

# WHEN YOU WISH UPON *DASTAR*: CREATIVE PROVENANCE AND THE LANHAM ACT

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## TABLE OF CONTENTS

INTRODUCTION .....	198
I. <i>DASTAR</i> BACKGROUND .....	202
II. THE RATIONALE OF <i>DASTAR</i> .....	206
A. <i>The Court's Unexamined Assumption that Section             43(a) Applies to Reverse Passing Off of Tangible             Goods</i> .....	206
1. Misleading Use of Precedent .....	206
a. False Advertising Precedents .....	207
b. Precedents Involving Expressive Works ...	209
c. <i>Dastar's</i> Failure to Address the Impact of the Trademark Law Revision Act of 1988 .....	210
B. <i>Pre- and Post-Trademark Law Revision Act Versions of             Section 43(a) Compared</i> .....	211
III. LEGISLATIVE HISTORY: EVIDENCE OF CONGRESSIONAL INTENT TO APPLY POST-1988 SECTION 43(a) TO REVERSE PASSING OFF OF EXPRESSIVE WORKS .....	219
A. <i>Trademark Law Revision Act</i> .....	219
B. <i>The Berne Convention Implementation Act as Evidence             of Congressional Intent to Provide a Section 43(a)             Remedy for Misattribution of Works of Authorship</i> .....	222
IV. ALTERNATIVE ANALYSIS: DISTINGUISHING A FALSE PROVENANCE FROM AN INCOMPLETE ONE .....	233
V. <i>DASTAR'S</i> POLICY RATIONALE: NARROWLY DEFINING THE CONSUMER'S "NEED TO KNOW" .....	242
VI. THE PREEMPTION SPECTRE AND THE UNCERTAIN SCOPE OF <i>DASTAR</i> .....	251
CONCLUSION .....	258

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## INTRODUCTION

Actions for “reverse passing off”<sup>1</sup> of goods or services under section 43(a) of the Lanham Act have become increasingly popular as judicial interpretations have revealed the broad potential of this statute to address many types of misrepresentations involving goods or services. Before section 43(a) was revised in 1988, most courts and commentators had readily accepted its broad application.<sup>2</sup> Although some have questioned or rejected the application of section 43(a) to reverse passing off, specifically in the context of copyrightable subject matter (that is, cases involving a false or omitted attribution of authorship),<sup>3</sup> few, if any, have questioned its ap-

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<sup>1</sup> “Reverse passing off” occurs when a defendant offers the public goods or services produced by another person, but represents them as the defendant’s own goods or services. *See, e.g.*, *Lipscher v. LRP Pubs., Inc.*, 266 F.3d 1305, 1312 (11th Cir. 2001). The RESTATEMENT (THIRD) OF UNFAIR COMPETITION recognizes this cause of action at common law, noting that an actor may be liable to another

if, in marketing goods or services manufactured, produced or supplied by the other, the actor makes a representation likely to deceive or mislead prospective purchasers by causing the mistaken belief that the actor or a third person is the manufacturer, producer, or supplier of the goods or services if the representation is to the likely commercial detriment of the other . . . .

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 5 (1995).

Reverse passing off may be “express” – where the defendant places its own origin indicator on goods produced by someone else – or “implied” – where the defendant omits the plaintiff’s origin indicator but does not substitute its own. *See, e.g.*, *Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d 1434, 1437 (9th Cir. 1993) (express); *Scheduled Airlines Traffic Offices, Inc. v. Objective, Inc.*, 180 F.3d 583, 591 n.4 (4th Cir. 1999) (implied).

<sup>2</sup> *See, e.g.*, *Lamothe v. Atl. Recording Co.*, 847 F.2d 1403, 1405 (9th Cir. 1998) (stating that section 43(a) reaches both goods and services, including motion pictures and musical compositions); *Kasco Corp. v. Gen. Servs., Inc.*, 905 F. Supp. 29, 33-35 (D. Mass. 1995); *Cleary v. News Corp.*, 30 F.3d 1255 (9th Cir. 1994); *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981); *Truck Equip. Serv. Co. v. Fruehauf Co.*, 536 F.2d 1210, 1216 (8th Cir. 1976). However, courts have also recognized that the mere removal of origin-identifying information does not necessarily violate the Lanham Act. *Lamothe*, 847 F.2d at 1407 n.2; *see also* *CCS Comm’n Control, Inc. v. Law Enforcement Assoc., Inc.*, 628 F. Supp. 1457, 1460 (S.D.N.Y. 1986) (stating that “removal of [product’s] identifying letters and its resale is not a violation of [section 43(a)] because it ‘makes actionable the application of a ‘false designation of origin,’ not the removal of a true designation”) (internal citation omitted). In applying a reverse passing off theory under section 43(a) to the replacement of an actor’s name in film credits, the Ninth Circuit has observed that:

[S]uch conduct, like traditional palming off, is wrongful because it involves an attempt to misappropriate or profit from another’s talents and workmanship. Moreover, in reverse palming off cases, the originator of the misidentified product is involuntarily deprived of the advertising value of [his] name and the goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product. The ultimate purchaser (or viewer) is also deprived of knowing the true source of the product and may even be deceived into believing that it comes from a different source.

*Smith*, 648 F.2d at 607. The rationale for recognizing the common law cause of action for reverse passing off – protecting the advertising value which the original manufacturer derives when the public can accurately identify that manufacturer as the source of the goods in question – is discussed in William M. Borchard, *Reverse Passing Off – Commercial Robbery or Permissible Competition?*, 67 TRADEMARK REP. 1 (1977).

<sup>3</sup> *See, e.g.*, John T. Cross, *Giving Credit Where Credit is Due: Revisiting the Doctrine of Reverse*

*Passing Off in Trademark Law*, 72 WASH. L. REV. 709-72 (1997); 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, 1003-25 (2002) (reviewing conflicting law on section 43(a) as source of a literary attribution right, and concluding that it has only limited utility for this purpose, which would be better achieved through enactment of an express and non-waivable attribution right for all copyrightable works); Catherine Romero Wright, *Reverse Passing Off: Preventing Healthy Competition*, 20 U. PUGET SOUND L. REV. 785-801 (1997); Lionel Sobel, *The Law of Ideas Revisited*, 1 UCLA ENT. L. REV. 9, 31 n.96 (1994) (collecting cases rejecting application of reverse passing off theory under section 43(a) to claims of misattributed authorship); Brief Amici Curiae of Intellectual Property Law Professors, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02-428).

Despite this criticism, many courts have embraced the application of section 43(a) to claims of reverse passing off arising from misattributed authorship. In *Scholastic, Inc. v. Stouffer*, 124 F. Supp. 2d 836 (S.D.N.Y. 2000), the district court held that the post-1988 version of section 43(a)(1) encompassed a "reverse passing off" claim where the alleged infringers "engaged in passing off [the complaining party's] marks, character names, and the illustrated likeness of [H]arry Potter as their own." The court relied on *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 781 (2d Cir. 1994) (stating that claim for false designation of origin under the pre-1988 version of section 43(a) "prohibits not only . . . the relabeling of a printed work . . . but also the reproduction of a work with a false representation as to its creator"), as well as a series of Southern District of New York decisions from the 1990's, which recognized reverse passing off claims under section 43(a)(1) for unauthorized copying of literary works. The *Scholastic* court noted that "[i]n the context of literary works, reverse passing off claims generally consist of the 'misappropriation of credit properly belonging to the original creator of the work.'" *Scholastic*, 124 F. Supp. 2d at 843-44 (quoting *Waldman*, 43 F.3d at 780-81). According to the *Scholastic* court, "[t]he harm caused by reverse passing off is that the originator or the product is 'involuntarily deprived of the advertising value of its name and of the goodwill that otherwise would stem from public knowledge of the true source of the [. . .] product.'" 124 F. Supp. 2d at 844 (quoting *Rosenfeld v. W.B. Saunders, Division of Harcourt Brace Jovanovich, Inc.*, 728 F. Supp. 236, 241 (S.D.N.Y. 1990), *aff'd*, 923 F.2d 845 (2d Cir. 1990)). As subsequently interpreted by the district courts, *Waldman* held that, in the literary context:

A successful reverse passing off claim requires that the claimant establish (i) that the work at issue originated with the claimant; (ii) that origin of the work was falsely designated by the defendant; (iii) that the false designation of origin was likely to cause consumer confusion; and (iv) that the claimant was harmed by the defendant's false designation of origin.

*Scholastic*, 124 F. Supp. 2d at 844 (citing *Waldman*, 43 F.3d at 781-85).

In addition to these requirements, however, in the case of copyrighted works the district courts following *Waldman* have also required complaining parties to show more than mere copying of their work (which would suffice to establish copyright infringement):

Courts of this district have barred Lanham Act claims where the plaintiffs' trademark allegations merely restate the allegations of their copyright claims, and in particular, fail to show the "requisite affirmative action of falsely claiming originality beyond that implicit in any allegedly false copyright." In order for a Lanham Act claim to survive in addition to a copyright claim, "an aggrieved author must show more than a violation of the author's protected right to credit and profit from a creation. The author must make a greater showing that the designation of origin was false, was harmful, and stemmed from some affirmative act whereby [the defendant] affirmatively represented itself as the owner."

*Scholastic*, 124 F. Supp. 2d at 844-45 (citations omitted) (quoting *Weber v. Geffen Records, Inc.*, 63 F. Supp. 2d 458, 463-64 (S.D.N.Y. 1999); *Armstrong v. Virgin Records, Ltd.*, 91 F. Supp. 2d 628, 633 (S.D.N.Y. 2000) (finding that attribution of song authorship to defendant "does not venture beyond that implicit in any allegedly false copyright.")).

Other courts, in contrast, have refused to apply section 43(a) to claims alleging misattribution of authorship. *See, e.g.*, *Litchfield v. Spielberg*, 736 F.2d 1352, 1358 (9th Cir. 1984) (holding that "[w]ithout substantial similarity, there can be no claim for reverse passing off under section 43(a)"), *cert. denied*, 470 U.S. 1052 (1985); *Berkic v. Crichton*, 761 F.2d 1289, 1291 n.1 (9th Cir. 1985) (following *Litchfield*), *cert. denied*, 474 U.S. 826 (1985);

plication to claims of reverse passing off in other contexts.

Prior to the Trademark Law Revision Act of 1988 (“TLRA”),<sup>4</sup> there was little reason to question whether or not reverse passing off was encompassed by the language of section 43(a). However, the language of that section differed significantly from that of the current version of section 43(a).<sup>5</sup> Ever since the TLRA amendments distinguished between false designation of origin claims and false advertising claims, the more precise language of section 43(a) no longer clearly includes reverse passing off.<sup>6</sup>

In 2003, when faced with a reverse passing off claim in the context of a work of authorship in which the copyright had expired, the Supreme Court held in *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>7</sup> that section 43(a) did not apply. The plaintiff in *Dastar*, Fox Television, filed a complaint alleging reverse passing off under section 43(a) when the defendant, Dastar, re-edited a public domain television series originally produced by Fox, and re-released the modified version under Dastar’s name in new packaging that did not credit Fox as the original creator.

The ultimate holding of the case – that section 43(a) cannot be used to create a quasi-copyright claim in works with respect to which the statutory copyright has expired<sup>8</sup> – is consistent with the overall federal intellectual property regime, and is arguably consistent with the current language of section 43(a). However, the Court undertook a surprisingly tortuous path to justify this conclusion. After conceding, with minimal analysis, that reverse passing off would be cognizable under section 43(a) where the false design-

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Shaw v. Lindheim, 919 F.2d 1353, 1364-65 (9th Cir. 1990) (holding that, regardless of substantial similarity between two works, § 43(a) should not apply where copyright law “provides an adequate remedy”); Kienzle v. Capital Cities/Am. Broad. Co., 774 F. Supp. 432 (E.D. Mich. 1991) (finding no Lanham Act violation where defendant allegedly misappropriated plaintiff’s idea for a television series); Vantage Point, Inc. v. Parker Bros., 529 F. Supp. 1204, 1219 (E.D.N.Y. 1981), *aff’d without op.*, 697 F.2d 301 (2d Cir. 1982) (refusing to apply section 43(a) to reverse passing off claim based on misappropriation of plaintiff’s idea, holding that the Lanham Act applies only to affirmative misrepresentations about the “nature or source” of defendant’s goods); *see generally* Lionel Sobel, *The Law of Ideas Revisited*, 1 UCLA ENT. L. REV. 9, 31 n.96 (1994) (collecting cases).

Courts recognizing reverse passing off of literary works as false designations of origin under section 43(a) did not reach a consensus on whether mere failure to identify the author constituted reverse passing off (in which case the claim was for “implied reverse passing off”) or whether an affirmative misattribution was required (“express reverse passing off”). *Compare Smith*, 648 F.2d at 605-07 (containing dictum implying that 43(a) applies to implied reverse passing off) with *Murray Hill Publ’ns, Inc. v. ABC Comm’n, Inc.*, 264 F.3d 622 (6th Cir. 2001), and *Agee v. Paramount Comm’n, Inc.*, 59 F.3d 317, 327 (2d Cir. 1995) (requiring affirmative misattribution).

<sup>4</sup> Pub. L. No. 100-667, 102 Stat. 3935 (effective Nov. 16, 1989).

<sup>5</sup> *See infra* notes 45-47 and accompanying text.

<sup>6</sup> *See infra* notes 48-53 and accompanying text.

<sup>7</sup> 539 U.S. 23 (2003).

<sup>8</sup> *Id.* at 34.

nation of origin misidentified the *physical* producer of a good, the Court struggled to explain why Fox's claim – misattributing the source of intangible intellectual property – fell outside the scope of section 43(a), while a claim alleging misattribution of the source of *tangible* goods would fall squarely within that section.<sup>9</sup> Moreover, the Court's analysis cast doubt on several applications of section 43(a) that had previously received widespread acceptance in the federal courts, and arguable acceptance by Congress, including its application to traditional passing off claims in the context of expressive works.

Surprisingly, at no point in its analysis of *Dastar* did the Supreme Court question whether section 43(a) applies to reverse passing off at all. By failing to give adequate attention to this underlying issue, the Court declined an opportunity to provide much needed clarification on the scope of federal unfair competition law.

This Article examines the application of section 43(a) to claims of reverse passing off through the lens of the Supreme Court's unpersuasive effort in *Dastar* to exclude a single class of reverse passing off-claims – those involving “expressive” works as opposed to physical commodities – from the scope of section 43(a). The Article critiques the Court's analysis of section 43(a) in light of case law and the pertinent legislative history, including, the TLRA of 1988,<sup>10</sup> the Berne Convention Implementation Act of 1988 (“BCIA”),<sup>11</sup> and the Visual Artists Rights Act of 1990 (“VARA”).<sup>12</sup> This history received no attention whatsoever in the *Dastar* opinion.

The Article then proposes an alternative analysis which respects the public policy goals of both trademark and copyright law while eliminating the more problematic aspects of the Court's interpretation of the Lanham Act. Under this approach, tangible goods and expressive works would be treated alike. In both cases, affirmatively false or misleading representations of origin would be actionable under section 43(a), while merely omitted or incomplete provenances would be disregarded. As the Article will demonstrate, this approach is more consistent with the international treaty obligations of the United States under the Berne Convention, as well as the historical understanding of the common law of reverse passing off, as exemplified in the Restatement (Third) of

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<sup>9</sup> See *infra* notes 18-23 and accompanying text.

<sup>10</sup> Pub. L. No. 100-667, 102 Stat. 3935 (effective Nov. 16, 1989).

<sup>11</sup> Pub. L. No. 100-568, 102 Stat. 2853 (1988).

<sup>12</sup> Pub. L. No. 101-650 (tit. VI), 104 Stat. 5089 (1990).

Unfair Competition. This approach preserves the application of section 43(a) to traditional passing off claims in the context of expressive works, thus ensuring that authors and other creative artists will continue to enjoy the same rights as other trademark owners – most importantly, the right to prevent others from using an author’s name and reputation as a marketing tool to attract customers for works to which the author did not in fact contribute.

### I. *DASTAR* BACKGROUND

After acquiring television rights to Dwight D. Eisenhower’s World War II book, *Crusade in Europe*, Fox produced a television series based on the book in 1949. However, Fox failed to renew that copyright in 1977, at which point the series entered the public domain. The publisher, Doubleday, in contrast, had renewed its copyright in the book in 1975. Fox reacquired the television rights to the book in 1988, including the exclusive right to distribute its original *Crusade* television series on video, which it then licensed to New Line Home Video.

In 1995, however, another player – Dastar – entered the scene. Dastar made copies of the original *Crusade* tapes, edited them, retitled them *World War II Campaigns in Europe*, and distributed them as a videotape set under its own name for a substantially lower price than New Line’s version. Dastar’s packaging did not acknowledge Fox’s *Crusade* series as the work from which *Campaigns* was derived, and specifically identified several Dastar employees as the “producers” of the work. Fox and New Line brought suit against Dastar, alleging that the defendant’s video series infringed their exclusive television rights and, further, that Dastar’s failure to acknowledge that the video set was derived from the *Crusade* television series constituted “reverse passing off” in violation of section 43(a). The gravamen of Fox’s complaint was that Dastar marketed its *Campaign* series as a Dastar product without acknowledging its “nearly wholesale reliance” on Fox’s *Crusade* series, and that, therefore, Dastar’s action violated section 43(a)’s proscription against making a “false designation of origin” or “false or misleading representation of fact” that is “likely to cause confusion . . . as to the origin . . . of his or her goods.”<sup>13</sup>

The district court granted summary judgment for the plaintiffs on all counts. The Ninth Circuit affirmed the district court on the Lanham Act claim, finding that the defendants had committed reverse passing off by “bodily appropriating” the *Crusade* television

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<sup>13</sup> *Dastar*, 539 U.S. at 28.

series without properly attributing it to Fox.<sup>14</sup>

Evidently, the Ninth Circuit viewed its decision as uncontroversial – Circuit Judges Kozinski and Gould, and District Judge Breyer, issued their opinion as an unsigned, unpublished memorandum. Relying on familiar Ninth Circuit case law applying section 43(a) to claims of reverse passing off, the circuit court concluded that Dastar’s actions constituted a bodily appropriation of Fox’s work of authorship:

Dastar copied substantially the entire *Crusade in Europe* series created by Twentieth Century Fox, labeled the resulting product with a different name and marketed it without attribution to Fox. Dastar therefore committed a “bodily appropriation” of Fox’s series. Dastar’s minimal changes to the series are not sufficient to avoid liability.<sup>15</sup>

On appeal, the U.S. Supreme Court focused on whether section 43(a) encompasses claims of reverse passing off with respect to works of an expressive nature, so as to recognize a claim for “bodily appropriation” of a work such as Fox’s television series.

While the Supreme Court has applied section 43(a) to cases involving traditional passing off,<sup>16</sup> it has never expressly applied that provision to reverse passing off. One might therefore have expected the *Dastar* Court to begin its analysis by thoroughly examining this question as a matter of first impression. Instead, with virtually no analysis, the Court conceded that section 43(a) encompasses claims of reverse passing off:

[E]very Circuit to consider the issue found § 43(a) broad enough to encompass reverse passing off . . . . The Trademark Law Revision Act of 1988 made clear that § 43(a) covers origin of production as well as geographic origin. Its language is amply inclusive, moreover, of reverse passing off—if indeed it does not implicitly adopt the unanimous court-of-appeals jurisprudence

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<sup>14</sup> See *Twentieth Century Fox Film Corp. v. Entm’t. Distrib.*, 34 Fed. Appx. 312, 2002 WL 649087 (9th Cir. 2002). The appellate court reversed on the copyright claim, however, finding an issue of fact as to whether the copyright in Eisenhower’s book had been properly renewed.

<sup>15</sup> 2002 WL 649087, at \*1 (citing *Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994)) (additional citations omitted); see also *Summit Mach. Tool Mfg. Corp. v. Victor CNC Systems, Inc.*, 7 F.3d 1434, 1436-37 (9th Cir. 1993) (asserting that “[a] defendant may also be guilty of reverse palming off by selling or offering for sale another’s product that has been modified slightly and then labeled with a different name.”).

