



Fall 9-1-2006

Stepmother, May I?: Moral Rights, Dastar, and the False Advertising Prong of Lanham Act Section 43(a)

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Clint A. Carpenter, *Stepmother, May I?: Moral Rights, Dastar, and the False Advertising Prong of Lanham Act Section 43(a)*, 63 Wash. & Lee L. Rev. 1601 (2006).

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Stepmother, May I?: Moral Rights, *Dastar*, and the False Advertising Prong of Lanham Act Section 43(a)

Clint A. Carpenter*

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* Candidate for Juris Doctor, Washington and Lee University School of Law, May 2007; B.A., Brigham Young University, 2001. I would like to thank Professor Sarah K. Wiant for her generous feedback and encouragement. And to Yvonne, my wife, who followed me from Los Angeles to rural Virginia so that I might ignore her while researching esoteric points of copyright law, I express my undying gratitude and affection. This Note is dedicated to the writers who mentored me in my efforts to develop the skill and talent they wield so well, and who helped me discover along the way that I would rather go to law school.

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I. Introduction

[A] divorced mother . . . is raising her two daughters alone after her husband . . . left her for [a] fashion model . . . and is doing quite well, thank you. But not five minutes into the film, her abdominal pains are diagnosed as a fast-growing cancer, and she's told she only has a few months to live. What choice does she have but to take [the model] under her wing and teach her how to be a real mom? . . . [A]fter a rocky start, the two women learn to love and respect each other. The girls learn to love and respect their stepmom. Everyone hugs and cries a lot.¹

Many of the millions of viewers who contributed to the \$160 million grossed by the movie *Stepmom*² might readily identify the foregoing as a plot summary of that 1998 Julia Roberts vehicle.³ But they would be wrong. In fact, the quoted summary describes a 1995 made-for-TV movie entitled *The Other Woman*.⁴ The confusion, however, would be understandable, at least to Nancey Silvers, screenwriter of *The Other Woman*, who believed the two films were so similar that she sued the producers of *Stepmom* for copyright infringement.⁵

Before filing suit, however, Silvers faced a hurdle that stands in the way of many authors who might wish to protect their interests in their work: Under

1. Hannah Brown, *Plot Sounds a Lot Like a Soap—But Then It Was, On TV*, N.Y. POST, Dec. 23, 1998, at 40.

2. Box Office Mojo, *Stepmom*, <http://www.boxofficemojo.com/movies/?id=stepmom.htm> (last visited Dec. 1, 2005) (on file with the Washington and Lee Law Review).

3. STEPMOM (Sony Pictures 1998).

4. *The Other Woman* (CBS television broadcast Mar. 26, 1995). Differences between the two films include the fact that Julia Roberts plays a photographer of fashion models, not a model herself, and that *Stepmom*'s cancer-stricken protagonist, played by Susan Sarandon, is mother to a boy and a girl rather than two girls. STEPMOM, *supra* note 3.

5. See *Silvers v. Sony Pictures Entm't, Inc.*, 402 F.3d 881, 883 (9th Cir. 2005) (en banc) (describing Silvers's complaint), *cert. denied*, 126 S. Ct. 367 (2005). Interestingly, when asked about the similarities between the two films shortly after the release of *Stepmom*, Silvers said "I consider it a huge compliment. Maybe my idea inspired somebody. As my father, Phil Silvers, used to say, 'There are only seven original ideas in the world.'" Brown, *supra* note 1, at 40. Given that Silvers pursued her suit against *Stepmom*'s producers for over five years, including two appellate hearings and a petition to the Supreme Court, it would appear that she changed her mind.

U.S. copyright law, she had no legal interest in *The Other Woman*.⁶ Although Silvers created the film's entire story, the "author" of *The Other Woman*, according to the Copyright Act of 1976, was the production company that hired her to write the screenplay, Frank & Bob Films II (Frank & Bob Films).⁷ And because the legal interests—the "exclusive rights"—protected by U.S. copyright law accrue only to statutory authors and their assigns, Silvers owned no infringeable right.⁸ If *Stepmom* was infringing, the rights affected belonged to Frank & Bob Films.

To remedy this deficiency, caused by her screenplay's status as a "work-for-hire," Silvers sought and obtained an unusual assignment from Frank & Bob Films:

Frank & Bob Films retained ownership of the underlying copyright to *The Other Woman* script, but assigned to Silvers "all right, title and interest in and to any claims and causes of action against Sony Pictures Entertainment, Inc. . . . and any other appropriate persons or entities, with respect to the screenplay *The Other Woman* . . . and the motion picture *Stepmom*."⁹

Thus, Silvers procured ownership, not of the underlying copyright or any of its exclusive rights, but rather of Frank & Bob Films's right to sue for *Stepmom*'s infringement of *The Other Woman*. In *Silvers v. Sony Pictures Entertainment, Inc.*,¹⁰ Silvers exercised this right by suing Sony for copyright infringement,

6. See generally Copyright Act of 1976, Pub. L. No. 94–553, 90 Stat. 2541 (amending 17 U.S.C. in its entirety).

7. See 17 U.S.C. § 201(b) (2000) ("In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and . . . owns all of the rights comprised in the copyright."). As used in this Note, however, the term "author" will denote the creator of a work; "statutory author" is the term this Note will use to describe one who is not the creator of a work but is nonetheless recognized as its author by operation of law.

8. See 17 U.S.C. § 106 (describing the "Exclusive Rights in Copyrighted Works"); *id.* § 201(a) ("Copyright in a work . . . vests initially in the author or authors of the work."); *id.* § 201(d)(2) ("Any of the exclusive rights comprised in a copyright . . . may be transferred . . . and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner.").

9. *Silvers*, 402 F.3d at 883. The uncommon nature of this assignment was suggested by Silvers's attorney, who was paraphrased in a news report as saying that "the situation was 'unusual' and that it was unlikely there would be a large number of cases in which copyright holders will assign their rights to sue for infringement." *En Banc Panel Will Consider Copyright Infringement Standing Issue*, METROPOLITAN NEWS-ENTERPRISE (Los Angeles), June 10, 2004, at 3. This assessment is given implicit credence by the Ninth Circuit, which, in deciding a challenge to the assignment's validity, wrote that "other circuits have addressed similar questions, [but] no court has squarely resolved this issue." *Silvers v. Sony Pictures Entm't, Inc.*, 330 F.3d 1204, 1206 (9th Cir. 2003), *rev'd en banc*, 402 F.3d 881 (9th Cir. 2005), *cert. denied*, 126 S. Ct. 367 (2005).

10. *Silvers v. Sony Pictures Entm't, Inc.*, CV 00–6386 SVW (RCx), slip op. at 2 (C.D.

"alleging that the movie *Stepmom* was substantially similar to the script for *The Other Woman*."¹¹

Sony responded to Silvers's lawsuit with a motion to dismiss, arguing that, without any ownership in the underlying copyright, Silvers lacked standing to sue for infringement of the copyright.¹² Sony grounded its argument in the language of Section 501(b) of the Copyright Act, which provides that "[t]he legal or beneficial owner of an exclusive right under a copyright is entitled . . . to institute an action for any infringement of that particular right committed while he or she is the owner of it."¹³ Under Sony's narrow interpretation of this provision, which would limit standing to sue for infringement to *only* the owners of exclusive rights, Silvers would not have standing because the right to sue for infringement is not one of the Act's exclusive rights.¹⁴

Silvers argued for a more inclusive reading of Section 501(b), citing the Fifth Circuit's decision in *Prather v. Neva Paperbacks, Inc.*¹⁵ as recognizing "the effectiveness of an assignment of accrued causes of action for copyright infringement."¹⁶ In support, Silvers pointed out that *Nimmer on Copyright* relied on *Prather* for the proposition that an "assignee of an accrued

Cal. Jan. 25, 2001) (on file with the Washington and Lee Law Review), *aff'd*, 330 F.3d 1204 (9th Cir. 2003), *rev'd en banc*, 402 F.3d 881 (9th Cir. 2005), *cert. denied*, 126 S. Ct. 367 (2005).

11. *Silvers*, 402 F.3d at 883.

12. *Id.*

13. 17 U.S.C. § 501(b).

14. *See Silvers*, CV 00-6386 SVW (RCx) at 2 (describing Sony's argument in favor of dismissal).

15. *Prather v. Neva Paperbacks, Inc.*, 410 F.2d 698 (5th Cir. 1969). Prather, the author of such books as *Strip for Murder*, *The Wailing Frail*, *Kill the Clown*, and *Dig That Crazy Grave*, discovered that Neva Paperbacks, publisher of *Sex Fantasy*, *Sex Cult*, and *Sex Trap*, had flagrantly infringed his books. *Id.* at 698-99. Pursuant to a prior agreement, Prather's publisher owned his copyrights in his books, so before suing Neva, Prather obtained from his publisher "all accrued causes of action for infringement" and at least a portion of the underlying copyright. *Id.* at 699. Neva claimed that the assignment did not grant to Prather the entire copyright, and because the rights in a copyright were indivisible under the Copyright Act of 1909, Neva argued that the entire copyright assignment was invalid and Prather therefore had no standing to sue. *Id.* The court, however, sidestepped Neva's argument, stating that "we find a simple, simple basis which avoids altogether the button game of 'copyright, copyright who has the copyright?'" *Id.* This "simple basis" was the fact that the agreement between Prather and his publisher also included "a complete and valid assignment of an accrued chose in action for infringement." *Id.* Citing precedent indicating that an assignment of copyright does not include an assignment of any accrued causes of action for infringement unless explicitly provided for, the court held that an "assignee of all choses in action for infringement, whether a 'proprietor' [an owner of a copyright under the 1909 Act] or not, has standing to sue." *Id.* at 700.

16. *Id.*

infringement cause of action has standing to sue . . . even if the [assignor] retains ownership of all other rights under the copyright."¹⁷

The district court agreed with Silvers, denying Sony's motion to dismiss,¹⁸ and a panel of the Ninth Circuit affirmed.¹⁹ Upon rehearing en banc, however, the Ninth Circuit reversed itself in a 7-4 decision.²⁰ Applying the maxim of statutory construction *expressio unius est exclusion alterius*, which "creates a presumption that when a statute designates certain persons, things, or manners of operation, all omissions should be understood as exclusions,"²¹ the majority concluded that "[t]he bare assignment of an accrued cause of action is impermissible under 17 U.S.C. § 501(b). Because that is all Frank & Bob Films conveyed to Silvers, Silvers was not entitled to institute and may not maintain this action . . . for alleged infringement of the copyright in *The Other Woman*."²² Silvers petitioned the Supreme Court for a writ of certiorari, arguing that the Ninth Circuit's decision was directly contrary to the Fifth Circuit's decision in *Prather*,²³ but cert was denied.²⁴

Of greater significance for purposes of this Note, however, is Judge Berzon's dissent from the en banc opinion.²⁵ After explaining why the majority's exclusive interpretation of Section 501(b) of the Copyright Act "is

17. *Silvers v. Sony Pictures Entm't, Inc.*, CV 00-6386 SVW (RCx), slip op. at 3 (C.D. Cal. Jan. 25, 2001) (on file with the Washington and Lee Law Review).

18. *Id.* at 7.

19. *Silvers*, 330 F.3d at 1209.

20. *Silvers*, 402 F.3d at 882.

21. *Id.* at 885 (quoting *Boudette v. Barnette*, 923 F.2d 754, 756-57 (9th Cir. 1991)).

22. *Id.* at 890.

23. On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit, *Silvers v. Sony Pictures Entm't, Inc.*, 126 S. Ct. 367 (2005) (No. 04-1738), 2005 WL 1506025. The majority in the en banc opinion had distinguished *Prather* on two grounds. The first was that *Prather* was decided under the 1909 Copyright Act, which specified only that the "proprietor" of a copyright may sue for infringement without defining "proprietor" or mentioning "exclusive rights," rather than the current 1976 Copyright Act. See *Silvers*, 402 F.3d at 889 (citing 17 U.S.C. § 101(b) (1952); MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 132 (1976)). The second was that "the assignment in *Prather* involved both accrued causes of action *and* some of what we now would call exclusive rights." *Id.* It is worth noting, however, that the *Prather* court made explicit the fact that it was not relying on any copyrights *Prather* may have been assigned in reaching its decision. See *Prather v. Neva Paperbacks, Inc.*, 410 F.2d 698, 699 (5th Cir. 1969) ("[W]e find a simple, simple basis which avoids altogether the button game of 'copyright, copyright who has the copyright?').

24. *Silvers v. Sony Pictures Entm't, Inc.*, 126 S. Ct. 367, 367 (2005).

25. *Silvers v. Sony Pictures Entm't, Inc.*, 402 F.3d 881, 890-95 (9th Cir. 2005) (en banc) (Berzon, J., dissenting). Judge Reinhardt joined Judge Berzon's dissent. *Id.* at 890.

internally inconsistent, provides inadequate support for its conclusion, and ignores [the Ninth Circuit's] analogous precedents,"²⁶ Judge Berzon concluded:

I see nothing in the assignment of accrued claims of Frank & Bob Films for infringement of a work *created* by Silvers to Silvers that violates the[] background principles [of the Copyright Act]. Silvers has a significant interest in the infringement of *The Other Woman*, as she was the original creator. She might well herself have held the copyright had she not contracted with Frank & Bob Films to create a work-for-hire. Although she relinquished the right to the copyright through her contract with Frank & Bob Films, she maintained an interest in how her work was used. More importantly, Silvers, as the creator, is the person for whom the copyright system is designed to provide incentives for more creations.²⁷

In recognizing these interests, Judge Berzon was, perhaps unwittingly, acknowledging Silvers's "moral rights," rights that exist separately from the economic rights of copyright and that inhere in the personality of authors.²⁸ That Judge Berzon's view did not carry the day is therefore unsurprising—from a moral rights perspective, *Silvers v. Sony Pictures* is simply the most recent in a series of decisions, both judicial and legislative, limiting authors' ability to vindicate their moral rights.²⁹ And just as in *Silvers*, the recent Supreme Court

26. *Id.* at 891 (Berzon, J., dissenting).

27. *Id.* at 893–94 (Berzon, J., dissenting). Judge Bea, joined by Judge Kleinfeld, also dissented in *Silvers* but argued for complete alienability of accrued causes of action for copyright infringement:

The underlying premise upon which the Majority relies is that there should not be an aftermarket in causes of action for copyright infringement. Given the growth of an aftermarket in derivative rights such as puts, calls and credit insurance against bankruptcy risks on corporate debt, the notion that an aftermarket in accrued causes of action for copyright infringement is to be prohibited is at best passe and at worst an unwarranted restraint on alienation. Indeed, such limitations, on those able to bring suit, harken back to the Tudor Kings of England who limited inheritance to primogeniture and descent by fee tail.

Id. at 905 (Bea, J., dissenting) (citations omitted).

28. *See infra* Part II.A (discussing moral rights). It is worth noting at this point that the term "moral rights" can be somewhat misleading:

Moral rights are legal rights—copyright rights—and should not be confused with notions of public or private morality. The term "moral rights" is used to distinguish them from the "economic rights" which have classically comprised United States and world copyright, such as rights to copy, translate, and publicly perform works of authorship.

Ralph Oman, *The United States and the Berne Union: An Extended Courtship*, 3 J.L. & TECH. 71, 93 (1988).

29. *See infra* Parts II–III (describing the status of moral rights protections under U.S. law).

case of *Dastar Corp. v. Twentieth Century Fox Film Corp.*,³⁰ the most significant of these decisions, was decided without even a mention of "moral rights."³¹ Indeed, as Silvers's conflict with *Stepmom* reminds us, moral rights are very much the "redheaded stepchild" of U.S. copyright law.

Part II of this Note begins to explain the lowly status of moral rights in the United States by discussing moral rights generally, U.S. obligations to recognize moral rights under the *Berne Convention for the Protection of Literary and Artistic Works*, and Congress's somewhat dubious claim at the time of accession to the Berne Convention that existing U.S. law adequately protected moral rights. Part III then discusses the critical role of Section 43(a) of the Lanham Act³² in protecting moral rights in the United States. Part IV discusses the Supreme Court's decision in *Dastar* and its near-fatal blow to moral rights protection under Section 43(a). Part V concludes that any post-*Dastar* Section 43(a) protection for moral rights must be found in the statute's "false advertising" prong. Historically, the false advertising prong of Section 43(a) has not been used to vindicate moral rights, so Part V goes on to test its viability in that area by hypothesizing Nancey Silvers's case against Sony as a Section 43(a) false advertising claim. Part VI concludes that although some moral rights protection may survive *Dastar* in the form of false advertising claims, that protection is insufficient to support the conclusion that the United States is presently in compliance with its obligations under the Berne Convention. Rather than persisting in "backdoor" approaches to moral rights, the United States should recognize moral rights directly and in full compliance with its treaty obligations if it wishes to retain its influence and moral authority in shaping international copyright law.

