE DYNAMICS OF EUROPEAN HUMAN RIGHTS JURISPRUDENCE* 9, 15–16 (1996); Laurence R. Helfer, *Finding a Consensus on Equality: The Homosexual Age of Consent and the European Convention on Human Rights*, 65 N.Y.U. L. REV. 1044, 1052–59 (1990). The principle appears to have developed to provide deference to state action in time of national emergency (such as during IRA terrorism). Such deference in application of Berne provisions is arguably visible in the WTO panel's May 2000 decision concerning the United States' Fairness in Music Licensing Act. Panel Report, *United States—Section 110(5) of the U.S. Copyright Act*, WT/DS160/R (June 15, 2000), available at http://www.wto.org/english/tratop_e/

In the case of Berne Article 6*bis*, deference to national interpretation is appropriate not only because of varied state practice historically, but because of varied state practice currently: France's limitation of moral rights in software,²⁸⁶ the exception-riddled moral rights statute in the United Kingdom,²⁸⁷ special regimes for particular kinds of works in Germany and the United States,²⁸⁸ etc. While national moral rights laws probably do not range as widely as national limitations and exceptions to copyright, they arguably range more widely than national implementation of the right of reproduction or even national implementation of the new international legal norm protecting digital locks from circumvention.²⁸⁹

Finally, even if national practices could trigger a new, stricter interpretation of Article 6*bis*, it is not at all clear that that interpretation could be applied against members who joined the Convention before the new consensus on national practices. Cogent estoppel and acquiescence arguments can be made under public international law²⁹⁰ by which the United States should be permitted to continue with "weak implementation" of Article 6*bis*. Estoppel has been an accepted principle of public international law since at least the Permanent Court of International Justice's (PCIJ) 1928 decision in *Concerning the Factory at Chorzow*.²⁹¹ While often applied to territorial claims,²⁹² estoppel has grounded the

dispu_e/cases_e/ds160_e.htm. Although the Panel found that the Act was a violation of TRIPS, as Graeme Dinwoodie has noted, "The report contains several passages apparently exhibiting substantial deference to national autonomy. Indeed, in many respects, the panel's level of deference contains an echo of pre-TRIPS attitudes to compliance." Dinwoodie, *supra* note 283, at 765. This pervasive national autonomy is not rooted in seven years of state practices vis-à-vis TRIPS Article 13; it is rooted in decades of varied state practices vis-à-vis Berne Article 9(2).

²⁸⁶ Code Propriété Intellectuelle [C. PROP. INTELL.] art. L. 121-7 (Fr.).

²⁸⁷ See generally Rigamonti, *supra* note 44, at 400-04.

²⁸⁸ The American VARA provisions were discussed extensively. See *supra* note 70-84 and accompanying text. For Germany's special regime for right of integrity with motion pictures, see Section 93(1), Urheberrechtsgesetz [UrhG] [Copyright Law], Sept. 9, 1965, BGBI. I at 1273, last amended by Gesetz, Sept. 10, 2004, BGBI. I at 1774.

²⁸⁹ Established by Article 11 of the WCT, *supra* note 86. See generally Justin Hughes, *The Internet and the Persistence of Law*, 44 B.C. L. REV. 359, 375-376 (2003) (discussing consistent U.S. and E.U. implementation of Article 11).

²⁹⁰ Keith Highet & George Kahale III, *International Decisions*, 89 AM. INT. L. J. 376, 382-383 (1995) ("The doctrine of estoppel, as it operates in public international law and EC law, serves to protect the settled expectations of states that relied in good faith on clear and unambiguous representations by another state by precluding the latter from subsequently adopting different statements.").

²⁹¹ (Ger. v. Pol.) 1928 P.C.I.J. (ser. A) No. 17, at 33-34 (Sept. 13) (recognizing estoppel as a "general principle of International Law by civilized nations"). See, e.g., *Concerning the Temple of Preah Vihear* (Cambodia v. Thail.), 1962 I.C.J. 6, 40 (separate opinion of Judge Alfaro); Georg Schwarzenberger, *Fundamental Principles of International Law*, 87 RECUEIL DES COURS 195, 301 (1955).