<sup>16</sup> See, e.g., *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000) (applying section 43(a) to a claim that the defendant copied plaintiff’s trade dress for clothing); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (applying section 43(a) to the claim that the defendant copied plaintiff’s trade dress for its restaurant).

on that subject.<sup>17</sup>

Based on this unexamined premise, the Court concluded that if Dastar had in fact purchased copies of New Line's *Crusade* video set, and then repackaged and relabeled those tangible objects as a Dastar product, the plaintiffs' 43(a) claim "would undoubtedly be sustained."<sup>18</sup> By way of analogy, the Court explained that section 43(a) would be violated if Coca-Cola were to pass off Pepsi-Cola as a Coca-Cola product.<sup>19</sup>

Having concluded that section 43(a) applies to reverse passing off of *tangible* goods, the Court questioned whether the same principle should apply here, where the defendant manufactured its own tapes, and merely reproduced without attribution the *intangible contents* of the tapes originally produced by the plaintiffs.<sup>20</sup> The Court concluded that the same principle does not apply, and accordingly it reversed the Ninth Circuit's decision that Dastar had violated section 43(a) by its "bodily appropriation" of Fox's work.<sup>21</sup> In other words, the Court held that while section 43(a) applies to reverse passing off claims that misrepresent the origin of physical goods, it does not apply to similar claims that misrepresent the origin of the intangible contents of expressive goods. Thus, Dastar's failure to identify Fox as the originator of this public domain work of authorship did not constitute reverse passing off under section 43(a), because the "origin of goods" encompassed by section 43(a) does not include the origin of an expressive work:

The dictionary definition of "origin" is "the fact or process of coming into being from a source," and "that from which anything primarily proceeds; source." And the dictionary definition of "goods" (as relevant here) is "[w]ares; merchandise." We think the most natural understanding of the "origin" of "goods"—the source of wares—is the producer of the tangible product sold in the marketplace, in this case the physical *Campaigns* videotape sold by Dastar. The concept might be

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<sup>17</sup> *Dastar*, 539 U.S. at 30-31 (citations omitted) (citing *Alpo Petfoods, Inc. v. Ralston Purina Co.*, 913 F.2d 958, 963-964, n.6 (D.C. Cir. 1990); *Williams v. Curtiss-Wright Corp.*, 691 F.2d 168, 172 (3d Cir. 1982); *Arrow United Indus., Inc. v. Hugh Richards, Inc.*, 678 F.2d 410, 415 (2d Cir. 1982); *F.E.L. Publications, Ltd. v. Catholic Bishop of Chicago*, 214 U.S.P.Q. 409, 416 (7th Cir. 1982); *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir. 1981); *Bangor Punta Operations, Inc. v. Universal Marine Co.*, 543 F.2d 1107, 1109 (5th Cir. 1976)).

<sup>18</sup> *Dastar*, 539 U.S. at 31.

<sup>19</sup> *Id.* at 32. For a critique of this questionable assertion, see *infra* notes 138-141 and accompanying text.

<sup>20</sup> *Id.* at 31.

<sup>21</sup> *Id.* at 23. The Supreme Court voted 8-0 to reverse the Ninth Circuit. Justice Breyer did not participate, because his brother, District Judge Charles R. Breyer, sat by designation on the Ninth Circuit panel that heard the case.



stretched (as it was under the original version of § 43(a)) 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. But 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.* Such an extension would not only stretch the text, but it would be out of accord with the history and purpose of the Lanham Act and inconsistent with precedent.<sup>22</sup>

The result in *Dastar* has been relatively uncontroversial, and understandably so. When a once-copyrighted work enters the public domain, the underlying policy of copyright law dictates that the work should henceforth be free for all to use.<sup>23</sup> Therefore, the party that offers a copy of such a work to the public should have no obligation to identify its authors or previous copyright owners. That party performs a valuable service by making the unprotected work available to the public even after the economic monopoly on that work has ceased to provide an incentive for doing so. The party making the work available typically cannot do so without incurring an expense – for manufacturing and distributing the copies – that the party naturally hopes to recoup through a market-sensitive pricing scheme. That party makes the work available regardless of whether the former copyright owner has any interest in doing so. At this stage in the life of the work, the party making it available – either in edited or unaltered form – can accurately identify itself as the source of that particular copy or version of the work. A contrary rule would undermine the integrity of the public domain, by placing restrictions on the freedom of individuals or businesses to make works accessible to the public. Although persons would still be free to copy public domain works, the requirement of proper attribution would constrain their freedom to do so. This restriction, of unlimited duration, might therefore violate the

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<sup>22</sup> *Id.* at 31-32 (emphasis added) (citations omitted) (quoting WEBSTER’S NEW INTERNATIONAL DICTIONARY 1079, 1720-1721 (2d ed. 1949)).

<sup>23</sup> The courts have frequently emphasized this policy in patent law. In *Eldred v. Ashcroft*, 537 U.S. 186 (2003), the Supreme Court noted that the same principle applies to copyrights. *Id.* at 223-27. The Court reiterated this in *Dastar* noting, “the right to copy, and to copy without attribution, once a copyright has expired, like ‘the right to make [an article whose patent has expired]—including the right to make it in precisely the shape it carried when patented—passes to the public.’” 539 U.S. at 33 (quoting *Sears, Roebuck & Co., v. Stiffel Co.*, 376 U.S. 225, 230 (1964)). In recent years, the dramatic growth in intellectual property protections, including copyright, has spurred increased concern among scholars for protecting the public domain. See, e.g., Peter Yu, *The Copyright Divide*, 25 CARDOZO L. REV. 331, 398-401 & nn.491-99 (collecting commentary on the public domain).

Constitutional requirement that copyright be granted only “for limited times.”<sup>24</sup>

What is surprising and somewhat troubling about *Dastar*, however, is not its specific holding with respect to expired copyrights, but the rationale and the largely unexamined premise on which it relied in reaching this result. Specifically, as discussed below, the Supreme Court accepted, without adequate examination, a questionable interpretation of the language and the underlying legislative intent of section 43(a), drawing a tenuous and largely unsupported distinction between tangible and intangible goods as subject matter to which section 43(a) might be applied.

## II. THE RATIONALE OF *DASTAR*

Although the *Dastar* Court did not question the premise that section 43(a) applies to reverse passing off claims that involve false representations of the physical source of tangible goods, it reached the opposite conclusion with respect to false representations of the source of the intangible contents of expressive works. As discussed below, there is little support for either of these conclusions in the text of section 43(a) or in its legislative history. First, it is unclear whether section 43(a) applies to reverse passing off at all. Second, if Congress did intend for section 43(a) to provide a federal cause of action for reverse passing off, the evidence belies the Court’s conclusion that Congress meant to exclude expressive works from the scope of this federal cause of action. In fact, section 43(a) suggests that Congress was *more* concerned about reverse passing off in the case of expressive works than in the case of any other kind of goods.

### A. *The Court’s Unexamined Assumption that Section 43(a) Applies to Reverse Passing Off of Tangible Goods*

#### 1. Misleading Use of Precedent

When the Supreme Court asserted that the repackaging and relabeling of New Line’s videotapes under the *Dastar* label would “undoubtedly” have constituted reverse passing off under section

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<sup>24</sup> U.S. CONST. art. I, § 8, cl. 8 (often called the “Intellectual Property Clause”) (authorizing Congress “[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”). The question of whether Congress may exercise its other powers – such as the commerce power – to grant rights exceeding those which it would be empowered to grant under the Intellectual Property Clause continues to be controversial. See, e.g., Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272 (2004) (surveying scholarship that views the Intellectual Property Clause as a limit on those other powers, but arguing for the opposite conclusion).

43(a), it bowed to what was perceived to be the unanimous views of the circuit courts of appeal that had already considered and endorsed the application of section 43(a) to claims of reverse passing off:

[E]very Circuit to consider the issue found § 43(a) broad enough to encompass reverse passing off . . . The Trademark Law Revision Act of 1988 made clear that § 43(a) covers origin of production as well as geographic origin. Its language is amply inclusive, moreover, of reverse passing off—if indeed it does not implicitly adopt the unanimous court-of-appeals jurisprudence on that subject.<sup>25</sup>

The federal courts in the past have readily embraced the argument that section 43(a) applies to claims of reverse passing off.<sup>26</sup> However, a closer look at the reasoning in those decisions reveals that it provides weak to nonexistent support for applying this interpretation of section 43(a) to the post-TLRA version of section 43(a). Specifically, as authority for applying section 43(a) to reverse passing off of tangible goods, but not to intangible expressive works, each of these precedents suffers from one or more of the following defects: (a) the precedent is inapplicable because it did not involve passing off at all, but rather false advertising; (b) contrary to *Dastar's* holding, the precedent indicates that section 43(a) *does* apply to reverse passing off of expressive works; or (c) the precedent applied the pre-TLRA version of section 43(a), rather than the version which was at issue in *Dastar*. Each of these defects will be addressed in turn.

#### a. False Advertising Precedents

The majority of the “reverse passing off” cases on which *Dastar* relied did not involve reverse passing off at all. Rather, they involved false descriptions of a defendant’s *own* merchandise<sup>27</sup> —

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<sup>25</sup> 539 U.S. at 30 (collecting cases).

<sup>26</sup> See *Alpo Petfoods, Inc. v. Ralston Purina Co.*, 913 F.2d 958, 963-964, n.6 (D.C. Cir. 1990); *Williams v. Curtiss-Wright Corp.*, 691 F.2d 168, 172 (3d Cir. 1982); *Arrow United Indus., Inc. v. Hugh Richards, Inc.*, 678 F.2d 410, 415 (2d Cir. 1982); *F.E.L. Publ'ns., Ltd. v. Catholic Bishop of Chicago*, 214 U.S.P.Q. 409, 416 (7th Cir. 1982); *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir. 1981); *Bangor Punta Operations, Inc. v. Universal Marine Co.*, 543 F.2d 1107, 1109 (5th Cir. 1976).

<sup>27</sup> See *Alpo Petfoods, Inc.*, 913 F.2d at 963-964, n.6 (regarding false advertising); *Arrow United Indus., Inc.*, 678 F.2d at 415 (regarding false advertising); *Bangor Punta Operations, Inc.*, 543 F.2d at 1109 (regarding false advertising). In *Bangor Punta Operations*, for example, where the defendant used a picture of plaintiff’s trawler in its advertising materials, representing it to be a picture of its own trawler, the Court relied on several earlier cases that had applied the same interpretation of the pre-1988 version of section 43(a). See *Alum-A-Fold Shutter Corp. v. Folding Shutter Corp.*, 441 F.2d 556 (5th Cir. 1971); *American Precast Corp. v. Maurice Concrete Prods.*, 360 F. Supp. 859 (D. Mass. 1973) (finding

claims that would be actionable today, if at all, under section 43(a)(1)(B), the false advertising branch of section 43(a).<sup>28</sup> Accordingly, the cases provide no authority for applying section 43(a) to claims of reverse passing off.

In each of these earlier false advertising cases, the defendant had used either images or samples of the plaintiff's goods as exemplars of its own goods, but had not in fact trafficked in the plaintiff's goods, since the goods the defendant actually provided to customers were its own.<sup>29</sup> This is far different from actually selling the plaintiff's goods under the defendant's name. By showing samples or pictures of the plaintiff's goods to potential customers, the defendants were implying to customers that their own goods were identical to the plaintiff's goods. In cases where this statement was accurate, it should not have been actionable. In cases where it was inaccurate, it was actionable because the defendant was making false statements about the qualities of its own goods; it was not making false statements about the origin of the plaintiff's goods. The *Restatement (Third) of Unfair Competition* confirms this analysis.<sup>30</sup>

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unfair competition where defendant used pictures of plaintiff's product to advertise its own), *aff'd*, 502 F.2d 1159 (1st Cir. 1974). In *Crossbow, Inc. v. Dan-Dee Imps. Inc.*, 266 F. Supp. 335 (S.D.N.Y. 1967), the court found unfair competition where the defendant copied plaintiff's product and packaging, used plaintiff's product as a sales sample and demonstration model for its own product, and accepted orders for plaintiff's product by brand name. *Crossbow* cited earlier cases that had rejected common law claims of "reverse passing off" against defendants who removed the plaintiff's source identifiers from a product and used it as a sales sample for their own merchandise. *Crossbow*, 266 F. Supp. at 340 (citing *PIC Design Corp. v. Sterling Precision Corp.*, 231 F. Supp. 106 (S.D.N.Y. 1964); *Mastro Plastics Corp. v. Emenee Indus., Inc.*, 16 A.D.2d 420, 228 N.Y.S.2d 514 (1st Dept. 1962), *aff'd, no opinion*, 12 N.Y.2d 826, 236 N.Y.S.2d 347, 187 N.E.2d 360 (1962)). Ironically, *Crossbow* noted that while *Mastro Plastics* rejected a common law claim of reverse passing off, it allowed the plaintiff to amend its complaint to state a section 43(a) claim for reverse passing off. *Crossbow*, 266 F. Supp. at 340.

<sup>28</sup> For a more detailed comparison of these two subsections, see *infra* notes 48-52 and accompanying text.

<sup>29</sup> In *Alpo Petfoods*, 913 F.2d at 960-61, each party made false claims about the qualities of its own dog food products; in *Arrow*, 678 F.2d at 414-15, the defendant falsely represented samples of the plaintiff's product as its own, in an effort to solicit customers; and in *Bangor Punta*, 543 F.2d at 1109, the defendant used pictures of the plaintiff's boat in advertising the defendant's own services.

<sup>30</sup> Comment (a) in section 5 of the RESTATEMENT notes that the type of claims presented in such cases – where the defendant presents potential customers with samples or pictures of the plaintiff's goods, with the plaintiff's trademark omitted, so as to falsely suggest that the defendant's goods are identical, in order to persuade customers to buy the defendant's goods – do not constitute reverse passing off. In those cases, the defendant does not in fact sell the plaintiff's goods, but simply uses them to falsely suggest the qualities of the defendant's goods:

The misrepresentations that are the subject of this Section should be distinguished from those that may result from the use of goods produced by another, or a photograph of such goods, as a sample or illustration of proffered goods actually produced by the actor or obtained from third persons. Such conduct may result in confusion of source in the traditional sense, see § 16, Comment a, or in a misrepresentation of the qualities or characteristics of the actor's goods,

Thus, the courts, which erroneously treated these as reverse passing off cases, simply failed to recognize this important distinction.<sup>31</sup>

b. Precedents Involving Expressive Works

As noted above, most of the section 43(a) cases on which *Dastar* relied were inapposite, because they involved false advertising rather than reverse passing off. In fact, only three of the section 43(a) cases cited favorably in *Dastar* actually addressed claims of reverse passing off.<sup>32</sup> Moreover, in a stunning irony, two out of those three cases involved *expressive works* – the very category of works to which *Dastar* held that reverse passing off should not apply. Nowhere in its opinion did the Court acknowledge this inconsistency.<sup>33</sup>

One of the expressive works cases cited in *Dastar* – *Smith v. Montoro*<sup>34</sup> – found a false designation of origin under section 43(a) where an actor’s film performance was falsely attributed to another actor in the screen credits. The other case – *F.E.L. Publications, Ltd. v. Catholic Bishop of Chicago*<sup>35</sup> – found a false designation of origin under section 43(a) where the defendant removed the plaintiff’s name and copyright notice from his copyrighted songs in church hymnals, and substituted the name of defendant’s parish in their place. In each of these cases, federal courts found that section 43(a) provided a cause of action for reverse passing off of the contents of an expressive work.

The third true reverse passing off case that *Dastar* cited – and the only one that did not involve an expressive work – was *Williams v. Curtiss-Wright Corp.*,<sup>36</sup> which involved source designations for engine replacement parts. The defendant sold unused surplus parts manufactured by the plaintiff, and identified them to customers using the plaintiff’s part numbers preceded by the letter “G.”

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see § 2, Illustration 8. However, such conduct is not within the scope of this Section.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 5 cmt. a (1995).

<sup>31</sup> Ironically, a post-*Dastar* case finally recognized this distinction. See *Bretford Mfg. v. Smith Sys. Mfg. Co.*, 286 F. Supp.2d 969, 971-72 (N.D. Ill. 2003) (rejecting section 43(a) claim arising from defendant’s use of plaintiff’s product as a component of sample merchandise defendant displayed to potential customers; applying *Dastar* analysis, and noting: “[T]he sample table was not the good offered for sale. What was offered for sale were the tables later purchased [from defendant].”)

<sup>32</sup> See *F.E.L. Publications, Ltd. v. Catholic Bishop of Chicago*, 214 U.S.P.Q. 409, 416 (7th Cir. 1982); *Williams v. Curtiss-Wright Corp.*, 691 F.2d 168 (3d Cir. 1982); *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir. 1981).

<sup>33</sup> *Dastar*, 539 U.S. 23.

<sup>34</sup> 648 F.2d 602, 603 (9th Cir. 1981).

<sup>35</sup> 214 U.S.P.Q. 409, 416 (7th Cir. 1982).

<sup>36</sup> 691 F.2d 168 (3d Cir. 1982).

Based on industry-specific practices, the plaintiff argued that this modification of the plaintiff's part numbers would imply to customers that the defendant (and not the plaintiff) was actually the manufacturer of these parts.<sup>37</sup> The court of appeals agreed that such a false designation of the origin of the plaintiff's goods would be actionable reverse passing off under section 43(a) if there was a likelihood of confusion.<sup>38</sup> However, this portion of the decision was dictum, because the court of appeals could not determine whether reverse passing off had taken place, since the trial court had not made any findings of fact as to what customers were likely to believe with respect to the source of the parts.<sup>39</sup>

In a further irony, the *Williams* opinion – the only reverse passing off case cited in *Dastar* that involved non-expressive goods – cited only two cases in support of its conclusion that section 43(a) applied to claims of reverse passing off<sup>40</sup> – and one of those cases was *Smith v. Montoro*, which involved an expressive work. The other case on which *Williams* relied did not involve reverse passing off at all; it was yet another mislabeled false advertising case.<sup>41</sup>

Thus, apart from the dictum in *Williams*, the only cases cited by *Dastar* that actually support application of section 43(a) to reverse passing off claims are those that involved reverse passing off of expressive works. And the *Williams* dictum itself relied on one of those same expressive works cases. Thus, it is all the more remarkable that the Supreme Court relied on these cases to support the application of section 43(a) to reverse passing off of non-expressive works, while denying its application in the case of expressive works.

c. *Dastar's* Failure to Address the Impact of the Trademark Law Revision Act of 1988

Each of the putative reverse passing off cases *Dastar* cited –

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<sup>37</sup> *Id.* at 172.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.* at 173.

<sup>40</sup> *Id.* at 172.

<sup>41</sup> See *L'Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649 (3d Cir. 1954). *L'Aiglon* held that a plaintiff demonstrated reverse passing off, actionable under the pre-1988 version of 43(a), where the defendant used a picture of the plaintiff's more expensive dress in order to advertise the defendant's cheaper dress. However, the defendant in *L'Aiglon* never sold any of the plaintiff's goods to the public, which is what would be required for a true case of reverse passing off. Rather, this was simply a false advertising case, because the defendant's use of a picture of the plaintiff's product constituted a "false description" of the defendant's goods within the meaning of section 43(a). In discussing what it perceived to be a "false description" cause of action under 43(a), the *L'Aiglon* court noted: "It seems to us that Congress has defined a statutory civil wrong of false representation of goods in commerce . . . . Perhaps this statutory tort bears closest resemblance to the already noted tort of false advertising to the detriment of a competitor . . . ." *Id.* at 651.

including both the true reverse passing off cases and the mislabeled false advertising cases – involved the pre-TLRA version of section 43(a),<sup>42</sup> the relevant text of which differs significantly from the current text of the statute. For that additional reason, all of the cases on which *Dastar* relied have limited value in interpreting the current text, and should be considered only if, and to the extent that, there is evidence that Congress intended to leave these pre-1988 interpretations undisturbed when it changed the pertinent language of section 43(a) in the 1988 TLRA amendments.<sup>43</sup> Absent such evidence, the Supreme Court's reliance on case law that had interpreted an obsolete version of section 43(a), and its failure to consider the impact of the TLRA amendments, greatly undermines the persuasiveness of the *Dastar* decision.

