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From the Selected Works of Graeme B. Dinwoodie

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1. What is the notion of a “work of art” in the relevant country?

The U.S. Copyright Act identifies potential copyright subject matter in very broad terms: the statute protects “original works of authorship fixed in any tangible medium of expression, now known or later developed from which they can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device.” 17 U.S.C. § 102(a). Initially, therefore, the scope of subject matter is defined by the concepts of originality and fixation, rather than by inclusion within classifications such as “work of art.” The standard of originality requires only that the work be independently created and possess a minimal degree of creativity. *See Feist Publications Inc. v. Rural Tel. Service*, 499 U.S. 340 (1991).*

The current statute does, however, provide that “works of authorship include [several] categories [of work]” and these include “pictorial, graphic and sculptural works.” 17 U.S.C. § 102(a)(5). This term is in turn defined expansively as including “two-dimensional and three-dimensional works of fine, graphic and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.” 17 U.S.C. § 101. The definition also provides that the concept of pictorial, graphic and sculptural works includes “works of artistic craftsmanship” and the “design of useful articles”, although these categories are subject to limitations discussed below. Indeed, because the listing of categories of works is illustrative in nature, the most important part of the definition is not the affirmative definition of what is a “work of art” (or, more strictly, a “pictorial, graphic or sculptural work”), but rather the limitations that are imposed upon certain sub-categories of works of art (such as the design of useful articles). These limitations are discussed below in response to Question 2.

*Although earlier U.S. copyright statutes did attach greater significance to categories of work, U.S. courts were even then sometimes reluctant to find restrictions in protection as a result of an assessment of the “artistic” nature of the work in question. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) (discussing the 1874 act). *But see Bailie v. Fisher*, 258 F.2d 425, 426 (D.C. Cir. 1958) (cardboard star with a circular center bearing the photograph of an entertainer not a “work of art” within scope of Copyright Act because not within “the historical and ordinary conception of the term art”) (citations omitted).

Although courts routinely forswear any effort to answer the question of what is a “work of art,” some judges have candidly acknowledged that aspects of the statutory language regarding pictorial, graphic and sculptural works inevitably require them to consider the artistic nature of a work. *See, e.g., Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 423 (2d Cir. 1985) (Newman, J., dissenting) (“In endeavoring to draw the line between the design of an aesthetically pleasing useful article, which is not copyrightable, and the copyrightable design of a useful article that engenders a concept separate from the concept of its utilitarian function, courts will inevitably be drawn into some minimal inquiry as to the nature of art”).

2a. Does the country follow a “unity of art” approach, or does the copyright law exclude or limit protection for certain categories of work?

In principle, a work’s usefulness – whether that utility is commercial (*see Bleistein, supra*) or mechanical (*see Mazer v. Stein*, 347 U.S. 201 (1954)) – should not prevent the protection of that work by copyright. *See* 17 U.S.C. § 113(a) (providing that “the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies . . . includes the right to reproduce the work in or on any kind of article, whether useful or otherwise”). In *Mazer*, the United States Supreme Court, interpreting an earlier statute, upheld copyright protection for the design of lamps in the form of Balinese dancers. Section 113(a) of the current statute restates the basic holding of *Mazer*. *See* H.R. Rep. No. 1476, 94th Cong. 2d Sess. 105 (1976).

In practice, the utilitarian nature of a work may however affect its susceptibility to copyright protection. Such works might more easily fall afoul of generally-applicable limitation in the copyright statute, such as the exclusion of ideas. *See Baker v. Selden*, 101 U.S. 99 (1879); 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work”); *Lotus Dev. Int’l Corp. v. Borland Int’l Inc.*, 49 F.3d 807 (1st Cir. 1995), *aff’d by an equally divided court*, 516 U.S. 233 (1996). In contemporary case law, computer software is perhaps the category of work most vulnerable to these generally applicable limitations. *See Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 704 (2d Cir. 1992) (“compared to aesthetic works, computer programs hover even more closely to the elusive boundary line [between idea and expression]”). And the utilitarian nature of a work may affect analysis of originality (or creativity). *Cf.* 1 M. Nimmer and D. Nimmer, *Nimmer on Copyright* § 2.01[B] (1995) (“Illustrative of the requirement of minimal creativity are those cases which deny copyright protection to . . . forms of expression dictated solely by functional considerations”).

Moreover, as noted above, the current copyright statute contains specific limitations imposed on the protection available to “works of artistic craftsmanship” and the “design of useful articles.” Section 101 of the Copyright Act provides that the “design of a useful article . . . shall be considered a pictorial, graphic and sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic and sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” (In a somewhat similar vein, the same section of the copyright statute provides that works of artistic craftsmanship shall be treated as pictorial, graphic or sculptural works “insofar as their form but not their mechanical or utilitarian aspects are concerned.”)

The case law interpreting this provision has bordered on the incomprehensible. As interpreted by the majority of courts, however, this provision greatly restricts copyright protection for artistic designs embodied in useful articles. To be sure, some courts have offered copyright protection to the designs of useful articles that have passed this so-called “separability” test. *See, e.g., Keiselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) (protecting the design of an ornate belt-buckle). But the prevailing approach is likely to exclude protection for designs that integrate form and function. *See, e.g., Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985) (denying protection to the design of four human mannequins because their design features were not “wholly unnecessary” to performance of the utilitarian function of the articles); *Brandir Int’l Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) (denying protection to the design of a bicycle rack because the ultimate design was influenced by functional considerations). Indeed, the legislative history to this provision suggests that it was specifically intended to draw a line between works of applied art (such as those lamp designs recognized in *Mazer* as the proper subjects of copyright protection) and works of industrial design (which were not to be afforded copyright protection). *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976).

One preliminary issue that affects the practical effect of the separability provision is the definition of “useful article.” *See infra* page 12 (discussing the different treatment of costumes and masks). It is only designs of such articles that must pass the separability test to receive copyright protection. Otherwise, originality and fixation are sufficient to warrant copyright protection. The statute defines “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” 17 U.S.C. § 101.

2b. Is there a difference in law or practice between the protection offered different categories of work? (We are most interested in whether copyright protection for the design of useful or consumer articles is limited and how.)

As a general matter, most categories of work obtain the same protection by copyright law. Even in theory, however, the statute occasionally makes specific provision for one category of work that affects the scope of protection vis-a-vis other categories of work.

And other more facially neutral provisions clearly effect different protection for different types of work. For example, the interpretation of the separability requirement discussed above gives rise to differences between works of applied art and integrated design.

3. What is the relationship between copyright and design right? Is cumulative protection available? Which criteria apply to determine whether cumulation is permitted?

Numerous efforts to enact a broad-based system of design protection in the United States have each failed, the closest effort being found in Title II of what became the Copyright Revision Act of 1976. Outside the copyright regime (and the trademark regime discussed below), certain designs may, however, be protected through a variety of different systems. Ornamental designs may be protected under a form of patent granted by the U.S. Patent and Trademark Office upon application and full examination. *See* 35 U.S.C. § 171. (This patent-based system has proved largely ineffective.) The design of semiconductor chips receive a short *sui generis* form of protection. *See* 17 U.S.C. §§ 901-910. And, most recently, the designs of boat hulls were the beneficiaries of experimental design right protection enacted by the Vessel Hull Design Protection Act (Title V of the Digital Millennium Copyright Act 1998).