II. Moral Rights and U.S. Obligations Under International Law

Certain countries of the world have long recognized rights personal to authors, and as such viable separate and apart from the economic aspect of copyright. Their separate viability is such that a full transfer of copyright may suffice for all economic purposes, but may exert no impact on the assertion of these claims. In France, home country to the doctrine, these rights are known as *le droit moral*, or moral rights. "The adjective 'moral'

30. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003). For a detailed discussion of *Dastar*, see *infra* Part IV.

31. See *infra* Part IV (describing the effect of *Dastar* on moral rights).

32. See 15 U.S.C. § 1125(a)(1) (2000) (prohibiting two major types of "unfair competition": "false association" and "false advertising").

has no precise English equivalent, although 'spiritual,' 'non-economic,' and 'personal' convey something of the intended meaning."³³

A. Romanticism and Its Progeny

The continental European concept of moral rights finds its origins in the Romantic view of authorship as a celebration of "innate genius."³⁴ As one scholar explained:

Romanticism . . . focus[es] squarely upon the relationship of the author to his work. It is this focus, coupled with the corollary notion that an audience has no claim upon an author, which animates the doctrine of moral right.

. . . .

. . . [A]ll artistic works result from the overflow, utterance or projection of the thoughts and feelings of the author. The author himself becomes the major element generating both the artistic product and the criteria by which it is to be judged. That, briefly put, is the central Romantic conception of the author.³⁵

Fundamental to the Romantic view is "the metaphor of the author as creator" and its attendant implications of divinity.³⁶ As one legal scholar emphatically declared, "when an artist creates . . . he does more than bring into the world a unique object having only exploitive possibilities; he projects into the world a part of his personality and subjects it to the ravages of public use."³⁷

33. 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8D.01[A] (Release No. 68, Dec. 2005) [hereinafter NIMMER] (footnotes omitted). The French term *le droit moral* is more accurately translated as the singular "moral right," which "connotes an indivisible package of rights, as distinguished from the plural 'moral rights,' reflective of the current American concept of divisibility." *Id.* § 8D.01[A] n.4. Nonetheless, this Note generally follows the American convention, employing the plural form.

34. Christopher Aide, *A More Comprehensive Soul: Romantic Conceptions of Authorship and the Copyright Doctrine of Moral Right*, 48 U. TORONTO FAC. L. REV. 211, 218 (1990); see also Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of "Authorship,"* 1991 DUKE L.J. 455, 497 ("The connection between 'moral rights' and the complex values associated with the Romantic conception of 'authorship' is clear.").

35. Aide, *supra* note 34, at 214, 217 (footnote omitted).

36. *Id.* at 218.

37. Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554, 557 (1940); see also Russell J. DaSilva, *Droit Moral and the Amoral Copyright*, 28 BULL. COPYRIGHT SOC'Y U.S.A. 1, 12 (1980) ("The author has, in a sense, made a gift of his creative genius to the world; in return, he has a right—a moral

Implicit in this unity between an author's personality and his work is the idea that protections for works of authorship must include protection of authors' personalities.

Admittedly, it may seem a stretch to apply the high-minded concepts of "genius" and "divinity" to *The Other Woman* and *Stepmom*, much less to such copyrightable works as stereo instructions or computer programming code. As one commentator suggests, however, because "genius is not always instantaneously or universally recognized, moral right casts its protective mantle over everything which has been granted copyright."³⁸ Moreover, despite the somewhat metaphysical nature of the Romantic view of authorship, the notion that "[a]n author stands apart from all humanity" informs not only the continental European view but virtually all Western conceptions of authorship.³⁹ As one American judge wrote, "Even the matter-of-fact attitude of the law does not require us to consider the sale of the rights to a literary production in the same way that we would consider the sale of a barrel of pork."⁴⁰

In the development of the law, however, Romantic notions of authorship clearly held greatest sway in continental Europe, where the law came to recognize four basic moral rights.⁴¹ The *droit de divulgation* is the author's "right to publish a work, or to withhold it from dissemination," while the *droit de retrait* is "the right to withdraw a published work from distribution if it no longer represents the views of the author."⁴² The third moral right, commonly called the right of integrity, is the author's "right to prevent others from making deforming changes in his work."⁴³ Finally, the right of attribution, also known as the paternity right, includes the following authors' rights:

right—to expect that society respect his creative genius.").

38. Aide, *supra* note 34, at 219.

39. *Id.* at 212.

40. *Clemens v. Press Publ'g Co.*, 122 N.Y.S. 206, 207 (App. Term 1910) (Seabury, J., concurring).

41. See 3 NIMMER, *supra* note 33, § 8D.01[A] (describing the categories of moral rights). The specific terms of the rights protected under these four categories vary from nation to nation. *Id.* The strongest protection is in France, where "the moral right is conceived as perpetual, inalienable, and imprescriptible." *Id.* "Apart from France, moral rights appear to be of greatest importance in Germany and Italy." *Id.* § 8D.01[A] n.3.

42. *Id.* § 8D.01[A]. Regarding the latter, Nimmer notes that the "retraction right is the least recognized among moral rights internationally; it is always subject to the qualification that the retracting author must pay full compensation for pulling back her interests that were previously granted." *Id.* § 8D.01[A] n.15 (citing Jeffrey M. Dine, Note, *Authors' Moral Rights in Non-European Nations: International Agreements, Economics*, Mannu Bhandari, and the *Dead Sea Scrolls*, 16 MICH. J. INT'L L. 545, 554 (1995)).

43. *Id.* § 8D.01[A].

- the right to be known as the author of his work;
- the right to prevent others from falsely attributing to him the authorship of a work that he has not in fact written;
- the right to prevent others from being named as the author of his work;
- the right to publish a work anonymously or pseudonymously, as well as the right to change his mind at a later date and claim authorship under his own name;
- the right to prevent others from using the work or the author's name in such a way as to reflect adversely on his professional standing.⁴⁴

Two of these Continental moral rights gained the status of international law with their incorporation into Article 6*bis* of the Berne Convention, which states:

Independently of the author's economic rights, and even after the transfer of said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which shall be prejudicial to his honor or reputation.⁴⁵

Thus, with the right to object to prejudicial alterations of their works, the Berne Convention protects the right of integrity, and with "the right to claim authorship," the Berne Convention protects the right of attribution.⁴⁶ One hundred sixty nations, including the United States, are signatories to the Berne Convention, agreeing to recognize authors' rights of attribution and integrity as independent from those authors' economic rights in their works.⁴⁷

Yet despite their shared tradition in the Romantic conception of authorship, the United States and the Continent have taken widely divergent views of the rights of attribution and integrity. French scholars, for example, began to discuss these rights in the eighteenth century,⁴⁸ and France was one of the original signatories to the Berne Convention in 1886.⁴⁹ In contrast, the

44. *Id.* (footnotes omitted).

45. Berne Convention for the Protection of Literary and Artistic Works art. 6*bis*, Sept. 9, 1886, S. TREATY DOC. No. 99-27, 1161 U.N.T.S. 3 [hereinafter Berne Convention] (describing the moral rights protections offered under the Berne Convention).

46. 3 NIMMER, *supra* note 33, § 8D.01[B].

47. World Intellectual Property Organization, Treaties and Contracting Parties, http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=15 [hereinafter WIPO] (last visited Jan. 29, 2007) (on file with the Washington and Lee Law Review).

48. DaSilva, *supra* note 37, at 9.

49. Oman, *supra* note 28, at 72 n.7 (citing 1 WORLD COPYRIGHT 518 (H.L. Pinner ed. 1953)). The other signatories to the 1886 Convention were Belgium, Germany, Great Britain, Haiti, Italy, Liberia, Spain, Switzerland, and Tunisia. *Id.* Article 6*bis*, however, was not added

United States was last among Western industrialized nations to join the Berne Union⁵⁰ when it acceded to the Berne Convention in 1988, moral rights being one of the primary points of contention.⁵¹ Prior to U.S. accession, it was generally accepted that "American copyright law . . . does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors,"⁵² and it is far from clear that the situation is much changed since.

This is not to suggest, however, that U.S. law's focus on statutory authors' economic rights has been altogether misplaced—it arises largely from the constitutional purpose of copyright, which emphasizes copyright's value to society over the individual interests of authors.⁵³ But that economic outlook, and the harsh outcomes for authors that often result,⁵⁴ has often come into

to the Berne Convention until 1928. *Id.* at 73.

50. Berne Convention, *supra* note 45, art. 1 ("The countries to which this Convention applies constitute a Union for the protection of the rights of authors in their literary and artistic works.").

51. See WIPO, *supra* note 47 (listing the nations who are signatories to the Berne Convention and the dates of their adherence).

52. *Gilliam v. Am. Broad. Cos.*, 538 F.2d 14, 24 (2d Cir. 1976).

53. See U.S. CONST. art. I, § 8, cl. 8 (granting to Congress the power "to Promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries"); see also DaSilva, *supra* note 37, at 55 ("The constitutional mandate reveals that American copyright arises not from a perpetual, natural right of 'propriété incorporelle,' as in France, nor even from a 'right of personality,' as in Germany, but rather from the sovereign's interest in promoting a socially desirable end."). The constitutional mandate, however, is not necessarily incompatible with moral rights. For example, in criticizing the work-for-hire doctrine's effect on moral rights, one commentator stated:

[T]aking authorship of a work too readily from its creator-in-fact will often run counter to the personal link between the individual creator and the created work which underlies the *droit moral* notions of . . . credit and integrity, to say nothing of the U.S.'s own historical objectives and policies of promoting science and the useful arts through rewards to actual creators, as articulated in the Constitution.

FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION 178 (1986) (comments of John M. Kerochian, Nash Professor of Law, Columbia University), reprinted in 10 COLUM.-VLA J.L. & ARTS 513, 690 (1986).

54. See, e.g., Candace G. Hines, Note, *Black Musical Traditions and Copyright Law: Historical Tensions*, 10 MICH. J. RACE & L. 463, 485–86 (2005) (describing how work-for-hire contracts allowed record companies to reap the economic benefits of white rock-and-roll musicians popularizing songs written and performed by black blues and R&B musicians, often leaving the black musicians in poverty). Hines offers the following example:

Elvis Presley, an admitted imitator of Black blues and R&B singers, is a prime example of the prevalence of this practice. In many cases, a work-for-hire contract existed, so the Black artist of the original song not only did not own the copyright but was not even paid for the use of the original musical work. One of Elvis' hit records, "That's All Right Mama," was actually originally written and recorded by

conflict with the nagging Romantic notion that works of authorship demand different treatment than "barrels of pork."⁵⁵ As discussed below, that conflict resulted in a patchwork of limited and roundabout protections for moral rights that, prior to *Dastar*, had changed only slightly since the beginning of U.S. adherence to the Berne Convention.⁵⁶

B. *The Berne Convention and Moral Rights in the United States*

Such was the state of U.S. copyright law when, in connection with U.S. accession to the Berne Convention, Congress passed the Berne Convention Implementation Act of 1988 (BCIA).⁵⁷ The BCIA amended the Copyright Act and was designed to bring the United States into compliance with the Berne Convention, yet none of the amendments incorporated Article 6*bis* or otherwise provided for protection of the moral rights of attribution and integrity.⁵⁸ Furthermore, in an effort largely calculated to forestall the implementation of Continental-style moral rights, Congress stated emphatically that the Berne Convention is not self-executing,⁵⁹ meaning that it carries the force of law in the United States only insofar as Congress enacts legislation implementing its

bluesman Arthur "Big Boy" Crudup, who was paid so little for his recordings that he balanced his work as a rural laborer—sometimes selling sweet potatoes—with his recording sessions throughout his career. Elvis was not the only one to record his music. Other musicians who recorded Crudup's music include Elton John, Creedence Clearwater Revival, and Rod Stewart. Crudup finally quit the music industry because he "was making everybody rich and [he] was poor." Blues scholar David Dicaire maintains that such circumstances were not individual occurrences.

Id. (footnotes omitted).

55. *Clemens v. Press Publ'g Co.*, 122 N.Y.S. 206, 207 (App. Term 1910) (Seabury, J., concurring).

56. *See infra* Parts II.B–III.C (discussing the protections available for moral rights under U.S. law).

57. Berne Convention Implementation Act of 1988, Pub. L. No. 100–568, 102 Stat. 2853 (codified as amended in scattered sections of 17 U.S.C.).

58. *See id.* (amending the Copyright Act of 1976).

59. *See, e.g.*, 17 U.S.C. § 104(c) (2000) ("No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto."); H.R. REP. NO. 100–609, at 38 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32–38 ("The Committee [on the Judiciary] states unequivocally that Berne is not self-executing, that domestic law is not in any way altered except through the implementing legislation itself, and that the implementing legislation is absolutely neutral on the issue of the rights of paternity and integrity."); 1 NIMMER, *supra* note 33, § 1.12[A] ("Almost a third of the BCIA's thirteen sections are designed, in whole or in part, to forestall any claim that the Berne Convention is self-executing under United States law.").

provisions.⁶⁰ This then raises the question: How can the United States credibly claim to adhere to the Berne Convention while taking such pains to avoid implementing Article *6bis*?

Congress's answer at the time of adherence was that "existing state and federal law in the United States satisfied Article *6bis*."⁶¹ This claim, that "there is a composite of laws in this country that provides the kind of protection envisioned by Article *6bis*,"⁶² is widely disputed.⁶³ Such assessments, however,

60. See 1 NIMMER, *supra* note 33, § 1.12[A] ("The issue of self-execution merited such close attention . . . because of its intimate relationship to the controversial issue of moral rights—Congress wished to ensure that Berne adherence not bring in its wake a Continental construction of *le droit moral* to displace the home-grown American doctrine on the subject."). U.S. courts have thus far accepted Congress's intent as dispositive of whether a plaintiff may bring a cause of action under Article *6bis* itself. See, e.g., *Choe v. Fordham Univ. School of Law*, 920 F. Supp. 44, 44 (S.D.N.Y. 1995) (dismissing a claim that "mutilation" of a student's law review Comment violated the student's moral rights under the Berne Convention). Commentators have generally followed the courts' lead. See, e.g., Graeme W. Austin, *The Berne Convention as a Canon of Construction: Moral Rights After Dastar*, 61 N.Y.U. ANN. SURV. AM. L. 111, 132 (2005) (noting that "the somewhat obvious point that the Berne Convention was not meant to provide an independent cause of action outside the Copyright Act . . . was confirmed by the BCIA, which expressly provides that the Convention is not self-executing"). *Nimmer on Copyright* suggests, however, that the issue of self-execution is not necessarily so clear-cut:

[P]recedent as high as the United States Supreme Court exists for holding certain treaties to be self-executing under U.S. law. Although moral rights proponents have not cited any instance in which courts have set at naught legislative and executive declarations of nonself-execution as strong as those that accompanied the BCIA, the mere absence of such precedents from the past does not foreclose them from arising in the future. The judiciary, in short, may agree with the other two branches of government that the Berne Convention is not self-executing; but that proposition is not self-evident.

With the passage of years, however, history itself offers at least a partial verdict. Parties have indeed . . . attempted to assert rights in U.S. courts directly under the Berne Convention. To date, the courts have decisively rebuffed those attempts.

1 NIMMER, *supra* note 33, § 1.12[A].

61. PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 17.23 (2005) (citing H.R. REP. NO. 100-609, at 33-34 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32-33 to 32-34).

