

NO NEED TO SEARCH THE NILE: THE SUPREME COURT
CLARIFIES THE USE OF PUBLIC DOMAIN WORKS IN
DASTAR v. TWENTIETH CENTURY FOX

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I. INTRODUCTION

In *Dastar Corp. v. Twentieth Century Fox Film Corp.*,¹ the Supreme Court examined the intersection between copyright and trademark law. In particular, the Court addressed whether the Lanham Act² prohibited unaccredited copying of a work in the public domain.³ With this decision, the Court enunciated a clear rule regarding the use of works in the public domain and clarified the distinction between copyright and trademark law.⁴ The essence of the decision is that individuals are free to use materials in the public domain without attributing those materials to the original source.⁵ The Supreme Court recognized that a creative work, like a river, flows from many sources, and that the Lanham Act does not require a user of public domain works to “search for the source of the Nile and all its tributaries”⁶ to properly attribute all contributors to the work.⁷

Previously, an author of a work in the public domain could demand attribution in a new work that incorporated his work.⁸ Authors were able to do this by claiming reverse passing off, a violation of the Lanham Act.⁹ Reverse passing off consists of selling a product on which you have

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

2. 15 U.S.C. § 1125(c) (2000).

3. *Dastar Corp.*, 539 U.S. at 25.

4. David G. Savage, *Justices Fine-Tune Coverage of Trademark Act*, L.A. TIMES, June 3, 2003, at A18.

5. Eugene Quinn, *Dastar v. Fox: Public Domain Wins in the US Supreme Court*, JURIST (June 4, 2003), at <http://jurist.law.pitt.edu/forum/forumnew112.php>.

6. *Dastar Corp.*, 539 U.S. at 39.

7. Madhavi Sunder, *In a Trademark Case, The Supreme Court Recognizes That Art Flows From Multiple Sources*, FINDLAW'S WRIT (June 12, 2003), at http://writ.findlaw.com/commentary/20030612_sunder.html.

8. *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981).

9. Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught in the Crossfire Between Copyright and Section 43(a)*, 77 WASH. L. REV. 985, 1003 (2002) (“[a]s an alternative to copyright law, plaintiffs have attempted to invoke section 43(a) of the Lanham Act to safeguard their attribution rights.”).

either replaced, or rendered unreadable, the marks identifying the true origin of the product.¹⁰ In this context, a reverse passing off claim would arise when an author incorporates a public domain work into a new work without attributing the author of the public domain work. This interpretation of the Lanham Act required attribution of public domain works which made it illegal “to misappropriate or profit from another’s talent and workmanship.”¹¹ Extending Lanham Act protection for talent and workmanship created a conflict with copyright law, which was already responsible for such protection.¹² To eliminate this overlap, the Court clarified the differences between copyright law and trademark law. In so doing, it held that trademark law, unlike copyright law, was not intended to protect originality or creativity; instead, it was created to protect consumers from unfair practices.¹³

Various commentators hailed this decision. For instance, a lawyer for the American Library Association lauded the decision for “removing a cloud that has been hanging over libraries and authors who use preexisting materials.”¹⁴ Professor Eugene Quinn was pleased with the decision’s ability to convey what the federal courts have tried to for several years: that “trademark law cannot be used as a subterfuge to extend the limited exclusivity enjoyed by copyrights and patents.”¹⁵

After examining the factual background of *Dastar* in Part II, Part III analyzes the state of the law prior to the Court’s decision. Part IV details the Supreme Court’s decision and implications. Finally, Part V examines *Dastar*’s implications for the future.

II. FACTUAL AND PROCEDURAL BACKGROUND

In 1948, General Dwight D. Eisenhower wrote a book about the Allied Campaign in Europe during World War II.¹⁶ Doubleday Publishing purchased his book, *Crusade in Europe*.¹⁷ Doubleday copyrighted the book and sold the exclusive television rights to Twentieth Century Fox Film Corporation (“Fox”).¹⁸ Fox then hired

10. JEROME GILSON, TRADEMARK PROTECTION & PRACTICE § 7.02[5][b] (2003); see, e.g. *Dastar*, 123 S. Ct. at 2047 (providing that an example of reverse passing off would be selling Pepsi with a Coca-Cola label on it).