Until recently, the Copyright Office practice was to deny copyright registration claimed in a “patented design or in the drawings or photographs in a patent application . . . after the patent has issued.” 37 C.F.R. § 202.10(a) (1991). In essence, the Copyright Office sought to impose an election upon the author of the design. This has now changed, and an election is not imposed. The courts adopted a more generous view earlier, and have long permitted cumulation of design patent and copyright. *See In re Yardley*, 493 F.2d 1389, 1394 (C.C.P.A.1974) (“Congress has not provided that an author-inventor must elect between securing a copyright or securing a design patent,” and allowing cumulation). The recently-enacted Vessel Hull Design Protection Act permitted cumulation of design right and other rights (except design patent). *See* 17 U.S.C. §§ 1329-30 (1998).

4a. Does trademark or unfair competition law protect visual images or the design of three dimensional articles?

The Supreme Court has held that anything that is capable of “carrying meaning” may potentially be trademark subject matter. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995). As a result, trademark and unfair competition law does protect both visual images and the design of three dimensional articles, provided that they satisfy the general prerequisites for such protection (principally, distinctiveness and use in commerce). *See e.g.*, Restatement (Third) of Unfair Competition § 9, comment g (1995); *see also* *Traffix Devices, Inc. v. Marketing Displays*, 69 U.S.L.W. 4172, 4173 (March 20, 2001). Distinctiveness requires that the matter claimed as a trademark serve to identify a product and distinguish it from others. *See* 15 U.S.C. § 1127.

Such images or designs may be registered with the Patent and Trademark Office, and thus protected against confusing imitation under Section 32 of the Lanham Act, or may receive similar protection without registration under the unfair competition provisions found in Section 43(a) of the Lanham Act. For example, in recent years, trademark and unfair competition law has protected the design of furniture, kitchen and other household equipment (such as food mixers, weighing scales, water faucets, or lamps), sporting equipment (such as golf clubs), fashion accessories (such as handbags), household ornaments, clothing, stationery items, the covers of guidebooks, and classic sports cars.

Determining whether design features are distinctive under trademark law has proven problematic for the U.S. courts. After the Supreme Court decision in *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763 (1992) appeared to assimilate trade dress protection with more traditional forms of trademark protection (and, in particular, held that trade dress could be protected as inherently distinctive), some courts sought to apply the standard test of distinctiveness – is the word arbitrary, suggestive, descriptive, or generic, when used in connection with the goods in question – to designs. This proved difficult for a variety of reasons, and thus other courts developed alternative tests focusing on whether the design was unique or unusual and whether it was likely to be perceived by consumers as a source-identifier rather than an ornamental or functional feature. *See, e.g.*, *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3d Cir.1994); *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996 (2d Cir.1995); *see also Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977). With the decision of the Supreme Court in *Wal-Mart Stores Inc. v. Samara Brothers Inc.*, 529 U.S. 505 (2000), requiring design to possess secondary meaning to receive protection, this question has become less complex. (Packaging trade dress and other non-design marks, other than color per se, may be protectable as inherently distinctive.) Secondary meaning for trade dress is shown in the same way as secondary meaning is demonstrated generally, namely through various indicia of actual consumer association. Importantly, however, neither originality nor creativity is essential to prove distinctiveness. *See Banff Ltd. v. The Limited, Inc.*, 869 F. Supp. 1103, 1116 (S.D.N.Y. 1994). On the other hand, nor is originality or creativity sufficient to receive trademark protection. Finally, trademark protection is available in the United States without registration.

4b. If so, does trademark law exclude such protection in certain cases? If so, what are the grounds for the exclusion? To what extent does this exclusion differ from the exclusion, if any, from copyright protection?

Trademark law excludes from protection designs that are “functional.” *See* Restatement (Third) of Unfair Competition § 17 (1995). Such designs will also be denied registration by the Trademark Office. *See* 15 U.S.C. § 1052(e)(5). In an infringement action under Section 32 (i.e., where the design is registered as a trademark), the burden to prove functionality rests upon the defendant; in an action for infringement of an unregistered design mark (under Section 43), the plaintiff must prove nonfunctionality. *See* 15 U.S.C. § 1125(a)(3) (1999 Supp.)

The lower courts have in the past few years applied a myriad of doctrinal tests to determine whether a design is functional and hence unprotectable. The United States Supreme Court has, however, recently confirmed that “in general terms, a product feature is functional . . . if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Traffix Devices*, 69 U.S.L.W. at 4174 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)). This test, first announced by the Court in dicta in *Inwood Laboratories, Inc. v. Ives Laboratories Inc.*, 456 U.S. 844, 850 n.10 (1982), had previously been endorsed by the Court in *Qualitex* in 1995, but this did not arrest the development and application of a wide array of doctrinal tests by lower courts. It remains to be seen whether the *Traffix Devices* opinion will operate as a greater restraint on judicial creativity.

To be sure, the *Traffix Devices* Court placed its imprimatur upon one of the several elaborations on the *Inwood* test found in its *Qualitex* opinion. See *Traffix Devices*, 69 U.S.L.W. at 4174 (“Expanding upon the meaning of this phrase, we have observed that a functional feature is one ‘the exclusive use of [which] would put competitors at a significant non-reputation related disadvantage’”(quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)). But the Court stressed that this “expansion” of the *Inwood* test articulated in *Qualitex* was not a comprehensive definition of functionality. If a design feature is essential to the use or purpose of the article in question or affects the cost or quality of the article (the *Inwood* test), then the design feature is functional without further analysis of competitive necessity. See *Traffix Devices*, 69 U.S.L.W. at 4174-75. Thus, for example, the Supreme Court in *Traffix Devices* regarded the dual-spring design of a road stand as functional because that design “provides a unique and useful mechanism to resist the force of wind.” *Id.* at 4175; see also *id.* at 1474 (noting that the design for which trade dress protection was sought “serves the important purpose of keeping the sign upright even in heavy wind conditions . . . , [does so] in a unique and useful manner” and “achieves important operational advantages” by preventing twisting of the sign, and “affects the cost or quality” of the sign because use of an additional spring in the design would increase the cost); *id.* at 1475 (“the dual-spring design . . . is the reason the device works”).

The *Traffix Devices* Court appeared to regard the expansion of *Inwood* articulated in *Qualitex* – whether the feature is one “the exclusive use of [which] would put competitors at a significant non-reputation related disadvantage” – as targeted at what the U.S. courts call “aesthetic functionality.” This historically confusing doctrine excludes from trademark protection designs which, though aesthetic rather than utilitarian, are essential for rivals to imitate in order to compete. For example, the Court of Appeals for the Second Circuit in *Wallace International Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76 (2d Cir. 1990) concluded that the ornamentation on baroque silverware was aesthetically functional because, although not essential to the use or purpose of the silverware, that ornamental design was essential to any rival seeking to compete in the market for baroque silverware.

While the *Traffix Devices* opinion remains somewhat enigmatic, under one reading, the Court might be instructing courts to assess claims of functionality based upon mechanical utility primarily under the above-quoted *Inwood* test (which might be called a test of “mechanical necessity”), and only claims of aesthetic functionality under a test of competitive necessity.