62. H.R. REP. NO. 100-609, at 34 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32-34.

63. See, e.g., 3 NIMMER, *supra* note 33, § 8D.02[D][1] (stating that Congress's determination that current U.S. law met the Article *6bis* requirements "flies in the face of numerous judicial and scholarly pronouncements on the subject"); *Moral Rights in our Copyright Laws: Hearings before the Subcomm. on Patents, Copyrights and Trademarks, of the S. Comm. of the Judiciary*, 101st Cong. 42 (1989) (Statement of Edward J. Damich) ("When the degree of moral rights protection afforded by American law is placed alongside the language of article *6bis*, no one can honestly maintain that American law measures up."); Justin Hughes, *American Moral Rights and the Dastar Decision* 49 (Benjamin N. Cardozo Sch. of Law Jacob Burns Inst. for Advanced Legal Studies, Working Paper No. 96, 2004), *available at*

are facilitated by the fact that in seeking to justify its claim of compliance, Congress specified the existing U.S. laws that it believed satisfied Article 6bis.⁶⁴

1. *The Copyright Act of 1976*

The traditional view, that U.S. copyright law does not protect moral rights at all,⁶⁵ is not entirely accurate, a fact Congress recognized when it based its claim of compliance, in part, on three provisions of the Copyright Act.⁶⁶ First, Section 106 grants statutory authors the exclusive right to make derivatives of their works.⁶⁷ Second, Section 115(a)(2) prohibits changes to the "fundamental character" of a sound recording used under a compulsory license.⁶⁸ Third, under certain very limited circumstances, Section 203 permits non-work-for-hire authors to terminate transfers and licenses of copyrights, regaining those rights for themselves.⁶⁹

<http://ssrn.com/abstract=618783> ("In the best of times, the patchwork [justification] had at least as many doubters as believers among American legal commentators."). A former Copyright Counsel to the House Subcommittee on Intellectual Property and Judicial Administration expressed his disagreement with Congress's "composite of laws" approach in particularly stark terms:

To all but the most partisan advocate, it was crystal clear that U.S. law provided no [moral] rights, and for a simple reason: the copyright industries opposed them. As a result, the World Intellectual Property Organization, which administers Berne, looked the other way as the United States joined without express moral rights. I say "express" because the Reagan Administration and Congress engaged in the charade of claiming that the United States already had adequate moral rights to permit adherence. Thus, in the one area where there was a need for the United States to belly up to the bar and join the international community, the United States stayed home.

William Patry, *The United States and International Copyright Law: From Berne to Eldred*, 40 HOUS. L. REV. 749, 751–52 (2003). *But see* H.R. REP. NO. 100–609, at 37 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32–37 (quoting Dr. Arpad Bogsch, then-Director General of WIPO, who stated his "belie[f] that in the United States the common law and such statutes (Section 43(a) of the Lanham Act) contain the necessary law to fulfill any obligation for the United States under Article 6bis").

64. *See* H.R. REP. NO. 100–609, at 34 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32–34 (listing the bases for the claim that existing law met the requirements of Article 6bis).

65. *See supra* note 52 and accompanying text (describing the traditional view).

66. *See* H.R. REP. NO. 100–609, at 34 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32–34 (citing 17 U.S.C. §§ 106, 115(a)(2), 203 (2000)).

67. 17 U.S.C. § 106 (2000).

68. *Id.* § 115(a)(2).

69. *Id.* § 203. Authors may exercise this ability to terminate for only five years beginning,

That these provisions of the Copyright Act protect the moral right of integrity to at least some degree is clear. Equally clear, however, is that their scope falls well short of the Article 6*bis* requirements.⁷⁰ Most obvious is that Section 115(a)(2) applies only to sound recordings subject to compulsory license, whereas Article 6*bis* applies to all copyrightable works.⁷¹ Furthermore, none of the three provisions offers any protection for the right of attribution.⁷² Of greatest significance, however, is the fact that none offers any protection to the many authors of works-for-hire, and only Section 203 reaches authors who have parted with their economic interests in their copyrights.⁷³ As a result, the Copyright Act provisions cited by Congress to justify its claim of compliance fail to comport with the standard mandated by Article 6*bis*, which requires that the rights of integrity and attribution be protected "[i]ndependently of the author's economic rights, and even after the transfer of said rights."⁷⁴

depending on the circumstances, after thirty-five to forty years have passed since the transfer. *Id.* § 203(a)(3). Section 203 further limits the utility of this termination power by permitting a transferee or licensee, subsequent to termination, to continue to utilize a derivative work already prepared under the terminated transfer or license. *Id.* § 203(b)(1).

70. See Berne Convention, *supra* note 45 (describing the Berne Convention's moral rights requirements).

71. 17 U.S.C. § 115(a)(2) (2000); Berne Convention, *supra* note 45.

72. 17 U.S.C. §§ 106, 115(a)(2) (2000).

73. *Id.*

74. Berne Convention, *supra* note 45; see also FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION 175 (1986) (comments of John M. Kernochan, Nash Professor of Law, Columbia University), reprinted in 10 COLUM.-VLA J.L. & ARTS 513, 687 (1986) ("Notice should be taken of the undermining effect on moral rights of the spreading use of work-for-hire arrangements by exploiters of authors' works. . . . The work-for-hire concept is generally antithetical to the *droit moral* view of art-works as linked to the personalities of the individuals who actually create them."). *Nimmer on Copyright* explains the effect of the U.S. concept of statutory authorship on Article 6*bis* compliance as follows:

Ineligibility for employees to assert moral rights in their creations "is doubtless a legal position which is incompatible with the protection provided under Article 6*bis*. . . ."

. . . .

. . . [T]he Berne Convention minimally requires recognition of moral rights "[i]ndependently of the author's economic rights, and even after the transfer of said rights." The exceptions under U.S. law unambiguously fail to comport with that requirement of inalienability—contractual assignment of otherwise subsisting rights almost invariably dooms the claimant's moral rights position. . . . It is therefore difficult to conclude that any appreciable moral rights subsist under U.S. law independently of the author's economic rights.

. . . U.S. moral right protection is far from nonexistent. Yet it apparently fails to accord the full-fledged protection contemplated by Article 6*bis*.

3 NIMMER, *supra* note 33, § 8D.02[D][1] (footnotes omitted).

2. State and Local Laws

According to Congress, "State and local laws includ[ing] those relating to publicity, contractual violations, fraud and misrepresentation, unfair competition, defamation, and invasion of privacy" also contribute to the "composite of laws" offered in satisfaction of Article 6*bis*.⁷⁵ An in-depth discussion of each of these is beyond the scope of this Note, but the following summarizes the ways in which several of these state and local laws can protect the right of integrity:

Unfair competition law may provide relief against the dissemination of a degraded version of a work, such as the broadcast of a low-quality radio program featuring the plaintiff's characters, on the ground that dissemination of the inferior version will injure the author's good will by misleading consumers into thinking that the author sponsored the degraded work. If a mutilated work reflects adversely on the author's reputation, its publication may be actionable as a defamatory tort or as an invasion of the author's rights of privacy or publicity.⁷⁶

State unfair competition laws may also offer some protection for the right of attribution, but the operation of those laws is generally similar to the corresponding federal law found in Section 43(a) of the Lanham Act, discussed in Part III below.⁷⁷

75. H.R. REP. NO. 100-609, at 34 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32-34.

76. GOLDSTEIN, *supra* note 61, § 17.24.1(c).

77. See *infra* Parts III-IV (discussing protection for moral rights under Section 43(a)); see also 2 JEROME GILSON ET AL., TRADEMARK PROTECTION AND PRACTICE § 7.01[4] (Release No. 56 2005) [hereinafter GILSON] (noting that plaintiffs often state grounds for relief under both federal and state unfair competition law and that "[t]he federal ground is ordinarily that on which the heaviest judicial reliance is placed"); *Twentieth Century Fox Film Corp. v. Dastar Corp.*, No. CV98-07189FMC(EX), 2003 WL 22669587, at *2 (C.D. Cal. Oct. 14, 2003) (stating that "[t]he Ninth Circuit has consistently held that claims brought under California unfair competition law are 'substantially congruent' to claims brought under the [federal] Lanham Act" and therefore dismissing plaintiff's state claim due to the U.S. Supreme Court's rejection of plaintiff's federal claim). Interestingly, Nancey Silvers alleged a violation of California unfair competition law, along with the copyright infringement claim, in her case against Sony. *Silvers v. Sony Pictures Entm't, Inc.*, CV 00-6386 SVW (RCx), slip op. at 6 (C.D. Cal. Jan. 25, 2001) (on file with the Washington and Lee Law Review). The District Court dismissed her claim as preempted by the Copyright Act, and the issue was not addressed on appeal. *Id.* at 6-7. Although state unfair competition claims are not usually preempted, in that they do not seek relief for rights that are "equivalent to any of the exclusive rights within the general scope of copyright," 17 U.S.C. § 301(a) (2000), Silvers's state claim "simply incorporate[d] by reference the allegations relating to her copyright infringement claim." *Silvers*, CV 00-6386 SVW (RCx) at 7. Thus, it appears that the failure of her state claim was essentially a matter of poor pleading.

Congress also noted approvingly that eight states had recently enacted legislation "protecting the rights of integrity and paternity in certain works of art."⁷⁸ The most prominent of these state moral rights statutes are the California Art Preservation Act⁷⁹ and the New York Artists' Authorship Rights Act;⁸⁰ the other state statutes generally follow either the California or the New York model.⁸¹ Although these laws do provide explicit protection for moral rights, their application is limited to a small subset of the broader category of works of fine art, itself an extremely small subset of all copyrightable works. The New York law, for example, excludes works-for-hire⁸² and applies to only "a work of fine art" or copies of such a work produced in a limited edition of three hundred copies or less.⁸³ In contrast, Article 6*bis* mandates that moral rights be extended to all authors.⁸⁴

3. *The Visual Artists Rights Act of 1990*

Although not yet enacted at the time of the BCIA, and so not part of Congress's patchwork justification, the Visual Artists Rights Act of 1990 (VARA),⁸⁵ which extends the rights of integrity and attribution to works of fine art in signed and numbered limited editions of two hundred copies or less, represents the first and only express recognition of moral rights in the U.S. code.⁸⁶ Although this legislation provides another support for Congress's claim of compliance with Article 6*bis*, it does so largely at the expense of the state moral rights statutes that formed one of Congress's original justifications. First, VARA preempts the state moral rights statutes in most instances, further circumscribing their already limited utility.⁸⁷ In addition, VARA's moral rights

78. H.R. REP. NO. 100-609, at 34 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32-34. The eight states were California, Louisiana, Maine, Massachusetts, New Jersey, New York, Pennsylvania, and Rhode Island. *Id.* at 32-34 n.68.

79. CAL. CIV. CODE §§ 987-89 (West Supp. 2006).

80. N.Y. ARTS & CULT. AFF. LAW § 11.01-16.01 (McKinney Supp. 2006).

81. 3 NIMMER, *supra* note 33, § 8D.09.

82. *Id.* § 8D.08[A].

83. N.Y. ARTS & CULT. AFF. LAW § 14.03(1) (McKinney Supp. 2006).

84. Berne Convention, *supra* note 45.

85. See Visual Artists Rights Act of 1990, 17 U.S.C. §§ 101, 106A (2000) (providing under limited circumstances the rights of attribution and integrity to certain visual artists).

86. *Id.* As in the state statutes, works-for-hire are not protected. See *id.* § 101 (defining a "work of fine art" to exclude works-for-hire).

87. See 3 NIMMER, *supra* note 33, § 8D.06[F][1]-[3][a] (discussing preemption of state laws by VARA).

protections are weaker than those of several of the statutes it preempts.⁸⁸ Beyond the issue of preemption, however, the very fact that Congress enacted legislation in 1990 designed to protect the rights of attribution and integrity belies its claim that those rights were already protected adequately—if attribution and integrity were protected in compliance with Article 6*bis* in 1988, then VARA would seem to be superfluous.

III. Moral Rights Under Section 43(a) of the Lanham Act: Then and Now

The laws canvassed thus far clearly do not create "a composite of laws . . . that provides the kind of protection envisioned by Article 6*bis*."⁸⁹ The right of attribution, in particular, receives virtually no protection outside the category of fine art (and at the time of Congress's claim, even protection for fine art was available in only eight states). Thus, the credibility of Congress's patchwork justification turns on its one remaining basis: Section 43(a) of the Lanham Act.⁹⁰

A. The Two Prongs of Section 43(a)

When it was passed in 1947, Section 43(a) of the Lanham Act would have seemed an unlikely vehicle for moral rights protections. Placed in the chapter on "Trademarks" in Title 15 of the U.S. Code rather than in Title 17, which deals with copyrights, the Lanham Act was intended, in part, to codify the body of federal unfair competition common law that had been invalidated by the famous case of *Erie Railroad v. Tompkins*.⁹¹ Although the limited wording of the Act prevented it from encompassing the entire law of "unfair competition," Section 43(a) does offer protection falling under this rubric.⁹²

88. See *id.* § 8D.06[F][3] (discussing ways in which VARA may be "a giant step backwards"); see also *Bd. of Managers of SOHO Int'l Arts Condo. v. City of N.Y.*, No. 01 Civ.1226 DAB, 2003 WL 21403333, at *13 (S.D.N.Y. 2003) (stating that the preemption language in VARA "has essentially served to pre-empt state laws broadly—even those which are more protective in scope than the federal statute").

89. H.R. REP. NO. 100-609, at 34 (1988), *reprinted* in 9 NIMMER, *supra* note 33, at App. 32-34.

90. *Id.*; Lanham Act § 43(a), 15 U.S.C. § 1125(a)(1) (2000).

91. *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:7 (Rel. 36, Dec. 2005). *Erie* is known to every first-year law student for its declaration that "[t]here is no federal . . . common law." *Erie*, 304 U.S. at 78.

92. See 4 MCCARTHY, *supra* note 91, § 27:7 (describing the historical development of

As originally enacted, Section 43(a) created liability in one who, "in connection with any goods or services," used "a false designation of origin, or any false description or representation."⁹³ Out of this language, courts created "the foremost federal vehicle for the assertion of two major and distinct types of 'unfair competition': (1) infringement of even unregistered marks, names, and trade dress, and (2) 'false advertising.'"⁹⁴ Effective in 1989, Congress codified the two "prongs" of Section 43(a), and following a renumbering in 1992, the relevant portion of the statute reads as follows:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

Section 43(a) into a remedy for certain types of unfair competition). As for the definition of "unfair competition," it "describes an array of legal actions addressing methods of competition that improperly interfere with the legitimate commercial interests of other sellers in the marketplace." RESTATEMENT (THIRD) OF UNFAIR COMPETITION xi (1995). Defining "unfair competition" with greater specificity proves difficult, as explained in the following:

Unfair competition is a commercial tort. Can the tort of unfair competition be defined? The simple and honest answer to this question is no—not in the abstract. . . .

We do know that American law sets a minimum level of "fairness" in competition. In other words, it is illegal to compete "too hard." The very term used to label the whole area—"unfair" competition—reveals the absence of any overall definite standard. The word "unfair" is no more precise than many other legal terms whose purpose is to give discretion to a judge, such as, for example, "reasonable" or "adequate."

Courts have little success in defining unfair competition in the abstract, and often resort to statements such as "The controlling question . . . is whether the acts complained of are fair or unfair." When asked by his professor to define "unfair competition" a law student answered, "Well, it seems to me that the courts try to stop people from playing dirty tricks." The professor's comment was, "One might spend weeks reading cases and find many definitions less satisfactory than this."

1 MCCARTHY, *supra* note 91, § 1:8 (footnotes omitted).

93. 15 U.S.C. § 1125(a) (1988) (amended 1989).

94. 4 MCCARTHY, *supra* note 91, § 27:9.

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.⁹⁵

Thus, Section 43(a)(1)(A) contains the trademark prong—also referred to as the "false association" prong, and Section 43(a)(1)(B) contains the false advertising prong.⁹⁶

B. Importing Moral Rights into Section 43(a)

It would appear on first glance that the commercial character of the language employed by Section 43(a)—emphasizing "goods," "services," "commerce," and the like—is far removed from the expressly non-economic considerations that inform moral rights.⁹⁷ Indeed, it was not until 1976 that a creative plaintiff successfully joined the two in the landmark case of *Gilliam v. American Broadcasting Cos.*⁹⁸ In *Gilliam*, the ABC television network had heavily edited several episodes of the British television program "Monty Python's Flying Circus," excising approximately twenty-seven percent of the original content in anticipation of airing the episodes in the United States.⁹⁹ The members of Monty Python filed suit, seeking an injunction preventing ABC from airing the edited episodes on the grounds that ABC's editing constituted copyright infringement, and that it "mutilated the original work and that consequently the broadcast of those programs as the creation of Monty Python violated the Lanham Act § 43(a)."¹⁰⁰ The Second Circuit reversed the district court's denial of an injunction,¹⁰¹ interpreting the false association prong of Section 43(a) as follows:

It is sufficient to violate the Act that a representation of a product, although technically true, creates a false impression of the product's origin.

95. 15 U.S.C. § 1125(a)(1) (2000).

