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Essay -- The Author's Name as a Trademark: A Perverse Perspective on the Moral Right of « Paternity » ?

Jane C. Ginsburg*

Abstract

The US Supreme Court in its 2003 decision in *Dastar v. Twentieth Century Fox*, construing the Lanham Federal Trademarks Act, deprived authors of their principal legal means to enforce attribution rights in the US. I have elsewhere criticized the *Dastar* Court's analysis, and have urged amending the Copyright Act to provide express recognition of the attribution right. This time, however, I propose to reconsider the foundation for the attribution right; I draw on literary and historical sources to supplement legal arguments concerning the meaning of the author's name. I will suggest that, contrary to the usual characterization of this right as flowing from the creative act, the attribution right *also* properly derives from trademark law, because the author's name gives her work a brand image that informs consumers' choices of literary and artistic works.

In trademark law, the brand name identifies the entity that controls the production of the goods, who is responsible for their quality. Translated to works of authorship, this would mean that the act warranting name credit is that of controlling the carrying out of the creation, rather than of creation as such. In copyright, however, the same concept could logically lead to depriving any employed creator, as well as a fair number of freelancers, of any right to impose their names on their works, because the employer or commissioning party will usually have the last word regarding the form or content of the creation. It is therefore necessary to propose a more nuanced approach: if the creator has enjoyed autonomy in the creative process, even if the work was made on demand, the creator has engaged in intellectual labor that justifies treating the creator as the « source » of the work. Any other approach would end up denying the role of creativity in copyright. But, as this Essay proposes to show, to reject all trademark-based rationales for attribution rights leads to other paradoxes.

The moral right of « paternity, » or of attribution of authorship, always precariously positioned in the US, may be moribund following the 2003 decision of the Supreme Court in *Dastar v. Twentieth-Century Fox*.¹ The Court there interpreted not the Copyright Act, but the federal Lanham Trademarks Act. Because there is no general copyright protection of authors' names, authors had resorted to trademark law to fill the gap, at least in part. Some courts of appeals had held that an author could obtain a remedy for the false attribution of her work to another person, in short, for plagiarism, on the ground that the conduct constituted « reverse passing off.» A third party who passes himself off as the work's author would have made a « false designation of the origin of goods or

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This Essay is based on a translation of *Le Nom de l'auteur en tant que signe distinctif: Une perspective perverse sur le droit à la "paternité" des oeuvres de l'esprit?* in Stéphane Martin, ed., *CAHIERS DU DROIT DE LA PROPRIÉTÉ INTELLECTUELLE, NUMÉRO SPECIAL: MÉLANGES OFFERTS À VICTOR NABHAN* (2004). Thanks to Prof. Greg Lastowka for making me rethink some of the contentions made in the earlier version.

¹ 123 S. Ct. 2041 (2003).

services » prohibited by section 43(a) of the Lanham Act.² But, in *Dastar*, the Supreme Court rejected the application of this text. According to the Court, the term « origin of goods » is limited to the producer of physical copies of works of authorship ; it does not apply to those works' intellectual origin.³

Now deprived of their principal legal means to enforce attribution rights, US authors, particularly those not party to collective bargaining agreements that cover attribution rights, may be effectively without protection. I have elsewhere criticized the *Dastar* Court's analysis, and have urged amending the Copyright Act to provide express recognition of the attribution right.⁴ This time, however, I propose to reconsider the foundation for the attribution right ; I will suggest that, contrary to the usual characterization of this right as flowing from the creative act, the attribution right *also* properly derives from trademark law, because the author's name gives her work a brand image that informs consumers' choices of literary and artistic works.

I

Let me make clear that I do not dispute the traditional copyright taxonomy, according to which two series of rights, moral and economic, vest in the author upon the creation of the work. I recognize that the work's creator, whatever her employment situation, should be entitled to name recognition, merely for having created the work. This recognition can be justified from different philosophical points of view. From a Franco-German perspective, the entitlement flows from natural rights theories that confer ownership prerogatives over the fruits of intellectual labor. From an Anglo-American vantage, the recognition of the author's name should encourage her to produce works of authorship, and thus should advance the broader public interest in the progress of knowledge. In either case, however, the justification, even if animated by the public interest, focuses on the author.