If this were the case, it would require many lower courts to revise current forms of analysis. For many courts, competitive necessity serves as a guide to most issues of functionality (whether mechanical or aesthetic); the Court rejected that standard as a comprehensive measure of functionality. Similarly, most lower courts have given some weight, in assessing functionality, to the availability of alternative designs that might serve the same purpose as the article in question. Yet, the *Traffix Devices* Court found that there was no need to have regard to alternative design possibilities if the *Inwood* test was met. *See Traffix Devices*, 69 U.S.L.W. at 4175.

Although the Court has rejected the lack of alternatives or competitive necessity as necessary components of a court’s analysis (or of a defendant’s case), it is likely that lower courts will continue to have regard to both these questions. Each will be helpful in determining whether a design feature is “essential to the use or purpose of the article or affects its cost or quality” or is one “the exclusive use of [which] would put competitors at a significant non-reputation related disadvantage.” What is “essential” and what puts competitors at “non-reputation related disadvantages” will not be easy to answer absent such subsidiary analyses of alternative designs and competitive conditions.

Given the current confusion in the trademark functionality doctrine thus described, it is difficult to compare that doctrine with similar exclusions in copyright law. The principal exclusions in copyright law with which it might be compared are: the non-protection of ideas; the separability exclusion applied to the design of useful articles; and the suggestion that copyright will not protect designs that are dictated by the function of the article upon which they appear. *See Responses to Questions 1-2; see also Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851, 854-55 (6th Cir. 1991) (copyright protection not available for “form of expression dictated solely by functional considerations”); *Magic Marketing, Inc. v. Mailing Servs. of Pittsburgh, Inc.*, 634 F. Supp. 769, 771 (W.D. Pa. 1986) (forms of expression dictated solely by functional considerations do not exhibit minimal level of creativity necessary to warrant copyright protection); *Computer Associates Int’l Inc. v. Altai, Inc.*, 982 F.2d 693, 707-10 (2d Cir. 1992) (excluding from copyright protection elements of a computer program dictated by efficiency or external factors such as the demands of the computer a program is run). In analyzing these three exclusions, we might conduct the comparison in terms of the purpose of the respective exclusions, the language of the respective tests, the practical effect of the exclusions, or the evidence relevant to establishing the exclusions.

The exclusions from copyright of designs dictated by function (whether in principle or practice) corresponds closely to a version of the trademark functionality exclusion

formerly applied by some lower courts, *see e.g.*, *Warner Bros. v. Gay Toys, Inc.*, 724 F.2d 327, 331 (2d Cir. 1983) (test of trademark functionality is whether the feature is dictated by the functions to be performed), and perhaps not unlike the “essential to the use or purpose of the article” standard now endorsed by the *Traffix* court. In both the trademark and copyright exclusions, the key analytical question is whether a design feature is “essential” or “dictated” simply because the particular article would not function without it or, alternatively, is a feature “dictated” or “essential” because no other design can replace it? *Cf. Brandir Int’l Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1148 (2d Cir. 1987) (relevant question for trademark functionality is whether alternative designs exist, not simply whether the design performs a function); *Warner Bros.*, 724 F.2d at 331 (mere accommodation of a function is insufficient to render a design functional under trademark law) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1342 (C.C.P.A. 1982)).

If the setting of the line between copyrightable expression and unprotected ideas contained in a work is conceived as a balance between creating sufficient incentives for creation without unduly restraining competition, *see Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971); Jane C. Ginsburg, *No “Sweat?” Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 Colum. L. Rev. 338, 346 (1992) (suggesting that the idea/expression distinction reflects notions of appropriate competition), there might appear some superficial resemblance to the competitiveness-based version of the trademark functionality test. Yet, even here, there are clear differences. Incentive to innovate is not part of the calculus in trademark law. *See Traffix Devices*, 69 U.S.L.W. at 4175.

Finally, the effect of the separability test (*see* Response to Question 2 above) has largely been to deny copyright protection for designs that reflect an integration of form and function. *See Keiselstein-Cord*, 632 F.2d at 994 (Weinstein J. dissenting) (commenting that a strict application of the separability rule would “deny protection to designers who use modern three-dimensional abstract works artfully incorporated into a functional object as an inseparable aspect of the article while granting it to those who attach their independent representational art, or even trite gimmickry, to a useful object for purposes of enhancement”). The invigorated form of the functionality doctrine contemplated in *Traffix Devices*, and an apparent restriction of the rather generous trade dress protection afforded designs in recent years, may have a similar effect on identifying the favored subjects of trade dress protection. *Cf. Traffix Devices*, 69 U.S.L.W. at 4175 (explaining the circumstances where designs may still receive trade dress protection).

In each of these areas, there are however clear evidentiary overlaps. The number of different ways of expressing a single ideas is frequently referenced by courts determining whether the protection sought by a copyright claimant would grant protection over the ideas in a work. *See Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 141 (5th Cir. 1992); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967). This analysis is not unlike consideration of available alternative designs, which is, as noted above, a

relevant question in assessing trademark functionality.

5. Does trademark law contain any exclusion from protection for works that are already protected by copyright? Does it contain any exclusion for subject matter that is patented?

Trademark protection contains no per se exclusion from protection of works that are already protected by copyright. That is to say, cumulation of copyright and trademark protection is generally permitted (although the approach of courts may differ in particular contexts, as discussed more fully below in Responses to Questions 6 & 8).

The cumulation of patent and trademark protection is more uncertain. As a general matter, most courts take the view that the different forms of intellectual property protection are independent of each other, and can be separately asserted. No statutory provision prohibits cumulation of rights.

One aspect of the patent/trademark issue was recently presented to the United States Supreme Court in the *Traffix Devices* case. There, the Court was presented with the question whether trademark rights could be asserted in the design of an article that had previously been the subject of a utility patent (since expired). A split had developed among the lower appellate courts. One circuit court, the Court of Appeals for the Tenth Circuit had held that “where a product configuration is a significant inventive component of an invention covered by a utility patent . . . it cannot receive trade dress protection.” *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1500 (10th Cir. 1995). Several other circuits had refused to foreclose trade dress protection merely because the design feature for which trade dress was claimed had been the subject of an expired patent. *See, e.g.*, *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277 (7th Cir. 1998); *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356 (Fed. Cir. 1999).

The Court held that “a utility patent is strong evidence that the features claimed therein are functional.” *Traffix Devices*, 69 U.S.L.W. at 4174. In the case before it, the Court found that there was a “strong evidentiary inference of functionality based upon the disclosure of the dual-spring design in the claim of the expired patents,” such design being “the central advance claimed in the expired utility patents” and “the essential feature of the [claimed] trade dress.” *Id.* The Court concluded that the plaintiff had failed to overcome the inference of functionality.

The Court’s opinion raises at least two questions concerning the expired patent-derived inference. First, which aspect of the Court’s description of the dual-spring design triggered the “strong evidentiary inference of functionality”? In addition to the characteristics noted above (the “central advance claimed in the patent” and the “essential feature of the claimed “trade dress”), the court noted that “the springs are necessary to the operation of the device” and that the defendant’s product would have infringed the expired patent based upon the doctrine of equivalents. Second, in what

ways can a plaintiff overcome this inference? Here, the Court suggests that “in a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain” apparently because such aspects might not “serve a purpose within the terms of the utility patent.” *Id.* at 4175; *see also id.* (“The dual-spring design is not an arbitrary flourish in the configuration of [plaintiff’s] product; it is the reason the device works.”).

