

# Misunderestimating *Dastar*: How the Supreme Court Unwittingly Revolutionized Copyright Preemption

by  
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## Abstract

Courts and commentators have misunderstood, and consequently underestimated, the recent Supreme Court case of *Dastar Corp. v. Twentieth Century Fox Film Corp.* Voicing concern that once a copyrighted work has fallen into the public domain it should stay there, the *Dastar* Court held that authors of such works cannot use federal unfair competition law to force copiers to give them credit. The Court guaranteed that result by stipulating that "origin" in § 43(a)(1)(A) of the Lanham Act does not refer to the source of an idea, concept, or communication. That holding barred a reverse passing off claim brought under § 43(a) against *Dastar Corp.* for its having sold videotapes without crediting the plaintiffs as the origin of formerly-copyrighted material included on those tapes. Because lower courts have focused on the legal means employed by the *Dastar* Court, however, rather than its evident policy goals, they have extended it to facts materially different from those at issue in the case. Courts have applied the case to bar Lanham Act claims against the unauthorized use of copyrighted, uncopyrightable, and trade secret-protected goods. Courts have stretched it to cover services, too. Most significantly, in a move that effectively doubles *Dastar's* reach, courts have even begun applying the case to bar unfair competition claims brought under state law. Although they don't apparently realize it, courts relying on *Dastar* to preempt state unfair competition claims have signaled a revolution in copyright law. Ever since the enactment of Copyright Act § 301(a) nearly thirty years ago, the express terms of that section have monopolized copyright preemption doctrine. But § 301(a) cannot explain or justify *Dastar's* evident power to preempt state unfair competition claims. Intentionally or not, the *Dastar* court has revived the long-moribund and somewhat ill-defined doctrine of implied copyright preemption. Here, even more than with regard to unfair competition, *Dastar's* consequences look likely to far outreach the Court's original, modest aims. We have surely underestimated *Dastar's* impact on unfair competition law. With regard to copyright law, however, we may still have time to understand and estimate *Dastar's* ultimate ramifications.

# Misunderestimating *Dastar*: How the Supreme Court Unwittingly Revolutionized Copyright Preemption

## Outline

### I. Introduction

### II. What *Dastar* and its Progeny Say: Copyright Limits Federal Unfair Competition Law

#### A. *Dastar* Itself

#### B. *Dastar* in the Courts

1. Expanding *Dastar* to Copyrighted Works
2. Expanding *Dastar* to Other Intellectual Properties
  - a. Uncopyrightable Works
  - b. Trade Secrets
  - c. Subject Matter Within the Scope of Patent Law
3. Expanding *Dastar* to Services
4. Expanding *Dastar* to State Law Reverse Passing Off Claims

#### C. *Dastar* in the Commentary

### III. What *Dastar* and its Progeny Do

#### A. Copyright Preempts State Unfair Competition Law

#### B. Direct Supremacy Clause Preemption, Rediscovered

### IV. Consideration of the Objection that § 301(a) Preempts Reverse Passing Off Claims

### V. The Future of Copyright Preemption

### VI. Conclusion

# Misunderestimating *Dastar*: How the Supreme Court Unwittingly Revolutionized Copyright Preemption

## I. Introduction

The Supreme Court case of *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>1</sup> has suffered from a misunderstanding. When it first issued, especially, many people took the case at face value. They assumed that *Dastar* meant what it said and, therefore, that it did little more than interpret the Lanham Act to exclude reverse passing off claims premised on misrepresentations about the source of uncopyrighted works. In other words, *Dastar* meant simply that you wouldn't face a federal lawsuit for claiming authorship of a formerly-copyrighted work that nobody now owns.

It soon became apparent, however, that *Dastar* meant something else—something bigger and unexpected. Lower courts applying the case focused not on the aims that explained its holding, but rather on the specific mechanism through which the *Dastar* Court had tried to achieve those aims: By stipulating that "origin" in § 43(a)(1)(A) of the Lanham Act did not mean the source of any idea, concept, or communication.<sup>2</sup> When read as a case amending § 43(a), *Dastar* suddenly applied not just to once-copyrighted works that had fallen into the public domain, but to copyrighted, uncopyrightable, and trade secret-protected works, too. Furthermore, the case also applied not just to goods embodying those works, but also to services. As judicial decisions (if not necessarily judicial opinions) have now begun to recognize, moreover, *Dastar* covers both federal and state unfair competition claims. That move effectively doubled *Dastar's* already expansive application. Nobody—including, notably, the Supreme Court—seems to have predicted that *Dastar* would have such far-reaching effects on the law of unfair competition.

*Dastar* promises to have an even more surprising and extensive impact, however, on copyright law. Although courts and commentators have yet to notice it, *Dastar* signals a revolution in copyright law's power to preempt state laws. As with regard to the effects the case has already had on unfair competition law, it is not at all evident that the Court wanted *Dastar* to open new—or, more accurately, to reopen forgotten—vistas in copyright preemption. For nearly thirty years, copyright law has relied almost entirely on the preemption rules expressly set forth in 301(a) of the Copyright Act.<sup>3</sup> Now, suddenly, *Dastar* has revived the long-moribund and somewhat ill-defined doctrine of *implied* copyright preemption. With regard to copyright preemption even more than with regard to unfair competition, *Dastar's* ultimate and extraordinary consequences look likely to far outreach the Court's original, modest aims. How was the case so sorely underestimated?

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<sup>1</sup> 539 U.S. 23 (2003).

<sup>2</sup> 539 U.S. at 37.

<sup>3</sup> 17 U.S.C.S. § 301(a) (2005).

Because it was so sorely misunderstood. *Dastar*, in a word, has been *misunderestimated*.

I describe *Dastar* as *misunderestimated* advisedly. After President George W. Bush used that word in a number of public statements, some mocked it as an all-too characteristic slip of the tongue.<sup>4</sup> But U.S. presidents have a long and honored history of crafting neologisms. President Thomas Jefferson, for instance, gets credit for originating over sixty words, including *authentication*, *countervailing*, *doll-baby*, *public relations*, and (less famously) *vomit grass*.<sup>5</sup> President Teddy Roosevelt coined *lunatic fringe* and gave *muckraker* its current, primary meaning.<sup>6</sup> Why not likewise credit President Bush for a new and useful word? At all events, let us not abandon *misunderestimate* to the jibes of political satirists. What word better combines, in one neat bundle, the distinct but related ideas of misunderstanding and underestimation? One who *misunderestimates* fails both to fully comprehend his subject and, consequently, to fully predict its ramifications.<sup>7</sup> That, in a very apt word, perfectly describes how courts and commentators have interpreted *Dastar*.

If notwithstanding that plea on behalf of *misunderestimate* you still find it hard to take the word seriously, so much the better. The word's somewhat comical implications suit *Dastar*, too. Singularly peculiar facts drove the Supreme Court's reasoning in that case, facts that have yet to recur in any lower court. Nonetheless, that has not prevented lower courts from using *Dastar* to significantly change the scope of unfair competition and copyright law. They do not thereby take liberties with *Dastar*; the plain language of the case obviously supports, and arguably even mandates, its application to facts far different than those before the Supreme Court. Still, we might very well wonder whether the Supreme Court really wanted that result. It looks very much as if the Court said far more than it meant to say precisely because aimed only to cast a moderate interpretive gloss on § 43(a) Lanham Act. Just as legislators sometimes choose statutory language that wreaks unintended consequences, however, the Supreme Court's clarification of the Lanham Act has reshaped federal and state unfair competition law and launched a revolution in copyright law.

Part II discusses what *Dastar* says by comparing the case itself with its reception in lower courts and in academic commentary. As that comparison demonstrates, *Dastar* has already displayed a tendency to have far greater effects than anyone at first expected.

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<sup>4</sup> See, e.g., Snopes.com, "Make the Pie Higher," at <<http://www.snopes.com/politics/bush/piehigher.asp>> (including the word in a poem constructed entirely of Bush misstatements and documenting the word's origin).

<sup>5</sup> David G. Post, "*The Free Use of Our Faculties*": *Thomas Jefferson, Cyberspace, and the Language of Social Life*, 49 *DRAKE L. REV.* 407, 418 (2001).

<sup>6</sup> Michael Quinion, *World Wide Words*, at <<http://www.worldwidewords.org/reviews/repre2.htm>> (reviewing ALLAN METCALF, *PRESIDENTIAL VOICES* (Houghton Mifflin 2004)).

<sup>7</sup> So, at least, I define the word. Since so few people take the word seriously, few disagree with my definition. *But see* Langmaker, "Misunderestimate," at <[http://www.langmaker.com/db/eng\\_misunderestimate.htm](http://www.langmaker.com/db/eng_misunderestimate.htm)> (defining the word as "To be excessively underestimated to the point of being ignored or ridiculed."). Since that source evidently cannot distinguish a verb from an adverb, however, it merits little regard.

Part III explains how *Dastar* stands ready to surprise us yet again, this time in the area of copyright preemption doctrine. Does that prediction err by mischaracterizing the extant scope of preemption under § 301(a)? Part IV carefully considers and rejects that critique. Part V thus ventures a few predictions about what will result if, as seems likely, *Dastar* resurrects implied copyright preemption. Part VI wraps things up by briefly recapping this paper's arguments.

## II. What *Dastar* and its Progeny Say: Copyright Limits Federal Unfair Competition Law

This Part contrasts the meaning of *Dastar* with what lower courts and commentators take the case to say. As section A describes, the *Dastar* Court argued from a variety of broad policy concerns to a narrow conclusion about the meaning of a single word in § 43 (a)(1)(A) of the Lanham Act.<sup>8</sup> As section B describes, lower courts have focused on that latter aspect of *Dastar*, reading the case to have effectively amended § 43(a)(1)(A) in all its applications. In so doing, lower courts have expanded *Dastar*'s reach far beyond what the Supreme Court's policy concerns mandated or even suggested. Section C surveys what commentators have said about *Dastar*, revealing that they have said little about its late-breaking expansion in lower courts and nothing about the preemption issues the case raises, a topic considered in Part III of this paper.

### A. *Dastar* Itself

In *Dastar Corp. v. Twentieth Century Fox Film Corporation*,<sup>9</sup> the Supreme Court addressed whether § 43(a)(1)(A) of the Lanham Act affords a claim against the reverse passing off of a once-copyrighted film that has fallen into the public domain. The plain language of that section puts anyone using in commerce a mark that "is likely to cause confusion . . . as to the origin . . . of his or her goods"<sup>10</sup> at risk of civil liability for unfair competition. The *Dastar* Court held, however, that "origin" in § 43(a)(1)(A) refers solely to "the producer of the tangible product sold in the marketplace"<sup>11</sup>—not to "the person or entity that originated the ideas or communications that 'goods' embody or contain."<sup>12</sup> Under that interpretation of the statute, the defendant in *Dastar* could incur no liability under § 43(a) for having engaged in the reverse passing off—i.e., having sold under its own name—goods containing once-copyrighted works created by another party.<sup>13</sup>

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<sup>8</sup> Codified at 15 U.S.C.S. § 1125(a)(1)(A) (2005).

<sup>9</sup> 539 U.S. 23 (2003).

<sup>10</sup> *Id.*

<sup>11</sup> 539 U.S. at 31.

<sup>12</sup> *Id.* at 32.

<sup>13</sup> The Court expressly left open the possibility that a defendant like *Dastar* might, upon the proof of additional facts, face liability for deceptive marketing under Lanham Act § 43(a)(1)(B). *Id.* at 38. That would not equate to "reverse passing off," however.

To understand how *Dastar* reached that conclusion, it helps to consider the case's own origins. In 1948, General Dwight D. Eisenhower completed writing *CRUSADE IN EUROPE*, his account of the World War II Allies' European campaign. Doubleday obtained the copyright to the book and granted an affiliate of plaintiff Twentieth Century Fox Film Corporation ("Fox") the exclusive rights to produce a television series based on that work. Fox arranged for the production of that television series, also called *Crusade in Europe*, and obtained the copyright thereto. Though Doubleday renewed its book copyright in 1975, Fox neglected to renew its copyright in the television series. The television series consequently fell into the public domain.<sup>14</sup>

In 1988, Fox reacquired the television rights in Eisenhower's book and sublicensed to plaintiff SFM Entertainment and New Line Home Video, Inc., the exclusive rights to distribute videos of *Crusade in Europe*. Defendant Dastar decided to compete in the same market. It purchased copies of the original version of the *Crusade in Europe* video—the one that had fallen into the public domain. Dastar then copied the video, edited it by excising some old and adding some new material, and created new packaging. In 1995, it began selling the resulting video set under the name, *Campaigns in Europe*. Dastar marketed *Campaigns in Europe* only under its own marks; its advertising and screen credits made no reference to the original *Crusade in Europe* television series, the videotapes that Fox authorized others to distribute, or Eisenhower's book.<sup>15</sup>

In 1998, chagrined that Dastar was selling *Campaigns in Europe* at half the price of *Crusade in Europe*, Fox and its sublicensees brought suit alleging that Dastar's video set infringed on Doubleday's copyright in the book and, thus, the exclusive television rights that Doubleday had granted them. They later added claims that by marketing *Campaigns in Europe* without giving proper credit to the *Crusade in Europe* television series Dastar had engaged in reverse passing off<sup>16</sup> in violation of § 43(a) of the Lanham Act and California unfair competition laws.<sup>17</sup>

On cross-motions for summary judgment, the district court found for Dastar on all three counts.<sup>18</sup> The Ninth Circuit Court of Appeals, in an unpublished opinion, affirmed the judgment for Dastar on the Lanham Act claim, reversed the judgment on the copyright claim, and said nothing about the state law unfair competition claim.<sup>19</sup> The Supreme Court granted certiorari.<sup>20</sup> With eight justices deliberating (Justice Breyer took no part in the proceedings) the Court issued a unanimous opinion, authored by Justice

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<sup>14</sup> *Id.* at 25-26.

