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Moral Rights in the US: Still in Need of a Guardian Ad Litem

Jane C. Ginsburg*

Abstract

Over ten years ago in the Cardozo Arts and Entertainment Law Journal, I inquired whether authors' "moral rights" had come of (digital) age in the US. Ever-hopeful at that time, I suggested that then-recent legislation enacted to enable the copyright law to respond to the challenges of digital media might, in addition to its principal goal of securing digital markets for works of authorship, also provide new means to protect authors' interests in receiving attribution for their works and in safeguarding their integrity. The intervening years' developments, however, indicate that, far from achieving their majority, US authors' moral rights remain in their infancy, still in need of a guardian ad litem. Nor is it clear what legal institution can assume that role. Judicial interpretation of the Digital Millennium Copyright Act underscores that text's limited utility as a legal basis for attribution rights. Moreover, the US Supreme Court's 2003 decision in Dastar v Twentieth-Century Fox has probably left authors worse off, because the Court removed recourse to the Lanham Trademarks Act as a source of attribution (and perhaps, integrity) rights. If statutes and caselaw afford no general basis of moral rights, might the convergence of contract law and digital communications yield agreements, private in form but public in impact, that collectively approximate attribution and integrity rights?

This assessment of developments in moral rights in the U.S. since 2001 will first analyze the caselaw construing section 1202 of the DMCA, which prohibits removal or alteration of "copyright management information." It will next summarize the damage Dastar has done to the development of moral rights. Finally, I will consider the extent to which online contracts and practices may supply an effective basis for the assertion of attribution and integrity rights. De facto implementation of attribution rights through digital watermarking and other means of incorporating authorship information in connection with the communication of digital copies or performances of work make possible the recognition of many levels of creative contributions, but without a

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legal obligation to credit creators, it is unclear whether authorship information will remain connected to the copies of their works. Regarding integrity rights, respect for the work as the author created it may, in the absence of enforceable legal or contract norms, yield to online users' preference for "remix." In that light, an alternative moral right of the author, proposed by Prof. Jessica Litman, and recounted in the previous AELJ essay, to compel comparison of the altered version with the original by obliging the modifying user to link back to it, is better than nothing. But, without a legal obligation to disclose alterations or link back to the original, the prospects for even this weakened integrity right do not presage imminent adolescence, much less a vigorous adulthood, for moral rights in the US.

I Introduction

Over ten years ago, in the pages of this Journal, I inquired whether authors' "moral rights" had come of (digital) age in the US.¹ Ever-hopeful at that time, I suggested that then-recent legislation enacted to enable the copyright law to respond to the challenges of digital media might, in addition to its principal goal of securing digital markets for works of authorship, also provide new means to protect authors' interests in receiving attribution for their works and in safeguarding their integrity. The intervening years' developments, however, indicate that, far from achieving their majority, US authors' moral rights remain in their infancy, still in need of a guardian *ad litem*. Nor is it clear what legal institution can assume that role. Judicial interpretation of the Digital Millennium Copyright Act underscores that text's limited utility as a legal basis for attribution rights. Moreover, the US Supreme Court's 2003 decision in *Dastar v Twentieth-Century Fox*² has probably left authors worse off, because the Court removed recourse to the Lanham Trademarks Act as a source of attribution (and perhaps, integrity) rights. If statutes and caselaw afford no general basis of moral rights, might the convergence of contract law and digital communications yield agreements, private in form but public in impact, that collectively approximate attribution and integrity rights? Or will the shortcomings of "viral" contracts temper cyber-utopian enthusiasms, once again disappointing expectations in the ability of the regulation of digital media to secure authors' rights?

This assessment of developments in moral rights in the U.S. since 2001 will first analyze the caselaw construing section 1202 of the DMCA, which prohibits removal or alteration of "copyright management information." It will

¹ Jane C. Ginsburg, *Have Moral Rights Come of (Digital) Age in the United States?*, 19 *Cardozo Arts & Ent. L. J.* 9 (2001).

² *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

next summarize the damage *Dastar* has done to the development of moral rights.³ Finally, I will consider the extent to which online contracts and practices may supply an effective basis for the assertion of attribution and integrity rights.⁴

II Protection of Copyright Management Information as a Source of Attribution and Integrity Rights

In my previous AELJ contribution, I posited “Moral Rights for the Digital Millennium,”⁵ primarily on the basis of section 1202’s prohibition on the removal or alteration of “copyright management information.” My prior analysis nonetheless acknowledged the limited firepower of section 1202 in the moral rights arsenal. For one thing, while the author’s name can be an element of statutorily protected copyright management information (CMI), the rightholder has no obligation to include the author’s name in the first place (though if it is included, it might be protected against removal). Equally if not more significantly, section 1202 prohibits removals or alterations of CMI that facilitate copyright infringement, but (outside the extremely narrow context of the Visual Artists Rights Act) there is no right under copyright to authorship attribution; thus removal of the author’s name cannot of itself violate section 1202.⁶ Since the

³ This discussion derives from the analyses in Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademark Law*, 41 Hous. L. Rev. 263, 284--85 (2004) and the 2011 Cumulative Supplement to Jane C. Ginsburg, Jessica Litman and Mary L. Kevlin, TRADEMARK AND UNFAIR COMPETITION LAW (4th ed. 2007).

⁴ For a more extensive evaluation of one aspect of this issue, see Mira T. Sundara Rajan, *Creative Commons: America’s Moral Rights?*, 21 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 905 (2011).

⁵ Ginsburg, *supra* note 1, at 11--12.

