

ARTICLE

PRESERVING CREATIVITY FROM ENDLESS DIGITAL EXPLOITATION: HAS THE TIME COME FOR THE NEW CONCEPT OF COPYRIGHT DILUTION?

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I. INTRODUCTION

Time Magazine named “You” as its Person of the Year in 2006, lauding the explosion of the imaginative efforts of millions of individuals, working alone or in collaborative groups, who post creative content on diverse open content sites.¹ Everything from the text of the online reference source, Wikipedia,² to

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¹ Lev Grossman, *Time’s Person of the Year: You*, TIME MAGAZINE, Dec. 13, 2006, available at <http://www.time.com/time/magazine/article/0,9171,1569514,00.html>.

² Wikipedia home page, <http://www.wikipedia.org/> (last visited Feb. 27, 2007). Wikipedia is an example of an open content site wherein online contributors can upload and

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short video clips on YouTube,³ to the portals for emerging musical artists and bands on MySpace, suggests a sea change in the development of online information and entertainment.⁴ The sources for online creative content are becoming increasingly decentralized in the digital age,⁵ with the spread of broadband connectivity and the rapid growth in technological tools that allow even the novice to develop new creative works or manipulate existing ones.⁶ In addition, more content is being produced in or converted to a digital format⁷

edit articles, photos, and other informational materials contained on this online community encyclopedia. Wikipedia: About, <http://en.wikipedia.org/wiki/Wikipedia:About> (last visited Feb. 27, 2007). According to the site, as of February 2007, over 75,000 individuals have contributed to the site, collaborating on more than 5,300,000 articles in over 100 languages. *Id.*

³ Established in 2005, YouTube allows web users to upload, share, and view brief video clips with approximately 70 million video clips viewed each day on the site. YouTube.com, <http://www.youtube.com/t/about> (last visited Feb. 27, 2007).

⁴ See Grossman, *supra* note 1. See *infra* notes 5-7 and accompanying text.

⁵ Grossman, *supra* note 1; Thomas P. Heide, *The Moral Right of Integrity and the Global Information Infrastructure: Time for a New Approach?*, 2 U.C. DAVIS J. INT'L L. & POL'Y 211, 218-19, 222-24 (1996). Regarding this change, Mr. Heide states that,

Through developments in communications technology, users can transmit as well as receive information. The networks allow users to acquire easily works produced by other users. Users can jointly produce works with each other over a network. Also, they can appropriate any application program, work or other content and incorporate it into other applications or multimedia works, which can then be supplied to others. The implication for the integrity right is clear. As users may easily move from their conventional role of consumers of information to that of providers of information, it is easy to disseminate widely a work that infringes the right. Consequently, this lessens the author's ability to control the re-use of her work.

Id. at 218-19. He notes that "virtually anyone has the opportunity to become an 'interactive artist'." *Id.* at 222-23. See *supra* note 5 and accompanying text.

⁶ See Heide, *supra* note 5, at 216-19 (author indicates that demand for more online content coupled with creation of more user-friendly technological tools would allow for greater user control over and manipulation of information content); Michael Walker, *Computer Software That Can Turn You Into a Songwriter*, N.Y. TIMES, Apr. 2, 2006, available at <http://www.nytimes.com> (author discusses ease of use of music software program that allow novices to stitch together computer-generated music samples for uploading as new songs to open content sites). See also D. W. Yang & B. M. Hoffstadt, *Countering the cyber-crime threat*, 43 AM. CRIM. L. REV. 201, 205 (2006) (authors raise concerns about more cybercrime, including online intellectual property theft, due to increased numbers of technically-savvy individuals with high-level computer and programming skills along with their greater willingness to create user-friendly tools that aid less technologically-capable people).

⁷ Several projects are underway to provide access to books and other print collections online. For example, Project Gutenberg has converted hard copy classic books and sheet music into digital formats that can be easily downloaded for free. See Project Gutenberg

which is easily searchable online, leading to both expanded access and more opportunities for creative works to be improperly exploited.⁸

Recognizing the potential for increased copyright infringement from these open content sites, the digital media industry, especially entertainment and broadcast corporations, has moved quickly to halt unauthorized uses of its copyrighted works on these sites.⁹ Taking a page from their previous successful lawsuits against downloading consumers and peer-to-peer software providers,¹⁰ several major content producers have quickly brought copyright

web site, http://www.gutenberg.org/wiki/Main_Page (last visited Mar. 23, 2007). In addition, Google is partnering with publisher and libraries to digitize their collections and place them online for public search and review. See History of Google Book Search, <http://books.google.com/googlebooks/newsviews/history.html> (last visited Mar. 25, 2007). Similarly, the Sheet Music Consortium is seeking to digitize a wide range of sheet music housed in libraries for public access. See Sheet Music Collections, <http://library.duke.edu/music/sheetmusic/collections.html> (last visited Mar. 25, 2007).

⁸ See *infra* notes 98-112 and accompanying text.

⁹ Matthew Belloni, *Video-Sharing Site Settles With Universal Music*, THE HOLLYWOOD REPORTER, ESQ., Feb. 12, 2007, available at <http://www.allbusiness.com/services/legal-services/4468199-1.html> (last visited Feb. 27, 2007); Martyn Williams, *YouTube Tackles Copyright*, PC WORLD, Feb. 2, 2007, available at <http://www.pcworld.com> (last visited Feb. 22, 2007); Joshua Chaffin, *Universal, MySpace set for landmark battle*, FIN. TIMES, Dec. 4, 2006, available at <http://www.ft.com/cms/s/f2fcd922-83c7-11db-9e95-0000779e2340.html> (last visited Feb. 27, 2007); Michael Liedtke, *Google video suit could signal YouTube trouble ahead*, USA TODAY, Nov. 8, 2006, available at http://www.usatoday.com/tech/news/2006-11-08-google-sued_x.htm; Antone Gonsalves, *Analyst Firm Predicts YouTube is "Goin' Down,"* INFORMATIONWEEK, Oct. 3, 2006, available at <http://www.informationweek.com>; Alex Veiga, *Morris: YouTube, MySpace Abuse Copyright*, Sept. 15, 2006, available at http://www.redorbit.com/news/technology/657691/morris_youtube_myspace_abuse_copyri ght/index.html (last visited Feb. 27, 2007).

¹⁰ For example, the Recording Industry of America filed more than 350 civil lawsuits and garnered more than 1,500 subpoenas against consumers who illegally downloaded or shared online copyrighted materials with others. National Institute of Justice, U.S. Dep't of Justice, Document No. 208135, *Intellectual property and white-collar crime: Report of issues, trends, and problems for future research* (2004), available at <http://www.ncjrs.gov/pdffiles1/nij/grants/208135.pdf> (last visited Aug. 31, 2006). Although some questioned the long-term benefits of suing one's own customers, (*Id.* at 21) illegal downloading fell dramatically in the U.S. from 29 percent (about 35 million web users) in 2002 to 14 percent (about 18 million web users) in 2003 in the wake of these lawsuits and the creation of legal downloading sites, such as iTunes. Memorandum from the Pew Internet and American Life Project and ComScore Media Metrix, *The impact of recording industry suits against music file swappers*, 1, 3 (Jan. 2004), available at http://www.pewinternet.org/pdfs/PIP_File_Swapping_Memo_0104.pdf. In addition, those individuals still involved in illegal downloading indicated that the lawsuits resulted in their doing less illegal file-sharing. *Id.* at 1. Similarly, the Motion Picture Association of

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actions against YouTube, My Space, and other open content sites over copyrighted materials posted on these sites by their users.¹¹ To stave off further copyright legal actions, YouTube and MySpace were forced to remove infringing material and are implementing filtering technology to prevent copyrighted materials from being illegally uploaded to their sites.¹² Industry

America contends that to combat digital piracy it has brought numerous copyright infringement actions against illegal file-sharing of films and television programs and has promoted the use of legal downloading services. Motion Picture Association of America, *Internet Piracy* (undated), http://www.mpa.org/piracy_internet.asp (last visited Oct. 5, 2006). See 2005 U.S. Piracy Fact Sheet from the Motion Picture Association of America (2005), <http://www.mpa.org/USpiracyfactsheet.pdf> (last visited October 5, 2006)[hereinafter MPAA 2005 Fact Sheet](discusses legal consequences and law enforcement efforts against movie piracy and promotes use of legitimate movie downloading sites). In addition, the entertainment industry was successful in bringing civil actions grounded in contributory and/or vicarious liability against web sites that provided peer-to-peer software used in illegal downloading. See, e.g., *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005) (Supreme Court determined that peer-to-peer file-sharing sites may be liable for contributory and/or vicarious copyright infringement for providing peer-to-peer software programs to direct infringers); *In Re Aimster Copyright Litigation*, 334 F.3d 643 (7th Cir. 2003), *cert. den.* 540 U.S. 1107 (2004)(affirming grant of injunction against peer-to-peer service on grounds of contributory infringement); *A & M Records v. Napster*, 284 F.3d 1091 (9th Cir. 2002) (affirming district court preliminary injunction and shut down order against Napster under contributory and vicarious copyright liability). See also MPAA 2005 Fact Sheet, *supra* (discussing *Grokster* decision as showing P2P software companies violated federal copyright laws). Furthermore, the entertainment and software industries have actively worked with law enforcement to undertake both domestic and global law enforcement efforts under the criminal provisions of the copyright laws. See MPAA 2005 Fact Sheet, *supra*; Recording Industry Association of America, *What the RIAA is doing about piracy* (2003), available at <http://www.riaa.com/issues/piracy/riaa.asp> (last visited Dec. 22, 2006).

¹¹ Belloni, *supra* note 9; Williams, *supra* note 9; Liedtke, *supra* note 9; Gonsalves, *supra* note 9; Veiga, *supra* note 9. Most recently, Viacom sued YouTube for \$1 billion in damages, claiming that the site allowed users to post 160,000 copyrighted Viacom video clips which, in turn, were viewed more than 1.5 billion times. Frank Ahrens, *Viacom Sues YouTube Over Copyright*, WASH. POST, Mar. 14, 2007, at D02, available at <http://www.washingtonpost.com/wp-dyn/content/article/2007/03/13/AR2007031300595.html>.

¹² Belloni, *supra* note 9; Liedtke, *supra* note 9. While some experts had warned that YouTube could be crushed under the weight of copyright violations as had befallen the original Napster, the site has moved quickly to remove thousands of user-posted files at the request of copyright holders and to make licensing deals with key music and video content providers. Gonsalves, *supra* note 9. Recently, YouTube completed licensing deals with such music, film, and broadcast producers as Sony Music BMG, Warner Music Group, CBS, NBC, and the Sundance Channel to legally show their copyrighted video clips on the site. See Liedtke, *supra* note 9; YouTube.com Press Room,

media giants have also begun to acquire these open content sites to leverage their popularity with the industry's desire to maintain control over copyrighted content.¹³

While the digital media industry demands greater protection and enforcement of the rights of copyright holders, another set of internationally-recognized intellectual property rights for creative works, known as moral rights, remain largely unprotected under U.S. law.¹⁴ Moral rights grant the individual creator of a work the legal authority to control its use and attribution under certain circumstances that is independent of economic rights embedded in copyright.¹⁵ Already receiving little protection compared to copyright, moral rights are also at risk in this environment of dramatically increased digital manipulation and exploitation of creative works. The Berne

http://www.youtube.com/press_room (last visited Feb. 27, 2007) (varied press releases announcing different licensing agreements between YouTube and content providers). Another video sharing site, Bolt.com, settled its multi-million dollar copyright infringement case with Universal Music Group by allowing itself to be acquired by GoFish and transferring about \$30 million in stock to pay for pending and future copyright lawsuits. Belloni, *supra* note 9.

¹³ See Marc Gunther, *News Corp. (hearts) MySpace*, FORTUNE, Mar. 29, 2006, available at http://money.cnn.com/2006/03/28/technology/pluggedin_fortune/index.htm; Liedtke, *supra* note 9. Despite pending copyright actions, in March 2006, media mogul Rupert Murdoch's News Corp. acquired MySpace for \$580 million, buying into one of the premier networking sites on the Internet. Many experts saw the purchase as a bargain considering its web popularity and the potential for News Corp. to garner extensive marketing data on a key demographic group for future market research and advertising opportunities. Gunther, *supra*. Subsequently, in October 2006, Google acquired YouTube for \$1.65 billion, and has set aside millions for potential damages for current and future copyright lawsuits. Liedtke, *supra* note 9.

¹⁴ See *infra* notes 15-21 and accompanying text.

¹⁵ Moral rights have received extensive discussion in scholarly legal journals, although on different topics than the thesis presented here. See, e.g., Monica E. Antezana, *The European Union Internet Copyright Directive as Even More than It Envisions: Toward a Super-EU Harmonization of Copyright Policy and Theory*, 26 B.C. INT'L & COMP. L. REV. 415, 431-34 (2003); Gregory M. Duhl, *Old Lyrics, Knock-Off Videos, and Copycat Comic Books: The Fourth Fair Use Factor in U.S. Copyright Law*, 54 SYRACUSE L. REV. 665, 705-06 (2004); Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 2-3 (1985); Linda J. Lacey, *Of Bread and Roses and Copyrights*, 1989 DUKE L.J. 1532, 1538-44 (1989); Susan P. Liemer, *Understanding Artists' Moral Rights: A Primer*, 7 B.U. PUB. INT. L.J. 41 (1998); Robert J. Sherman, Note, *The Visual Artists Rights Act of 1990: American Artists Burned Again*, 17 CARDOZO L. REV. 373, 379-80, 388-89 (1995); Jonathan Stuart Pink, *Moral Rights: A Copyright Conflict Between the United States and Canada*, 1 SW. J. L. & TRADE AM. 171, 192 (1994). See *infra* notes 39-55 and accompanying text.

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Convention,¹⁶ WIPO's Performances and Phonograms Treaty ("WPPT"),¹⁷ and Universal Declaration of Human Rights¹⁸ call for member nations, including the United States, to protect moral rights. Moral rights vest in the individual who actually created the work,¹⁹ and these rights are separate and distinct from the economic rights embodied in copyright ownership.²⁰

Although anxious to halt others who might exploit its copyrighted materials, the industry has been largely unwilling to address its own exploitation of the moral rights of creative people,²¹ the original creators of the copyrighted works for which they seek expanded copyright safeguards.

In part, the industry's silence arises from pure economic interest, since it wants to avoid the limitations that moral rights might impose on its use of licensed or copyrighted creative content.²² The only federal law to explicitly

¹⁶ Berne Convention for the Protection of Literary and Artistic Works art. 6bis, Sept. 9, 1886, *revised at Brussels*, June 26, 1948, 123 L.N.T.S. 233. *See infra* notes 55 & 78 and accompanying text.

¹⁷ World Intellectual Property Organization Performances and Phonograms Treaty, Dec. 20 1996, S. Treaty Doc. No. 105-17, 36 ILM 76 (1997).

¹⁸ G.A. Res. 217IIIA (1948), *available at* <http://www.unhcr.ch/udhr/lang/eng.htm> (last visited June 14, 2006). Article 27 (2) states that, "[e]veryone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author." *Id.* The U.S. voted in favor of this U.N. declaration passed in 1948. *Id.* *See Sherman, supra* note 15, at 383.

¹⁹ *See infra* notes 78-79 and accompanying text.

²⁰ *See infra* notes 39-49 and accompanying text. Under the Berne Convention and the WPPT, the rights of attribution and integrity must be recognized and protected for a broad range of creative works. *See infra* notes 39-63 and accompanying text.

²¹ *See* K.J. Greene, *Copyright, Culture & Black Music: A Legacy of Unequal Protection*, 21 HASTINGS COMM. & ENT. L.J. 339, 340 (1999) (author asserts racial bias under copyright law that penalizes African-American rap artists for digital sampling, but rewards white musicians for their appropriation of African-American music through compulsory licensing provisions); Neela Kartha, Comment, *Digital Sampling and Copyright Law in a Social Context: No More Color-Blindness!!*, 14 U. MIAMI ENT. & SPORTS L. REV. 218, 224 (1997) (author argues that discrimination against African-Americans has persistently deprived such music of needed copyright protections); Sherman, *supra* note 15, at 398, 400-01 (author contends that media and entertainment industries have successfully lobbied Congress to pass copyright laws that maximize their economic dominance over less powerful creative people).

²² Moral rights critics raise concerns that the protection of such rights will hurt economic interests in creative works, producing a "chilling effect" on private investment, and thereby lessening the quality and quantity of creative works in the marketplace. Robert C. Bird & Lucille M. Ponte, *Protecting Moral Rights in the United States and the United Kingdom: Challenges and Opportunities under the U.K.'s New Performances Regulations*, 24 B.U. INT'L L. J. 213, 248 (2006); Carl H. Settlemyer III, *Between Thought and Possession: Artists' "Moral Rights" and Public Access to Creative Works*, 81 GEO. L. J. 2291, 2309-10

address moral rights, the Visual Artists Rights Act (“VARA”),²³ does not address musical works and expressly excludes content distributed by the digital media industry, such as books, electronic publications, films, and other audiovisual works from its protections.²⁴ But it also derives from Congress’s persistent failure to enact statutory law that will fully address national obligations to respect and defend moral rights in creative works under international intellectual property agreements,²⁵ while continuing to protect primarily the copyright interests of lucrative and powerful digital media interests.²⁶

Seemingly stymied about how to address creative rights not framed in the economic terms of infringement, Congress need only look to its own treatment of trademarks to help discover a potential approach to moral rights. Claiming the need to comply with international treaty obligations, Congress enacted the Federal Trademark Dilution Act (“FTDA”),²⁷ which recognizes that harm can result even when no infringement is present through trademark dilution²⁸ by blurring²⁹ and/or tarnishment,³⁰ in 1995. After the passage of the FTDA, many

(1993) (citing Robert A. Gorman, *Federal Moral Rights Legislation: The Need for Causation*, 14 NOVA L. REV. 421, 423-24 (1990)). See *supra* notes 9-13 and accompanying text.

²³ 17 U.S.C. § 106A (2006). For helpful summaries of VARA’s main provisions, see generally Susan P. Liemer, *How We Lost Our Moral Rights and the Door Closed on Non-Economic Values in Copyright*, 5 J. MARSHALL REV. INTELL. PROP. L. 1, 25 (2005); Sherman, *supra* note 15, at 407-23.

²⁴ See *infra* note 68 and accompanying text.

²⁵ Prior to the passage of VARA, moral rights bills were proposed but never passed in Congress every year, starting in 1979. Christopher J. Robinson, Note, *The “Recognized Stature” Standard in the Visual Artists Rights Act*, 68 FORDHAM L. REV. 1935, 1941 n.36 (2000) (citing H.R. Rep. No. 101-514, at 8 (1990), reprinted in 1990 U.S.C.C.A.N. 6915, 6918 n.13). The limited moral rights provisions of VARA were passed only after being added in to an unrelated bill providing for new federal judge positions. *Id.* at 1935.

²⁶ See *supra* notes 9-13 and accompanying text.

²⁷ 15 U.S.C. §§1125 (c), 1127 (2000). It was asserted that the FTDA was passed in order to comply with the mandates of the Trade Related Aspects of Intellectual Property Rights (TRIPS) agreement, but some legal experts have challenged that claim. Keola R. Whittaker, *Trademark Dilution in a Global Age*, 27 U. PA. J. INT’L. ECON. L. 907, 910-11, 920-21 (2006). See *infra* notes 251-67 and accompanying text.

²⁸ *Id.* at §1127. See H. R. Rep. No. 104-374, at 3-4 (1995) (indicating need to protect trademarks from dilution as distinguished from infringement), available at <http://thomas.loc.gov/cgi-bin/cpquery/T?&report=hr374&dbname=104> (last visited Mar. 6, 2007) [hereinafter House Dilution Report]. See *infra* notes 233-55 and accompanying text.

²⁹ See *infra* notes 240-43 & 306-09 and accompanying text.

³⁰ See *infra* notes 244-50 & 310 and accompanying text.