96. See 4 MCCARTHY, *supra* note 91, § 27:9 ("[A]fter the 1992 renumbering, the 'two prongs' of Section 43(a) are Section 43(a)(1)(A) and Section 43(a)(1)(B).").

97. Compare 15 U.S.C. § 1125(a)(1) (2000) (Section 43(a) of the Lanham Act), with Berne Convention, *supra* note 45 (Article 6bis of the Berne Convention).

98. See *Gilliam v. Am. Broad. Cos.*, 538 F.2d 14 (2d Cir. 1976) (holding that "an allegation that a defendant has presented to the public a . . . distorted version of plaintiff's work . . . should be recognized as stating a cause of action under [Section 43(a)].").

99. *Id.* at 19.

100. *Id.* at 24.

101. *Id.* at 17.

The[] cases [that have applied this standard] cannot be distinguished from the situation in which a television network broadcasts a program properly designated as having been written and performed by a group, but which has been edited, without the writer's consent, into a form that departs substantially from the original work. "To deform his work is to present him to the public as the creator of a work not his own, and thus makes him subject to criticism for work he has not done." In such a case, it is the writer or performer, rather than the network, who suffers the consequences of the mutilation, for the public will have only the final product by which to evaluate the work. Thus, an allegation that a defendant has presented to the public a "garbled," distorted version of plaintiff's work seeks to redress the very rights sought to be protected by the Lanham Act and should be recognized as stating a cause of action under that statute.¹⁰²

In effect, the Second Circuit recognized that Section 43(a) protects an author's right of integrity—the right "to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to"¹⁰³ his or her work.¹⁰⁴ The court acknowledged as much, stating:

American copyright law, as presently written, does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors. Nevertheless, the economic incentive for artistic and intellectual creation that serves as the foundation for American copyright law cannot be reconciled with the inability of artists to obtain relief for mutilation or misrepresentation of their work to the public on which the artists are financially dependent. Thus courts have long granted relief for misrepresentation of an artist's work by relying on theories outside the statutory law of copyright Although such decisions are clothed in terms of proprietary right in one's creation, they also properly vindicate the author's personal right to prevent the presentation of his work to the public in a distorted form.¹⁰⁵

Five years later, in *Smith v. Montoro*,¹⁰⁶ the Ninth Circuit further expanded the reach of Section 43(a) to encompass the right of attribution. In *Montoro*, actor Paul Smith sued the U.S. distributor of the movie *Convoy Buddies* for replacing Smith's name in the screen credits and advertising

102. *Id.* at 24–25 (citations omitted).

103. Berne Convention, *supra* note 45.

104. See 4 MCCARTHY, *supra* note 91, § 27:83 (discussing the application of Section 43(a) to the unauthorized editing of creative works). Professor McCarthy notes, however, that "where the alterations made without permission of the author or creator are relatively minor and inconsequential . . . there will be no violation of Lanham Act § 43(a)." *Id.*

105. *Gilliam v. Am. Broad. Cos.*, 538 F.2d 14, 24 (2d Cir. 1976).

106. See *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981) (holding that an allegation of "reverse passing off" states a valid claim under Section 43(a)).

materials with the name of another actor.¹⁰⁷ Smith's Section 43(a) claim was that the distributor violated the prohibition against "false designation[s] of origin" by engaging in "reverse palming off," also known as "'reverse passing off,' which occurs when a person removes or obliterates the original trademark, without authorization, before reselling goods produced by someone else."¹⁰⁸ In overturning the lower court's dismissal for failure to state a valid claim, the Ninth Circuit reasoned as follows:

According to appellant's complaint, defendants not only removed appellant's name from all credits and advertising, they also substituted a name of their own choosing. . . . As a matter of policy, such conduct . . . is wrongful because it involves an attempt to misappropriate or profit from another's talents and workmanship. Moreover, in reverse palming off cases, the originator of the misidentified product is involuntarily deprived of the advertising value of its name and of the goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product. The ultimate purchaser (or viewer) is also deprived of knowing the true source of the product and may even be deceived into believing that it comes from a different source.¹⁰⁹

The distributor argued that Section 43(a)'s protection from reverse passing off extends only to the "sale of goods," but the court disagreed, stating that "the Lanham Act explicitly condemns false designations or representations in connection with 'any goods or services'" and that this standard applies to false representations in films.¹¹⁰

Although the court never explicitly referenced moral rights, its recognition of Smith's Section 43(a) reverse passing off claim opened the door for authors

107. *Id.* at 603.

108. *Id.* at 605.

109. *Id.* at 606–07.

110. *Id.* at 605 (citing *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd.*, 467 F. Supp. 366 (S.D.N.Y. 1979), *aff'd*, 604 F.2d 200 (2d Cir. 1979)). The court explained why Section 43(a)'s protection extends to actors, in particular, as follows:

In the film industry, a particular actor's performance, which may have received an award or other critical acclaim, may be the primary attraction for movie-goers. Some actors are said to have such drawing power at the box office that the appearance of their names on the theater marquee can almost guarantee financial success. Such big box office names are built, in part, through being prominently featured in popular films and by receiving appropriate recognition in film credits and advertising. Since actors' fees for pictures, and indeed, their ability to get any work at all, is often based on the drawing power their name may be expected to have at the box office, being accurately credited for films in which they have played would seem to be of critical importance in enabling actors to sell their "services," i.e., their performances.

Id. at 607.

to assert their rights of attribution in the same way.¹¹¹ Combined with *Gilliam's* recognition of an implicit right of integrity cause of action, Section 43(a) became the foremost vehicle for authors to assert their moral rights in the United States.¹¹² In enacting the BCIA, Congress recognized this fact, and Section 43(a) was foremost among its justifications for its claim that existing U.S. law complied with Article 6bis.¹¹³ Whether or not Congress's claim of

111. See, e.g., *Lemothe v. Atl. Recording Corp.*, 847 F.2d 1403, 1404 (9th Cir. 1988) (concluding that Section 43(a) "provides relief to co-authors whose names have been omitted from a record album cover and sheet music featuring the co-authored compositions"); *Waldman Publ'g Corp. v. Landall, Inc.*, 43 F.3d 775, 781 (2d Cir. 1994) ("[T]he Lanham Act prohibits . . . the reproduction of a work with a false representation as to its creator. The misappropriation is of the artistic talent required to create the work."); *Johnson v. Jones*, 149 F.3d 494, 503 (6th Cir. 1998) (affirming district court's finding that defendant architect violated Section 43(a) by copying plaintiff architect's drawings and replacing plaintiff's name and seal with defendant's); *Selby v. New Line Cinema Corp.*, 96 F. Supp. 2d 1053, 1054–55 (C.D. Cal. 2000) (denying defendant's motion to dismiss Section 43(a) claim that defendant's screenplay and film *Frequency* "bodily appropriate[] and cop[y]" plaintiff's screenplay *Doubletime*); see also 3 NIMMER, *supra* note 33, § 8D.03[A][2][a] (stating that the rationales underlying *Smith v. Montoro* apply equally to authors as well as actors and to authors outside the motion picture context).

112. See, e.g., Paul Goldstein, *Copyright and Legislation: The Kastenmeier Years*, 55 LAW & CONTEMP. PROBS. 79, 90 (1992) ("Section 43(a) of the Lanham Act . . . may be the best that moral right advocates can hope for on the federal level."). Section 43(a) has been especially important in protecting the right of attribution. See GOLDSTEIN, *supra* note 61, § 17.24.2.1(b) ("Absent a contractual obligation, Section 43(a) of the Lanham Act, prohibiting misrepresentations in the sale of goods or services, at one time offered the greatest potential relief against a publisher's failure to attribute authorship."). Work-for-hire authors and authors who have parted with their copyright interests, in particular, have relied on Section 43(a). See, e.g., Robert Clarida et al., *Artists Don't Get No Respect: Panel on Attribution and Integrity*, 28 COLUM. J.L. & ARTS 435, 438 (2005) ("[I]t's interesting that these cases especially always arose where there was a reason for [a] copyright claim not to work."). It should be noted, however, that even Section 43(a)'s relatively broad protections for moral rights do not wholly conform to Article 6bis standards. For example, although the statute's standing requirements will generally protect work-for-hire authors—inasmuch as they can show they are "likely to be damaged"—the existence of a contractual agreement disclaiming a right to attribution may, in some circumstances, bar a Section 43(a) claim. See *Cleary v. News Corp.*, 30 F.3d 1255, 1259–61 (9th Cir. 1994) (discussing in dicta the possible effect of such a contractual provision on a reverse passing off claim brought by a work-for-hire author against his employer).

113. See *Hughes*, *supra* note 63, at 3 ("Lanham Act claims were arguably the keystone of the United States' claim of substantive equivalence to Article 6bis moral rights."); Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught in the Crossfire Between Copyright and Section 43(a)*, 77 WASH. L. REV. 985, 988 (2002) ("[S]ection 43(a) of the Lanham Act . . . frequently has been touted as the one federal enactment capable of safeguarding the right of attribution."); H.R. REP. NO. 100–609, at 34 (1988), *reprinted in* 9 NIMMER, *supra* note 33, at App. 32–34 (mentioning Section 43(a) as a basis for protecting moral rights and citing *Gilliam* for the proposition that "some courts have recognized the equivalent" of moral rights); *id.* at 32–37 (quoting Dr. Arpad Bogsch, the Director General of WIPO, who stated that he "believe[s] that in the United States the common law and such statutes (Section 43(a) of the Lanham Act) contain the necessary law to fulfill any obligation for the United States under

compliance was an accurate assessment of then-existing law,¹¹⁴ its continuing credibility hinges on Section 43(a) remaining a viable protection for moral rights.

IV. *Dastar Corp. v. Twentieth Century Fox Film Corp.*

In 2003, the Supreme Court handed down its decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*,¹¹⁵ a case with far-reaching implications for moral rights in the United States. The case arose out of *Crusade in Europe*, a 1949 Fox television series based on Dwight D. Eisenhower's memoir about the Allied campaign in Europe in World War II.¹¹⁶ Fox failed to renew its copyright in *Crusade in Europe*, and the series fell into the public domain in 1977.¹¹⁷ In 1995, Dastar edited a copy of *Crusade in Europe*, added a few original elements, and released the result as a video set entitled *World War II Campaigns in Europe*.¹¹⁸ In advertising, on the packaging, and onscreen, Dastar claimed credit for the video set with no reference to Fox or the original television series.¹¹⁹ Fox filed suit in 1998, claiming, among other things, that Dastar's failure to credit the original *Crusade in Europe* series constituted reverse passing off in violation of Section 43(a)(1)(A), the first prong of Section 43(a).¹²⁰ Put in the language of the statute, this was a claim that Dastar's act of crediting only itself was a "false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . as to the origin . . . of [its] goods."¹²¹ The district court granted summary judgment in favor of Fox, and the Ninth Circuit affirmed as to Fox's Section 43(a) claim.¹²² The Supreme Court granted certiorari to determine "whether § 43(a) of the Lanham Act . . . prevents the unaccredited copying of a work."¹²³

Article 6bis").

114. See *supra* note 63 and accompanying text (disputing the idea that, at the time of U.S. accession to the Berne Convention, existing U.S. law met the Article 6bis requirements).

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

116. *Id.* at 25–26.

117. *Id.* at 26.

118. *Id.* at 26–27.

119. *Id.* at 27.

120. *Dastar*, 539 U.S. at 27.

121. 15 U.S.C. § 1125(a)(1) (2000).

122. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 27–28 (2003).

123. *Id.* at 25.

It should be noted at this point that the facts of *Dastar* were far from conducive to a positive outcome for moral rights.¹²⁴ Not only was Fox not an "author," it was not even a "statutory author." Fox could not even claim to be a former statutory author because its lapsed copyright originally belonged to Time, Inc., which actually produced *Crusade in Europe* for Fox and subsequently assigned its copyright to Fox.¹²⁵ Fox was merely a former copyright holder—hardly a poster-child for the Romantic conception of authorship and certainly not an entity with any claim to moral rights in *Crusade in Europe*.

In addition, Fox's inability to rely on a claim of copyright infringement was due entirely to its own failure to take the simple step of renewing its copyright in the series, thus making Fox a less-than-sympathetic plaintiff and overemphasizing, perhaps, the significance of the fact that Section 43(a) and the Copyright Act can offer somewhat overlapping protections.¹²⁶ Finally, because Fox did not renew its copyright, *Crusade in Europe*—unlike the vast majority of works at issue in Section 43(a) claims—was in the public domain, where authors' interests are at their weakest in comparison to the public interest, and where, even under the Berne Convention, moral rights no longer apply.¹²⁷

Given these facts, it is unsurprising that moral rights and U.S. obligations under Article 6bis played almost no part in the parties' briefs,¹²⁸ generated only

124. See, e.g., Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263, 267 (2004) ("The facts of the case had nothing to do with authors [and] were very unappealing.").

125. See *Dastar*, 539 U.S. at 25–26, 35 (discussing Time's status as the original copyright holder and its role as the "principal, if not the exclusive, creator"). Time may not have been an author either, statutory or otherwise, in that the footage used in the series came entirely from other sources such as the U.S. military, though Time added narration and other elements. See *id.* at 35 (discussing the "origin" of *Crusade in Europe*). Admittedly, some attenuation between authors and their works has often been present in Section 43(a) claims involving attribution or integrity—the members of Monty Python, for example, were likely not the only people who could claim at least some degree of authorship in a given episode of *Monty Python's Flying Circus*—but the facts of *Dastar* were particularly egregious.

126. See *id.* at 33–34 (discussing the conflict between Section 43(a) and copyright almost exclusively by reference to the law dealing with *expired* copyrights and patents).

127. See *id.* at 33 ("The right to copy, and to copy without attribution, once a copyright has expired . . . passes to the public."); Berne Convention, *supra* note 45 (stating that an author's rights of attribution and integrity "shall, after his death, be maintained, at least until the expiry of the economic rights").

128. See generally Brief for Petitioners, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (No. 02–428), 2003 WL 367729; Brief for Respondents, *Dastar*, 539 U.S. 23 (No. 02–428), 2003 WL 1101321; Reply Brief, *Dastar*, 539 U.S. 23 (No. 02–428), 2003 WL 1610796.

a passing reference to the Berne Convention at oral argument,¹²⁹ and received not a single mention in the Court's opinion.¹³⁰ Instead, the opinion, written by Justice Scalia, framed the issue presented by stating that "[a]t bottom, we must decide what § 43(a)(1)(A) of the Lanham Act means by the 'origin' of

129. See Transcript of Oral Argument at 24, *Dastar*, 539 U.S. 23 (No. 02-428), 2003 WL 1876459 (mentioning the Berne Convention). The relevant portion of the argument is excerpted below:

QUESTION: Mr. Garre, before you finish, there was a reference in your brief that I didn't follow. It cropped up in another brief too, and it had—it was a reference to the Berne Convention. Could you—what is the relevance of that international treaty to this—to this case?

....

MR. GARRE [Assistant to the Solicitor General, on behalf of the United States, as amicus curiae]: It is relevant in that it's an international convention that—that covers copyrights, but we explain our brief it—we don't think that it affects the analysis in this case because it—as—as the Berne Convention Implementation Act states, it doesn't expand or reduce existing rights under—under domestic law.

Id. Although one would hope that the inquiring Justice did not rely on this woefully inadequate explanation of the Berne Convention's relevance to *Dastar*, the outcome of the case seems to imply otherwise. Certainly, the amicus brief Mr. Garre referred to sheds little light on the subject. After asserting the United States' "substantial interest in ensuring that domestic law is consistent with the United States' international obligations under the Berne Convention," it correctly points out that Congress believed that existing law complied with Article 6bis, but the brief does so without any mention in the text of Section 43(a)'s substantial role in that assessment. See Brief for the United States as Amicus Curiae Supporting Petitioner at 1, 9-10, *Dastar*, 539 U.S. 23 (No. 02-428), 2003 WL 544536 (discussing the BCIA's legislative history regarding Article 6bis).