⁶ While the copyright owner, not the author (unless she is also a copyright owner), determines whether to affix CMI attributing the work to its creator, the author might have standing to bring a CMI claim for removal or alteration of authorship attribution. Section 1303(a) provides that “any person injured by a violation of 1201 or 1202 may bring a civil action . . .” Is the author “injured” by removal of her name? Arguably, the only “injured” party is the copyright owner, because a CMI violation results from actual or prospective copyright infringement. In that case, even if the right holder includes the author’s name, and a third party removes it, the author will have no claim against the removal of her name if she is not also a copyright owner. As a result, creators of works made for hire would have no standing to bring a CMI action unless the employer or commissioning party transfers exclusive rights to the creator. Similarly, an author who has assigned all copyright interests without retailing a royalty interest would lack standing, while those who received royalties would be “beneficial copyright owners and could sue for infringement, see 17 U.S.C. sec. 501(b).

If, by contrast, “injury” sweeps more broadly to cover non-copyright interests implicated by CMI (including, perhaps, consumer interests in the accuracy and reliability of terms and conditions of payment for access to or copies of works), then non copyright owner authors might advance a CMI claim. For example, with respect to violations of the section 1201 right against distribution of devices designed to circumvent technological measures protecting access to and copying of the work, courts have recognized that the producers of the technological protection measures have standing to sue the distributors of the circumvention devices. See, e.g., *RealNetworks v. Streambox*, 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. Jan. 18, 2000). But in that instance, the interests of the copyright owners and of the producers of the technological measures are aligned. In the case of removal of authorship attribution, by contrast, author and rightholder interests may in fact be opposed, but it seems clear that if the rightholder removes

AELJ article, caselaw has further reinforced the statutory barriers (and even erected some new ones) to successful invocation of section 1202 to advance authorship attribution rights.

The caselaw has addressed three issues: What is “copyright management information”?; Where must copyright management information appear in order to be protected?; and What level of knowledge or intent violates section 1202? Regarding the first question, courts have divided over whether only identifying information that is part of an “automated copyright protection or management system” can be deemed CMI protected under section 1202.⁷ In those jurisdictions confining section 1202’s application to automated systems, authors will have no claim if their names are removed from non digitally-delivered hardcopies. This truncation of the scope of CMI protection ignores the text of section 1202, which plainly envisions a broad application for CMI; section 1202(c)(2) defines CMI as “any of the following information conveyed in connection with copies or phonorecords of a work or performances or displays of a work, including in digital form, except that such term does not include any personally identifying information about a user of a work or of a copy, phonorecord, performance, or display of a work . . .” The specification of “including in digital form” clearly means that information not in digital form is also covered. Some courts nonetheless justified their improbable reading of “including” to mean “only if” (and in addition, only if the digital information is part of a rights management system) on the ground that section 1202 was enacted as part of the *Digital Millennium Copyright Act*; that the title of the chapter to which § 1201 and § 1202 belong is “Copyright Protection and Management Systems;” and that Congress’ goal in section 1202 was to foster electronic commerce. As the Third Circuit recognized, however, that section 1202 emerged from a context of legislative responses to the challenges of digital communications neither precludes a more general role for CMI, nor compels such a substantial rewriting of the definition. Thus, the statutory text does not justify this judge-made limitation on the application of section 1202 to authors’ attribution interests.⁸

A broad reading of CMI to include author-identifying information on analog as well as digital copies, and whether or not in connection with a rights management “system,” could mean that removal or alteration of a copyright notice bearing the author’s name, or of an author’s byline, even from analog copies, violates section 1202. Removal standing alone, however, does not suffice. It is also necessary to consider what “conveyed in connection with copies or

authorship attribution, the author (absent a contract obliging the rightholder to attribute the work) has no CMI claim against the rightholder.

⁷ Compare *IQ Group v. Wiesner Pub., LLC*, 409 F. Supp. 2d 587 (D.N.J. 2006); *Textile Secrets Int’l, Inc. v. Ya-Ya Brand, Inc.*, 524 F. Supp. 2d 1184, 1198 (CD. Cal. 2007) (CMI must be related to automated system) with *Murphy v. Millennium Radio Group LLC*, 650 F.3d 295(3d Cir. 2011); *Agence France Presse v. Morel*, 769 F. Supp. 2d 295 (S.D.N.Y. 2011); and *Cable v. Agence France Presse*, 728 F. Supp. 2d 977 (N.D. Ill. 2010) (declining to read such a limitation into section 1202).

⁸ *Murphy v Millennium Radio Group*, 650 F.3d 295, 305 (3d Cir. 2011).

phonorecords of a work or performances or displays of a work” means, and, most importantly, whether the complaining author can surpass the statute’s high threshold for proving the requisite intent.

Regarding the location of CMI, some courts have interpreted “in connection with” to require that the identifying information be embedded in the copy or phonorecord of the work,⁹ while others have rejected such a narrow view.¹⁰ Again the language of the statute does not command incorporation of the CMI in the copy of the work: “conveyed in connection with” does not mean “on copies,” and if a “performance of a work” is involved, embedding may not be possible. Of particular relevance to authors, if the object of the transaction is a display of an artwork, its creator, understandably, may not wish to embed visually-perceptible CMI in the image. If the statute aims to provide reliable information regarding the identity of the work, of its author, and of the terms and conditions of its exploitation, it would seem that providing the information in ways that do not imperil the integrity of the work could still meet Congress’ objectives. At least one court, however, has stated that “if a general copyright notice appears on an entirely different webpage than the work at issue, then that CMI is not ‘conveyed’ with the work and no claim will lie under the DMCA.”¹¹ In that case, the plaintiff alleged that the defendant copied poems from plaintiff’s website and displayed them on the defendant’s own site. The plaintiff argued that the defendant had, by placing copyright notices on the parts of its own site that contained the allegedly infringing poems (thereby attributing to itself the authorship of plaintiff’s poems), supplied false CMI in violation of § 1202. While the court held that plaintiff’s assertion that defendant’s placement of a copyright notice directly within the title of one of the allegedly copied poems stated a claim for relief under the DMCA, it also ruled that the more remote location of a copyright notice relative to the other allegedly copied poems did not “convey” the CMI “with” the other alleged infringements. In requiring that the false CMI be “conveyed with” the infringing works, the court seems to be reading “conveyed *in connection* with” out of the statute. The former, incomplete, reading suggests the CMI must be amalgamated with the work; the latter leaves room for more distant placement, although the more clicks required to access the CMI, the less likely a court may be to find even a connection between the work and its “conveyance” to the end user.