The answer to each of these questions might be more easily detected if the purpose of the evidentiary inference were more clearly explained by the Court. The inference would appear to flow from the likelihood that design features included within the claims of a patent are essential to the purpose of the article (and thus within the *Inwood* test). *See id.* at 1474 (discussing the ways in which “the rationale for the rule that the disclosure of a feature in the claims of a utility patent constitutes strong evidence of functionality is well illustrated in this case”). Some briefs submitted to the Court sought to rest non-protection for design features covered by an expired patent on the so-called “right to copy” the subject matter of expired patents (to which some briefs ascribed a constitutional pedigree, based upon the conflict between the Copyright and Commerce Clauses of the United States Constitution). The Court expressly deferred consideration of the constitutional arguments to another day. *See id.* at 1475 (suggesting that such a question might be raised where “trade dress becomes the practical equivalent of an expired utility patent”). But the Court would also appear not to have based the inference on any non-constitutional right to copy.

The toughest constitutional question – where trade dress might “become the practical equivalent of an expired utility patent” – might have been avoided by other recent developments. Trade dress protection for designs begins to approximate patent protection most readily when it is detached from its confusion-based moorings. Dilution protection for designs – available without regard for confusion – offered this possibility. Although some courts recognized that this pushed the constitutional question to the brink, *see I.P. Lund Trading Aps v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998), other courts were willing to countenance the possibility of dilution protection for design trade dress. *See Sunbeam Prods. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997). And the statutory language would appear to admit of this possibility. *See* 15 U.S.C. § 1125(c).

But recent developments in dilution case law might avoid this question. The Court of Appeals for the Second Circuit has in the past month held that dilution protection is available only to marks that are inherently distinctive. *See TCPIP Holding Co. v. Haar Communications Inc.*, 57 U.S.P.Q.2d (BNA) 1969 (2d Cir. 2001). Combined with the ruling by the United States Supreme Court that designs may only be protected upon proof of secondary meaning (and thus cannot be inherently distinctive), *see Wal-Mart Stores, Inc. v. Samara Bros, Inc.*, 120 S. Ct. 1339 (2000), this would exclude the possibility of dilution protection for product designs.

These issues (particularly the constitutional issues) may warrant different resolution where the design feature has never been patented (for lack of novelty, for example) or where the design was covered by a patent that has been invalidated. In these contexts, federal trade dress protection has largely been unaffected by the patent issues. (Novelty of a design, for example, is not a prerequisite to distinctiveness and hence protection as trade dress). Where the design is still protected by a patent, cumulative trade dress protection is probably not a hugely significant issue given the strength of patent rights. The analysis may also be different in the case of design patent protection, although such cumulation is presently permitted.

6. To which extent is cumulative protection granted under copyright and trademark law for the following:

(a) work titles

The title of a work is not protected by copyright. *See* 37 C.F.R. § 202.1(a). The title of a work may be protected by trademark, but only if it is shown to identify the work and distinguish it from others. To effectuate this objective, courts and the Patent and Trademark Office have been reluctant to grant trademark protection to the title of a single work. *See In re Hal Leonard Publishing Corp.*, 15 U.S.P.Q.2d 1574 (T.T.A.B. 1990) (describing as “well-settled” and “unchanged” the proposition that the title of a book cannot be registered as a trademark); *see also* *Twin Peaks Prods., Inc. v. Publications International, Ltd.*, 996 F.2d 1366, 1378 (2d Cir. 1993) (noting, in trademark action alleging infringement of television program by a book with a similar title, the “special concerns implicated by [trademark] claims against titles of works of artistic expression”). Titles of a single work may, however, be protected by trademark law upon proof of secondary meaning. *See, e.g.*, *Simon & Schuster, Inc. v. Dove Audio, Inc.*, 970 F. Supp. 279, 293 (S.D.N.Y. 1997) (title of the book “The Book of Virtues” by William Bennett had acquired secondary meaning); *Orion Pictures Co. v. Dell Publishing Co.*, 471 F. Supp. 392 (S.D.N.Y. 1979) (title of the motion picture “A Little Romance”); *see also* J. Thomas McCarthy, *Trademarks and Unfair Competition* § 10.2 (4th ed. 2000) (suggesting that secondary meaning is a prerequisite to protection of a title of a single work, even where the title is not descriptive of the work’s contents). And trademark protection is even more readily granted to the title of a series of books, magazines, or newspapers; these are regarded as more likely to identify the source of the product. *See, e.g.*, *Walt Disney Co. v. Cable News Network, Inc.*, 231 U.S.P.Q. 235 (C.D. Cal. 1986) (protecting the title of daily cable television program BUSINESS DAY upon proof of secondary meaning); *Atlantic Monthly Co. v. Frederick Unger Publishing Co.*, 197 F. Supp. 524 (S.D.N.Y. 1961) (protecting ATLANTIC as part of magazine title used by Atlantic Monthly).

(b) emblems

Emblems may be protected by copyright only if they are sufficiently original; this is

possible, but simple abstract designs may be especially vulnerable to claims of non-originality. *See* John Muller & Co. v. New York Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986) (logo lacked creativity necessary for copyright protection). It is easier to protect emblems or logos under trademark law, provided that they are distinctive. Such symbols (especially if two-dimensional) tend to encounter fewer problems under the doctrine of functionality than do three dimensional designs.

(c) the name, appearance, and other aspects of fictitious (e.g. cartoon) characters?

Characters, whether first developed as part of literary, audio-visual, artistic, or other works, are protectable by both copyright and trademark law. *See, e.g.,* Brown v. It's Entertainment, Inc., 34 F. Supp.2d 854 (E.D.N.Y. 1999) (granting injunction against use of cartoon character in costumes under both copyright and trademark law). Copyright protection is available only where, and only to the extent that, the character is sufficiently delineated that it moves beyond a stock character. *See* Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930); Anderson v. Stallone, 11 U.S.P.Q.2d 1161 (C.D. Cal. 1989) (protecting characters in Rocky movies under both the test developed in *Nichols* and the so-called "story being told" test, under which characters are independently protected by copyright if they represent the "story being told"); Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978) (protecting Mickey Mouse and other Disney characters against copying in magazines). For example, in *MGM v. American Honda Motor Co.*, 900 F. Supp. 1287 (C.D. Cal. 1995), the court held that the James Bond character – consisting of his "cold-bloodedness; his overt sexuality; his love of martinis 'shaken not stirred'; his marksmanship; his 'license to kill' and use of guns; his physical strength; his sophistication" – would likely be protected under copyright law. Case law in the Ninth Circuit would appear to suggest that graphic characters are wont to receive greater protection than literary characters on account of their greater development, but lower courts continue to analyze claims of protection on a case by case basis, having regard to the level of character development in question.

Trademark protection is available to those aspects of a fictitious character that are distinctive. *See* Walt Disney Co. v. Powell, 698 F. Supp. 10 (D.D.C. 1988) (the appearance of Mickey Mouse protected by trademark law as well as copyright law). The names of characters are not protected by copyright, but may receive protection against confusingly similar names under trademark and unfair competition law.