<sup>15</sup> *Id.* at 26-27.

<sup>16</sup> The Supreme Court explained, "Passing off (or palming off, as it is sometimes called) occurs when a producer misrepresents his own goods or services as someone else's. 'Reverse passing off,' as its name implies, is the opposite: The producer misrepresents someone else's goods or services as his own." 539 U.S. 27 n. 1 (citations omitted).

<sup>17</sup> *Id.* at 27.

<sup>18</sup> See *Twentieth Century Fox Film Corporation v. Dastar Corp.*, 2000 U.S. Dist. LEXIS 22064 (C.D. Cal. 2000).

<sup>19</sup> *Twentieth Century Fox Film Corporation v. Dastar Corp.*, 34 Fed.Appx. 312, 2002 U.S. App. LEXIS 7426 (9th Cir. 2002) (unpublished opinion).

<sup>20</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 537 U.S. 1099 (2003).

Scalia, reversing the Ninth Circuit's resolution of the Lanham Act claim and remanding the case for further proceedings.<sup>21</sup>

Although the Supreme Court presented its holding as a simple matter of interpreting the language of § 43(a),<sup>22</sup> policy considerations quite evidently swayed the Court's deliberations. Foremost among those considerations, the Court worried that giving the Lanham Act too broad a scope would put it into conflict with the Copyright Act. After describing how the Lanham Act aims to protect consumers from harmful misrepresentations of origin,<sup>23</sup> for instance, and admitting that, "The purchaser of a novel is interested not merely, if at all, in the identity of the producer of the physical tome (the publisher), but also, and indeed primarily, in the identity of the creator of the story it conveys (the author),"<sup>24</sup> the Court nonetheless refused to read "origin . . . of . . . goods" in § 43(a)(1)(A) so as to allow a cause of action against the reverse passing off of the content of communicative goods. Why? "[A]ccording special treatment to communicative products," the Court explained, would cause "the Lanham Act to conflict with the law of copyright, which addresses that subject specifically."<sup>25</sup>

The Court related how it had in many instances taken pains to ensure that patentable subject matter did not receive greater protections than those afforded by the Patent Act,<sup>26</sup> citing *TrafFix Devices, Inc. v. Marketing Displays, Inc.*,<sup>27</sup> *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,<sup>28</sup> *Sears, Roebuck & Co. v. Stiffel Co.*<sup>29</sup> (but, surprisingly, not its companion case, *Compco Corp. v. Day-Brite Lighting, Inc.*<sup>30</sup>), and *Kellogg Co. v. National Biscuit Co.*<sup>31</sup> That wind-up prepared the Court for its pitch on behalf of defending the integrity of copyright policy:

Assuming for the sake of argument that Dastar's representation of itself as the "Producer" of its videos amounted to a representation that it originated the creative work conveyed by the videos, allowing a cause of action under § 43(a) for that representation would create a species of mutant copyright law that limits the public's "federal right to 'copy and to use,'" expired copyrights.<sup>32</sup>

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<sup>21</sup> 539 U.S. at 38.

<sup>22</sup> See 539 U.S. 31 ("At bottom, we must decide what § 43(a)(1)(A) of the Lanham Act means by the 'origin' of 'goods.'") (emphasis in the original).

<sup>23</sup> *Id.* at 32.

<sup>24</sup> *Id.* at 33.

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 33-34.

<sup>27</sup> 532 U.S. 23, 29 (2001).

<sup>28</sup> 489 U.S. 141, 150-51 (1989).

<sup>29</sup> 376 U.S. 225, 230 (1964).

<sup>30</sup> 376 U.S. 234 (1964).

<sup>31</sup> 305 U.S. 111, 121-22 (1938).

<sup>32</sup> 539 U.S. at 34 (citation omitted).



The Court then turned to other considerations from policy and precedent that, while worthy of study, do not prove especially pertinent here.<sup>33</sup> The evident worry that federal unfair competition law might conflict with copyright law arguably exercised a more powerful influence on the Court than those other considerations did. The discussion about the need to avoid a conflict between the Lanham Act and the Copyright Act certainly came before, and ran longer than, the Court's other policy discussions. More to the point, *Dastar's* anxiety about the prospect of "a species of mutant copyright law" shows the Court engaging in what we might call "intra-federal preemption." As argued later in the paper,<sup>34</sup> that reasoning effectively mandates that courts preempt state law reverse passing off claims similar to the Lanham Act claim struck down by *Dastar*. Indeed, as argued in the next section, courts have already begun to fulfill that mandate.

## B. *Dastar* in the Courts

Lower courts have consciously expanded the reach of *Dastar* in a variety of ways. Most notably, they have read it to bar § 43(a) reverse passing off claims arising out of the unauthorized use of copyrighted works. That expansion has won almost universal support in the case law. Lower courts have also expanded *Dastar* by reading it to bar reverse passing off claims arising out of the use of uncopyrightable ideas and trade secrets (rather than just uncopyrighted works) and by reading it to speak to communicative services (rather than just communicative goods). Although those expansions have won considerably less support in the case law, they provide further evidence that *Dastar* has had a bigger impact than anyone—including, in all likelihood, the Supreme Court itself—initially would have predicted. Lower courts have expanded *Dastar's* reach in yet another, still more remarkable way: By relying on the case to preempt state law reverse passing off claims arising out of the unauthorized use of copyrighted works. Surprisingly, lower courts have adopted that fourth reading of *Dastar* without any evident consciousness that in so doing they have signaled a revolution in copyright's preemption doctrine. Sub-sections 1 through 4 discuss, in turn, each of those four ways in which lower courts have expanded *Dastar's* reach.

### 1. Expanding *Dastar* to Copyrighted Works

Almost every time a lower court has cited *Dastar* in barring a Lanham Act reverse passing off claim, that claim has arisen from the unauthorized reuse of copyrighted works. In thus applying *Dastar*, those lower courts have expanded the case's holding well beyond its facts. The claim at issue *Dastar*, recall, did not arise out of the reuse of a copyright-protected work.<sup>35</sup>

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<sup>33</sup> See, e.g., *id.* at 34-35 (citing § 106A of the Copyright Act as the sole protection of authors' attribution rights federal lawmakers intended); 35-36 (citing awkward practical problems that would follow from giving § 43(a)(1)(A) a broader meaning); 36-37 (citing related precedents that a contrary holding would put in doubt).

<sup>34</sup> See *infra* Part III.

<sup>35</sup> See 539 U.S. at 26.

Indeed, no lower court has yet to apply *Dastar* to claims arising out of reuse of a work having precisely the same copyright status as the work at issue in that case: A once-copyrighted work that had fallen into the public domain.<sup>36</sup> One or more courts have applied *Dastar* to bar reverse passing off claims under Lanham Act § 43(a) relating to the reuse of *uncopyrightable* (as opposed to *non-copyrighted*) works.<sup>37</sup> Of more interest for present purposes, many more cases have applied *Dastar* to bar Lanham Act claims against the reverse passing off of *copyrighted* works. Those nine cases, all from federal courts, come from the First Circuit,<sup>38</sup> Fifth Circuit,<sup>39</sup> and district courts across the country.<sup>40</sup> No court to date has declined to follow that long line of cases by limiting *Dastar*'s effect to reverse passing off claims involving only uncopyrighted works. In sum, then, judicial authorities agree that *Dastar* limits Lanham Act reverse passing off claims arising out of the unauthorized use of copyrighted as well as uncopyrighted works.

In retrospect, it should cause no great surprise that lower courts have expanded *Dastar* to cover copyrighted works.<sup>41</sup> Recall that the *Dastar* court claimed to have found the proper meaning of "origin of goods" as used in § 43(a)(1)(A) of the Lanham Act, explaining 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."<sup>42</sup> The Court did not expressly limit that reading to cases involving works of authorship in public domain. Nor could the rhetoric of *Dastar* have easily admitted that exception. Granted, the Court cited policy considerations and appears in fact to have been motivated by concerns that unfair competition law might conflict with copyright

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<sup>36</sup> *See id.*

<sup>37</sup> For discussion of those cases, and an argument they expanded the types of intellectual property covered by *Dastar*, see *infra* Part II.B.2.

<sup>38</sup> *Zyla v. Wadsworth*, 360 F.3d 243, 251-52 (1st Cir. Mass. 2004) (applying *Dastar* to preempt Lanham Act claim based on credit given for copyrighted textbook).

<sup>39</sup> *General Universal Sys. v. Lee*, 379 F.3d 131, 149 (5th Cir. Tex. 2004) (applying *Dastar* to preempt Lanham Act claim based on reverse passing off of copyrighted software).

<sup>40</sup> *Aagard v. Palomar Builders, Inc.*, 344 F. Supp. 1211, 1218 (E.D. Cal. 2004) (applying *Dastar* to preempt Lanham Act claim based on reverse passing off of copyrighted architectural plans); *Bob Creeden & Assocs., Ltd. v. Infosoft, Inc.*, 326 F. Supp. 2d 876, 878-80 (N.D. Ill. 2004) (copyrighted software); *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1117 (W.D. Wash. 2004) (copyrighted images); *Smith v. New Line Cinema*, 2004 U.S. Dist. LEXIS 18382 at \*10-\*11, Copy. L. Rep. (CCH) P28896 (S.D.N.Y. Sept. 8, 2004) (copyrighted screenplay); *Boston Int'l Music, Inc. v. Austin*, Copy. L. Rep. (CCH) P28,719, 2003 U.S. Dist. LEXIS 16240 at \*4 (D. Mass. 2003) (copyrighted music); *Carroll v. Kahn*, 68 U.S.P.Q.2D (BNA) 1357, 2003 U.S. Dist. LEXIS 17902 at \*15-\*18 (N.D.N.Y. 2003) (copyrighted film); *Williams v. UMG Recordings, Inc.*, 281 F. Supp.2d 1177, 1186 (C.D. Cal. 2003) (copyrighted film).

<sup>41</sup> For an argument that the *Dastar* Court should have foreseen this outcome, and crafted an opinion better designed to deal with it, see Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1527 (2004) (complaining that the *Dastar* Court "obviously did not view overlapping copyright and trademark protection as part of a single, overarching issue or interrelated set of problems. As a result, the Court did not provide a solution to that interrelated set of problems and instead issued an incomplete and unsatisfactory result.").

<sup>42</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

law.<sup>43</sup> Nonetheless, in an apparent attempt at judicial modesty, the Court hid its policy concerns behind the fig leaf of statutory interpretation.

The *Dastar* Court thus effectively amended the Lanham Act, changing its meaning for any and all applications. Indeed, lower courts largely appear not to have even noticed that they have expanded *Dastar* to cover copyright-protected works. The exceptional court, *Williams v. UMG Recordings*,<sup>44</sup> confronted the defendants' claim that *Dastar* applies only to uncopyrighted works with a summary counterargument: "To the contrary, the Supreme Court's holding did not depend on whether the works were copyrighted or not."<sup>45</sup> Perhaps that goes a bit far. A fair reading of *Dastar* shows that the uncopyrighted status of the works at issue in the case did trigger the Court's policy concerns. Nonetheless, regardless of the reasoning behind it, lower courts quite understandably take *Dastar*'s holding to dictate the meaning of "origin" in § 43(a)(1)(A) as a general matter, regardless of its application.

## 2. Expanding *Dastar* to Other Intellectual Properties

Held strictly to its facts, *Dastar* speaks only of the permissibility of claims against the reverse passing off of fixed works of authorship—i.e., copyrightable (if not necessarily copyrighted) intellectual property.<sup>46</sup> It has, however, been extended to bar complaints about the reverse passing off of other types of intellectual property—i.e., uncopyrightable facts and trade secrets. Judging from the plain language of the case, courts will almost certainly also soon extend *Dastar* to cover subject matter within the scope of patent law. This subsection discusses each topic in turn.

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<sup>43</sup> See *id.* at 33 (claiming that to allow reverse passing off claims against those who market copies of uncopyrighted works would cause "the Lanham Act to conflict with the law of copyright, which addresses that subject specifically. "); *id.* at 34 (worrying that such a cause of action would "create a species of mutant copyright law that limits the public's "federal right to 'copy and to use,'" expired copyrights . . . "); *id.* at 35 (arguing that plaintiffs' interpretation of the Lanham Act would (describing the sharply limited rights in § 106A of the Copyright Act and arguing, "Recognizing in § 43(a) a cause of action for misrepresentation of authorship of noncopyrighted works (visual or otherwise) would render these limitations superfluous."); *id.* at 37 (explaining that the Court's interpretive gloss aimed to prevent the Lanham Act from creating "a species of perpetual patent and copyright, which Congress may not do.").