Admittedly, a footnote does mention that *Smith v. Montoro* was a part of Congress's determination, *id.* at 10 n.5, but the subsequent Section of the brief dealing with *Montoro* fails to make clear the connection between that case, Section 43(a), and Berne compliance. Compare *id.* at 14-15 (explaining why *Montoro* represents a proper application of Section 43(a)), with Brief Amici Curiae of the Directors Guild of America et al. in Support of Respondents at 8-12, *Dastar*, 539 U.S. 23 (No. 02-428), 2003 WL 1101049 (explaining in detail why "[e]liminating the Lanham Act's protection against reverse passing off in the context of creative works would jeopardize the United States' compliance with the Berne Convention"). Perhaps this was because, contrary to the Court's eventual holding, the United States was arguing for only a slightly more limited interpretation of Section 43(a) that would continue to respect *Montoro* as good law, while barring claims with facts like those in *Dastar*. See Brief for the United States as Amicus Curiae Supporting Petitioner, *supra*, at 18-19 (arguing that, although Section 43(a) does protect against reverse passing off, courts should be cautious in ensuring that the statutory requirements are met, particularly in cases dealing with works in the public domain).

130. See generally *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003). The Court did mention VARA, but rather than acknowledge that VARA falls well short of Article 6bis requirements, see *supra* Part II.B.3, the Court instead determined that recognizing a cause of action for attribution in Section 43(a) would render VARA's attribution protections superfluous, and "[a] statutory interpretation that renders another statute superfluous is of course to be avoided." *Dastar*, 539 U.S. at 35.

'goods.'"¹³¹ The Court then determined that "the most natural understanding of the 'origin' of 'goods'—the source of wares—is the producer of the tangible product sold in the marketplace."¹³² Using that construction of the statutory language, the Court went on to conclude that "the phrase 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."¹³³

In so limiting the Lanham Act's protections, the Court explicitly rejected an exception for "communicative products" (i.e., "works of authorship"), because it perceived that such an exception would bring the Lanham Act into conflict with the Copyright Act.¹³⁴ As the Court explained, recognizing a valid Section 43(a) claim grounded in Dastar's representation that it originated the creative content of *Crusade in Europe* "would create a species of mutant copyright law that limits the public's federal right to copy and to use expired copyrights."¹³⁵ Furthermore, "[w]ithout a copyrighted work as the basepoint," argued the Court, "the word 'origin' has no discernable limits":¹³⁶

In many cases, figuring out who is in the line of "origin" would be no simple task. Indeed, in the present case it is far from clear that respondents have that status. . . . While Fox might have a claim to being in the line of origin, its involvement with the creation of the television series was limited at best. . . . If anyone has a claim to being the original creator of the material used . . . it would be those groups [that shot the footage], rather than Fox. We do not think the Lanham Act requires this search for the source of the Nile and all its tributaries.¹³⁷

131. *Dastar*, 539 U.S. at 31.

132. *Id.*

133. *Id.* at 37.

134. *See id.* at 33–34 (rejecting the argument "that the reality of purchaser concern is different for what might be called a communicative product—one that is valued not primarily for its physical qualities, such as a hammer, but for the intellectual content that it conveys, such as a book or, as here, a video" because it would "cause[] the Lanham Act to conflict with the law of copyright").

135. *Id.* at 34 (internal quotation marks omitted). In what was likely a bit of knowing irony, Justice Scalia's reference to "mutant copyright law" is one of several instances in which his opinion fails to attribute its word-for-word copying from Dastar's brief. *See* David Nimmer, *The Moral Imperative Against Academic Plagiarism (Without a Moral Right Against Reverse Passing Off)*, 54 DEPAUL L. REV. 1, 59–60 (2004) (comparing excerpts from Dastar's brief with excerpts from Justice Scalia's opinion). Professor Nimmer, who was one of the authors of Dastar's Supreme Court brief, notes that "[h]appily for Justice Scalia (as well as for the U.S. justice system), his own opinion in *Dastar* eliminates any right to maintain that those words in the Court's opinion represent reverse passing off, thus forestalling my colleagues and me from calling him to the bar!" *Id.* at 60.

136. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 35 (2003).

137. *Id.* at 35–36.

Clearly, the bad facts of Fox's case, in particular the fact that *Crusade in Europe* was in the public domain, played a more than ample role in the Court's rejection of a "communicative products" exception. Unfortunately for moral rights and Article 6bis compliance, the rule crafted in *Dastar* does not make any of those facts a point of distinction. Instead, *Dastar* stands for the broad, bright-line proposition that "'reverse passing off' claims brought under Lanham Act § 43(a)(1)(A) cannot focus on allegedly false claims of authorship, invention, or creation."¹³⁸

The Court's decision in *Dastar* has been roundly criticized for the overly broad rule it created and for its failure to consider Section 43(a)'s role in ensuring U.S. compliance with the Berne Convention.¹³⁹ Even many of those commentators who agree with the outcome in *Dastar* find fault with the Court's reasoning.¹⁴⁰ Many who argue that the rule created by *Dastar* was

138. 4 MCCARTHY, *supra* note 91, § 27:77.1 (footnotes omitted).

139. *See, e.g.*, GOLDSTEIN, *supra* note 61, § 17.14.1 (explaining why *Dastar*'s "attempt to distinguish physical goods—regulable under Section 43(a)(1)(A)—from the information or entertainment embodied in these goods—elements that are, in the Court's view, regulable only under copyright law"—is a distinction that "barely deserves to make a difference"); *Family Movie Act of 2004: Hearing on H.R. 4586 Before the Subcomm. on Courts, the Internet and Intellectual Property of the H. Comm. on the Judiciary*, 108th Cong. 10 & n.2 (2004) (statement of Marybeth Peters, Register of Copyrights, U.S. Copyright Office) (stating that the "ill-considered [*Dastar*] decision . . . has weakened the protection for moral rights that our laws offer" and that "the subcommittee should examine whether Section 43(a) of the Lanham Act should be amended to reflect what was the longstanding understanding prior to *Dastar*—that Section 43(a) is an important means for protecting the moral rights of attribution and integrity"); Graeme W. Austin, *The Berne Convention as a Canon of Construction: Moral Rights after Dastar*, 61 N.Y.U. ANN. SURV. AM. L. 111, 113, 115 (2005) (stating that "the premises upon which the Court appeared to base its solicitude for the public domain are unsound" and that "greater cognizance of the Berne Convention obligation under article 6bis might have prompted the Court to articulate a narrower rule that did not sweep away the protections to author attribution afforded by section 43(a)"); Michael Landau, *Dastar v. Twentieth Century Fox: The Need for Stronger Protection of Attribution Rights in the United States*, 61 N.Y.U. ANN. SURV. AM. L. 273, 291–303 (arguing that each of the Court's three bases for its holding in *Dastar* is flawed); Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171, 1185–86 (2005) ("Social protections against deceptive authorial attributions were not well defined, but they did exist under the rubric of trademark law. However, the Supreme Court's recent decision in [*Dastar*] has essentially eviscerated the primary basis of those protections.").

140. *See, e.g.*, 3 NIMMER, *supra* note 33, § 8D.02[D][6] (acknowledging that the Court gave "short shrift" to the Berne Convention but distinguishing the Article 6bis right "to claim authorship of the work" from the right Fox sought to vindicate in *Dastar*); 4 MCCARTHY, *supra* note 91, § 27:77.1 (agreeing with the outcome of *Dastar* but disagreeing with the Court's rationale that "to require attribution of the creative source of goods would . . . be inconsistent with its previous interpretations of the Lanham Act"); Mary LaFrance, *When You Wish upon Dastar: Creative Provenance and the Lanham Act*, 23 CARDOZO ARTS & ENT. L.J. 197, 206 (2005) ("What is surprising and somewhat troubling . . . is not [*Dastar*'s] specific holding with respect to expired copyrights, but [that] the . . . Court accepted, without adequate examination, a

unnecessarily broad also argue that lower courts can and should interpret *Dastar* more narrowly to be more consistent with Congress's intent that Section 43(a) be a means of complying with Article 6bis.¹⁴¹ The courts, however, have thus far declined to do so; instead, they have taken the Supreme Court at its word, holding that *Dastar* forecloses all Section 43(a)(1)(A) claims for attribution of creative works.¹⁴²

V. False Advertising: A Post-Dastar Protection for Moral Rights?

Dastar calls into question whether the right of integrity is still protected under Section 43(a)(1)(A), though there is not unanimous agreement on this

questionable interpretation of the language and the underlying legislative intent of section 43(a), drawing a tenuous and largely unsupported distinction between tangible and intangible goods."); Hughes, *supra* note 63, at 49 (stating that *Dastar* "shred[s]" the "keystone" of Congress's assertion of compliance with Article 6bis and that "the reasoning in *Dastar* is fundamentally unstable as an interpretation of Section 43(a), [but] that a narrower, more stable approach could have reached the same result with no negative impact on our mythology of patchwork protection").

141. See, e.g., Austin, *supra* note 60, at 146–49 (explaining how "the Berne Convention and the 'Charming Betsy' Rule provide a doctrinal basis for limiting the effect of the *Dastar* decision" to works whose copyrights have expired); Ginsburg, *supra* note 124, at 269–71 (discussing two ways in which *Dastar* may be factually distinguished from claims for attribution of authorship); Hughes, *supra* note 63, at 35–43 (arguing that *Dastar* should be understood narrowly to apply only to claims of a "false designation of origin" and not claims of a "false or misleading description of fact" or "representation of fact"); cf. Nimmer, *supra* note 135, at 43–44 (arguing that *Dastar* should be interpreted to foreclose only reverse passing off cases where the alleged falsehood is "of no consequence to purchasers" (quoting *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32–33 (2003))).

142. See, e.g., *Zyla v. Wadsworth, A Div. of the Thomson Corp.*, 360 F.3d 243, 251–52 (1st Cir. 2004) (concluding that *Dastar* bars plaintiff's claim that a credit in the acknowledgments of a textbook under-represents and misrepresents plaintiff's actual contribution in violation of Section 43(a)(1)(A)); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1183–85 (C.D. Cal. 2003) (disagreeing with the arguments that *Dastar* applies only to uncopyrighted works or, in the alternative, to the "origin of goods" rather than to the "origin of services"); *Carroll v. Kahn*, No. 03–CV–0656, 2003 WL 22327299, at *6 (N.D.N.Y. Oct. 9, 2003) ("[In *Dastar*,] the Supreme Court left the protection to the creative talent behind communicative products to the copyright laws. Accordingly, a Lanham Act claim based upon the failure to attribute proper credit must be dismissed."); *Smith v. New Line Cinema*, No. 03 Civ. 5274(DC), 2004 WL 2049232, at *4 (S.D.N.Y. Sep. 13, 2004) ("In light of *Dastar*, Smith, as the alleged author of the screenplay embodied in the tangible good offered for sale, is not the originator of the film."); cf. *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 149 (5th Cir. 2004) (stating in dicta that "GUS asserts that HAL copied the ideas, concepts, structures, and sequences embodied in its copyrighted [software]. In sum and substance, GUS's claim is simply a claim that HAL has infringed its copyright *Dastar* makes clear that such claims are not actionable under § 43(a)").

point.¹⁴³ The major treatises are in agreement, however, that under *Dastar*, the false association prong of Section 43(a) no longer offers any protection for the moral right of attribution.¹⁴⁴ Given that Congress's claim of compliance with Article 6bis hinges on the viability of Section 43(a) as a protection for moral rights, it would seem there can be little question that after *Dastar*, the United States is failing to meet its treaty obligations under Article 6bis of the Berne Convention.

The authorities, however, implicitly suggest an intriguing but virtually unexplored possibility by agreeing that Section 43(a)(1)(B), the "false advertising" prong of Section 43(a), is unaffected by *Dastar*.¹⁴⁵ This raises the obvious question: Can Section 43(a)(1)(B) fill Section 43(a)(1)(A)'s shoes in protecting moral rights? Because authors making claims under Section 43(a) have generally relied on the false association prong to protect their rights of attribution and integrity, courts have not squarely faced this question.¹⁴⁶

143. See 4 MCCARTHY, *supra* note 91, § 27:77.1 (stating that under *Dastar*, fact situations like those found in *Gilliam* and similar cases will no longer violate Section 43(a)(1)(A)); 3 NIMMER, *supra* note 33, § 8D.04[A][2] ("[T]here is reason to be chary that *Dastar* . . . may have pulled the rug out from the Second Circuit's ruling [in *Gilliam*]"). But see GILSON, *supra* note 77, § 7.02[6][d][i] ("The result in *Gilliam* remains sound under the Supreme Court's opinion in *Dastar*"); cf. GOLDSTEIN, *supra* note 61, § 17.24.1.2(b) (stating that *Dastar* "will probably not affect section 43(a)'s protection of an author's interest in not having a distorted work attributed to him").

144. See GOLDSTEIN, *supra* note 61, §§ 17.24.2.1(b)–2 (discussing *Dastar*'s effect on rights of attribution); 3 NIMMER, *supra* note 33, § 8D.03[A][2][b] (discussing *Dastar*'s effect on the ruling in *Smith v. Montoro*); 4 MCCARTHY, *supra* note 91, § 27:77.1 ("[T]he *Dastar* case means that . . . § 43(a)(1)(A)'s prohibition on false claims of origin cannot be extended to false claims of the creation of inventive or communicative works. Thus, 'reverse passing off' claims brought under Lanham Act § 43(a)(1)(A) cannot focus on allegedly false claims of authorship, invention or creation."); GILSON, *supra* note 77, § 7.02[6][d][ii][A] ("After the Supreme Court's opinion in *Dastar*, the important question is . . . is the plaintiff claiming that its authorship of a creative work is falsely represented by the defendant's statement of the origin of the work? If so . . . plaintiff may not succeed under *Dastar*.").

145. See GOLDSTEIN, *supra* note 61, § 17.14.3 ("Because the Court's opinion addressed only Section 43(a)(1)(A), it left open the possibility for relief against reverse passing off of literary and artistic works under 43(a)(1)(B)."); 3 NIMMER, *supra* note 33, § 8D.03[A][2][B] ("[T]he Court's opinion construed only the 'origin' clause contained in the first paragraph of Section 43(a); it therefore remains possible for a party to fall afoul of the second paragraph of that provision by engaging in false advertising."); 4 MCCARTHY, *supra* note 91, § 27:77.1 ("[F]act situations such as found in well-known cases such as the 'Monty Python' decision and the false actor's credit case of *Smith v. Montoro* will be in violation of Lanham Act § 43(a) only if they fit within the criteria of the 'false advertising' prong of Lanham Act § 43(a)(1)(B)."); GILSON, *supra* note 77, § 7.02[6][d][ii] (stating that a "creative plaintiff" may still have a cause of action after *Dastar* under Section 43(a)(1)(B)).

146. But cf. *Tao of Sys. Integration, Inc. v. Analytical Servs. & Materials, Inc.*, 299 F. Supp. 2d 565, 571–74 (E.D. Va. 2004) (dismissing under *Dastar* a reverse passing off claim that defendant presented plaintiff's ideas as its own in a proposal for a NASA contract but

Furthermore, the fact that the two prongs of Section 43(a) evolved largely independently of one another suggests that the answer is by no means an obvious one—a Section 43(a)(1)(B) claim is not simply a Section 43(a)(1)(A) claim applied to advertising.¹⁴⁷

On this point, *Silvers v. Sony Pictures* may prove useful. Silvers's copyright claim in that case can readily be recast in moral rights terms—in essence, that Sony's failure to attribute Silvers's authorship of the screenplay from which *Stepmom* was derived, instead attributing authorship solely to itself, violated Silvers's moral right of attribution.¹⁴⁸ In the past, this claim could

denying a motion to dismiss, without discussion of *Dastar*, a false advertising claim based on the same conduct).