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in academic circles strongly criticized trademark dilution as further proprietizing language and suppressing speech, particularly in regard to noncommercial parodies.³¹ Ten years later, however, Congress passed the Trademark Dilution Revision Act (“TDRA”), updating and revising dilution standards in a manner that better balances trademark economic interests with free speech concerns.³²

Recognizing the controversy surrounding the development of trademark dilution, this article proposes the adoption of a new concept of copyright dilution to protect the moral rights of attribution and integrity which have long been ignored but are now further imperiled in this emerging digital open content environment.³³ This article first provides an overview of moral rights and the adoption of moral rights protections for attribution and integrity in a

³¹ See e.g., Keith Aoki, *Authors, Inventors and Trademark Owners: Private Intellectual Property and the Public Domain Part II*, 18 COLUM-VLA J.L. & ARTS 191, 245-48 (1994) (asserts that trademark dilution suppresses parodies and criticisms of powerful corporate entities); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L. J. 1687, 1696-97, 1710-13 (1999) (raises concerns about suppressing speech that may include reference or citation of trademark); Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus that the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 VA. J. L. & TECH. 3, ¶¶ 3-6, 24-31 (2005) (contends that FTDA will chill free speech as to parodies and increase corporate censorship). Although critical of trademark dilution, Prof. Lemley does indicate that “[m]any economists and lawyers in the past fifty years have challenged the ‘monopoly phobia’” often associated with dilution and start from “the presumption that brand names and advertising perform useful social functions and contribute to the economy.” Lemley, *supra*, at 1691.

³² Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730. See *infra* notes 305-17 and accompanying text.

³³ See *infra* notes 330-87 and accompanying text. Although not supportive of the concept and application of copyright dilution, Prof. Bohannon has previously discussed and rejected the notion of copyright dilution to protect image or distinctiveness of the copyrighted work. Christina Bohannon, *Copyright Harm, Foreseeability, and Fair Use*, 85 WASH. U. L. REV. 969, 974, 1022 (2007). She contended that some courts have impliedly used a copyright dilution analysis in handling copyright infringement cases without appropriate statutory authority or demonstrable economic harm to the copyright holder. *Id.* at 974, 1022-27. Prof. Bohannon questioned court determinations in several cases that did not fully consider whether the disputed works achieved market substitution and actual economic harm in finding for the copyright holders. *Id.* at 1022-27. However, a closer examination of these cases suggests that although issues of good will and distinctiveness were raised in these cases, these judicial determinations were often based on findings that the works also failed to meet the mandates of fair use as regards legitimate parodies or transformative uses under copyright infringement and trademark infringement and dilution. This article will propose a change in statutory law along with a continued application of copyright fair use provisions and precedents in copyright dilution disputes. See *infra* notes 378-83 and accompanying text.

host of civil and common law nations.³⁴ The article then examines the concept of trademark dilution, reviewing applicable state anti-dilution laws and precedent before the enactment of the FTDA³⁵ as well as examining the statutory language of the FTDA and TDRA and subsequent judicial interpretation of both statutes.³⁶ Drawn from this review of historical precedent and federal and state statutes, the article advances a proposed theory of copyright dilution that will help safeguard the moral rights of attribution and integrity through copyright blurring and copyright tarnishment, respectively, where there has been copying (or sampling) in part or whole from an earlier creative work.³⁷ The article concludes by exploring reasonable limitations on the use of copyright dilution to address the economic and policy concerns that have consistently blocked the broader protection of moral rights in the U.S.³⁸

II. MORAL RIGHTS: ISSUES OF ATTRIBUTION AND INTEGRITY IN A DIGITAL AGE

The concept of moral rights doctrine is founded on the notion that all creative people possess certain civil or human rights to their creative works.³⁹ These moral rights go beyond the mere protection of economic rights, typically found under U.S. copyright laws.⁴⁰ The moral rights doctrine considers moral rights as separate and untethered from economic rights protected under copyright laws.⁴¹ A creative individual may transfer her economic rights to

³⁴ See *infra* notes 39-60 and accompanying text.

³⁵ See *infra* notes 224-55 and accompanying text.

³⁶ See *infra* notes 256-317 and accompanying text.

³⁷ See *infra* notes 330-87 and accompanying text.

³⁸ See *infra* notes 363-84 and accompanying text.

³⁹ Antezana, *supra* note 15, at 421-22; Duhl, *supra* note 15, at 705-06; Kwall, *supra* note 15, at 2-3; Pink, *supra* note 15, at 192; Sherman, *supra* note 15, at 379-80, 388-89. See Calvin D. Peeler, *From the Providence of Kings to Copyrighted Things (and French Moral Rights)*, 9 IND. INT'L & COMP. L. REV. 423, 448 (1999); Brandon G. Williams, Note, *James Brown v. IN-FRIN-JR: How Moral Rights Can Steal the Groove*, 17 ARIZ. J. INT'L & COMP. L. 651, 657-58 (2000). See generally Lacey, *supra* note 15, at 1548-51; Liemer, *supra* note 15 (providing useful review of main components of moral rights); Betsy Rosenblatt, *Moral Rights Basics*, March 1998, available at <http://cyber.law.harvard.edu/property/library/moralprimer.html> (offering basic review of moral rights in U.S. context).

⁴⁰ Antezana, *supra* note 15, at 421-22; Duhl, *supra* note 15, at 705-06; Lacey, *supra* note 15, at 1541-42, 1548-49; Ilhyung Lee, *Toward an American Moral Rights in Copyright*, 58 WASH. & LEE L. REV. 795, 800-01 (2001); Peeler, *supra* note 39, at 448; Pink, *supra* note 15, at 192-93; Sherman, *supra* note 15, at 379, 388-89.

⁴¹ Duhl, *supra* note 15, at 706; Kwall, *supra* note 15, at 2-3; Lacey, *supra* note 15, at 1548-49; Liemer, *supra* note 15, at 44; Peeler, *supra* note 39, at 442; Williams, *supra* note

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third parties under copyright, but will still retain moral rights over the creative work.⁴² Therefore, a creative individual can retain a certain level of continuing control over her creations.⁴³

Under moral rights doctrine,⁴⁴ a creative work is not just a commodity in the commercial marketplace, but a direct reflection of a creative individual's personality or identity, sometimes referred to as an expression of an individual's "creative soul."⁴⁵ Moral rights are fundamental human or civil rights that arise out of the personhood of the creative person with the creative

39, at 657.

⁴² Duhl, *supra* note 15, at 706; Kwall, *supra* note 15, at 2-3; Lacey, *supra* note 15, at 1548-49; Liemer, *supra* note 15, at 44; Peeler, *supra* note 39, at 442; Williams, *supra* note 39, at 657.

⁴³ Lacey, *supra* note 15, at 1548-49; Liemer, *supra* note 15, at 44-45. *See also* Kwall, *supra* note 15, at 2-3, 37.

⁴⁴ Moral rights theory was founded upon the works of Immanuel Kant and Georg Wilhelm Friedrich Hegel. Duhl, *supra* note 15, at 705; Lacey, *supra* note 15, at 1541-42; Chris Johnstone, *Underground Appeal: A Sample of the Chronic Questions In Copyright Law Pertaining to the Transformative Use of Digital Music in a Civil Society*, 77 S. CAL. L. REV. 397, 431 (2004). Both philosophers considered private property rights as the "embodiment of personality" (Lacey, *supra* note 15, at 1541) with private property rights as most valuable if they encourage self-expression and human development. Duhl, *supra* note 15, at 705; *see* Johnstone, *supra*, at 431. Hegel explicitly formulated the dualistic approach to intellectual property as made up of both moral and economic rights. Lacey, *supra* note 15, at 1541-42; Peeler, *supra* note 39, at 425, 448.

⁴⁵ Antezana, *supra* note 15, at 422; Duhl, *supra* note 15, at 706; Lee, *supra* note 40, at 801; Liemer, *supra* note 15, at 43; Williams, *supra* note 39, at 657; Geri J. Yonover, *Artistic Parody: The Precarious Balance: Moral Rights, Parody, and Fair Use*, 14 CARDOZO ARTS & ENT. L. J. 79, n. 35 (1996). *See also* Neil Netanel, *Copyright Alienability Restrictions and the Enhancement of Author Autonomy: A Normative Evaluation*, 24 RUTGERS L.J. 347, 402-03 (1993). Under the principle of moral rights, Professor Liemer illuminates the personal nature of the creative process as follows:

The unique relationship between an artist, the creative process, and the resultant art makes an artist unusually vulnerable to certain personal harms. The art an artist produces is, in a sense, an extension of herself. The artists' connection to her art is much more personal and simply qualitatively different from the relationship of most other people to other objects and activities.

When an artist creates, she produces something that allows others a glimpse into her individual human consciousness. The medium may be clay or choreography, the message may be silly or serious, but the mental process is surprisingly similar. The artist allows herself to take a very personal risk, opening up something of her view of the world to others and showing others what is going on in her head, whether emotional, intellectual, or spiritual. That view is available for others to experience, over and over again, potentially forever.

Liemer, *supra* note 15, at 43.

work as a personal manifestation of the individual's creative energy or soul.⁴⁶ Therefore, a creative individual can never be completely distinct from her creative works,⁴⁷ regardless of whether or not she retains the copyright to her creations.⁴⁸ Traditionally, only natural persons, rather than corporations or institutions, may hold moral rights to creative works.⁴⁹

Notions of moral rights have existed for centuries, including ancient Greek⁵⁰ and Roman⁵¹ societies. In contemporary times, moral rights protection had been most widely-embraced initially in civil law nations,⁵² such as France, Germany, Italy, and Spain, that broadly define creative works⁵³ and provide

⁴⁶ Benjamin Davidson, *Lost in Translation: Distinguishing between French and Anglo-American Natural Rights in Literary Property, and how Dastar Proves that the Difference Still Matters*, 38 CORNELL INT'L L. J. 583, 585-86 (2005). See also Daniel J. Gervais, *The Internationalization of Intellectual Property: New Challenges from the Very Old and the Very New*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 929, 934 (2002); Liemer, *supra* note 15, at 42-43. See *supra* notes 15-21 and accompanying text.

⁴⁷ Antezana, *supra* note 15, at 421; Duhl, *supra* note 15, at 706; Lacey, *supra* note 15, at 1548-49; Liemer, *supra* note 15, at 43.

⁴⁸ Kwall, *supra* note 15, at 2-3, 37; Lacey, *supra* note 15, at 1548-49; Liemer, *supra* note 15, at 44-45.

⁴⁹ Antezana, *supra* note 15, at 421; Pink, *supra* note 15, at 183, 187.

⁵⁰ See Michael W. Carroll, *Whose Ownership Is It Anyway?: How We Came to View Musical Expression as a Form of Property*, 72 U. CIN. L. REV. 1405, 1419-33 (2004); Liemer, *supra* note 23, at 25-26. The right of attribution applied to the written works of Greek playwrights, poets, and philosophers. Carroll, *supra*, at 1427-28. However, the right of attribution did not encompass music, which was thought to be from the divine and a force of nature. Carroll, *supra*, at 1427-28.

⁵¹ See Cheryl Swack, *Safeguarding Artistic Creation and the Cultural Heritage: A Comparison of Droit Moral Between France and the United States*, 22 COLUM.-VLA J.L. & ARTS 361, 366 (1998). For example, it violated Roman law for someone to steal another creative person's right to be recognized as the creator of her own work. Swack, *supra*, at 366.

⁵² Antezana, *supra* note 15, at 421-22; Duhl, *supra* note 15, at 705-06; Kwall, *supra* note 15, at 2-3; Pink, *supra* note 15, at 192; Sherman, *supra* note 15, at 379-80, 388-89. See Peeler, *supra* note 39, at 448. See generally Lacey, *supra* note 15, at 1548-51; Liemer, *supra* note 23, at 26; Rosenblatt, *supra* note 39.

⁵³ In these nations, creative individuals are accorded the highest levels of moral rights protections. Bird & Ponte, *supra* note 22, at 226; Kwall, *supra* note 15, at 11-12. Undisputedly, France provides the broadest protection of moral rights, including the rights of right of disclosure, retraction, attribution, integrity, and resale royalties as well as protections against misattribution, excessive criticism, and attacks on the creator's personality. Bird & Ponte, *supra* note 22, at 227; Kwall, *supra* note 15, at 12; Lee, *supra* note 40, at 803-04; Liemer, *supra* note 15, at 46, n. 30; Liemer, *supra* note 23, at 7-8; Swack, *supra* note 51, at 511 & n.24; Patrick G. Zabatta, *Moral Rights And Musical Works: Are Composers Getting Berned?*, 43 SYRACUSE L. REV. 1095, 1104 (1992).

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post-mortem rights for the creative person's heirs⁵⁴ in accordance with the terms of the Berne Convention.⁵⁵ Recently, many common law nations, that had previously relied solely upon the economic rights protection under copyright,⁵⁶ have adopted moral rights protections, including the United Kingdom,⁵⁷ Canada,⁵⁸ Australia,⁵⁹ and New Zealand.⁶⁰ Although a signatory to both the WPPT and the Berne Convention⁶¹ as well as one of the largest exporters of creative works,⁶² the U.S. offers very limited moral rights

⁵⁴ Bird & Ponte, *supra* note 22, at 259; Kwall, *supra* note 15, at 15. For example, French copyright law explicitly states that moral rights "may be transmitted mortis causa to the heirs of the author. Exercise may be conferred on another person under the provisions of a will." C. PROP. INTELL., ch. I art. L121-1. In addition, Germany and the Netherlands permit moral rights safeguards to end after the creator's death, simultaneously terminating moral rights with the expiration of economic rights under copyright. Kwall, *supra* note 15, at 15.

⁵⁵ The Berne Convention calls upon signatory nations to protect moral rights at least as long as that nation's protection of economic rights, or at a minimum, until the death of the creator of the artistic work. Article 6bis, §2.

⁵⁶ Pink, *supra* note 15, at 192. See Duhl, *supra* note 15, at 705-06; Sherman, *supra* note 15, at 380, 389; Williams, *supra* note 39, at 656-57. See generally Carroll, *supra* note 50 (reviews historical evolution of music as property right protected under copyright).

⁵⁷ Bird & Ponte, *supra* note 22, at 238-42; Jennifer B. Pfeffer, *The Costs and Legal Impracticalities Facing Implementation of the European Union's Droit de Suite Directive in the United Kingdom*, 24 NW. J. INT'L L. & BUS. 533, 552 (2004); Gerald Dworkin, *The Moral Right of the Author: Moral Rights and the Common Law Countries*, 19 COLUM.-VLA J.L. & ARTS 229, 246 (1995) (citing Copyright, Designs and Patents Act of 1988, c. 48, §§ 77-89, 94-95).

⁵⁸ Canadian Copyright Act, c. 10 R.S.C. 14(1-2) (4th Supp. 1985), available at <http://laws.justice.gc.ca/en/C-42/230491.html>. See CANADIAN INTELLECTUAL PROPERTY OFFICE, A GUIDE TO COPYRIGHTS: COPYRIGHT PROTECTION (2005), available at http://strategis.ic.gc.ca/sc_mrksv/cipo/cp/copy_gd_protect-e.html#12 [hereinafter CIPO GUIDE]. See Pink, *supra* note 15, at 183, 187; CASLON ANALYTICS, NOTE – MORAL RIGHTS CASES, CANADA (May 2006), available at <http://www.caslon.com.au/mrcasesnote4.htm>.

⁵⁹ COPYRIGHT AMENDMENT (MORAL RIGHTS) ACT 2000, No. 159, pt. IX, available at <http://scaleplus.law.gov.au/html/comact/10/6273/top.htm>. See CASLON ANALYTICS, INTELLECTUAL PROPERTY GUIDE – AUSTRALIA (May 2006), available at <http://www.caslon.com.au/ipguide17.htm>; CASLON ANALYTICS, *supra* note 58. Similar to the U.S., the broadcast and media industries were strongly opposed to the passage of moral rights in Australia. CASLON ANALYTICS-AUSTRALIA, *supra*.

⁶⁰ Copyright Act, 1994, § 94 (N.Z.), available at http://www.legislation.govt.nz/browse_vw.asp?content-set=pal_statutes.

⁶¹ It is interesting to note that even countries that are not signatories to the Berne Convention offer moral rights safeguards, including Bangladesh, Colombia, Ecuador, El Salvador, Haiti, and Panama. Kwall, *supra* note 15, at 12, n. 42.

⁶² Antezana, *supra* note 15, at 426, 434; Alexander Caviedes, *International Copyright Law: Should the European Union Dictate Its Development?*, 16 B.U. INT'L L. J. 165, 173

safeguards⁶³ under VARA. ⁶⁴ VARA applies only to certain visual fine arts, granting limited protection for moral rights and exhibiting a minimal effort to

(1998); Sherman, *supra* note 15, at 398-99.

⁶³ In enacting the Berne Convention, Congress explicitly exempted the U.S. from honoring the rights of attribution and integrity, opting for a minimalist approach to the Convention. See Antezana, *supra* note 15, at 426-27; Brandi L. Holland, *Moral Rights Protection in the United States and the Effect of the Family Entertainment and Copyright Act of 2005 on U.S. International Obligations*, 39 VAND. J. TRANSNAT'L L. 217, 231(2006); Zabatta, *supra* note 53, at 1106. The subsequent passage of VARA exhibited a continuing limited approach to protecting moral rights. Eric B. Hiatt, *The "Dirt" On Digital "Sanitizing": Droit Moral, Artistic Integrity and The Directors Guild of America v. Cleanflicks Et Al.*, 30 RUTGERS COMPUTER & TECH. L.J. 375, 395-96 (2004); Holland, *supra*, at 230. See *infra* notes 160-65 and accompanying text. Ms. Holland states that,

The driving force behind the U.S. copyright law, however, is a utilitarian motivation. The United States grants artists' rights to advance the public welfare by providing incentive for creativity and innovation. . . .Due to the explicit utilitarian view of the U.S. Constitution, the U.S. view on copyright protection derives from economics. Furthermore, the United States does not value an artist's creative work by its contribution to society or its overall social utility. Perceived value directly relates to the price that the public is willing to pay for the work. Thus, the United States does not protect moral rights as an artist's natural right; rather, artists' rights, which the United States protects, are for the benefit of the U.S. economy. The United States has been reluctant to recognize a true moral right. In fact, where the United States has enacted pieces of the moral right, they have significantly limited its definition. (footnotes omitted)

Id. at 230.

⁶⁴ 17 U.S.C. §106(a) (2006). As to moral rights protection, VARA indicates that 106A. Rights of certain authors to attribution and integrity

(a) Rights of attribution and integrity. Subject to section 107 [17 U.S.C. § 107] and independent of the exclusive rights provided in section 106 [17 U.S.C. § 106], the author of a work of visual art—

(1) shall have the right—

(A) to claim authorship of that work, and

(B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create;

(2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and

(3) subject to the limitations set forth in section 113(d) [17 U.S.C. § 113(d)], shall have the right—

(A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and

(B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.

See *supra* notes 23-24 and accompanying text.

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comply with the Berne Convention.⁶⁵ The Act covers only the visual fine arts, such as paintings, drawings, prints, still photographs, and sculptures, that meet certain rigid statutory requirements.⁶⁶ VARA explicitly excludes any “motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication. . .” and “any work made for hire.”⁶⁷ VARA preempted existing state laws⁶⁸ that often offered more comprehensive protections of creative works,⁶⁹ including post-mortem rights for heirs.⁷⁰

⁶⁵ Hiatt, *supra* note 63, at 234-35. Congress contended that VARA was not necessary to comply with the Berne Convention, but merely brought, “U.S. law into greater harmony with laws of other Berne countries.” H.R.Rep. No. 514, 101st Cong., 2d Sess. 15, at 7-8, 10 (1990). Representative Robert Kastenmeier, then Chairman of the House Judiciary Subcommittee on Courts, Intellectual Property, and the Administration of Justice, commented that, “[w]hile this title is not necessary for this country’s adherence to the Berne Convention, . . . it certainly strengthens our commitment to that convention.” 136 Cong.Rec. H13313 (daily ed. Oct. 27, 1990).

⁶⁶ 17 U.S.C. §101 (2006). These visual creations must either be in their original form or produced in limited, numbered, and signed editions of 200 or fewer to receive any VARA protections. *Id.* VARA defines a “work of visual art” as

(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

Id. The U.S. Copyright Office offers a Visual Arts Registry that allows visual artists to record their work for moral rights protection. Visual Arts Registry, 37 CFR §201.25 (2005). See U.S. COPYRIGHT OFFICE, LIBRARY OF CONGRESS, CIR. 40.0708, COPYRIGHT REGISTRATION OF WORKS OF VISUAL ARTS (2008), available at <http://www.copyright.gov/circs/circ40.pdf>.