<sup>44</sup> 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003).

<sup>45</sup> *Id.* at 1185. The court did offer a bit more to the argument; the quote continues: "Rather, in being careful not to extend trademark protections, the Court noted that protection for communicative products was available through copyright claims. In fact, this protection would only be available if a valid copyright existed." *Id.* The *Williams* court surely erred, however, in claiming that *Dastar* conditioned its analysis on a valid copyright subsisting, or even having subsisted, in the communicative products at issue. Rather, the Court plainly focused on whether copyright protection was available. See 539 U.S. at 37-38 (discussing ways the defendants could have won copyright rights).

<sup>46</sup> See *supra* Part II.B.1.

**a. Uncopyrightable Works.** It might at first appear unduly pedantic to claim that *Dastar* does not speak of uncopyrightable subject matter. The opinion does, after all, show evident concern about preserving the public domain from overbroad claims of unfair competition.<sup>47</sup> Nonetheless, no less a personage than Judge Richard A. Posner has claimed (in a law review article rather than a judicial opinion) that *Dastar* applies only "in cases in which what is palmed off is expressive material."<sup>48</sup> To read it as applicable to uncopyrightable material more generally would, he explains, put in doubt the venerable holding of *International News Service v. Associated Press*,<sup>49</sup> which affirmed an injunction on (arguably) the reverse passing off of uncopyrightable facts.<sup>50</sup> Nonetheless, one or more courts have, rightly or wrongly, expanded *Dastar* to bar § 43(a) reverse passing off claims relating to the reuse of *uncopyrightable* (as opposed to *uncopyrighted*) works.

The "or more" hedge reflects uncertainty about the copyright status of the works at issue in two of those cases. *Keane v. Fox Televisions Stations, Inc.*,<sup>51</sup> clearly involved an uncopyrightable work. Although the plaintiff in *Keane* initially asserted a copyright in his idea for an "American Idol"-style television show, he later amended his pleadings to drop that claim.<sup>52</sup> He apparently recognized, as did the court, that "copyright law does not protect ideas but only the expression of ideas."<sup>53</sup> Citing *Dastar*, the *Keane* court dismissed the plaintiff's Lanham Act claim on grounds, in relevant part, that § 43(a) does not forbid the reverse passing off of mere ideas.<sup>54</sup>

*Keane* thus quite plainly showed a court applying *Dastar* to dismiss a reverse passing off claim under Lanham Act § 43(a) relating to reuse of uncopyrightable ideas or concepts.<sup>55</sup> Perhaps the court in *Larkin Group, Inc. v. Aquatic Design Consultants, Inc.*,<sup>56</sup> did likewise; the case's language leaves it unclear whether or not the works in question were copyrightable.<sup>57</sup> Although the plaintiff clearly alleged that the defendants had "photos and other property belonging to [plaintiff],"<sup>58</sup> the court said, "Plaintiff is essentially claiming that defendants took plaintiff's uncopyrighted and unpatented ideas and concepts . . ."<sup>59</sup> Similar uncertainty clouds the holding of *Bretford Mfg. v. Smith Sys. Mfg. Co.*,<sup>60</sup> which read *Dastar* to bar a Lanham Act reverse passing off claim where

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<sup>47</sup> See *supra* Part II.A.

<sup>48</sup> *Misappropriation: A Dirge*, 40 HOUS. L. REV. 621, 639 (2003).

<sup>49</sup> 248 U.S. 215 (1918).

<sup>50</sup> See Posner, *supra* note 48, at 639 (describing with approval the characterization of the facts set forth in Justice Holmes' dissent). I use "(arguably)" in recognition that the source of that characterization, coming as it does from a dissent, might raise suspicion.

<sup>51</sup> 297 F. Supp. 2d 921 (S.D. Tex. 2005).

<sup>52</sup> *Id.* at 929.

<sup>53</sup> *Id.* at 935, n. 75.

<sup>54</sup> *Id.* at 935.

<sup>55</sup> See *Keane v. Fox Television Stations, Inc.*, 297 F. Supp. 2d 921, 935 (S.D. Tex. 2005).

<sup>56</sup> 323 F. Supp. 2d 1121, 1124-27 (D. Kan. 2004).

<sup>57</sup> *Id.* at 1123.

<sup>58</sup> *Id.* at 1126.

<sup>59</sup> *Id.*

<sup>60</sup> 286 F. Supp. 2d 969 (N.D. Ill. 2003).

the defendant had used a leg from one of the plaintiff's tables to prepare a sample table, which the defendant then used to win a contract for building similar tables in quantity.<sup>61</sup> Was plaintiff's table leg copyrighted? Probably not. Although the *Bretford* court did not speak to the issue, furniture designs generally constitute useful articles not subject to copyright protection.<sup>62</sup> Also, the fact that the defendant evidently made numerous copies of the plaintiff's table leg without suffering a copyright infringement claim—but instead only a reverse passing off claim—strongly suggests that no such copyright existed.<sup>63</sup>

At any rate, courts apparently have few qualms about extending *Dastar's* coverage from uncopyrighted works to uncopyrightable ones. Certainly, no court has yet to reject an appeal to *Dastar* based on that distinction. Does that expansion of *Dastar* make sense? Granted that many of the same policy concerns that inspired the Supreme Court's decision regarding the former type of intellectual property also apply to the latter, it bears noting that not all of them do. Note, for instance, that the Supreme Court justified its refusal to grant the *Dastar* plaintiffs protection from reverse copying in part because that they could have availed themselves of copyright protection.<sup>64</sup> The same hardly holds true of plaintiffs asserting claims for the reverse passing off of their uncopyrightable ideas or facts. Furthermore, as Judge Posner observed, expanding *Dastar* to cover uncopyrightable facts threatens to bring it into conflict with well-established precedents upholding the misappropriation cause of action.<sup>65</sup>

**b. Trade Secrets.** Does *Dastar* bar reverse passing off claims premised on the unauthorized use of trade secrets? One authority, the court in *Tao of System Integration v. Analytical Services & Materials, Inc.*,<sup>66</sup> appears to have answered that question, "Yes." Plaintiff Tao complained that defendant AS&M's winning proposal to sell engineering services to NASA incorporated Tao's trade secrets, misrepresenting AS&M's services and confusing NASA to Tao's detriment.<sup>67</sup> The *Tao* court dismissed the § 43(a)(1)(A) claim that plaintiff based on those allegations. As the court explained, the plaintiff claimed that AS&M's proposal "incorporated ideas or concepts that belonged to Tao. This, however, is precisely the type of allegation which the Supreme Court rejected as the basis for a reverse-passing-off claim in *Dastar* . . . ."<sup>68</sup> With the *Tao* court's expansion of *Dastar* to

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<sup>61</sup> *Id.* at 972.

<sup>62</sup> See 17 U.S.C. § 101 (LEXIS 2005) (limiting the definition of copyrightable sculptural works to "their form but not their mechanical or utilitarian aspects," and explaining that the design of any useful article will qualify as sculpture "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."); *Collezione Europa U.S.A v. Hillsdale House Ltd.*, 243 F. Supp. 2d 444, 455 (M.D.N.C. 2003) (describing plaintiff's furniture as "useful articles; that is, they have 'an intrinsic utilitarian function,' 17 U.S.C. § 101, and are presumptively uncopyrightable.").

<sup>63</sup> See *Bretford Mfg. v. Smith Sys. Mfg. Co.*, 116 F. Supp. 2d 951 (N.D. Ill. 2000) (detailing plaintiff's complaints without making any mention of a copyright infringement claim).

<sup>64</sup> 539 U.S. at 2049.

<sup>65</sup> See Posner, *supra* note 48, at 639.

<sup>66</sup> 299 F. Supp. 2d 565 (E.D. Va. 2004).

<sup>67</sup> *Id.* at 568-69.

<sup>68</sup> *Id.* at 572.

cover trade secrets, as with other courts' expansion of *Dastar* to cover copyrighted works,<sup>69</sup> we see how the policy considerations that evidently drove the *Dastar* Court matter far less to lower courts than the Court's gloss on the language of § 43(a)(1)(A).

**c. Subject Matter Within the Scope of Patent Law.** Thus far, no court appears to have had occasion to apply *Dastar* to bar a complaint about the reverse passing off of subject matter within the scope of patent law. That scenario seems inevitable, however, given that the *Dastar* court justified its holding by making repeated references to patent law and policy.<sup>70</sup> The Court's final and most concise statement of its holding, moreover, not only expressly invokes patents; it puts them on equal footing with copyrights:

In sum, reading the phrase "origin of goods" in the Lanham Act in accordance with the Act's common-law foundations (which were *not* designed to protect originality or creativity), and in light of the copyright and patent laws (which *were*), we 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."<sup>71</sup>

It surely remains only a matter of time before some clever defendant, facing an accusation of the reverse passing off of subject matter within the scope of patent law, successfully invokes that language to dismiss the claim. That will hardly represent a breakthrough; as the *Dastar* opinion's review of the precedents make plain, the Court has long limited states from interfering with patent law and policy.<sup>72</sup> It will, however, represent one more example of the case's application to a form of intellectual property not before the *Dastar* court.

### 3. Expanding *Dastar* to Services

*Dastar* speaks only of the proper definition of the "origin . . . of . . . goods" in § 43(a)(1)(A).<sup>73</sup> Yet that section refers not to goods alone, but to "goods, services, or commercial activities," together.<sup>74</sup> Perhaps unsurprisingly, then, courts have expanded *Dastar* beyond mere goods, to services and commercial activities. The court in *Williams v. UMG Recordings, Inc.*, flatly rejected the plaintiff's claim that *Dastar* could not

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<sup>69</sup> See *supra* Part II.B.1.

<sup>70</sup> See, e.g., 539 U.S. at 2048 (citing patent cases as authority and using the phrase, "patent or copyright" several times).

<sup>71</sup> *Id.* at 2049.

<sup>72</sup> See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938).

<sup>73</sup> See e.g., 539 U.S. at 37 ("[T]he phrase "origin of goods" in the Lanham Act . . . 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.").

<sup>74</sup> 15 U.S.C.S. § 1125(a)(1)(A).

preempt a claim for the reverse passing off of services.<sup>75</sup> More than that, the *Williams* court audaciously countered that *Dastar* itself in fact concerned not goods but services, claiming that "in *Dastar*, the defendant did exactly what Plaintiff accuses Defendants of doing here - attributing to itself and its employees various 'services' that the plaintiffs claimed they, in fact, provided on the defendant's videotapes."<sup>76</sup> Although it did not offer a similarly bold—or, indeed, any—defense of its move, the court in *Tao of Sys. Integration v. Analytical Servs. & Materials, Inc.*, because it found that *Dastar* barred a §43(a) complaint alleging the reverse passing off of engineering services, also arguably expanded *Dastar* to cover the reverse passing off of services as well as of goods.<sup>77</sup>

#### 4. Expanding *Dastar* to State Law Reverse Passing Off Claims

*Dastar* speaks only of the relationship between copyright law and the federal law of unfair competition. The Supreme Court said nothing in that case about how to resolve the analogous reverse passing off claim that the plaintiffs' had raised under California's state law of unfair competition. That issue was not before the *Dastar* Court. As the Court observed, the Ninth Circuit opinion under review had "said nothing with regard to the state-law claim."<sup>78</sup> More recently, however, lower courts have in several instances read *Dastar* to preempt state law reverse passing off claims like the one at issue in that case. As this sub-section details, however, those courts have said very little to explain why *Dastar* has that effect.

The short list of lower cases applying *Dastar* to preempt state law reverse passing off claims begins with *Dastar* itself, on remand. After the Supreme Court reversed and remanded the Ninth Circuit's resolution of the Lanham Act claim at issue in *Dastar*, the defendants asked the district court to revisit the plaintiffs' state law claim and dismiss it with prejudice. The court granted both requests.<sup>79</sup>

Typically for courts applying *Dastar* to preempt state law reverse passing off claims, however, the court hearing *Dastar* on remand failed to explain the legal basis for its decision. Instead, the court simply pronounced, "The Supreme Court's finding that Defendants' actions were not misleading under the Lanham Act controls the resolution of their California unfair competition claim."<sup>80</sup> Why did the Supreme Court opinion "control"? The court did not say.

That pattern set by the court considering *Dastar* on remand—enigmatically relying on the Supreme Court's opinion to reject a state law—has since recurred each time a lower court has cited *Dastar* as the reason for preemption a reverse passing off

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<sup>75</sup> 281 F. Supp.2d 1177, 1186 (C.D. Cal. 2003).

<sup>76</sup> *Id.*

<sup>77</sup> 299 F. Supp. 2d 565, 572 (E.D. Va. 2004).

<sup>78</sup> 539 U.S. at 28.

<sup>79</sup> *Twentieth Century Fox Film Corp. v. Dastar Corp.*, 2003 U.S. Dist. LEXIS 21194, 68 U.S.P.Q.2d (BNA) 1536 (C.D. Cal. Oct. 14, 2003).