Finally, many CMI claims against alteration or removal of authorship attribution are likely to founder on the statutory double intent standard. Under section 1202(b), the wrongful act is not simply removing the attribution, or distributing or publicly performing or displaying the work without the attribution.

⁹. Kelly v. Arriba Soft Corp., 77 F.Supp.2d 1116 (C.D.Cal.1999), *aff’d.*, 336 F.3d 811 (9th Cir. 2003) (information on photographer’s webpage, not on individual photographs); Schiffer Pub., Ltd. v. Chronicle Books, LLC, 73 U.S.P.Q.2d (BNA) 1090 (E.D. Pa. 2004) (information on inside cover of book, not on individual photographs)

¹⁰. BanxCorp v. Costco Wholesale Corp., 723 F.Supp.2d 596 (S.D.N.Y. 2010); *See also* Agence France Presse v. Morel, 769 F.Supp.2d 295 (S.D.N.Y. 2011) (citing *BanxCorp* in declining to decide significance of CMI location on motion to dismiss).

¹¹ Personal Keepsakes, Inc. v. Personalizationmall.com Inc., No 11 C 5177, 2012 WL 414803, at *7 (N.D. Ill. Feb. 8, 2012).

The statute also requires that those who distribute, perform or display the work (1) have known that the attribution was removed or altered without the copyright owner's authorization, *and* (2) that those who remove or alter the attribution, or who distribute or perform works whose attribution has been removed or altered, do so "knowing, or . . . having reasonable grounds to know that it will induce, enable, facilitate, or conceal an infringement of any right under this title." Thus, even intentional removal or alteration of authorship attribution is not unlawful if the copyright owner cannot show that the person who removed or altered the information knew that the removal would encourage or facilitate copyright infringement.¹²

The cases suggest that the second level of intent is most likely to be established when the defendant, having removed or altered the CMI, distributes the work without the accompanying information (or with altered information) to third parties, who will in turn make the work available to the public. Thus, in *McClatchey v. AP*,¹³ in rejecting the AP's motion for summary judgment, the court held:

Under Plaintiff's version of the facts, AP intentionally cropped the copyright notice out of the picture before distributing it to subscribers. This appears to be precisely the conduct to which Section 1202(b) is directed. As Plaintiff notes, the nature of APs' business is to provide stories and pictures for use by its members and subscribers. Thus, a reasonable factfinder could conclude that by cropping out the copyright notice, Defendant had the requisite intent to induce, enable, facilitate or conceal infringement.¹⁴

While *McClatchey* concerned removal of a copyright notice, the decision is relevant to authorship attribution claims, because copyright notices often bear the author's name. In addition, even where the work did not include a copyright notice, intentional removal of the author's name and redistribution of the work can facilitate infringement, at least where the work circulates without other information that indicates to intermediary distributors from whom to seek permission to exploit the work.

By contrast, where the person removing the authorship attribution has directly distributed the work to the public, it may be more difficult to show that the removal or alteration will facilitate copyright infringement, because it may be necessary to show that the defendant knew or should have known that end-consumer recipients would be induced by the absence or alteration of the author's name to infringe the work. Absent evidence that the distributor expected end-users in turn to redistribute, for example through file-sharing, the statutory standard may often prove insuperable. As a result, on the whole, section 1202 does not afford authors a very effective vehicle to ensure the maintenance of authorship attribution.

¹². See, e.g., *Gordon v. Nextel Comms.*, 345 F.3d 922 (6th Cir. 2003); *Kelly*, 77 F. Supp. 2d 1116; *Schiffer*, 73 U.S.P.Q.2d (BNA) 1090.

¹³. 82 U.S.P.Q.2d 1190 (W.D. Pa. 2007). See also *Banxcorp*, 723 F. Supp. 2d 596; *Jacobsen v. Katzer*, 609 F.Supp.2d 925 (N.D. Cal. 2009).

¹⁴ *McClatchey* 82 U.S.P.Q. at 1196.

III *Dastar* and the Death of Attribution (and Integrity?) Rights Under the Lanham Act

For a time, it seemed as if the Lanham Federal Trademarks Act partially provided for a right of attribution: by making false and confusing designations of origin actionable, the Act--many thought--afforded authors relief against misattributions of authorship.¹⁵ Even so, the trademarks law would only have reprimanded giving credit to one to whom credit was not due; it would not have afforded an affirmative right to claim authorship. In other words, giving incorrect credit may have been actionable; giving no credit was not.¹⁶

In June of 2003, however, the U.S. Supreme Court interpreted the Lanham Act to deny false attribution claims as to the origin of a “communicative product” in *Dastar Corp. v. Twentieth Century Fox Film Corp.*¹⁷ In *Dastar*, the Court made clear that a work’s entry into the public domain precludes resort to the Lanham Act to achieve a de facto prolongation of exclusive copyright-like rights. In so doing, however, the Court appears to have stricken the Lanham Act from the roll of laws authors might invoke in support of attribution rights.