(d) costumes and clothing designs

Costumes and clothing designs are protectable by copyright. *See, e.g.,* Wal-Mart v. Samara Bros., 165 F.3d 120 (2d Cir. 1999) (upholding copyright and trade dress claim for infringement of clothing designs), *rev'd on other grounds*, 529 U.S. 205 (2000) (rejecting trade dress claim for the clothing design features); Knitwaves Inc. v. Lollytogs Ltd., 71 F.3d 996 (2d Cir. 1995) (sweater designs). Clothing is, however, clearly a useful

article within the meaning of the statutory provision discussed above, and thus must pass the separability test to receive protection. Costumes are a closer case, but have been treated by the Copyright Office and the courts as useful articles, and thus subject to the same additional hurdle. *See Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452 (2d Cir. 1989); United States Copyright Office, Policy Decision on the Registrability of Costume Designs, 56 Fed. Reg. 56530 (Nov. 5, 1991). Face masks, on the other hand, are not treated as useful articles, and thus more readily protected. *See, e.g., Masquerade Novelty Inc. v. Unique Indus.*, 912 F.2d 663 (3d Cir. 1990)(finding that the only utilitarian function of animal nose masks was to portray the appearance of the animal in question and thus did not fall within the statutory definition of "useful article").

Clothing designs and costumes may also be protected by trademark law, provided that the design features for which protection is sought are distinctive and used in commerce. However, parts of clothing design may be regarded as functional under the test discussed above. *See, e.g., Stormy Clime v. Pro Group, Inc.*, 809 F.2d 971 (2d Cir. 1987). Between 1992-2000, the distinctiveness of a design feature could be established based upon either the inherent or acquired distinctiveness of such design feature. In the wake of the United States Supreme Court decision in *Wal-Mart Stores Inc. v. Samara Bros., Inc.* 529 U.S. 205 (2000), protection may now be based only upon acquired distinctiveness. Trade dress protection for clothing designs has thus been somewhat curtailed, and may prove particularly ineffective against imitation in the first few months of marketing.

(e) furniture design

Furniture designs may be protected by both trademark and copyright law. With respect to copyright protection, most furniture will be regarded as useful articles, and thus any design feature will receive copyright protection only if it satisfies the separability test discussed above.

In recent years, protection has been available under trademark law to some furniture designs. *See, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1263-64 (Fed. Cir.) (protecting look of garden furniture); *Krueger Int'l v. Nightingale Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996) (design of stacking chairs). But the trademark distinctiveness requirement can prove a difficult hurdle in many cases, *see, e.g., L & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258 (2d Cir. 1996) (vacating preliminary injunction because not clear that consumers associated design with plaintiff, rather than with maker of the original furniture design, and criticizing *Imagineering* decision), as can the functionality exclusion discussed above. *See Landscape Forms Inc. v. Cascade Co.*, 70 F.3d 251 (2d Cir. 1995).

(f) architectural designs

Since 1990, U.S. copyright law has prevented architectural works as such. *See*

Architectural Works Copyright Protection Act 1990, Pub. L. No. 101-650. An architectural work is defined by the statute as “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features”. This new protection is available to works created after December 1, 1990, although it is important to note that this type of work may be embodied in both a constructed building and plans. *See* Hunt v. Pasternak, 179 F.3d 683, 685 (9th Cir. 1999). There have been only a few court decisions interpreting the scope of the definition. *See, e.g.,* Yankee Candle Co. v. New England Candle Co., 14 F. Supp.2d 154 (D. Mass. 1998) (recognizing that although the design of a shopping mall, as a whole, may be protected under the legislation, the design of the store front of a single store in the mall could not be protected). Because such works are now protected as a discrete category of work, rather than subsumed under the category of sculptural works, copyright protection is not conditioned upon the design meeting the separability test (discussed above) to which the design of all useful articles in the pictorial, graphic and sculptural works category are subjected. But the legislative history does make clear that “functionally required” design elements are not protectable. *See* H.R. Rep. No. 101-735, 101st Cong. 2d Sess. 24 (1990). Nor would this protection extend to standard design features that one would find in any building of the type in question. *See, e.g.,* Walter Sedovic Architect v. Alesandro, 2000 CCH Copy. L. Dec. ¶ 28, 012 (S.D.N.Y. 1999) (because the only similar features in the two churches in question were large vertical doors and being cross-shaped, there was no substantial similarity of protected expression).

In recent years, owners of buildings have begun to use trademark law to protect architectural designs. The appearance of distinctive buildings housing franchised businesses (such as fast-food restaurants) have been relatively successful in claiming trade dress rights in the overall appearance of the business setting. Frequently, however, trade dress rights are being asserted to control the market in merchandise depicting the building rather than simply to restrain the construction of confusingly similar buildings. A notable example was the attempt by the Rock and Roll Music Museum and Hall of Fame to enjoin the sale of unauthorized posters of the museum (which had been designed by I.M. Pei). The district court granted an injunction, but the appellate court reversed the lower court (in a somewhat confused opinion) for failure to establish that the architectural design was consistently functioning as a trademark. *See* Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions, 134 F.3d 749 (6th Cir.1998).

(g) labeling or packaging

Standard labels such as a mere listing of ingredients may be insufficiently creative to be protected by copyright. *See* 37 C.F.R. § 202.1(a). But case law makes clear that labels that move beyond such mere provision of information may be protected. *See, e.g.,* Kitchens of Sara Lee, Inc. v. Nifty Foods Corp., 266 F.2d 541 (2d Cir. 1959) (labels for

chocolate cake); *Quality King Distributors v. L'Anza Research Int'l*, 523 U.S. 135 (1998) (labels for shampoo). The protection of distinctive labels and packaging is one of the primary areas of trademark activity, the latter being the traditional example of what is called "trade dress."

(h) musical works

Musical works can, of course, be protected by copyright law. *See* 17 U.S.C. 102(a)(2). And musical phrases consisting of small groupings of notes may in certain circumstances be protected by trademark law. *See, e.g., In re General Electric Co.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978) (recognizing that sounds can, in certain circumstances, be registered as trademarks).

The more problematic questions are whether a short musical phrase can be protected by copyright, and whether a complete song can be protected by trademark. Two recent cases have suggested that copyright may, in the case of exceptionally creative short musical (lyrical) phrases, offer protection. *See Tin Pan Apple Inc. v. Miller Brewing Co.*, 30 U.S.P.Q.2d 1791 (S.D.N.Y. 1994) (leaving open the possibility that short phrases from the lyrics of a rap song might be sufficiently creative given the complexity of the musical phrase); *Santrayll v. Burrell*, 39 U.S.P.Q.2d 1052 (S.D.N.Y. 1996) (rhythmic repetition of phrase "uh-oh" may be sufficiently original to warrant copyright protection). Claims that a "signature song" can serve as a trademark have met with less success. *See, e.g., Oliveira v. Frito-Lay, Inc.*, 50 U.S.P.Q.2d 1152 (S.D.N.Y. 1999) (denying protection and noting that "protection for musical works falls under the rubric of copyright law, not trademark law"); *EMI Catalogue Partnerships v. Hill, Holiday, Connors, Cosmopolous, Inc.*, 228 F.3d 56, 63-64 (2d Cir. 2000) (holding that, although the title of a song may serve as a trademark in certain circumstances, the musical composition itself may not be protected by trademark, and stressing that "copyright law, not trademark law, is the primary vehicle for protecting the rights of a song's composer . . . in the musical composition"); *cf. Batiste v. Island Records, Inc.*, 179 F.3d 217, 225 (5th Cir. 1999) (dismissing claim for passing off based upon unauthorized use of digital sample of musical work written and recorded by plaintiff because consumers would not be confused).