### B. *Pre- and Post-TLRA Versions of Section 43(a) Compared*

In concluding that the current version of section 43(a) would “undoubtedly” apply to reverse passing off of tangible goods, the *Dastar* Court relied entirely on cases that had construed a pre-TLRA version of section 43(a), which was worded quite differently from the current version. It provided that:

Any person who shall affix, apply, or annex, or use *in connection with any goods or services*, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation or origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier

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<sup>42</sup> See, e.g., *Williams v. Curtiss-Wright Corp.*, 691 F.2d 168, 172-73 (3d Cir. 1982) (dictum) (relying on *Smith v. Montoro* and *L'Aiglon* to conclude that pre-1988 version 43(a) applied to reverse passing off, but noting that this was not the basis on which the lower court granted the preliminary injunction under review); *Arrow United Indus., Inc. v. Hugh Richards, Inc.*, 678 F.2d 410, 415 (2d Cir. 1982) (finding reverse passing off under pre-1988 version of 43(a) where defendant used samples of plaintiff's goods, representing those goods as its own, to secure a contract to provide such goods to the customer); *F.E.L. Publ'n, Ltd. v. Catholic Bishop of Chicago*, 214 U.S.P.Q. 409, 416 (7th Cir. 1982) (holding that “false designation of origin” claim under pre-1988 version of 43(a) could be asserted if consumers would be confused when defendant removed publisher's copyright information from hymnals and substituted the name of the parish); *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir. 1981) (finding reverse passing off where defendant removed actor's name from movie credits and substituted a different name); *Bangor Punta Operations, Inc. v. Universal Marine Co.*, 543 F.2d 1107, 1109 (5th Cir. 1976) (addressing “false advertising” claim under pre-1988 version of 43(a), arising from defendant's misappropriation of plaintiff's advertising material, where defendant used a photo of plaintiff's trawler in its advertising, representing it as its own trawler).

<sup>43</sup> Pub. L. No. 100-667, 102 Stat. 3935 (1988).

to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which the locality is situated, or by any person who believes that he is or is likely to be damaged by the use of such false description or representation.<sup>44</sup>

The TLRA amendments, in contrast, divided section 43(a) into two parts.<sup>45</sup> Subsection (a)(1)(A) applies to false or misleading *designations of origin, affiliation, or sponsorship of a defendant's goods, services, or commercial activities*.<sup>46</sup> Subsection (a)(1)(B) applies to false representations, in commercial advertising or promotion, *with respect to the nature, qualities, characteristics, or geographic origin of any person's goods, services, or commercial activities*. Section 43(a)(1)(B) has become known as the "false advertising" provision of section 43(a).

Notably, section 43(a)(1)(B) does not expressly prohibit false representations about the non-geographic *origin* of a person's goods or services, if the misrepresentation about origin does not also misrepresent the *nature, qualities, or characteristics* of the goods or services.<sup>47</sup> But if the misrepresentation does pertain to nature, qualities, characteristics, or geographic origin, the misrepresentation is actionable regardless of whether it applies to the plaintiff's goods or the defendant's goods, because subsection (a)(1)(B) applies to misrepresentations about *any person's goods, services, or commercial activities*, not just those of the plaintiff.<sup>48</sup>

<sup>44</sup> 60 Stat. 441 (emphasis added).

<sup>45</sup> Section 43(a) provides:

§ 1125. *False designations of origin and false descriptions forbidden*

(a) Civil action.

(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, or

(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.

Pub. L. No. 100-667, 102 Stat. 3935.

<sup>46</sup> *Id.* (emphasis added).

<sup>47</sup> See generally *Porous Media Corp. v. Pall Corp.*, 201 F.3d 1058 (8th Cir. 2000) (press release did not concern nature, characteristics, qualities, or geographic origin of either party's products, and did not constitute commercial advertising or promotion as required by section 43(a)(1)(B)).

<sup>48</sup> See, e.g., *BellSouth Adv'g & Publ'g Corp. v. Lambert Publ'g*, 45 F. Supp. 2d 1316 (1999) (false advertising claim under section 43(a)(1)(B) must involve false representation



In contrast, the prohibition against false designations of origin in subsection (a)(1)(A) refers only to misrepresentations involving the *defendant's* own goods, services, or commercial activities. It says nothing about misrepresentations that the defendant makes with respect to the origin of the *plaintiff's* goods, services, or commercial activities. If a defendant is to be held liable for making false statements about "his or her" own goods, then it is circular to suggest that the defendant's statements are false because the goods in question are not in fact "his or her" own goods. One simply cannot have it both ways: Either the "goods" that the defendant is accused of misrepresenting are "his or her" own goods under section (a)(1)(A), in which case the defendant's self-identification as the source of those goods is by definition accurate, or the goods in question are the *plaintiff's* goods. If they are the plaintiff's goods, then section (a)(1)(A) does not apply, and the defendant's inaccurate self-identification as the origin of those goods must be actionable, if at all, only under subsection (a)(1)(B), which addresses a defendant's false statements about a plaintiff's goods.<sup>49</sup>

The wording of section 43(a)(1)(B) – the false advertising provision – differs significantly from that of section 43(a)(1)(A). The false advertising provision expressly applies to a defendant's false representations as to "*his or her or another person's* goods, services or commercial activities." Under traditional canons of statutory construction, the difference in the language of (A) and (B) strongly implies that Congress contemplated a distinction between false representations about a defendant's own goods and false representations about the goods of other parties, and that Congress deliberately chose the narrower wording of section (A) in order to apply that provision only to misrepresentations about the defendant's own goods.<sup>50</sup> Surprisingly, the Court did not even acknowl-

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about defendant's *or another's* product or services), *aff'd without op.*, 207 F.3d 663 (11th Cir. 2000).

<sup>49</sup> The Supreme Court did not acknowledge the circularity problem, even though the problem is apparent from the Court's own language. In defining "passing off" and "reverse passing off," the Court implicitly acknowledges that reverse passing off applies only to statements which a defendant makes about someone else's goods or services:

Passing off (or palming off, as it is sometimes called) occurs when a producer misrepresents his own goods or services as someone else's. *See, e.g., O. & W. Thum Co. v. Dickinson*, 245 F. 609, 621 (6th Cir. 1917). "Reverse passing off," as its name implies, is the opposite: The producer misrepresents someone else's goods or services as his own. *See, e.g., Williams v. Curtiss-Wright Corp.*, 691 F.2d 168, 172 (3d Cir. 1982).

*Dastar*, 539 U.S. at 26 n.1. However, this clearly did not stop the Court from concluding that "reverse passing off" is cognizable under section 43(a)(1)(A), even though that section applies only to the defendant's own goods or services.

<sup>50</sup> At least three familiar canons of construction are implicated here:

(1) "[T]he starting point for interpreting statutes is the language of the statute itself.

edge, much less evaluate, this difference in the language of the two provisions.

Reverse passing off claims involve false statements about the origin of a *plaintiff's* goods or services. The defendant in such a case offers the public goods or services that in fact originated from the plaintiff. The plaintiff complains that the defendant has falsely attributed those goods or services to a source other than the plaintiff.<sup>51</sup> As indicated above, nothing in the express language of section 43(a), in its current form, makes such false statements actionable.

Thus, no text in section 43(a) facially provides a cause of action against a defendant that puts its *own* name or trademark on goods or services that someone else in fact provided. Only by stretching the meaning of "nature, qualities, characteristics, or geographical origin" in subsection (a)(1)(B) could section 43(a) be deemed to include such non-geographic designations of origin. Indeed, the specific inclusion of *geographic* origin in subsection (a)(1)(B) strongly suggests, by reverse implication, that Congress did not intend that subsection to encompass *non-geographic* origin indicators. Nor should one interpret "nature, qualities, [or] characteristics" to encompass the origin of a product, because identical goods may come from different sources. In drafting the TLRA amendments, the 1988 Congress deliberately chose to apply subsection (a)(1)(A) to non-geographic origin indicators, and to apply subsection (a)(1)(B) to geographic origin indicators. Under fundamental canons of statutory construction,<sup>52</sup> the plain language

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Absent a clearly expressed legislative intention to the contrary, that language must ordinarily be regarded as conclusive." *Consumer Prods. Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108 (1980).

(2) "[It is a] settled rule that a statute must, if possible, be construed in such a fashion that every word must have some operative effect." *United States v. Nordic Vill., Inc.*, 112 S. Ct. 1011, 1015 (1992); *accord*, *Reiter v. Sonotone Corp.*, 442 U.S. 330, 338 (1979) (asserting that "[i]n construing a statute, we are obliged to give effect, if possible, to every word [the legislature] used.").

(3) "Canons of construction ordinarily suggest that terms connected by a disjunctive be given separate meanings, unless the context dictates otherwise." *Reiter*, 442 U.S. at 339.

<sup>51</sup> *See, e.g.*, *F.E.L. Publications, Ltd. v. Catholic Bishop of Chicago*, 214 U.S.P.Q. 409, 416, 1982 WL 19198 (7th Cir. 1982) (defendant took credit as the source of plaintiff's hymns); *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir. 1981) (defendant attributed plaintiff's film performance to another actor); *Williams v. Curtiss-Wright Corp.*, 691 F.2d 168 (3d Cir. 1982) (defendant's numbering system arguably implied that it was the manufacturer of plaintiff's engine parts).

<sup>52</sup> When Congress includes particular language in one part of a statute but omits it in another part of the same statute, it is presumed that Congress acted intentionally in the inclusion and exclusion. *See Barnhart v. Sigmon Coal Co.* 534 U.S. 438, 452 (2002); *Bates v. United States*, 522 U.S. 23, 29-30 (1997); 73 AM. JUR. 2D *Statutes* § 131 (2004). Another relevant principle has been articulated as *expressio unius est exclusio alterius* ("the expression of one thing implies exclusion of others") and *inclusio unius est exclusio alterius* ("the inclusion of one thing implies exclusion of others"). *See United States v. Ray*, 375 F.3d 980, 999-

of section 43(a)(1)(B), as revised in 1988, is simply inapplicable to non-geographic source designations, and therefore does not apply to claims of reverse passing off with respect to either tangible or intangible goods.

Under this literal interpretation, section 43(a) does not provide a cause of action against a defendant that falsely identifies itself as the originator of goods or services that actually emanated from the plaintiff. The crucial question, which *Dastar* did not address, is whether this literal reading accurately reflects the intent of Congress in enacting the TLRA.

If the literal interpretation is correct, that same interpretation might also preclude a section 43(a) claim where a defendant falsely suggests that the plaintiff's goods come from a maker other than the plaintiff *or* the defendant. For example, this interpretation might preclude a claim under section 43(a) where a defendant has falsely asserted that the plaintiff's goods are made by terrorists, by members of a Satanic cult, by non-union labor, by convicted felons, or by a manufacturer with a reputation for inferior goods. Yet these are the kind of false and injurious statements that Congress almost certainly would have intended section 43(a)(1)(B) to render actionable.<sup>53</sup> Such false statements could be as harmful as those that more directly reference the nature, qualities or characteristics of the plaintiff's goods. Thus, despite the narrow language of section 43(a)(1)(B), it can be argued that Congress intended to treat the identity of the maker of goods, or the provider of services, as one of the "characteristics" of those goods or services under section 43(a)(1)(B). Under this interpretation, 43(a)(1)(B) would encompass reverse passing off even though the underlying false statements would still be beyond the scope of section 43(a)(1)(A); however, even under this interpretation, section 43(a)(1)(B)

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1000 (9th Cir. 2004) (where federal statute assigns different obligations to courts and to a federal agency, this demonstrates that "Congress is not only capable of distinguishing between the two entities, but that if it had intended [to impose the same obligations], it could have clearly said so in the statute."); 73 AM. JUR. 2D *Statutes* § 129 (2004) (listing cases citing each principle). Based on these principles, the reference to "origin, sponsorship, or approval" in subsection (a)(1)(A) must mean something different from "nature, characteristics, qualities, or geographic origin" in subsection (a)(1)(B).

<sup>53</sup> For example, Procter & Gamble brought two suits under the current version of section 43(a), in different circuits, when an Amway distributor spread rumors that Procter & Gamble was affiliated with Satanism. Both suits involved the same incidents of false advertising involving the plaintiff's commercial activities. However, the opinion in the Tenth Circuit case clearly indicates that the claim was brought under section 43(a)(1)(B), see *Procter & Gamble Co. v. Haugen*, 317 F.3d 1121, 1124 (5th Cir. 2003), and the opinion emphasizes the words "characteristics" and "qualities" in that subsection. *Id.* at 1124 n.3. In contrast, the Fifth Circuit opinion in *Procter & Gamble v. Amway Corp.*, 242 F.3d 539 (5th Cir. 2001), refers to the same claim only as a "§ 43(a)" claim, and then quotes only subsection (a)(1)(A). *Id.* at 545 & n.8.

claims would still be limited to the context of commercial advertising and promotion.

A third interpretation of subsection (a)(1)(B) is also possible. This provision could provide a remedy for *some* false designations of origin, but not necessarily for those which constitute reverse passing off. The basis for this interpretation is that some false designations of origin may indirectly reflect on the “nature, qualities, or characteristics” of goods, and perhaps these are the only types of non-geographic designations of origin that should fall within the reach of subsection (a)(1)(B). A consumer could certainly perceive a statement that Satanists, terrorists, non-union labor, felons, or a low-end manufacturer created the plaintiff’s goods as an indication of poor quality or other characteristics relevant to that individual’s purchasing decision. At least some consumers are likely to use this kind of information to determine whether the product meets their needs.<sup>54</sup> For example, ardent union supporters might be deeply offended by having non-union goods in their homes. Even more people might be reluctant to make purchases that would provide financial support to terrorists or Satanists. Certainly, most consumers would be cautious about buying goods made by a manufacturer with a purported reputation for poor quality.

These types of false – and derogatory – indications of origin may more properly be understood as constituting “false advertising” about a competitor’s goods than, for example, a false statement in which the defendant itself tries to claim credit as the source of a competitor’s goods – the classic reverse passing off scenario. A defendant’s effort to claim credit for another’s merchandise is unlikely to involve disparagement of the characteristics of those goods. Indeed, just the opposite is likely to be true, in that the defendant is attempting to bolster its own reputation by taking credit for the plaintiff’s successful production activities.<sup>55</sup> Therefore, the subsection (a)(1)(B) prohibition against false statements about the characteristics of products made by someone other than

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<sup>54</sup> Thus, for example, the Tenth Circuit viewed allegations of Satanic affiliations as relevant to the characteristics or qualities of Proctor & Gamble’s products. *Haugen*, 317 F.3d at 1124 & n.3.

<sup>55</sup> One might analogize this situation to certification marks, which, while protected by the Lanham Act, are not considered designations of a particular source, and indeed will fail to qualify for protection as certification marks if they are ever used as source indicators. 15 U.S.C. § 1127 (2004) (defining “certification mark”). A mark indicating that goods are made by union labor, that they originate in a certain geographic region, that they were manufactured using a particular process, or that they meet certain standards for quality, would be a certification mark. The “Underwriter’s Laboratory,” “Energy Star,” or “AAA” marks would be examples of certification marks.

the defendant might apply to certain false designations of origin that carry strong implications regarding quality or characteristics (e.g., made by Satanists). They might not apply, however, to false designations that merely deny credit to the true manufacturer. Because reverse passing off cases typically involve false designations of the latter sort, they have little to do with the perceived quality or characteristics of the goods in question. Accordingly, under this interpretation they would not be encompassed by subsection (a)(1)(B).

Therefore, the language of section 43(a) does not support the Supreme Court's assumption that if Dastar had simply altered the source indicators on New Line's physical goods, this action would "undoubtedly" have given rise to a section 43(a) claim. If Dastar were to repackage New Line's actual videotapes under its own name, it would not be falsely representing the origin of *its own* goods. Instead, Dastar would be doing one of two things. First, it might be falsely representing the origin of New Line's goods. In the alternative, it would not be falsely representing the origin of any goods at all, because, as the party making these particular videotapes available to consumers, Dastar could accurately present itself to those consumers as the originator of the tapes.

Which of these characterizations is correct depends on what the term "origin" means in section 43(a)(1)(A). If the "origin" of the goods is the party that is actually *offering* the goods to the public – rather than the source from which that party obtained them – then Dastar as mere repackager of New Line's tapes would be telling the truth by designating itself the origin of the repackaged tapes. If, however, the *actual physical maker* of the tapes is considered to be the "origin" of those tapes, then Dastar as mere repackager would indeed be misrepresenting the origin of New Line's goods. In either case, however, Dastar's relabeling of New Line's physical goods would not involve a false representation about the origin of Dastar's *own* goods. Thus, notwithstanding the Court's assumptions to the contrary, Dastar's relabeling of New Line's tapes would fall outside the literal text of section 43(a)(1)(A). And, based on the text of the false advertising prong of section 43(a), in the absence of any false representations about the qualities or characteristics of the tapes, the relabeling would also not be actionable under section 43(a)(1)(B). Accordingly, the text of the Lanham Act provides little support for the Supreme Court's claim that relabeling another merchant's goods is "undoubtedly" actiona-

ble as reverse passing off under section 43(a).<sup>56</sup>

As discussed in Part IV below, the legislative history of the TLRA is ambiguous with regard to Congress' intent to ratify the pre-1988 case law that had applied section 43(a) to reverse passing off. If the interpretation of section 43(a) set forth above is correct, however, then a false designation of a non-geographic origin that pertains only to a *plaintiff's* goods or services would be actionable – if at all – only under subsection (B) of section 43(a)(1). It would, however, be actionable under either (A) or (B) when it pertains to a *defendant's* goods or services.

The reverse passing off claim in *Dastar* alleged a false designation of the origin of the *plaintiff's* goods. Therefore it should not have been cognizable under subsection (a)(1)(A) at all. In addition, since this particular false designation did not pertain to the nature, quality, characteristics, or geographic origin of the videotapes, it probably should not have been cognizable under subsection (a)(1)(B) either. A strong argument can therefore be made, based on the statutory language, that the reverse passing off claim under section 43(a) in *Dastar* should have been rejected regardless of whether it pertained to tangible or intangible goods.<sup>57</sup>

Thus, based on the literal text of section 43(a), it appears that reverse passing off need not be recognized at all under section 43(a) for either tangible or intangible goods, or for services or for

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<sup>56</sup> In addition, the “commercial advertising or promotion” language in section 43(a)(1)(B) imposes a further limitation on the applicability of that subsection to claims of reverse passing off. A claim arises under this provision only if the false representation about the qualities or geographic origin of goods or services takes place in the context of “commercial advertising or promotion.” 15 U.S.C. § 1125(a)(1)(B) (2004). While the packaging of a DVD or videotape might qualify, the credits listed on the film itself probably would not, because these credits are not visible to consumers when the DVD or videotape is being marketed. See *Rice v. Fox Broad. Co.*, 330 F.3d 1170 (9th Cir. 2003) (holding that false statements made on a television show were not actionable under section 43(a)(1)(B) because they were not made in promotion or marketing of the show; statements on the jacket of videotape were also not actionable because they could not be observed by potential customers prior to purchase and, therefore, did not influence purchasing decision). See generally *Cashmere & Camel Hair Mfrs. Inst. v. Saks Fifth Ave.*, 284 F.3d 302 (1st Cir. 2002) (holding that false advertising claim under Lanham Act must involve a statement that is likely to influence the purchasing decision); *First Health Group Corp. v. BCE Emergis Corp.*, 60 U.S.P.Q.2d 1532 (7th Cir. 2001), amended by No. 00-3833, 2001 U.S. App. LEXIS 24477 (7th Cir. 2001) (holding that “commercial advertising or promotion” in section 43(a)(1)(B) is not a synonym for all commercial speech subject to federal regulation); *Procter & Gamble Co. v. Haugen*, 222 F.3d 1262 (10th Cir. 2000) (representations in “commercial advertising or promotion” under section 43(a)(1)(B) must be made for purpose of influencing purchasing decision).