11. *Montoro*, 648 F.2d at 607. See, e.g. *Lamothe v. Atlantic Recording Corp.*, 847 F.2d 1403, 1406 (9th Cir. 1988) (“Implied reverse passing off is accomplished simply by removing or obliterating the name of the source and then selling the product in an unbranded state.”); *Roho Inc. v. Marquis*, 902 F.2d 356, 359 (5th Cir. 1990) (“Traditional and reverse palming off activities have both been recognized as wrongful because they involve attempts to misappropriate another’s talents.”); *Walker Mfg. v. Hoffmann, Inc.*, 261 F. Supp. 2d 1054, 1072 (N.D. Iowa 2003).

12. Petitioner’s Reply Brief at *1, *Dastar Corp. v. Twentieth Century Fox*, 123 S. Ct. 2041 (2003) (No. 02-428).

13. *Dastar Corp.*, 539 U.S. at 34.

14. *Savage*, *supra* note 4, at A18.

15. *Quinn*, *supra* note 5.

16. *Dastar Corp.*, 539 U.S. at 25.

17. *Id.*

18. *Id.*

Time Inc. (“Time”) to create the corresponding television series, *Crusade in Europe*, which consisted of twenty-six episodes first broadcast in 1949.¹⁹ Fox copyrighted this television series.²⁰ While Doubleday renewed the book’s copyright in 1975, Fox failed to renew the television series’ copyright, allowing the series to enter the public domain in 1977.²¹

In 1988, Fox repurchased the television rights to *Crusade in Europe*.²² Furthermore, Fox purchased the exclusive right to distribute *Crusade in Europe* on videotape and the ability to sub-license the right to distribute the videotape to other companies.²³ Fox then contracted with SFM Entertainment (“SFM”) and New Line Home Video Inc. (“New Line”), giving them the exclusive right to distribute the videotape.²⁴ SFM restored the negatives from the original television series and repackaged the series on videotape.²⁵ New Line then sold the videotapes to the public.²⁶

Then in 1995, Dastar Corporation (“Dastar”) purchased copies of the original television series, which was now in the public domain.²⁷ Dastar copied those tapes and edited them into a new videotape series, which it named *World War II: Campaigns in Europe*.²⁸ Other than altering the opening and closing sequences, the content of the videos was essentially the same.²⁹ Dastar sold these videotapes for significantly less money than New Line’s licensed copy of the original television series.³⁰ Neither *Crusade in Europe* the television series, nor the book it was based upon received attribution or credit in the *Campaigns in Europe* tapes or packaging.³¹

New Line, SFM, and Fox sought to avoid competing with the less expensive and unlicensed *Campaigns in Europe*. To protect their interests, the trio filed suit in federal district court alleging, *inter alia*, that the Dastar videotapes violated federal trademark law.³² In an unpublished opinion, Judge Florence-Marie Cooper of the United States District Court for the Central District of California granted summary judgment in favor of Fox.³³ The Ninth Circuit affirmed the judgment on the Lanham Act claim.³⁴ The U.S. Supreme Court granted certiorari as

19. *Id.*

20. *Id.*

21. *Id.*

22. *Id.*

23. *Id.*

24. *Id.*

25. *Id.*

26. *Id.*

27. *Id.*

28. *Id.*

29. *Id.*

30. *Id.*

31. *Id.*

32. Twentieth Century Fox Film Corp. v. Dastar Corp., No. 98-7189, 2000 U.S. Dist. LEXIS 22064, at *1 (C.D. Cal. Nov. 27, 2000).