⁶⁷ 17 U.S.C. § 101A-C (2006). The exclusions under VARA explicitly refer to

(A) (i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;

(ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;

(iii) any portion or part of any item described in clause (i) or (ii);

(B) any work made for hire; or

(C) any work not subject to copyright protection under this title.

Id. See Sherman, *supra* note 15, at 409-410.

⁶⁸ 17 U.S.C. § 301(f)(1) (2006). See Heide, *supra* note 5, at 233; Zabatta, *supra* note 53, at 1119.

⁶⁹ Some state laws also recognize more than the rights of attribution and integrity, such

Although these limited moral rights are far less than the protections provided in other nations,⁷¹ artists have rarely been successful in the courts under the moral rights provisions of the Act.⁷² Furthermore, surveys have shown that few artists know about VARA or its requirements.⁷³ Since music, films, and books are not covered under VARA, these industries have largely avoided moral rights obligations mandated under the Berne Convention and the WPPT. Efforts to obtain moral right protections under the Lanham Act,⁷⁴

as the right of withdrawal (*see, e.g.*, P.R. LAWS ANN. tit. 31, § 1401 (2005)) and the right of resale royalties (*see, e.g.*, CAL. CIV. CODE § 986(7)(b)(2) (2008)). Further, VARA applies only to originals while some state laws also protected reproductions of creative works. (*see, e.g.*, CAL. CIV. CODE §982(d)(3) (2008); LA. REV. STAT. ANN. § 51:2152(5) (2008); N.Y. ARTS & CULT. AFF. Law § 11.01(16) (McKinney 2008)).

⁷⁰ 17 U.S.C. § 106A(d)(2) (2006). Most earlier state laws allowed heirs to exercise the deceased artist's moral rights after death, up to 50 years after the creator's death. *See, e.g.*, CAL. CIV. CODE at §§ 987(c)(2), 987(g)(1); CONN. GEN. STAT. § 42-116s(4)(d) (2008); P.R. LAWS ANN. tit. 31, §1401(c) (2005).

⁷¹ Bird & Ponte, *supra* note 22, at 256-57; Hiatt, *supra* note 63, at 395-96; Holland, *supra* note 63, at 234-35. *See* Quality King Distributors, Inc. v. L'Anza Research Int'l, Inc., 523 U.S. 135, 149 n.21 (1998) (In dicta, Supreme Court states that VARA "is analogous to Article 6bis of the Berne Convention for the Protection of Literary and Artistic Works, but its coverage is more limited.").

⁷² Despite being in place for seventeen years, only one artist has won any monetary damages for the destruction of his work under the right of integrity (Martin v. City of Indianapolis, 4 F. Supp. 2d 808 (S.D. Ind. 1998), *aff'd* 192 F.3d 608 (7th Cir. 1999)) and only one artist has gained their right to attribution for a photographic exhibit (Grauer v. Deutsch, 01 Civ.8672, 2002 U.S. Dist. LEXIS 19233 (S.D.N.Y. Oct. 11, 2002)) under the provisions of VARA.

⁷³ Patricia Alexander, *Moral Rights in the VARA Era*, 36 ARIZ. ST. L.J. 1471, 1490-91 (2004); RayMing Chang, *Revisiting the Visual Artists Rights Act of 1990: A Follow-up Survey About Awareness and Waiver*, 13 TEX. INTELL. PROP. L.J. 129, 132 (2005); Liemer, *supra* note 23, at 6. In a congressionally-mandated 1995 survey, the U.S. Copyright Office discovered an overall lack of awareness of VARA amongst artists. Alexander, *supra*, at 1490-91; Chang, *supra*, at 132. The report found that less than 50% of the respondents were aware of VARA. Alexander, *supra*, at 1491. In a 2003 online survey that mimicked an earlier 1995 survey found only a slightly higher recognition of moral rights issues amongst artists. Chang, *supra*, at 144-45.

⁷⁴ Prior to the *Dastar* case, courts handed down inconsistent decisions on Lanham Act protections for moral rights claims, suggesting that moral rights claims do not fit neatly into the Act's provisions. *See, e.g.*, Leigh v. Warner Bros., Inc., 212 F. 3d 1210 (11th Cir. 2000) (replica of photographer's "Bird Girl" statue in film and promotional materials not actionable under moral rights or Lanham Act); Batiste v. Island Records, Inc., 179 F. 3d 217 (5th Cir. 1999) (claimed mutilation of song "Funky Soul" not actionable under Lanham Act); Halicki v. United Artists, 812 F.2d 1213 (9th Cir. 1987) (finds that film producer lacked standing and in dicta refused to apply moral rights to Lanham Act claims as in

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or under various alternative tort theories, such as defamation, unfair competition, and invasion of privacy, have been largely unsuccessful, preventing meaningful judicial analysis and protection of moral rights.⁷⁵

Gilliam); *Gilliam v. American Broadcasting Co., Inc.*, 538 F. 2d 14, 26-27 (1976) (Gurfein, J., concurring); *Boosey & Hawkes Music Publishers, Ltd. V. Walt Disney Co.*, 934 F. Supp. 119 (S.D.N.Y. 1996) (Lanham Act does not provide moral rights protection for alleged lack of proper attribution and mutilation of Stravinsky's *Rite of Spring*, a public domain musical composition, contained in *Fantasia* video release). In addressing Lanham Act protections in *Gilliam*, Judge Gurfein, in a concurring decision, indicated that the act does not protect the right of attribution or integrity. He wrote, "[s]o far as the Lanham Act is concerned, it is not a substitute for droit moral which authors in Europe enjoy. If the licensee may, by contract distort the recorded work, the Lanham Act does not come into play. . . [and] does not deal with artistic integrity." *Id.* at 27. *But see Gilliam*, 538 F. 2d at 24-25 (in dicta appeals court determined that cause of action under Lanham Act should be recognized for defendant's presentation of 'garbled' and "distorted" version of plaintiff's comedy series); *Smith v. Montoro*, 648 F. 2d 602 (9th Cir. 1981) (actor's demand for proper credit or attribution in film credits and promotional materials is actionable under Lanham Act). However in the *Dastar* case, the Supreme Court ultimately determined that Lanham Act does not apply to misattribution or uncredited copying of a creative work. *Dastar v. Twentieth Century Fox*, 539 U.S. 23, 37 (2003). *See generally* Michael Landau, *Dastar v. Twentieth Century Fox: The Need for Stronger Protection of Attribution Rights in the United States*, 61 N.Y.U. ANN. SURV. AM. L. 273 (2005) (criticizes *Dastar* case as incorrectly abolishing trademark attribution rights).

⁷⁵ Kwall, *supra* note 15, at 25-27; Liemer, *supra* note 15, at 48-49; Lacey, *supra* note 15, at 1552; Bird & Ponte, *supra* note 22, at 253-54; Sherman, *supra* note 15, at 392-93; Zabatta, *supra* note 53, at 1123-24. Professor Kwall states that,

[d]efamation and invasion of privacy doctrines are of limited utility in protecting a creator's moral rights. The personality rights safeguarded by the moral right doctrine encompass more than protection for a creator's professional reputation or relief for injured feelings. In addition, courts that invoke either defamation or privacy theories frequently adhere to technical rules and requirements that narrow the application of these doctrines in situations concerning moral rights.

Kwall, *supra* note 15, at 25-27.

In addition, Professor Sherman noted that,

[n]otwithstanding the tangential effects of selected sections of the current Copyright Act, as well as the alternative, but incomplete, legal analogues to moral rights laws, there are many examples of American artists who have had no legal recourse to prevent their work from being altered or destroyed by their owners.

Some recent and notable pre-VARA examples of the treatment of works of art as mere chattel include the destruction of a sculpture by noted artist Isamu Noguchi, the rather bizarre alteration of a Calder mobile, and the sale of individual panels of a multipanel work by James Rosenquist as separate works. In each of these cases, the artist had no legal recourse.

Sherman, *supra* note 15, at 393-94 (footnotes omitted). *See supra* notes 63-73 and accompanying text. *See generally* Zabatta, *supra* note 53, at 1111-24 (discusses lack of compliance with Berne Convention based on inadequacies of federal and state laws and

Merely amending VARA to include other creative works will only serve to saddle more artists with a seriously flawed statutory scheme and further hobble efforts for a more expansive view of moral rights.

There are numerous forms of moral rights protections,⁷⁶ but the two most important and broadly accepted rights are the right of attribution and the right of integrity, which are explicitly contained in the Berne Convention⁷⁷ and the WPPT.⁷⁸ First, the right of attribution (or paternity) provides the original

common law theories to protect rights of attribution and integrity).

⁷⁶ Aside from the main rights of attribution and integrity are the rights of disclosure (divulcation) and retraction (or withdrawal). Under the right of disclosure, the creator of the work determines when the work is complete and ready for public review. Nicole Griffin Farrell, *Frankly We Do Give a . . . Darn! Hollywood's Battle Against Unauthorized Editing of Motion Pictures: The "Cleanflicks" Case*, 2003 UTAH L. REV. 1041, 1047-48 (2003); Kwall, *supra* note 15, at 5; Lacey, *supra* note 15, at 1549; Liemer, *supra* note 15, at 52-54; Peeler, *supra* note 39, at 447; Williams, *supra* note 39, at 657. While the right of retraction concern's the creative person's right to withdraw their work from public display or sale and to refuse to make any further creative works. Karen Y. Crabbs, *The Future of Authors' and Artists' Moral Rights in America*, 26 BEVERLY HILLS B. ASS'N J. 167, 169-70 (1992); Kwall, *supra* note 15, at 6; Lacey, *supra* note 15, at 1549; Liemer, *supra* note 15, at 54-55; Williams, *supra* note 39, at 657. In addition, some states and countries recognize as a moral right for fine artists the opportunity to receive additional royalties upon the subsequent resale of their creations. Lacey, *supra* note 15, at 1552 n.101; Liemer, *supra* note 15, at 55-56; Jean-Luc Piotraut, *An Authors' Based Copyright Law: The Fairness and Morality of French and American Law Compared*, 24 CARDOZO ARTS & ENT. L.J. 549, 584 (2006).

⁷⁷ Article 6bis of the Berne Convention states that,

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

See *supra* notes 16 & 66 and accompanying text. As of July 2008, 164 nations have signed the Berne Convention. World Intellectual Property Organization, <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/berne.pdf> (last visited July 22, 2008) (listing of signatory nations on the official web site of the World Intellectual Property Organization ("WIPO")).

⁷⁸ The WPPT addresses musical works and the protection of the moral rights of musical performers such as, musicians, vocalists, and music producers. The treaty states that,

(1) Independently of a performer's economic rights, and even after the transfer of those rights, the performer shall, as regards his live aural performances or performances fixed in phonograms, have the right to claim to be identified as the performer of his performances, except where omission is dictated by the manner of the use of the performance, and to object to any distortion, mutilation or other modification of his performances that would be prejudicial to his reputation.

Id. at ch.II, art. 5(1). See World Intellectual Property Organization, Summary of World Intellectual Property Organization Performances and Phonograms Treaty (WPPT)(1996),

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individual who created the work the right to be properly credited as its creator.⁷⁹ This moral right also permits a creator to seek anonymous or pseudonymous attribution for her creative work.⁸⁰ In addition, the right of attribution includes the right of misattribution which allows a creative person to stop works from being falsely attributed to her which she did not author or create.⁸¹

It is important to recognize that the right of attribution is not merely about authorial vanity, but provides a host of individual as well as societal benefits. Primarily the right of attribution promotes an environment of self-expression, self-exploration, and creativity rewarding a creative person through recognition of and financial incentives for her individual efforts.⁸² Although pecuniary gain may play a role in some artistic endeavors, many individuals produce creative works without any compensation, but merely out of a desire for to create, to explore their inner selves or out of the personal pride of receiving credit for one's efforts.⁸³ The society also benefits because creative output results in more creative works for public consumption.⁸⁴ Similar to trademarks, attribution may also help to enhance a creator's professional reputation, influencing consumer recognition of a creative individual's brand and impacting future consumer purchasing choices based on the perceived

http://www.wipo.int/treaties/en/ip/wppt/summary_wppt.html (last visited June 16, 2006). There are currently 64 signatory nations to the WPPT. World Intellectual Property Organization, <http://www.wipo.int/treaties/en/ip/wppt/> (follow "Contracting Parties" hyperlink) (listing of signatory nations on the official web site of the WIPO) (last visited July 22, 2008). See *supra* notes 17 & 61 and accompanying text.

⁷⁹ Kwall, *supra* note 15, at 5,7, 37-38; Lacey, *supra* note 15, at 1549; Lee, *supra* note 40, at 802; Liemer, *supra* note 15, at 47-49; Peeler, *supra* note 39, at 449; Williams, *supra* note 39, at 657-58.

⁸⁰ Lee, *supra* note 40, at 802.

⁸¹ Lacey, *supra* note 15, at 1549; Lee, *supra* note 40, at 802.

⁸² Catherine L. Fisk, *Credit Where It's Due: The Law and Norms of Attribution*, 95 GEO. L.J. 49, 56 (2006); Duhl, *supra* note 15, at 705; Lacey, *supra* note 15, at 1533, 1548; Liemer, *supra* note 15, at 43-44. See *infra* note 85 and accompanying text.

⁸³ Antezana, *supra* note 15, at 421; Duhl, *supra* note 15, at 707; Fisk, *supra* note 82, at 56-57; Lacey, *supra* note 15, at 1573-74; Liemer, *supra* note 15, at 44. In ancient Greek and Roman societies, individual fame for artistry was far more valued than economic gain, which was often viewed with disdain. Carroll, *supra* note 50, at 1427-28, 1432-33; Lacey, *supra* note 15, at 1571-72, 1574. See Greene, *supra* note 21, at 357-58 (author contends that economic incentives are not key to creative process since black artists often produced creative works without economic compensation or legal protection as slaves). In the 1800s, U.S. courts also considered attribution as a key reward distinct from any economic benefits. Fisk, *supra* note 82, at 57.

⁸⁴ Holland, *supra* note 63, at 230; Settlemeyer, *supra* note 22, at 2309-10.

quality of the creator's works.⁸⁵ For example, an individual might go to see a particular film because she enjoyed the past work of the director, such as Martin Scorsese or M. Night Shyamalan, or pass on the film because of her dislike of that director's previous work.⁸⁶ The consumer can therefore more efficiently seek out creative content based upon the identity of the individual creator and her perceptions of that creator's quality of work.⁸⁷ With the increasing corporate ownership of creative works, however, "intellectual property is divorced from [its] creators,"⁸⁸ leading numerous legal scholars to propose a variety of regimes to protect the right of attribution.⁸⁹

⁸⁵ Bird & Ponte, *supra* note 22, at 281; Fisk, *supra* note 82, at 62-63; Jane C. Ginsburg, *The Author's Name as a Trademark: A Perverse Perspective on the Moral Right of "Paternity"*, 23 CARDOZO ARTS & ENT. L.J. 379, 384 (2005); Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1380, 1416, 1419-20 (2005); Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171, 1177, 1179-80 (2005). Professor Lastowka indicated that,

...[A]uthorial attribution can function much like a trademark interest. If artists seek riches, they must compete for patrons, prizes, and the favor of the public. In order to win in this competition, artists must attempt to ensure that their works are of high quality, and that prospective consumers will associate their new works with their established reputations. If artists can ensure attribution of their works, artists producing better quality will gain public goodwill and reap the benefits of their investments in producing works of higher quality. (citation omitted) This recognition and goodwill can lead to greater opportunities for employment and contractual leverage. Authorial attribution is thus a mechanism for ensuring that greater profits flow to those producing superior products.

Id. at 1177. See Heymann, *supra*, at 1380 (author indicates that author's choice of name, real or pseudonym, is ultimately "a branding choice"). See *supra* note 22 and accompanying text. See *infra* note 257 and accompanying text.

⁸⁶ See Fisk, *supra* note 82, at 62-63; Ginsburg, *supra* note 85, at 384; Heymann, *supra* note 86, at 1380, 1382-83, 1416; Lastowka, *supra* note 85, at 1179 (all three scholars discuss how attribution in literary texts serve as identifiers of individual authors and attendant quality of work to consumers).

⁸⁷ Heymann, *supra* note 85, at 1380, 1382, 1416, 1420; Lastowka, *supra* note 85, at 1177; Lemley, *supra* note 31, at 1690. See Gerard N. Magliocca, *One and Inseparable: Dilution and Infringement in Trademark Law*, 85 MINN. L. REV. 949, 957-58 (2001) (author reviews reduced customer search costs through short-hand of trademark and quality associated with such marks).

⁸⁸ Fisk, *supra* note 82, at 54-55. See also, Heymann, *supra* note 85, at 1393. See generally Fisk, *supra* note 82, at 54-60 (addresses shifts in attribution systems to external corporate ownership and internal reward systems for individual employees who created the works).

⁸⁹ See generally Fisk, *supra* note 82, at 52, 111-13 (author calls for right of attribution as implied contract term in all employment agreements); Heymann, *supra* note 85, at 1381, 1416-22, 1422-23, 1445-46 (calls for use of author's chosen identity or authornym as commercial trademark for purposes of proper attribution to protect against consumer

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Although not couched in terms of moral rights, various social or industry norms of attribution⁹⁰ have developed and may penalize those who plagiarize or fail to properly credit the creative works of others.⁹¹ For example, the film

confusion, rather than part of moral rights recognition for authors); Lastowka, *supra* note 85, at 1174, 1239-40 (author proposes amending Lanham Act to protect authorship under existing trademark law); Ginsburg, *supra* note 85, at 387-89 (author suggests legal recognition of right of attribution for both creator as well as originator who supervised development of creative work through blending of trademark and copyright law); Jane C. Ginsburg, *The Right To Claim Authorship In U.S. Copyright And Trademarks Law*, 41 HOUS. L. REV. 263, 301-07 (2004) (author recommends recognition of right of attribution through amendment of U.S. Copyright Act). *But see*, Rebecca Tushnet, *Naming Rights: Attribution and Law*, 2007 UTAH L. REV. 789, 797, 813-14 (2007) (author asserts that right of attribution cannot fit within existing legal frameworks and is better suited to enforcement as ethical obligations). In advocating for her notion of authoronym, Prof. Heymann indicates that

[W]e can recognize the concept that the values that trademark law promotes—“reduc[ing] the customer’s costs of shopping and making purchasing decisions” and “help[ing] assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product”—are equally valid goals when the “customer” shops in the marketplace of ideas. Authorship, in other words, has both copyright and trademark components, and the law should take account of both. (citations omitted)

Heymann, *supra* note 85, at 1383.

⁹⁰ Lastowka, *supra* note 85, at 1184-85; Fisk, *supra* note 82, at 51-52; Stuart P. Green, *Plagiarism, Norms, and the Limits of Theft Law: Some Observations on the Use of Criminal Sanctions in Enforcing Intellectual Property Rights*, 54 HASTINGS L.J. 167, 174-75 (2002). *See generally* Fisk, *supra* note 82, at 76-101 (discusses broad range of attribution norms found in various industries and disciplines); Green, *supra*, at 175-81 (provides historical overview of plagiarism and claims of plagiarism as obsolete in modern society). *See infra* note 91 and accompanying text.

⁹¹ Lastowka, *supra* note 85, at 1184-85; Fisk, *supra* note 82, at 84-85. Regarding the enduring importance of authorial attribution, Professor Lastowka notes the continuing social condemnation of acts of plagiarism. Lastowka, *supra* note 85, at 1184. Professor Lastowka states that

The conventional legal understanding of the term “plagiarism” is that it is not a violation of any law, but a violation of the norm of accurate authorial attribution. Even in this postmodern era, anti-plagiarism norms remain quite strong. When a public figure is charged with plagiarism, the public concern is not primarily about protecting the possessory interests of the “owner” of the stolen words. Instead, society sees itself as the victim of duplicity and is interested in passing judgment on the character of the plagiarist. Recent scandals relating to the authorship practices of Stephen Ambrose, Doris Kearns Goodwin, Laurence Tribe, and Charles Ogletree all demonstrate that the media is confident that the public wants to hear news about high-profile plagiarism. The morality play is clearly the attraction here - in most of these cases, the average citizen is unlikely to have ever read the materials that were claimed to have been plagiarized.

industry has extensive experience in dealing with formal and complex attribution obligations in its agreements with various creative guilds, such as the Writers Guild of America.⁹² Yet, even under these formal agreements, some creative individuals complain about the lack of proper credit for their contributions to a film and express concerns about issues of transparency and the role of favoritism in the administration of these systems.⁹³

The Digital Millennium Copyright Act also provides a minor form of protection for the right of attribution.⁹⁴ The Act provides civil remedies for the intentional removal or alteration without the consent of the copyright owner⁹⁵

Id. at 1184-85 (citations omitted). *See infra* notes 95-103 and accompanying text.