<sup>80</sup> *Id.* at \*14.

claim raised under state law. The court in *Aagard v. Palomar Builders, Inc.*, offered the longest, but least clear, justification.<sup>81</sup> When it first raised the question of whether the plaintiff's state law unfair competition claim should suffer preemption, the *Aagard* court framed the issue solely in terms of § 301(a) of the Copyright Act.<sup>82</sup> Before applying that statutory preemption provision, however, the court turned to the problem of disentangling the two theories embedded in the plaintiff's claim, "a hybrid of both traditional and reverse palming off."<sup>83</sup> Once having solved that problem, the court returned to the question of whether the reverse passing off claim merited preemption.<sup>84</sup>

From that point onward, the *Aagard* court's inquiry into the preemption of state reverse passing off claims made no reference to § 301(a). That undoubtedly improved the opinion, since the court's earlier summary of Ninth Circuit law had sorely misstated the scope of § 301(a) preemption.<sup>85</sup> Fortunately, if perhaps inadvertently, the *Aagard* court dropped the § 301(a) approach and instead relied solely on *Dastar* to resolve the preemption of the state reverse passing off claim. After relating *Dastar*'s holding with regard to federal unfair competition claims, the *Aagard* court concluded, "Similarly, courts in this Circuit previously held that claims asserted pursuant to California unfair competition laws are 'substantially congruent' to claims filed under the Lanham Act. Accordingly, state law claims which rely upon reverse palming off of communicative products also conflict with—and are, therefore, preempted by—federal copyright law."<sup>86</sup>

The court in *Williams v. UMG Recordings, Inc.* offered almost exactly the same holding, though without bothering with any feints towards § 301(a).<sup>87</sup> The plaintiff before the *Williams* court, realizing that the just-issued opinion in *Dastar* doomed its Lanham Act unfair competition claim, asked for leave to amend its complaint so as to add a reversing passing off claim under state law. The *Williams* court succinctly denied that request on grounds, "The Ninth Circuit has consistently held that state law unfair competition claims are 'congruent' with *Lanham Act* claims; Plaintiff's putative unfair

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<sup>81</sup> 344 F. Supp. 2d 1211 (E.D. Cal. 2004).

<sup>82</sup> *Id.* at 1217. For discussion of §301(a) and its application to reverse passing off claims, see *infra* Part IV.B.

<sup>83</sup> 344 F. Supp. 2d at 1217.

<sup>84</sup> *Id.* at 1218.

<sup>85</sup> The *Aagard* court said, "Reverse palming off claims are preempted unless they allege bodily appropriation and the claimant seeks more than mere monetary damages." *Id.* at 1217. The court accurately described Ninth Circuit law regarding the first of those two elements, bodily appropriation. In support of the second, however, the court wrongly cited *Firoozye v. Earthlink Network*, 153 F. Supp. 2d 1115, 1130 (N.D. Cal. 2001), as authority. In fact, however, *Firoozye* concerned not a claim for reverse passing off, but rather conversion, a distinctly different cause of action. The *Firoozye* court merely said, quite plausibly given the extant case law and commentary, that "while a claim for conversion typically involves tangible property and thus may be immune from preemption, where a plaintiff is only seeking damages from a defendant's reproduction of a work--and not the actual return of a physical piece of property--the claim is preempted." *Id.* Contrary to the *Aagard* court, there appears to be no support, in *Firoozye* or elsewhere, for preempting a reverse passing claim because it seeks damages.

<sup>86</sup> 344 F. Supp. 2d at 1218 (citations omitted).

<sup>87</sup> 281 F. Supp. 2d 1177 (C.D. Cal. 2003).



competition claim would fail for the same reasons his *Lanham Act* claim fails."<sup>88</sup> In similar fashion, the court in *Bob Creeden & Associates, Ltd. v. InfoSoft, Inc.*, cited the congruence between the Illinois unfair competition under which plaintiff had pleaded reverse passing off and the Lanham Act, concluding, "Because [plaintiff] fails to state a claim under the Lanham Act, [plaintiff] likewise has no claim under Illinois' statutory unfair competition laws."<sup>89</sup>

Quoting the four lower courts that have applied *Dastar* to state reverse passing off claims, while useful in itself, proves most useful for demonstrating what those cases did *not* say. Although those courts made clear that *Dastar* influenced their deliberations, they did not identify the source of that influence. And none but the district court considering *Dastar* on remand identified the power of that influence; by saying that the Supreme Court's opinion "controls the resolution of [plaintiffs'] California unfair competition claim"<sup>90</sup> that district court suggested that it had no choice in the matter. *Aagard, Williams*, and *Bob Creeden* say still less. So far as their language goes, *Dastar* might represent no more than persuasive authority. The extant case law thus demonstrates only that *Dastar* has *something* to do with the preemption of state reverse passing off claims. Figuring out the basis and extent of *Dastar*'s power will require that we go beyond those cases, to more general principles of preemption.<sup>91</sup>

### C. *Dastar* in the Commentary

Although *Dastar* has attracted a fair amount of commentary, none of it appears to hit upon the thesis set forth here. The most impassioned discussions about *Dastar* tend, unsurprisingly, to arise from the debate between the case's champions and its critics. Commentators on the "pro" side of *Dastar* tout the case as a victory for the public domain.<sup>92</sup> Commentators on the "con" side criticize *Dastar* for unnecessarily limiting an

<sup>88</sup> *Id.* at 1186.

<sup>89</sup> 326 F. Supp. 2d 876, 880 (N.D. Ill. 2004).

<sup>90</sup> *Dastar*, 2003 U.S. Dist LEXIS 21194 at \*14.

<sup>91</sup> See *infra* Part III.

<sup>92</sup> See, e.g., Ruth L. Okediji, *Through the Years: The Supreme Court and the Copyright Clause*, 30 W'M MITCHELL L. REV. 1633, 1636 (2004) ("The decision affirmed a vision of the public domain as a resource for completely unconditional access to, and use of, expired public works."); Richard Ronald, *Note: Dastar Corp. v. Twentieth Century Fox Film Corp.*, 19 BERKELEY TECH. L.J. 243, 255 (2004) (describing *Dastar* as "good policy" because it "frees manufactures to use public domain works without fear of a burdensome attribution requirement."); Kurt M. Saunders, *A Crusade in the Public Domain: The Dastar Decision*, 30 RUTGERS COMPUTER & TECH. L.J. 161, 172-173 (2004) ("The Supreme Court's holding in *Dastar* was a pragmatic result that avoided a further enclosure of the public domain and reinforced the notion that the public domain is indispensable to future creative endeavor."); Niels Schaumann, *Copyright, Containers, and the Court: A Reply to Professor Leaffer*, 30 W'M MITCHELL L. REV. 1617, 1631 (2004) ("To me, the most reassuring thing about *Dastar* is that the Court declined to create new copyright-like rights in public domain works."); Joshua K. Simko, *Every Artist is a Cannibal, Every Poet is a Thief: Why The Supreme Court Was Right to Reverse The Ninth Circuit in Dastar Corp. v. Twentieth Century Fox Film Corp.*, 11 J. INTELL. PROP. L. 355, 366 (2004) ("[Dastar] paves the way for

important means of protecting consumers from reverse passing off.<sup>93</sup> A separate, less polarized vein of commentary discusses whether *Dastar's* holding reflects primarily a question of how to interpret the Lanham Act<sup>94</sup> or instead a broad inquiry into harmonizing Supreme Court precedents, federal unfair competition law, and copyright policy.<sup>95</sup> Commentators have also pondered whether and to what extent *Dastar* carries a message about constitutional limits on the federal government's power to protect intellectual property.<sup>96</sup> Each of those various lines of inquiry has its virtues, of course.

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artists and producers of creative works to incorporate prior public domain works, thereby enhancing meaning and allowing a richness and complexity of interpretation . . . ."); Lynn McLain, *Thoughts On Dastar From A Copyright Perspective: A Welcome Step Toward Respite for the Public Domain*, 11 U. BALT. INTELL. PROP. L.J. 71, 72 (2003) ("Dastar is a welcome step towards regaining the public domain . . . .").

<sup>93</sup> See, e.g., Greg Lastowka, *The Trademark Function of Authorship* 33-34 (draft paper dated January 27, 2005, on file with the author) (describing the opinion's scope as "sweeping," "startling," and ultimately, "bizarre"); Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263, 268 (2004) ("*Dastar* [] prompts the concern—reinforced by lower court decisions interpreting *Dastar*—that the Supreme Court may have disqualified authors from pleading the trademarks act's prohibition on false designation of origin to support a claim to attribution of authorship status."); F. Scott Kieff, *Contrived Conflicts: The Supreme Court Versus the Basics of Intellectual Property Law*, 30 W'M MITCHELL L. REV. 1717, 1725 (2004) (complaining that *Dastar's* "contrivance about the power of § 43(a) runs the risk of eviscerating the carefully crafted balance . . . set forth in the Lanham Act."); Leaffer, *supra* note 92, at 1614 (questioning the Court's rationale on grounds, "I fail to see how the requirement to acknowledge authorship would be that onerous and would improperly extend copyright.").

<sup>94</sup> See, e.g., Thomas Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272, 327 (2004) ("in *Dastar* the Court was not [] interpreting the copyright statute but rather section 43(a) of the Lanham Act.").

<sup>95</sup> See, e.g., Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 883 n. 244 (2004) ("Though *Dastar* involved arguments about the limited construction of the Lanham Act, the Court's analysis possibly also adverts to . . . the constitutional structure for protecting intellectual property."); Graeme B. Dinwoodie, *The Trademark Jurisprudence of the Rhenquist Court*, 8 MARQ. INTELL. PROP. L. REV. 187, 203 (2004) ("[M]ere statutory interpretation tools do not provide a complete explanation" for the case's reasoning); David Nimmer, *The Moral Imperative Against Academic Plagiarism (Without a Moral Right Against Reverse Passing Off)*, 54 DEPAUL L. REV. 1, 42-44 (2004) (arguing that the case's holding falls somewhere between a mere interpretation of § 43(a)(1)(A) and a negation of any Lanham Act claim concerning authorship). See also Moffat, *supra* note 41, at 1523 (criticizing *Dastar* on grounds "the Court did not deal with the variety of problems posed by concurrent trademark and copyright protection . . . .").

<sup>96</sup> See, e.g., Leaffer, *supra* note 92, at 1617 (arguing that, contrary to some commentators might like to think, *Dastar* "avoided an important and controversial issue concerning legislative authority in the field of intellectual property law."); Nachbar, *supra* note 94, at 327 (arguing that *Dastar* says little or nothing about limits on federal power because "there was no challenge to Congress's power in" the case); Schaumann, *supra* note 92, at 1630 ("[T]he court nearly (but not quite) implies that the Commerce Clause power cannot be exercised in a way that conflicts with the Copyright Clause."); Diane Leenheer Zimmerman, *Is There a Right to Have Something to Say? One View of the Public Domain*, 73 FORDHAM L. REV. 297 (2004) (saying *Dastar* limits federal power over copyrighted expressions but does not "answer whether there are comparable

None, however, appears to attempt a detailed examination of how *Dastar's* expansive reception by lower courts heralds a revolution in copyright preemption doctrine.<sup>97</sup> Aiming to fill that gap in the academic commentary on *Dastar*, the next Part takes up that task.

### III. What *Dastar* and its Progeny Do

This Part considers not what courts and commentators say about *Dastar*, the topic of the prior Part, but rather what that case and its progeny actually do in practice. Ordinarily, that sort of distinction would not bear much fruit. Especially in the law (as opposed to, say, sports), words tend to equate to results. In the particular instance of *Dastar* and related cases, however, quite a gap has opened between what courts say and what they do. The Supreme Court said in *Dastar*, for instance, that it was limiting the scope of the Lanham Act. In fact, however, thanks to the functional equality between a § 43(a) reverse passing off claim and a typical state law reverse passing off claim, the *Dastar* court limited both federal and state law. Similarly, lower courts applying *Dastar* say (insofar as they say anything) that it bars state law reverse passing off claims because they traditionally treat those claims in the same way they treat federal ones. In fact, however, whether they realize it or not, those courts have launched a revolution in copyright preemption doctrine. Section A explains why *Dastar* preempts state reverse passing off claims, whereas Section B explains how *Dastar* does so.

#### A. Copyright Preempts State Unfair Competition Law

Courts applying *Dastar* have already demonstrated that the case has the power to stop state law reverse passing off claims dead in their tracks.<sup>98</sup> Those courts have not, however, clearly identified why *Dastar* has that effect. Insofar as those courts have said anything about the source of *Dastar's* influence over state law claims, they have typically spoken as if it exercised no more than persuasive authority.

The court in *Williams v. UMG Recordings, Inc.*, for instance, simply observed, "The Ninth Circuit has consistently held that state law unfair competition claims are

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limits on Congress's power to create novel interests that do not fall under the umbrella of copyright.") (footnote omitted); Edward Lee, *The Public's Domain: The Evolution of Legal Restraints on the Government's Power to Control Public Access Through Secrecy or Intellectual Property*, 55 HASTINGS L.J. 91, 108 n. 67 (2003) (crediting *Dastar* for "avoiding discussion of possible constitutional limitations.").

