

DR. LIVINGSTON, I PRESUME?

By: Jim Astrachan

"We do not think the Lanham Act requires this search for the source of the Nile and all its tributaries." Last month with these words, the United States Supreme Court throttled the attribution rights of authors ruling that the unfair competition provisions of the Lanham Act are not violated when an unlicensed copy of a public domain work fails to credit its author. The decision was morally wrong and only modestly supported.

The Court wrote it is too difficult to ferret out the identity of an author. I can't imagine difficulty as a bar to attribution. And the Court's search for the source of the Nile analogy conjured up for me vivid images of the Court on safari without a guide, chopping circular paths through dense jungle with dull machetes.

Soon after World War II, General Dwight Eisenhower wrote *Crusade in Europe*. *Crusade* was then turned into a television series by Twentieth Century Fox Film and Time, Inc., broadcast for the first time in 1949. While the underlying written work remained subject to copyright due to copyright renewal, Fox failed to renew the copyright to the TV series and the series passed into the public domain.

Anticipating public interest on the 50th anniversary of the end of the War, a company named Dastar released a video called *World War II Campaigns in Europe*. In making the *World War II Campaigns* series, Dastar bought copies of the original *Crusades* TV tapes, then in the public domain, copied them, and edited them to about half the length of the original. A modicum of new material was added. *World War II Campaigns in Europe* was aggressively sold in new packaging created by Dastar and without any reference to the *Crusade* series, its producers or authors.

Fox and others sued Dastar for copyright infringement of Eisenhower's book and its exclusive television rights in the book, which Fox acquired from the publisher. The copyright claim became mired in the technicalities of whether the publisher's copyright in the book was properly renewed, and was remanded to the trial court before it might have reached the Supreme Court. As an afterthought to its suit, Fox amended its complaint claiming that Dastar's video series violated § 43(a) of the Lanham Act because selling copies of Fox's TV series without properly crediting the creators of the original series was reverse passing off. Finding that the public is likely to be confused or deceived by these acts, the District Court awarded profits to Fox and then doubled them to discourage other acts of infringement. The Ninth Circuit Court of Appeals affirmed, holding that Dastar's "bodily appropriations of Fox's original [television] series is sufficient to establish the reverse palming off."

What does the Ninth Circuit know, anyway? Not too much, wrote a Supreme Court which according to Chicago law professor Cass Sunstein has struck down more federal legislation at a higher annual rate than any other Supreme Court in the last fifty years.

The gravaman of Fox's claim was that Dastar, in marketing and selling Fox's film as its own product without acknowledging it was merely a copy of *Crusades*, had made a false designation of origin, a false or misleading description of fact or a false or misleading representation of fact. In other words, any person reading the packaging or credits and viewing the tapes would believe that only Dastar was responsible for their creation.

Considering the false designation of origin claim, the Court opened its dictionary to define "origin" and concluded that as used in the Lanham Act, the phrase "origin of goods" could never possibly connote the person or entity that created the ideas or communications that goods embody or contain. Instead, origin means the producer of the products.

And that's the rub. Works of authorship are different from lawn mowers and food processors. Consumers buy appliances without regard to the identity of the engineer who designed them. The buy decision is different for authors and writings. Do consumers who follow Tom Clancey care about the identity of his publisher? Not likely.

What appears to have distressed the Court was the perceived overlap of copyright law by the Lanham Act if the decision was to have been affirmed. The Court sought a rule to effect that once the copyright to a work expires, there should be no impediment whatsoever to allowing public access to that work. Requiring attribution

of the original author, director or producer creates such an impediment, the Court concluded.

Why not balance the rights of authors and the public? Why not use the Lanham Act to provide the attribution an author demands and the public is entitled to? Why allow a subsequent author to trade on the value of an earlier work without acknowledgement? Why should consumers not know the "origin" of the work?

Doing so, the Court ruled, would create "serious practical problems" because "figuring out who is in the line of origin would be no simple task." Is compliance with healthcare privacy, or environmental laws a simple task? The Court also ruled that crediting authors might imply sponsorship or endorsement creating additional litigation. I have a hard time with this reasoning.

Agree or disagree, it makes no difference. The case is decided. Now its time for Congress to amend the Lanham Act to require attribution of authors for works that are in the public domain. It's nothing less than truth in labeling, but I concede an amendment will require some thought on how far back attribution must apply. Homer, Shakespeare, Twain, Eisenhower? I don't see this as particularly burdensome and it does balance the rights of parties.

Finally, on another matter, I wrote several months ago that the Supreme Court was likely to leave alone the decision of the California Supreme Court in *Kasky v. Nike*, a case where Nike was found to have engaged in unfair trade practices following its

rebuttal PR campaign relating to working conditions exposed in the media. Last week, the Court declared the case not ripe for determination and sent it back to California.

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