33. *Id.*

34. Twentieth Century Fox Film Corp. v. Entm’t Distrib., 34 Fed. Appx. 312, 314 (9th Cir. 2002).

to whether the Lanham Act prohibited the unaccredited copying of a public domain work.³⁵

III. THE CIRCUIT SPLIT

The competitive practice at issue in *Dastar* was reverse passing off,³⁶ also known as reverse palming off. Reverse passing off occurs when someone without authorization removes or obscures the original trademark on a product and sells the product either unbranded, or with a mark other than the original trademark.³⁷ This “includes situations in which a defendant markets another’s product that has been only slightly modified and then relabeled.”³⁸ Behavior of this type violates § 43(a) of the Lanham Act’s prohibition on causing confusion, mistake, or deception regarding the origin of a good.³⁹

In the past, reverse passing off claims provided protection when copyright remedies were unavailable to the author of the original work.⁴⁰ In some courts, the standard necessary to prove reverse passing off originated from the standard necessary to prove copyright infringement.⁴¹ When the Ninth Circuit decided *Dastar*, the circuits were divided as to whether copying the creation of another without proper attribution was enough to trigger Lanham Act liability under § 43(a).⁴²

In deciding *Dastar*, the Ninth Circuit followed the rules set forth in a line of cases beginning with *Smith v. Montoro*. In *Montoro*, the court allowed an actor to proceed with a reverse passing off claim against a film distribution company.⁴³ The film distributor removed the actor’s name from the film’s credits and advertising, and put another name in its place.⁴⁴ The court found that “[a]s a matter of policy, such conduct, like traditional palming off, is wrongful because it involves an attempt to misappropriate or profit from another’s talents and workmanship.”⁴⁵ From then on, the Ninth Circuit has held that a “bodily appropriation” of

35. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 537 U.S. 1099 (2003).

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

37. GILSON, *supra* note 10.

38. *Pioneer Hi-Bred Int’l v. Holden Found. Seeds, Inc.*, 35 F.3d 1226, 1241 (8th Cir. 1994); *see also Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d 1434, 1437 (9th Cir. 1993).

39. 15 U.S.C. § 1125(a)(1) (2000).

40. *See, e.g., Waldman Publ’g Corp. v. Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994) (allowing a reverse passing off claim to go forward when a copyright claim was unavailable).

41. *Attia v. Soc’y of the N.Y. Hosp.*, 201 F.3d 50, 59 (2d Cir. 1999) (“[I]n determining whether [the plaintiff] had made out a claim of reverse passing off under the Lanham Act, we ruled that plaintiff needed to satisfy the same standard of ‘substantial similarity’ that must be met in copyright cases.”).

42. Petitioner’s Reply Brief at *8, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02-428).

43. 648 F.2d at 608.

44. *Id.* at 603.

45. *Id.* at 607.

another's work is enough to trigger § 43(a) liability.⁴⁶ The Ninth Circuit took its definition of bodily appropriation—"copying or unauthorized use of substantially the entire item"⁴⁷—from copyright law and applied it to trademark law.⁴⁸

The Second Circuit required a less rigorous "substantial similarity" test.⁴⁹ The substantial similarity test called for comparing the similarities between two works, not counting the differences.⁵⁰ This standard "[is] essentially the 'substantial similarity' standard used to show copyright infringement . . . [The court found] this standard an appropriate one for determining false designation of origin under the Lanham Act."⁵¹ Other circuits, however, have found that proof of copying alone is not enough to trigger trademark liability.⁵²

IV. THE SUPREME COURT DECISION

The Supreme Court granted certiorari in *Dastar* to resolve the issue of "whether § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), prevents the unaccredited copying of a work."⁵³ The Court resolved the issue with an 8-0⁵⁴ decision handed down in June 2003.⁵⁵ In its opinion, the Supreme Court reversed the Ninth Circuit's decision and held that trademark law does not prevent the unaccredited copying of an uncopyrighted work.

Justice Scalia, writing for the Court, refused to extend the Lanham Act to include the copying of public domain works without attribution to the original author. He stated that extending the Lanham Act in that manner would "create[] a species of perpetual . . . copyright, which Congress may not do."⁵⁶ In ruling that unaccredited copying of public domain works was not within the purview of § 43(a), the Court examined the purpose of § 43(a) and the meaning of the word "origin" within the statute.