The facts of the case had nothing to do with authors, and were very unappealing. In 1949, Twentieth Century Fox produced a multipart television series, *Crusade in Europe*, based on then-General Eisenhower’s campaign memoirs.¹⁸ In 1977, after Fox failed to renew the copyright registration, the work went into the public domain.¹⁹ In 1995, Dastar released a set of videos, *Campaigns in Europe*, substantially copied from *Crusade*.²⁰ Dastar listed itself as the producer of *Campaigns*, without reference to *Crusade* or Fox. Fox sued, claiming that Dastar’s release of the videos under its own name constituted “reverse passing off” in violation of the Lanham Federal Trademarks Act, section 43(a). Fox contended that substituting Dastar’s name for Fox’s constituted a “false designation of origin,” because Fox, the original producer, was the originator of the *Crusade* television series that *Campaigns* “bodily appropriated.”²¹ The district court agreed and awarded Fox double Dastar’s

¹⁵ The Ad Hoc Working Group on U.S. Adherence to the Berne Convention, a group formed at State Department behest whose report was submitted to Congress, concluded that U.S. law afforded “substantial protection . . . for the real equivalent of [the] moral rights” of attribution and integrity, particularly by recourse to the Lanham Act. See Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention at 35, 39--42, reprinted in 10 Colum. J.L. & Arts 513, 547, 551-554.

¹⁶ See, e.g., *Johnson v. Jones*, 149 F.3d 494, 496, 499 (6th Cir. 1998) (claim against an architect who substituted his name for another’s on architectural plans); *Lamothe v. Atl. Recording Corp.*, 847 F.2d 1403, 1405 (9th Cir. 1988) (claim by co-author against songwriter who published music under only his name); *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir. 1981) (claim against film company who substituted one actor’s name for another in film credits).

¹⁷ 539 U.S. 23 (2003).

¹⁸ *Dastar*, 539 U.S. at 25--26.

¹⁹ *Id.*

²⁰ *Id.* at 26.

²¹ *Id.* at 28.

profits,²² thus granting Fox perhaps a higher damages award than it would have received for copyright infringement (had Fox's copyright still been in force). The Ninth Circuit affirmed in an unpublished opinion.²³ The Supreme Court reversed, 8-0 (Justice Breyer recused).²⁴

The unanimous opinion construed the statute's prohibition on "us[ing] in commerce" (selling) any "false designation of origin . . . which . . . is likely to . . . cause mistake, or to deceive as to the . . . origin . . . of his or her goods . . . by another person."²⁵ The Court held that "origin" in the sense of the Lanham Act does not mean the original creator of a work of authorship from which copies are made, but rather the source of the particular copies (goods) that are being distributed.²⁶ Thus, a reverse passing off claim "would undoubtedly be sustained if [the defendant] had bought some of [the] Crusade videotapes and merely repackaged them as its own."²⁷ But the Court rejected the contention that a different concept of "origin" should apply to a "communicative product"--a work of authorship.

Arguably, the Court's refusal to accord authors the status of "originators" of communicative works was limited to works whose copyrights had expired, rather than extending to all communicative works, whatever their copyright status. The Court referred some ten times to the copyright-expired status of Fox's television series. The Court's doubts about the validity of an interpretation of "origin" to mean "author" seem closely entwined with its concern to maintain the public domain. For example, the Court objected: "Reading 'origin' in [the trademarks act] to require attribution of uncopyrighted materials would pose serious practical problems. Without a copyrighted work as the basepoint, the word 'origin' has no discernable limits."²⁸

On the other hand, it is not clear why, under the concept of "origin" the Court attributed to the trademarks act, authors would qualify as originators of copyright-protected works. The Court's declaration that "the phrase ['origin of goods'] refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods,"²⁹ would seem to apply equally to in-copyright and copyright-expired works.

In fact, federal district court decisions have generally declined to limit *Dastar's* application to public domain works.³⁰ The list of decisions applying

²² Twentieth Century Fox Film Corp. v. Dastar Corp., No. CV98-7189, 2000 WL 35503106 (C.D. Cal. Aug. 29, 2000).

²³ Twentieth Century Fox Film Corp. v. Entm't Distributing, 34 Fed. Appx. 312 (9th Cir. 2002)

²⁴ *Dastar*, 539 U.S. at 38.

²⁵ Lanham Trademarks Act §43(a), 15 U.S.C. § 1125(a)(1).

²⁶ *Dastar*, 539 U.S. at 32--35.

²⁷ *Id.* at 31.

²⁸ *Id.* at 35.

²⁹ *Id.* at 37.

³⁰ See, e.g., Carroll v. Kahn, 68 U.S.P.Q.2d 1357, 1361-62 (N.D.N.Y. 2003) (quoting *Dastar* and *Williams v. UMG Recording* to support dismissal of "failure to attribute" claim); *Williams v. UMG Recordings, Inc.* 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003) ("[T]he Supreme Court's holding did not depend on whether the works were copyrighted or not."). For a general analysis of *Dastar's* sweeping impact, including on state unfair competition claims, see Tom W. Bell,

Dastar to rule that § 43(a)(1)(A) of the Lanham Act concerns only tangible goods, and therefore precludes claims alleging misattribution of authorship, continues to grow, particularly in the context of disputes over authorship credit for scholarly works. For example, in *Rudovsky v West*³¹ the court held the Lanham Act did not apply to claims of misattribution of authorship of a pocket part update of a legal treatise prepared by publisher's staff but partly credited to the authors of the treatise, and in *Romero v. Buhimschi*³² the court rejected a § 43(a)(1)(A) claim concerning the alleged denial of coauthorship credit to a fellow medical researcher.³³ In *Vogel v. Wolters Kluwer*³⁴ the author of contributions to the first three editions of a textbook alleged that the fourth and fifth editions incorporated his contributions but without authorship credit to him; the court dismissed the claim on the ground that a false designation of origin under the Lanham Act concerns only the provenance of the physical copies of the books, not authorship; the court also held the state law unfair competition claims preempted by the Copyright Act. Of course, *Dastar*'s impact is not limited to academic authors, as a host of decisions concerning commercial entertainment product demonstrates.³⁵