(i) appearance of books

The cover or appearance of a book may be protected by copyright (as a pictorial, graphic, or sculptural work) provided that the prerequisite of originality has been satisfied. The appearance of a book may also be protected by trademark law, if the cover or appearance has come to act as a source-identifier. *See Frederick Warne & Co. v. Book Sales, Inc.*, 481 F. Supp. 1191 (S.D.N.Y. 1979) (denying defendant's motion for summary judgment in case where trade dress rights claimed in the appearance of a book); *Reader's Digest Assoc. v. Conservative Digest, Inc.*, 821 F.2d 800 (D.C. Cir. 1987) (protecting the cover design of a magazine as an original work of authorship and a source-identifying dress).

Trademark protection has also been sought for the appearance of a line of books, *see* Publications Int'l, Ltd. v. Landoll, Inc., 164 F.3d 337 (7th Cir. 1998), but the courts are becoming stricter in their recognition of what is called "family trade dress," meaning a line of products with identical source-identifying design features. *See* Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 380 (2d Cir. 1997) (noting enhanced concern for competition where protection is sought for line of products); Regal Jewelry Co. v. Kingsbridge Int'l Inc., 47 U.S.P.Q.2d 1074, 1081 (S.D.N.Y. 1998) (discussing difficulties of establishing family trade dress).

7. Has the attitude towards protectability of the items mentioned in Question 6 above under trademark and/or copyright law changed in recent years? In which respect?

The decision of the United States Supreme Court in *Two Pesos v. Taco Cabana* in 1992 suggested an expansive view of trade dress protection for design features. The lower courts acted upon the Supreme Court's invitation and generally expanded such protection. In the following years, trade dress protection was afforded a variety of designs and other features that were not the traditional subjects of trademark protection.

The 1995 decision of the Supreme Court in *Qualitex*, although expansive in so far as the Court accepted the registration of color per se as a trademark, contained the first suggestions that the Supreme Court might restrain the excesses of *Two Pesos*. This restraint has been made more explicit by the two most recent Supreme Court decisions, namely *Samara Brothers* and *Traffix Devices*. *See Traffix Devices*, 69 U.S.L.W. at 4173 (noting that "in *Wal-Mart*, we were careful to caution against misuse or over-extension of trade dress").

There have been fewer obvious trends in the protection of these item under copyright law, although the high point of protection for designs may have been the 1980 decision of the Court of Appeals for the Second Circuit in *Keiselstein-Cord*, *supra*. Later decisions have adopted a stricter view of the separability test, and have thus restricted copyright protection for designs other than those wholly unconnected to the function of the useful article in question.

8. To what extent is trademark or unfair competition protection available in circumstances where copyright law affirmatively denies protection? (For example, where copyright protection has expired, where copyright law exempts certain conduct from infringement, where the defendant's conduct would be regarded as appropriation only of ideas, etc.). Does the extent of trademark protection differ depending upon the reason that copyright protection is not available?

The courts have developed no generally applicable rule that protection for a work under trademark law is to be unavailable where copyright protection is unavailable. Indeed, the general approach of the courts is to treat the different forms of intellectual property protection quite discretely. This is in often justified by reference to the different purposes

of the separate regimes. *See, e.g., Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 637-39 (7th Cir. 1993) (resting conclusion that utility patent and trade dress can co-exist on analysis of different purposes); *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1215 (8th Cir. 1976) (explaining trademark protection that might protect unpatentable matter on grounds that the two laws are directed at a different purpose).

As a result, trademark law may arguably be used to restrain free use of a work even when it is in the public domain as a matter of copyright law. *See Frederick Warne & Co. v. Book Sales, Inc.*, 481 F. Supp. 1191 (S.D.N.Y. 1979); J. Thomas McCarthy, *Trademarks and Unfair Competition* § 6.11 (“if the cartoon character has achieved trademark significance, one should not, even after expiration of the copyright, be able to take an image of the character and use it on merchandise if it is likely to cause confusion as to source, affiliation, or connection”). *Contra see Comedy III, infra*. For example, where a work is no longer protected by copyright, the title of the work can (and perhaps should) be used by any person exercising legitimate rights to copy. *See G. & C. Merriam Co. v. Syndicate Publishing Co.*, 237 U.S. 618, 622 (1915) (“After the expiration of the copyright of that character, it is well-settled that the further use of the name, by which the publication was known and sold under the copyright, cannot be acquired by registration as a trade-mark; for the name has become public property, and is not subject to such appropriation.”). But if the title of the work is protected by trademark law, that title cannot be used in a way that gives rise to confusion as to the source of the product. *See Maljack Prods. v. Goodtimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996) (quoting *Merriam* but noting that it will likely be difficult to show confusion in such circumstances).

Trademark law may also offer protection to aspects of a work that may not be protected by copyright. The style of an artist’s work may be difficult to protect under copyright law because it may veer too close to the line between idea and expression. *But see Steinberg v. Columbia-Delphi Prods.*, 663 F. Supp. 706 (S.D.N.Y. 1987). But some courts have been willing to protect the artistic style of an artist under trademark law if it is distinctive. *See Romm Art Creations Ltd. v. Simcoe International, Inc.*, 786 F. Supp. 1126 (E.D.N.Y. 1992) (protecting the look of an artist’s painting as trade dress). *But see Galerie Furstenberg v. Coffaro*, 697 F. Supp. 1282, 1290 (S.D.N.Y. 1988) (dismissing trademark claim based upon appropriation of the style of Salvador Dali because such claims are properly brought under the copyright statute).

And specific limitations privileging a user’s use of a work under copyright law may be circumvented by broader trademark protection. Section 120 of the Copyright Act limited the scope of copyright in architectural works by providing that the copyright “does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or is ordinarily visible from a public place.” This provision of the Copyright Act did not, however, stop the district court in *Rock and Roll* from granting an injunction against the sale of posters showing the museum design

under trademark law. Because the appellate court vacated the injunction for failure to make out a trademark claim, the issue was not decided by the appellate court (although argued to them).

On the other hand, several court decisions have attempted to transpose the limits of copyright law into trademark law where protection is being sought for a work that is, has been, or potentially is, the subject matter of copyright protection. Thus, for example, some courts have determined (and denied) distinctiveness of design features under trademark law by direct appeal to the impact of protecting an idea in violation of copyright law. *See, e.g.,* *Jungle Rags, Inc. v. Rainbow Graphics, Inc.*, 29 U.S.P.Q.2d 1704, 1708 (M.D. Fla. 1993) (flap in shirt in shape of animal's mouth not inherently distinctive because to make that finding would grant monopoly on the fashion idea); *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 32 (2d Cir. 1995) ("In evaluating claims to distinctive trade dresses, two additional considerations should be borne in mind. . . Second, just as copyright law does not protect ideas but only their concrete expression, neither does trade dress law protect an idea, a concept, or a generalized type of appearance."); *Leigh v. Warner Bros.*, Civ. No. 497-340, 1998 WL 351878, at *8-9 (S.D. Ga. June 22, 1998) (noting the potential for "undermining copyright" by offering trade dress protection to a photograph used on the cover of a book), *aff'd in relevant part*, 212 F.3d 1210 (11th Cir. 2000).