<sup>97</sup> *But see* Lastowka, *supra* note 93, at 44 n. 155 (saying of the *Dastar* Court's invocation of § 106A as proof that federal lawmakers meant to preclude any other protections of attribution rights, "The most plausible (if radical) reading of the conflict would . . . carry some flavor of constitutional preemption. . . . For instance, it could conceivably affect other non-copyright schemes protecting authorship rights, including state laws concerning misappropriation and rights of publicity.").

<sup>98</sup> *See supra* Part II.B.4. (discussing cases).

'congruent' with *Lanham Act* claims; Plaintiff's putative unfair competition claim would fail for the same reasons his *Lanham Act* claim fails."<sup>99</sup> The court in *Bob Creeden & Associates, Ltd. v. Infosoftware, Inc.*, cited a similar congruence between the Illinois unfair competition law under which plaintiff had pleaded reverse passing off and the Lanham Act and concluded, "Because [plaintiff] fails to state a claim under the Lanham Act, [plaintiff] likewise has no claim under Illinois' statutory unfair competition laws."<sup>100</sup>

Statements so brief do not suffice to bridge the gap between federal and state law. How could the Supreme Court's interpretation of the Lanham Act in *Dastar* possibly reach all the way down to control the disposition of a similar state law claim? The *Dastar* court offered many justifications for its holding. Perhaps the *Williams* and *Creeden* courts simply found those reasons convincing. In that event, *Dastar* would serve as nothing more than persuasive authority about how to interpret a state unfair competition law in light of prudent policy concerns.

Surely, though, *Dastar* exercises more than merely persuasive authority over state law reverse passing off claims. Suppose, for instance, that a lower court were to disagree with the *Williams* and *Creeden* courts about *Dastar*'s wisdom. Would that court enjoy complete freedom to let stand a state law reverse passing off claim arising under facts legally identical to those in *Dastar*? The district court tasked with considering *Dastar* on remand from the Supreme Court evidently felt at no such liberty. That district court said, "The Supreme Court's finding that Defendants' actions were not misleading under the Lanham Act *controls* the resolution of their California unfair competition claim."<sup>101</sup> That strongly suggests that *Dastar* had more than merely persuasive authority.

Although still on the skimpy side, the explanation offered by the *Aagard v. Palomar Builders*<sup>102</sup> court for applying *Dastar* to a state law reverse passing off claim reveals why the latter had to hew to the former. Like the *Williams* and *Creeden* courts, the *Aagard* court first noted that "California unfair competition laws are 'substantially congruent' to claims filed under the Lanham Act."<sup>103</sup> Unlike its judicial counterparts, however, the *Aagard* court added the crucial link between the state and federal claims: "Accordingly, state law claims which rely upon reverse palming off of communicative products also *conflict with*—and are, therefore, *preempted by*—federal copyright law."<sup>104</sup>

That hardly says it all, but it does say a lot. The *Aagard* court quite rightly notes that courts facing state law reverse passing off claims akin to the Lanham Act claim at issue in *Dastar* don't have any choice in the matter; those courts must strike the state law claims as preempted by federal law. The *Aagard* court does not, however, specify exactly *why* such state law claims suffer preemption. Does some specific provision of the

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<sup>99</sup> 281 F. Supp.2d 1177, 1186 (C.D. Cal. 2003).

<sup>100</sup> 326 F. Supp. 2d 876, 880 (N.D. Ill. 2004).

<sup>101</sup> *Twentieth Century Fox Film Corp. v. Dastar Corp.*, 2003 U.S. Dist. LEXIS 21194, \*14, 68 U.S.P.Q.2d (BNA) 1536 (C.D. Cal. Oct. 14, 2003) (emphasis added).

<sup>102</sup> 344 F. Supp. 2d 1211 (E.D. Cal. 2004).

<sup>103</sup> *Id.* at 1218 (citations omitted).

<sup>104</sup> *Id.* (emphasis added).

"federal copyright law" to which Aagard refers have that effect? Or does the Copyright Act as a whole stand in the way of Dastar-like state reverse passing off claims? To those questions, the next section turns.

## B. Direct Supremacy Clause Preemption, Rediscovered

The U.S. Constitution provides that it and the laws made under it "shall be the supreme law of the land . . . any thing in the constitution or laws of any state to the contrary notwithstanding."<sup>105</sup> The Constitution also expressly empowers federal lawmakers to pass legislation creating and protecting copyright rights.<sup>106</sup> The Constitution's supremacy clause thus provides the ultimate justification for copyright's preemption of state laws, no matter what guise that preemption takes. *Dastar* does not change that. The case does, however, herald a shift in the type of copyright preemption that courts favor, away from the express preemption of §301(a) and toward the more general principles of implied preemption applied in *Dastar*. Since different sorts of preemption have different effects, moreover, that doctrinal shift promises to broaden the scope of copyright preemption.

Courts have enforced the supremacy clause by way of three different types of preemption: field preemption, express preemption, and implied preemption.<sup>107</sup> Field preemption arises when "Congress has intended, by legislating comprehensively, to occupy an entire field of regulation and has thereby 'left no room for the States to supplement' federal law."<sup>108</sup> Because the Copyright Act leaves many openings for state law to play a role,<sup>109</sup> field preemption plays a distinctly minor role in copyright.<sup>110</sup> It thus far appears to have occurred only in cases finding that the Copyright Act's recordation

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<sup>105</sup> U.S. CONST. art. VI, § 2.

<sup>106</sup> *Id.* at art. I, § 1, cl. 8.

<sup>107</sup> See *Capital Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 698-99 (1984); *In re World Auxiliary Power Co.*, 303 F.3d 1120, 1128-29 (9th Cir. 2002); Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 236-37 (2002) (using "explicit" rather than "express" preemption); Mark A. Lemley, *The Law and Policy of Intellectual Property Licensing Beyond Preemption: The Law and Policy of Intellectual Property Licensing*, 87 CALIF. L. REV. 111, 137-38 (1999) (using the terms, "field preemption," "express conflicts preemption," and "implied conflicts preemption").

<sup>108</sup> *Capital Cities Cable*, 467 U.S. 691, 699 (quoting *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230 (1947)). See also *In re World Auxiliary Power Co.*, 303 F.3d at 1128 ("leaving no room for the operation of state law.") (quoting *Keams v. Tempe Technical Institute, Inc.*, 39 F.3d 222, 225 (9th Cir.1994) (internal quotation marks and citation omitted)).

<sup>109</sup> See 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.01[B][3][a], n. 257.1 (2005) ("Given that the states may legitimately regulate many aspects relating to copyrightable compositions, that aspect of the pre-emption doctrine would appear not generally applicable here.").

<sup>110</sup> Professor Rothman claims it plays no role. See *supra* note 107, at 237. Recent cases evince a contrary view, however. See, e.g., *In re World Auxiliary Power Co.*, 303 F.3d at 1229 (addressing the question of whether the Copyright Act's recordation provisions preempt state law recordation laws as one of "field" preemption.).

provisions so occupy the field as to preempt state recordation laws from having an effect.<sup>111</sup>

Section § 301(a), because it explicitly delineates the proper limits of state law, operates by dint of express preemption.<sup>112</sup> Between its enactment in the 1976 Copyright Act and the advent of *Dastar*, § 301(a) held a near-monopoly in copyright preemption analysis.<sup>113</sup> Having that statutory provision ready-at-hand, and lacking any equally authoritative alternative, courts quite naturally relied on § 301(a) in determining the scope of copyright preemption.<sup>114</sup> Through *Dastar*, however, the Supreme Court has, intentionally or otherwise, breathed new life into implied copyright preemption.

At one time, prior to § 301(a)'s introduction of express preemption, copyright law preempted state laws impliedly or not at all.<sup>115</sup> Relatively few cases found preemption under that doctrine, however,<sup>116</sup> nor have many cases done so since. Section 301(a) did not take over copyright preemption doctrine immediately, of course. In the span before that legislative innovation had seen much judicial interpretation, courts sometimes bolstered their preemption analyses by drawing on old case law that had relied on the Supremacy Clause alone.<sup>117</sup> But that shows little more than an understandable preference

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<sup>111</sup> In re Peregrine Entertainment, Ltd., 116 B.R. 194, 201-02, 16 U.S.P.Q.2d 1017 (C.D. Cal. 1990) (finding that "any state recordation system pertaining to interests in copyrights would be preempted by the Copyright Act.") *But see* In re World Auxiliary Power Co., 303 F.3d 1120, 1129-30 (9th Cir. 2002) (limiting Peregrine's holding to registered copyrights).

<sup>112</sup> See NIMMER & NIMMER, *supra* note 109, at § 1.01[B] ("Congress has acted in explicit terms to pre-empt various state laws through Section 301 of the Copyright Act of 1976."); Rothman, *supra* note 107, at 237 (claiming that express preemption "clearly exists in copyright law because of the Section 301 preemption clause contained within the Copyright Act."). *But see* Lemley, *supra* note 107, at 139 (applying the "field" label to § 301(a) preemption).

<sup>113</sup> For a description of § 301(a)'s operation, as well as a small sample of the many, many cases employing that provision in questions of preemption, see *infra* Part IV.B.

<sup>114</sup> See NIMMER & NIMMER, *supra* note 109, at § 1.01[B] (thanks to § 301(a), "courts usually need not gauge whether the federal interest in this field is dominant, whether the field of federal regulation is sufficiently comprehensive to raise an inference of intent to pre-empt, or whether any of the other pre-emption tests apply; rather, in general the courts may simply turn to the explicit statutory language.") (footnotes omitted).

<sup>115</sup> See *id.* (describing copyright preemption prior to the 1976 act).

<sup>116</sup> See, e.g., *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2nd Cir. 1980) (affirming summary judgment against common law unfair claim based on defendants' use of facts on grounds that, under *Sears & Compco*, "states are pre-empted from removing such material from the public domain."); *Triangle Publications, Inc. v. Sports Eye, Inc.*, 415 F. Supp. 682, 686 (E.D. Pa. 1976) (denying preliminary injunction on grounds that plaintiff's misappropriation claim preempted under the *Sears/Compco* doctrine that "state regulation of unfair competition is pre-empted as to matters falling within the broad confines of the copyright clause of the United States Constitution.").

<sup>117</sup> See, for example, *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 149 (D.D.C. 1980) (applying § 301 to resolve preemption issue but also favorably quoting *Hoehling* court's invocation of *Sears & Compco*); *Mitchell v. Penton/Industrial Publishing Co.*, 486 F. Supp. 22, 26 (N.D. Ohio 1979) (using both § 301 and the *Sears/Compco* doctrine to hold that plaintiff's misappropriation claim preempted).

for familiar precedents—not that implied copyright preemption enjoyed a robust coexistence with express preemption under § 301(a).

After § 301(a) rose to dominate copyright preemption doctrine, courts relied on implied preemption only in those particular and somewhat rare cases where a state regulatory scheme targeting rights and remedies under the Copyright Act was at stake.<sup>118</sup> Or, more accurately, courts arguably relied on implied preemption in those cases. The case of *Vault Corp. v. Quaid Software, Ltd.*,<sup>119</sup> offers a characteristically ambiguous example of the genre. The court there held a Louisiana statute regulating software licenses preempted without evidently relying on § 301(a). Neither, however, did the court disparage that section's relevance.<sup>120</sup> And, notably, the lower court in *Vault* had resolved the preemption issue by citing both § 301 and the implied preemption doctrine expressed in the Supreme Court's *Sears/Compco* cases.<sup>121</sup> Given its relatively quick discussion of the preemption issue, the court of appeals might well have simply neglected to cite the former source of preemption law. *Association of American Medical Colleges v. Cuomo*,<sup>122</sup> offers similarly equivocal support for the supposition that implied copyright preemption flourished alongside § 301(a). The court there, evaluating a New York law requiring disclosure of statistical information about and contents of academic exams, concluded that if the state law, "facilitates infringement, it conflicts with the federal Copyright Act and is preempted."<sup>123</sup> That arguably represents an instance of implied preemption, as the court did not cite § 301(a). But, then again, the court did not outwardly reject that section nor criticize an earlier trial court's invocation of § 301(a) to evaluate the preemption of that same state law.<sup>124</sup>

Perhaps the case of *American Society of Composers and Publishers v. Pataki*<sup>125</sup> offers a clear example of implied copyright preemption during the reign of § 301(a). That case concerned a New York state law requiring performing arts societies to give notice before investigating a party suspected of violating the copyrights of the societies' members, and imposing sanctions on the societies if they failed to give the suspect the required notice.<sup>126</sup> The *ASCAP v. Pataki* court found that statute preempted without

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<sup>118</sup> As Professor Goldstein explains, "State regulatory programs do not fit comfortably within the design of section 301. To varying degrees, these programs do affect copyright subject matter. But none creates a right equivalent to copyright." III PAUL GOLDSTEIN, COPYRIGHT § 15.2.1,3 15:16-1 (2d ed. Supp. 2005).

<sup>119</sup> 847 F.2d 255 (5th Cir. 1988).

<sup>120</sup> *Id.* at 268-70.