By contrast, in *Cvent, Inc. v. Eventbrite, Inc.*³⁶ the court declined to dismiss a Lanham Act claim against "reverse passing off" committed by a competitor who allegedly "scraped" plaintiff's event-planning website in order to

Misunderestimating Dastar: How the Supreme Court Unwittingly Revolutionized Copyright Preemption, 65 Md. L. Rev. 206 (2006). See also David A. Gerber, Copyright Reigns--Supreme: Notes on *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 93 Trademark Rep. 1029, 1032 (2003). ("[A]lthough *Dastar Corp.* involved reverse passing off, its sweep is much wider. The brightline rule rejecting authorial claims under §43(a) should lead to the death not only of the droit à la paternité or right of attribution but other 'moral rights' under §43(a) as well.").

³¹ 98 U.S.P.Q.2d 1595 (E.D. Pa. 2011).

³² 396 Fed. Appx. 224 (6th Cir. 2010)

³³ Id. at 232 (citing *Baden Sports, Inc. v. Molten USA, Inc.*, 556 F.3d 1300, 1307 (Fed. Cir. 2009).

³⁴ 630 F. Supp. 2d 585 (M.D.N.C. 2008).

³⁵ See, e.g., *Harbour v. Farquhar*, 245 Fed.Appx. 582 (9th Cir. 2007) (dismissing claim involving musical compositions included in television programs); *Chivalry Film Prods. v. NBC Universal, Inc.*, No. 05 Civ. 5627, 2006 WL 89944 (S.D.N.Y. Jan. 11, 2006) (screenwriter claimed producer of "Meet the Parents" copied his script and misattributed screenplay to third parties; court held *Dastar* required dismissal of misattribution claim); *A Slice of Pie Prods. v. Wayans Bros. Entm't*, 392 F.Supp.2d 297 (D. Conn. 2005) (same re film "White Chicks"); *Keane v. Fox*, 297 F.Supp.2d 921 (S.D. Tex. 2004), where the court dismissed plaintiff's claim that, as the originator of the idea of the "American Idol" television series, and developer of the "American Idol" mark, he should have been recognized and paid. The court held that Keane had not developed trademark rights in the term "American Idol." The court also ruled against any claim in the concept of the television series, citing *Dastar*: "the Lanham Act does not create a cause of action for 'plagiarism,' that is, 'the use of otherwise unprotected works and inventions without attribution.'"; *Hustlers v. Thomasson*, 73 U.S.P.Q.2d 1923 (N.D. Ga. 2004) (holding that *Dastar*'s limitation of false designation of origin claims to the producer of physical copies bars not only claims by authors, but also by publishers; the court also follows *Williams v. UMG Recordings* in holding *Dastar* not limited to works in the public domain); *Mays & Assoc. v. Euler*, 370 F.Supp.2d 362 (D. Md. 2005) (after *Dastar*, no Lanham Act claim for non-attribution of authorship of web design portfolio); *JB Oxford & Co. v. First Tenn. Bank Nat'l Ass'n.*, 427 F.Supp.2d 784 (M.D. Tenn. 2006) (no § 43(a) claim against advertiser who allegedly copied plaintiff's advertisement and substituted its name for plaintiff's).

³⁶ 739 F. Supp. 2d 927 (E.D. Va. 2010).

reproduce the information on competitor's website. In that case, however, the plaintiff also had a valid copyright claim; the court appears to have read *Dastar* as precluding "end-running" failed copyright claims, thus letting stand those Lanham Act claims that accompany a valid copyright action.

That reading, while consistent with the *Dastar* court's preoccupation with maintaining the public domain, may clash with another aspect of the decision's treatment of the relationship of copyright and trademark claims. The *Dastar* court offered as an additional reason for rejecting section 43(a) attribution claims the inclusion in section 106A of the copyright act of (very) limited attribution rights in the Visual Artists Rights Act of 1990.³⁷ VARA applies to "work[s] of visual art,"³⁸ a class confined to the original work or up to two hundred signed and numbered copies of a painting, drawing, print, sculpture, or a photographic image "produced for exhibition purposes only," so long as the work is not "made for hire."³⁹ VARA affords artists whose works fall within its restrictive definition a kind of private "Landmarks" law to preserve their works against mutilation or destruction. Attribution rights, albeit included, are not the focus of the Act. Indeed, VARA's restriction to physical originals makes that statute a very feeble measure for enforcing artists' attribution rights: a "work of visual arts" excludes mass market multiples. Thus, there is no VARA right to compel attribution for one's artwork if the artist's name has been left off anything more than the original or a signed and numbered limited edition of two hundred. And, of course, VARA does nothing for literary, musical, audiovisual, or most other authors. Nonetheless, the *Dastar* court appears to suggest that VARA's enactment promotes a negative inference that VARA is the *only* federal law locus for attribution rights: if authors already enjoyed attribution rights, VARA would be superfluous, and "[a] statutory interpretation that renders another statute superfluous is of course to be avoided."⁴⁰

The Court's characterization of VARA as "superfluous," is, however, plainly incorrect. Section 43(a) does *not* make VARA superfluous. There may be narrow areas of overlap, but VARA, in its severely constricted zone, affords a significant right that section 43(a) does not: an *affirmative* right to claim authorship, not merely a right to object to misrepresentations of authorship that confuse consumers as to the work's origin. Moreover, VARA's beneficiaries are artists, but section 43(a)'s are the consuming public, and the rationales for the laws are different: copyright is a property right protecting against copying per se; trademark law derives from the tort action of "passing off" and, in U.S. law, does not prohibit copying as such, but only copying which introduces materially false or misleading information into the marketplace. Courts addressing overlapping intellectual property claims have acknowledged that differently motivated laws may yield similar results when brought to bear on the same subject matter, yet one does not drive out the other.⁴¹

37. Visual Artists Rights Act of 1990 § 603, 17 U.S.C. § 106A (2000).

38. *See* 17 U.S.C. § 101.