<sup>57</sup> Because none of the briefs submitted in *Dastar* addressed this issue, it is hardly surprising that the Court ignored it as well. Nonetheless, a decision based on a version of section 43(a) that was no longer in effect when the alleged infringement took place is built on a flimsy foundation.

any of the “other commercial activities” encompassed by section 43(a).

As discussed below, however, the legislative history of the TLRA and closely related statutes may evidence a contrary intent. Furthermore, to the extent that this history supports the application of section 43(a) to reverse passing off, it also suggests that the *Dastar* Court’s distinction between tangible goods and expressive works is inconsistent with the intent of Congress.

### III. LEGISLATIVE HISTORY: EVIDENCE OF CONGRESSIONAL INTENT TO APPLY POST-1988 SECTION 43(a) TO REVERSE PASSING OFF OF EXPRESSIVE WORKS

In construing the scope of section 43(a), it is helpful to consider not only the legislative history of the TLRA itself, but also the legislative history of two closely related statutes – the BCIA<sup>58</sup> and the VARA.<sup>59</sup> As discussed below, a review of these histories reveals that at no time has Congress clearly stated its intent to include reverse passing off of tangible goods in either section (a)(1)(A) or section (a)(1)(B). Ironically, however, on the few occasions that Congress has implied its endorsement of reverse passing off claims under section 43(a), that endorsement has applied specifically to intangible, expressive works. This suggests that *Dastar*’s conclusion may be precisely the opposite of what Congress intended.

Although the legislative history of the TLRA itself is largely inconclusive on the question of reverse passing off, a close review of the legislative histories of the BCIA and the VARA suggests that Congress would not have endorsed the Supreme Court’s decision to protect tangible but not expressive origins. It suggests, moreover, that Congress might have been willing to endorse a completely different distinction in the context of reverse passing off – a distinction between affirmatively false or misleading representations of origin, and representations of origin that are merely omitted or incomplete. Such a distinction, if applied to the facts presented in *Dastar*, would permit New Line to recover for reverse passing of its creative content, but only if *Dastar* made affirmatively false or misleading representations of origin that would materially affect the consumer’s purchasing decision.

#### A. *Trademark Law Revision Act*

Let us assume, *arguendo*, that the source of a good or service

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<sup>58</sup> Pub. L. No. 100-568, 102 Stat. 2853 (1988).

<sup>59</sup> Pub. L. No. 101-650, 104 Stat. 5128 (1990).

can in some cases be treated as one of its "characteristics" for purposes of section 43(a)(1)(B). Does this mean that reverse passing off is actionable under that provision, even if it is not actionable under section 43(a)(1)(A)? If the answer is no, then false statements about the origin of another party's goods or services are never actionable under section 43(a), and *Dastar's* assumption that such a cause of action would "undoubtedly" exist for tangible videotapes is simply wrong. If the answer is yes,<sup>60</sup> then *Dastar's* assumption regarding tangible goods was correct, but its holding to the contrary for expressive works is justified only if the Court's distinction between tangible and intangible goods is consistent with the intent of Congress.

In spite of the literal language of section 43(a), there is evidence in the legislative history of the TLRA that Congress in fact did *not* intend to overrule most previous judicial interpretations of section 43(a). As noted earlier, these included a significant line of cases that stated, correctly or not, that section 43(a) applied to reverse passing off, and reached this conclusion with respect to *both* tangible and intangible goods. The legislative history is, however, ambiguous.<sup>61</sup>

For example, the 1988 Report of the Senate Judiciary Committee states that the TLRA revisions to section 43(a) were intended "to codify the interpretation it has been given by the courts."<sup>62</sup> Al-

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<sup>60</sup> The Amicus Brief submitted by the International Trademark Association in *Dastar* suggests that reverse passing off is a type of false advertising under section 43(a)(1)(B). See Brief of Amicus Curiae the International Trademark Association in Support of Neither Party, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, (2003) at 11-12 & n.8 (No. 02-428); see also Lori H. Freedman, *Reverse Passing Off: A Great Deal of Confusion*, 83 TRADEMARK REP. 305 (1993) (suggesting that reverse passing off claims should be actionable under section 43(a)(1)(B) rather than section 43(a)(1)(A)); *Lamothe v. Atl. Recording Corp.*, 847 F.2d 1403, 1406 (9th Cir. 1988) (considering, without deciding, whether reverse passing off is actionable as false advertising).

<sup>61</sup> Professor Jean Burns has commented that the legislative history of the TLRA's revisions to section 43(a) "creates as much confusion as clarity." Jean Wegman Burns, *Confused Jurisprudence: False Advertising Under the Lanham Act*, 79 B.U. L. REV. 807, 820 (1999); see also Frank Z. Hellwig, *The Trademark Law Revision Act of 1988: The 100th Congress Leaves Its Mark*, 79 TRADEMARK REP. 287, 311 (1989) (commenting on the "lack of a unifying legislative history."). However, confusion about the congressional intent underlying section 43(a) is not unique to the TLRA amendments. See, e.g., THE UNITED STATES TRADEMARK ASSOCIATION, *Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 TRADEMARK REP. 375, 426 (1987) (stating that "Section 43(a) is an enigma, but a very popular one. Narrowly drawn and intended to reach false designations or representations as to the geographical origin of products, the section has been widely interpreted to create, in essence, a federal law of unfair competition.") (quoted in *Scholastic, Inc. v. Stouffer*, 124 F. Supp. 2d 836, 842 n.5 (S.D.N.Y. 2000)); Callman on Unfair Competition, § 5.5 (noting that, from the enactment of the Lanham Act in 1946 all the way to the enactment of the TLRA in 1988, federal courts were unable to reach a clear consensus on whether section 43(a) covered false advertising claims).

<sup>62</sup> S. REP. NO. 100-515, at 40 (1988).



though this can be read as an endorsement of the pre-1988 case law applying section 43(a) to reverse passing off, those precedents are noticeably omitted from the illustrative list that immediately follows: "For example, it has been applied to cases involving the infringement of unregistered marks, violations of trade dress and certain nonfunctional configurations of goods and actionable false advertising claims."<sup>63</sup>

The Report specifically states the Committee's intent to overrule one line of cases, originating with *Bernard Food Industries v. Dietene Co.*,<sup>64</sup> holding "that Section 43(a) applies only to misrepresentations about one's own products or services; it does not extend to misrepresentations about [a] competitor's products or services."<sup>65</sup> Accordingly, the Report continues, the TLRA amended section 43(a) "to make clear that misrepresentations about another's products are as actionable as misrepresentations about one's own."<sup>66</sup> This intent was manifested in section 43(a)(1)(B), the false advertising branch of section 43(a).

The 1988 Senate Report also notes that the Senate Judiciary Committee deleted proposed language stating that *omissions* of material information which misrepresent the nature, characteristics or qualities of a product or service are actionable under the section. This deletion was made to respond to concerns that it 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. Currently, the question of when Section 43(a) reaches failure to disclose information material to a consumer's purchasing decision is an open question in the courts. The committee does not, through the deletion, indicate that it condones deceptive advertising, whether by affirmative misrepresentation or material omission, and *leaves to the courts the task of further developing an applying this principle under section 43(a)*.<sup>67</sup>

The 1988 legislative history thus contains no specific indication that Congress intended to encompass claims of reverse passing off under either section (a)(1)(A) or (a)(1)(B). In the absence of any other evidence of such intent, it would seem that the literal language of the statute should control, and reverse passing off should not be recognized under section 43(a). However, as dis-

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<sup>63</sup> *Id.*

<sup>64</sup> 415 F.2d 1279, 163 U.S.P.Q. 264 (7th Cir. 1969), *cert. denied*, 397 U.S. 912, 164 U.S.P.Q. 481 (1970), *cited in* S. REP. NO. 100-515, at 40 (1988).

<sup>65</sup> S. REP. NO. 100-515, at 40 (citing *Bernard Food Indus.*, 415 F.2d at 1283).

<sup>66</sup> *Id.*

<sup>67</sup> *Id.* at 41 (emphasis added).

cussed below, contrary inferences may be drawn from the legislative history of the contemporaneous BCIA, as well as the VARA, which was enacted only two years later.

B. *The Berne Convention Implementation Act as Evidence of Congressional Intent to Provide a Section 43(a) Remedy for Misattribution of Works of Authorship*

In the same year that it enacted the TLRA, Congress considered and enacted the BCIA.<sup>68</sup> The near-simultaneous consideration and enactment of these statutes makes the BCIA's legislative history particularly helpful in interpreting the TLRA. Unfortunately, the *Dastar* opinion overlooks evidence in the BCIA's history which strongly suggests that the 100th Congress not only acquiesced in the application of section 43(a) to false attributions of works of authorship, but expressly *endorsed* that application as an important component of the network of state and federal laws upon which Congress relied in concluding that the United States could comply with the moral rights provisions of the Berne Convention without enacting any new moral rights legislation. In contrast to the legislative history of the TLRA, which is highly ambiguous in its treatment of reverse passing off claims in general, the legislative history of the BCIA strongly suggests that the 1988 Congress approved of applying section 43(a) to reverse passing off of literary and artistic works. Arguably, then there is a stronger case for applying section 43(a) to reverse passing off of expressive works than to reverse passing off of tangible goods – contrary to the conclusion drawn by the Court in *Dastar*.

The BCIA brought federal copyright laws into compliance with the Berne Convention for the Protection of Literary and Artistic Works, the leading international copyright convention. In the congressional debates that led to enactment of the BCIA, a crucial question was whether new legislation would be needed to bring the U.S. into compliance with the “moral rights” provisions of the Berne Convention, which required signatories to protect authors' rights to receive proper attribution for their work and to object to derogatory alterations of their work.<sup>69</sup> The Berne attribution right

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<sup>68</sup> Pub. L. No. 100-568, 102 Stat. 2853 (1988).

<sup>69</sup> Article 6*bis* provides:

Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

represents a variety of reverse passing off, as illustrated in *Smith v. Montoro* and the “bodily appropriation” cases, while the right to object to alterations corresponds to traditional passing off of the type recognized in *Gilliam v. American Broadcasting Cos.* and *King v. Innovation Books*, cases in which author/plaintiffs objected to having their names associated with significantly altered versions of their works.

The history of the BCIA strongly supports the inference that the 100th Congress understood section 43(a) to apply to intangible works of authorship rather than merely tangible goods, and that it held this understanding during the same time period when it considered and enacted the TLRA. In determining whether Berne would require the United States to enact moral rights legislation, Congress considered the conclusions reached by a committee of copyright experts assembled by the Department of State.<sup>70</sup> The Final Report of Ad Hoc Working Group on U.S. Adherence to the Berne Convention,<sup>71</sup> issued in 1986, cited the then-current version of section 43(a) as a proxy for the moral rights of attribution and integrity. With respect to attribution, the Report unequivocally states that section 43(a) (as in effect at that time) “prohibits false designations of origins of works, including intellectual and artistic works, and prohibits false descriptions and representations of such works.”<sup>72</sup> Citing *Smith v. Montoro* and work of the late Professor Melville Nimmer, the Report notes “that omission of an author’s name from his work may constitute ‘an implied reverse passing off’ and thus violate section 43(a).”<sup>73</sup> When publication without attribution misleads the public into thinking that the publisher or producer of a work, rather than its author, was the originator of the work, the Report states, “[t]his is a false designation of origin under section 43(a).”<sup>74</sup> With respect to reverse passing off, the Report notes, in a section captioned “Prohibiting Identification of Another as Creator of the Author’s Work” that “[f]alse identification of another as author . . . may give rise to a claim by the actual author under section 43(a).”<sup>75</sup> In a section captioned “Prohibiting Identification of the Author as Creator of Another’s Work” – a ref-

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Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, art. 6bis, S. Treaty Doc. No. 27, 99th Cong., 2d Sess. 41 (1986).

<sup>70</sup> H.R. REP. NO. 100-609, at 37-38 (1988).

<sup>71</sup> *Final Report of Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, reprinted in 10 COLUM.-VLA J. L. & ARTS 513, 547-57 (1986) [hereinafter *Final Report*].

<sup>72</sup> *Id.* at 36.

<sup>73</sup> *Id.* at 41.

<sup>74</sup> *Id.*

<sup>75</sup> *Id.*

erence to traditional passing off – the Report recognizes a series of federal cases as precedents supporting a remedy for “false identification” of expressive works under section 43(a).<sup>76</sup> Finally, with respect to the right of integrity, the Final Report cites *Gilliam* as a leading case, noting that “[c]ourts increasingly have granted authors protection for the integrity of their work under section 43(a).”<sup>77</sup>

Some members of the Working Group disagreed with the Final Report’s conclusion that extant U.S. law fully complied with the moral rights provisions of Berne. Subsequent scholars have criticized that conclusion as well.<sup>78</sup> Congress, on the other hand, readily accepted the Report’s conclusion, and enacted the BCIA without enacting any new moral rights legislation.<sup>79</sup> The Senate Report accompanying the BCIA noted:

[P]rotection is provided under existing U.S. law for the rights of authors listed in Article 6bis: (1) to claim authorship of their works (‘the right of paternity’); and (2) to object to distortion, mutilation or other modification of their works, or other derogatory action with respect thereto, that would prejudice their honor or reputation (the ‘right of integrity’). This existing U.S. law includes various provisions of the Copyright Act and L[a]nham Act, various state statutes, and common law principles such as libel, defamation, misrepresentation, and unfair competition, which have been applied by courts to redress authors’ invocation of the right to claim authorship or the right to object to distortion. Section 2(3) of the Act clarifies that the amendments made by this Act, together with the law as it exists on the date of enactment of the Act, satisfy U.S. obligations under Article 6bis and that no further rights or interests shall be

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<sup>76</sup> *Id.* (citing *Follett v. New Am. Library, Inc.*, 497 F. Supp. 304 (S.D.N.Y. 1980); *Geisel v. Poynter Prods., Inc.*, 295 F. Supp. 331 (S.D.N.Y. 1968); and “cases involving recording artists”).

<sup>77</sup> *Final Report*, *supra* note 71, at 42-43.

<sup>78</sup> Many commentators have criticized the conclusion in the BCIA House Report, H.R. REP. NO. 100-609, at 37-38 (1988), that the combination of federal and state laws then in existence was sufficient to satisfy the moral rights requirements of Article 6bis of Berne. See e.g., John M. Kernochan, *Comments of John M. Kernochan, in Final Report, supra* note 71, at 173, 174 (calling this conclusion “tenuous”); Edward J. Damich, *Moral Rights in the United States and Article 6bis of the Berne Convention: A Comment on the Preliminary Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention, in Final Report, supra* note 71, at 143, 150-51 (calling U.S. moral rights protection “virtually non-existent”); Russ VerSteeg, *Federal Moral Rights for Visual Artists: Contract Theory and Analysis*, 67 WASH. L. REV. 827, 832 (1992). See generally Robert J. Sherman, Note, *The Visual Artists Rights Act of 1990: American Artists Burned Again*, 17 CARDOZO L. REV. 373, 405-409 & nn.185-93 (1995) (collecting commentary critical of the House Report’s conclusion).

<sup>79</sup> The Working Group’s Final Report was the basis for most of the provisions of the BCIA. See William Belanger, *U.S. Compliance with the Berne Convention*, 3 GEO. MASON L. REV. 373, 391 (1995).

recognized or created for that purpose.<sup>80</sup>

The House Committee on the Judiciary agreed, stating in its report on the BCIA that “[b]ased on a comparison of its laws with those of Berne member countries, and on the current status of Federal and State protections of the rights of paternity and integrity, the Committee finds that current United States law meets the requirements of Article 6bis.”<sup>81</sup>

The House Report also supports the inference that Congress understood section 43(a) to apply to works of authorship when it enacted both the TLRA and the BCIA. The purpose of the BCIA was to enact legislation that was necessary to bring the United States into compliance with the BCIA, including its moral rights provisions. The BCIA House Report repeatedly emphasized that the Berne Convention was not self-executing,<sup>82</sup> so that joining the Convention would not automatically change existing domestic law, and took the position that the amendments to Title 17 contained in the BCIA, together with existing state and federal law, were sufficient for full compliance.

On the specific question of whether amendments were needed to comply with the requirements of Article 6bis regarding the attribution and integrity rights, the House Report noted that after two days of extensive testimony the “great majority” of experts agreed “that no additional law-making was needed to satisfy” those requirements.<sup>83</sup> In summarizing these arguments, the Report specifically mentions “section 43(a) of the Lanham Act, relating to false designations of origin and false descriptions”<sup>84</sup> as a basis for protecting moral rights. In addition, the Report specifically cites *Gilliam v. American Broadcasting Cos.*,<sup>85</sup> which relied on both copyright law and section 43(a), as an example of a court finding ways to “recognize[ ] the equivalent of such rights.”<sup>86</sup> It also notes that, more than twenty years earlier, Professor Melville Nimmer “wrote that ‘it might well be concluded’ that the totality of then-current law was sufficient to meet at least a ‘narrowly construe[d]’ definition of our obligations under Article 6bis.”<sup>87</sup> The fact that “the law

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<sup>80</sup> S. REP. NO. 100-352, at 9-10 (1988) (accompanying Pub. L. No. 100-568, Berne Convention Implementation Act of 1988).

<sup>81</sup> H.R. REP. NO. 100-609, at 38 (1988).

<sup>82</sup> *Id.* at 23, 32, 38.

<sup>83</sup> *Id.* at 33.

<sup>84</sup> *Id.*

<sup>85</sup> 538 F.2d 14 (2d Cir. 1976).

<sup>86</sup> H.R. REP. NO. 100-609, at 34 (1988).

<sup>87</sup> *Id.* at 34 n.67 (quoting Melville Nimmer, *Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 STAN. L. REV. 499, 525 (1967)).

has changed dramatically since then," the Report concludes, "add[s] more weight to this conclusion."<sup>88</sup>

The House Report noted that international copyright experts who participated in a 1987 World Intellectual Property Organization ("W.I.P.O.") Roundtable in Geneva unanimously agreed with this majority view.<sup>89</sup> The Report quotes Dr. Arpad Bogsch, the Director General of W.I.P.O., as stating that:

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. I believe that in the United States the common law and such statutes (Section 43(a) of the Lanham Act) contain the necessary law to fulfill any obligation for the United States under Article 6bis.<sup>90</sup>

Regardless of whether the majority's view was correct as a matter of law, that view was unambiguously adopted by the House Report.<sup>91</sup> And while it is clear that the Report did not rely exclusively on section 43(a) in concluding that the rights of attribution and integrity were sufficiently protected under domestic law, the specific references to section 43(a) and *Gilliam* irrefutably demonstrate that the 1988 Congress understood that section 43(a) had already been applied to works of authorship, and that it had been used to protect an author's attribution right and/or integrity right in such works.

Although the BCIA's legislative history lists section 43(a) as one source of moral rights, it does not specifically identify section 43(a) as the source of an *attribution* right. The attribution right would normally correspond to protection against reverse passing off (as in *Smith v. Montoro* or *F.E.L. Publications*), whereas the integrity right would normally correspond to protection against traditional passing off (as in *Gilliam* or *King*). Thus, it is possible that when Congress enacted the BCIA, it understood section 43(a) as the source of a right of integrity, but was relying on state rather than federal unfair competition law to supply the attribution right. However, the deliberations on the BCIA took place at the same time as the deliberations on the TLRA, and the same Congress enacted both statutes. As noted earlier, the TLRA legislative history expressly endorses the pre-1988 judicial interpretations of section 43(a), except for those cases that had treated omitted attributions

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<sup>88</sup> *Id.* (suggesting, however, that "the prime example" of these dramatic changes was the enactment of state "moral rights" statutes).

<sup>89</sup> *Id.* at 36.

<sup>90</sup> *Id.* at 37.