147. Compare 4 MCCARTHY, *supra* note 91, § 27:13 (listing the elements of a prima facie Section 43(a)(1)(A) case), with 4 MCCARTHY, *supra* note 91, § 27:24 (listing the elements of a prima facie Section 43(a)(1)(B) case). In one of the few commentaries to discuss false advertising as a protection for moral rights, Professor Ginsburg addresses one of these differences between the two prongs of Section 43(a). See Ginsburg, *supra* note 124, at 276–79 (discussing the issue of materiality in false advertising claims); see also *infra* Part V.D (same). Parties and courts, however, often fail to acknowledge that there are distinctions between the elements and analysis of the two prongs other than Section 43(a)(1)(B)'s "use in advertising" requirement. And sometimes, even the advertising distinction escapes their notice. Consider the case of *Carroll v. Kahn*, No. 03–CV–0656, 2003 WL 22327299 (N.D.N.Y. Oct. 9, 2003), in which Plaintiff documentary filmmaker's complaint simply alleged that Defendants' acts "constitute[d] a false designation of origin and other violations of . . . section 43(a)." Verified Complaint at para. 135, *Carroll*, No. 03–CV–0656, 2003 WL 24152706. Although there was one reference to how Defendants "marketed" the film in question, *id.* at para. 142, the complaint offered no further explanation of what was meant by "marketed" and essentially alleged only that Defendants failed to properly credit plaintiff and "misrepresented that Defendants owned rights to the film and copyright," *id.* at para. 60, 142. In ruling on Defendants' motion to dismiss, the court's analysis was no more specific as to which prong of Section 43(a) the claim arose under. *Carroll*, 2003 WL 22327299, at *5–6. For example, the court characterized it as "contend[ing] that Defendants improperly marketed the film as belonging to them and, thus, falsely represented the origin of the film," *id.* at *2, yet the court failed to take the obvious next step of considering whether "marketing" implicates the first or second prong of Section 43(a). Indeed, nowhere in its opinion did the court even acknowledge that Section 43(a) has subsections, let alone two distinct prongs with independent elements and jurisprudence. Instead, the court blithely asserted that "[t]o the extent Plaintiff claims that Defendants repackaged Plaintiff's product as their own, then the Complaint states a claim. A Lanham Act claim based on Defendants' alleged failure to give Plaintiff proper credit as author and/or producer, however, is foreclosed by *Dastar*." *Id.* at *5. This lack of clarity and specificity is not uncommon and is, to some degree, understandable—after all, Section 43(a) is, as one commentator put it, "an onion of complexity." Jean Wegman Burns, *Confused Jurisprudence: False Advertising Under the Lanham Act*, 79 B.U. L. REV. 807, 835 (1999). Still, one would hope that judges and lawyers put forth at least some effort in peeling back the layers.

148. See *supra* Part I (discussing *Silvers v. Sony Pictures*). Sony's actions can be described as both a failure to attribute and a misattribution, as demonstrated by *Smith v. New Line Cinema*, No. 03 Civ. 5274(DC), 2004 WL 2049232 (S.D.N.Y. Sep. 13, 2004). In *Smith*, the plaintiff alleged that the film *The Cell* was an unauthorized derivative of the plaintiff's screenplay. *Id.* at *1. Professor Hughes explains that "*The Cell* obviously credited someone as

have been brought in federal court under Section 43(a)(1)(A) as a claim that Sony's misattribution was a "false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which [was] likely to cause confusion, or to cause mistake . . . as to the origin . . . of [*Stepmom*]." ¹⁴⁹ Of course, *Dastar* now precludes such a use of Section 43(a)(1)(A). But because Silvers's hypothetical right of attribution claim appears to fall well within the pre-*Dastar* ambit of Section 43(a) and does not present the sort of bad facts that plagued Fox, it is an excellent vehicle for testing whether Section 43(a)(1)(B) can replace its sister prong as a means of enforcing authors' moral rights and, as a result, prevent *Dastar* from bringing the United States out of compliance with its international obligations. Thus, the remainder of this Part will seek to answer the following hypothetical: Could Silvers obtain an injunction against Sony on the grounds that Sony's misattribution of authorship constituted "false advertising" in violation of Section 43(a)(1)(B) of the Lanham Act? ¹⁵⁰

the screenwriter(s) and did not credit Smith, so there were both assertions and omissions." Hughes, *supra* note 63, at 42. In arguing for a narrow understanding of *Dastar*, Professor Hughes makes much of the distinction between non-attribution and misattribution, *id.* at 38–43, but those are issues that are beyond the scope of this Note.

149. 15 U.S.C. § 1125(a)(1) (2000). As mentioned previously in this Note, Silvers did bring a claim of this type under California unfair competition law, but it was dismissed by the trial court because Silvers failed to distinguish it sufficiently from her copyright claim. See *supra* note 77 (discussing Silvers's state unfair competition claim). Subsequent to *Dastar*, however, Silvers's state claim would have been dismissed regardless of any flaw in her pleading because "[t]he Ninth Circuit has consistently held that claims brought under California unfair competition law are 'substantially congruent' to claims brought under the Lanham Act" and thus, *Dastar* controls both. See *Twentieth Century Fox Film Corp. v. Dastar Corp.*, No. CV98–07189FMC(EX), 2003 WL 22669587, at *2, *5 (C.D. Cal. Oct. 14, 2003) (dismissing Fox's state unfair competition claim because of the Supreme Court's ruling on its Section 43(a) claim in *Dastar*); see also *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1183–86 (C.D. Cal. 2003) (stating that *Dastar* precludes plaintiff's Lanham Act claim and denying plaintiff's motion to amend complaint to include a state law unfair competition cause of action because "[t]he Ninth Circuit has consistently held that [such] claims are 'congruent' with Lanham Act claims; [p]laintiff's putative unfair competition claim would fail for the same reasons his Lanham Act claim fails").

150. See 15 U.S.C. § 1125(a)(1)(B) (2000) (defining the false advertising prong of Section 43(a)). Although the statutory remedies available for violations of registered trademarks are also available for violations of Section 43(a), including profits, damages, and costs, 15 U.S.C. § 1117(a) (2000), an injunction preventing Sony from continuing to market *Stepmom* without attributing authorship to Silvers would undoubtedly be a satisfactory remedy. As applied to videotape and DVD sales, for example, Sony would be faced with three basic options. First, Sony could stop selling *Stepmom* and pull all outstanding copies from store shelves. Second, Sony could go to the expense of correcting the packaging and credits of all outstanding videotape and DVD copies. Third, Sony could settle the case, compensating Silvers for its misattribution. It seems unlikely that Sony would be willing to completely write-off video and DVD sales of *Stepmom*, and either of its other two options would vindicate Silvers's right of

A. Preliminary Considerations

At the outset, several of the elements of a Section 43(a)(1)(B) claim may be dispensed with relatively simply.¹⁵¹ First, "[t]he use of actors' names in film credits and/or in advertising for the film should usually qualify as a use 'in commercial advertising or promotion.'"¹⁵² Given that screenwriters receive credit in the same way and in the same places as film actors, the "advertising or promotion" requirement¹⁵³ of Section 43(a)(1)(B) should be met in Silvers's case. Second, the fact that *Stepmom* was released and advertised worldwide should be more than sufficient to guarantee that Silvers's claim will satisfy the "uses in commerce" requirement.¹⁵⁴ Third, film prints, videotapes, and DVDs of *Stepmom* clearly constitute "goods."¹⁵⁵

Finally, if Sony's misattribution was in fact false advertising, Silvers was likely damaged by it.¹⁵⁶ For Sony to have made a truthful attribution, it would have had to acknowledge that *Stepmom* is a derivative of *The Other Woman* and obtain a license to make such a derivative from Frank & Bob Films.¹⁵⁷ Silvers's contract with Frank & Bob Films probably provided for payment to Silvers of a portion of the proceeds from such a license. Furthermore, just like "being accurately credited for films in which they have played would seem to be of critical importance in enabling actors to sell their 'services,'"¹⁵⁸ accurate credit for films they have written (or partially written) is critical in enabling screenwriters to sell their services. It is therefore likely that the ability to claim

attribution. Furthermore, "[c]ompared to the showing necessary to obtain an injunction, a higher standard of proof is required to recover damages." 4 MCCARTHY, *supra* note 91, § 27:42. Thus, the analysis in this Part will focus on the elements necessary to obtain an injunction under Section 43(a)(1)(B).

151. See 15 U.S.C. § 1125(a)(1)(B) (2000) (describing the elements of a Section 43(a) false advertising claim). For simplicity's sake, other preliminary considerations such as jurisdiction and statutes of limitations will not be discussed in this Note. For a general discussion of those subjects, see 4 MCCARTHY, *supra* note 91, § 27:45–46, 48.

152. 4 MCCARTHY, *supra* note 91, § 27:85 (quoting 15 U.S.C. § 1125(a)(1)(B) (2000)).

153. 15 U.S.C. § 1125(a)(1)(B) (2000).

154. *Id.* § 1125(a)(1); see also 4 MCCARTHY, *supra* note 91, § 27:47 (explaining the statute's use of the phrase "uses in commerce").

155. See 15 U.S.C. § 1125(a)(1) (2000) ("Any person who, on or in connection with any goods . . .").

156. See *id.* § 1125(a)(1)(B) (making a false advertiser "liable in a civil action by any person who believes that he or she is or is likely to be damaged by [the false advertising]").

157. See 17 U.S.C. § 106 (2000) ("[T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following: . . . (2) to prepare derivative works based upon the copyrighted work.").

158. *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981).

that *Stepmom* was based on *The Other Woman* would have enhanced Silvers's future employment prospects.

B. Standing

Although the language of the statute grants standing to "any person who believes that he or she is or is likely to be damaged" by a particular instance of false advertising,¹⁵⁹ "something more than a plaintiff's mere subjective belief that it is likely to be injured is required before injunctive relief is appropriate."¹⁶⁰ As with many aspects of Section 43(a), the specifics of this "something more" vary from circuit to circuit.¹⁶¹ The threshold consideration is whether the plaintiff and defendant are direct competitors.¹⁶² "[S]tanding will ordinarily be almost automatic if the parties are competitors,"¹⁶³ and in the Seventh, Ninth, and Tenth Circuits, the parties *must* be in competition to have standing to sue for injunctive relief for false advertising.¹⁶⁴ In the remaining circuits, "[i]n cases where the parties are not in direct competition, a likelihood of damage can be shown by a likely loss of sales, or by damage to reputation which in turn will likely cause a decline in income."¹⁶⁵ In seeking an injunction, no proof as to actual causation or injury is necessary.¹⁶⁶

159. 15 U.S.C. § 1125(a)(1) (2000).

160. 4 MCCARTHY, *supra* note 91, § 27:28.

161. See GILSON, *supra* note 77, § 7.02[6][a] ("[T]he various courts have yet to speak with one voice on how the Section should be applied. There is considerable agreement, however, and interpretative patterns have emerged which can reasonably be applied to various fact situations. At the same time, it is usually necessary to review the cases circuit-by-circuit."). For a discussion of the overall confusing state of Section 43(a) false advertising jurisprudence, see Burns, *supra* note 147.

162. 4 MCCARTHY, *supra* note 91, § 27:32 (discussing non-competitor standing).

163. *Id.* § 27:31.

164. *Id.* § 27:32. In these circuits, the requirement that the parties be in competition is unique to false advertising claims; actions brought under the first prong of Section 43(a) have no such requirement. See *Jack Russell Terrier Network of N. Cal. v. Am. Kennel Club, Inc.*, 407 F.3d 1027, 1037 (9th Cir. 2005) (describing the different standing requirements of the two prongs of Section 43(a)). The Ninth Circuit has softened this rule somewhat by requiring only that a plaintiff allege that "the injury was 'competitive,' i.e., harmful to the plaintiff's ability to compete with the defendant." *Barrus v. Sylvania*, 55 F.3d 468, 470 (9th Cir. 1995). The Seventh Circuit does not presume standing, even when the parties are in competition—the plaintiff must still "produce some evidence of either actual damage or the probability of future damage." 4 MCCARTHY, *supra* note 91, § 27:28.

165. 4 MCCARTHY, *supra* note 91, § 27:31 (footnotes omitted).

166. See *id.* § 27:28 n.4 (citing *Southland Sod Farms v. Stover Seed Co.*, 108 F.3d 1134, 1145–46 (9th Cir. 1997)).

Nonetheless, a plaintiff must make "at least the minimal showing required" in a given circuit.¹⁶⁷

If Silvers were to bring her hypothetical false advertising claim in the Ninth Circuit, as she did with her copyright infringement claim, she would have to show that she is in competition with Sony. *Lamothe v. Atlantic Recording Corp.*¹⁶⁸ seems to suggest that if Silvers were to name *Stepmom*'s credited screenwriters as parties to the suit, the competition requirement would be satisfied as to all parties, including Sony.¹⁶⁹ In *Lamothe*, defendant Crosby and plaintiffs Lamothe and Jones had been members of the band Mac Meda.¹⁷⁰ When Mac Meda disbanded, Crosby joined the rock group RATT, which released versions of two songs written by Lamothe, Jones, and Crosby on one of its albums.¹⁷¹ The album packaging and sheet music, however, credited only Crosby and a fellow member of RATT, making no mention of Lamothe and Jones's contributions.¹⁷² Lamothe and Jones filed suit against Crosby, the record company, and the sheet music company, among others.¹⁷³ In allowing the claim to proceed, the Ninth Circuit acknowledged its rule that "the actionable 'conduct must not only be unfair but must in some discernable way be competitive'"¹⁷⁴ and stated that "[t]he defendants [did] not dispute that the plaintiffs and Crosby are competitors in the relevant market."¹⁷⁵ The court's phrasing of the foregoing statement, combined with the absence of any further discussion of the competition requirement, suggests that the plaintiffs did not need to show that they were also in competition with the record company and the sheet music company in order to satisfy the requirement as to all defendants.¹⁷⁶ Under this standard, Silvers is clearly in competition with the

167. *Id.* § 27:33.

168. *Lamothe v. Atl. Recording Corp.*, 847 F.2d 1403 (9th Cir. 1988).

169. *See id.* at 1405–06 (explaining why plaintiffs have stated a valid cause of action under Section 43(a)). The screenwriters credited in *Stepmom* were Gigi Levangie, Jessie Nelson, Steven Rogers, Karen Leigh Hopkins, and Ron Bass. The Internet Movie Database, *Full Cast and Crew for Stepmom*, <http://www.imdb.com/title/tt0120686/fullcredits> (last visited Feb. 22, 2006) (on file with the Washington and Lee Law Review).

170. *Lamothe*, 847 F.2d at 1405.

171. *Id.* at 1405 & n.1.

172. *Id.* at 1405.

173. *Id.* at 1403.

174. *Id.* at 1406 (quoting *Halicki v. United Artists Comm., Inc.*, 812 F.2d 1213, 1214 (9th Cir. 1987)).

175. *Lamothe*, 847 F.2d at 1046.

176. *See id.* (discussing the application of the competition requirement to the facts of the case). Although this is the clear implication of the court's discussion of the issue, it should be noted that the court in *Lamothe* analyzed the case under the first prong of Section 43(a) without deciding whether the defendants' actions could also have constituted false advertising. *Id.*

screenwriters who did receive credit in *Stepmom*, and thus she should have standing in the Ninth Circuit to bring a false advertising suit against both the screenwriters and Sony.

Silvers should also have standing to bring a false advertising claim in any of the circuits that allow non-competitor standing by showing a likelihood of damage based on "damage to reputation which in turn will likely cause a decline in income."¹⁷⁷ In *Smith v. Montoro*,¹⁷⁸ the plaintiff had standing because of the "vital interest of actors in receiving accurate credit for their work."¹⁷⁹ Screenwriters have no less of an interest in accurate credit and perhaps have an even greater interest, given that, unlike actors, their contribution cannot be identified from their personal appearance onscreen. As a result, Silvers should also have standing in the circuits allowing for non-competitor standing.

C. False or Misleading Representations of Fact

For a court to impose liability on Sony, Silvers must show that "false" or "misleading" statements in *Stepmom*'s advertising "misrepresent[ed] the nature, characteristics, [or] qualities" of *Stepmom*.¹⁸⁰ The *Gilson* treatise defines the parameters of Section 43(a)(1)(B)'s falseness inquiry as follows:

The courts apply Section 43(a)(1)(B) to a wide variety of advertising and other commercial conduct that imparts in interstate commerce a "false or misleading description of fact, or false or misleading representation of fact." They have not made a substantive distinction between "description" and "representation," but the claimed false advertising must . . . misrepresent the "nature, characteristics, qualities, or geographic origin of goods or services." Although a "false designation of origin" can also misrepresent, that term is generally identified with an infringing trademark under Section 43(a)(1)(A).¹⁸¹

constituted false advertising. *Id.* When *Lamothe* was decided in 1988, however, the Ninth Circuit applied the competition requirement to cases brought under either prong of Section 43(a). See 4 MCCARTHY, *supra* note 91, § 27:32 (explaining how the Ninth Circuit's 1987 decision in *Halicki* that limited standing under Section 43(a) to competitors was restricted to false advertising cases in *Waits v. Frito-Lay, Inc.*, 972 F.2d 1093 (9th Cir. 1992)).

177. 4 MCCARTHY, *supra* note 91, § 27:31.

178. *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981).

179. *Id.* at 608. *Montoro* was decided several years before *Halicki*, in which the Ninth Circuit adopted its rule limiting standing in Section 43(a) cases to competitors. *Halicki*, 812 F.2d at 1214. Because the circuits allowing non-competitor standing have rejected the *Halicki* rule, they are still likely to view the *Montoro* standing rationale as good law.