⁹² Fisk, *supra* note 82, at 77. In discussing screen credit in Hollywood, Professor Fiske indicates that

[e]laborate rules govern whose name will appear and whose will not, who can be listed under which job title (director, screenplay by, key grip, etc.), and the order and size of the print in which names are listed. The credit rules are the subject of negotiations between the guilds representing various workers and the production companies, but currently the administration of credit is left entirely to the guilds representing each of the forms of talent. One of the most important things that Hollywood guilds do is to administer the credit system. (citation omitted)

Id. *See* Shawn K. Judge, *Giving Credit Where Credit is Due?: The Unusual Use of Arbitration in Determining Screenwriting Credits*, 13 OHIO ST. J. ON DISP. RESOL. 221 (1997) (provides overview of screen credits arbitration process).

⁹³ Fisk, *supra* note 82, at 77-78. Within the contours of industry or workplace norms, Professor Fisk recommends an implied contract term in employment relationships to protect the individual's right of attribution, which may be waived under a fair and informed negotiation process. *Id.* at 53, 111-12. *See* David Robb, *Botched credits cost producers \$30,000 in fines*, BPI ENTERTAINMENT NEWS WIRE, Mar. 25, 1992 (discusses arbitral award for writers who received improper and diminished writing credit for their screenplay). *But see*, Kwall, *supra* note 15, at 26-27. Professor Kwall opines that contract law will not be adequate to protect moral rights. She states that

[e]ven contract law, which is the purported basis for decision in many cases concerning the integrity and paternity components of the moral right doctrine, cannot function as an adequate substitute. In addition to the limitations presented by the privity requirement and the judiciary's general reluctance to afford extensive protections for creators absent express contractual provisions, relatively unknown creators face a disparity of bargaining power that frequently results in a loss of valuable protections. (footnotes omitted)

⁹⁴ 17 U.S.C. § 1202 (2006).

⁹⁵ *Id.* at § 1202(b). The provision states that,

(b) Removal or Alteration of Copyright Management Information.— No person shall, without the authority of the copyright owner or the law—

- (1) intentionally remove or alter any copyright management information,
- (2) distribute or import for distribution copyright management information knowing that the copyright management information has been removed or altered without authority of the copyright owner or the law, or

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of any copyright management information (CMI), which is “information conveyed in connection with copies” of a protected work, such as “the name of or other identifying information about, the author of a work.”⁹⁶ Since the copyright holder is often not the creator of the work, however, the CMI may not identify the actual creator of the work.⁹⁷ In addition, the copyright owner may be willing to license creative materials without any CMI or requirement that the actual creator receive any attribution. Furthermore, in many instances, the copied or used creative work may not contain the name or identifying information of the author – so no removal or alteration of a CMI is at issue.

The ineffectiveness of the DMCA’s provision on CMI as to the moral right of attribution is illustrated in a controversy involving Bob Dylan’s failure to credit a Civil War-era poet, Henry Timrod, Muddy Waters, and a traditional slave ballad on his 2006 album, *Modern Times*.⁹⁸ Google searches of the album lyrics initially turned up the similarities to Timrod’s collected poems,⁹⁹ which can also be found online.¹⁰⁰ Dylan’s lyrics borrowed about six to ten phrases from Timrod’s poems.¹⁰¹ In addition, Dylan was further challenged for using the titles and melodies as well as some of the lyrics from two traditional songs,¹⁰² which can be found online: “Rollin’ and Tumblin’,”¹⁰³ a

(3) distribute, import for distribution, or publicly perform works, copies of works, or phonorecords, knowing that copyright management information has been removed or altered without authority of the copyright owner or the law, knowing, or, with respect to civil remedies under section 1203, having reasonable grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any right under this title.

⁹⁶ *Id.* at § 1202 (c)(2). The relevant portion of the definition for a copyright management information includes “[t]he name of, and other identifying information about, the author of a work.” *Id.*

⁹⁷ See *supra* note 88 and accompanying text.

⁹⁸ Motoko Rich, *Who’s This Guy Dylan Who’s Borrowing from Henry Timrod?*, N.Y. TIMES, Sept. 14, 2006, available at <http://www.nytimes.com/2006/09/14/arts/music/14dyla.html>; Suzanne Vega, *The Ballad of Henry Timrod*, N.Y. TIMES, Sept. 17, 2006, available at <http://www.nytimes.com/2006/09/17/opinion/17vega.html>.

⁹⁹ Rich, *supra* note 98.

¹⁰⁰ Rich, *supra* note 98. Timrod’s poems can be found online at a variety of sites. See e.g., Poems by Henry Timrod, http://www.poetry-archive.com/t/timrod_henry.html (last visited March 23, 2007); The Poems of Henry Timrod, <http://www.selfknowledge.com/htimr10.htm> (last visited March 23, 2007); The Poems of Henry Timrod by Henry Timrod, <http://www.gutenberg.org/etext/845> (last visited March 23, 2007); Poet: Henry Timrod - All poems of Henry Timrod, <http://www.poemhunter.com/henry-timrod/> (last visited March 23, 2007).

¹⁰¹ Rich, *supra* note 98

¹⁰² *Id.*

blues song often connected to Muddy Waters, and “Nettie Moore,”¹⁰⁴ a slave ballad. The liner notes to the album read only “[a]ll songs written by Bob Dylan,”¹⁰⁵ and do not credit the original creators.¹⁰⁶

The sampled poems and songs are in the public domain and are not protected under the provisions of VARA, so no copyright or federal laws had been broken.¹⁰⁷ Since the poem and slave ballad are in the public domain, there are no longer any copyright holders and therefore no copyright owners whose CMI must be respected under the DMCA.¹⁰⁸ In addition, no CMI protection attaches, because even though Muddy Waters is often associated with the earlier-cited blues song, it is unclear if he is the actual copyright holder of the work. However, some commentators question the ethics of not attributing the borrowed materials to their original creators.¹⁰⁹

The dispute may reflect a lack of sensitivity to concerns about the continuing injustices of Western cultures’ cultural appropriation of the creative works of less powerful minorities and indigenous peoples.¹¹⁰ Some others

¹⁰³ *Id.* The lyrics to this traditional blues song can also be found online at various sites. See, e.g., <http://www3.clearlight.com/~acsa/songfile/ROLLINTU.HTM> (last visited March 23, 2007); <http://www.lyricsdownload.com/muddy-waters-rollin-and-tumblin-lyrics.html> (last visited Mar. 23, 2007). See *supra* note 22 and accompanying text.

¹⁰⁴ Rich, *supra* note 98. The music and lyrics to this traditional slave love song can be found on various web sites. See, e.g., Music from 1800-1860 web site, <http://www.pdmusic.org/1800s/57gnm.txt> (last visited Jan. 14, 2009); <http://scriptorium.lib.duke.edu/sheetmusic/a/a05/a0538/a0538-2-72dpi.html> (last visited Mar. 23, 2007). See *supra* note 21 and accompanying text.

¹⁰⁵ Rich, *supra* note 98.

¹⁰⁶ *Id.*

¹⁰⁷ Rich, *supra* note 98. See *supra* notes 63-70 and accompanying text.

¹⁰⁸ See *supra* notes 94-97 and accompanying text.

¹⁰⁹ Rich, *supra* note 98; Vega, *supra* note 98. As Grammy-winner Suzanne Vega indicated in an opinion editorial on the dispute,

Is it part of the folk process to lift a few specific metaphors and phrases whole from some else’s work? I really don’t think it is. Being influenced by a text and reworking it is not the same as directly quoting, which is what he has done here. . . . These days if a sample of music is taken, you have to acknowledge the original artist. . . . Shouldn’t the same courtesy be extended to all intellectual property? In other words, is he really “a thieving little swine” as one “fan” puts it?

Vega, *supra* note 98. Similarly, Christopher Ricks, a Boston University humanities professor, indicated that there is a difference between plagiarism and allusion to earlier creative works. Rich, *supra* note 98. He indicated that “plagiarism wants you not to know the original, whereas allusion wants you to know” the original work as a way of commenting on or paying homage to the borrowed materials or tradition. *Id.* He added that “I don’t think Dylan is alluding to Timrod. I don’t think people can say that you’re meant to know its Timrod.” Rich, *supra* note 98.

¹¹⁰ See Fisk, *supra* note 82, at 55-56; Greene, *supra* note 21, at 340-41; Kartha, *supra*

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defended Dylan's actions, asserting that artists traditionally borrow from the past as part of the creative process¹¹¹ or that his actions ignited public interest in valuable, but often forgotten, creative works.¹¹² However, under the moral rights concept of attribution, Timrod, Waters, and the source of the slave ballad must receive credit for the use of their creative works.

In the music field, many musicians have brought lawsuits against other musicians and the music industry for its use of digital samples without permission.¹¹³ Typically, digital sampling involves using snippets of a song's

note 21, at 219-23, 232-34. Contextually, it is important to note that through the decades white artists have often achieved great success by appropriating the music of African-Americans. Greene, *supra* note 21, at 340-41; Kartha, *supra* note 21, at 219-23, 232-34. Professor Greene writes that,

[b]lack artists as a class consistently receive inadequate compensation, credit, and recognition for original works. . . . While it is true that the music industry has generally exploited music artists as a matter of course, (footnote omitted) it is also undeniable that African-American artists have borne an even greater level of exploitation and appropriation.

Greene, *supra* note 21, at 341. Ms. Kartha also indicates that copyright law is racially-biased because it often penalizes black rap artists for digital sampling while rewarding white appropriation of black music through compulsory licensing of cover songs allowing "white artists to shanghai the African-American songbook." Kartha, *supra* note 21, at 232.

¹¹¹ Rich, *supra* note 98; Vega, *supra* note 98. See Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L. J. 535, 569-70 (2004) (author asserts that sampling may pay tribute or serve free speech interests through social commentary). In this vein, famed artist Pablo Picasso is quoted as saying, "Bad artists copy. Great artists steal." Pablo Picasso (1881 - 1973), Spanish artist, <http://www.quotedb.com/quotes/3500> (last visited Dec. 30, 2008). See *Bridgeport Music v. Dimension Films*, 383 F. 3d 390 (6th Cir. 2004), *aff'd in part, rev'd in part*, 230 F. Supp. 2d 830 (M.D. Tenn. 2002) (appeals court determined that sampling of copyrighted song was per se infringement). In this music sampling dispute, the district court noted that

[T]he purposes of the copyright laws is to deter wholesale plagiarism of prior works. However, a balance must be struck between protecting an artist's interests, and depriving other artists of the building blocks of future works. Since the advent of Western music, musicians have freely borrowed themes and ideas from other musicians.

230 F. Supp. 2d at 842.

¹¹² Rich, *supra* note 98; Vega, *supra* note 98. See Randy S. Kravis, Comment, *Does A Song By Any Other Name Still Sound As Sweet?: Digital Sampling and Its Copyright Implications*, 43 AM. U.L. REV. 231, 258-59 (1993) (author argues that music sampling helps publicize and revive interest in older, often overlooked music).

¹¹³ Ben Challis, *The Song Remains the Same: A Review of the Legalities of Music Sampling*, THE MUSIC JOURNAL, Dec. 2003, available at <http://www.musiclawupdates.com/articles/ARTICLE%2003thesongremainsthesame.htm> (last visited Jan. 19, 2005); Ronald Gaither, *The Chillin' Effect of Section 506: The Battle over Digital Sampling in Rap Music*, 3 VAND. J. ENT. L. & PRAC. 195, 204-05 (2001); A.

melody and/or lyrics and incorporating them into a new song.¹¹⁴ In many digital sampling cases, a subsequent artist may often digitally alter the tone, pitch, or tempo of an earlier song,¹¹⁵ making it difficult in some instances for the original artist to recognize the appropriation of her creative works.¹¹⁶ The altered digital sample can easily be put into a new song without properly crediting the original artist.¹¹⁷ Those musical artists who own their copyrights

Dean Johnson, *Music Copyrights: The Need for an Appropriate Fair Use Analysis in Digital Sampling Infringement Suits*, 21 Fla. St. U. L. Rev. 135, 163 (1993); Susan J. Latham, Article, *Newton v. Diamond: Measuring the Legitimacy of Unauthorized Compositional Sampling - A Clue Illuminated and Obscured*, 26 HASTINGS COMM. & ENT. L.J. 119, 123 (2003); Lucille M. Ponte, *The Emperor Has No Clothes: How Digital Sampling Infringement Cases Are Exposing Weaknesses in Traditional Copyright Law and the Need for Substantive Statutory Reform*, 43 AM. BUS. L. J. 515, 518-19 (2006); Robert M. Szymanski, *Audio Pastiche: Digital Sampling, Intermediate Copying, Fair Use*, 3 UCLA ENT. L. REV. 271, 291-92 (1996).

¹¹⁴ Unlike analog systems, musical artists, engineers, and producers have virtually unlimited access digitized music and sounds which can be altered or manipulated through Musical Instrument Digital Interface (MIDI) synthesizers. David S. Blessing, *Who Speaks Latin Anymore? Translating De Minimis Use for Application to Music Copyright Infringement and Sampling*, 45 WM. & MARY L. REV. 2399, 2403-04 (2004); Kartha, *supra* note 21, at 224; Latham, *supra* note 113, at 123; Szymanski, *supra* note 113, at 278-81 (1996).

¹¹⁵ Blessing, *supra* note 114, at 2402 (2004); Rebecca Morris, Note, *When Is A CD Factory Not Like A Dance Hall?: The Difficulty Of Establishing Third-Party Liability For Infringing Digital Music Samples*, 18 CARDOZO ARTS & ENT. L. J. 257, 262-64 (2000); Ponte, *supra* note 113, at 516. *See generally* Blessing, *supra* note 114, at 2403-04 (reviews digital recording, computer sound analysis and alteration, and playback in digital sampling process); Gaither, *supra* note 113, at 198-99 (summarizes three main phases of standard digital sampling process).

¹¹⁶ Brett I. Kaplicer, *Rap Music and De Minimis Copying: Applying the Ringold and Sandoval Approach to Digital Samples*, 18 CARDOZO ARTS & ENT. L. J. 227, 237 (2000); Szymanski, *supra* note 113, at 300.

¹¹⁷ Kartha, *supra* note 21, at 232-34; Szymanski, *supra* note 113, at 287-88. Digital sampling has been “often criticized for making pop music increasingly redundant, for putting musicians out of work, and for enabling ‘no-talents to steal the creative work and sounds of their betters’.” Szymanski, *supra* note 113, at 288. It is recognized that

[i]n the nascent stages of sampling, as artists were feeding off samples of the distinctive sounds of prior works, the prevalent attitude was “catch me if you can” and many hip-hop recordings were being released without any attempt to license either the sound recording or the musical composition from which the sample was derived.

Latham, *supra* note 113, at 123. *See* Renee Graham, *Will ruling on samples chill rap?*, BOSTON GLOBE, Sep. 14, 2004, at 1-2, available at http://www.boston.com/ae/music/articles/2004/09/14/will_ruling_on_samples_chill_rap/ (discusses rap music industry’s early lax approach to seeking permissions for digital sampling of others’ music).

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had had some success vindicating their economic rights in these disputes,¹¹⁸ while those who do not own the copyright have little legal protection. With music software that allows both experienced musicians and non-musicians to manipulate music samples, violations of moral rights to attribution in musical works will likely increase in the coming years.¹¹⁹ Those musical artists who do not own their copyright may find themselves increasingly unable to adequately protect their moral right of attribution.¹²⁰

Furthermore, a creative person may also wish to avoid misattribution for works of others. Without referring to moral rights, three Ninth Circuit decisions illustrate the tension that exists between copyright protection and the concerns of musical artists about misattribution, specifically the use of imitations of their voices for commercial purposes. In dealing with this issue, the Ninth Circuit has taken different views on whether a singer's voice is protected under California tort law. In *Sinatra v. The Goodyear Tire & Rubber Co.*,¹²¹ singer Nancy Sinatra challenged the use of a song "These Boots Are Made For Walkin'" with singers who mimicked her "mod" clothing and her voice for the tire commercial. Sinatra, who had popularized the song, argued that the song and the arrangement had acquired "a secondary meaning" and the imitation had deceived the public into believing she had participated in the ad, analogous to the notion of misattribution.¹²² In that case, the Ninth Circuit rejected Sinatra's tort and unfair competition claims stating that her action against imitation of her performance was preempted by copyright law. Since the defendants had licensed the right to use the song from the copyright holder, the court held that her state actions were impliedly preempted by federal law and that her performance, both voice and fashion, were not copyrightable under federal law.¹²³

¹¹⁸ See, e.g., *Bridgeport Music, Inc. v. Dimension Films*, 383 F. 3d 390 (6th Cir. 2004), *aff'd in part, rev'd in part*, 230 F. Supp. 2d 830 (M.D. Tenn. 2002) (digital sampling of three notes from *Get Off Your Ass and Jam* sound recording is *per se* infringement); *Grand Upright Music, Ltd. v. Warner Bros. Records*, 780 F. Supp. 182 (S.D.N.Y. 1991) (rapper's sampling of three words and portion of music from Gilbert O'Sullivan's song *Alone Again (Naturally)* *per se* infringement worthy of possible criminal infringement charges); *Jarvis v. A&M Records*, 827 F. Supp. 282, 292 (D. N.J. 1993) (court determined that copying of music was not de minimis use).

¹¹⁹ "Many in the music industry contend that digital sampling is an 'indispensable' part of production process." Szymanski, *supra* note 113, at 278. See *supra* notes 5-8 and accompanying text.

¹²⁰ See *infra* notes 197-201 and accompanying text.

¹²¹ 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

¹²² *Id.* at 717-18. It is interesting to note that Young & Rubicam were involved in both the disputed Sinatra and Midler campaigns. See *infra* notes 128-31 and accompanying text.

¹²³ *Id.*

Subsequently, the Ninth Circuit addressed the misappropriation of the distinctive voices of two other famed singers, Bette Midler¹²⁴ and Tom Waits,¹²⁵ under California's common law tort. Like Sinatra's earlier dispute, these well-known singers alleged that their voices were imitated by others in commercials without their consent - selling cars in the *Midler* case¹²⁶ and snack food in *Waits* case.¹²⁷ In the *Midler* case, Ford had properly licensed the song, "Do You Want To Dance" from its copyright holder, just as had the defendant in *Sinatra*.¹²⁸ Similarly, Midler believed that the public was being deceived about her participation in the ad.¹²⁹ However, the court reached a different result, concluding that Midler's distinctive voice was protected under the tort of misappropriation.¹³⁰ Distinguishing *Sinatra*, the *Midler* court indicated that Sinatra's unfair competition was based on the use of the copyrighted song, rather than misappropriation of her voice, which foiled her claim.¹³¹

In *Waits*, the court once again considered an ad agency's imitation of his voice for a commercial selling SalsaRio Doritos.¹³² Although the defendants had not violated copyright, Waits song, "Step Right Up," inspired the wordplay in the ad.¹³³ Unlike Sinatra and Midler, Waits has maintained a very public stance that musical artists compromise their artistic integrity by featuring their music in commercials.¹³⁴ Similar to Sinatra and Midler, he also

¹²⁴ *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513 (1992).

¹²⁵ *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

¹²⁶ *Midler*, 849 F.2d at 461.

¹²⁷ *Waits*, 978 F.2d at 1097.

¹²⁸ *Midler*, 849 F.2d at 462.

¹²⁹ *Id.* at 461-62.