<sup>121</sup> See *Vault Corp. v. Quaid Software, Ltd.*, 655 F. Supp. 750, 761 (E.D. La. 1987) ("In this situation the *Sears-Compco* preemption doctrine, as well as § 301 of the Copyright Act, are both applicable.").

<sup>122</sup> 928 F.2d 519 (2nd Cir. 1991).

<sup>123</sup> *Id.* at 523. The court remanded the case for further consideration of that issue. *Id.* at 526.

<sup>124</sup> See *Association of American Medical Colleges v. Carey*, 482 F. Supp. 1358 (D.C.N.Y. 1980) (finding sufficient merit in claim that § 301(a) preempted the state law to justify issuance of preliminary injunction against its enforcement.).

<sup>125</sup> 930 F. Supp. 873 (S.D.N.Y. 1996).

<sup>126</sup> *Id.* at 876.

making any reference to § 301(a). It instead relied on *AAMC v. Cuomo*<sup>127</sup> and an implied preemption precedent<sup>128</sup> to conclude, "Because the provisions impose a notice requirement on copyright enforcers, and make non-compliance with the requirement actionable, the provisions hinder the realization of the federal copyright scheme."<sup>129</sup>

Even supposing that those cases show implied preemption survived in one small corner of copyright law, they hardly show the doctrine thriving after the enactment of § 301(a). At a minimum, it seems fair to say that for many years § 301(a) almost wholly crushed any interest in resolving copyright preemption questions by way of direct appeal to the supremacy clause. Furthermore, courts considering the sorts of generic common law or statutory claims typically responsible for triggering preemption inquiries—claims of unfair competition, misappropriation, conversion, breach of contract, or so forth—have long shown absolutely no interest in stepping outside the bounds of §301(a). So copyright preemption appeared, at any rate, prior to *Dastar*.

Seen against that background, *Dastar's* revolutionary impact on copyright preemption jumps forth. After nearly thirty years under the hegemony of § 301(a), and thanks solely to *Dastar's* liberating effect, courts have begun to revisit the fundamentals of copyright preemption. Intentionally or not, *Dastar* has freed lower courts to go beyond the strictures of § 301(a), to make direct appeal to the supremacy clause in questioning whether a state law cause of action conflicts with the Copyright Act.<sup>130</sup> As discussed below,<sup>131</sup> that revolution stands to reshape the future of copyright preemption.

#### **IV. Consideration of the Objection that § 301(a) Preempts Reverse Passing Off Claims**

Some authorities assert that § 301(a) of the Copyright Act preempts state law reverse passing off claims against defendants who market communicative products.<sup>132</sup> Were that claim true, it would mitigate this paper's argument that *Dastar* has revived direct Supremacy Clause preemption of state laws that conflict with federal copyright power.<sup>133</sup> To the contrary, § 301(a) would suffice to preempt the sorts of claims at issue

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<sup>127</sup> 928 F.2d 519 (2nd Cir. 1991).

<sup>128</sup> *Hines v. Davidowitz*, 312 U.S. 52, 67, 85 L. Ed. 581, 61 S. Ct. 399 (1941).

<sup>129</sup> *Id.* at 878.

<sup>130</sup> See *supra* Part II.B.4 (describing how courts have used *Dastar* rather than § 301(a) to decide copyright preemption questions).

<sup>131</sup> See *infra* Part V.

<sup>132</sup> See, e.g., *Marobie-FL, Inc. v. Nat'l Ass'n of Fire Equipment Distributors and Northwest Nexus, Inc.*, 983 F. Supp. 1167, 1181 (N.D. Ill. 1997) ("Claims premised on reverse passing off are preempted under the [Copyright] Act."); *Higher Gear Group, Inc. v. Rockenbach Chevrolet Sales, Inc.*, 223 F. Supp. 2d 953, 959 (N.D. Ill. 2001) ("claims based on 'reverse passing off,' where a defendant sells a plaintiff's product as his own, are generally preempted."); III PAUL GOLDSTEIN, COPYRIGHT § 15.16.1, 15:143 (2d ed. Supp. 2005) ("Courts have held that section 301 preempts actions for 'reverse passing off' in which the defendant copies the plaintiff's work and passes it off as defendant's.") (footnote omitted).

<sup>133</sup> See *supra* Part III.



in *Dastar*. In that event, courts could—and undoubtedly would—continue to rely solely on the Copyright Act to resolve copyright preemption issues. Direct Supremacy Clause preemption would remain a largely theoretical issue in copyright law, one unlikely to have any practical impact. As this section explains, however, no authority can convincingly assert that § 301(a) preempts state law claims like those at issue in *Dastar* nor, when read closely, do many authorities actually do so.

Section 301(a) of the Copyright Act preempts any state law that satisfies two conditions: it creates "legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106," and those rights cover "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . ." <sup>134</sup> The second condition does not have particular pertinence to the question of § 301(a)'s power to preempt state reverse passing off claims; the issue turns on interpretation of the first condition. <sup>135</sup>

As the plain language of that provision suggests, and as courts and commentators agree, if a state law claim requires proof of an element not required for a copyright claim, that state law claim will escape preemption under § 301(a). <sup>136</sup> A state law unfair competition reverse passing off claim easily passes that test. Generally speaking, such a claim requires proof that the defendant: 1) caused likely commercial harm to the plaintiff; 2) by misrepresenting; 3) in a manner likely to confuse prospective consumers; 4) that the defendant was the origin of goods or services; 5) in fact originating with the plaintiff. <sup>137</sup> All but the last of those elements go beyond the requirements for a copyright infringement claim.

Consider, for instance, someone who illegally duplicates copyrighted movies and sells them as admittedly unauthorized copies. Far from misrepresenting the source of those movies, the pirate trumpets the fact that he offers good but cheap copies of someone else's intellectual property. <sup>138</sup> He thus commits copyright infringement without

<sup>134</sup> 17 U.S.C.S. § 301(a) (2005).

<sup>135</sup> See also *id.* at (b) ("Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to—(1) subject matter that does not come within the subject matter of copyright . . . [or] (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 . . .").

<sup>136</sup> See, e.g., *Computer Assocs. Int'l v. Altai, Inc.*, 982 F.2d 693, 716 (2nd Cir. 1992); *Oddo v. Ries*, 743 F.2d 630, 635 (9th Cir. 1984); *NIMMER & NIMMER*, *supra* note 109, at 1.01[B][1] (collecting cases in support of the proposition that "the 'extra element' test generally furnishes the touchstone here.") (footnote omitted).

<sup>137</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 5 (1995).

<sup>138</sup> Recall that we here question whether the pirate is engaging in the reverse passing off of the copyrighted movie, rather than of the physical DVDs or video tapes on which the copyright recorded the movie. The latter, entirely different practice, would surely support an unfair competition claim. See *Dastar*, 539 U.S. at 31 (explaining that the plaintiffs' claim "would undoubtedly be sustained if *Dastar* had bought some of New Line's *Crusade* videotapes and merely repackaged them as its own.").

also engaging in the reverse passing off of a communicative product.<sup>139</sup> Such a reverse passing off would require proof of different and additional elements—namely, misrepresentations likely to confuse consumers as to the origin of the movie—not required by the copyright infringement claim. Commentators thus agree that § 301(a) should not preempt a well-pleaded claim under state law against the reverse passing off of a communicative product.<sup>140</sup>

Most courts agree. In particular, and notably,<sup>141</sup> the Second and Ninth Circuits have concluded that a well-pleaded reverse passing off claim includes extra elements protecting it from § 301(a) preemption. Courts elsewhere largely concur.

Start with the Second Circuit. Although the circuit court in *Kregos v. Associated Press*, found preempted by § 301(a) the state law unfair competition-qua-false designation of origin claim under consideration, it did so because, "as [plaintiff] has formulated his pleadings, the claim contains no element to qualitatively differentiate it from those areas protected by copyright."<sup>142</sup> The plaintiff complained only that the defendants had published his work without crediting him—not that they had taken credit for it themselves.<sup>143</sup> He thus failed to properly plead the extra elements that distinguish a reverse passing off claim from a copyright one. Conversely, the circuit court in *Waldman Pub. Corp. v. Landoll, Inc.*, ventured that "A claim of reverse passing off is separate and distinct from a claim of copyright infringement."<sup>144</sup>

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<sup>139</sup> Strictly speaking, even if the pirate misrepresented that he was selling legal copies of the movie, he would risk liability for the *direct* passing off the DVDs or videos as authentic rather than for the *reverse* passing off someone else's goods or services as his own. I describe the pirate as selling admittedly unauthorized copies only because pirates sometimes do so and because it simplifies the example.

<sup>140</sup> See NIMMER & NIMMER, *supra* note 109, at § 1.01[B][1], n. 62 ("[F]alse representation as to the identity of the author or copyright owner is not an act of copyright infringement, and hence, a state law prohibiting such conduct is not an 'equivalent' right."); John T. Cross, *Giving Credit Where Credit is Due: Revisiting the Doctrine of Reverse Passing Off in Trademark Law*, 72 WASH. L. REV. 709, 747-48 (1997) (explaining that reverse passing off should not be preempted under § 301(a) because, "State law reverse passing off almost always includes an important extra element that makes it qualitatively different than any of the rights granted by section 106 of the Copyright Act. This extra element is defendant's false representation that defendant is the source of the product.") (footnote omitted).

<sup>141</sup> Given the volume and significance of the copyright cases that the two circuits generate, "Some view the Second and the Ninth Circuits as the de facto consolidated court of copyright appeals . . ." Chris J. Katopis, *The Federal Circuit's Forgotten Lessons?: Annealing New Forms Of Intellectual Property Through Consolidated Appellate Jurisdiction*, 32 JOHN MARSHALL L. REV. 581, 612-13 (1999).

<sup>142</sup> 3 F.3d 656, 666 (2d Cir. 1993).

<sup>143</sup> *Id.*

<sup>144</sup> 43 F.3d 775, 779 n.3 (2d Cir. 1994). Notably, however, that statement qualifies as *dicta* with regard to state law reverse passing off claims. Although the circuit court was vacating in part *Waldman Pub. Corp. v. Landoll, Inc.*, 848 F. Supp. 498 (S.D.N.Y. 1994), the portion of that trial opinion disposing of the state law reverse passing off claim was not on appeal.

District courts in the Second Circuit have in recent years both followed *Kregos* and confirmed the implication that a well-pleaded reverse passing off claim will not suffer preemption under § 301(a). The court in *Faulkner v. Nat'l Geographic Soc'y*, for instance, held that, "Plaintiffs' common law unfair competition claim is preempted because it alleges nothing other than false designation of origin through improper use of copyright notice."<sup>145</sup> The court in *Silverstein v. Penguin Putnam, Inc.*, in contrast, found that the plaintiffs' "unfair competition claims covering reverse passing off are not preempted because those claims involve the extra element of misrepresentation or deception."<sup>146</sup> After confirming that "unfair competition claims asserting 'reverse passing off' claims are generally not preempted by the copyright laws," the court in *Kaplan v. Stock Market Photo Agency, Inc.* found the particular claims before it failed on other grounds.<sup>147</sup> The court in *Scholastic, Inc. v. Stouffer* likewise judged that the plaintiff before it had "alleged the necessary extra element to affirmatively distinguish that claim from a copyright infringement action."<sup>148</sup> Older cases from district courts in the Second Circuit speak somewhat more equivocally<sup>149</sup> but, by dint of their age if nothing else, less authoritatively.<sup>150</sup>

Consistent with the plain meaning and universal interpretation of § 301(a), courts in the Ninth Circuit do not read that provision to preempt a state law reverse passing off claim that pleads elements beyond those required for a copyright claim. As the appellate court in *Summit Machine Tool Mfg. Corp. v. Victor CNC Systems, Inc.*, put it, "State unfair competition laws which seek to prevent reverse palming off are not preempted by

<sup>145</sup> 211 F. Supp. 2d 450, 478 (S.D.N.Y. 2002), *affirmed on other grounds sub nom*, *Faulkner v. Mindscape Inc.*, 2005 U.S. App. LEXIS 3642 (2d Cir. 2005).

<sup>146</sup> 2003 U.S. Dist. LEXIS 5487, at \*25-\*26, Copy. L. Rep. (CCH) P28,602 (S.D.N.Y. April 4, 2004), *reversed and remanded on other grounds*, 368 F.3d. 77 (2d Cir. 2004).

<sup>147</sup> 133 F. Supp. 2d 317, 329 (S.D.N.Y. 2001) (dismissing the claims because "plaintiff cannot establish substantial similarity as a matter of law.").

<sup>148</sup> 124 F. Supp. 2d 836 (S.D.N.Y. 2000).

<sup>149</sup> *Compare Tracy v. Skate Key Roller Rink Corp., Inc.*, 697 F. Supp. 748, 751 (S.D.N.Y. 1988) ("both passing off and reverse passing off claims involve the same additional element, misrepresentation or deception, that makes it 'not equivalent to any of the exclusive rights' of copyright law recognized in the statute.") *and*, *Kisch v. Ammirati & Puris Inc.*, 657 F. Supp. 380, 385 (S.D.N.Y. 1987) (finding of state passing off claim that "plaintiff is not asserting rights equivalent to those protected by copyright and therefore does not encounter preemption.") *with*, *Orth-O-Vision, Inc. v. Home Box Office*, 474 F. Supp. 672, 684 n.12 (S.D.N.Y. 1979) (finding preempted by § 301(a) a claim that plaintiff characterized as "palming off"—which the court allowed would escape preemption—but that court construed as a claim for reverse passing off).