<sup>91</sup> *Id.* at 38-39.

as actionable. It is difficult to believe, then, that in the TLRA deliberations, the same Congress would endorse case law applying section 43(a) to false attributions of authorship while rejecting that same case law in their simultaneous BCIA deliberations. At the very least, one would expect to see some language expressly indicating such contradictory intent. Thus, in the absence of any language in either legislative history expressly rejecting the application of section 43(a) to affirmatively false attributions, particularly in light of Congress' express rejection (in the TLRA history) of section 43(a)'s application to mere omissions of attribution, it seems far more reasonable to believe that the BCIA legislative history endorses the application of section 43(a) to affirmatively false attributions of authorship in the case of expressive works.

Thus, the legislative histories of both the TLRA and the BCIA contradict Justice Scalia's assertion that the "origin" of "goods" in section 43(a) "refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods."<sup>92</sup>

The BCIA House Report also arguably refutes the Supreme Court's statement in *Dastar* that Congress could not have intended section 43(a) to apply to misattributions of authorship. Although the Congress that first enacted section 43(a) in 1946 may not have foreseen this application, there is also no evidence that it intended to foreclose this application. Furthermore, it appears that a *subsequent* Congress, in 1988, understood that section 43(a) *does* cover misattribution of works of authorship when it decided that compliance with Article 6bis of Berne did not require enactment of a federal statute that would explicitly protect authors against misattribution. It is a settled canon of construction that Congress' silence in the face of longstanding judicial interpretations of a statute tends to imply Congress' tacit endorsement of those interpretations.<sup>93</sup> Because the judicial interpretation of section 43(a) as applicable to authorial misattribution began only in the 1970's, ordinarily this might not qualify as sufficiently longstanding to imply congressional endorsement of that interpretation. However, Congress's express reliance in 1988 on both federal and state unfair competition law, including judicial interpretations of the relevant statutes, as a form of moral rights protection against authorial mis-

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<sup>92</sup> *Dastar*, 539 U.S. at 37.

<sup>93</sup> See, e.g., *Gulf Oil Corp. v. Copp Paving Co.*, 419 U.S. 186, 200-201 (1974) (holding that congressional silence in light of four decades of consistent judicial interpretation argues against finding this interpretation inconsistent with congressional intent).

attribution sufficient to satisfy Article 6bis offers evidence far stronger than congressional silence, suggesting that Congress was both aware of, and untroubled by, this application of section 43(a). Surely, if the 1988 Congress had intended the TLRA to repudiate the line of cases represented by *Gilliam*, *Smith*, and *F.E.L. Publications*, there would have been some indication of that intent in the legislative history.

Thus, the simultaneous consideration of the TLRA and the BCIA by the 1988 Congress seems to reinforce the view that Congress intended section 43(a) to continue to protect expressive works against reverse passing off. However, it does not clarify whether, when Congress bifurcated old section 43(a) into its “false designation” prong and its “false advertising” prong in the TLRA amendments, it had a clear and definite notion of *which* prong would thereafter apply to reverse passing off claims. As discussed in Part II.B. above, neither prong describes the “reverse passing off” scenario as clearly as it was described in the pre-1988 version of section 43(a). With no clear congressional statement of intent, it remains a mystery just *how* Congress intended the current version of section 43(a) to encompass reverse passing off. However, the BCIA history certainly implies that the 1988 Congress intended to validate judicial interpretations that found protection against misattribution of expressive works to be implicit in the pre-1988 version of the statute.

Congress revisited the BCIA’s legislative history just two years later, when it enacted the very limited moral rights protections of the VARA. The legislative history of the VARA provides further evidence that Congress had already embraced the application of section 43(a) to expressive works. Specifically, the House Report on the VARA noted that, during the debates preceding the BCIA:

While some (chiefly motion picture directors and screenwriters) argued that adherence to Berne required the enactment of new laws, the vast majority of those urging adherence contended that existing laws, both Federal and State, statutory and common, were sufficient to comply with the requirements of the Convention. The Congress agreed with the latter viewpoint and therefore enacted legislation to implement the Convention’s requirements without also enacting additional moral rights laws.<sup>94</sup>

Therefore, prior to *Dastar*, substantial evidence indicated that Congress endorsed the views of the federal courts that had inter-

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<sup>94</sup> H.R. REP. NO. 101-514, at 7-8 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6915, 6917-18 (1990) (footnotes omitted).



preted section 43(a) to provide a remedy for affirmatively false attribution of a work of authorship, at least with respect to copyrightable works. Rather than questioning this interpretation, courts instead focused on determining the proper legal test for finding that the right had been infringed. The Ninth Circuit adopted a requirement of near-wholesale copying – or “bodily appropriation”<sup>95</sup> – while the Second Circuit required only “substantial similarity,”<sup>96</sup> a standard more favorable to plaintiffs. Some Circuits found the quantity of copying less important, relying instead on a broader “likelihood of confusion” analysis to determine when a false attribution amounted to reverse passing off under section 43(a).<sup>97</sup>

According to Article 6bis of the Berne Convention, the moral rights mandated by that Article must exist independently of the economic aspects of copyright – that is, the rights provided by section 106 of the Copyright Act – and should not be lost upon assignment or exclusive license of the copyright:

Independently of the author’s economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which shall be prejudicial to his honor or reputation.<sup>98</sup>

The effect of *Dastar*, however, is to terminate the author’s attribution right when the author transfers the copyright. By rendering section 43(a) incapable of protecting the creative “origin” of expressive works, *Dastar* makes copyright law the only federal means for protecting attribution rights, and thus makes a federal attribution right unavailable to authors who do not own or control their copyrights (for example, if they have assigned the copyright or

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<sup>95</sup> See, e.g., *Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994); *Shaw v. Lindheim*, 919 F.2d 1353, 1364 (9th Cir. 1990); *Litchfield v. Spielberg*, 736 F.2d 1352, 1358 (9th Cir. 1984).

<sup>96</sup> See, e.g., *Waldman Publ’g Corp. v. Landoll, Inc.*, 43 F.3d 775, 784 (2d Cir. 1994).

<sup>97</sup> See, e.g., *Murray Hill Publ’n., Inc. v. ABC Communications, Inc.*, 264 F.3d 622, 634 (6th Cir. 2001); *Lipscher v. LRP Publ’g., Inc.*, 266 F.3d 1305, 1313-14 (11th Cir. 2001); *King v. Ames*, 179 F.3d 370, 374 (5th Cir. 1999); *Batiste v. Island Records, Inc.*, 179 F.3d 217, 225 (5th Cir. 1999); *PS Promotions, Inc. v. Stern*, No. 97 C 3742, 2000 U.S. Dist. LEXIS 3075 (N.D. Ill. Mar. 8, 2000); see also *Montgomery v. Noga*, 168 F.3d 1282, 1299 n.27 (11th Cir. 1999) (comparing approaches).

<sup>98</sup> Berne Convention for the Protection of Literary and Artistic Works, *supra* note 69, at art. 6bis. Berne does not prescribe any remedies for infringement of moral rights, however. Nor does Berne contain any general enforcement mechanisms to compel signatories to comply with its provisions. See *id.* art. 6bis(3) (“The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.”).

have licensed it without expressly reserving rights equivalent to an attribution right). Accordingly, by making copyright the exclusive means for protecting attribution rights under federal law, *Dastar* now seems to have removed a large component of the federal attribution protections on which Congress appears to have relied when it determined, in 1988, that the existing combination of federal and state laws in the United States satisfied the moral rights provisions of Berne.<sup>99</sup>

Accordingly, if *Dastar* means what it says, the Berne-mandated moral right of attribution is no longer protected under federal unfair competition law.<sup>100</sup> Ironically, it may still be protected under *state* unfair competition laws, which were not at issue in *Dastar*. However, the Supreme Court's concern that *federal* unfair competition law should not become a "mutant" form of copyright also raises the possibility that similar moral rights protection will also be denied under state laws, for two reasons. First, there is the spectre of federal preemption, whereby state unfair competition laws might be deemed preempted because states cannot be allowed to provide "mutant" copyright protection if the latter would interfere with the purposes of the federal copyright laws.<sup>101</sup> Second, some

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<sup>99</sup> Of course, this would not be the first instance in which the United States has failed to comply with Berne. Article 18 required the United States to restore copyrights in works from other Berne countries where those works have entered the public domain prematurely through failure to comply with formalities (such as notice or registration), yet the United States did not restore those copyrights until 1996, when restoration was mandated by the Agreement on Trade-Related Aspects of Intellectual Property Rights Including Trade in Counterfeit Goods (TRIPS) provisions of the 1994 World Trade Organization (WTO) Agreement, the terms of which were implemented by Congress in the Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (1994). Although the WTO Agreement subjects signatory nations to penalties for failure to comply with the Berne Convention, Article 9(1) of the TRIPS provisions expressly excludes the moral rights provisions of Article 6*bis*.

<sup>100</sup> It is less clear whether *Dastar* has any impact on uses of the Lanham Act to protect the other Berne-mandated moral right, the right of integrity – that is, the author's right to prevent certain derogatory alterations of a work – as illustrated by the Monty Python troupe's victory in *Gilliam*, 538 F.2d 14, and Stephen King's partial victory in *King*, 976 F.2d 824. Prior to *Dastar*, section 43(a) was deemed to apply where a plaintiff altered a defendant's copyrighted work but attributed the altered work to the defendant, and thus, arguably misrepresented the authorship of the transformed work. Because these cases fit the model of traditional passing off, rather than reverse passing off, it is not clear whether *Dastar* would prevent the application of section 43(a) to such claims. See *infra* notes 152-57 and accompanying text (discussing whether *Dastar's* interpretation of the "origin" of a "good" would foreclose traditional passing off claims involving expressive works).

<sup>101</sup> Because patent and copyright protection are the exclusive domain of federal law (except for the very limited scope of common law copyright), state laws that provide intellectual property protections that exceed limits deliberately imposed by Congress in the federal patent or copyright laws, or that duplicate such laws, are generally held to be preempted, even in the absence of a specific federal preemption statute. Compare *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (federal law preempted state law providing patent- or copyright-like protection to boat hull designs), *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) (federal law preempted an Illinois statute that ap-

courts might hold *Dastar's* interpretation of section 43(a) also controls the interpretation of the comparable state law.<sup>102</sup>

If neither state nor federal unfair competition laws protect the right of attribution, then the limited moral rights protection afforded by copyright law – the section 106 right to prevent unauthorized copying or derivative work creation, and the narrow moral rights protection for works of visual art under section 106A – will be the only forms of moral rights protection available under U.S. law. Contrary to the dictates of Berne Article 6bis, in most cases federal moral rights protection will be available only to the owner of the economic rights in a work, and will not protect the author once those rights have been transferred or have expired.<sup>103</sup>

However, until each state's unfair competition laws are explicitly found to be preempted in this context, or subject to the same narrow interpretation as section 43(a), they will still provide an alternative, and piecemeal, way for some plaintiffs to protect attribution rights in their expressive works. Accordingly, unless and until all state laws regarding reverse passing off are held to be subject to the *Dastar* interpretation in the case of expressive works, that interpretation will preclude some, but not all, plaintiffs from succeeding in their reverse passing off claims under state law, resulting in inconsistent levels of moral rights protection across jurisdictions.

The *Dastar* opinion points to section 106A as evidence that the Congress that enacted the VARA in 1990 did not intend section 43(a) to protect the moral right of attribution. As the Court points out, section 106A creates narrowly defined rights of attribution and integrity for limited edition works of visual art, some of which would arguably be superfluous if those rights were already fully

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peared to provide patent-like protection to industrial designs regardless of whether the designs were federally patented), *and* *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964) (similar to *Sears*), *with* *Goldstein v. California*, 412 U.S. 546 (1973) (pre-1972 federal law did not preempt state law granting copyright-like protection to sound recordings, because Congress' failure to provide copyright protection to sound recordings did not reflect deliberate decision to deny such protection), *and* *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) (federal law did not preempt state trade secret law, because latter did not undermine patent law's goal of encouraging public disclosure of novel inventions).

<sup>102</sup> In two post-*Dastar* cases raising claims of reverse passing off under California's unfair competition statutes, Cal. Bus. Prof. Code §§ 17200, 17500 (2003), federal district courts in California have rejected the claims, holding that the Supreme Court's interpretation of section 43(a) requires a similar interpretation of state law, even though the language of the California statutes in question bears little resemblance to that of section 43(a). *Twentieth Century Fox Film Corp. v. Dastar Corp.*, 68 U.S.P.Q.2d (BNA) 1536 (C.D. Cal. 2003); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177 (C.D. Cal. 2003).

<sup>103</sup> The only exception would be those "works of visual art," which receive an explicit, but very limited, form of moral rights protection under 17 U.S.C. § 106A (2004).

protected by section 43(a) of the Lanham Act. However, section 106A was enacted by a Congress that was very much aware of, and indeed reiterated,<sup>104</sup> the previous Congress' declaration that no moral rights legislation was necessary to comply with Article 6bis of Berne.<sup>105</sup> Thus, Congress seems to have intended section 106A as an enhancement of existing protections even if its enactment led to some overlap in protections.<sup>106</sup> Moreover, section 106A clearly protects rights that section 43(a) does not – for example, the right to prevent certain works of art from being destroyed or damaged, even by their owners, and the right to prevent objectionable alterations to works even in the absence of a misattribution.<sup>107</sup> It preempts equivalent state moral rights protection during the life of the author, something else that section 43(a) does not do, and thereby reduces the potential for inconsistent levels of moral rights protection in different states.<sup>108</sup> It also imposes specific requirements for giving effect to moral rights waivers, requirements that are far more rigorous than those that apply to waivers under section 43(a).<sup>109</sup> It provides for the full array of copyright remedies, including statutory damages, and thus allows for a recovery of damages without the showing of actual economic injury (or defendant's unjust enrichment) that is generally necessary to recover damages under section 43(a).<sup>110</sup> In addition, the rights granted to authors under section 106A do not depend on whether or not a particular misattribution creates a likelihood of confusion on the part of consumers; indeed, an author may have a claim under section 106A even if the public is fully informed that the attribution is inaccurate or incomplete, or has no interest in knowing the true origin of the work.<sup>111</sup>

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<sup>104</sup> See *supra* text accompanying note 94.

<sup>105</sup> See *supra* notes 68-91 and accompanying text.

<sup>106</sup> In enacting VARA, Congress also seems to have focused more on the perceived shortcomings of Title 17 in light of Berne, rather than on the broader question of whether the totality of domestic laws satisfied Berne, which it answered affirmatively in 1988. See H.R. REP. NO. 101-514, *supra* note 94, (noting that “only an artist who retains the copyright in his or her work is able to invoke Title 17 rights in defense of the integrity of that work, and then only where a modification amounts to the creation of a derivative work.”).

<sup>107</sup> 17 U.S.C. § 106A(a)(3)(A)-(B) (2004).

<sup>108</sup> *Id.* § 301(f).

<sup>109</sup> *Id.* § 106A(e).

<sup>110</sup> *Id.* §§ 501(a), 504 (2004) (allowing statutory damages for copyright infringement as alternative to actual damages and profits); *Web Printing Controls Co. v. Oxy-Dry Corp.*, 906 F.2d 1202 (7th Cir. 1990) (Lanham Act plaintiff seeking damages must show that consumer confusion caused actual injury); *Schutt Mfg. Co. v. Riddell, Inc.*, 673 F.2d 202 (7th Cir. 1982) (similar); *Caesar's World, Inc. v. Venus Lounge, Inc.*, 520 F.2d 269 (3d Cir. 1975) (absence of proof of damage to plaintiff or profit by infringer precludes award of damages under 15 U.S.C. § 1117).

<sup>111</sup> Section 106A(a)(2) (the attribution right) allows an author to object to the use of his or her name as the author of the altered work, while section 106A(a)(3) (the integrity

Furthermore, as discussed in the next section, the alternative interpretation of section 43(a) proposed in this Article would eliminate even more of the claimed overlap with the VARA. Section 106A grants certain visual artists the affirmative right to receive credit for their work.<sup>112</sup> This right would not be superfluous if section 43(a) were interpreted to prevent reverse passing off only when it takes the form of affirmatively false or misleading attributions, and not when the attribution is merely omitted or incomplete. Under this interpretation, the types of false attributions that would be actionable under section 43(a) would include situations where a defendant affirmatively took credit for a plaintiff's specific contributions to a work, or affirmatively attributed those contributions to a third party, but would not include cases where a defendant merely failed to give credit to the plaintiff. Cases of the latter sort would be actionable, if at all, only under section 106A.

#### IV. ALTERNATIVE ANALYSIS: DISTINGUISHING A FALSE PROVENANCE FROM AN INCOMPLETE ONE

In spite of the concerns expressed by Justice Scalia, there is indeed a way to preserve the ability of unfair competition laws to protect the public against misleading attributions of expressive works without requiring a detailed provenance for every work embodying ideas or expression. If we assume, for the sake of argument, that *Dastar* was correct in stating that section 43(a) applies to reverse passing off of *tangible* goods (under a very liberal interpretation of either subsection (a)(1)(A) or (a)(1)(B)),<sup>113</sup> it is still not entirely clear that section 43(a) should provide a cause of action where the "passing off" consists of an omitted or incomplete attribution. In other words, one can argue that an actionably false representation about the origin of a plaintiff's goods or services should involve something more than a mere omission; instead, it should require an *affirmatively* false declaration of source.

If a defendant acquires merchandise from a plaintiff, removes the plaintiff's trademark, and substitutes its own mark, a strong ar-

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right) allows an author to object to such an alteration even if his or her name is removed from the work.

<sup>112</sup> Section 106A provides, in relevant part, that:

[T]he author of a work of visual art

(1) shall have the right—

(A) to claim authorship of that work, and

(B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create . . . .

17 U.S.C. § 106A(a)(1) (2004).

<sup>113</sup> See *supra* notes 43-54 and accompanying text.

gument can be made that the defendant is accurately representing itself as the originator of these particular goods. Although the defendant would not be the *sole* source of the goods, it would certainly be *one of* the sources, and indeed it would be the most *proximate* of those sources, since it is the last player in the distribution chain that has brought the goods to the purchaser. Thus, the defendant's indication of itself as the origin of the goods would still be accurate, though not comprehensive, since it leaves out the earlier history of the goods.

The approach proposed here rejects *Dastar's* unwarranted narrowing of the concept of "origin," and allows section 43(a) to apply equally to expressive works and tangible merchandise, as well as services and commercial activities, as it has in the past. Thus, creative and physical provenances are treated alike. The proposed approach also avoids the parade of horrors that the Court envisioned as the unavoidable consequence of applying section 43(a) to expressive works. However, it recognizes that the very same parade of horrors could easily follow from the Court's ill-considered assumption that section 43(a) bars relabeling as to *physical* origins.

Rather than impose on merchants an open-ended obligation to recite the entire creative or physical provenance of goods and services, the approach proposed here distinguishes between attributions that are affirmatively false or misleading, on the one hand, and attributions that are merely omitted or incomplete, on the other. As discussed below, this approach would provide a cause of action under section 43(a) only in the case of affirmatively false or misleading representations of origin, whether that origin is creative or physical. Although there may be occasions where a fine line separates affirmative misrepresentations from incomplete or omitted attributions, such line-drawing is hardly unfamiliar to courts evaluating section 43(a) claims, which always turn on the ultimate questions of whether the public is likely to be confused and whether that confusion is likely to injure the plaintiff.