39. *Id.*

40. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041, 2048 (2003).

41. *See, e.g., Frederick Warne & Co. v. Book Sales, Inc.*, 481 F. Supp. 1191, 1196–99 (S.D.N.Y.

The *Dastar* Court nonetheless may have left open two avenues within the trademarks act to vindicate creators' rights. First, the Court recognized reverse passing off claims when the defendant has "merely repackaged . . . as [his] own" goods which the defendant has not otherwise altered.⁴² Second, it preserved claims under a related section of the trademarks act. The Court stated,

If, moreover, the producer of a video that substantially copied the Crusade series were, in advertising or promotion, to give purchasers the impression that the video was quite different from that series, then one or more of the respondents might have a cause of action--not for reverse passing off under the "confusion . . . as to the origin" provision of § 43(a)(1)(A), but for misrepresentation under the "misrepresents the nature, characteristics [or] qualities" provision of § 43(a)(1)(B). For merely saying it is the producer of the video, however, no Lanham Act liability attaches to *Dastar*.⁴³

With respect to what a "mere repackaging" reverse passing off claim would cover, it is important to recognize that, notwithstanding *Dastar*'s emphasis on free copying from the public domain, not every exploitation that the copyright law might permit will escape Lanham Act condemnation. For example, the copyright law "first sale doctrine" entitles purchasers of tangible copies of a work of authorship to resell, rent, or lend those copies without the copyright owner's authorization.⁴⁴ But, even under *Dastar*, that does not mean that the Lanham Act will allow me to purchase copies of the latest Brad Meltzer or John Grisham legal thrillers and resell them under my own name. In fact, that would seem to be exactly the situation posited in the Court's caveat that a reverse passing off claim "would undoubtedly be sustained if [the defendant] had bought some of [the] Crusade videotapes and merely repackaged them as its own."⁴⁵

Nor, despite the Court's linkage of "origin" with physical copies, should the "mere repackaging" claim be limited to communication of physical copies originally manufactured by the trademarks claimant. For one thing, it would be extraordinarily formalistic were the "mere repackaging" claim confined to physical copies that *Dastar* recycles, thus excluding exact copies that *Dastar*

1979) (stating that a publisher of children's books in the public domain could bring a trademark claim against defendant's copying of particular illustrations from the book, and commenting that "[b]ecause the nature of the property right conferred by copyright is significantly different from that of trademark, trademark protection should be able to co-exist, and possibly to overlap, with copyright protection without posing preemption difficulties"); *cf.* *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (holding that federal design patent law preempts state laws protecting against copying of boat hull designs but does not preempt state laws protecting consumers against misleading presentations of products); *Kohler Co. v. Moen, Inc.*, 12 F.3d 632 (7th Cir. 1993) (holding federal trademark protection for product configurations does not necessarily conflict with federal patent law); *In re Application of Yardley*, 493 F.2d 1389 (C.C.P.A. 1974) (holding that because "Congress has not provided that an author-inventor must elect between securing a copyright or securing a design patent," the author-inventor may claim both forms of protection).

⁴² *Id.* at 31.

⁴³ *Id.* at 38.

⁴⁴ 17 U.S.C. §109(a) (2006).

⁴⁵ *Dastar*, 539 U.S. at 38.

reproduces. The “goods” at issue should be understood to be any physical reproductions, not only the ones made by the claimant. Otherwise, the statute would reach the soda company that purchased old Coca-Cola bottles (whose vintage design is undoubtedly, as a matter of copyright or design patent law, in the public domain) and refilled them with a substitute cola, but not the soda company who makes new bottles in the shape of the Coca-Cola bottle and fills them with the substitute.⁴⁶

The *Cvent* court applied the “mere repackaging” rationale to sustain the availability of a reverse passing off claim:

There is no controlling precedent in the Fourth Circuit on point, nor has this Court ever confronted this precise issue [of the post-*Dastar* subsistence of reverse passing off claims]. However, *Cvent* appears to have the better of the argument, at least insofar as its complaint does not assert that Eventbrite has passed off its ideas as its own, but rather that Eventbrite has re-branded and re-packaged its product (the CSN venue database) and sold it as its own. Admittedly, the Supreme Court's "tangible goods" language in the *Dastar* opinion is confusing, and tends to suggest that electronic products are not covered by the Lanham Act. However, the *Dastar* opinion also makes clear that the Court used that language simply to distinguish goods and products offered for sale (which receive Lanham Act protection) from any "idea, concept, or communication embodied in those goods" (which are protected only by copyright laws).⁴⁷

The *Cvent* court may have understated *Dastar*'s reach with respect to overlapping copyright and trademark claims, but the *Cvent* court is also correct that *Dastar*'s treatment of what constitute “goods” under the Lanham Act is somewhat inconsistent, if not incoherent. Sometimes, “goods” comprehend only tangible copies, such as *Dastar*'s videocassettes, but at other times, “goods” could also extend to intellectual products. The latter reading emerges from the Court's reference to subsisting section 43(a)(1)(B) claims against “false or misleading description of fact, or false or misleading representation of fact, which . . . misrepresent[] the nature, characteristics, [or] qualities . . . of his or her or another person's goods [or] services.”⁴⁸ Arguably, removing the author's or performer's name and replacing it with another's constitutes a false or misleading representation of fact (who is the author of this book; who performed in this film) that misrepresents the nature, characteristics, or qualities (authorship; performance) of the goods (the work). For purposes of section 43(a)(1)(B), then, the Court appears to have acknowledged that “goods” can mean a

⁴⁶ *Cf. id.* at 32 (stating Lanham Act “forbids, for example, the Coca-Cola Company's passing of its product as Pepsi-Cola or reverse passing off Pepsi-Cola as its product.”)