180. 15 U.S.C. § 1125(a)(1)(B) (2000).

181. GILSON, *supra* note 77, § 7.02[6][a].

This understanding of "falseness" under Section 43(a)(1)(B) suggests three possible ways in which Sony's misattribution of authorship in *Stepmom* could be actionably false: as a false designation of origin, as a false representation of fact, or as a misleading representation of fact. The determination as to which of these three options most accurately describes Sony's actions will be critical to the outcome of Silvers's hypothetical false advertising case.

The long shadow of *Dastar* suggests that Silvers would need to be cautious in making an argument that Sony's misattribution was a "false designation of origin." It is true that the statement in *Dastar* that "the phrase 'origin of goods' refers [only] to the producer of the tangible goods"¹⁸² is unquestionably a reference to Section 43(a)(1)(A)'s language regarding "confusion . . . as to the origin . . . of . . . goods"¹⁸³ and not the term "false designation of origin," which is applicable to either prong of Section 43(a).¹⁸⁴ Nonetheless, courts and commentators are not always careful to make this distinction. The *Gilson* treatise, for example, contends that even in a Section 43(a)(1)(B) false advertising claim, "the important question is . . . is the plaintiff claiming that its authorship of a creative work is falsely represented by the defendant's statement of the origin of the work? If so, it does not matter how much of plaintiff's work is 'appropriated' . . . plaintiff may not succeed under *Dastar*."¹⁸⁵

This application of *Dastar* to false advertising seems to rely on an implicit assumption that a claim based on a "false designation of origin" can only apply to the Section 43(a)(1)(A) "likely to cause confusion . . . as to the origin . . . of . . . goods" consideration¹⁸⁶ and not to the Section 43(a)(1)(B) "misrepresents the nature . . . of . . . goods" consideration.¹⁸⁷ Not only does this assumption contradict the treatise's earlier assessment that "a 'false designation of origin' can also misrepresent [under 43(a)(1)(B)],"¹⁸⁸ it also appears unsupported by the plain language of the statute, which makes any of the acts listed in Section 43(a)(1), including a false designation of origin, actionable under either prong.¹⁸⁹ The reading in *McCarthy on Trademarks* of

182. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

183. 15 U.S.C. § 1125(a)(1)(A) (2000). The phrase "origin of goods" appears only in the first prong of Section 43(a). *Id.* § 1125(a)(1).

184. *See id.* § 1125(a)(1) (prohibiting "any false designation of origin" that meets the requirements of either prong of Section 43(a)).

185. GILSON, *supra* note 77, § 7.02[6][d][ii][A].

186. 15 U.S.C. § 1125(a)(1)(A) (2000).

187. *Id.* § 1125(a)(1)(B).

188. GILSON, *supra* note 77, § 7.02[6][a].

189. 15 U.S.C. § 1125(a)(1) (2000).

Dastar's general applicability to Section 43(a)(1)(B) false attribution claims seems more in harmony with the statutory language:

The Supreme Court decision in *Dastar* means that . . . fact situations such as found in the well-known cases such as the "Monty Python" decision and the false actor's credit case of *Smith v. Montoro* will be in violation of Lanham Act § 43(a) only if they fit within the criteria of the "false advertising" prong of Lanham Act § 43(a)(1)(B). That is, the challenged false attribution must be "in commercial advertising or promotion" and must misrepresent "the nature, characteristics, [or] qualities" of the work.¹⁹⁰

Because the authorities, however, are not in clear agreement on this point and courts have shown their willingness to apply *Dastar* broadly,¹⁹¹ Silvers would have to be very careful in making a claim that the falseness of Sony's advertising lies in a false designation of *Stepmom's* origin. Moreover, if Silvers could rely on one of the other two options for showing falseness under Section 43(a)(1)(B), she would probably be wise to do so.

Silvers's second possible option in characterizing the falseness of Sony's advertising would be as a literally false description or representation of fact that "misrepresents the nature, characteristics, [or] qualities"¹⁹² of *Stepmom*. The advantage of showing literal falseness is that it allows a court to grant relief without the plaintiff having to show "how consumers perceive its message or claim."¹⁹³ In other words, "[i]f a plaintiff proves a challenged claim is literally false, a court may grant relief without considering whether the buying public was misled."¹⁹⁴ This is in contrast to advertising that "is literally true, but in context becomes likely to mislead," in which case "a plaintiff must produce evidence, usually in the form of market research or consumer surveys," showing that consumers actually are misled by the literally true advertising.¹⁹⁵ To distinguish between advertising that is "literally false" and advertising that is "misleading," "[t]he Eight[h] Circuit has proposed a rule of thumb":

190. 4 MCCARTHY, *supra* note 91, § 27:77.1.

191. *See supra* note 142 (listing cases in which lower courts have construed the rule in *Dastar* broadly).

192. 15 U.S.C. § 1125(a)(1)(B) (2000).

193. *See* 4 MCCARTHY, *supra* note 91, § 27:55 (describing the "two alternative types of false advertising"). Literal falseness may, in some cases, also allow a plaintiff to avoid having to prove "materiality." *See infra* Part V.D. (discussing the materiality requirement).

194. *Johnson & Johnson-Merck Consumer Pharm. Co. v. Rhone-Poulenc Rorer Pharm.*, 19 F.3d 125, 129 (3d Cir. 1994).

195. 4 MCCARTHY, *supra* note 91, § 27:55.

"The greater the degree to which a message relies upon the viewer or consumer to integrate its components and draw the apparent conclusion . . . the less likely it is that a finding of literal falsity will be supported. Commercial claims that are implicit, attenuated, or merely suggestive usually cannot fairly be characterized as literally false." An advertising claim that legitimately has two meanings, one true, one false, is not in the literally false category.¹⁹⁶

Assuming, for the moment, that Silvers's claim that *Stepmom* is a derivative of *The Other Woman* is true, there are several ways in which Sony's advertising could be viewed as literally false. First, because the *Lamothe* decision "can be read as standing for the rule that telling only part of the truth in such a way that it creates a misleading impression is a false designation illegal under § 43(a),"¹⁹⁷ *Stepmom*'s "Story by Gigi Levangie"¹⁹⁸ credit would be literally false inasmuch as it fails to disclose Silvers's contribution to the story.¹⁹⁹ Similarly, "[i]t has been held that a copyright infringer who uses his

196. *Id.* (quoting *United Indus. Corp. v. Clorox Co.*, 140 F.3d 1175, 1181 (8th Cir. 1998)). Whether formulations such as this are helpful in actual practice, however, is open to dispute. See Burns, *supra* note 147, at 866 ("Unfortunately, the judicial findings distinguishing literal from implied falsity have the same *ad hoc*, eye-of-the-beholder quality that permeates so much of section 43(a)(1)(B) jurisprudence."). Highlighting the often subjective nature of the determinations courts make in these cases, Professor Burns points to the following:

Among the claims that courts have found to be literally false are a statement that a pregnancy test worked "in as fast as 10 minutes"; a claim that a hemorrhoid medication "stopped pain immediately" and was "new"; the description "rice based" on a product containing rice syrup solids but not rice or rice carbohydrates. On the other hand, courts have found no literal falsity in claims that a product kills all roaches within 24 hours; a golf course is a "replica," "copy," and "simulation" of another; a cough medicine "starts to work instantly"; and that a brokerage firm had "passed Century 21 to become the largest volume real estate organization in the United States and Canada."

Id. at 866–67 (footnotes omitted). Furthermore, statements that would otherwise be literally false will be non-actionable if they are merely "puffing," which is described as "exaggerated advertising, blustering, and boasting upon which no reasonable buyer would rely." 4 MCCARTHY, *supra* note 91, § 27:38; see also Richard J. Leighton, *Materiality and Puffing in Lanham Act False Advertising Cases: The Proofs, Presumptions, and Pretexes*, 94 TRADEMARK REP. 585, 616–27 (2004) (discussing the "puffing" defense in false advertising cases and other related contexts). As the title of Leighton's article suggests, puffing is also relevant to the issue of "materiality," discussed *infra* Part V.D.

197. 4 MCCARTHY, *supra* note 91, § 27:65.

198. The Internet Movie Database, *supra* note 169.

199. See 4 MCCARTHY, *supra* note 91, § 27:65 (describing how "attribution of a work to only one of several joint authors is a false designation" under the Ninth Circuit's decision in *Lamothe*); see also *Blank v. Pollack*, 916 F. Supp. 165, 172 (N.D.N.Y. 1996) (denying a motion to dismiss a Section 43(a)(1)(B) claim that "the defendant[']s . . . design was seriously flawed, and that the plaintiff made such extensive alterations to the design . . . that, as it exists today, it must be said to have originated from his ingenuity, not the defendant").

own name on the infringing work, even in a copyright notice, violates Lanham Act § 43(a)'s false representation prohibition.²⁰⁰ Thus, Sony's copyright notice in its own name and perhaps even its statement that *Stepmom* is "A Sony Pictures Production"²⁰¹ might also be viewed as literally false under Section 43(a)(1)(B).

Of course, for a court to recognize any of these claims as false descriptions or representations, Silvers would have to show that they are in fact false. In most circuits, courts apply the same "substantial similarity" test that they use to determine a case of copyright infringement.²⁰² Thus, in these circuits, Silvers's claim that Sony used false representations in *Stepmom*'s advertising would turn on the same test that would have determined the outcome of her original claim for copyright infringement, had that case been allowed to continue to the merits.²⁰³ The exception, however, would be if Silvers brought her false advertising case in the Ninth Circuit, where "there must be a 'bodily appropriation' of plaintiff's work, not just substantial similarity," for there to be a violation of Section 43(a).²⁰⁴ This is not an impossible standard, but it is probably not one Silvers could meet.²⁰⁵

200. 4 MCCARTHY, *supra* note 91, § 27:80 (footnote omitted). *But see id.* § 27:79 ("[T]he Second Circuit in 1996 laid down a flat rule that a copyright infringer's use of a copyright notice in its own name is by itself insufficient to trigger a falsity claim under § 43(a).").

201. STEPOM, *supra* note 3.

202. *See* 4 MCCARTHY, *supra* note 91, § 27:81 (discussing situations in which a copyright infringer claims to be the creator of the infringing work). For extensive discussions of the substantial similarity standard as applied to copyright infringement, see 2 GOLDSTEIN, *supra* note 61, at § 7.3; 4 NIMMER, *supra* note 33, at § 13.03.

203. *See Silvers v. Sony Pictures Entm't, Inc.*, 402 F.3d 881, 883 (9th Cir. 2005) (describing Silvers's claim as alleging that the movie *Stepmom* was substantially similar to the script for *The Other Woman*), *cert. denied*, 126 S. Ct. 367 (2005).

204. *See* 4 MCCARTHY, *supra* note 91, § 27:81 (citing *Shaw v. Lindheim*, 908 F.2d 531, 542 (9th Cir. 1990), *amended by* No. 88-6677, 1990 U.S. App. LEXIS 20420 (9th Cir. Nov. 23, 1990) (listing changes to be made to portions of the court's opinion not related to Lanham Act claim), *and superseded by*, 919 F.2d 1353 (9th Cir. 1990) (implementing the changes listed in the amending order)).

205. *See Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994) ("In the copyright context we have defined 'bodily appropriation' as the 'copying or unauthorized use of substantially the entire item.' We consider this definition useful in the Lanham Act context." (quoting *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989))). In *Cleary*, the court found that "[w]hile the 1990 edition of *Robert's Rules [of Order]* is similar in many respects to the 1970 edition, the changes between the editions are not so slight that the 1990 edition can be considered a 'bodily appropriation' of the 1970 edition." *Id.* Although the Ninth Circuit did not expressly adopt the "copying or unauthorized use of substantially the entire item" test as the test for bodily appropriation, *id.*, nearly all of the cases in which courts have found bodily appropriation could meet that standard. *See, e.g., Zito v. Steeplechase Films, Inc.*, 267 F. Supp. 2d 1022, 1029 (N.D. Cal. 2003) ("[D]efendants['] inclusion of a copy of plaintiff's copyrighted photograph in their documentary film is a bodily appropriation of

If, for some reason, a court were unwilling to construe Sony's statements as literally false, Silvers could still attempt to show that they were misleading. The same proof discussed above would still be required, but she would also have to "produce evidence, usually in the form of market research or consumer surveys, showing exactly what message ordinary consumers received" from Sony's ads.²⁰⁶ Silvers could probably meet this requirement—it is hard to imagine that surveyed consumers would understand the statement "Story by Gigi Levangie," for example, to mean anything but that Levangie was the sole creator of the film's story.²⁰⁷ The expense of obtaining such survey information, however, would likely be highly burdensome. Therefore, a claim that Sony's statements were misleading rather than literally false should only be used as a fallback position if a claim of literal falsity was foreclosed.

D. Material Misrepresentation

Under Section 43(a), an advertiser is liable if it "misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities." Judicial interpretation has added its own gloss to this language. For a misrepresentation to be actionable, consumers must find the claim it makes to be material—that is, it must affect the consumer's purchasing decision.²⁰⁸

In some cases, however, a finding of literal falsity will trigger a presumption of materiality.²⁰⁹ If Silvers were to succeed in showing literal falsity in the Fifth

plaintiff's work.").

206. See 4 MCCARTHY, *supra* note 91, § 27:55 (explaining the requirements of a claim that advertising is "misleading" but not "literally false").

207. Cf. *id.* (describing the requirements of a consumer survey).

208. GILSON, *supra* note 77, § 7.02[6][b][i][C] (footnotes omitted).

209. Leighton, *supra* note 196, at 596–97. This presumption is described as follows:

Where the offending claim is literally false, a violation of Lanham Act Section 43(a) may be established without evidence that the statements actually misled consumers because "[a]ctual deception is presumed." Based on this presumption, an impressive array of courts found it logical to hold that the related element of materiality may be presumed from a literally false claim. . . . Recent cases show a split among the federal circuits and even within the Second Circuit on whether courts may presume materiality from literal falsity.

Id. (footnotes omitted). The circuits that generally recognize the presumption include the Second, Fifth, Seventh, and D.C. Circuits. See *id.* at 596–97 & n.61 (citing *Pizza Hut, Inc. v. Papa John's Int'l, Inc.*, 227 F.3d 489, 497 (5th Cir. 2000); *Avila v. Rubin*, 84 F.3d 222, 227 (7th Cir. 1996); *Castrol, Inc. v. Quaker State Corp.*, 977 F.2d 57, 62 (2d Cir. 1992)); *PPX Enters., Inc. v. Audiofidelity Enters., Inc.*, 818 F.2d 266, 272 (2d Cir. 1987); *ALPO Petfoods, Inc. v. Ralston Purina Co.*, 720 F. Supp. 194, 214 (D.D.C. 1989)). But see *IQ Prods. Co. v.*

Circuit, for example, materiality would probably be presumed.²¹⁰ A few other courts have created a presumption of materiality by "equat[ing] proof of materiality with its sister element, proof of injury."²¹¹ Generally, the rationale for equating materiality with injury is that "a separate materiality element is unnecessary because it is 'merely [a] different way[] of paraphrasing the

Pennzoil Prods. Co., 305 F.3d 368, 376 (5th Cir. 2002) (deciding allegedly false advertising was not material without deciding whether it was literally false or not); Nat'l Basketball Ass'n v. Sports Team Analysis, 939 F. Supp. 1071, 1109–10 (S.D.N.Y. 1996) (same), *aff'd in part, rev'd in part sub nom.*, Nat'l Basketball Ass'n v. Motorola, Inc., 105 F.3d 841 (2d Cir. 1997). The circuits that generally do not presume materiality from literal falsity include the First Circuit and the Eleventh Circuit. See Leighton, *supra* note 196, at 597 & n.63 (citing Johnson & Johnson Vision Care v. 1–800 Contacts, 299 F.3d 1242, 1250–51 (11th Cir. 2002); Cashmere & Camel Hair Mfrs. Inst. v. Saks Fifth Ave., 284 F.3d 302, 312 n.10 (1st Cir. 2002)).