Similarly, some courts have suggested that if a work has passed into the public domain under copyright law, trademark law cannot be used to protect it. *See* *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 596 (9th Cir. 2000) (rejecting claim of trademark in 30-second clip from public domain motion picture and commenting that "we will not entertain this expedition of trademark protection squarely into the dominion of copyright law").

9. To what extent is trademark or unfair competition protection available in circumstances where patent law affirmatively denies protection? Does the extent of trademark protection differ depending upon the reason that patent protection is not available?

It is often claimed that there is a right to copy the subject matter of an expired patent, and that this "right to copy" cannot be subject to interference by other forms of intellectual property (most notably) trademark. As discussed above (Response to Question 5), the Supreme Court has recently declined to address this question directly, although its "evidentiary inference" of functionality may effectively generate such a rule. Whether this occurs will depend upon how lower courts apply *Traffix Devices*, and how the open questions referenced above are answered.

Some U.S. scholars have phrased the "right to copy" in terms that might exclude the possibility of protecting subject matter that is unpatentable (e.g., because of lack of novelty). But the case law addressing this aspect of the debate is largely directed at the

conflict between state forms of protection and federal patent protection, a conflict resolved in favor of federal patent law by virtue of the Supremacy Clause in the U.S. Constitution. It is clear from the (somewhat confused) line of constitutional case law that state law may offer some forms of intellectual property protection to subject matter that is unpatentable, and likely that federal trade dress law can do the same.

These questions are however influenced by the overlay of constitutional questions involving not just the Supremacy Clause but also the inter-relationship of the Commerce Clause (upon which trademark protection rests) and the Copyright and Patent Clause (which authorizes federal copyright and patent protection). Some litigants and scholars would transpose the limits of the Copyright Patent Clause (e.g., as to the requirements of originality or the limited nature of any protection) to protection offered under Commerce-Clause based legislation. The issue is being debated in the lower courts, *see, e.g.*, *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999), and the outcome of that debate when presented to the United States Supreme Court will significantly affect the answer to this question.

10. To what extent does trademark law protect against non-attribution or misattribution of authorship? Is this protection coterminous with protection offered by moral rights?

Protection of the moral right of attribution or paternity as such in the United States is almost non-existent at the federal level, *see* Visual Artists Rights Act, *see* Pub. L. No. 101-650, 103rd Cong. 2d Sess. (1990), although supplemented by slightly broader state laws, *see, e.g.*, Cal. Civil Code §§ 980-990, N.Y. Arts & Cult. Aff. Law § 11.01-16.01, and perhaps effectively by new provisions on copyright right management information. *See* 17 U.S.C. § 1202.

Trademark law may offer effective protection against conduct that would violate moral rights protection of this kind on the theory that misattribution of the authorship of a work may confuse consumers as to the source or origin of the work, or the affiliation or connection of the author (or person stated to be the author) to the work. *See* *Lamothe v. Atlantic Recording Corp.*, 847 F.2d 1403, 1407 (9th Cir. 1988) (cause of action stated under the Lanham Act where authorship of a musical work is attributed to some, but not all, of the co-authors); *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981) (violation of section 43(a) of the Lanham Act where an actor's name was omitted from the credits and replaced by another); *Johnson v. Jones*, 149 F.3d 494, 503 (6th Cir. 1998) (attributing the architectural plans to person other than the author constituted passing off actionable under the unfair competition provision of the Lanham Act).

But trademark law contains conditions that make this protection less effective than a fully-fledged moral right. In particular, there must be a false representation. It is not clear that non-attribution (as opposed to misattribution) would violate the Lanham Act. *See* *Cleary v. News Corp.*, 30 F.3d 1255, 1260-61 (9th Cir. 1994). The strongest claims

to use of the Lanham Act in this context arise where the attribution is made of a distorted version of the author's work (thus implicating rights of integrity as well as attribution). *See, e.g.*, *Gilliam v. American Broadcasting Co.*, 538 F.2d 14, 24 (2d Cir. 1976). *But see* *Choe v. Fordham University School of Law*, 920 F. Supp. 44 (S.D.N.Y. 1995) (denying Lanham Act claim where law review published article under author's name with unauthorized editorial revisions), *aff'd mem.*, 81 F.3d 319 (2d Cir. 1996).

11. Please make reference to existing case law regarding the overlap between trademark and copyright law, in particular as regards the following topics:

(a) differences regarding the scope of protection (e.g. copyright protection extending beyond similar goods)

Copyright law accords the copyright owner with the exclusive right to prepare derivative works. *See* 17 U.S.C. § 106(2). The scope of this right is in part determined by the concept of substantial similarity that helps to define the reach of the reproduction right. *See* *Horgan v. Macmillan, Inc.*, 789 F.2d 157 (2d Cir.1986). This right clearly enables the copyright owner to control the use the work in the production of dissimilar goods.

Trademark rights exist only with respect to the products or services upon which they are used, and trademark law classically protected against confusion of purchasers as to the source of a product. But modern U.S. trademark law has adopted a broader notion of actionable confusion: it may protect against confusion of non-purchasers, against confusion occurring after the point of sale, and confusion as to affiliation or connection or endorsement. *See* 15 U.S.C. § 1125(a). This expansion has enabled trademark protection more readily to extend to non-competing dissimilar goods, but the similarity of goods of the parties remains a relevant consideration in determining confusion.

Since 1995, dilution protection has been offered under federal trademark law to marks that are famous. *See* 15 U.S.C. § 1125(c). This form of trademark protection is consciously directed at uses on dissimilar goods. Dilution is established through blurring (the lessening of the capacity of a famous mark to identify or distinguish goods) or tarnishment. The courts have offered no consistent means of assessing whether "blurring" exists, *see, e.g.*, *I.P.Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 33 (1st Cir. 1998) (rejecting prevailing *Sweet* factors and instituting an inquiry instead "into whether target consumers will perceive the products as essentially the same"); tarnishment involves the development of "negative" connotations surrounding the mark.

Copyright protection is limited to the life of the author plus seventy years. *See* 17 U.S.C. § 302(a). Trademark protection is potentially perpetual, dependent upon continued use and distinctiveness. But if the work/mark is not used for a period

of time, copyright protection will endure and trademark protection (absent a justification for non-use) will expire.

(b) what is required to sustain a claim copyright infringement, as compared to trademark infringement or trademark dilution

The essential elements of the different trademark causes of action are set forth in response to Question 11(a); in addition, of course, the matter for which protection is sought must be distinctive and used in commerce. Registration is not required to bring a trademark infringement claim.

An action for copyright infringement requires (other than ownership of the copyright) that a plaintiff demonstrate copying and improper appropriation, the latter involving substantial similarity of protected expression. *See Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946). For works other than Berne Convention works, a copyright must be registered in order to bring an infringement proceeding. *See* 17 U.S.C. § 411.