¹³⁰ *Id.* at 463. In the ground-breaking case, the court stated that,

A voice is as distinctive and personal as a face. The human voice is one of the most palpable ways identity is manifested. We are all aware that a friend is at once known by a few words on the phone. At a philosophical level it has been observed that with the sound of a voice, "the other stands before me." (citation omitted) A fortiori, these observations hold true of singing, especially singing by a singer of renown. The singer manifests herself in the song. To impersonate her voice is to pirate her identity.

Id.

¹³¹ *Id.* at 462-63.

¹³² *Waits*, 978 F.2d at 1097-98.

¹³³ *Id.* at 1097.

¹³⁴ *Id.* The court stated that,

Tom Waits does not, however, do commercials. He has maintained this policy consistently during the past ten years, rejecting numerous lucrative offers to endorse major products. Moreover, Waits' policy is a public one: in magazine, radio, and newspaper interviews he has expressed his philosophy that musical artists should not

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believed the public was being deceived about his participation in the commercial, akin to the notion of misattribution.¹³⁵ The court, once again, echoed the assertion made in *Midler* that a distinctive voice of a famed singer can be protected under California common law tort of misappropriation.¹³⁶

While on the surface these decisions seem to contradict the *Sinatra* decision, both the *Midler* and *Waits* courts contended that the plaintiffs' actions were not preempted by federal copyright laws since voices are not protected under copyright.¹³⁷ The *Waits* court stated that it allowed recovery "for infringement of voice, not for infringement of a copyrightable subject such as sound recording or musical composition."¹³⁸ These courts warned that if the disputes involved subject matter already protected under the copyright laws, then the singers' actions would have been preempted.¹³⁹ However, under a moral rights regime, all three artists could have sought protection under the right of integrity.

The *Midler* and *Waits* decisions also made clear that the courts protected these voices because they were perceived as famous and distinctive.¹⁴⁰ It is unlikely that the courts would protect the voices of lesser known singers from appropriation,¹⁴¹ again raising concerns about the continuing exploitation of

do commercials because it detracts from their artistic integrity.

Id.

¹³⁵ The court further indicated that *Waits* was entitled to damages for mental distress because the company's actions contradicted *Waits* public stance. *Id.* at 1103. The court noted that,

Waits testified that when he heard the Doritos commercial, "this corn chip sermon," he was shocked and very angry. These feelings "grew and grew over a period of a couple of days" because of his strong public opposition to doing commercials. *Waits* testified, "It embarrassed me. I had to call all my friends, that if they hear this thing, please be informed this is not me. I was on the phone for days. I also had people calling me saying, Gee, Tom, I heard the new Doritos ad." Added to this evidence of *Waits*' shock, anger, and embarrassment is the strong inference that, because of his outspoken public stance against doing commercial endorsements, the Doritos commercial humiliated *Waits* by making him an apparent hypocrite. This evidence was sufficient both to allow the jury to consider mental distress damages and to support their eventual award.

Id. See *infra* notes 192-96 and accompanying text.

¹³⁶ *Id.* at 1099-1100.

¹³⁷ *Waits*, 978 F.2d at 1100; *Midler*, 849 F.2d at 462.

¹³⁸ *Waits*, 978 F.2d at 1100. See *infra* notes 197-201 and accompanying text.

¹³⁹ *Waits*, 978 F.2d at 1100; *Midler*, 849 F.2d at 462.

¹⁴⁰ *Waits*, 978 F.2d at 1100; *Midler*, 849 F.2d at 463.

¹⁴¹ The *Midler* court specifically indicated that

We need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers

less powerful or marginalized artists as discussed previously.¹⁴²

The second main moral right of integrity permits a creative person to block the alteration, distortion or destruction of her creative work.¹⁴³ This moral right also allows the creator to halt any presentation of the work in a derogatory manner contrary to the creator's artistic intentions.¹⁴⁴ In addition, the right of integrity allows a creative person to prevent excessive criticism of her creative works or other unwarranted attacks on her personality¹⁴⁵ made "solely for the purpose of vexation."¹⁴⁶ The right protects the artist against criticism whose sole purpose is to mistreat the author or creator of the work.¹⁴⁷ Therefore, the right of integrity may involve two basic types of claims: (1) physical distortion claims based upon damage to or distortion of the original work¹⁴⁸ or (2) contextual claims arising from use of the original or distorted work in a negative or harmful circumstance.¹⁴⁹ In both instances, the artist may also suffer harm because the new use damages her reputation or holds her up to personal ridicule.

In April 2006, the estate of Spanish surrealist painter Joan Miró objected to Google's copying of Miro's style on its home page in an attempt to honor him on his birthday.¹⁵⁰ The family's representative indicated that the purported tribute violated Miró's copyright and moral rights. Google denied any violation of Miró's rights, but removed the Miró-like elements from its logo.¹⁵¹ The dispute raises both physical alteration and contextual concerns. The

have appropriated what is not theirs and have committed a tort in California.

Midler, 849 F.2d at 463.

¹⁴² See *supra* note 21 and accompanying text. It may also be important to note that famous celebrities may have the public exposure and funds to bring these actions.

¹⁴³ Kwall, *supra* note 15, at 5, 8-9, 38-39; Lacey, *supra* note 15, at 1549; Lee, *supra* note 40, at 802; Liemer, *supra* note 15, at 50-52; Peeler, *supra* note 39, at 448-49; Williams, *supra* note 39, at 658.

¹⁴⁴ Kwall, *supra* note 15, at 5, 8-9, 38-39; Lacey, *supra* note 15, at 1549; Lee, *supra* note 40, at 802; Liemer, *supra* note 15, at 50-52; Peeler, *supra* note 39, at 448-49; Williams, *supra* note 39, at 658.

¹⁴⁵ Crabbs, *supra* note 76, at 170; Kwall, *supra* note 15, at 7. Some non-U.S. jurisdictions recognize a right against excessive criticism, but do not prevent reasonable criticisms of the work, regardless of its severity. Kwall, *supra* note 15, at 7 n.25.

¹⁴⁶ Crabbs, *supra* note 76, at 170; Kwall, *supra* note 15, at 7.

¹⁴⁷ Crabbs, *supra* note 76, at 170.

¹⁴⁸ See *infra* notes 151-91 and accompanying text.

¹⁴⁹ See *infra* notes 192-223 and accompanying text.

¹⁵⁰ CASLON ANALYTICS, *supra* note 58.

¹⁵¹ *Id.* A family spokesperson indicated that the family members "were upset about it. . . A lot of problems could have been alleviated if Google had informed the family first. But I'm not saying the family would have agreed to it." *Id.*

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artistic style of Miró's distinctive work was altered or distorted to fit Google's logo. Also, the use of his artistry on Google's search page evokes contextual concerns linking his fame and artistic sensibilities to modern commercialism and an affiliation with Google's services without permission.

Within an increasingly digital environment, the music and film industries are often involved in disputes dealing with the actual physical alteration of creative works under the right of integrity.¹⁵² In the film industry, recent efforts at colorizing classic black-and-white films¹⁵³ or sanitizing and distributing contemporary color films to delete or blur out graphic language, violence, and sexuality¹⁵⁴ may result in right of integrity claims based on physical alteration of films.

In 1988, the heirs of director John Huston tried to stop Turner Broadcast from colorizing their deceased father's 1948 film, *The Asphalt Jungle*.¹⁵⁵ Mr. Huston had been a vocal critic of colorizing films during his lifetime.¹⁵⁶ MGM-Loews, not Huston, however, held the copyright to the film under the prevailing studio system.¹⁵⁷ Unable to bring an action under U.S. copyright law, the Huston family undertook a lengthy legal battle in the French courts to block colorization of the film for broadcast in France under the right of integrity.¹⁵⁸ The Huston heirs were initially successful at the French trial court

¹⁵² See *infra* notes 153-213 and accompanying text.

¹⁵³ Heide, *supra* note 5, at 245, n. 198; Yonover, *supra* note 45, at 89-90; Williams, *supra* note 39, at 660; Zabatta, *supra* note 53, at 1104-05. Although the family could not bring a copyright action in the U.S., the family was successful in their moral rights action in the French court which blocked the broadcast of the colorized film, fining both Turner Entertainment and Le Cinq, the French broadcast station. CASLON ANALYTICS, MORAL RIGHTS CASES, COLORIZATIONS AND CIRCUSES (May 2006), available at <http://www.caslson.com.au/mrcasesnote2.htm>; Yonover, *supra* note 45, at 90. The decision was affirmed in 1994. Heide, *supra* note 5, at 245, n. 198; Yonover, *supra* note 45, at 90.

¹⁵⁴ See Sarah Gansheimer, *The Family Entertainment and Copyright Act and Its Consequences and Implications for the Movie-Editing Industry*, 8 TUL. J. TECH. & INTELL. PROP. 173, 179-80 (2006); Hazel Malcolmson, *Copyright Infringement in the Digital Age: The Issue of Unfixed Works*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 297, 337-38 (2006); Hiatt, *supra* note 63, at 395-96. See *infra* notes 164-69 and accompanying text.

¹⁵⁵ See CASLON ANALYTICS, *supra* note 148; Heide, *supra* note 5, at 245, n. 198; Yonover, *supra* note 45, at 89-90; Williams, *supra* note 39, at 660-61; Zabatta, *supra* note 53, at 1104-05.

¹⁵⁶ See CASLON ANALYTICS, *supra* note 153. The director had allegedly been "distracted" after viewing a colorized version of his film; Williams, *supra* note 39, at 660.

¹⁵⁷ Holland, *supra* note 63, at 242; Natalie C. Suhl, *Moral Rights Protection in the United States Under the Berne Convention: A Fictional Work?* 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1203, 1226-27 (2002); Zabatta, *supra* note 53, at 1104, n. 62.

¹⁵⁸ Heide, *supra* note 5, at 245, n. 198; Yonover, *supra* note 45, at 90. See generally Bird & Ponte, *supra* note 22, at 227-61 (offers comparison of traditional and contemporary moral

under the right of integrity.¹⁵⁹ Yet a French appeals court later overturned the lower court, indicating that colorized copies did not harm the right of integrity since the original copy of the film had not been colorized.¹⁶⁰ Ultimately, the Supreme Court of France overruled the appellate court, deeming the colorization of Huston's film as violative of his moral right of integrity as one of its creators.¹⁶¹ On remand, the French trial court blocked the television broadcast of the duplicate colorized version¹⁶² as well as fined Turner Entertainment and Le Cinq, the French TV station that planned to air the colorized film.¹⁶³

Recently, in *Clean Flicks of Colo., LLC v. Soderbergh*,¹⁶⁴ major motion picture studios, prodded by the Directors Guild of America, won injunctive relief against video sanitizing services that distributed altered DVD versions of contemporary films.¹⁶⁵ In earlier proceedings, the directors compelled the studios to join the lawsuit since the studios, and not the directors, owned the copyrights to these films.¹⁶⁶ The editing services purchased DVDs and then used digital editing devices primarily to remove or obscure any objectionable language, violence, and sexuality.¹⁶⁷ The editing businesses claimed fair use in their alteration of the films since they purchased and edited the films on a one-for-one basis.¹⁶⁸

The court rejected the fair use claim finding that the altered versions of the

rights in France, the U.S., and the U.K.).

¹⁵⁹ Heide, *supra* note 5, at 245, n. 198; Yonover, *supra* note 45, at 90.

¹⁶⁰ Heide, *supra* note 5, at 245, n. 198; Yonover, *supra* note 45, at 90.

¹⁶¹ See CASLON ANALYTICS, *supra* note 153; Heide, *supra* note 5, at 245 n.198; Suhl, *supra* note 157, at 1227; Yonover, *supra* note 45, at 90; Zabatta, *supra* note 53, at 1104-05.

¹⁶² CASLON ANALYTICS, *supra* note 153.

¹⁶³ CASLON ANALYTICS, *supra* note 153; Yonover, *supra* note 45, at 90. Turner Broadcast was ordered to pay \$74,000 in fines while Le Cinq was ordered to pay \$37,000. CASLON ANALYTICS, *supra* note 153; Yonover, *supra* note 45, at 89. On appeal, this decision was affirmed in 1994. CASLON ANALYTICS, *supra* note 153.

¹⁶⁴ 433 F. Supp. 2d 1236 (D. Colo. 2006).

¹⁶⁵ *Id.* at 1243-44.

¹⁶⁶ Gansheimer, *supra* note 154, at 179; Hiatt, *supra* note 63, at 380. See *supra* notes 155-63 and accompanying text.

¹⁶⁷ 433 F. Supp. 2d at 1238-39. Although directors have long been upset about the sue of new digital technologies to alter their films, movie studios were apprehensive about challenging these services out of concern about drawing unwanted attention and perhaps further censorship of graphic movie content. Hiatt, *supra* note 63, at 380-81. See generally Gansheimer, *supra* note 154, at 175-78 (discussing various forms of editing technologies used by video sanitizing services).

¹⁶⁸ *Id.* at 1239.

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films were not “transformative” of the original works.¹⁶⁹ The court also turned aside the studios’ claims that edited versions of films created more sales for the studios. In language echoing moral rights doctrine, the court expressly recognized “the intrinsic value of the right to control the content of the copyrighted work” and that merely making the movies more palatable for a wider audience “is more than merely a matter of marketing; it is a question of what audience the copyright owner wants to reach.”¹⁷⁰ In addition, the Court indicated that the passage of the Family Movie Act (FMA) of 2005¹⁷¹ permitted the sale of in-home editing devices that did not create permanent fixed versions of DVDs, but prohibited the creation of edited DVDs for rental or resale.¹⁷² The court enjoined further editing or distribution of the altered DVDs.¹⁷³ However, if the Studios had permitted the distorted copies to be made, directors who did not own their copyrights would not be able to challenge the distorted works. Under the right of integrity, the directors would have been permitted to challenge the physical distortion of fixed versions of their original creative works.

In the musical context, U.S. copyright law provides a back-handed application of the right of integrity under its compulsory licensing provisions for music.¹⁷⁴ Under the compulsory licensing provision, a third party may obtain a required license from a copyright owner to sing, perform, or record an

¹⁶⁹ *Id.* at 1241-42.

¹⁷⁰ *Id.* at 1242.

¹⁷¹ Pub. L. No. 109-9, 119 Stat. 218, 223-24 (2005) (codified in 17 U.S.C. § 110(11) (2006)). The FMA was one aspect of the Family Entertainment and Copyright Act (“FECA”) (Pub. L. No. 109-9, 119 Stat. 218 (codified as amended at various sections of titles 17 and 18 of the U.S. Code) that addressed various copyright concerns in light of emerging digital technologies. *See* Gansheimer, *supra* note 154, at 174-75. *See generally* Alison R. Watkins, *Surgical Safe Harbors: The Family Movie Act and the Future of Fair Use Legislation*, 21 BERKELEY TECH. L.J. 241, 250-57 (2006) (provides detailed discussion of FMA); Gansheimer, *supra* note 154, at 183-187 (discusses main defenses available to editing services after FECA).

¹⁷² 433 F. Supp. 2d at 1240.

¹⁷³ *Id.* at 1243-44.

¹⁷⁴ 17 U.S.C. §115 (2006). This type of licensing is often referred to as a “mechanical license.” Kenneth M. Achenbach, *Grey Area: How Recent Developments in Digital Music Production Have Necessitated the Reexamination of Compulsory Licensing for Sample-Based Works*, 6 N.C. J. L. & TECH. 187, 207-08 (2004); Johnstone, *supra* note 44, at 425. Under this 1909 provision, Congress sought to avoid a monopoly in the distribution of music between the Aeolian Company, a maker of player piano rolls, and national music publishers through exclusive dealings contracts and to promote healthy industry competition for musical works. Achenbach, *supra* note 170, at 207-08; Kravis, *supra* note 107, 272 (1993).

original musical composition as a “cover song.”¹⁷⁵ The copyright owner must provide the license as long as the cover song performance or recording does “not change the basic melody or fundamental character of the” original song.¹⁷⁶ This provision suggests an implicit right of integrity,¹⁷⁷ but it is not an accurate reflection of moral rights doctrine for two reasons. First, the copyright owner is often not the actual creator of the music and therefore the actual creator may not be giving consent to the use.¹⁷⁸ Secondly, the individual artist, even if she holds the copyright, loses all discretion and control over the musical work when required to license it to a third party.¹⁷⁹

Claims of distortion of one’s music are readily found in digital sampling disputes with artists achieving some success outside of the U.S., including the United Kingdom.¹⁸⁰ For example, country blues musician Marc Cohn sued Shut Up and Dance Records in the British courts under the moral right of integrity, not copyright, when the company sampled the melody from his hit song, *Walking in Memphis*. The record company had placed the sample into hip-hop song, *Raving, I’m Raving*.¹⁸¹ The court determined that the digital sample violated Cohn’s right of integrity because the record company had

¹⁷⁵ 17 U.S.C. § 115 (a) (1) (2006). See Kwall, *supra* note 15, at 38-39; Zabatta, *supra* note 53, at 1114-15.

¹⁷⁶ 17 U.S.C. §115 (a) (2) (2006). This section reads,

A compulsory license includes the privilege of making a musical arrangement of the work to the extent necessary to conform it to the style or manner of interpretation of the performance involved, but the arrangement shall not change the basic melody or fundamental character of the work, and shall not be subject to protection as a derivative work under this title, except with the express consent of the copyright owner.

Id.

¹⁷⁷ Johnstone, *supra* note 44, at 431; Szymanski, *supra* note 113, at 296. See generally Rajan Desai, *Music Licensing, Performance Rights Societies, and Moral Rights for Music: A Need in the Current U.S. Music Licensing Scheme and a Way to Provide Moral Rights*, 10 U. BALT. INTEL. PROP. L.J. 1, 6, 11, 20 (2001) (author calls for extension of moral rights protections to musical performances in U.S.).

¹⁷⁸ Fisk, *supra* note 82, at 54-55. See *supra* notes 22 & 88 and accompanying text. See *infra* note 180 and accompanying text.

¹⁷⁹ See Greene, *supra* note 21, at 369-70; Kartha, *supra* note 21, at 225 (both authors contend that copyright law is racially-biased by permitting white appropriation of innovative black music, such as rap and jazz, through compulsory licensing of cover songs). See *supra* notes 21, 39-60 and accompanying text.

¹⁸⁰ See generally Bird & Ponte, *supra* note 22, at 234-46 (reviewing UK statute and cases on moral rights in music disputes).

¹⁸¹ ZEROGeS – Copyright Information, <http://www.zero-g.co.uk/index.cfm?articleid=39> (last visited Oct. 19, 2006); Everyhit.com, *Record-Breakers and Trivia*, <http://www.everyhit.com/record6.html> (last visited Oct. 19, 2006).

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altered his music without his permission.¹⁸² The court ordered the company to halt production and distribution of any additional copies of the song and mandated that the profits be donated to charity.¹⁸³

Similarly, in *Morrison Leahy Music Ltd. v. Lightbond Ltd.*,¹⁸⁴ musical artist George Michael and others pursued an injunction against the defendant record company, Lightbond Ltd., over its production and distribution of a “medley” that included digital samples from five songs Michael had authored.¹⁸⁵ Lightbond had obtained a license the songs.¹⁸⁶ Although Michael did not own the copyright to the music,¹⁸⁷ he brought an action under his right of integrity for the remix in accordance with U.K. copyright law.¹⁸⁸ In granting the injunction, the court concluded that under the licensing agreement Michael had retained his moral rights to the songs and a remix of his music was not permitted.¹⁸⁹ The court further held that there was a triable issue of fact as to whether the defendant’s sampling of Michael’s music might rise to a distortion or mutilation under the moral rights provisions of U.K. copyright laws.¹⁹⁰

Instances of moral rights concerns about contextual issues that may harm the musical artist’s reputation are also well recognized outside the U.S. For example, in 2006, Tom Waits once more won a landmark case in the Spanish courts for copyright infringement and violation of Waits’s moral right of integrity.¹⁹¹ As indicated previously, Waits has consistently vowed to his fans that his songs would not be used for advertising purposes.¹⁹² He rejected requests from Volkswagen-Audi to use his song, *Innocent When You Dream*, in one of the company’s commercials. However, the advertising firm used “the same melodic structure” and musical arrangement of the original song as well as featuring “a Tom Waits’ vocal impersonation.”¹⁹³ Waits learned from

¹⁸² ZEROGcs - Copyright Information, *supra* note 182.