This approach begins by rejecting the Court's suggestion that the source of ideas or expression embodied in a product is irrelevant to the product's "origin" for purposes of section 43(a). Every commodity offered for sale embodies ideas or expression, whether or not these are eligible for patent, trade secret, or copyright protection. Even a salt shaker embodies ideas. In some cases, particularly those involving goods with significant expressive, artistic, or inventive elements, consumers may care a great deal more about the source of the ideas, information, or inventive or creative ele-

ments embodied in the good than the source of its physical manufacture.<sup>114</sup>

Instead, this approach refocuses the unfair protection analysis on the goal of consumer protection, by inquiring what the consumer reasonably believes about a good and whether that belief is likely to have a material effect on the purchasing decision.<sup>115</sup> In some cases, authorship of the idea, expression, or performance embodied in the commodity may be just such a factor. Certainly, in the case of literary works or entertainment works, the identity of the actual author, performer, or creative overseer may frequently be more crucial to the consumer's purchasing decision, than the identity of the party that manufactured the physical embodiment.<sup>116</sup> Like other, more traditional, types of trademarks, the identity of key creative participants is often viewed as a source indicator that is an important predictor of the quality or content of the goods. In order for these source indicators to perform their consumer protection function, they must receive the same degree of protection under the Lanham Act as more traditional trademarks. Affording this legal parity to indicators of creative source under the Lanham Act is possible if we treat all affirmatively false or misleading statements of origin as actionable unfair competition, while providing no cause of action where indications of origin are merely omitted or incomplete. The proposed rule would therefore bar application of section 43(a) to reverse passing off claims based on mere omissions (often referred to as "implied" reverse passing off), regardless of whether they pertain to the origin of tangible or

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<sup>114</sup> Even the Court's own example supports this. Although the Court suggests that customers do not care to know who invented the Coca-Cola formula, and care only to know that their beverage was made by the Coca-Cola Company, 539 U.S. at 32, the latter claim is dubious. Customers care only that the formula in their beverage is the genuine Coca-Cola formula, and that someone has exercised appropriate quality control over its preparation. The function of the trademark is to convey this crucial information to the consumer. Consumers do not care who actually mixed or bottled the beverage, any more than they care to know the name of the person who invented the formula. They just want to know that the intellectual property embodied in the beverage (the trade secret formula) is "the real thing." For further discussion of the Court's Coke/Pepsi analogy, see notes 138-41 and accompanying text.

<sup>115</sup> This is the familiar standard used in federal trademark law to determine whether a misdescriptive mark is "deceptive" and therefore unregistrable under section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a) (2004). See, e.g., *In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1336 (Fed. Cir. 2003); *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988). The standard is also used to determine whether a false advertisement is actionable under section 43(a)(1)(B). See, e.g., *Hickson Corp. v. Northern Crossarm Co.*, 357 F.3d 1256, 1260 (11th Cir. 2004); *Johnson & Johnson Vision Care, Inc. v. 1-800 Contacts, Inc.*, 299 F.3d 1242, 1247 (11th Cir. 2002).

<sup>116</sup> Justice Scalia acknowledged this in *Dastar*, but concluded that the consumer's interest in creative provenance outweighed the importance of avoiding overlap between unfair competition and copyright law. 539 U.S. at 33-34.

intangible components of a commodity. It would, however, provide a cause of action under section 43(a) for any affirmatively false or misleading indication of origin (that is, “express” reverse passing off). The same distinction would apply regardless of whether the misrepresentation (or omission) pertains to the tangible or intangible components of a commodity. Thus, the same standard would apply to both expressive and non-expressive works.

Moreover, this approach recognizes the absurdity of the Court’s assumption that removing a manufacturer’s mark from goods, and substituting the re-seller’s mark, is “undoubtedly” actionable as a “false designation of origin.”<sup>117</sup> Merely omitting the identity of a maker or other upstream supplier is in most cases unlikely to cause consumer mistake or deception, because consumers ordinarily do not expect a full provenance on every item they purchase – and this is equally true whether the provenance in question applies to tangible or intangible contributions. Even when a defendant affirmatively names itself as the source, without identifying upstream contributors, that affirmation may not be false, but simply incomplete. Thus, replacing the plaintiff’s mark with the defendant’s mark does not necessarily cause the public to infer that the defendant was the only party that contributed to the finished product.

The relative lack of harm to consumers in the case of omitted source designations is easily illustrated, even in the case of tangible origins where the Court thought that section 43(a) should “undoubtedly” apply. For example, when Chrysler puts its name on a car without identifying the source of every component of that car, it is accurately representing itself as the source of the combination of components, indeed the most proximate and important source, and the failure to identify its partners and subcontractors is not false or misleading, even if Chrysler did not itself manufacture a single component of the vehicle. If the car fails to perform well, the consumer will identify Chrysler as the source of the vehicle, and the consumer will hold Chrysler accountable. The consumer will not especially care who made the particular component that failed, and in all likelihood the consumer did not ask the identity of each component manufacturer at the time he or she bought the car from Chrysler. Thus, the consumer’s buying decision was probably not influenced by Chrysler’s failure to disclose that the component makers were unaffiliated with Chrysler. In this example, section 43(a) would not provide a cause of action, because the de-

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<sup>117</sup> *Dastar*, 539 U.S. at 31.



fendant has truthfully identified itself as the party responsible for offering this particular combination of components to the relevant marketplace. If the consumer is concerned about the source of a particular component – the engine, for example – then he or she would probably inquire at the time of purchase, or look up this information in the product brochures. If Chrysler (or its authorized agent) affirmatively represents that the engine was manufactured by Chrysler, when in fact it was manufactured by Tonka Toys, then Chrysler has engaged in express, rather than implied, reverse passing off, and section 43(a) should apply.<sup>118</sup> Mere silence as to the engine's source, however, should not be actionable, since a reasonable consumer would not expect that Chrysler itself makes every component of its vehicles. However, the Court's suggestion that removal of the manufacturer's label would "undoubtedly" violate section 43(a) seems to contradict this common-sense conclusion.

To use another example, suppose that a customer orders a sour apple martini at a bar. When the martini arrives, it does not bear a label indicating the specific brands of schnapps and vodka that the bartender used.<sup>119</sup> Surely the customer does not believe that the bar itself distilled the schnapps and vodka. Instead, the customer assumes, without even considering the matter, that the bar uses various brands of beverages that are made and distributed by other parties. The customer knows that the bar is the most proximate source of the martini, because the bar selected the brands and the bartender is responsible for how the drink was mixed. Therefore, the customer will accurately blame the bar if the drink is not prepared well or if the ingredients are of poor quality. But the customer does not believe that the bar actually

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<sup>118</sup> The pervasive problem of standing, of course, limits the ability of section 43(a) to protect consumers even under both the *Dastar* approach and the approach proposed here. If Tonka Toys did not care that Chrysler was taking credit for its engines, it would be unlikely to bring a section 43(a) claim for either express or implied reverse passing off, and the deception of consumers could conceivably continue. However, Chrysler's competitors would have standing to sue, based on the likelihood of competitive injury, and might very well be motivated to do so. In this respect, the proposed distinction between express and implied reverse passing off is subject to the same infirmity as the *Dastar* approach, an infirmity that arises because the section 43(a) standing requirements dictate that consumer protection be relegated to industry competitors rather than entrusted to the consumers themselves. To some extent, of course, the consumer protection function is also delegated to federal administrative agencies.

<sup>119</sup> It is unlikely that the makers of these ingredients gave the bar an express license to omit their origin indicators. There may be an implied license, but such a license might be implied in virtually any situation where components are purchased from suppliers and then assembled and distributed under another vendor's name. In fact, it might be more accurate to say that such a license is implied unless the component maker expressly states a contrary intent.

made the individual ingredients. In contrast, if the bar *affirmatively misrepresents* the brand of vodka that it is using – perhaps claiming to use a premium brand but in fact using a cheaper brand – the customer is being misled. The trademark owner of the premium brand in this case has a traditional passing off claim.<sup>120</sup> But the trademark owner of the cheaper brand also has a claim, at least under the law of most states, for reverse passing off by affirmative misrepresentation. If the customer likes the cheaper vodka, he or she will mistakenly think it is the premium brand, and will be more likely to purchase the premium brand in the future, not realizing that the enjoyable product in fact originated elsewhere. In contrast, if the bar said nothing about the source of the vodka, we know that the customer assumes it was not distilled by the bar, and the customer can ask the bar to identify the source if that information is important to the customer. No misrepresentation has occurred, and the customer is not confused by the bar's initial decision to omit the source identification.

The *Restatement (Third) of Unfair Competition* uses a similar scenario to illustrate a situation in which reverse passing off should not be recognized:

A operates a restaurant and purchases candies sold by B in boxes bearing B's trademark. A removes the candies and individually wraps them in paper bearing the name of A's restaurant and serves them to its customers. In the absence of evidence indicating that the customers are likely to believe that the candies were manufactured by A, A has not made a representation likely to deceive or mislead under the rule stated in this Section.<sup>121</sup>

The same analysis applies if the plaintiff and defendant offer identical items in the same marketplace. For example, suppose the defendant buys apples from the plaintiff, relabels them, and then sells them to the public under the defendant's own label. In that sense, both the plaintiff and the defendant are sources of the relabeled fungible goods. But when a customer purchases one of these relabeled apples from the defendant, its most proximate origin is the defendant. If the apple is rotten, who must refund the customer's money? Certainly not the plaintiff. The defendant is the source of this apple in the true trademark sense, because the

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<sup>120</sup> See, e.g., *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526 (1924) (holding that common law passing off occurred where pharmacists dispensed defendant's medication under plaintiff's brand name).

<sup>121</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 5, cmt. b.

defendant's goodwill stands behind the apple, and its reputation will be damaged if the apple is bad, and more so if the defendant refuses to allow an exchange or a refund. The defendant's mark indicates who is ultimately responsible *to the consumer* for the quality of the product. In that sense, it is an accurate representation. The omission of plaintiff's origin indicator would be actionable if reverse passing off applies to omissions, but not if it applies only to affirmatively false statements. The consumer's interests are protected even if the plaintiff's trademark is omitted, because a disappointed consumer will look to the defendant for recompense. Thus, no cause of action for the omitted trademark is needed.

In discussing the common law concept of reverse passing off, the *Restatement (Third) of Unfair Competition* suggests that there is less potential for commercial injury in the case of reverse passing off than in the traditional passing off scenario:

Although all forms of passing off involve the creation of confusion with respect to the source of goods or services, the threat of harm to the commercial interests of others is less immediate in the case of reverse passing off. Unlike the misrepresentations of source described in § 4, reverse passing off does not directly threaten the reputation of another since by definition the misrepresentation acts to sever the actual producer's association with the goods or services marketed by the actor. Similarly, it cannot be said that the actual producer is subject to a direct diversion of trade in the usual sense since it has already sold the very goods at issue. Reverse passing off, however, may sometimes misrepresent the relative capabilities or accomplishments of the parties, thus creating the likelihood of a future diversion of trade to the actor. This Section subjects the actor to liability only if the actual producer can establish both the fact of a misrepresentation and a likelihood of harm to its commercial relations.<sup>122</sup>

The *Restatement's* Reporter's Notes distinguish between mere omission of the maker's mark, and affirmatively false representations regarding the maker's identity:

The case law does not recognize an affirmative duty on the part of a seller to disclose the identity of the manufacturer or producer of goods offered for sale; liability is imposed only on the basis of an express or implied misrepresentation that the goods have been produced by the actor or a third person.<sup>123</sup>

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<sup>122</sup> *Id.*, § 5, cmt. a.

<sup>123</sup> *Id.*, § 5, cmt. b, Reporter's Notes (citing *Vargas v. Esquire, Inc.*, 164 F.2d 522 (7th Cir. 1947) (refusing to recognize an obligation to credit plaintiff as the creator of drawings

The *Dastar* approach does not conform to the *Restatement* approach, because it does not distinguish between affirmative representations and mere omissions. Instead, it distinguishes between creative and manufacturing provenance, and conclusively presumes that consumers do not care about creative provenance.<sup>124</sup>

The approach proposed here is more consistent with the *Restatement* position: The party reselling another manufacturer's goods would be entitled to omit the maker's source identifier and substitute its own mark to indicate that the reseller was the proximate *source* of the goods, but would not be entitled to represent itself affirmatively as the *manufacturer* of those goods, because the latter would constitute an affirmatively false representation. The same distinction would apply to both physical and creative provenance. Using the *Dastar* context as an example, Dastar would be entitled to omit any reference to Twentieth Century Fox or the other creative forces behind the film series, and would be entitled to place its own source identifier on the videocassettes to identify itself as the proximate source of the products. However, Dastar would not be entitled to make affirmatively false representations regarding the identities of the writers, narrators, editors, producers or other participants who created the work. Thus, Dastar could identify its own employees who actually worked on the revised and reissued films, along with the contributions they made or the functions they performed, but it would not be entitled to make or imply any false statements about their contributions or functions. Whether Dastar's representations crossed this line is a question for the trier of fact. Thus, whether representing Dastar and several of

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published in defendant's magazine); PIC Design Corp. v. Sterling Precision Corp., 231 F. Supp. 106, 115 (S.D.N.Y. 1964) (declining to impose liability on seller who removed plaintiff's name from product purchased through intermediary and resold product in box marked with its own name, and noting that "[t]o hold otherwise would be to forbid any repackaging, resale, or reshipment of any item not manufactured by the shipper but sold under his name."); Commodore Import Corp. v. Hiraoka & Co., 422 F. Supp. 628 (S.D.N.Y. 1976); Roho, Inc. v. Marquis, 902 F.2d 356 (5th Cir. 1990) (use of plaintiff's product as component of new product sold under defendant's name is not actionable); Shaw v. Lindheim, 919 F.2d 1353 (9th Cir. 1990), *on remand*, 809 F. Supp. 1393 (C.D. Cal. 1992) (holding that sale under defendant's name of television script taken in part from plaintiff's work is not actionable)).

<sup>124</sup> *Dastar*, 539 U.S. at 32-33.

The consumer who buys a branded product does not automatically assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product—and typically does not care whether it is. The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.

*Id.*

its employees as “producers” of the videotapes<sup>125</sup> constitutes a false representation depends on the typical consumer would understand as the meaning of the term “producer.”

Treating mere omissions of source as actionable is especially problematic in situations where the defendant does not, and cannot reasonably be expected to ascertain, the identity of prior sources. Although the defendant in *Dastar* knew that Fox was the creator of the public domain series, it is easy to conceive of a case in which a public domain work is discovered but its creator and the rest of its provenance are not easily ascertained. The discoverer who wishes to make this work available to the public, either in its original form or in an adaptation, should not be expected, on pain of subsequent liability, to undertake extraordinary efforts to discover and disclose its provenance as a prerequisite to satisfying the public’s desire for access to the work. By denying a cause of action for mere omissions, the approach proposed here would avoid burdening parties seeking to make uncopyrighted works available to the public. Unlike the *Dastar* approach, it would also guarantee an equivalent benefit to parties who wish to offer the public products whose physical manufacturer is unknown. Under *Dastar*, since the omission of a *known* manufacturer would “undoubtedly” be actionable, it is unclear whether a manufacturer could bring suit for reverse passing off against someone who distributed its products without attribution because the distributor was unable to ascertain the maker’s identity.

The proposed approach would resolve the situation, discussed earlier,<sup>126</sup> in which a defendant falsely alleges that the plaintiff’s goods are made by someone *other than the defendant or the plaintiff—e.g., Satanists or terrorists*. In such a case, the defendant has made affirmatively false, rather than merely incomplete, representations about the source of the plaintiff’s goods. Thus, when a defendant offers goods to the public which were manufactured by the plaintiff, labeling the goods as originating from the defendant would be accurate (as in *Dastar*) because the defendant in fact supplied the goods to the public. Labeling the goods as originating from the plaintiff would be accurate *if* the goods had not been significantly altered (as they were in *Gilliam* and *King*) since leaving the plaintiff’s control. Labeling them as originating from an intermediary, such as a distributor, would be accurate if in fact that particular intermediary was involved in the distribution process. Labeling

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<sup>125</sup> *Dastar*, 539 U.S. at 27.

<sup>126</sup> See *supra* notes 54-56 and accompanying text.

them as originating from every component maker or intermediary who contributed to offering the finished goods to the public could also be accurate, as long as the label did not imply that a party was responsible for something other than its actual contribution (as exemplified again by *Gilliam and King*). However, labeling the goods as originating from a source that has never had any connection with those goods would be false and actionable.

If we accept the Court's assumption that the 1988 Congress did intend to include the pre-1988 reverse passing off cases in the lines of authority that it codified in the TLRA amendments, the distinction proposed here between incomplete or omitted provenances and affirmatively false statements of origin finds stronger support in the relevant legislative history than does the Court's decision to jettison expressive works from the scope of section 43(a). As noted earlier,<sup>127</sup> both the House Report that accompanied the BCIA and the *Final Report* on which Congress relied in enacting the BCIA confirmed that the pre-1988 version of section 43(a) applied to "intellectual and artistic works."<sup>128</sup> The *Final Report* also indicated that mere removal of an author's name could be actionable under section 43(a).<sup>129</sup> While the proposed approach does not adopt that position, it still carries out the BCIA's intent more faithfully than does the *Dastar* approach.<sup>130</sup>

#### V. *DASTAR*'S POLICY RATIONALE: NARROWLY DEFINING THE CONSUMER'S "NEED TO KNOW"

Unfortunately, because the Supreme Court conceded the application of section 43(a) to reverse passing off of tangible goods, the Court was compelled to undertake a tortured and unpersuasive analysis to justify its holding that the same conclusion should not apply to intangible goods. It did so largely by relying on an unpersuasive consumer protection rationale.

In defending its narrow interpretation of section 43(a), the Court relied on its belief that consumers do not want or need information about the creative origins of most goods. In the case of goods, the Court concluded, the consumer is only concerned with the physical manufacturer of those goods:

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<sup>127</sup> See *supra* note 73 and accompanying text.

<sup>128</sup> *Final Report*, *supra* note 71, at 35.

<sup>129</sup> *Id.*; see *supra* note 74 and accompanying text.

<sup>130</sup> Another scholar has taken the even stronger view that the plain language of section 43(a) does not apply to reverse passing off at all; his argument does not distinguish between merely omitting a source indicator and providing an affirmatively false indicator. See John T. Cross, *Giving Credit Where Credit is Due: Revisiting the Doctrine of Reverse Passing Off in Trademark Law*, 72 WASH. L. REV. 709, 737-42 (1997).

We think the most natural understanding of the “origin” of “goods”—the source of wares—is the producer of the tangible product sold in the marketplace, in this case the physical *Campaigns* videotape sold by Dastar . . . . The consumer who buys a branded product does not automatically assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product—and typically does not care whether it is. The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to consumers.<sup>131</sup>

Perhaps the most obvious flaw in this premise arises from the fact that tangible goods frequently do not bear any indication of their physical manufacturer, either because they bear only the label of a licensor, or because they are manufactured by parties who act at the direction of the manufacturer identified on the label. Apparel bearing a famous brand label, such as “Ralph Lauren” or “Liz Claiborne” or “Nike,” is typically made by parties who are not identified on the clothing’s label. These labels typically indicate only the brand name and the country of manufacturer – China, Mexico, Indonesia, Pakistan, etc. Consumers therefore have no idea who actually made the goods purchased; they only know that the brand wants to take the credit (or blame) for the finished goods.<sup>132</sup> Taking the Court’s emphasis on physical origins to the logical extreme, of course, consumers would be entitled to know the names of the individual workers who cut and sewed their apparel. Consumers typically do not care to know such detail.

The Court acknowledged – with surprising reluctance – that limiting the “origin” of tangible goods to the physical manufacturer of those goods might be too narrow an interpretation of the term, yet it was unwilling to “stretch” the term beyond the other responsible parties who licensed, or otherwise authorized, the production of the goods:

The concept might be stretched (as it was under the original version of § 43(a)) 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. But 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”

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<sup>131</sup> *Dastar*, 539 U.S. at 31-33.

<sup>132</sup> The same can be said of services in many cases; consumers contract with a service provider but may not know, or care about, the identity of the individual (or the subcontractor) who actually delivers the service to them.

embody or contain.<sup>133</sup>

However, by confining the “stretched” concept of “origin” only to those who “commissioned or assumed responsibility for . . . production of the physical product,” the Court failed to acknowledge that a party further *down* the distribution chain might also have a valid claim to be the “origin” – or at least one of the “origins” – of the tangible goods in question, even if that party had no authority whatsoever over the manufacturing process. In other words, the wholesaler, distributor, repackager, or retailer of goods might also be considered the “origin” of those goods. Certainly, when one of those parties puts its trademark on the goods that it offers for resale, it stands behind those goods in the sense that dissatisfied purchasers will look to the owner of that trademark to determine who is accountable for the quality of that product. By pinpointing the “origin” as the physical manufacturer of the goods, or the party that authorized their manufacture, the Court not only ruled out “upstream” parties who contributed ideas or other creative input that went into the creation of the tangible goods; it also ruled out “downstream” parties (such as distributors and retailers) who took responsibility for packaging, handling, and/or ultimately delivering the tangible goods to the public. Thus, the Court placed greater emphasis on physical manufacture than either creative design activities or, packaging and, distribution activities.