²⁹² See, e.g., *Fisheries* (U.K. v. Nor.), 1951 I.C.J. 116 (Dec. 18). In the 1951 *Fisheries* case, the United Kingdom objected to Norway's system of calculating the Norwegian

ICJ's procedural conclusions at least once²⁹³ and it is reasonable to argue that in putting forward its "patchwork" protection, the United States relied on the conduct exhibited by many prominent Berne members (and tolerated by all others) up until 1988.²⁹⁴

VII. CONCLUSION

Reviewing America's 1988 commitment to Berne moral rights with fifteen years of hindsight, William Patry concluded that "it was crystal clear that U.S. law provided no such rights" and that "the Reagan Administration and Congress engaged in the charade of claiming that the United States already had adequate moral rights to permit adherence."²⁹⁵ But by 1988 multiple commissions and scholars in multiple common law jurisdictions had reached a very different conclusion: that a patchwork of causes of action provided roughly similar rights. Australia, New Zealand, and the United Kingdom were Berne signatory for decades without statutory moral rights; France itself had run solely on judge-created rights for three decades of Berne obligations; Switzerland had fulfilled its obligations with a scanty code provision robustly construed. Either the charade was enormously widespread, or widespread diversity of national practices had established broad leeway in national implementation of Article 6bis.

Because § 43(a) of the Lanham Act figured prominently in all narratives about patchwork protection, there is no question that the *Dastar* decision punched a hole in the patchwork. The motivating force behind the *Dastar* decision—to keep public domain materials wholly unencumbered—was correct. But that critical goal could have been achieved in a way that would have been more sensible for both the Lanham Act and our Berne Article 6bis obligations. Instead, *Dastar*'s policy-driven reading of "origin" in § 43(a) has been extended somewhat mindlessly by courts to other elements of § 43(a) and to reinterpretation/preemption of state

coastline because it pushed Norwegian waters into territory that Britain considered open seas. The ICJ, however, noted that "th[e] system [of delimitation] was consistently applied by Norwegian authorities," *id.* at 136–37, and that "[f]or a period of more than sixty years the United Kingdom Government itself in no way contested it," *id.* at 138. On this basis, the ICJ ruled in favor of Norway. *Id.* at 139–143.

²⁹³ *Concerning Military and Paramilitary Activities in and Against Nicaragua* (Nicar. v. U.S.), 1984 I.C.J. 392 (Nov. 26) (United States estopped from disputing jurisdiction under Article 36(2) of the Statute of the Court). See also Megan L. Wagner, Comment, *Jurisdiction by Estoppel in the International Court of Justice*, 74 CAL. L. REV. 1777 (1986).

²⁹⁴ Jurists of international law vary on whether estoppel in international law requires reliance and detriment, but the United States would be able to argue such reliance and detriment. For a view that reliance is required, see Judge Fitzmaurice in the *Preah Vihear Temple* case, 1962 I.C.J. 6, 63–64. For the view that reliance is not required, see *Legal Status of Eastern Greenland* (Den. v. Nor.), 1933 P.C.I.J., (ser. A/B), No. 53, at 68 (Apr. 5).

²⁹⁵ William Patry, *The United States and International Copyright Law: From Berne to Eldred*, 40 HOUS. L. REV. 749, 751 (2003).

unfair competition laws. All this has made the “*Dastar* gap” larger than it need have been. At the same time, the discussion above has shown that the new gap in Article 6*bis* protection created by *Dastar* may be, practically speaking, quite small. In particular, the complexity of § 43(a)’s wording may mean that a *Gilliam*-style misattribution will still be actionable under § 43(a) as a misrepresentation of fact. Section 1202 of the Copyright Act, VARA, state law moral rights statutes, state law reverse-passing-off claims, and contract law have all been discussed as factors narrowing the real *Dastar* gap.

To some Europeans, the gap—no matter how small—will comport with their vision of America as a place that cares more about commerce than culture. This is an enduring, probably permanent, theme in transatlantic relations. In *Democracy in America*, Alexis de Toqueville observed that in America “there is no class . . . in which the taste for intellectual pleasures is transmitted with hereditary fortune and leisure and by which the labors of intellect are held in honor.”²⁹⁶ An American looking at continental European moral rights in 1940 lamented that “[b]usy with the economic exploitation of her vast natural wealth, America has, perhaps, neglected the arts,”²⁹⁷—a strange thing to write while Europeans were busy waging World War II on one another.

If you adhere to a pure economic incentive view of American copyright law, then it may be a waste of judicial resources to “require[e] that courts adjudicate disputes relating to attribution in cases where attribution offers no market benefits”²⁹⁸—that is, it may be a waste of time to fix a relatively small problem with no economic import. On the other hand, if you believe that attribution and recognition are quite important to authors regardless of the economic benefits, then—while still respecting the public domain spirit of the Court’s decision—the *Dastar* gap would be an easy thing to fix.

²⁹⁶ ALEX DE TOQUEVILLE, 1 *DEMOCRACY IN AMERICA* 52 (Phillips Bradley, trans., Vintage Books 1st ed. 1990).

²⁹⁷ Roeder, *supra* note 34, at 557.

²⁹⁸ Band & Schruers, *supra* note 228, at 11.