But the author is not the only party in interest. There is also her public. In that regard, the author's name functions like a trademark.⁵ The author's name is in fact a term that « identifies and distinguishes » goods or services, that allows consumers to choose among works of authorship on the basis of past experiences with other works by the same author or on the basis of the author's reputation. When the public encounters the author's name, for example, on a book jacket or in film credits, it expects the work to demonstrate certain qualities. A consumer might say, « I liked So-and-So's last novel ; I think I'll try the new one. » Or « This director's films are well-regarded, I think I'll see for myself.» This thought process

² See *Gilliam v. ABC*, 538 F.2d 14 (2d Cir. 1976); *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981); *Lamothe v. Atl. Recording Corp.*, 847 F.2d 1403 (9th Cir. 1988)

³ 123 S.Ct. at 2047–48.

⁴ See *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 Hous. L. Rev. 163 (2004).

⁵ For a more detailed discussion, see, e.g., F. Gregory Lastowka, *The Trademark Function of Authorship* forthcoming 2005, B.U. L. Rev.

is no different from that of the consumer who purchases shampoo by its brand name or a designer article of clothing. The producer of the shampoo or the clothing designer both endeavor to give their goods a brand image that will on the one hand enable the consumer to identify the goods and relate them to his past experiences, and on the other confer a certain « cachet » to the trademark, a « cachet » that comes as much from advertising as from any inherent qualities of the goods. In either event, whether or not the consumer is lured by the attractive advertising, he will end up associating the trademark not only with certain goods, but also with a lifestyle, or with a variety of physical or emotional qualities he finds desirable.

The same can be said of the name of the author. One might go even further and assert that in the relationship of the author and her public, what matters is not so much the work's creation as its association with the author, whoever may in fact be the creator. Hence the resort to ghostwriters who create, while the person whose name adorns the work garners the glory (and the loyalty of the public to « her » future works). From a trademark point of view, the « author » is the person who presents herself as such, who succeeds in persuading the public that her personality pervades the work, even if someone else wrote it.

I am not making this up. On the contrary, I am drawing the legal conclusions of a literary controversy (which nonetheless ended in a lawsuit⁶) between the writer Alexandre Dumas, père, and his principal assistant, Auguste Maquet. This controversy formed the subject of a play presented last year in Paris, *Signé Dumas*, by Cyril Gely and Eric Rouquette. In the play, Dumas argues with Maquet, who is demanding more money, and threatening to reveal that the « true » author of Dumas works, the « real Dumas » is himself, Auguste Maquet. Dumas expresses his immense disdain for Maquet's pretensions:

Dumas

And since when am I no longer the author of my works?

Maquet

At least since we've been working together. . . .

Dumas

You pretend to be the author of my works? You!

Maquet

Yes.

Dumas

And you have the gall to say that to my face ! Author . . . But you don't even know what the word means! . . .

⁶ See Paris Court of Appeals, decision of November 14, 1859 (Maquet c. Dumas), 1859 Ann. Prop. Ind. 390.

Maquet

I do. The author is the one who invents, who imagines. He is the only one who may assert the paternity of the works.

Dumas

What do you mean « paternity »? Which paternity? The paternity is mine, Maquet!

Maquet

And why would that be?

Dumas

Because I'm the one who signs. . . .

Maquet

Who said that signing equals paternity?