The Court also failed to acknowledge the difficulty of applying its narrow interpretation of “origin” to services and “other commercial activities,” both of which receive the same protections as goods according to sections 43(a)(1)(A) and (a)(1)(B). Services, of course, are inherently intangible. Since there is often nothing physically produced by the party rendering the service, it is difficult to use the Supreme Court’s definition of “origin” to identify the source of the service. Nonetheless, services are expressly encompassed by sections 43(a)(1)(A) and (B). The term “other commercial activities” further suggests Congress’ intent to provide these protections to all forms of commerce. Because Congress used the same term “origin” to refer to the sources of all three forms of commerce, canons of construction require the term “origin” to be given the same meaning in both contexts, absent a clear indication of congressional intent to the contrary.<sup>134</sup> The Supreme Court’s conclusion that the “origin” of goods in section 43(a)(1)(A) refers only to the manufacturer of the *physical* goods is therefore difficult

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<sup>133</sup> *Dastar*, 539 U.S. at 31-32 (footnote omitted).

<sup>134</sup> *In re Estate of Cowart v. Nicklos Drilling Co.*, 505 U.S. 469, 479 (1992).



to reconcile with the statutory language, which recognizes that services and other commercial activities have origins as well. However, *Dastar* does not offer any clues as to what the Supreme Court would consider to be the origin of these other important yet typically intangible types of commerce.<sup>135</sup>

The problem with applying the Court's concept of "origin" in the context of services and other commercial activities is particularly relevant where, as in *Dastar*, the tangible goods in question clearly derive most of their value from their creative content rather than from the physical medium in which that content is embedded. In such a case, the physical manufacturer of the goods may be, from the consumer's perspective, the least significant contributor to the finished product.<sup>136</sup> Consumers purchased the Crusades/Campaigns videotapes for their creative content, not for the physical videotapes themselves; otherwise, they would simply have purchased blank tapes. The creative content of the tapes was actually the result of creative *services* performed by someone. Although, as noted above, the Court failed to acknowledge this, the language of the Lanham Act recognizes that those services have an origin, and that the originator of services is entitled to protection under section 43(a) to the same degree as the originator of goods. In the case of these videotapes, the origin of the services and the origin of the goods are not the same; while *Dastar* may have made a contribution, so, too, did Fox. Does the fixation (in a tangible medium of expression) of the creative content produced by those services cause the services to no longer have an "origin" for purposes of the Lanham Act? It would hardly seem so. The more appropriate question to ask is: Does the Lanham Act impose an affirmative requirement that the origin of those services be disclosed? The Court implicitly held that it did not. Yet, the Court found exactly such an affirmative obligation to disclose the origin of the physical goods.<sup>137</sup> Why was the Court concerned with the goods and not

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<sup>135</sup> It is unfortunate that the Court did not even consider the problem of defining the origin of services. Services, while themselves intangible, may be *physically delivered* by a source that is different from their creative source. For example, a live band typically performs music that was written by others; a radio station always does. Similarly, a carpet cleaning crew typically uses carpet cleaning methods that were developed by persons other than (a) the cleaning crew themselves or (b) the owners or managers who dispatch the crew to the customer's location.

<sup>136</sup> Indeed, while *Dastar* may have edited the tapes, added content, and ultimately made the physical tapes available to the public, *Dastar* may not itself have been the physical manufacturer of these tapes, and thus, under the Court's own interpretation of section 43(a), *Dastar* might not receive Lanham Act protection against someone who deletes *Dastar*'s name and re-sells the tapes.

<sup>137</sup> Such an affirmative obligation is rejected by the RESTATEMENT:

The case law does not recognize an affirmative duty on the part of a seller to

the services that make up the most important part of the goods? Contrary to the Court's suggestion, if a consumer were to be disappointed in the videotaped entertainment he or she had purchased, the consumer would not necessarily hold the maker of the physical videotape responsible. If the consumer disliked the content, he or she would want to hold the creator of the content responsible. In contrast, if the consumer found the videotape to be physically defective, he or she would want to hold the physical manufacturer, wholesaler, or retailer accountable. A similar argument would apply to almost any tangible product that contains significant intellectual property, such as pharmaceuticals, sound recordings, books, motion pictures, and videogames and other software.

The Court attempted to address the relationship between intellectual property and the physical products incorporating that property by drawing an analogy to competing brands of soft drinks, but its analogy was inapposite. Consumers of soft drinks might, the Court noted, care whether the soft drink they purchase was actually manufactured by Coca-Cola rather than Pepsi-Cola; however, they would probably not care who first invented the formula for that drink.<sup>138</sup> Thus, the label should correctly identify the physical manufacturer of the beverage, but need not identify the party responsible for developing the recipe. On that basis, the Court concluded that a soft drink maker should not be held liable for reverse passing off under section 43(a) simply because it fails to list all the parties that contributed to developing the soft drink formula. In other words, the Court determined that the source of the intellectual property underlying the drink would not be important to the consumer, whereas the source of the tangible product itself could be a significant factor in the buying decision. "The words of the Lanham Act," the Court concluded, "should not be stretched to cover matters that are typically of no consequence to purchasers."<sup>139</sup>

The Court appears to have confused itself with a misleading analogy. The Coke/Pepsi analogy fails to recognize that "Pepsi-Cola" and "Coca-Cola" refer not only to different companies but to distinctly *different products* as well.<sup>140</sup> The analogy assumes that section 43(a) *would* protect the consumer's interest in cases where the

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disclose the identity of the manufacturer or producer of goods offered for sale; liability is imposed only on the basis of an express or implied misrepresentation that the goods have been produced by the actor or a third person.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 5, cmt. b, Reporter's Notes (1995).

<sup>138</sup> *Dastar*, 539 U.S. at 32.

<sup>139</sup> *Id.* at 32-33.

<sup>140</sup> This author, for one, can tell the difference between a Coke and a Pepsi.

actual maker of the drink (the Pepsi-Cola company) has not authorized Coca-Cola to relabel Pepsi-Cola's products with the Coca-Cola label, but that section 43(a) would *not* protect the consumer's concern in cases where Coca-Cola's relabeling activity was undertaken with the consent (express or implied) of the actual manufacturer (Pepsi). In other words, the Court would not allow a section 43(a) claim by a soft drink maker that has consented to Coca-Cola's relabeling of its product, because the maker's consent would bar the action, and thus the relabeling would not constitute actionable reverse passing off. Yet the consumer's interest in accurate information about the source of the product is just as significant where the relabeling is authorized as where it is unauthorized. The consumer has no reason to care whether Coca-Cola had permission to relabel another maker's products as its own. As long as the drink sold under the Coca-Cola label has the qualities (flavor, sweetness, fizz factor, caffeine level, absence of tainted or spoiled ingredients) that consumers have come to expect from the product they know as Coca-Cola, they are getting what they have bargained for, even if the drink is physically made by someone else – whether that someone else is Pepsi or Seagram's or some lesser-known drink-maker. If the drink disappoints, the consumer will quite rightly blame Coca-Cola, the downstream labeler who has voluntarily applied its own origin identifier to the Pepsi-made product before offering it to the public. If Coca-Cola were selling a Pepsi product under the Coke label with Pepsi's permission, Pepsi would have no cause of action under section 43(a) because the labeling was authorized by contract. The existence of contractual authorization, however, would have no impact on the consumer, who would have no more information about the product than if the relabeling had been done with Pepsi's consent. Thus, a licensed sale of a third party's product under the Coca-Cola name would be exactly the same, from a consumer's point of view, as an unlicensed sale. Coca-Cola would be ultimately responsible for the quality and characteristics of any product sold under its name, and it would be answerable to the purchaser if the product were unsatisfactory or had significantly different characteristics from the product which Coca-Cola had sold under that same name in past. Coca-Cola would be free to obtain its product from any supplier it chose, but it would bear the risk of disappointing consumers if it failed to maintain the consistency and quality of the product.<sup>141</sup> Thus, in

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<sup>141</sup> It is remotely possible that the Court was led astray by the well-known rivalry and taste difference between Coke and Pepsi. If a consumer bought a drink labeled Coke and

this example, Coca-Cola's goodwill is on the line, not Pepsi's. The consumer views Coca-Cola as the origin of the product, even if Coke was not the real manufacturer. The consumer is not deceived, even if Pepsi did not consent to the relabeling, because the product the consumer received is exactly the product he or she was expecting to receive – it is the product the consumer knows as Coca-Cola.

The Court's confusion about its own Coke/Pepsi analogy is evident if we substitute the name "Drinkmaker X" for the name "Pepsi." If Coca-Cola buys its familiar syrup from Drinkmaker X, adds carbonated water, and puts the combination into Coca-Cola cans and bottles for sale to consumers, then the consumer is getting the exact product that he or she recognizes as Coke. In this case, then, Coca-Cola's failure to identify Drinkmaker X as the physical manufacturer of the drink that it sells in its distinctive Coca-Cola packaging does not cause consumers to be misled, confused, or deceived. Although the Court correctly acknowledged that consumers might not care who invented the Coca-Cola formula, the Court was incorrect in asserting that consumers *would* care whether the syrup was made by Coke or by Drinkmaker X. In fact, most consumers probably *do not know or care* who actually makes the Coca-Cola product that they drink. They know only that Coca-Cola stands behind it, so that if they are disappointed they will be able to hold Coca-Cola accountable.

Thus, section 43(a) does not protect consumers from *licensed* reverse passing off (either implied or express), and consumers have no need of such protection. Whose interests are served, then, by applying section 43(a) to *unlicensed* reverse passing off? Based on the soft drink example, it is probably not the interest of the

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discovered, upon tasting it, that it was in fact a Pepsi, that consumer would certainly feel deceived as well as disappointed (unless he or she actually prefers Pepsi). However, Coke could just as easily have disappointed this consumer by changing its formula so that its drink tasted more like Pepsi. As we all know, Coca-Cola actually did this some years ago, introducing "New Coke" to the great dismay of its loyal customers. However, the marketplace rendered its verdict, and when consumers let Coca-Cola know of their displeasure, Coca-Cola responded by abandoning this experiment. (Decades earlier, when Coke gradually removed the last traces of cocaine from its recipe, there were no howls of protest; apparently no one could tell the difference.) In contrast, if the same consumer bought a drink labeled "Coke," and that drink had been made by Pepsi using the Coke formula, that consumer would not be disappointed, and probably would not feel deceived even after learning the truth about its origin. Thus, the Court's reliance on the Coke/Pepsi example may have led it to assume – wrongly – that reverse passing off of a tangible good would cause a type of injury to consumers that would be absent in the case of reverse passing off of an intangible good. However, if the Court had used the same example but had assumed identical beverages with less famous origin indicators, such as Brand X and Brand Y, it might have seen more clearly that the consumer interest in this situation is not significantly different from the consumer interest in the scenario involving intangible goods.

consumer, who is left equally in the dark, and equally unharmed, in both instances.<sup>142</sup> Rather, it appears to be the interest of the competitor whose product is being relabeled without its consent. That competitor is missing the opportunity to generate goodwill through teaching the customer to associate the positive qualities of the product with the brand name of the party that played the most significant role in producing that product.

It seems disingenuous, therefore, for the Court to suggest that public policy requires us to distinguish reverse passing off of tangible goods from reverse passing off of intangible goods on the ground that consumers have a legitimate interest in knowing the “true source” of tangible goods but lack an interest in knowing the true “source” of intangible goods. Rather, to the extent that public policy concerns play a role in this decision, the decision whether and when to provide a remedy for reverse passing off should not depend on the tangibility of the good, but instead on whether the competitor’s interest in receiving proper “credit” for its contributions is worth protecting. If the interest is worth protecting then it should be protected regardless of the tangibility of the goods that the party produced (just as it should be protected in the case of intangible “services”). If the interest is not worth protecting – because, as is typically the case, the relabeler will have to purchase the maker’s goods or services either in the open market at consumer prices or at the same wholesale price as non-relabeling sellers, thus ensuring that the maker will receive its normal profit margin for each of these sales – then claims of reverse passing off should not be recognized for *any* good or service, regardless of tangibility.<sup>143</sup>

Does the maker of the relabeled goods suffer an injury be-

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<sup>142</sup> This conclusion is bolstered by the fact that courts generally agree that consumers lack standing to sue under section 43(a). See, e.g., *Seven-Up Co. v. Coca-Cola Co.*, 86 F.3d 1379, 1383, 1383n.5 (5th Cir. 1996); see also James S. Wrona, *False Advertising and Consumer Standing under Section 43(a) of the Lanham Act: Broad Consumer Protection Legislation or a Narrow Pro-Competitive Measure?*, 47 RUTGERS L. REV. 1085 (1995) (collecting cases).

<sup>143</sup> A post-*Dastar* case has already applied the *Dastar* analysis to tangible goods, rejecting a reverse passing off claim under section 43(a) where the defendant used, without attribution, a table leg manufactured by the plaintiff as a component of a table, which the defendant showed to prospective customers as a sample of its merchandise. In a well-reasoned opinion, the district court in *Bretford Manufacturing, Inc. v. Smith System Manufacturing Co.*, 286 F. Supp. 2d 969, 971-72 (N.D. Ill. 2003), gave two reasons for rejecting the plaintiff’s claim: First, the sample table was not the actual good offered for sale; it was only a representation of the good that would be sold. Second, the buyer “was not concerned with the source of the component parts.” *Id.* Ironically, *Bretford’s* rationale is a distinct departure from the rationale of the very same pre-1988 “reverse passing off” cases that *Dastar* cited as proof that section 43(a) applies to reverse passing off of tangible goods; in most of the cases on which *Dastar* relied, courts had found liability for reverse passing off under section 43(a) where the defendant merely showed the plaintiff’s goods to potential customers as a *representation* of the defendant’s own goods. See *supra* notes 28-32 and accompanying text.

cause it does not receive proper “credit” from consumers for the quality of its goods? Might this injury cause the maker to lose out on future sales of other goods or services because it has not generated sufficient goodwill to ensure that consumers will take a chance on the new, untested offering? While this is possible, it is doubtful. Even if some relabeling occurs, there is no reason why the maker cannot compete with the relabeler for recognition in the marketplace. Indeed, in most cases, the maker should be the more efficient competitor since the price the relabeler pays the maker for the good will not be less than wholesale, and perhaps closer to retail. It would be highly unusual for the relabeler’s purchase cost to be less than the maker’s manufacturing cost, unless consumers are also able to buy the maker’s product at the same firesale price.

It is, of course, commonplace for a well-known manufacturer to serve as the unnamed source for another manufacturer’s “house brand” of goods. The Kenmore line of appliances, for example, which is sold by Sears Roebuck, is in fact manufactured by at least three name-brand manufacturers – Whirlpool, Amana, and GE – who are also direct competitors of Sears in the appliance market.<sup>144</sup> Sears does not volunteer this information to its customers through any kind of prominent signage in its stores, brochures, or web pages. Rather, it puts its own Sears or Kenmore mark on the merchandise, thus arguably engaging in reverse passing off, albeit with the consent of the manufacturer. Arguably, the consumer is defrauded by this transaction since the consumer who has had a negative experience with Whirlpool, for example, or who wishes to boycott that company for some reason, will not realize that his or her effort to avoid purchasing a Whirlpool product by purchasing Kenmore has failed.

All of these scenarios involve presenting a product to a customer under an omitted or misleading label. Neither one, however, would support a claim of reverse passing off under section 43(a), because the actual maker of the product has either explicitly or implicitly consented to the relabeling, and the consumers themselves generally lack standing to sue under the Lanham Act.<sup>145</sup> Accordingly, the Court’s stated concern for consumers is not a persuasive rationale for its decision to interpret section 43(a) so as

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<sup>144</sup> See *Appliance Aid*, at <http://www.applianceaid.com/searscodes.html> (last visited Apr. 12, 2005).

<sup>145</sup> *Colligan v. Activities Club*, 442 F.2d 686, 692 (2d Cir. 1971) (consumers lack standing to sue under the Lanham Act). See generally Jean Wegman Burns, *Confused Jurisprudence: False Advertising Under the Lanham Act*, 79 B.U. L. REV. 807, 836-39 (1999) (discussing history of the denial of consumer standing).

to encourage omission of source indicators of creative sources while penalizing such omissions in the case of manufacturers.

## VI. THE PREEMPTION SPECTRE AND THE UNCERTAIN SCOPE OF *DASTAR*

Even if *Dastar's* consumer-protection rationale is unpersuasive, the Court did not rely solely on this argument to justify its distinction between reverse passing off of tangible goods and reverse passing off of "communicative products." Though conceding that consumers sometimes do care about the creative origins of expressive goods,<sup>146</sup> the Court held that even in such situations a section 43(a) claim for reverse passing off should be barred, because recognizing such a claim would permit plaintiffs to assert rights analogous to copyright in works not protected by copyright law.<sup>147</sup> Relying largely on the field preemption rationales of *Sears/Compco*<sup>148</sup> and *Bonito Boats*,<sup>149</sup> the Court concluded that such an application of section 43(a) would amount to an impermissible end-run around the Congressionally-determined durational limits of copyright protection:

Assuming for the sake of argument that *Dastar's* representation of itself as the "Producer" of its videos amounted to a representation that it originated the creative work conveyed by the videos, allowing a cause of action under § 43(a) for that representation would create a species of mutant copyright law that limits the public's "federal right to 'copy and to use,' " expired copyrights . . . .<sup>150</sup>

This is indeed a persuasive argument for refusing to recognize a section 43(a) claim that is based *purely* on a failure to attribute the authorship of a once-copyrighted work that has entered the public domain. However, by limiting this part of its reasoning to expired copyrights, the Court left open the question whether section 43(a) applies to reverse passing off of works that are still copyrighted, or to expressive works that were never copyrightable. With

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<sup>146</sup> *Dastar*, 539 U.S. at 33.

<sup>147</sup> *Id.*

<sup>148</sup> *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964); *Compco v. Day-Brite Lighting*, 376 U.S. 234 (1964).

<sup>149</sup> *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

<sup>150</sup> *Dastar*, 539 U.S. at 34 (citations omitted) (citing *Bonito Boats*, 489 U.S. at 165). Durational limits are mandated as well by the Intellectual Property Clause of the Constitution, which allows Congress to grant exclusive rights to authors only for "limited times." U.S. CONST., art. 1, § 8, cl. 8; see *Eldred v. Ashcroft*, 537 U.S. 186, 205 (2003) (holding that Copyright Term Extension Act of 1998 did not exceed Congress' authority under this clause).

respect to works in the former category, recognizing an attribution right under section 43(a) would not run afoul of any clearly manifested congressional intent to deny an attribution right to copyrighted works.<sup>151</sup> Likewise, with respect to expressive works that are not copyrightable (for example, works that are insufficiently original), Congress has not articulated any intent to deny attribution rights to such works.

Although the Court articulated its new, narrower, interpretation of the “origin” of goods in the context of *reverse* passing off claims, it did not indicate whether that same interpretation should apply in the context of *traditional* passing off claims. Based on the Court’s stated rationale – that consumers are not concerned about the creative origins of products – it would appear that the same interpretation must apply. If so, then an author will no longer be able to bring a section 43(a) claim against parties who falsely or misleadingly attribute a work to that author. In other words, as discussed below, in the post-*Dastar* world authors such as Stephen King and John Grisham may have no federal remedy when they find their names attached to movies that are unrelated to anything they have written.