⁴⁷ *Cvent, Inc. v. Eventbrite, Inc.*, 739 F. Supp. 2d 927, 936 (E.D. Va. 2010) (citations omitted). *See also Cable v. Agence France Presse*, 728 F. Supp. 2d 977 (N.D. Ill. 2010) (copying and reselling plaintiff's photographs, stripped of plaintiff's byline, under photo agency's name states a claim for mere repackaging). A “mere repackaging” claim, however, might not lie when the defendant has not copied the entire work. *See, e.g., Personal Keepsakes, Inc. v. Personalizationmall.com Inc.*, No 11 C 5177, 2012 WL 414803 (N.D. Ill. Feb. 8, 2012).

⁴⁸ *Dastar*, 539 U.S. at 30 n.4.

“communicative work,” while, for purposes of section 43(a)(1)(A), “goods” would mean only the physical copies.

The potential availability of a section 43(a)(1)(B) claim becomes particularly significant if, after *Dastar*, the “origin” of copyrighted works is falsely designated only when physical copies are mislabeled as to their manufacture. But preservation of section 43(a)(1)(B) claims is problematic, as lower courts have recognized: if it sufficed merely to recast a “false designation of origin” claim as a “misrepresentation of the nature, characteristics or qualities” claim, then *Dastar* would be completely toothless. Thus, for example, the court in *Antidote International Films v Bloomsbury Publishing, PLC*,⁴⁹ observed: “If authorship were a ‘characteristic[]’ or ‘qualit[y]’ of a work, then the very claim *Dastar* rejected under § 43(a)(1)(A) would have been available under § 43(a)(1)(B).”⁵⁰ By the same token, the *Romero* court rejected the § 43(a)(1)(B) claim that false authorship credit falsely represented the “nature, characteristics, [or] qualities”, because these elements “refer[] to the characteristics of the good itself, rather than authorship designation.”⁵¹

Might integrity claims fare better under § 43(a)(1)(B), since they address alterations to the (intellectual) goods, rather than attribution of their “origin”? In *Gilliam v ABC*, a majority of the Second Circuit ruled that broadcasting a truncated version of “Monty Python’s Flying Circus” under the group’s name constituted a “false designation of origin” (under an earlier text of section 43(a)).⁵² One may wonder, given *Dastar*’s emphasis on physical goods, whether this decision is still good law. Professor Justin Hughes has argued that a proper reading of *Dastar* would preserve not only § 43(a)(1)(B) claims, but even some § 43(a)(1)(A) claims.⁵³ He acknowledges that the broad reading given to *Dastar* by some lower courts⁵⁴ would mean that *Gilliam*’s authority is at best precarious. He contends, however, that *Gilliam* is distinguishable because it concerned misattribution, while *Dastar* concerned nonattribution. In his opinion, it “would not make any sense” to apply *Dastar*’s “tight, physical manufacturing definition of origin” to § 43’s prohibition on false or misleading descriptions or representations of fact. *Dastar* would require, instead, a focus on issues such as “assertion versus omission, passing off versus reverse passing off, and origin versus affiliation.” Misattribution claims should be actionable after *Dastar* as long as the misattribution “can reasonably be characterized as a description or misrepresentation of fact.” Otherwise, he posits, a pornographic film that credits Steven Spielberg as the director would not be actionable --- an absurd result and “unlikely what the Court intended.”⁵⁵ By the same token, attributions of distorted versions of an author’s work would misrepresent its “nature, characteristics or

⁴⁹ 467 F. Supp. 2d 394 (SDNY 2006)

⁵⁰ *Id.* at 400.

⁵¹ *Romero v. Buhimschi*, 396 F. App’x 224, 232 (6th Cir. 2010). *Accord* *Personal Keepsakes*, 2012 WL 414803.

⁵² 538 F.2d 14 (2d Cir. 1978).

⁵³ Justin Hughes, *American Moral Rights and Fixing the Dastar Gap*, 2007 Utah L. Rev. 659.

⁵⁴ *See, e.g., Carrol v. Kahn*, 68 U.S.P.Q.2d 1357 (N.D.N.Y. 2003) ; *General Universal Sys., Inc. v. Lee*, 379 F.3d 131 (5th Cir. 2004).

⁵⁵ Hughes, *supra* note 53, at 695.

qualities.”⁵⁶ But even if § 43(a)(1)(B) integrity or attribution right claims survive *Dastar*, that provision presents an additional hurdle: the factual misrepresentation must occur “in commercial advertising or promotion.” Merely purveying or performing mislabeled works may not suffice.⁵⁷

IV Contracting Into Moral Rights?

If laws regulating digital markets for copyrighted works have failed to provide a source of protection for authors’ attribution and integrity interests, might authors marshal digital technology itself to their aid? Specifically, might authors avail themselves of the ubiquitous reach of online contracts to require recognition of their authorship status and respect for the integrity of their works? In the off-line world, an author might bind a co-contractant, usually a publisher or other intermediary distributor, to honor her moral rights, but, lacking privity with downstream exploiters, the author would have no contract claim against a sublicensee who distorted the work or failed to credit the author (though she might have a claim against the licensing publisher, if the author’s agreement required the publisher to include a moral rights clause in sublicenses and the publisher failed to do so). An online contract embedded in the work and which conditioned access to the work on the user’s clicked-on agreement to adhere to the author’s terms and conditions, however, might bind all users, whether they acquired access directly from the author’s webpage, or instead from other sources of digital dissemination, including other websites or other users.