(c) exemptions permitting parodies and other issues concerning free speech

Copyright law contains no “free speech” exception as such. Instead, free speech values are incorporated into the law via the non-protection of ideas, the independent creation defense, and the fair use defense. *See Harper & Row v. The Nation Enters.*, 471 U.S. 539 (1985). In 1994, the United States Supreme Court specifically addressed the question of parody under copyright law in *Campbell v. Acuff-Rose Music Inc.*, 510 U.S. 569 (1994). The Court there offered parodists significant latitude to make use of copyrighted works. The Court did not, however, create a parody exception to copyright, or even a presumption that a parody will be treated as fair use. Instead, the Court accepted that parodies might be regarded as transformative in nature, a characteristic favored in copyright fair use analysis. The Court also distinguished parody from satire. The latter, commenting upon society generally rather than upon the parodied work, received less favorable treatment by the Supreme Court because the satirist does not (unlike the parodist) have to use the work in question to make his or her expressive or creative point. This consideration – whether the defendant used more than necessary to make her creative point by conjuring up the first work – is also a consideration where parodies are being evaluated under the fair use analysis.

Judicial treatment of parodies under trademark law has been less structured, and hence less clear. No per se exception exists for parodies, although if a use of a mark/work is clearly a parody, it is unlikely that consumers will be confused in any actionable sense. *Compare* *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987) *with* *Anheuser-Busch v. Balducci*, 28 F.3d 769 (8th

Cir. 1994) (finding likely confusion as to connection with the plaintiff where the parody advertisement was likely to be seen as a genuine advertisement). It is within the “likelihood of confusion” analysis that the status of a work as a parody will be reflected. *See Lyons Partnership v. Giannoulas*, 179 F.3d 384 (5th Cir. 1999) (treating the parodic nature of the imitation of trademarked character as an additional factor in the likelihood of confusion analysis and finding for the defendant); *see also Cliff Notes, Inc. v. Bantam Doubleday Dell Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (requiring higher level of likelihood of confusion where parody is expressive rather than commercial in nature because trademark interest must be balanced with public interest in free expression). At first blush, parodies may be vulnerable under trademark law if the mark in question is famous and thus may be protected against dilution. Many parodies may implicate the somewhat intuitive notion of tarnishment in their treatment of marks. At the very least, courts are loathe to allow the claim of parody to be invoked by a competitor attempting to undermine the image associated with a competitor’s mark. *See Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39 (2d Cir. 1994) (finding violation under New York dilution statute where competitor used a parody of the defendant’s mark in a television commercial taking the form of comparative advertising). As with classical infringement case law, noncommercial parody is likely to be given greater scope than parody used for commercial purposes. *See L.L. Bean Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 33 (1st Cir. 1987) (declining to enjoin noncommercial parody under equivalent state law).

(d) exhaustion of rights/first sale

The sale or transfer of a trademarked product under its own name is permitted; the trademark owner’s rights are exhausted upon first sale. This right is contingent upon the goods being “genuine goods”, that is not altered by the transferor. Moreover, trademark liability may also attach if the further transfer of the goods involves a use of the mark that falsely (and confusingly) suggests affiliation or endorsement.

The distribution right of a copyright owner is subject to the first sale doctrine. *See* 17 U.S.C. §§ 106(3), 109(a). The copyright owner cannot exercise its distribution right with respect to any particular lawfully made copies of the work. *See Quality King Distributors v. L’Anza Research Int’l*, 523 U.S. 135 (1998) (discussing scope of the first sale doctrine as applied to importation of works without the permission of the copyright owner).

(e) limits on the transfer of rights. (We are interested here in limits under one intellectual property regime that might prevent the right holder from fully exercising its rights, or from effectively obtaining the same rights, under a different intellectual property regime. For example: limits on the transfer of authors’ rights that might prevent unfettered assertion of trademark rights

by an assignee of both sets of rights; or conditions on the transfer of trademark rights that limit the ability of an assignee to use trademark law to restrain the same conduct as could be restrained by the owner of a valid copyright)

Copyrights are freely transferable, in whole or in part. *See* 17 U.S.C. § 201(d). Transfers of copyright, as defined, executed after January 1, 1978, are however subject to the right of the copyright owner to terminate that grant after a statutorily-defined period (normally 35 years). Termination causes the reversion of rights, although the transferee is entitled to continue to utilize derivative works prepared under the terms of the grant. *See* 17 U.S.C. § 203. Termination rights are not transferable, but if they are not exercised within the statutory period, the rights remain with the transferee. *See id.* § 203(a)(5).

Trademark rights are also freely transferable. But to be valid, an assignment of a trademark must be accompanied by the goodwill attendant thereto. *See* 15 U.S.C. § 1060. Courts have in recent years interpreted this provision liberally and have focused, rather than on the transfer of physical assets of the transferor's business, on whether the transferee is capable of producing goods under the mark in continuity with the past owner.

Trademark rights may also be licensed, *see* 15 U.S.C. § 1055, and any use by the licensee enures to the benefit of the licensor. The licensor must, however, control the nature and quality of the licensee's products. Absent such control, the license may be treated as "naked" and the trademark rights lost.

(f) differences in the relief available for copyright and trademark infringement

The relief available to successful copyright owners is listed in Chapter 5 of the Copyright Act and include injunctive relief, awards of actual damages and infringer's profits, and seizure of infringing materials. These also include the grant of statutory damages (in lieu of actual damages and profits) and attorneys' fees, *see* 17 U.S.C. § 505, although these remedies are available only where the work has been timely registered in accordance with the provisions of Section 412. *See* 17 U.S.C. § 412. Where a plaintiff succeeds under both copyright and trademark law, the fact that the plaintiff has received an award of profits as relief in the trademark claim will not preclude an award of statutory damages under copyright law. *See* *Lyons Partnership v. AAA Entertainment Inc.*, 53 U.S.P.Q.2d 1397, 1404-05 (S.D.N.Y. 1999); *Nintendo of America, Inc. v. Dragon Pacific Int'l*, 40 F.3d 1007, 1010-1011 (9th Cir. 1994).

The principal forms of relief available under the trademark statute are not unlike those available under the copyright statute. Additional forms of relief apply in the case of counterfeiting. *See* 15 U.S.C. § 1117(b)-(c) (providing for treble damages

and statutory damages). But in the routine trademark infringement case, the remedies approximate those available to the successful copyright claimant. Trademark law does not, however, include a provision for award of statutory damages (other than in the context of cybersquatting), but attorneys' fees are available in exceptional cases. The Supreme Court has not yet addressed whether the standard for attorneys' fees in trademark cases should differ as between plaintiff and defendant, whereas the Court has held that the standard must be the same when attorneys' fees are sought under the Copyright Act. *See Fogerty v. Fantasy Inc.*, 510 U.S. 517 (1994).

Although punitive damages are not available under the Lanham Act, some states' trademark and unfair competition law (most of which tracks federal law) may permit punitive damages. The United States Supreme Court is currently considering the constitutionality of such awards. *See Leatherman Tool Group v. Cooper Indus.*, 205 F.3d 1351 (9th Cir. 1999), *cert granted*, 121 S. Ct. 297 (2000).

12. Please add anything which might be of interest in the context (e.g. the attitude towards trademark protection for works of art in the public domain), etc.

N.B. We are especially interested in whether the rules permitting or excluding protection discussed in your answers are derived from statutory rules, have been developed by courts, or are grounded in national constitutions.

Comments on several of these topics have been incorporated in the Responses above. It is also worth noting that in general terms, arguments against use of trademark rights to protect works where copyright protection is affirmatively denied (e.g., when a copyright has expired, or is there a danger that ideas may be protected) appear to have found greater resonance with the courts in the last few years. But this may simply reflect that trademark protection for copyright subject matter is being sought far more aggressively than was formerly the case.