With respect to traditional passing off claims involving copyrightable expressive works, federal courts prior to *Dastar* – including the influential Second Circuit – generally agreed that section

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<sup>151</sup> Since the *Dastar* opinion was issued, several federal courts have already applied its holding to works still under copyright. *Zyla v. Wadsworth*, 360 F.3d 243, 251-52 (1st Cir. 2004) (applying *Dastar* to reject a textbook co-author’s 43(a)(1)(A) claim where her publisher, the assignee of the copyright, dropped her name from a later edition that incorporated some of her revisions to an earlier edition); *Keane v. Fox TV Stations, Inc.*, 297 F. Supp. 2d 921, 935 (S.D. Tex. 2004) (applying *Dastar* to reject 43(a) claim alleging that defendant engaged in reverse passing off by appropriating plaintiff’s idea and title for a talent show called “American Idol”); *Carroll v. Kahn*, No. 03-CV-0656, 2003 U.S. Dist. LEXIS 17902, at \*15-18 (N.D.N.Y. Oct. 9, 2003) (applying *Dastar* to reject 43(a) claim alleging failure to give author/producer screen credit for his work on a film); *Williams v. UMG Recordings, Inc.* 281 F. Supp. 2d 1177, 1183-85 (C.D. Cal. 2003) (applying *Dastar* to reject author’s 43(a) claim, as well as state unfair competition claim, for misattribution of film credits, on the ground that “origin of goods” refers only to tangible goods, not authorship); *MJM Prods. v. Kelley Prods., Inc.*, No. 03-390-JD, 2003 U.S. Dist. LEXIS 16783, at \*9 n.3 (D.N.H. Sept. 24, 2003) (unpublished table decision) (ruling that *Dastar* forecloses Lanham Act claim based on content similarities between film and television series); *Boston Int’l Music, Inc. v. Austin*, No. 02-12148-GAO, 2003 U.S. Dist. LEXIS 16240, at \*4-5 (D. Mass. Sept. 12, 2003) (applying *Dastar* to reject 43(a) claim based on unauthorized copying of plaintiff’s musical composition). One court has also applied *Dastar* to bar a section 43(a) reverse passing off claim for misrepresentation of patent ownership. *digiGAN, Inc., v. iValidate, Inc.*, No. 02 Civ. 420 (RCC), 2004 U.S. Dist. LEXIS 1324, at \*14-15 (S.D.N.Y. Feb. 3, 2004) (holding that a patent is not a “good or service” under the Lanham Act) (also citing *Hans-Jurgen Laube & Oxidwerk HJL AG v. KM Europa Metal AG*, No. 96 Civ. 8147(PKL), 1998 U.S. Dist. LEXIS 3921, at \*4-5 (S.D.N.Y. Mar. 27, 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1574-75 (Fed. Cir. 1996)).



43(a) applied.<sup>152</sup> In *King* and *Gilliam*, the defendant had affirmatively misrepresented the plaintiff's association with an altered version of the plaintiff's copyrighted work. However, the Supreme Court's concern about creating "a species of mutant copyright law" would argue for overturning these decisions, because they permit section 43(a) claims to limit the use of copyrightable works regardless of whether the use in question is permitted by the copyright statutes.<sup>153</sup>

If the Court's holding is intended to apply only to *reverse* passing off of intangibles, then its statement that the "origin" of "goods" refers only to the origin of *physical* goods is overbroad, since this would also limit the application of section 43(a) to claims of traditional passing off – that is, claims against a defendant that offers its goods or services to the public under the plaintiff's name. In other words, if the "origin" of goods is limited to their physical origin, then traditional passing off claims under section 43(a) must also fail in any case where the defendant has falsely attributed authorship of a work to the plaintiff. Since the defendant has not falsely claimed that the plaintiff physically manufactured the goods, only that the plaintiff authored their expressive content, according to the *Dastar* interpretation of section 43(a) the defendant has not made a false or misleading statement about the "origin" of those goods.

Traditional passing off claims for expressive – and copyrightable – works have been recognized under section 43(a) in a series of cases that were completely ignored in *Dastar*. In *Gilliam*,<sup>154</sup> the goods (or, perhaps more accurately, the services) offered by defendant ABC were mutilated performances of the plaintiff's television shows – the result of unauthorized editing for the purpose of inserting commercials. The plaintiff argued that ABC had engaged in passing off, by falsely designating the Monty Python troupe as the source of ABC's mutilated programs, in violation of section

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<sup>152</sup> See, e.g., *Gilliam v. American Broadcasting Co.*, 538 F.2d 14 (2d Cir. 1976); *Stephen King v. Innovation Books, Allied Vision, Ltd., New Line Cinema Corp.*, 976 F.2d 824 (2d Cir. 1992). The federal courts had long held section 43(a) applicable to *reverse* passing off of expressive works as well. See *supra* text and accompanying notes 33-42.

<sup>153</sup> Though section 43(a) claims that allege traditional passing off of copyrighted works would not constitute an end run around the limited term of copyright, they could circumvent other copyright law limitations. For example, while federal courts have exclusive jurisdiction over copyright claims, section 43(a) claims may be brought in either state or federal courts. More fundamentally, the rule that copyright owners have exclusive rights to prevent the unauthorized reproduction, distribution, alteration, or public performance or display of their works, 17 U.S.C. § 106 (2004), would be undercut if authors or other creative contributors could bring section 43(a) claims based on activities that occur after they have relinquished the copyright in their works.

<sup>154</sup> 538 F.2d 14 (2d Cir. 1976).

43(a). The Second Circuit agreed, finding that ABC was the true source of the altered goods, and that ABC had falsely represented the Python troupe as the source.<sup>155</sup>

Under the *Dastar* approach, the Monty Python troupe would have a section 43(a) claim only if it had been wrongly represented as the source of *physical* goods that it did not actually produce. However, the public that was likely to be confused by a false designation of origin never received or experienced any physical goods. Instead, the public received or experienced only the intangible *performance* that resulted from ABC's use of those goods. Alternatively, one could say that the public received or experienced a service – entertainment – that was provided by means of those goods. The essential good or service at issue in that case, therefore, was not a tangible good at all, but an intangible performance of an expressive work.

Understood this way, the decision in *Gilliam* did not hold that ABC misidentified the true source of any *tangible* goods, which the television viewer did not care about or even receive; rather, the court held that ABC misidentified the true source of the intangible performance, which the viewer did care about and did receive.<sup>156</sup> The viewers that found the edited programs disappointing would blame Monty Python as the designated source of the creative content; they would be unlikely to blame the broadcaster (ABC), the manufacturer, or the distributor that merely provided the tangible tapes to the broadcaster. Indeed, the consumers would be equally confused if the tapes had been altered by a third party *without* the broadcaster's knowledge. Thus, if the facts of *Gilliam* arose again today, under the *Dastar* holding, the Monty Python troupe would apparently have no section 43(a) claim against ABC for altering their performance without consent, because they were not falsely represented as the creators of any *tangible* goods.

Similarly, in *King*,<sup>157</sup> the Second Circuit found that the defen-

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<sup>155</sup> Because the plaintiffs had also retained the copyright in their work, and the right to object to alterations, the Second Circuit also held that the unauthorized editing infringed their copyright – specifically, the exclusive right to create derivative works under 17 U.S.C. § 106(2).

<sup>156</sup> Of course, even if ABC had identified itself as a source of the Python troupe's mutilated performance, that would not have eliminated the false designation of origin problem. Omitting the Python troupe's names entirely would have implied that ABC was the sole creator of the work, which would have been equally false, and possibly actionable as reverse passing off under state law or the pre-1988 version of section 43(a). Even a disclaimer, as the *Gilliam* majority noted, would not have solved the problem entirely, because it would not help the consumer to distinguish the troupe's contributions from ABC's contributions. See *Gilliam*, 538 F.2d at 25 n.13.

<sup>157</sup> 976 F.2d 824 (2d Cir. 1992).

dant had falsely designated Stephen King as the source of a film, which was promoted as *Stephen King's Lawnmower Man*, even though the public did not receive or experience this film as a tangible good. The public experienced only the intangible performance, which may be viewed as either a service or an intangible "good." Even customers who rented or purchased a tangible copy of the film (like a videotape or DVD) would not be misled by this false possessory credit into thinking that Stephen King was the manufacturer of the physical object they acquired. Instead, the false credit would mislead them into thinking that he was a creative contributor to the intangible motion picture. In other words, they would blame King if the movie were bad, but not if the tape broke or the DVD had a scratch. Thus, the false indication of King as the source of this film would confuse consumers as to the origin of the most important aspect of this product – the content of the motion picture itself.

Post-*Dastar*, however, King would apparently no longer have a passing off claim under section 43(a), because the defendant, Innovation Books, did not falsely represent King as the source of any tangible goods. The *Dastar* Court indicated that the consumer would not care who originated the intangible creative content of the *Crusades* episodes; they would only care who originated the tangible goods. However, the consumer who is considering buying or renting *Lawnmower Man* might care very much whether Stephen King was involved in making the film. The consumer would care about this question as much as, if not more than, the question of who physically manufactured the video or DVD. Thus, the *Dastar* analysis as applied to *King* is unpersuasive. Yet, if the "origin" of "goods" has the narrow meaning ascribed to it in *Dastar*, then federal law does not protect the consumer from films falsely claiming to be the work of Stephen King.<sup>158</sup>

Suppose that a different film company makes a competing, and better, version of *Lawnmower Man*, and receives the express endorsement of Stephen King because their film is more faithful to his original short story. Does the Lanham Act offer no protection

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<sup>158</sup> In a recent variation on the problem of artistic passing off as illustrated by *Gilliam* and *King*, film directors raised section 43(a) claims against companies that engage in unauthorized editing and distribution of their films, or which distribute software that enables home viewers to automatically edit out objectionable material from the DVD versions of those films. To the extent that this lawsuit survives enactment of the Family Entertainment and Copyright Act of 2005, S. 167, one commentator notes that *Dastar* could present an obstacle to those claims. Gail H. Cline, *On a ClearPlay, You Can See Whatever: Copyright and Trademark Issues Arising From Unauthorized Film Editing*, 27 *Hastings Comm. & Ent. L.J. (Comm/Ent)* 567 (2005).

to consumers perusing the DVD rack at their local rental store, trying to figure out which version is which? Suppose that the unendorsed version is titled *Stephen King's Lawnmower Man*. How will the consumer know that Stephen King did not endorse this version? If, as *Dastar* holds, the "origin" of "goods" refers only to tangible goods, then section 43(a) does not prevent this false endorsement. Even under the narrowest possible interpretation of *Dastar* – under which section 43(a) is inapplicable to expired copyrights – if the two competing films in this example were in the public domain, the Lanham Act would fail to protect the consumer against confusion arising from an affirmatively false representation about the origin of each public domain work.

There is one key difference between the *Gilliam* and *King* scenarios. The plaintiffs in the *Gilliam* scenario would still have a copyright claim even if their 43(a) claim was rejected under *Dastar*. Because the plaintiffs retained significant rights under their licensing agreement, the defendant's alteration of their work involved unauthorized adaptation under section 106(2) of the Copyright Act. In contrast, in the *King* scenario, if the plaintiff were deprived of his section 43(a) claim, he would have no copyright claim to fall back on because the defendant had a license to copy, adapt, distribute, and publicly perform the plaintiff's work.

Ironically, both in traditional passing off scenarios such as *Gilliam* and *King*, and in reverse passing off scenarios such as *Smith v. Montoro, F.E.L. Publications*, or *Dastar* itself, a plaintiff might be able to proceed with a claim under state unfair competition laws, which are almost identical to the Lanham Act, because *Dastar's* narrow definition of "origin" in section 43(a) has no binding effect on the interpretation of state laws.<sup>159</sup> *Dastar* did not hold that copyright law preempts a section 43(a) claim pertaining to intangibles. Rather, the Court held that when Congress enacted and revised the Lanham Act it could not have *intended* to allow the overlap that would result from applying section 43(a) to works of authorship. This conclusion pertains to the intent of Congress in enacting and amending section 43(a), not its intent in enacting the federal copyright laws. Thus, the *Dastar* decision does not bar state or federal

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<sup>159</sup> In California, however, where state unfair competition law is closely modeled on section 43(a), two district court decisions have applied the Supreme Court's reasoning in *Dastar* to reject reverse passing off claims based on authorship misattribution. *Twentieth Century Fox Film v. Dastar Corp.*, No. CV98-07189FMC(EX), 2003 WL 22669587, at \*3-5 (C.D. Cal. Oct. 14, 2003) (on remand from Supreme Court, rejecting state unfair competition claim arising from same facts); *Williams v. UMG Recordings, Inc.* 281 F. Supp. 2d 1177, 1183-85 (C.D. Cal. 2003) (applying *Dastar* to reject state unfair competition claim for misattribution of film credits).

courts from interpreting state unfair competition laws broadly enough to encompass misattribution of copyrighted or copyrightable works.

*Dastar* did not address whether federal copyright law would preempt a state law claim of reverse passing off of creative works. Therefore, it is not clear whether preemption doctrine precludes the creators of copyrightable material from bringing claims under state unfair competition laws when the “origin of goods” test articulated in *Dastar* has foreclosed their section 43(a) claim.<sup>160</sup> The Supreme Court’s concern with allowing unfair competition doctrine to prolong an author’s monopoly even after the expiration of copyright echoes the Court’s concern in prior cases in which it held that federal law preempted enforcement of state unfair competition laws when such enforcement would override the limitations which Congress has imposed on the federal patent and copyright monopolies:

An unpatentable article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so . . . “Sharing in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested.” To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public something which federal law has said belongs to the public. The result would be that while federal law grants only 14 or 17 years’ protection to genuine inventions, States could allow perpetual protection to articles too lacking in novelty to merit any patent at all under federal constitutional standards. This would be too great an encroachment on the federal patent system to be tolerated.<sup>161</sup>

Furthermore, although *Dastar* did not involve a question of federal/state preemption, the opinion expressly relies on the

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<sup>160</sup> The Supreme Court has on several occasions held that state unfair competition remedies were preempted by federal copyright or patent statutes. *See, e.g.,* *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232-33 (1964) (holding that federal patent law prevented state from enjoining, or awarding damages for, the copying of an unpatented and uncopyrighted lamp design, even though the copying could lead to consumer confusion as to source); *see also* *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237-38 (1964); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (holding that state law prohibiting use of a particular process for copying boat hull designs was preempted by federal patent and copyright laws).

<sup>161</sup> *Sears, Roebuck & Co.*, 376 U.S. at 231-32 (quoting *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 122 (1938)) (additional citation omitted).

Court's preemption jurisprudence to support the conclusion that Congress could not have intended section 43(a) to provide a remedy for reverse passing off of public domain works.<sup>162</sup> This suggests that the preemption defense may be highly effective for defendants accused of reverse passing off of public domain works under state unfair competition laws.<sup>163</sup>

### CONCLUSION

When the *Dastar* Court adopted its narrow reading of the term "origin" in section 43(a), it failed to distinguish between omitted or incomplete attributions and affirmatively false or misleading attributions. Instead, it accepted both types of "reverse passing off" as cognizable under section 43(a), but only with respect to tangible goods. Moreover, the Court found this cause of action to be cognizable specifically under subsection (a)(1)(A), rather than the false advertising provisions of subsection (a)(1)(B).<sup>164</sup> With no explanation, the Court simply ignored the fact that subsection (a)(1)(A) speaks only to a defendant's misleading designations of origin with respect to "his or her" goods. It noted that the 1988 TLRA amendments "made clear that § 43(a) covers origin of production as well as geographic origin" and that it is "amply inclusive, moreover, of reverse passing off,"<sup>165</sup> without analyzing whether these conclu-

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<sup>162</sup> *Dastar*, 539 U.S. at 33-34 (citing *Sears, Kellogg, and Bonito Boats*).

<sup>163</sup> However, it also begs the question of which public domain works would support a preemption defense. The case for preemption under *Dastar* is strongest in the case of formerly copyrighted works that have entered the public domain. But would the defense also be available in the case of works that have never been copyrightable in the first place? It is quite probable that the Court would reject the preemption doctrine in the case of some uncopyrightable works, on the theory that where Congress has chosen not to legislate at all with regard to those works, Congress intended to leave the question of their protection to the states. See, e.g., *Goldstein v. California*, 412 U.S. 546 (1973) (holding that federal copyright law did not preempt state law prohibiting copying of sound recordings prior to 1972, because federal copyright laws did not extend to sound recordings during those years). However, there are other classes of works, which Congress intended to place in the public domain, such as works created by federal employees acting within the scope of their employment. The Court would almost certainly hold that a state law claim of reverse passing off of such works would be preempted. Other works, falling between these extremes, would present more difficult questions – databases, for example.

<sup>164</sup> The Court stated that resolution of the case required it to "decide what § 43(a)(1)(A) of the Lanham Act means by the 'origin' of 'goods.'" 539 U.S. at 31. It added that if a party who made a video

that substantially copied the Crusade series were, in advertising or promotion, to give purchasers the impression that the video was quite different from that series, then one or more of the respondents might have a cause of action—not for reverse passing off under the 'confusion . . . as to the origin' provision of § 43(a)(1)(A), but for misrepresentation under the 'misrepresents the nature, characteristics [or] qualities' provision of § 43(a)(1)(B).

*Id.* at 38.

<sup>165</sup> *Dastar*, 539 U.S. at 30.

sions, if correct, should apply to both parts of section 43(a)(1) or merely to the false advertising provisions.

Once the Court had accepted the questionable premise that section 43(a)(1)(A) applies to claims of reverse passing off that are based on incomplete designations of origin, in order to justify its conclusion that expressive works such as Fox's television series were not entitled to this protection, the Court found itself compelled to undertake a tortured and ultimately unpersuasive analysis to distinguish the protections available to producers of tangible works from those available to producers of expressive works.

In addition, when the Court strayed down this path, its reasoning cast doubt on some previously uncontroversial precedents that had given authors a remedy for traditional passing off. It also conflicted with repeated indications of congressional intent regarding the use of section 43(a) to comply with the United States' obligations under the Berne Convention. Had the Court simply drawn a distinction between false attributions and omitted or incomplete attributions, the first of these troubling ramifications could easily have been avoided,<sup>166</sup> and the second would have been significantly mitigated.

Thus, section 43(a) in its current form need not be read to encompass all claims of reverse passing off, even those involving tangible goods which the *Dastar* Court so casually endorsed. If section 43(a) includes reverse passing off at all, it should encompass only affirmatively false or misleading attributions, while disallowing claims for merely incomplete or omitted attributions. Such an in-

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<sup>166</sup> There is no such thing as a traditional passing off claim for omitting an origin identifier. Traditional passing off *always* involves an affirmatively false or misleading indication of origin. There are occasions, however, where an origin indicator might be partially accurate but also partially misleading. This is true in both the *Gilliam* and *King* cases, where to some degree the work originated with the attributed source, but the attribution overstates the extent of the source's creative involvement. These were not cases of omitted or incomplete attribution, however; they were cases of affirmatively misleading (though not completely false) attributions. Thus, the "Stephen King's Lawnmower Man" attribution was misleading because it overstated King's involvement, not because it omitted the identities of other creative participants. See *King*, 976 F.2d at 829. In contrast, the "based upon" credit, which indicated that the film was based on a story by Stephen King, was accurate and not misleading, because it did not overstate King's role in making the film. *Id.* at 829-31. The actionable aspect of the misleading possessive credit could have been eliminated (as, indeed, the court's injunction ordered) simply by removing the possessory credit entirely, leaving only the far more accurate "based upon" credit; the likelihood of confusion could thereby be eliminated without imposing any affirmative obligation on the part of the film's producer or distributor to identify the other parties who contributed to the creative aspects of the film. Thus, in the case of traditional passing off, there is no need to distinguish omitted or incomplete attributions; all false or misleading attributions are affirmative in nature, and should therefore be cognizable under section 43(a) based on the approach proposed in this Article. In other words, the distinction proposed here for reverse passing off claims already exists in the case law for traditional passing off claims; unfortunately, *Dastar's* narrow interpretation of section 43(a) threatens to overturn this settled doctrine.

terpretation of section 43(a) would obviate any need for the unpersuasive distinction that the Supreme Court attempted to draw between tangible and intangible goods, and the resulting uncertainty regarding services and other commercial activities. It would preserve the right of authors with strong name recognition to protect their valuable trademarks against unscrupulous marketers who might falsely attach these authors' names to inferior expressive works. At the same time, however, it would accomplish the result intended by the *Dastar* Court, freeing users of public domain works from any obligation to provide the public with detailed pedigrees for those works.