To some extent a “viral” contract regime of moral rights already exists, through Creative Commons licenses. The default CC license requires attribution of authorship, and the author may also choose to include an “ND” (no derivatives) icon, which might serve to instruct users not to alter or modify the work.⁵⁸ But CC licenses accompany works distributed online for free. For authors who seek to earn a living from their work, obligatory gratuity may pose an insuperable shortcoming. A CC-licensed work may help introduce an author to an audience, but at some point a professional author needs to be paid. Authors thus may face the choice between respect for their names and their works, but without remuneration, or remuneration at the risk of their moral rights. More

⁵⁶ Id. at 680 (quoting Lanham Act of 1946 § 43(a)(1)(B)).

⁵⁷ *Accord*, Gillian Davies & Kevin Garnett, *Moral Rights*, 28-046 (2011) (“Simply mislabeling and selling a work without advertising the name may not constitute ‘promotion’ and the promotion itself might not always contain the alleged false representation.”)

⁵⁸ It is not clear whether the excluded “derivatives” are “derivative works” in the copyright sense, in which case the instruction might not bar all modifications or alterations, but only those which sufficiently transform the work to constitute new works of authorship. To the extent that modifications may compromise a work’s integrity without necessarily yielding a new work, the ND icon would not fully correspond to the moral right of integrity. See Sundara Rajan, *supra*, at 927. On the other hand, CC’s plain-English explanation of what ND means, “This license allows for redistribution, commercial and non-commercial, as long as it is passed along *unchanged and in whole*, with credit to you.” [cite, (emphasis supplied)], suggests a non-technical understanding of the term.

fundamentally, as Professor Sundara Rajan has eloquently explained, if CC-implemented moral rights come at the price to authors of free distribution of their works, then the overall endeavor of authorship becomes devalued.⁵⁹

The CC license may not be the only viral copyright license in town (or in some less terrestrial setting),⁶⁰ but there appear to be no equivalent licenses that also provide that the recipient of any internet-distributed copy must pay the original creator some fee. In theory, such a license could be devised, and would enforce the fee requirement through a DRM system that might, for example, prevent access to the work unless the recipient clicks through to the artist's website, agrees to the license terms and makes the payment. But the obstacles to successful propagation of such a license extend beyond the obvious problem of DRM-cracking (notwithstanding its illegality under the DMCA).⁶¹ Even assuming that access protections remained in place, authors who choose to distribute their works under what we might call an "Authorship Integrity" license will need to attract a public. Creative Commons-licensed works are easily found, thanks to a well-developed search feature.⁶² The deviser of an AI license created and simply distributed "into the wild" without the type of planning and marketing Creative Commons received would likely struggle to compile an index of works using that license and to make that index known to the public. Participation of author organizations such as the Authors Guild, the Graphic Artists Guild and the National Writers Union in an AI licensing scheme might alleviate the difficulties. Similarly, if major publishing houses were to adopt AI licenses for their works (or to recommend the use of the license to all of their authors), the license would receive significant publicity, and the creation of a database of works released under the license might become more feasible. Publisher participation, however, assumes alignment of their interests with those of authors. While the challenges of digital media may underscore a common concern for preserving the authenticity of works,⁶³ it may be overly optimistic to trust that publishers will always exploit works in perfect harmony with their authors' aspirations.

Conclusion

Over ten years after my initial speculations about the future of moral rights in the digital environment, the day that U.S. authors' rights of attribution and integrity attain their majority remains far off. The current positive law largely confines them to a Lost Boys' "Neverland." By contrast, *de facto* implementation of attribution rights through digital watermarking and other means of incorporating authorship information in connection with the communication of digital copies or performances of work makes possible the recognition of many

⁵⁹ Sundara Rajan, *supra*, at 931-936 ("The Dark Side of Open Access: Art as a Profession in Decline").

⁶⁰ Other "viral" licenses include the GNU Free Documentation License, The Free Art License, the Game System License and the Design Science license.

⁶¹ See 17 USC sec 1201.

⁶² <http://search.creativecommons.org/> including adding "CC search" to the user's browser.

⁶³ As suggested in *Have Moral Rights Come of (Digital) Age?*. See Ginsburg, *supra* note 1, at 14.

levels of creative contributions. That is, not only with respect to works by a single or a small number of authors, but also for works to which a large number of participants contribute, perhaps in a continuous manner. Whether viral contracts or voluntary online practices accomplish these attributions, their achievement seems feasible. Regarding integrity rights, however, respect for the work as the author created it may, in the absence of enforceable legal or contract norms, yield to online users' preference for "remix." In that light, an alternative right of the author, posited in the previous essay,⁶⁴ to compel comparison of the altered version with the original by obliging the modifying user to link back to it, is better than nothing. Moreover, variations on this theme already exist online, notably the Wikipedia feature that reveals all changes made to a given entry.⁶⁵ But, without a legal obligation to disclose alterations or link back to the original, the prospects for even this weakened integrity right do not presage imminent adolescence, much less a vigorous adulthood, for moral rights in the US.

⁶⁴ Ginsburg, *supra* note 1, at 17 (citing Jessica Litman, *Revising Copyright for the Information Age*, 75 *Or. L. Rev.* 19, 47 (1996)).

⁶⁵ Edits to individual Wikipedia pages may be viewed by clicking the "Page History" tab that appears on each page. "Page History" allows users to see previous revisions, including the time and date of revision and the user name or IP address of the individual making the changes. Wikipedia also provides a tool which compares previous versions of the page against each other. *See* Help: Page history, Wikipedia, http://en.wikipedia.org/wiki/Help:Page_history (last modified Dec. 10, 2011). Members of the Wikipedia community are currently engaged in a project to allow for simplified search of these page revisions. *See* WikiBlame, <http://wikipedia.ramselehof.de/wikiblame.php>.