46. See *Twentieth Century Fox Film Corp. v. Entm't Distrib.*, 34 Fed. Appx. 312, 314 (9th Cir. 2002) (citing *Cleary v. News Corp.*, 30 F.3d 1255, 1261-62 (9th Cir. 1994)) ("Dastar's 'bodily appropriation' of Fox's original series is sufficient to establish the reverse passing off, because the 'bodily appropriation' test subsumes the 'less demanding 'consumer confusion' standard."). See also *Cleary*, 30 F.3d at 1261 ("It is not enough that the misattributed material is 'substantially similar;' instead, there must be 'bodily appropriation.'").

47. *Cleary*, 30 F.3d at 1261 (quoting *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989)).

48. *Id.*

49. *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 783 (2d Cir. 1994).

50. *Attia v. Soc'y of the N.Y. Hosp.*, 201 F.3d 50, 57-58 (2d Cir. 1999).

51. *Waldman Publ'g Corp.*, 43 F.3d at 783.

52. See, e.g., *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 913 F. Supp. 1454, 1472 (D. Kan. 1996) ("If the purpose of the Lanham Act were to protect creative designers by preventing all intentional copying, then plaintiff would prevail. That, however, is not the act's purpose.").

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

54. Justice Breyer did not participate because his brother sat on the panel that heard this case in the Ninth Circuit.

55. *Dastar Corp.*, 539 U.S. at 23.

56. *Id.* at 37.

“The Lanham Act was intended to make ‘actionable the deceptive and misleading use of marks,’ and ‘to protect persons engaged in . . . commerce against unfair competition.’”⁵⁷ However, the Lanham Act is not expansive enough to cover every possible variation of unfair trade practice.⁵⁸ Rather, it applies only to the unfair trade practices specified in the text of the Act itself.⁵⁹

The specific unfair trade practice which Dastar was charged with was reverse passing off. The essence of Fox’s claim was that, by removing Fox’s name from the Dastar video, *Campaigns in Europe*, Dastar had made a false or misleading representation as to the origin of the video.⁶⁰ Fox, however, could have easily protected its interest in *Crusade in Europe* by renewing its copyright. Fox would then have had a strong possibility of proving that *Campaigns in Europe* infringed the copyright for *Crusade in Europe*, the television series.⁶¹ Lacking the ability to pursue copyright claims on the television series, Fox attempted to use trademark law to protect its rights in the *Crusade in Europe* videotape set.

Protection from reverse passing off comes from § 43(a) of the Lanham Act.⁶² Specifically, it arises from the Lanham Act’s prohibition of false or misleading designations of a work’s origin.⁶³ Under the Lanham Act, “origin” covers both the product’s geographic origin and the origin of production.⁶⁴ Fox argued that the term “origin” was expansive enough to cover both the manufacturer of the item and the origination of the idea behind the item.⁶⁵ The Court completely rejected that argument, finding that “the most natural understanding of the ‘origin’ of ‘goods’ . . . is the producer of the tangible products sold in the marketplace”⁶⁶ In fact, it held that the phrase “‘origin of goods’ is incapable of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain.”⁶⁷ The Court even went so far as to state that consumers do not care about an idea’s origins and that the Lanham Act need not protect consumers from things with which consumers are not concerned.⁶⁸

Another argument rejected by the Court was that communicative products such as books and videotapes should have more extensive

57. *Id.* at 28 (citing 15 U.S.C. § 1127 (2000)).

58. *Id.*

59. *Id.*

60. *Id.* at 31.

61. *Id.* at 38 (stating “it would have had an easy claim of copyright infringement.”). It is still an open issue as to whether the Dastar video infringed the copyright in *Crusades in Europe*, the book. *Id.*

62. Catherine Romero Wright, *Reverse Passing Off: Preventing Healthy Competition*, 20 SEATTLE U. L. REV. 785, 789 (1997).

63. Kwall, *supra* note 9.

64. *Dastar Corp.*, 539 U.S. at 29.

65. *Id.* at 31.

66. *Id.*

67. *Id.* at 32.