¹⁸³ *Id.*

¹⁸⁴ *Morrison Leahy Music Ltd. v. Lightbond Ltd.*, [1993] ENT. & MEDIA L.REP. 144 (Ch.) (Eng.).

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 150.

¹⁸⁷ Morrison Leahy owned the copyright to the songs. *Id.* at 145-146, 149.

¹⁸⁸ *Id.* at 148.

¹⁸⁹ *Id.*

¹⁹⁰ *Id.* at 151.

¹⁹¹ *Tom Waits Wins Landmark Spanish Legal Judgment*, PR NEWSWIRE, Jan. 19, 2006, available at <http://www.prnewswire.com/cgi-bin/stories.pl?ACCT=109&STORY=/www/story/01-19-2006/0004263323&EDATE>. He also filed a similar moral rights claim in the German courts based on moral rights for the use of a vocal impersonation of his voice in car commercials that were shown in Sweden, Finland, Denmark and Norway. *Id.*

¹⁹² *Id.* See *supra* notes 134-35 and accompanying text.

¹⁹³ *Id.*

fans about the commercial shown in Spain, with many of his fans believing that he had abandoned his promise not to use his music in this manner.¹⁹⁴

The Barcelona appeals court determined that the production company and Volkswagen-Audi were liable not only for copyright infringement, but also for violations of Waits' right of integrity for adapting his music and vocal stylings in the commercial. Viewing his voice as a creative work, the Spanish court protected Waits' "personality and reputation" as well as his copyright. The court granted damages of 30,000 Euros for Waits' moral rights claim and 36,000 Euros for Waits and his music publisher's copyright infringement claims.¹⁹⁵

Conversely, in the U.S., musicians who do not hold the copyright to their music have been largely unsuccessful in actions for distortion or mutilation of their creative work through sampling. In *Laws v. Sony Music Entertainment, Inc.*,¹⁹⁶ the plaintiff brought an action claiming misappropriation of her voice and name based on the digital sampling of her recording, "Very Special," into the song "All I Have" by Jennifer Lopez and L.L. Cool J.¹⁹⁷ The sound recording sampled in the song had been licensed from the copyright holder, Elektra Records.¹⁹⁸ Distinguishing *Midler* and *Waits*, the Ninth Circuit determined that Laws's misappropriation claim was preempted by copyright law because sound recordings, unlike voices, are protected under copyright law.¹⁹⁹ Since the sample was the copyrighted recording of Laws's actual voice, rather than an imitation of her voice, her action was preempted by copyright law since her voice was contained within a copyrighted medium.²⁰⁰

In *Newton v. Diamond*,²⁰¹ James Newton, a renowned jazz flutist and Guggenheim fellow,²⁰² challenged the sampling of three notes from his

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

¹⁹⁶ 448 F.3d 1134 (9th Cir. 2006).

¹⁹⁷ *Id.* at 1135-36. The court noted that "[t]he song and Lopez's album, 'This is Me . . . Then,' became a huge commercial success, netting over forty-million dollars. At one time 'All I Have' was the number one song in the United States." *Id.* at 1136.

¹⁹⁸ *Id.* at 1136.

¹⁹⁹ *Id.* at 1140-41.

²⁰⁰ *Id.* at 1141. However, to an artist it may seem to turn logic on its head to disallow actions to protect one's actual voice, while permitting actions when others are merely copying your voice.

²⁰¹ 349 F. 3d 591, 592 (9th Cir. 2003), *aff'g* 204 F. Supp. 2d 1244, *reh'g denied*, 2004 U.S. App. LEXIS 23398, at *1190 (9th Cir. Nov. 9, 2004)(en banc). For critical assessments of this case see Latham, *supra* note 113, at 127-37; Lucille M. Ponte, *Too Few Notes? Digital Sampling and Fragmented Literal Similarity in Newton v. Diamond*, 38 BUS. L. REV. 141 (2005).

²⁰² Teresa Wiltz, *The Flute Case That Fell Apart; Ruling on Sampling Has Composers*

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musical composition, *Choir*, which had been altered in pitch and looped over forty times through the Beastie Boys' rap song, *Pass the Mic*.²⁰³ The sound recording of the sample had been properly licensed from EMC records, but Newton held the rights to the underlying musical composition.²⁰⁴ Like Laws, Newton had been properly credited in the group's liner notes.²⁰⁵ Newton filed actions claiming violations of domestic and international copyright laws as well as reverse passing-off and misappropriation of his identity under the Lanham Act.²⁰⁶ The court, however, dismissed the Lanham Act claims²⁰⁷ and found for the Beastie Boys on the copyright claims. The court determined that the digital sampling from his musical composition was *de minimis* copying and, therefore, unprotected under copyright.²⁰⁸

Newton also publicly contended that the Beastie Boys' sampling of his work raised contextual concerns, as he believed the group's music, often laced with graphic language, ran contrary to the Christian beliefs underlying the *Choir* composition.²⁰⁹ Asserting that money did not motivate his opposition to the sample's use, Newton asserted that he would not have given permission to sample his music in this rap song for any amount of money because of his Christian values.²¹⁰ Newton also claimed that he was greatly insulted that the song was used in a *Beavis and Butthead* cartoon.²¹¹ Since Newton's implicit

Rattled, WASH. POST, Aug. 22, 2002, at C01. At the time of the dispute, Newton served as a Senior Professor of Music at California State University in Los Angeles. He was also the Director of Music Programming and Research of the Luckman Fine Arts Complex and the Artistic Director and Conductor for the Luckman Jazz orchestra. See Meet the Composer, <http://www.meetthecomposer.org/newton.html> (last visited Oct. 12, 2006) (Newton's official web site).

²⁰³ *Newton*, 349 F.3d at 593-94.

²⁰⁴ *Id.* at 593. ECM Records bought Newton's rights to the sound recording for a flat \$5,000.00 fee. *Id.* at 592.

²⁰⁵ Molly Sheridan, *When Stealing Is Not a Crime: James Newton vs. the Beastie Boys*, NEWMUSICBOX.COM, July 24, 2002, available at <http://www.newmusicbox.org/news.nmbx?id=00124>.

²⁰⁶ *Newton*, 204 F. Supp. 2d at 1247.

²⁰⁷ The group successfully moved to dismiss the Lanham Act and misappropriation claims and filed for summary judgment on the copyright infringement claims. *Id.*; *Newton*, 349 F. 3d at 594.

²⁰⁸ *Id.* at 598.

²⁰⁹ Newton had stated that his composition had been inspired initially by his memories of observing four female gospel singers in a rural Arkansas church. *Newton*, 349 F.3d at 592.

²¹⁰ Sheridan, *supra* note 206. Newton is quoted as contending that, "I'm a Christian and with that name there's no way I would have [given permission]. That's totally antithetical to my beliefs. For me it goes much deeper." Sheridan, *supra* note 206.

²¹¹ Regarding the use of the sample in the irreverent cartoon show, Newton stated that, "[i]t was very shocking and surprising to know that they used the sample without giving me

moral rights concerns are not legally recognized nor protected under U.S. law, Newton could only resort to the court of public opinion to make his concerns known.²¹²

Musicians have also raised integrity claims when their music has been utilized in films in contexts that they find objectionable or disturbing.²¹³ In these situations, music and film integrity concerns may become intertwined when musicians raise contextual concerns about the selection of music to be used in films while filmmakers push for their rights to protect the contents of their films.²¹⁴ As early as 1948, Russian composer Dmitry Shostakovich and other composers sued to enjoin the use of public domain musical compositions in the Cold War film, *The Iron Curtain*.²¹⁵ Shostakovich and the other plaintiffs asserted claims of defamation and violation of their moral rights.²¹⁶ They contended that the film's use of their musical compositions as background music suggested that they approved of the film's negative portrayals of the Soviet Union and made them appear to be disloyal to their Russian homeland.²¹⁷ The court rejected the defamation counts²¹⁸ and dismissed the moral rights claims as not recognized in the U.S. and lacking an appropriate basis for judicial review.²¹⁹ Similar to the *Huston* case, the

the right of choice. . . . And when I found out that the music was used on a Beavis and Butthead cartoon I was. . . I don't know I can't even put in words how upset I was." Sheridan, *supra* note 206.

²¹² See Sheridan, *supra* note 206. On Newton's web site, he angrily responded to the court's decision and the rap group's attempt to seek attorney's fees in the case.

This decision is extremely troubling. It ignores my twenty-three years of international recognition, and my freedom of cultural expression by insisting that my work fit within a European paradigm to be protected. Beastie Boys have stolen my musical expression and now vindictively seek to punish me financially for trying to protect a work that celebrates God's place in the African-American struggle for freedom in this country.

Meet the Composer, *supra* note 203.

²¹³ Zabatta, *supra* note 53, at 1124-26.

²¹⁴ See *infra* notes 217-23 and accompanying text.

²¹⁵ *Shostakovich v. Twentieth Century-Fox Film Corp.*, 196 Misc. 67, 80 N.Y.S. 2d 575 (1948), *aff'd* 275 A.D. 692, 87 N.Y.S. 2d 430 (N.Y. App. Div. 1949). See Yonover, *supra* note 45, at 89; Williams, *supra* note 39, at 669.

²¹⁶ *Shostakovich*, 196 Misc. at 68-69, 80 N.Y.S. 2d at 577.

²¹⁷ *Shostakovich*, 196 Misc. at 69-70, 80 N.Y.S. 2d at 578.

²¹⁸ *Shostakovich*, 196 Misc. at 70; 80 N.Y.S. 2d at 578-79. The court found no libel in the use of the background music, stating that there was no showing of either explicit or implicit approval by the composers of the film's message. *Id.*

²¹⁹ *Shostakovich*, 196 Misc. at 70-71; 80 N.Y.S. 2d at 578. The U.S. court stated that,

Conceivably, under the doctrine of Moral Right the court could in a proper case, prevent the use of a composition or work, in the public domain, in such a manner as would be violative of the author's rights. The application of the doctrine presents much difficulty however. With reference to that which is in the public domain there arises a

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plaintiffs subsequently brought an action in the French courts, which permitted the seizure of the film due to “moral damage” to the composers.²²⁰

Another contemporary example involved country music composer, Carl Perkins, who was a staunch advocate for children’s rights and started a center against child abuse. Perkins was angered when director Barbra Streisand used one of his songs, “Honey Don’t,” as the background music for a child rape scene in her 1992 film, *The Prince of Tides*.²²¹ Since the right of integrity is not protected under U.S. law for music or video, Perkins could do nothing to block the action even though he believed it greatly harmed his reputation as a composer and children’s rights campaigner.²²²

In sum, it is clear that creative individuals often struggle to retain acknowledgment of and some amount of control over their creative works both to defend their reputations as well as to retain the artistic value of their work. Many artists can only vindicate their moral rights outside the U.S., despite its treaty obligations to safeguard such rights. Businesses, on the other hand, have been more successful in shaping legal protections of their trademarks that enable them to protect their business reputation and goodwill beyond the confines of infringement. Recognizing that harm can flow where there is no infringement, the evolution of trademark dilution provides important lessons that can illuminate the path to protecting moral rights for creative works through the concept of copyright dilution.

conflict between the moral right and the well established rights of others to use such works. (citation omitted) So, too, there arises the question of the norm by which the use of such work is to be tested to determine whether or not the author’s moral right as an author has been violated. Is the standard to be good taste, artistic worth, political beliefs, moral concepts or what is it to be? In the present state of our law the very existence of the right is not clear, the relative position of the rights thereunder with reference to the rights of others is not defined nor has the nature of the proper remedy been determined. Quite obviously therefore, in the absence of any clear showing of the infliction of a willful injury or of any invasion of a moral right, this court should not consider granting the drastic relief asked on either theory.

Id.

²²⁰ Soc. Le Chant de Monde v. Soc. Fox Europe et Soc. Fox Americane Twentieth Century, 1 Gazette du Palais 191 (13 Jan 1953), *aff’d*, D.A. Jur. 16, 80 Cour d’appel Paris. See Holland, *supra* note 63, at 241-42 (2006); Kwall, *supra* note 15, at 27-28; Williams, *supra* note 39, at 668-69; Yonover, *supra* note 45, at 89.

²²¹ *Id.* at 1125.

²²² *Id.* at 1125-26. At the time, Perkins was quoted as saying that “people are asking me, ‘Carl, why would you have a song in such a filthy place in a movie?’ They are shocked, especially since they all know I started a child-abuse center. I am very damaged by this and very hurt.” *Id.* at 1126, n. 212.

III. THE EVOLUTION OF TRADEMARK DILUTION THEORY

Trademark owners pour significant resources and exercise great efforts into building recognition of their trademarks and protecting the value of their brands.²²³ In some instances, a company's tangible assets may be significantly outweighed by its intangible assets, particularly trademarks and goodwill.²²⁴ Therefore, trademarks are "enormously valuable but fragile assets, susceptible to irreversible injury from promiscuous use,"²²⁵ which can be diminished over time or directly destroyed in the eyes of the consuming public in an instant.²²⁶

Trademark serves two main purposes in the marketplace: (1) as an identifier of the origin or source of the goods or services being offered and (2) as a representation of the quality or image of that brand's goods or services in the minds of consumers.²²⁷ Trademark law is aimed principally at protecting

²²³ Aoki, *supra* note 31, at 245; Joseph J. Galvano, *There Is No "Rational Basis" for Keeping It a "Secret" Anymore: Why the FTDA's "Actual Harm" Requirement Should Be Interpreted the Same Way for Dilution Caused by Blurring as It Is for Dilution Caused by Tarnishing*, 31 HOFSTRA L. REV. 1213, 1217-18 (2003); Julie Manning Magid, Anthony D. Cox, and Dena S. Cox, *Quantifying Brand Image: Empirical Evidence of Trademark Dilution*, 43 AM. BUS. L.J. 1, 7-8 (2006); Magliocca, *supra* note 87, at 960. See 2-5A GILSON ON TRADEMARKS, CH. 5A, §5A.01[1] (2007). Professor Aoki notes that,

The transformation of trademark law from a body of law sensitive to avoiding consumer confusion into a body of law focused on expanding the trademark owner's exclusive rights by protecting a mark's integrity has occurred against the rise of a sprawling electronic mass media in the late twentieth century. Rapidly developing information and communication technologies increase the media's purview while the centers of media control coalesce. During the 1980's, corporations controlling print and electronic media continued to expand their scope and concentrate their power base through mergers and diversification. . . .

In this dense information environment, advertising and the mass media's ability to transmit imagery and information is crucial to ensure the growth of consumption. Increasingly, corporations market and sell consumer goods through the extensive use and promotion of abstract symbols. Trademarked symbols become heavily imbued with economic and expressive value through extensive advertising.

Aoki, *supra* note 31, at 244-45 (footnotes omitted).

²²⁴ Magid, et al., *supra* note 224, at 7-8; Magliocca, *supra* note 87, at 960; Layne T. Smith, *Tarnishment and the FTDA: Lessening the Capacity to Identify and Distinguish*, 2004 B.Y.U. L. REV. 825, 830 (2004). For example in 2002, Coca-Cola's tangible assets were valued at \$8.8 billion, while its trademarks and brands alone were estimated to be worth about \$70 billion. Magid, et al., *supra* note 224, at 8. See Lemley, *supra* note 31, at 1706-07 (author is critical of trend that views trademarks "as valuable things that can be owned in and of themselves").

²²⁵ GILSON, *supra* note 224, at §5A.01[4][a] (quoting The United States Trademark Association Review Commission Report and Recommendations, 77 T.M.R. 375 (1978)).

²²⁶ See *infra* notes 237, 244-46 and accompanying text.

²²⁷ Galvano, *supra* note 224, at 1216-17; Lemley, *supra* note 31, at 1695; Robert S.

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consumers from confusion, deception, or mistake about the origin or source of the goods or services,²²⁸ and secondarily at preventing unfair competition between direct business competitors.²²⁹ Consumers will also benefit through improved product quality if companies can expect to garner the rewards of a positive reputation for providing quality products or services in the marketplace.²³⁰ Yet, prior to the passage of the Federal Trademark Dilution Act of 1995,²³¹ trademark law had long been criticized for failing to adequately protect marks from other unauthorized uses by non-competitors that could seriously damage the value of the marks.²³²

The evolution of trademark law came about gradually, from only protecting consumers from confusion to expanding the protection of the property interests of trademark holders. As early as 1927, Professor Frank Schechter presciently recognized the power of marks to sell goods and services and challenged the limited protection of trademarks in his ground-breaking article, *The Rational Basis of Trademark Protection*.²³³ His work expressed the contrarian view that

Nelson, *Unraveling the Trademark Rope: Tarnishment and Its Proper Place in the Laws of Unfair Competition*, 42 IDEA 133 (2002) (unpaginated); Smith, *supra* note 225, at 828. See GILSON, *supra* note 224, at §5A.01[1].

²²⁸ Lemley, *supra* note 31, at 1695; Jesse A. Hofrichter, *Tool of the Trademark: Brand Criticism and Free Speech Problems with the Trademark Dilution Revision Act of 2006*, 28 CARDOZO L. REV. 1923, 1931 (2007); Martha Kelley, *Is Liability Just a Link Away? Trademark Dilution by Tarnishment under the Federal Trademark Dilution Act of 1995 and Hyperlinks on the World Wide Web*, 9 J. INTELL. PROP. L. 361, 362 (2002); Magid, et al., *supra* note 224, at 4-5; Smith, *supra* note 225, at 828-29.

²²⁹ Hofrichter, *supra* note 229, at 1931; Kelley, *supra* note 229, at 362; Lemley, *supra* note 31, at 1695; Smith, *supra* note 225, at 828. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428-29 (2003) (Court indicates that trademark law meant to protect consumers and businesses from unfair competition caused by “imitating competitors”); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (Court indicates that unfair competition laws intended to protect consumers from confusion about goods, and not to promote product innovation in boat hull patent dispute).

²³⁰ Galvano, *supra* note 224, at 1217-18; Magliocca, *supra* note 87, at 958.

²³¹ 15 U.S.C. § 1125 (2006) (amended 2005).

²³² Magid, et al., *supra* note 224, at 5; Magliocca, *supra* note 87, at 960-61; Schechter, *infra* note 234, at 341-42; Smith, *supra* note 225, at 830. See *infra* note 234 and accompanying text.

²³³ 40 HARV. L. REV. 813 (1927), reprinted in 60 T.M.R. 334 (1970). As Professor Schechter perceptively observed,

We have seen that the proper expansion of trademark law has been hampered by obsolete conceptions both as to the function of a trademark and as to the need for its protection. Commencing with the assumption that a trademark designates either origin or ownership—in other words, source—the law, even in its most liberal interpretation at the present time, will prevent the misuse of that mark only where there is an actual confusion created by such misuse, resulting in either diversion of trade or other

trademark law should focus on safeguarding the value and selling power of trademarks, as opposed to consumer protection.²³⁴ Borrowing from European legal traditions,²³⁵ Professor Schechter took the view that “the preservation of the uniqueness of a trademark should constitute the only rational basis for its protection,” not the prevention of consumer confusion.²³⁶ Recognizing the costly investment in creating and marketing trademarks, Professor Schechter proposed the development of laws to provide a property right to owners of marks and to safeguard the inherent value of marks. He suggested a trademark scheme that would protect against “the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods.”²³⁷

Congress and state legislatures did not immediately support Professor Schechter’s innovative proposal.²³⁸ Nearly twenty years after Professor Schechter’s article, Massachusetts enacted the first trademark dilution statute and other states slowly followed suit.²³⁹ State anti-dilution statutes encompassed Professor Schechter’s initial notion of protecting the distinctive nature of marks from dilution under the legal theory of trademark blurring.²⁴⁰

concrete financial liability or injury to trade repute.

...

Trademark pirates are growing more subtle and refined. They proceed circumspectly, by suggestion and approximation, rather than by direct and exact duplication of their victims’ wares and marks. The history of important trademark litigation within recent years shows that the use of similar marks on non-competing goods is perhaps the normal rather than the exceptional case of infringement.

Schechter, *supra*, at 341.