210. See *Pizza Hut, Inc. v. Papa John's Int'l, Inc.*, 227 F.3d 489, 497 (5th Cir. 2000) ("With respect to materiality, when the statements of fact at issue are shown to be literally false, the plaintiff need not introduce evidence on the issue of the impact the statements had on consumers. In such a circumstance, the court will assume that the statements actually misled consumers."). Although it appears that the court in *Pizza Hut* was confusing the issue of materiality (i.e., likelihood of influencing consumers' purchasing decisions) with the issue of falseness (i.e., likelihood of deceiving consumers), later Fifth Circuit decisions followed the *Pizza Hut* rule. See, e.g., *Sw. Recreational Indus. v. FieldTurf, Inc.*, No. 01–50073, 2002 WL 32783971, at *3 (5th Cir. Aug. 13, 2002) ("[W]here a defendant has made literally false statements, the plaintiff need not demonstrate that the statements actually misled consumers, for we assume that false statements are materially deceptive."). Within weeks of its decision in *FieldTurf*, however, the Fifth Circuit appears to have recognized this confusion in *IQ Prods. Co. v. Pennzoil Prods. Co.*, 305 F.3d 368 (5th Cir. 2002). Without discussing *Pizza Hut*, the court in *IQ Products* wrote the following:

Even if the district court erred in finding that IQ failed to present a genuine issue of material fact on the literal falsity of the defendants' statement that Fix-A-Flat was "non-explosive," which we do not decide, IQ failed to produce competent summary judgment evidence that it was harmed by the defendants' allegedly false and misleading advertisement. IQ presented no competent summary judgment evidence that indicates that consumers would have bought IQ's tire inflator products instead of Fix-A-Flat in the absence of the defendants' allegedly false and misleading statements.

Id. at 376. If the court were following the *Pizza Hut* rule, IQ's failure to present evidence that the advertising would influence consumers' purchasing decisions would not have been dispositive without a determination whether the advertising statement was literally false or simply misleading. Thus, *IQ Products* seems to cast doubt on the *Pizza Hut* rule that materiality will be presumed if challenged advertising is literally false. Another way of viewing the Fifth Circuit's decisions in this area, however, and perhaps those of other courts recognizing the presumption, may be suggested by a possible justification for adding a materiality requirement to the statutory language, which is "to treat [materiality] as part of the plaintiff's proof of 'likely' damage from the defendant's misrepresentation." Burns, *supra* note 147, at 872. Of course, treating materiality in this way presents its own set of problems. See *id.* (describing the conflict between this view of materiality and the proof requirements for an injunction).

211. Leighton, *supra* note 196, at 600.

statutory requirement that the plaintiff show injury or likely injury caused by a false or misleading statement."²¹²

If Silvers was unable to show literal falsity or if she brought her case in a court that does not recognize a presumption of materiality, she would have to demonstrate that Sony's false advertising would affect customers' purchasing decisions.²¹³ Because there are no clear standards for determining materiality and court decisions are therefore inconsistent, it is difficult to predict how a court would rule on this issue in Silvers's case.²¹⁴ Certainly, it would be unreasonable for her to argue that the average consumer's movie purchasing decisions are in any way influenced by who is named in the writing credits.²¹⁵

Rather, Silvers's best argument would be that the very fact that film advertising almost always includes credits the average consumer cares nothing about—the screenwriter, the director of photography, the production designer, etc.—indicates that film credits are not directed toward the average consumer. Instead, the consumers targeted by film credits are the potential future employers of those credited. The standardized content, format, and layout for film credits in advertising is ubiquitous—it is seen, for example, at the bottom of movie posters and newspaper and magazine ads, at the end of television ads, and on the back of videotape and DVD packaging. Film studios display credits in such a uniform manner across all forms of advertising because their agreements with the trade unions representing writers, actors, directors, and

212. *Id.* (quoting Michael A. Albert & Robert L. Bocchino Jr., *Trade Libel: Theory and Practice Under the Common Law, the Lanham Act, and the First Amendment*, 89 TRADEMARK REP. 826, 853 n.165 (1999)).

213. *See* 4 MCCARTHY, *supra* note 91, § 27:35 (discussing the materiality requirement); *see also* Burns, *supra* note 147, at 873 (citing *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 855 (2d Cir. 1997); *Tire Kingdom, Inc. v. Morgan Tire & Auto, Inc.*, 915 F. Supp. 360, 366 (S.D. Fla. 1996); *Compaq Computer Corp. v. Procom Tech., Inc.*, 908 F. Supp. 1409, 1426–27 (S.D. Tex. 1995); *In re Century 21-Re/Max Real Estate Adver. Claims Litig.*, 882 F. Supp. 915, 923–24 (C.D. Cal. 1994)).

214. *See* Burns, *supra* note 147, at 873 (discussing the lack of standards for determining materiality). To demonstrate this lack of clear standards, Professor Burns states:

For instance, courts have found the following to be immaterial claims: a claim that falsely stated the technical aspects of a product, an advertisement that falsely represented reimbursement "two and a half times faster" than competitors, an advertisement that falsely suggested that two tires were different when the only difference was in the warranty, and an advertisement that used a photograph of a component made by a different company. On the other hand, two courts held that the slogan "As seen on TV" is a material misrepresentation.

Id. at 873 n.299 (citations omitted).

215. *See* Ginsburg, *supra* note 124, at 276–78 (discussing the problem posed by the "materiality" requirement in a Section 43(a)(1)(B) claim for attribution).

others require them to do so.²¹⁶ The interest of these trade unions, as reflected in the concessions they extract from the studios, is not in giving accurate information to the general movie-going public but in protecting the interests of their members, a large part of which is helping to ensure their members' future employability.²¹⁷ Viewed in this light, Sony's misattribution is material in that potential employers who chose not to hire Silvers to write their screenplays may have chosen differently had Silvers been accurately credited as a writer of *Stepmom* (or as the writer of the work on which *Stepmom* was based).

E. Denouement

So where does this hypothetical application of Section 43(a)(1)(B) false advertising leave U.S. moral rights protection: basking in the radiant, blinding-white smile of *Stepmom*'s Julia Roberts, or withering under the cruel, icy glare of *Cinderella*'s Wicked Stepmother? The answer lies somewhere in between. From the foregoing discussion, it does appear that Nancey Silvers could make out a prima facie case of false advertising against Sony for its alleged misattribution of *Stepmom*. Thus, it seems that Section 43(a)'s false advertising prong has at least some potential to protect authors' moral rights of attribution.

Yet the limitations unique to Section 43(a)(1)(B) claims, not the least of which is the threshold requirement that the falsity occur "in commercial advertising or promotion,"²¹⁸ make clear that false advertising cannot fully replace the pre-*Dastar* moral rights protections offered by Section 43(a)(1)(A). Furthermore, Congress's claim of compliance with Article 6bis was tenuous, at best, when it was made in 1988,²¹⁹ and *Dastar* has since foreclosed not only Section 43(a)(1)(A), the "keystone"²²⁰ of Congress's

216. See, e.g., The Internet Movie Database, *The Writers Guild of America*, <http://www.imdb.com/wga> (last visited Mar. 4, 2006) (describing the process used to determine screenwriting credits) (on file with the Washington and Lee Law Review).

217. See WRITERS GUILD OF AMERICA, WEST, GUIDE TO THE GUILD 2, http://www.wga.org/uploadedFiles/who_we_are/fyiwho.pdf (last visited Mar. 4, 2006) ("Our primary duty is to represent our members in negotiations with film and television producers to ensure the rights of screen, television, and new-media writers. . . . Writers' livelihoods often depend on the careful and objective determination of credits.") (on file with the Washington and Lee Law Review).

218. 15 U.S.C. § 1125(a)(1)(B) (2000).

219. See *supra* note 63 and accompanying text (noting that the idea that U.S. law already existing at the time of Berne Convention adherence met the Article 6bis requirements has been widely disputed).

220. Hughes, *supra* note 63, at 49.

patchwork justification, but also many of the state claims on which Congress relied.²²¹ As a result, the moral rights protections potentially offered under false advertising not only fail to restore fully what was lost under *Dastar*, they also fail to restore credibility to Congress's claim of compliance.²²²

Moreover, despite the fact that *Dastar*, by its terms, applies only to Section 43(a)(1)(A),²²³ there is no guarantee that courts will not find that *Dastar* also forecloses claims for attribution brought under Section 43(a)(1)(B). After all, lower courts have not shown much interest in limiting *Dastar*'s reach thus far, and a court would not be unreasonable to find that the rationales underlying the decision in *Dastar* are also applicable to false advertising. Certainly, the Supreme Court's concern with creating "a species of mutant copyright,"²²⁴ for example, carries equal weight in regard to any false advertising of *Crusade in Europe* as to *Crusade in Europe*'s origin. And because courts hearing false association claims have failed to credit the distinction that the "mutation" in *Dastar* arose from the fact that *Crusade in Europe* was in the public domain, it seems unlikely that they would do otherwise in the false advertising context.²²⁵

If a Section 43(a)(1)(B) claim like that in the Silvers hypothetical ever does come before a court, however, and the court rules that the claim is foreclosed by *Dastar*, at least the case could be appealed to the Supreme Court with a full discussion of Section 43(a)'s crucial role in U.S. compliance with the Berne Convention (and without the bad facts that plagued Fox in *Dastar*). Faced squarely with the choice between endorsing the broad interpretation of the *Dastar* rule and ending U.S. compliance with its obligations to the other 159 nations of the Berne Union, the Court would have a significant incentive to adopt a limited view of the rule, perhaps making explicit the public domain limitation that was implicit in its decision in *Dastar*.²²⁶ Thus, false advertising does offer some degree of hope for

221. See *supra* note 77 & 149 (discussing Silvers's state unfair competition claim).

222. See Ginsburg, *supra* note 124, at 279 ("Ultimately . . . attempts to salvage authors' claims against misattribution under section 43(a)[(1)(B)] prove strained or insufficient.").

223. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 31 (2003) ("At bottom, we must decide what § 43(a)(1)(A) of the Lanham Act means by the 'origin' of 'goods.'").

224. *Id.* at 34.

225. See *supra* note 142 (citing cases in which courts have adopted a broad reading of *Dastar*).

226. See *supra* notes 134–43 and accompanying text (describing the Supreme Court's rationales for its holding in *Dastar*); see also *supra* note 141 (listing possible means of limiting *Dastar*).

moral rights in the United States, regardless of whether the lower courts would initially be willing to recognize such claims.

VI. Conclusion

Unfortunately, even if a right of attribution false advertising claim were litigated to the Supreme Court and resulted in a limiting of the *Dastar* rule, this would only restore the pre-*Dastar* status quo in which Congress's claim of compliance with Article 6bis "[f]ew] in the face of numerous judicial and scholarly pronouncements on the subject."²²⁷ The fact would remain that the moral rights of integrity and attribution receive no explicit protection under U.S. law, except for the few works covered by VARA.²²⁸ Even before *Dastar*, Section 43(a) was never a "moral rights law"—any overlap between the interests protected by Section 43(a) and those protected by Article 6bis is a function of coincidence rather than design.²²⁹ In truth, the avenues offering moral rights protection in the United States are really more akin to back alleys.²³⁰

Yet satisfactory solutions seem likely to prove elusive. Just as the Supreme Court could restore the pre-*Dastar* status quo, Congress could do the same by amending Section 43(a).²³¹ But for the United States to embrace fully Article 6bis, Congress would have to amend the Copyright Act to offer the

227. 3 NIMMER, *supra* note 33, § 8D.02[D][1]; *see also supra* note 63 (citing commentators who have disputed Congress's claim that existing U.S. law satisfied Article 6bis).

228. 17 U.S.C. §§ 101, 106A (2000); *see also* Gilliam v. Am. Broad. Cos., 538 F.2d 14, 24 (2d Cir. 1976) ("American copyright law, as presently written, does not recognize moral rights or provide a cause of action for their violation.").

229. *See supra* Part III.A (discussing the legislative history of Section 43(a)); Kwall, *supra* note 113, at 1020 ("As is true of judicial applications of copyright law, courts render section 43(a) determinations quite apart from any consideration of the authorial interests at stake when the right of attribution is at issue.").

230. *See* Kwall, *supra* note 113, at 1020–25 (explaining why "plaintiffs attempting to obtain a remedy for reverse passing off are disserved through their forced reliance on section 43(a) to redress violations that should properly be addressed within the scope of an independent right of attribution").

231. *See Family Movie Act of 2004: Hearing on H.R. 4586 Before the Subcomm. on Courts, the Internet and Intellectual Property of the H. Comm. on the Judiciary*, 108th Cong. 10 & n.2 (2004) (statement of Marybeth Peters, Register of Copyrights, U.S. Copyright Office) (stating that the "ill-considered [*Dastar*] decision . . . has weakened the protection for moral rights that our laws offer" and that "the subcommittee should examine whether section 43(a) of the Lanham Act should be amended to reflect what was the longstanding understanding prior to *Dastar*—that section 43(a) is an important means for protecting the moral rights of attribution and integrity").

moral rights of attribution and integrity to all authors. If the experience of VARA is any indicator, however, the unanimous voices of corporate copyright owners, which also prevented implementation of moral rights legislation in 1988,²³² would no doubt similarly eviscerate the protections any amendment would provide.²³³

Nonetheless, one of the key arguments urged by those in favor of U.S. adherence to the Berne Convention was the following:

By joining the Berne Union, the United States would raise its law and practice to the level accepted by Berne members, who are among its closest copyright allies and best customers, and thereby achieve political credibility in its international copyright relations. Adherence would constitute a declaration by the United States that it understands the responsibilities that flow from the worldwide appeal of U.S. national authorship, and that U.S. law will take into fair consideration the needs of the global cultural community.²³⁴

In fact, an interest in strengthening U.S. "moral authority" in international copyright was at issue in nearly all of the arguments favoring adherence to the Berne Convention,²³⁵ as echoed by a former Secretary of Commerce, who stated that U.S. adherence to the Berne Convention "is simply the right thing to do . . . for a great nation," and that "it will let us hold our heads higher in the world of international copyright."²³⁶

In failing to effectively implement Article 6*bis*, Congress has allowed corporate copyright owners to define the limits of U.S. moral authority, thereby undermining the very political and moral credibility that the United States sought to gain from adherence to the Berne Convention in the first place. As Edward J. Damich, currently Chief Judge of the U.S. Court of Federal Claims, told Congress: "It is hypocritical of the United States to enforce strictly the economic articles of the Berne Convention against noncomplying nations,

232. See 3 NIMMER, *supra* note 33, § 8D.02[C] & n.29–31 ("During the debate over the BCIA, Congress faced an avalanche of opposition to moral rights, including denunciations of moral rights by some of the bill's most vociferous advocates.").

233. *But cf.* Ginsburg, *supra* note 124, at 301–06 (describing the contours of an acceptable moral rights amendment to the Copyright Act); Landau, *supra* note 139, at 314 (same).

234. Oman, *supra* note 28, at 112.

235. See *id.* at 110–13 (summarizing the arguments favoring adherence that were made in *The Implications, Both Domestic and International, of U.S. Adherence to the International Union for the Protection of Literary and Artistic Works: Hearings Before the Subcomm. on Patent, Copyrights and Trademarks on the S. Comm. on the Judiciary, 99th Cong.* (1987)).

236. 3 NIMMER, *supra* note 33, § 8D.02[D][2] n.90 (internal quotation marks omitted) (quoting *Hearings on S. 1301 and S. 1971 Before the Subcomm. on Patents, Copyright and Trademarks, of the S. Comm. on the Judiciary, 100th Cong.* 76 (1988) (statement of Secretary C. William Verity, Department of Commerce)).

while at the same time to take a casual approach to [A]rticle 6bis.²³⁷ When Article 6bis so clearly grants to authors moral rights in their creations, why should Nancey Silvers have to rely on a claim of false advertising under trademark law to see those rights vindicated? If the United States wishes to continue to "hold its head higher" and remain a world leader in copyright, both morally and economically, then it would be wise to find less circuitous routes to comply with its international obligations.

237. *Moral Rights in our Copyright Laws: Hearings Before the Subcomm. on Patents, Copyrights and Trademarks, of the S. Comm. of the Judiciary* 42, 101st Cong. (1989) (statement of Edward J. Damich). *Nimmer on Copyright* makes a similar point:

The United States has joined the Berne Convention primarily for the sake of moral leadership in the world copyright community. Yet by its minimalist approach, the United States leaves itself open to the charge that it is failing to comply with some very important Berne provisions. Prudential behavior dictates that, in order to reap the benefits that flow from appearing to be moral, the U.S. must undertake activities that will be perceived as moral. "The United States should not be perceived as imposing a double standard on the rest of the world." That combination of self-interest and morality may well lead the United States to increase the measure of moral rights that it accords. For it is morally questionable to proclaim one's moral leadership while failing to accord clearly (as opposed to arguably) sufficient moral rights.

3 NIMMER, *supra* note 33, § 8D.02[D][2] (footnotes omitted).