<sup>150</sup> The trial court opinion in *Waldman Pub. Corp. v. Landoll, Inc.*, 848 F. Supp. 498 (S.D.N.Y. 1994), looks especially suspect. The court there held, "Where a plaintiff claims that defendant has copied plaintiffs' product and sold it under defendant's name, that claim of reverse passing off is preempted by the Copyright Act." *Id.* at 505. On appeal, the Second Circuit vacated the case on other grounds but observed, "A claim of reverse passing off is separate and distinct from a claim of copyright infringement." 43 F.3d 775, 779 n. 3 (2d Cir. 1994). *See also* *American Movie Classics Co. v. Turner Entertainment Co.*, 922 F. Supp. 926, 934 (S.D.N.Y. 1996) (following *Waldman* trial court opinion to find preempted by § 301(a) a claim where defendant "is essentially accused of exhibiting films which [plaintiff] had exclusive rights to exhibit.").

federal law."<sup>151</sup> Granted, the appellate court of *Kodadek v. MTV Networks, Inc.*,<sup>152</sup> subsequently found preempted by § 301(a) a state unfair competition claim arising out of allegations that defendants had attributed to Mike Judge the "Beavis and Butthead" characters created by plaintiff.<sup>153</sup> Perhaps that misattribution would have supported a properly pleaded reverse passing off claim. The court premised preemption analysis, however, on the observation that the plaintiff expressly bases his unfair competition claim on rights granted by the Copyright Act.<sup>154</sup> That unfair competition claim, because it failed to add any elements beyond those in his copyright claim, necessarily failed to escape § 301(a) preemption.<sup>155</sup>

Following the lead of those appellate decisions, district courts in the Ninth Circuit have found that § 301(a) preempts only those state law reverse passing off claims that fail to plead elements beyond those required for a copyright claim.<sup>156</sup> The recent case of *Salim v. Lee* reviewed Ninth Circuit law to conclude that an "unfair competition claim is not preempted to the extent it alleges reverse passing off under state law."<sup>157</sup> Similarly, the court in *Idema v. Dreamworks, Inc.* found the plaintiffs' fraud and negligent misrepresentation claims preempted under § 301(a) due to their "failure to make out a claim of 'reverse passing off' . . . ."<sup>158</sup> *Idema* thus strongly suggests what *Salim* proved: a properly pleaded reverse passing off claim will survive § 301(a) preemption in the Ninth Circuit. Demonstrating an opposite outcome under the Ninth Circuit's test for § 301(a) preemption, the court in *Perfect 10, Inc. v. Cybernet Ventures, Inc.*, dismissed state law unfair competition claims that alleged no more than "misappropriation of third-party content" and "willful infringement" of copyrights.<sup>159</sup>

Not all the decisions of district courts in the Ninth Circuit so clearly conform to the now-prevailing view that § 301(a) will not preempt a properly pleaded reverse passing off claim. The case of *CD Law Inc. v. LawWorks Inc.*,<sup>160</sup> for instance, takes a little explaining. The court there found preempted by § 301(a) a Washington state law unfair competition claim premised on, *inter alia*, the wrongful use of information that plaintiff

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<sup>151</sup> 7 F.3d 1434, 1441 (9th Cir. 1993).

<sup>152</sup> 152 F.3d 1209 (9th Cir. 1998).

<sup>153</sup> *Id.* at 1210.

<sup>154</sup> *Id.* at 1213.

<sup>155</sup> See also *Litchfield v. Spielberg*, 736 F.2d 1352, 1358 (9th Cir. 1984) ("In so far as these state claims are restatements of the copyright infringement claims, they are preempted by federal copyright law.").

<sup>156</sup> For reasons discussed *supra*, at Part II.B.4, the cases of *Aagard v. Palomar Builders, Inc.*, 344 F. Supp. 1211 (E.D. Cal. 2004), and *Williams v. UMG Recordings, Inc.*, 281 F. Supp.2d 1177 (C.D. Cal. 2003), though concerning preemption of state reverse passing off claims, do not properly qualify as cases that resolve the issue using § 301(a). Rather, those two cases resolve the issue using *Dastar* case.

<sup>157</sup> 202 F. Supp. 2d 1122, 1127 (C.D. Cal. 2002).

<sup>158</sup> 62 F. Supp. 2d 1129, 1191 (C.D. Cal. 2001) (explaining that the preempted claims were "virtually identical" to the Lanham Act claim the court had earlier dismissed on those same grounds).

<sup>159</sup> F. Supp. 2d 1114, 1125 (C.D. Cal., 2001) (citing *Kodadek* in support).

<sup>160</sup> 1994 U.S. Dist. LEXIS 20776, 35 U.S.P.Q.2d (BNA) 1352 (W.D. Wash. 1994).

published on CD-ROM discs and "defendants' wrongful labelling [sic] of their disc without attributing plaintiff's contribution."<sup>161</sup> As other cases demonstrate, however, no mere failure to attribute will suffice to support a claim for the reverse passing off.<sup>162</sup> Also, the plaintiff in *CD Law* failed to allege that consumer confusion was likely to result. The case thus did not concern a properly pleaded claim for reverse passing off, making the *CD Law* court's finding of § 301(a) preemption consistent with the Ninth Circuit approach. Other, older decisions of district courts in the Ninth Circuit prove more resistant to assimilation with that now predominating view.<sup>163</sup> Because those cases date back to 1990 or earlier, however, they simply fail to reflect the Ninth Circuit's current approach to § 301(a) preemption of *Dastar*-like claims raised under state law.

Courts elsewhere generally take the same approach to § 301(a) preemption of state law reverse passing off claims. District courts in the Sixth Circuit have twice now made clear that they will permit such a claim if it comes supported by adequate pleading.<sup>164</sup> District courts in the other circuits have implied as much by preempting reverse passing claims under § 301(a) expressly because those claims failed to allege the full panoply of elements that properly distinguish reverse passing off from copyright infringement. The court in *Costar Group, Inc. v. Loopnet, Inc.*, for instance, dismissed a reverse passing off claim because the plaintiff alleged no more than "the mere act of copying,"<sup>165</sup> thus leaving open the possibility that a claim alleging misrepresentation of authorship and likelihood of consumer confusion would survive § 301(a) preemption. District courts in the Federal Circuit have likewise held that "a failure to attribute' is alone insufficient for a state-law claim to avoid Copyright Act preemption."<sup>166</sup>

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<sup>161</sup> *Id.* at \*7. Plaintiff's claim also alleged that defendants obtained the disc under fraudulent pretenses. *Id.*

<sup>162</sup> See, e.g., *Costar Group, Inc. v. Loopnet, Inc.*, 164 F. Supp. 2d 688, 714 (D. Md. 2001), *affirmed on other grounds*, 2004 U.S. App. LEXIS 12123 (4th Cir. Md., June 21, 2004); *Meyer v. Giles*, 1992 U.S. Dist. LEXIS 21264, at \*9; Copy. L. Rep. (CCH) P27,080 (W.D. Mich. 1992); *Lacour v. Time Warner, Inc.*, 2000 U.S. Dist. LEXIS 7286, \*26-\*27; Copy. L. Rep. (CCH) P28,108 (N.D. Ill. 2000); *International Kitchen Exhaust Cleaning Ass'n v. Power Washers of North America*, 81 F. Supp. 2d 70, 74 (D.D.C. 2000).

<sup>163</sup> See, e.g., *Xerox Corp. v. Apple Computer, Inc.*, 734 F. Supp. 1542, 1550-51 (N.D. Cal. 1990) (finding reverse passing off claim preempted by § 301(a)); *Bull Publ'g Co. v. Sandoz Nutrition Corp.*, 1989 U.S. Dist. LEXIS 16622, \*18-\*20, 13 U.S.P.Q.2d (BNA) 1678 (N.D. Cal. 1989) (same).

<sup>164</sup> See *Meyer v. Giles*, 1992 U.S. Dist. LEXIS 21264, \*9; Copy. L. Rep. (CCH) P27,080 (W.D. Mich. 1992) (dismissing as preempted by § 301(a) an unfair competition claim sounding in misappropriation, explaining, "There are no allegations in the complaint regarding whether [defendant] 'palmed off' or 'passed off' [plaintiff's] work as his own. Indeed, had there been such allegations in the complaint, no preemption would be found."); *P.I.T.S. Films v. Laconis*, 588 F. Supp. 1383, 1386 (E.D. Mich. 1984) (distinguishing a misappropriation claim preempted by § 301(a) from a claim where "plaintiff alleges unfair competition by virtue of misrepresentation and passing off, [which] is not subject to preemption.").

<sup>165</sup> 164 F. Supp. 2d 688, 714 (D. Md. 2001), *affirmed on other grounds*, 2004 U.S. App. LEXIS 12123 (4th Cir. Md., June 21, 2004).

<sup>166</sup> *International Kitchen Exhaust Cleaning Ass'n v. Power Washers of North America*, 81 F. Supp. 2d 70, 74 (D.D.C. 2000). See also *Peckarsky v. ABC, Inc.* 603 F. Supp. 688, 696 (D.D.C.

A few courts, granted, appear to have read § 301(a) to preempt *all* state law reverse passing off claims, no matter how well pleaded. As noted above, such a reading does not conform with the plain language or received meaning of § 301(a).<sup>167</sup> Nor, as the above review of the case law indicates, does that reading conform with the most authoritative, numerous, and recent judicial interpretations.<sup>168</sup> Nonetheless, some (but far from all) trial courts in the Seventh and Eleventh Circuits appear to have vested § 301(a) with unduly broad power to preempt state reverse passing off claims.

Among trial courts in the Seventh Circuit, the trend started with *FASA Corp. v. Playmates Toys, Inc.*<sup>169</sup> Although the *FASA* court allowed that some courts and commentators had concluded that § 301(a) does not preempt state law reverse passing off claims,<sup>170</sup> it ultimately concluded that the reverse passing off claim under consideration lacked the additional elements necessary to distinguish the claim from one for copyright infringement.<sup>171</sup> For reasons carefully explained by Professor Roberta Kwall, *FASA* suffers a somewhat dubious provenance.<sup>172</sup> Even so, the facts of the case do not take its holding far beyond the many cases from other jurisdictions, reviewed above,<sup>173</sup> that have disallowed inadequately pleaded state reverse passing off claims while still leaving room for claims that rely on the extra elements that distinguish reverse passing off from copyright infringement.<sup>174</sup>

Most other district courts in the Seventh Circuit have taken *FASA* to support an appropriately modest view of § 301(a).<sup>175</sup> A couple of district courts in the Seventh

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1984) (explaining that assertion of a failure to attribute authorship "in an otherwise pre-empted common law action will not save the common law claim from pre-emption.").

<sup>167</sup> See *supra*, text accompanying notes 134-40.

<sup>168</sup> See *supra*, text accompanying notes 141-66.

<sup>169</sup> 869 F. Supp. 1334, 1358-64 (N.D. Ill. 1994) (state law misrepresentation and tortious interference), *vacated and remanded on other grounds*, 108 F.3d 140 (7th Cir. 1997)

<sup>170</sup> *Id.* at 1362 ("Courts and commentators have not consistently answered the question of whether a state law claim premised on reverse passing off is preempted by the Copyright Act.").

<sup>171</sup> *Id.* at 1361-64.

<sup>172</sup> See 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, 1019 (2002) (questioning the reasoning of the *FASA* court and observing that "had the *FASA* court had available to it the Second Circuit's opinion in [*Waldman Pub. Corp. v. Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994)], it is possible the *FASA* court would have analogized the state unfair competition claim to a section 43(a) claim and held that the misrepresentation of a work's creator is an element that renders the state unfair competition action 'qualitatively different' from one based on copyright law.") (footnotes omitted).

<sup>173</sup> See *supra*, text accompanying notes 141-66.

<sup>174</sup> See, e.g., *FASA*, 869 F. Supp. at 1361 ("FASA's unfair competition counts are predicated on exactly the same conduct as that underlying the copyright counts . . ."); *id.* at 1361-62 ("[W]e cannot conclude that an allegation of misrepresentation based solely on an alleged infringer's act of displaying, selling, or promoting the infringing work as his or her own creation, is sufficient to remove a state based claim from the preemptive reach of 17 U.S.C. § 301(a).").