Dumas

Everyone. The signature designates the author. That's all there is to it.⁷

So there it is, bright and clear: to be an author is to say one is.⁸ Because Dumas holds himself out to his public as the author of his works, he becomes the author in fact. Later on in the play, Dumas explains why he deserves to be called the author: because his works embody him, because the public sees in them (or thinks it sees in them) the outsized personality of Alexandre Dumas:

[He goes to the book case and points out his works.] . . . [He opens a book.]
When [my readers] open one of these books, do you know what they find there, Maquet? My heart. Mine. I can die tomorrow, my heart will continue to beat for centuries. Where is your heart, Maquet? Where? Not between these pages! Nor in this bookcase! It's nowhere. You don't have a heart. You don't know what it is to give of oneself. To give with one's heart. And you never will know. You see this book, well, I touch the person who reads it. And in return I am loved. *[He closes the book.]* And when the reader closes the book, I am a part of his life. Forever. Me and me alone. That's all that matters. That is the sole reason for this book. That's what makes me the author. And who cares by what means, who cares that people learn that I needed a Maquet . . .⁹

Watching the play, it is clear that Dumas delivers this assertion -- which, taken out of context, might seem extraordinarily cynical -- straight from the heart.

⁷ Cyril Gely, Eric Rouquette, *Signé Dumas* pp. 80-82, (Les éditions nouvelles 2003) (translation mine).

⁸ This assertion is not unknown to copyright law, see, e.g., Berne Conv. Art. 15.1 (presumption of authorship). See also Part II, *infra*.

⁹ *Signé Dumas*, pp. 88-89.

The personality of Dumas invests the *Musketeers*, *The Count of Monte Cristo*, etc., even if to a significant extent Maquet is the one who wrote those books. One might think this a parody of the classic French concept of originality as manifesting the impress, or handprint, of the author's personality, in a situation in which the putative author's hand is absent. The impress of the author's personality becomes a pressing into service of another writer's labors. But, according to the Dumas portrayed in the play, he who has written the words, who has plotted the action, who has drawn the characters, is merely a miserable « pen-pusher », ¹⁰ while it is he, Dumas who, in signing the work, invests it with the force of his being. Little matter if someone else built the house, he lives there, and because he will have lived there, the house becomes his forever in the public's mind. ¹¹

This is a theory of authorship that recalls the concept of famous marks. When the public encounters the mark « Coca Cola » on a merchandising property such as a teeshirt or a glass, it will not necessarily believe that an executive in the Atlanta headquarters produced or even conceived of these goods (which were probably made under license). But in the consumer's mind these goods will be adorned with the attractions of the mark. The person who wears the teeshirt basks in the reflection of youth, vigor, and insouciance associated with « Coca Cola » and the lifestyle the mark evokes. By the same token, it is the image of Dumas, of his overweening personality, that draws the public to « his » works, even if he didn't write them. Or, to employ the historical Dumas' own words, « Each work ceases after a while to bear the mark of the collaborator, and becomes personal to the one who puts his name on it. » ¹² The proof: the works that Maquet wrote – and signed – after his definitive break with Dumas, did not encounter the success of the works Dumas signed. Even though Maquet claimed (at least in the play) to « do Dumas better than Dumas himself. » ¹³

The comparison with trademarks is unavoidable, even if it might ruffle moral rights traditionalists: the same factory makes two pairs of identical trousers, but only one bears the designer label. Two functionally identical articles, but all the affective difference resides in the presence or absence of the famous brand name. One expects the public to go for the trousers with the trademark.

II

¹⁰ Id. p. 89.

¹¹ See id. p. 89 (where Dumas evokes a château which will always be known as his, even if he no longer lives there).

¹² Letter 29 of Alexandre Dumas, April 1840, p. 120, quoted in <http://fr.groups.yahoo.com/group/langue-fr/message/15309> (visited April 25, 2005).

¹³ *Signé Dumas*, p. 87. On the other hand, the historical Dumas may in fact have written more than the play, or Dumas himself, purported. See, e.g., Alexander Lindey, PLAGIARISM AND ORIGINALITY 225 (1952):

The truth is that Dumas was anything but a false-front. His “collaborators” weren't collaborators at all; they merely supplied him the clay into which he infused miraculous life. August Maquet, said to be the ablest of Dumas' helpers, wrote on his own, too. Without the master, Maquet was nothing. Without Maquet, Dumas was still Dumas.