68. *Id.* at 32-33.

trademark protection.⁶⁹ Central to this argument is the notion that consumers purchase communicative products because they are more interested in the originator of the idea than in the manufacturer of the product.⁷⁰ For example, the purchaser of a Tom Wolfe novel is probably not concerned about which publishing house physically created the book, but likely cares very much whether the work was actually written by Tom Wolfe.⁷¹ The Court refused to create a special class of trademark law to handle the special problems of communicative products because it felt that copyright law already addressed the special needs of communicative products.⁷²

Dastar claimed it had the right to use the footage from *Crusades in Europe* without attribution because the television series was in the public domain.⁷³ In 1977, the copyright for *Crusades in Europe*, the television show, expired.⁷⁴ Dastar argued that once a copyright expires, the material passes into the public domain wherein it is free to be used by the public in any manner whatsoever.⁷⁵ The Court agreed with Dastar, stating that:

unless an intellectual property right such as a . . . copyright protects an item, it will be subject to copying. The rights of a . . . copyright holder are part of a “carefully crafted bargain,” under which, once the . . . copyright monopoly has expired, the public may use the . . . work at will and without attribution. Thus, in construing the Lanham Act, we have been “careful to caution against misuse or over-extension” of trademark and related protections into areas traditionally occupied by . . . copyright.⁷⁶

The Court further noted that the public domain was important as a baseline, allowing people to know how far they are required to go back in time when citing a work that relies on prior works. Without this baseline, the Court felt there would be “no discernible limits” in attributing the originators of a work.⁷⁷ The lack of discernible limits would require authors of creative works in the future to go on massive scavenger hunts for contributing works.⁷⁸

69. *Id.* at 33.

70. *Id.*

71. *Id.*

72. *Id.* at 37.

73. *Id.* at 26

74. *Id.*

75. *See id.* at 33.

76. *Id.* at 33-34 (citations omitted).

77. *Id.* at 35.

78. *Id.*

A video of the MGM film *Carmen Jones*, after its copyright has expired, would presumably require attribution not just to MGM, but to Oscar Hammerstein II (who wrote the musical on which the film was based), to Georges Bizet (who wrote the opera on which the musical was based), and to Prosper Merimee (who wrote the novel on which the opera was based). In many cases, figuring out who is in the line of “origin” would be no simple task.

Id.

The footage at issue in *Dastar* was illustrative of this problem. Fox commissioned Time to obtain the footage for the documentary.⁷⁹ Time, however, did not shoot the film used for the documentary series.⁸⁰ Instead, Time obtained footage taken by the United States Army, Navy, and Coast Guard; the British Ministry of Information and War Office; the National Film Board of Canada; and various unidentified “Newsreel Pool Cameramen.”⁸¹ If users of this public domain footage were required to attribute all of the originators, then each of these organizations would require acknowledgement, along with any other person or entity that helped to create the footage. Requiring attribution for every party who contributed to a work could quickly become unwieldy.

Crediting the originators of a work could also cause more legal difficulties. For example, it could be a trademark violation to attach the original creator’s name to a new product because it could imply that the original creator was involved with the new product.⁸² This would place producers in a strange bind: if they attributed the original product that was used to create their new product, then they could possibly be sued under the Lanham Act for implying “sponsorship or approval” of the new work.⁸³ On the other hand, if Fox had prevailed in this suit, the producer of the new product could be liable for not attributing every contributor.

V. CONCLUSION

This case clarifies the rights and responsibilities of authors. The Court has created a bright-line rule requiring proper attribution only for the use of works outside of the public domain. It is now unambiguous how much attribution is necessary to escape a claim of reverse passing off. The public domain is an appropriate dividing line between material that needs attribution and material that may be used without attribution. Thus, authors will have an easier time determining if they must give or be given attribution for a particular work. The number of Lanham Act claims for improper attribution will likely decrease because the Lanham Act can no longer serve as a substitute for copyright protection.⁸⁴

79. *Id.* at 26.

80. *Id.* at 35.

81. *Id.*

82. *Id.*

83. See 15 U.S.C. § 1125(a)(1)(A) (2000).

84. See Jeff E. Scott & Jordan D. Grotzinger, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, at http://www.gtlaw.com/pub/alerts/2003/scottj_07.pdf (July 2003).