²³⁴ *Id.* at 345. See GILSON, *supra* note 224, at §5A.01[1]; Nelson, *supra* note 228; Magid, et al., *supra* note 224, at 5-6. Professor Magid and her co-authors indicate that Schechter’s “notion of protecting the inherent value of the trademark from dilution was singularly antithetical to the consumer confusion emphasis of trademark.” *Id.*

²³⁵ Schechter, *supra* note 234, at 336-38; 345-46. Professor Schechter considered British and German precedent in making his case for the expansion of trademark law protections. *Id.*

²³⁶ *Id.* at 345.

²³⁷ *Id.* at 342.

²³⁸ Kelley, *supra* note 229, at 363; Nelson, *supra* note 228; Smith, *supra* note 225, at 838-39.

²³⁹ Galvano, *supra* note 224, at 1223; Hofrichter, *supra* note 229, at 1932; Smith, *supra* note 225, at 839. Subsequent state anti-dilution statutes based their language from the Model State Trademark Bill, adopted by the U.S. Trademark Association, and drawn from the text of Massachusetts statute. Galvano, *supra* note 224, at 1223; Magliocca, *supra* note 87, at 961; Nelson, *supra* note 228; Smith, *supra* note 225, at 839.

²⁴⁰ Galvano, *supra* note 224, at 1226; Hofrichter, *supra* note 229, at 1933; . In discussing the legislative history of the New York anti-dilution law, one court hypothesized about the blurring issues presented by the misuse of famous trademark names such as “Dupont shoes,

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Trademark blurring, or the “whittling away” Professor Schechter warned about, results in diminishment of the unique nature of a mark through unauthorized uses of the mark on non-competing goods over a long period of time.²⁴¹ For example, in applying the Illinois anti-dilution statute, the court enjoined a refrigeration and heating company from using the name Polaroid, finding trademark blurring of the well-known Polaroid mark associated with quality cameras and photographic products.²⁴²

However, state anti-dilution statutes also moved beyond Schechter’s original thinking, embracing the protection of marks from the “likelihood of injury to business reputation” under the concept of trademark tarnishment.²⁴³ The tarnishment concept addresses whether the unauthorized use of the mark places it an unwholesome or unsavory light or links it to products of shoddy quality or workmanship.²⁴⁴ Unlike blurring, tarnishment seeks to avoid the immediate and serious harm to the mark from improper or insalubrious associations.²⁴⁵ In early tarnishment cases under state anti-dilution statutes, the mark owner sought to prevent a mark from being used in connection with pornographic materials,²⁴⁶ crude language or humor,²⁴⁷ unflattering product associations,²⁴⁸

Buick aspirin tablets, Schlitz varnish, Kodak pianos, Bulova gowns, and so forth.” *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1038 (2d Cir. 1989) (appeals court finds that use of LEXUS for luxury cars does not significantly blur use of LEXIS for legal services provider).

²⁴¹ Galvano, *supra* note 224, at 1226; Hofrichter, *supra* note 229, at 1933; Kelley, *supra* note 229, at 365; Smith, *supra* note 225, at 835. Trademark blurring has been analogized to “cancer-like growth” that destroys uniqueness over time. Nelson, *supra* note 228 (quoting *Tiffany & Co. v. The Boston Club, Inc.*, 231 F. Supp. 836, 844 (D. Mass. 1964)).

²⁴² *Polaroid Corp. v. Polaroid, Inc.*, 319 F.2d 830 (7th Cir. 1963). Prior to the passage of the FTDA, only a few other courts found for trademark holders on the theory of blurring. *See e.g.*, *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc.*, 855 F.2d 480 (7th Cir. 1988) (Using Illinois dilution statute, court enjoins used car dealership’s use of slogan “The Greatest Used Car Show on Earth” as diluting distinctiveness of Ringling Brothers’ well-known circus slogan, “The Greatest Show on Earth”); *Toys “R” Us, Inc. v. Canarsie Kiddie Shop, Inc.*, 559 F. Supp. 1189 (E.D.N.Y. 1983) (In part under New York State anti-dilution statute, court enjoined retailer’s use of Kids ‘R Us on its line of children’s clothing). *See infra* notes 273-75 and accompanying text.

²⁴³ Galvano, *supra* note 224, at 1223-24; Nelson, *supra* note 228; Smith, *supra* note 225, at 826.

²⁴⁴ Galvano, *supra* note 224, at 1228-29; Hofrichter, *supra* note 229, at 1934; Kelley, *supra* note 229, at 365-66; Smith, *supra* note 225, at 833.

²⁴⁵ Galvano, *supra* note 224, at 1227-29; Smith, *supra* note 225, at 833. *See infra* notes 271-75 and accompanying text. (tarn. cases)

²⁴⁶ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979) (court granted preliminary injunction prohibiting distribution or exhibition of

or illicit drug activities.²⁴⁹

Despite the mandates of state anti-dilution statutes, courts were reluctant to apply these theories in trademark cases without a showing of likely consumer confusion,²⁵⁰ undermining Schechter's insight into the need to decouple dilution from consumer protection. Much of this reluctance arose from

"sexually depraved" film "Debbie Does Dallas" as trademark tarnishment of Dallas Cowboys cheerleading squad); *The Pillsbury Co. v. Milky Way Productions*, 1981 W.L. 1402 (N.D. Ga. 1981) (court issued injunction against publication of pictures of characters "Poppin Fresh" and "Poppie Fresh" engaged in sexual acts in *Screw* magazine as tarnishment under Georgia dilution statute). *Cf.* *Girl Scouts v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228 (S.D.N.Y. 1969) ("lampooning use" of the Girl Scout name, motto, and insignia on poster of pregnant Girl Scout with motto "Be Prepared" not tarnishment). *See* Galvano, *supra* note 224, at 1227-30; Kelley, *supra* note 229, at 365-67 (both articles discuss case precedent under state and federal anti-dilution laws).

²⁴⁷ *Eastman Kodak Co. v. D. B. Rakow*, 739 F. Supp. 116 (W.D.N.Y. 1989) (applying N.Y. anti-dilution statute, court decided that comedian's use of stage name "Kodak" tarnished Kodak's reputation due to crude language and sexual jokes that were inconsistent with Kodak's stated advertising policies against violent or sexual themes); *General Electric Co. v. Alumpa Coal, Co.*, 205 U.S.P.Q. 1036 (D. Mass. 1979) (court found tarnishment from use of term "Genital Electric" placed within distinctive General Electric logo).

²⁴⁸ *See, e.g., Deere & Co. v. MTD Prod., Inc.*, 41 F.3d 39 (2d Cir. 1994) (competitor tarnished Deere's mark by altering logo to suggest deer on Deere's logo as smaller and fearful of its competitor); *Chemical Corp. of America v. Anheuser-Busch, Inc.*, 306 F.2d 433 (5th Cir. 1962) (Court enjoined use of trade slogan "When there's life. . .there's bugs" as unwholesome twist on A-H beer slogan, "Where there's life. . .there's Bud") *cert. denied*, 372 U.S. 965 (1963); *Grey v. Campbell Soup Co.*, 650 F. Supp. 1166 (C.D. Cal. 1986) (court found dilution in marketing of "Dogiva" dog treats as tarnishing "Godiva" mark for premium chocolates). Not every negative or unfavorable association, however, provides grounds for tarnishment. Kelley, *supra* note 229, at 366. *See, e.g., Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (use of mark "Here's Johnny" and slogan "World's Foremost Comedian" for portable toilets does not constitute tarnishment); *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788 (9th Cir. 1981) (Sears's parodic use of BAGZILLA mark and phrase "monstrously strong" on garbage bags did not tarnish GODZILLA, a movie monster character's mark); *Jordache Enterprises, Inc., v. Hogg Wyld, Ltd.*, 625 F. Supp. 48 (D.N.M. 1985) (court found that use of name Lardashe jeans with hog pockets as play on words as to famous Jordache mark did not tarnish it). *See infra* notes 318-28 and accompanying text.

²⁴⁹ *Coca-Cola Co. v. Alma-Leo USA, Inc.*, 719 F. Supp. 725 (N.D. Ill. 1989) (under Illinois Anti-Dilution Act, court enjoined defendant from distributing "Mad Scientist Magic Powder" bubble gum in containers resembling Coca-Cola bottles as tarnishment); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972) (court found trademark tarnishment in poster using trade dress and slogan "Enjoy Coca-Cola" substituting "Cocaine" for Coca-Cola).

²⁵⁰ GILSON, *supra* note 224, at §5A.01[1]; Nelson, *supra* note 228.

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concerns about unclear legal parameters of dilution and the risk of creating trademark monopolies over certain words.²⁵¹ State statutes also differed on which trademarks would be safeguarded – some protected locally “famous” marks while others protected “distinctive” marks, regardless of the level of fame.²⁵² State statutes were also criticized for failing to adequately protect free speech that criticized or parodied well-recognized trademarks.²⁵³ Untethered from consumer confusion and unclear on the nature of marks deserving protection, only a few state anti-dilution cases under trademark blurring and tarnishment theories were successful.²⁵⁴

Nearly seventy years after Schechter’s seminal article, and after more than

²⁵¹ GILSON, *supra* note 224, at §5A.01[1]; Nelson, *supra* note 228; Travis, *supra* note 31, at ¶19.

²⁵² Keola R. Whittaker, *Trademark Dilution in a Global Age*, 27 U. PA. J. INT’L. ECON. L. 907, 910, 915 (2006).

²⁵³ See Aoki, *supra* note 31, at 243-44, (author criticizes expanding intellectual property rights for trademarks interests into “quasi-authorial figures” creating conflict with First Amendment free speech rights); Travis, *supra* note 31, at ¶¶25-31 (criticizes expansion of trademark law to include dilution as leading to further corporate censorship of critical voices). See, e.g., *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987) (despite free speech defense, court sustained injunction against distribution of Mutant of Omaha t-shirts that parodied Mutual of Omaha logo with anti-nuclear sentiments as tarnishing company’s goodwill); *Anheuser-Busch v. Balucci Publ’ns*, 28 F. 3d 769 (8th Cir. 1994) (court found dismissal of dilution claim under Missouri law as erroneous when environmental parody ad used term “Michelob Oily” tarnishing A-H’s mark). Cf., *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir.), *cert. denied and appeal dismissed*, 483 U.S. 1013 (1987) (applying Maine anti-dilution statute, sexual parody of L.L. Bean catalog and its marks as protected First Amendment speech); *Lucasfilm Ltd. v. High Frontier, et al.*, 622 F. Supp. 931 (D.C. 1985) (court refused to enjoin use of mark in public interest television ads criticizing Reagan Administration’s Strategic Defense Initiative as “Star Wars” as not blurring distinctiveness of mark); *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 556 F. Supp. 785 (E.D.N.Y. 1983) (court finds that “Petley Flea Bags” as parody of Tetley tea bags and related items and does not constitute tarnishment).

In the *L.L. Bean* case, the court warned about the risks to free speech from anti-dilution statutes. The court stated that,

If the anti-dilution statute were construed as permitting a trademark owner to enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct. The legitimate aim of the anti-dilution statute is to prohibit the unauthorized use of another’s trademark in order to market incompatible products or services. The Constitution does not, however, permit the range of the anti-dilution statute to encompass the unauthorized use of a trademark in a noncommercial setting such as an editorial or artistic context.

811 F.2d at 33.

²⁵⁴ See *supra* notes 251-56 and accompanying text.

half of the states had adopted anti-dilution statutes, Congress eventually enacted the FTDA in 1996.²⁵⁵ A variety of reasons motivated the enactment of the FTDA, including concerns over lack of uniformity and forum-shopping under state anti-dilution statutes,²⁵⁶ the reluctance of state court to issue nationwide injunctions under state laws,²⁵⁷ greater compliance with international trade agreements,²⁵⁸ and the effective lobbying efforts of powerful trademark owners.²⁵⁹ The new federal law was not intended to preempt state dilution statutes, which would continue to protect “locally famous or distinctive marks.”²⁶⁰

The FTDA broadly defines the notion of dilution as “the lessening of the capacity of a famous mark to identify and distinguish goods or services,” without any need to show direct competition or consumer confusion.²⁶¹ Departing from Professor Schechter’s emphasis on distinctive marks, the Act safeguards “famous” marks and provides several nonexclusive factors for determining the actionable level of fame.²⁶² Unlike state anti-dilution laws, the

²⁵⁵ 15 U.S.C. §§1125, 1127 (2006) (as amended). See Galvano, *supra* note 224, at 1223; Nelson, *supra* note 228; Smith, *supra* note 225, at 839. See generally H.R. REP. NO. 104-374 (1995) (House report accompanying FTDA) [hereinafter HOUSE FTDA REPORT].

²⁵⁶ HOUSE FTDA REPORT, *supra* note 256, at 4; Kelley, *supra* note 229, at 364; Whittaker, *supra* note 253, at 910, 914-15.

²⁵⁷ HOUSE FTDA REPORT, *supra* note 256, at 3-4; Kelley, *supra* note 229, at 364.

²⁵⁸ HOUSE FTDA REPORT, *supra* note 256, at 3; Whittaker, *supra* note 253, at 910-11, 918-26. The House report specifically indicated that the FTDA would bring the U.S. in accord with the Trade-Related aspects of Intellectual Property Rights (TRIPS) as well as the Paris Convention. HOUSE FTDA REPORT, *supra* note 256, at 3.

²⁵⁹ Aoki, *supra* note 31, at 244-48. Professor Oswald noted that “[m]any trademark law commentators dislike dilution theory, characterizing it as a ‘remedy without a wrong.’” Lynda J. Oswald, “Tarnishment” and “Blurring” under the Federal Trademark Dilution Act of 1995, 36 AM. BUS. L. J. 255, 264 (1999).

²⁶⁰ HOUSE FTDA REPORT, *supra* note 256, at 4; Kelley, *supra* note 229, at 363.

²⁶¹ 15 U.S.C. § 1127 (2006).

²⁶² *Id.* at §1125(c)(2)(A)(i)-(iv). The original statutory factors as to fame are as follows:

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the mark’s owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and
- (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

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federal statute sought to blunt First Amendment criticism through the explicit inclusion of a fair use provision in the FTDA that protects comparative commercial advertising, noncommercial use of the mark, and news reporting and commentary.²⁶³

In order to achieve federal dilution protection, the senior trademark owner must show that,

(1) the senior mark is famous; (2) the disputed junior mark was used after the senior mark became famous; (3) the junior use of the senior mark is commercial; and, 4) the junior use of the mark dilutes the senior mark, weakening the capacity of the senior mark in identifying goods and services.²⁶⁴ The primary remedy for the trademark holder is injunctive relief as well as other remedies within the court's discretion, including monetary damages for willful dilution.²⁶⁵

The FTDA was roundly criticized for its vague language and absence of a clear analytical framework.²⁶⁶ After the passage of the Act, federal courts struggled with three main issues in interpreting the Act in regard to the appropriate method for analyzing what constitutes dilution,²⁶⁷ the limits on dilution in light of fair use concerns,²⁶⁸ and the applicable standard of harm for granting injunctive relief.²⁶⁹ First, although the Act defines dilution, it does not specifically reference the concepts of trademark blurring and tarnishment. Courts grappled with the threshold issue of the level of proof to find a mark famous enough for dilution²⁷⁰ and whether a "famous" mark must be nationally

Id. See Galvano, *supra* note 224, at 1224; GILSON, *supra* note 224, at §5A.01[4][c]; Oswald, *supra* note 260, at 271. Professor Oswald notes that, "[w]hile these factors provide some guidance to a court, the determination of whether a mark is famous is a highly fact-specific and somewhat unpredictable exercise." *Id.*

²⁶³ *Id.* at §1125(c)(3)(A)-(C). See *infra* notes 276-81 & 310-18 and accompanying text.

²⁶⁴ Galvano, *supra* note 224, at 1225; GILSON, *supra* note 224, at §5A.01[3]; Nelson, *supra* note 228, at 149.

²⁶⁵ 15 U.S.C. §§1125(c)(1), (c)(5) (2006). See GILSON, *supra* note 224, at §5A.01[3].

²⁶⁶ Kathleen Goodberlet, *The Trademark Dilution Revision Act of 2006: Prospective Changes to Dilution Definition, Claim Analyses, and Standard of Harm*, 6 J. HIGH TECH. L. 249, 260 (2006); Smith, *supra* note 225, at 860; Whittaker, *supra* note 253, at 911.

²⁶⁷ Goodberlet, *supra* note 267, at 260-64. See *supra* notes 266-67 and accompanying text; *infra* notes 269-70 and accompanying text.

²⁶⁸ Aoki, *supra* note 31, at 243-44, 247-48; Travis, *supra* note 31, at ¶ 55; Julie Zando-Dennis, Note, *Not Playing Around: The Chilling Power of the Federal Trademark Dilution Act of 1995*, 11 CARDOZO WOMEN'S L.J. 599, 600-01 (2005). See *infra* notes 276-81 and accompanying text.

²⁶⁹ Galvano, *supra* note 224, at 1234-44; Goodberlet, *supra* note 267, at 265-67. See *infra* notes 287-90 and accompanying text.

²⁷⁰ GILSON, *supra* note 224, at §5A.01[4][a]; Hofrichter, *supra* note 229, at 1936.

famous or need only be famous in a regional or niche market.²⁷¹ The courts have also taken different views on the appropriate interpretation of trademark blurring, leading to a split between jurisdictions on its application.²⁷² The Seventh Circuit utilized a two-prong approach,²⁷³ while the Second, Third, and Sixth Circuits applied multi-factor approaches to assess blurring claims.²⁷⁴

Concerning the nature of tarnishment, circuits applied largely subjective views in determining whether the junior mark had tarnished the senior mark's reputation.²⁷⁵ For example, the court enjoined the use of the family-friendly mark, "Dairy Queen," in a planned humorous "mockumentary," satirizing beauty contests in rural Minnesota, to be named "Dairy Queens."²⁷⁶ Yet

²⁷¹ GILSON, *supra* note 224, at §5A.01[4][c][iii]; Hofrichter, *supra* note 229, at 1936; Whittaker, *supra* note 253, at 916. Six federal circuits permitted a finding of fame based on a local area or specific consumer market. *Id. See, e.g.,* Syndicate Sales, Inc. v. Hampshire Paper Corp., 192 F.3d 633, 641 (7th Cir. 1999) (in trade dress dilution case, court determined that district court erred in determining mark was not famous based solely on its niche-market status); Avery Dennison Corp. v. Sumpton, 189 F.3d 868, 875 (9th Cir. 1999) (court determined that Avery Dennison had failed to show mark as famous outside of its specialized market segment). The law also protected trade dress as famous marks, provided that "the matter sought to be protected is not functional." 15 U.S.C. §1125(a)(3) (2006). GILSON, *supra* note 224, at §5A.01[4][f].

²⁷² Goodberlet, *supra* note 267, at 261-64.

²⁷³ *Id.* at 263. Under this test, the court first assessed whether or not a mark is famous and then reviewed the similarity of the junior mark to the senior mark in determining blurring. *Id. See e.g.,* Eli Lilly & Co. v. Natural Answers, Inc., 233 F.3d 456, 469 (7th Cir. 2000) (affirming the likelihood of dilution as plaintiff's PROZAC mark achieved substantial renown and substantially similar to defendant's HERBROZAC mark).

²⁷⁴ GILSON, *supra* note 224, at §5A.01[5][d][ii]; Goodberlet, *supra* note 267, at 263-64. The first multi-factor test was referred to as the "Sweet Test" based on Judge Sweet's six-point analysis of New York's dilution statute in the *Mead Data* case. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1035 (2d Cir. 1989) (Sweet, J., concurring). *See* Galvano, *supra* note 224, at 1231-33; GILSON, *supra* note 224, at §5A.01[5][d][i]; Nelson, *supra* note 228, at 152. Several courts used the test which was later roundly criticized for conflating dilution with consumer confusion under trademark infringement. GILSON, *supra* note 224, at §5A.01[5][d][i]; Nelson, *supra* note 228, at 152. Subsequently, the Sweet Test was supplanted by a ten-factor analysis referenced as the "Nabisco Test." *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 222 (6th Cir. 1999) (finding dilution in sale of Nabisco CatDog crackers resembling the shape and orange color of the famous Pepperidge Farms Goldfish crackers mark). *See* GILSON, *supra* note 224, at §5A.01[5][d][ii]; Galvano, *supra* note 224, at 1239; Nelson, *supra* note 228, at 152.