<sup>175</sup> See *Mist-On Systems, Inc. v. Gilley's European Tan Spa*, 303 F. Supp. 2d 974, 980 (W.D. Wis. 2002) (finding unfair competition claim preempted by § 301(a) because "plaintiff does not allege

Circuit have, however, taken *FASA* as a launching point for dubiously broad assertions like, "Claims premised on reverse passing off are preempted under the [Copyright] Act."<sup>176</sup> Those courts did not issue holdings nearly so broad as their assertions, however; rather, they relied on the conventional analysis under which only inadequately pleaded reverse passing off claims suffer § 301(a) preemption.<sup>177</sup> Some courts can apparently see through that rhetoric to the underlying law.<sup>178</sup> Unfortunately, however, the court in *Balsamo/Olson Group, Inc. v. Bradley Place, Ltd. Partnership*, appears to have taken that somewhat wild language seriously.<sup>179</sup>

Trial courts in the Eleventh Circuit have issued contradictory views about the power of § 301(a) to preempt state reverse passing off claims. The defendants in *Pelican Engineering Consultants v. Sheeley* copied plaintiff's building plans without

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any additional facts beyond those asserted to support its copyright claim and it does not distinguish the copyright and state common law claims."); *Villa v. Brady Publishing*, 2002 U.S. Dist. LEXIS 11753, \*9 (N.D. Ill. 2002) (preempting claim that unauthorized reproduction of plaintiff's artwork constituted a deceptive business practice on grounds that plaintiff's assertions "are qualitatively identical to those that would be form [sic] the basis of a copyright infringement claim."); *Lacour v. Time Warner, Inc.*, 2000 U.S. Dist. LEXIS 7286, \*26; Copy. L. Rep. (CCH) P28,108 (N.D. Ill. 2000) (holding state law reverse passing off claim preempted under § 301(a) because plaintiff alleged only that defendant failed to credit him as the work's author and "does not allege any act of misrepresentation beyond this."); *Goes Lithography Co. v. Banta Corp.*, 26 F. Supp. 2d 1042 (N.D. Ill., 1998) (summarizing decisions of sister courts as holding "that the inherent misrepresentation that accompanies the unauthorized copying and reproduction of another's copyrighted work in a reverse passing off case without more is not enough to constitute a cause of action under [Illinois unfair competition law].").

<sup>176</sup> *Marobie-FL, Inc. v. Nat'l Ass'n of Fire Equipment Distributors and Northwest Nexus, Inc.*, 983 F. Supp. 1167, 1181 (N.D. Ill. 1997) (citing *FASA* in support of assertion). *See also*, *Higher Gear Group, Inc. v. Rockenbach Chevrolet Sales, Inc.*, 223 F. Supp. 2d 953, 959 (N.D. Ill. 2001) (citing *FASA* in support of assertion that "claims based on 'reverse passing off,' where a defendant sells a plaintiff's product as his own, are generally preempted.").

<sup>177</sup> *See Higher Gear Group*, 223 F. Supp. 2d at 959 (explaining that § 301(a) preempted the state law claim before it because, "The crux of the claim is that Auto eDirect and/or Vitols made unauthorized copies of [defendant's] software, which is the same conduct necessary to support a copyright infringement claim."); *Marobie-FL*, 983 F. Supp. at 1180 ("Plaintiff's copyright infringement claim and unfair competition claim are based on the same conduct: the unauthorized copying and distribution of its clip art . . . There are no new allegations of likelihood of consumer confusion in Count II. In fact, there are no new allegations at all in Count II." The court added, citing *FASA* as support, "In any event, the inherent misrepresentation that accompanies the unauthorized copying and distribution of another's copyrighted work is not enough." *Id.*).

<sup>178</sup> *See, e.g., Chicago Style Productions, Inc. v. Chicago Sun Times, Inc.*, 313 Ill. App. 3d 45, 48 (1st Dist. Ill. App. Ct. 2000) (quoting the above passage from *Marobie-FL* but preempting plaintiff's claim because "plaintiff's failure to allege that the [defendant] made affirmative misrepresentations about the origin of its "Chicago Style" series renders its Consumer Fraud Act claim identical to a copyright claim." *Id.* at 49).

<sup>179</sup> 950 F. Supp. 896, 898-99 (C.D. Ill. 1997) (finding claim under Illinois statute against deceptive trade practices preempted notwithstanding allegations of deception causing consumer confusion).

authorization and under another name.<sup>180</sup> The district court found that § 301(a) did not preempt the plaintiff's common law unfair competition claim because the plaintiff alleged consumer confusion.<sup>181</sup> The district court in *Law Bulletin Publ'g Co. v. LRP Pubs., Inc.*, by contrast, found the plaintiff's reverse passing off claim preempted by § 301(a) because the "extra element" of "misrepresentation leading to consumer confusion" that allegedly distinguished passing off claims from copyright claims "is present only minimally in the reverse passing off context."<sup>182</sup> The Eleventh Circuit court of appeals affirmed the latter case, albeit without expressly condoning the trial court's broad condemnation of reverse passing off claims.<sup>183</sup>

Before closing this review of the case law addressing whether § 301(a) preempts reverse passing off claims, we should keep in mind that, prior to *Dastar*, courts and litigants might not have thought or dared to look outside of the scope of the Copyright Act when faced with dubious state law claims. Some courts might thus have worked a bit too hard to squeeze state law reverse passing off claims within the bounds of § 301(a) preemption. Courts need no longer resort to that legal gambit, however, because *Dastar* has now opened the way to direct Supremacy Clause preemption of reverse passing off claims that conflict with ends and means of copyright law. To the plain language of § 301(a), the commentary explaining its meaning, and the overwhelming judicial authority holding that § 301(a) does not preempt an adequately-pleaded state law reverse passing off claim, courts can now add the Supreme Court's reassurance that the Supremacy Clause can do what § 301(a) cannot. Especially after *Dastar*, courts should not, need not, and thus probably will not find that § 301(a) preempts all state law reverse passing off claims.

## V. The Future of Copyright Preemption

How will *Dastar* shape copyright preemption doctrine in coming years? At the very least, courts considering the preemption of state reverse passing off claims will continue to seize on the case as a simpler and more authoritative alternative to § 301(a) of the Copyright Act. Courts have already done so in several instances. It also looks likely that courts applying the broad principles of *Dastar* to state reverse passing off claims will, consciously or not, expand the reach of copyright preemption beyond the limits of § 301(a). That trend, too, arguably has begun. Farther into the future, after citing *Dastar* to preempt state reverse passing off claims has become commonplace, courts may begin applying the case to preempt other types of state law claims. In that event, *Dastar* will lead to the preemption of state law claims that escape the reach of § 301(a) but nonetheless impermissibly conflict with federal copyright law. This Part explains each of those predictions, in turn.

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<sup>180</sup> 2000 U.S. Dist. LEXIS 12577, \*8; 56 U.S.P.Q.2D (BNA) 1477; Copy. L. Rep. (CCH) P28,154 (M.D. Fla. 2000).

<sup>181</sup> *Id.* at \*8.

<sup>182</sup> 1998 U.S. Dist. LEXIS 11345, \*13 (S.D. Fla. 1998).

<sup>183</sup> 66 F.3d 1305 (11th Cir. 2001).



Courts will almost certainly continue the practice, already evident in the case law,<sup>184</sup> of relying on *Dastar* rather than § 301(a) to resolve difficult questions about the preemption of state reverse passing off claims. Applying § 301(a), especially its "extra element" test, poses a notoriously difficult problem, as anyone who has tried to wade through the meandering case law on § 301(a) can testify.<sup>185</sup> *Dastar* offers courts an authoritative yet simple way around that problem. The *Aagard* opinion<sup>186</sup> gives ready proof of how and why courts grappling with copyright preemption doctrine might abandon § 301(a) for *Dastar*. Tackling the question of whether or not to preempt a state law reverse passing off claim, the *Aagard* court initially framed the issue in terms of § 301(a).<sup>187</sup> As detailed above, however, the court botched that attempt and, intentionally or not, abandoned § 301(a) to resolve the matter solely in reliance on *Dastar*.<sup>188</sup> Other courts applying *Dastar* to decide state law reverse passing off claims have not even bothered citing § 301(a).<sup>189</sup> Future courts will not only face the same easy choice between § 301(a) and *Dastar*; they will also increasingly find that they can rely on earlier courts in choosing the latter.

We should thus expect to see courts habitually decide the preemption of state law reverse passing off claims by light of *Dastar* and its lower court progeny, rather than § 301(a). It furthermore looks likely that, as a consequence, courts will expand copyright preemption doctrine beyond the confines of § 301(a). That statutory provision, recall, aims at barring state law rights that "are equivalent to any of the exclusive rights" afforded by copyright law.<sup>190</sup> The *Dastar* Court, in contrast, barred the unfair competition claim before it for interfering with copyright policy, not for duplicating copyright law rights.<sup>191</sup> *Dastar* thus offers nothing like the sort of "extra elements" inquiry that courts applying § 301(a) routinely engage in.<sup>192</sup> As courts increasingly turn to the *Dastar* line of cases, rather than to § 301(a), in resolving preemption questions, they

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<sup>184</sup> See *supra* Part II.B.4.

<sup>185</sup> As one such person, I am quite happy to testify to that claim. But, should additional proofs be required, see, e.g., Ashley D. Hayes, Note: *The Right of Publicity and Protection of Personae: Preemption Not Required*, 51 SYRACUSE L. REV. 1049, 1067 (2001) ("Although section 301 of the Copyright Act was intended to alleviate the confusion regarding preemption analysis that existed prior to the 1976 Copyright Act, it has not met this intended purpose."); Shelley Ross Saxe, Note: *Baltimore Orioles, Inc. V. Major League Baseball Players Association: The Right of Publicity in Game Performances and Federal Copyright Preemption*, 36 UCLA L. REV. 861, 878 (1989) ("Determining whether a state right is *equivalent* to any of the rights protected by the federal copyright statute is one of the most difficult aspects of analyzing federal copyright preemption.") (emphasis in the original).

<sup>186</sup> *Aagard v. Palomar Builders, Inc.*, 344 F. Supp. 1211 (E.D. Cal. 2004).

<sup>187</sup> *Id.* at 1217.

<sup>188</sup> See *supra*, Part II.B.4.

<sup>189</sup> See *Creeden & Assocs., Ltd. v. Infsoft, Inc.*, 326 F. Supp. 2d 876 (N.D. Ill. 2004); *Williams v. UMG Recordings, Inc.*, 281 F. Supp.2d 1177 (C.D. Cal. 2003); *Twentieth Century Fox Film Corp. v. Dastar Corp.*, 2003 U.S. Dist. LEXIS 21194, 68 U.S.P.Q.2d (BNA) 1536 (C.D. Cal. Oct. 14, 2003).

<sup>190</sup> 17 U.S.C.S. § 301(a) (2005).

<sup>191</sup> See *supra* Part II.A (detailing reasoning of *Dastar* Court).

<sup>192</sup> See *supra* Part IV.B (describing "extra elements" test and its application in the case law).

will decreasingly ask whether a state law claim is equivalent to, or has the same elements as, a copyright law claim. Rather, following *Dastar's* lead, courts will ask whether a suspect state law claim threatens to conflict with federal copyright policy.

Will that mark an improvement in copyright law or, more importantly, in intellectual property law as a whole? I doubt it. The notorious vagaries of *Sears*, *Compro*, and *Bonito Boats* show that implied conflicts preemption hardly offers bright prospects for the rule of law. Granted, § 301(a) has won deserved criticism for likewise casting impenetrable shadows. But by way of their "extra element" gloss, courts eventually interpreted §301(a) so as to mark off broad categories of state law as plainly beyond the threat of preemption. Case law interpreting implied conflict copyright preemption won't offer equally sharp (or, more properly, equally fuzzy) boundaries for years, at best. Such reflections lead me to conclude that the last and greatest surprise to issue from *Dastar*, that wildcard of a case, may well be its most unwelcome one.

## VI. Conclusion

*Dastar* offers a wealth of surprises. What started out looking like a well-intentioned, tightly reasoned, and modestly limited little case has, in only a few years, grown into an intellectual property powerhouse. *Dastar* nominally does no more than bar federal unfair competition alleging the reverse passing off of goods communicating formerly-copyrighted material. In application, however, *Dastar* has come to bar federal *or state* unfair competition claims alleging the reverse passing off of goods *or services* communicating formerly-copyrighted, *still-copyrighted*, *uncopyrightable*, *or trade-secret* protected material. In brief, *Dastar* now prohibits almost all complaints about the misattribution of intellectual property.

That phenomenon alone would merit attention. But *Dastar* conceals yet another, related, and bigger surprise. The *functional equivalence* between federal and state unfair competition claims means that case's policy arguments apply to the latter as well as the former. Courts have thus quite sensibly cited *Dastar* as justification for barring state law reverse passing off claims. The *legal differences* between reverse passing off and copyright claims, however, means that *Dastar* cannot derive its power to preempt state reverse passing off claims from §301(a) of the Copyright Act. A reverse passing claim has "extra elements" that distinguish it from a copyright claim and, thus, immunize a state reverse passing off claim from express preemption under § 301(a). Only the long-moribund and ill-defined doctrine of implied preemption can explain *Dastar's* power over state reverse passing off claims. It remains uncertain what will come of that, *Dastar's* most revolutionary impact.

The *Dastar* Court probably did not foresee that lower courts would apply its opinion to so broad a range of unfair competition claims. Everyone, it seems, underestimated the case on that count. We may still have time, however, to understand and estimate *Dastar's* ultimate impact on copyright preemption doctrine.