In the *Maquet c. Dumas* lawsuit, the Tribunal de la Seine, in a decision affirmed by the Paris Court of Appeals, dismissed Auguste Maquet's claim to revoke his transfer of copyright in the books he wrote in common with Dumas. The court also rejected Maquet's demand to be recognized as the works' coauthor. According to the trial court, which apparently did not understand that the « right of paternity » would be deemed perpetual and inalienable (we are in 1858 ; it would take a few more years for French judges to invent a hardier *droit moral*), the author's name is freely tradeable like any other article in commerce:

The name of the author and the coauthor of literary and scientific works, as applied to those works, is subsidiary to those works and bears the legal characteristic of purely private property; as a result, the name may be the subject of contractual agreement, and may be left off the book titles, if that is what the author and coauthor contracted for.¹⁴

Having contracted with Dumas to renounce any recognition of his own name, in return for book royalties, Maquet may not now be heard to complain of his deal, which the two parties knowingly and freely entered into, and which Maquet had even cited in a letter sent to Dumas in 1845 praising this arrangement in the most expansive (not to say servile) terms.¹⁵

What is one to make of this exchange, in which the party who has consented to a well-paid anonymity is refused the right to repent of his deal? Such a result would be inadmissible in French copyright law today.¹⁶ It is, by contrast, completely permissible in the US, where the ghostwriter gives up by contract a right which he probably did not have in any event, the attribution right not being generally recognized in US copyright law.¹⁷ From the point of view of moral rights, at least in France, the author must forever retain the right to claim name recognition. But, as Professors André and Henri-Jacques Lucas point out, preserving the « free revocability of a renunciation » of authorship credit is not the same thing as declaring any renunciation null and void. By avoiding the latter course, French courts leave open the way, at least in theory, for a co-contractant to demand indemnification when, having been paid for his silence, the ghostwriter's revocation entails the loss of at least part of the value of the deal.¹⁸ It would follow that, despite the officially inalienable character of moral rights, the market for waivers (as opposed to transfers) of moral rights does not violate public policy. As a result, the ghostwriter's employer enjoys the opportunity to pass himself off as the author. An opportunity in principle precarious, because it may be defeated by

¹⁴ 1859 Ann. Prop. Indus. p. 395.

¹⁵ The text of this letter is reproduced at page 392, 1859 Ann. Prop. Indus.

¹⁶ See, e.g., Paris Court of Appeals, decision of February 1, 1989 (*Anne Bragance c. Michel de Grèce*), 142 RIDA 301, note Sirinelli.

¹⁷ Even where US copyright law adopts a very limited moral right, respecting « works of visual art », the law also allows for waivers, under the terms set out in the Act, see 17 U.S.C. § 106A(e).

¹⁸ See A. Lucas et H.-J. Lucas, *TRAITE DE LA PROPRIETE LITTERAIRE ET ARTISTIQUE*, pp. 332-33 (2d ed. 2001) (referring as well to the « right of repentance » set out at Code of intellectual property, art. L. 121-4).

the ghostwriter's right to claim authorship, but perhaps more robust than theory would suggest, even without a claim for indemnification, at least where the ghostwriter hopes for subsequent employment of a similar kind.

But what about the public? If renunciations of the right to claim authorship are consistent with even French copyright law, can the same be said of trademark and unfair competition law?¹⁹ When the commissioning party passes himself off as the author, is there not commercial fraud? Is not the consumer lured into error regarding the true source of the work? One might reconcile the public interest with the creator's by reference to US trademark law. Even after *Dastar*, to substitute another name for the creator's could violate a related Lanham Act provision forbidding false representations, in commercial advertising or promotion, of the nature, characteristics, or qualities of goods or services.²⁰ In this case, the « product » would be the work of authorship, and the creator's name would be an essential quality or characteristic.²¹ If the public is entitled not to be misled as to the correct percentage of tomatoes advertised in a can of tomato sauce, it should equally be entitled to know who is the true creator of a work of authorship—who, in Gely and Rouquette's formulation, is the « real Dumas. »

But, then, who was the « real » Dumas? In terms of trademarks, one might assert that the « real » Dumas is the one whose personality informs the books that are written by others, but that are created under his control. That would be no different from the rules governing trademark licenses: at least in the US, the person who benefits from an exploitation's « goodwill » is not the licensee who produces goods under the mark, but the owner of the mark, who will, in principle, have dictated the broad outlines of the exploitation and will have exercised control over

¹⁹ « Trademarks » here refers to the US concept, which unites under the term « trademark law » concepts which in other legal systems might be treated separately as unfair competition law.

²⁰ See 123 US at 2050, citing, Lanham Federal Trademarks Act, § 43(a)(1)(B). This may be an overly hopeful interpretation of the Court's reference to the “false representation” claim, however. The Court evoked a deceptive description of the qualities of the goods: *Dastar* might be liable if it advertised its version as “quite different,” when in fact it was largely the same. By the same token, one might contend that if *Dastar* had significantly altered the contents of the films, but promoted them as the unaltered work of Fox, a § 43(a)(1)(B) claim might lie. See 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 27:77.1, at 27-149 (4th ed 2003). As a result, *Monty Python*-like claims to protect the integrity of works of authorship, see *Gilliam v. ABC*, 538 F.2d 14 (2d Cir. 1978) (broadcasting truncated version as “Monty Python's Flying Circus” when the authors did not authorize the removal of approximately 1/3 of the content of the show, violates § 43(a)'s prohibition on false designations of origin), may survive *Dastar*. As for the right of attribution, if the name of the author is considered part of the “nature, characteristics or qualities” of the work, then listing someone “quite different” as author might come within § 43(a)(1)(B)'s current scope. But see David Nimmer, *The Moral Right Against Academic Plagiarism (Without a Moral Right Against Reverse Passing Off)*, 54 DePaul L. Rev. 1, 42 (2004) (this interpretation “reduces everything the court said to a jejune exercise in pleading”); on the other hand, see *id.* at 43-44 (where misrepresentation of authorship is material to purchasing decision, “blatant falsehood” in advertising the names of the creators or performers could still give rise to liability under § 43(a)(1)(B) even post-*Dastar*).

²¹ Although the Court stated that a “false representation” claim remained available, at least with respect to the advertised description of the qualities of the goods, the assertion may be inconsistent with the Court's interpretation of “goods” as meaning physical copies, rather than intellectual output. See *The Right to Claim Authorship*, *supra* note 4, at 273.

the quality of the licensed goods.²² Whether a book or a can of tomato sauce is at issue, the exercise of control over the contents of the goods bearing the mark is the essential task of the trademark owner.

This notion is not unknown to copyright law. For example, where the employer is the initial copyright owner of employee-created works, this result has been justified, even in civil law countries, on the ground that whoever exercises control over the exploitation, and presents him- or herself as the source of the work is the person with whom the public associates the work.²³ More broadly, one may assert that the « author » is the person who conceives and controls the execution of the work.²⁴ US courts, for example, have recognized that a printer who gave concrete form to a work but played no role in the conception of the work was not the « author » of the resulting creation.²⁵

By the same token, French courts have distinguished between « authors » and « mere executors », persons who only carry out others' instructions. Thus, while French law lists directors among the presumptive « authors » of audiovisual works, this presumption has been rebutted when the producer proved that the directors merely followed specific and detailed instructions so that each director's contribution would be uniform. The court held that « everything which characterizes creative freedom and the personality of the author eluded these directors, who were the mere executors of the producer's will. »²⁶

Moreover, some commercial falsehoods are not only tolerated, but implicitly protected by copyright law. After all, what is a pseudonym?²⁷ Is it not the

²² See Lanham Act § 5 (exploitation by a « related company » benefits the trademark owner), § 45 (definition of « related company » as any person whose use of the mark is controlled by the trademark owner as to the nature and quality of goods produced under the mark.).

²³ See Jacqueline Seignette, CHALLENGES TO THE CREATOR DOCTRINE: AUTHORSHIP, COPYRIGHT OWNERSHIP AND THE EXPLOITATION OF CREATIVE WORKS IN THE NETHERLANDS, GERMANY AND THE UNITED STATES p. 100 & nn. 19-22 (1994).

²⁴ For a fuller exposition of this characterization, see Jane C. Ginsburg, *The Concept of Authorship in Comparative Copyright Law*, 52 De Paul L. Rev. 1063 (2003).

²⁵ See *Andrien v. Southern Ocean County Chamber of Commerce*, 927 F.2d 132 (3d Cir. 1991). See also *Lindsay v. RMS Titanic*, 52 USPQ2d 1609 (SDNY 1999) (director, nt camera operators, deemed the « author » of underwater filmed sequences that the director meticulously detailed, but did not himself film).

²⁶ Court of Appeals of Poitiers, 3d chamber, decision of December 7, 1999 (SARL Chamelu et SA Editions Atlas c. Cts Chaye) (unpublished, cited in JCP LA SEMAINE JURIDIQUE ENTREPRISE ET AFFAIRES, No. 36, 7 Sept. 2000, Chronique, p. 1375). See, Court of Cassation. First civil chamber, decision of November 13, 1973 (Cons. Renoir c. Guinot), Dalloz 1974, Jurisprudence p. 533-536 (note Colombet) (recognizing co-authorship status of a sculptor hired by Renoir to make sculptures based on Renoir's drawings); Tribunal de Grande Instance of Paris, 3d chamber, decision of January 21, 1983 (Valluet c. Vasarely), Dalloz 1984, Sommaires Commentés, p. 286-87 (painting executed by Vasarely's assistant deemed the work of the assistant alone, because Vasarely's instructions were too vague); Court of Cassation, first civil chamber, decision of February 22, 2000 (Hemsi c Laurin et autres), EDITIONS DU JURIS-CLASSEUR, COMMUNICATION ET COMMERCE ELECTRONIQUE, June, 2000, p. 17-18, note C. Caron (researcher hired to prepare a catalogue raisonné held not entitled to co-authorship status because she neither conceived nor developed the organization of the catalogue, nor selected the works included nor wrote the catalog's notes).

²⁷ The French Code of intellectual property protects pseudonyms, see art. 113-6.

evocation of a false personality to identify the source of the work ? The « author » who enjoys her public's loyalty is merely a construct designed to hide the true identity of the creator. A sometimes necessary falsehood, for example in the 19th century, to deceive publishers regarding the author's sex. Nonetheless, the pseudonym is perfectly consistent with trademark law, because it is indeed the brand name under which the creator offers her works. From the point of view of trademark law, the relevant information is the name under which the product is sold, whether or not an actual person bears this name.

The concept of authorship can therefore be summarized as entailing control over the carrying out of the creation, rather than the act of creation as such. In trademark law, the concept fits, for the person who controls the production of the goods is responsible for their quality: the trademark owner is answerable to the public if the qualities of the goods bearing the mark are not what they are claimed to be. In copyright, however, the same concept could logically lead to depriving any employed creator, as well as a fair number of freelancers, of authorship status, because the employer or commissioning party will usually have the last word regarding the form or content of the creation. It is therefore necessary to propose a more nuanced test: if the creator has enjoyed autonomy in the creative process, even if the work was made on demand, the creator has engaged in intellectual labor that should be recognized. Any other approach would end up denying the role of creativity in copyright.

In the end, does trademark law have a role to play in the attribution of authorship status? Is it appropriate to take into account the public's expectations regarding the « author »'s identity? Would this not result in allowing the stronger party to usurp authorship status, for the co-contractant who compels the actual creator's anonymity will successfully pass itself off as the author. To be an author it would suffice to say one is, by signing the work. But to deny the pertinence of trademark law to authorship attribution would lead to another anomaly: Alexandre Dumas would not have been the author of his works.