²⁷⁵ GILSON, *supra* note 224, at §5A.01[6]; Nelson, *supra* note 228, at 155; Oswald, *supra* note 260, at 273. *See supra* notes 246-49 and accompanying text.

²⁷⁶ *American Dairy Queen Corp. v. New Line Prod., Inc.*, 35 F. Supp. 2d 727, 735 (D. Minn. 1998). The court rejected the defendant's claim of expressive speech regarding the title, contending that the film company had other alternatives for naming their film. *Id.* at

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another court found for the junior use of the slogan, “The Greatest Bar on Earth,” against claims of tarnishing the family-friendly circus slogan, “The Greatest Show on Earth.”²⁷⁷ Additionally, the Supreme Court²⁷⁸ and legal

734-35. *See, e.g.*, *Kraft Food Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 956 (N.D. Ill. 2002) (court preliminarily enjoined use of name “King VelVeeda” on website with sexual content and links to “cheesy” materials); *Polo Ralph Lauren L.P. v. Schuman*, 46 U.S.P.Q.2d (BNA) 1046, 1048 (S.D. Tex. 1998) (court found that use of famous Polo mark was tarnishment when used in name, THE POLO CLUB, for adult-oriented entertainment venue); *Toys “R” Us, Inc. v. Akkaoui*, 40 U.S.P.Q.2d (BNA) 1836, 1839 (N.D. Cal. 1996) (court enjoined use of Adults “R” Us for web site domain name and for line of sexual devices and clothing); *Hasbro, Inc. v. Internet Entm’t. Group, Ltd.*, 40 U.S.P.Q.2d (BNA) 1479, 1480 (W.D. Wash. 1996) (under Washington dilution statute, court issued preliminary injunction against use of mark for children’s board game “Candy Land” for adult-oriented web site); *Anheuser-Busch Inc. v. Andy’s Sportswear, Inc.*, 40 U.S.P.Q.2d (BNA) 1542, 1542 (N.D. Cal. 1996) (court prevented the sale of “Buttwiser” T-shirts as tarnishing famous “Budweiser” mark).

²⁷⁷ *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp.*, 937 F. Supp. 204, 214 (S.D.N.Y. 1996). The court found that the fact that the circus sold alcohol at some of its venues and some of its sponsoring restaurant sold alcohol to patrons undercut its claim that the bar’s use of its altered slogan tarnished its wholesome, family-friendly image. *Id.* at 211. Similarly, courts have found that dilution through association of mark with lesser quality, but not necessarily unwholesome or shoddy quality, will not result in a finding of tarnishment. *See, e.g.*, *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415, 453 (S.D.N.Y. 2004) (DB’s emulation of multi-colored logo purses are not unwholesome or shoddy and do not amount to blurring or tarnishment of Louis Vuitton’s mark on its purses); *Clinique Labs., Inc. v. Dep Corp.*, 945 F. Supp. 547, 562 (S.D.N.Y. 1996) (defendant’s use of term “Bastique” to create cheap knock-offs of Clinique products not tarnishment); *Lyons P’ship, L.P. v. Giannoulas*, 14 F. Supp. 2d 947, 954 (N.D. Tex. 1998), *aff’d*, 179 F. 3d 384 (5th Cir. 1999) (court determines that Barney, purple dinosaur sketch did not tarnish senior mark due in part that junior use did not link Barney to poor quality products or unwholesome activities). *Cf.* *Victoria’s Secret Stores, et al. v. Arco Equip. Co., Inc.*, 194 F. Supp. 2d 704, 731 (S.D. Ohio 2002) (court finds trademark tarnishment in association of website’s use of Victoria’s Secret mark in its sale of sex toys and other adult-oriented items); *Eli Lilly & Co.*, 233 F.3d at 466 (court indicates that tarnishment may occur if consumers associate famous mark with “inferior or offensive product”); *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 507 (2d Cir. 1996) (court stated that tarnishment may occur where mark is “linked to products of shoddy quality” and “public will associate the [senior mark with] lack of quality of lack of prestige” (quoting *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 44 (2d Cir. 1994))).

²⁷⁸ *Moseley v. V. Secret Catalogue, Inc.*, 537 U.S. 418, 432 (2003). Discussing the theory of tarnishment in dicta, the Supreme Court indicated that:

[w]hether it is actually embraced by the statutory text, however, is another matter. Indeed, the contrast between the state statutes, which expressly refer to both “injury to business reputation” and to “dilution of the distinctive quality of a trade name or trademark,” and the federal statute which refers only to the latter, arguably supports a

experts have questioned whether the text of the FTDA was ever intended to embrace trademark tarnishment.²⁷⁹

Second, the FTDA raises concerns about the proper bounds of dilution under its fair use exemption for non-commercial use.²⁸⁰ Numerous legal commentators have criticized the FTDA for allowing corporate interests to control and suppress free speech involving their marks.²⁸¹ In some instances, the courts have found dilution, even if parody, political speech, or protest commentaries are involved and ties to commercial activities were tenuous.²⁸²

narrower reading of the FTDA. (citation omitted)

Id.

²⁷⁹ Nelson, *supra* note 228, at 150; Smith, *supra* note 225, at 826. State statutes typically refer to tarnishment using language about “injury to business reputation” which is not found in the FTDA. See Galvano, *supra* note 224, at 1223-24; Nelson, *supra* note 228, at 150; Smith, *supra* note 225, at 826.

²⁸⁰ Aoki, *supra* note 31, at 243-44, 247-48; Travis, *supra* note 31, at ¶ 55; Zando-Dennis, *supra* note 269, at 600-01.

²⁸¹ Aoki, *supra* note 31, at 243-44, 247-48; Travis, *supra* note 31, at ¶¶ 55-56; Zando-Dennis, *supra* note 269, at 600-01. Professor Aoki wrote that:

The strongest trademarks are owned by the largest and most powerful corporate entities, which have the most resources to continue investing heavily in advertising, merchandising and policing their intellectual properties. Ironically, given the pervasiveness of these trademarked signs and symbols, they are also the most heavily insulated from use in oppositional, or simply alternate cultural or sub-cultural strategies or settings. These strategies may use “owned” symbols to criticize, mock or parody the pervasiveness of such symbols. Strong anti-dilution laws grant trademark owners increasingly strong veto power over downstream uses of such a trademark for purposes of social commentary and expression critical of or radically alternative to a trademark owner’s practices and products. In some circumstances, however, the use of just such a trademarked symbol may be the most effective way to express or communicate one’s criticism of a trademark owner’s activities. . . . [B]ecause U.S. law fictionalizes the corporation as a “legal person” existing in the private realm of the marketplace, there is also no problem of public or “state action” when a powerful private entity uses trademark law to suppress alternate uses of a mark for expressive purposes.

Id. at 247-49. See generally Zando-Dennis, *supra* note 269, at 609-16 (author discusses repeated efforts by Mattel to enjoin critical or parodic speech involving its “Barbie” mark under the FTDA, including use of mark for non-profit benefit to aid critically ill children). However, Prof. Lemley, a critic of dilution, does concede that trademark dilution has not translated into a presumed reduction in persuasive advertising which continues to rise dramatically. Lemley, *supra* note 31, at 1691.

²⁸² Travis, *supra* note 31, at ¶¶ 38-43, 55-57; Zando-Dennis, *supra* note 269, at 622-25. See, e.g., *People for the Ethical Treatment of Animals (PETA) v. Doughney*, 263 F.3d 359, 365-66 (4th Cir. 2001) (court enjoined use of domain name “www.peta.org” for web site parodying PETA finding commercial conduct merely due to redirecting search engine traffic from official PETA site); *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313, at *5-6 (S.D.N.Y. 1997) (court determined that Bucci’s web site,

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Yet many more courts have refused to find dilution, viewing parody, political, or protest speech as noncommercial and protected under the First Amendment,²⁸³ even if commercial purposes were intermingled with protected speech.²⁸⁴ Furthermore, courts have handed-down inconsistent decisions on

“www.plannedparenthood.com,” diluted mark by deflecting traffic from Planned Parenthood site and was commercial due to sales of anti-abortion book and efforts to raise funds to fight abortion); *Dr. Seuss Enters., LP v. Penguin Books, USA, Inc.*, 109 F.3d 1394, 1403 (9th Cir. 1997) (court enjoins sale of book on O.J. Simpson trial mimicking Dr. Seuss art and writing style as not parody and therefore not fair use under either copyright infringement or trademark infringement or dilution); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 309 (D.N.J. 1998), *aff’d*, 159 F.3d 1351 (3d Cir. 1998) (court issued injunction against site critical of “Jews for Jesus” organization at “jewsforjesus.org” finding commercial use due to single link to another site selling books and audiotapes); *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110, 114 (D. Mass. 2002) (rejecting First Amendment claims, court found that disgruntled consumer who registered 16 variations of TD Waterhouse mark acted in bad faith with the intent to “tarnish or disparage”); *Starbucks Corp. v. Dwyer*, No. 3:00-CV-1499 MMC (N.D. Cal. injunction filed June 8, 2000) (court enjoined parodic and altered use of Starbucks mermaid logo, with words “Consumer Whore,” on comic book artist’s web site critical of excessive consumerism). *See supra* note 249 and accompanying text.

²⁸³ *See, e.g.*, *Lamparello v. Falwell*, 420 F.3d 309, 321-22 (4th Cir. 2005) (court finds that web site, “www.falwell.com,” critical of Rev. Jerry Falwell is protected as noncommercial speech under FTDA); *TMI Inc. v. Maxwell*, 368 F.3d 433, 434 (5th Cir. 2004) (unhappy customer’s use of two domain names similar to home builder’s mark to complain about company protected as noncommercial speech under FTDA and Texas dilution statute); *American Family Life Insurance Company (AFLAC) v. Hagan*, 266 F. Supp. 2d 682, 701 (N.D. Ohio 2002) (court denied injunctive relief sought against political ads that mimicked AFLAC Duck ads); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1168 (C.D. Cal. 1998) (court refused to enjoin use of Bally mark on consumer commentary site using words “ballysucks” as part of domain name).

²⁸⁴ *See, e.g.*, *Lyons P’ship, L.P. v. Giannoulas*, 179 F.3d 384, 390, *aff’g*, 14 F. Supp. 2d 947 (N.D. Tex. 1998) (court determines that Barney-like purple dinosaur sketch did not tarnish senior mark due to protected parody and found no intention to benefit from character’s goodwill); *MasterCard Int’l Inc. v. Nader 2000 Primary Comm., Inc.*, 70 U.S. P.Q.2d (BNA) 1046 (S.D. N.Y. 2004) (court refused to enjoin use of parody of Mastercard “priceless” ads in political primary ads involving funds solicitations); *Wham-O, Inc. v. Paramount Pictures Corp.*, 286 F. Supp. 2d 1254, 1262 (N.D. Cal. 2003) (court determined that humorous of misuse of Slip-N-Slide product in movie did not rise to level of trademark tarnishment); *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 423 (S.D.N.Y. 2002) (court finds dog perfume line parodying luxury brands in product names did not dilute Tommy Hilfiger mark with “Tommy Holedigger” product); *LucasFilm, Ltd. v. Media Market Group, Ltd.*, 182 F. Supp. 2d 897, 900-01 (2002) (court held that animated pornographic film “StarBallz” did not tarnish family-oriented “Star Wars” mark); *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1155 (C.D. Cal. 1998) (court indicated that popular song “Barbie Girl,” a parody of famous Barbie mark with sexual

whether hyperlinks on a web site to other offensive web sites provided a basis for tarnishment.²⁸⁵

Third, the courts also were divided on the nature of proof of harm needed to prove dilution.²⁸⁶ The Second, Sixth, and Seventh Circuits stated that a senior mark holder must show only the likelihood of harm from dilution,²⁸⁷ following the approach of earlier state anti-dilution statutes.²⁸⁸ The Fourth and Fifth Circuits, however, departed from the state pattern and mandated actual proof of harm to enjoin use of the mark.²⁸⁹

In *Moseley*, the Supreme Court sought to clarify the standard of harm for dilution cases²⁹⁰ and caused more confusion regarding the application of the FTDA.²⁹¹ The case focused on an adult-oriented store, originally called “Victor’s Secret,” which Victoria’s Secret believed diluted its famous trademark.²⁹² In response to Victoria’s Secret’s demand, the Moseleys, the store owners, changed the name of the store to “Victor’s Little Secret.”²⁹³ Victoria’s Secret then sued and the court granted summary judgment on the claim of trademark tarnishment through its association with adult-themed sexual merchandise.²⁹⁴ The Sixth Circuit affirmed the lower court decision

lyrics, did not constitute tarnishment).

²⁸⁵ Kelley, *supra* note 229, at 371-73. *See supra* note 277 and accompanying text.

²⁸⁶ Galvano, *supra* note 224, at 1231-43; GILSON, *supra* note 224, at §5A.01[7]; Hofrichter, *supra* note 229, at 1936-37. *See generally* Galvano, *supra* note 224, at 1249-60 (author calls for higher level of proof for blurring and lower level of proof for tarnishment).

²⁸⁷ Galvano, *supra* note 224, at 1239; GILSON, *supra* note 224, at §5A.01[3]; Hofrichter, *supra* note 229, at 1936-37. *See Moseley*, 537 U.S. at 426 n. 6, 428; *Eli Lilly*, 233 F.3d at 468; *Nabisco*, 191 F.3d at 224-25.

²⁸⁸ *See supra* notes 240-50 and accompanying text.

²⁸⁹ GILSON, *supra* note 224, at §5A.01[3]; Hofrichter, *supra* note 229, at 1936-37. *See, e.g.*, *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 671 (5th Cir. 2000) (court determines no actual dilution of Polo mark by its use for magazine); *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development*, 170 F.3d 449, 461 (4th Cir. 1999) (court found no dilution of “The Greatest Show on Earth” circus slogan by Utah’s slogan “The Greatest Snow on Earth” in absence of showing of actual economic harm).

²⁹⁰ *Moseley*, 537 U.S. at 428. *See generally* Michael Fuller, Recent Development, *Moseley v. V. Secret Catalogue, Inc., The FTDA’s “Little Secret”: A Claim of Trademark Dilution Requires Actual Proof of Dilution Rather than a Likelihood of Dilution*, 11 U. BALT. INTELL. PROP. L. J. 123 (2003) (provides overview of *Moseley* case).

²⁹¹ Hofrichter, *supra* note 229, at 1937-38; Smith, *supra* note 225, at 849. *See infra* notes 305-17 and accompanying text.

²⁹² *Moseley*, 537 U.S. at 422-23.

²⁹³ *Id.* at 423.

²⁹⁴ *Id.* at 425. The Supreme Court noted that the district court did not find trademark blurring nor any consumer confusion to support the plaintiff’s infringement and unfair

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finding a likelihood of harm from both trademark blurring and tarnishment.²⁹⁵

However, the Supreme Court contrasted the language of the FTDA with state statutory dilution language.²⁹⁶ State statutes typically indicate that the “likelihood of harm” is the standard for dilution.²⁹⁷ Yet the FTDA indicates that the improper conduct must “cause dilution of the [mark’s] distinctive quality.”²⁹⁸ Based on its textual comparison, the Court determined that the moving party must show actual dilution, not the likelihood of dilution, to succeed under the FTDA.²⁹⁹ The Court indicated that actual losses as to sales or profits need not be proven to succeed on a trademark dilution claim.³⁰⁰ Despite recognizing the expense and unreliability of consumer surveys and other means to prove actual dilution,³⁰¹ the Court indicated that consumer surveys and reliable circumstantial evidence, such as evidence of identical marks, could be utilized to show actual dilution.³⁰² The Court further muddled the waters by questioning the validity of tarnishment claims under the FTDA.³⁰³

competition claims. *Id.*

²⁹⁵ *Id.* at 425-427. Quoting the Sixth Circuit, the Supreme Court summarized the appellate court’s finding:

While no consumer is likely to go to the Moseleys’ store expecting to find Victoria’s Secret’s famed Miracle Bra, consumers who hear the name ‘Victor’s Little Secret’ are likely automatically to think of the more famous store and link it to the Moseleys’ adult-toy, gag gift, and lingerie shop. This, then, is a classic instance of dilution by tarnishing (associating the Victoria’s Secret name with sex toys and lewd coffee mugs) and by blurring (linking the chain with a single, unauthorized establishment). Given this conclusion, it follows that Victoria’s Secret would prevail in a dilution analysis, even without an exhaustive consideration of all ten of the *Nabisco* factors.

Id. at 427 (quoting *V. Secret Catalogue, Inc. v. Moseley*, 259 F.3d 464, 475-77 (6th Cir. 2001)).

²⁹⁶ *Id.* at 432-33.

²⁹⁷ *Id.* at 432.

²⁹⁸ *Id.* at 432-433.

²⁹⁹ *Id.* at 433. The Court concluded that “actual dilution must be established.” *Id.* Other courts briefly followed this decision before the enactment of the TDRA. *See, e.g.,* *Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*, 2006 U.S. Dist. LEXIS 92550 at *12-13 (W.D. Wash. Dec. 21, 2006) (applying *Moseley*, court dismissed dilution claims because plaintiff failed to show actual harm); *GMC v. Phat Cat Carts, Inc.*, 504 F. Supp. 2d 1278, 1286 (M.D. Fla. 2006) (citing *Moseley*, court found that GM had shown actual dilution of its marks by golf cart company).

³⁰⁰ *Id.* at 433.

³⁰¹ *Id.* at 434.

³⁰² *Id.* This approach would seem to conflate trademark infringement with trademark dilution.

³⁰³ *Id.* at 432; Hofrichter, *supra* note 229, at 1937-38. *See supra* notes 271, 276-80 and accompanying text. *See generally* Smith, *supra* note 225, at 857-60 (in wake of *Moseley*

The enactment of the Trademark Dilution Revision Act of 2006 rebuffed the Supreme Court's *Moseley* decision and sought to clarify conflicting applications of the FTDA.³⁰⁴ The revised Act explicitly recognizes and defines both trademark blurring and tarnishment as actionable forms of dilution.³⁰⁵ Trademark blurring deals with an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark."³⁰⁶ The TDRA also spells out six nonexclusive factors for determining the likelihood of trademark blurring:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in

decision, author urges courts to continue to find tarnishment claims as encompassed under FTDA).

³⁰⁴ Gooderbelt, *supra* note 267, at 269; Hofrichter, *supra* note 229, at 1938-39; Whittaker, *supra* note 253, at 912. In support of revising the FTDA, Anne Gundelfinger, President of the International Trademark Association stated that,

Today, trademark dilution law in the United States is in need of repair. Nine years and hundreds of cases after the FTDA was enacted, virtually everyone—courts, litigants, commentators alike—agree that the law is a mess. While the statute has provided some measure of relief to owners of famous marks, we have split decisions on even the most basic dilution-related questions, a near-complete-lack of agreement or guidance on what it takes to prove dilution. In particular, the Supreme Court's holding in the *Moseley* case requiring proof of actual dilution has undermined the incipency concept that is the heart of dilution protection.

As a result, America's law to protect famous marks is now ambiguous, at best, and, at worst, ineffective.

Trademark Dilution Revision Act of 2005: Hearing Before the Subcomm. On Courts, The Internet, and Intellectual Property of the H. Comm. On the Judiciary: Hearing on H.R. 683, 109 Cong. 6 (2005) (statement of Anne Gundelfinger, President of the International Trademark Association).

³⁰⁵ 15 U.S.C.S. §1125(c)(1) (2006), amended by 15 U.S.C.S §1125(c)(1) (Supp. I 2006). The revised provision states that,

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

§1125(c)(1) . See GILSON, *supra* note 224, at §5A.01[1]-5A.01[2]; Gooderbelt, *supra* note 267, at 269-70; Hofrichter, *supra* note 229, at 1939.

³⁰⁶ 15 U.S.C. §1125(c)(2)(B) (2006).

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substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.³⁰⁷

In contrast to *Moseley*, the TDRA also encompasses trademark tarnishment and states that this form of dilution “is [an] association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”³⁰⁸

Regardless of the form of dilution, the famous mark must possess either inherent or acquired distinctiveness and its fame must be widely-recognized on national basis,³⁰⁹ rather than in niche or local markets.³¹⁰ The TDRA also provides the bases for determining if a mark attains the required degree of national recognition, including the reach of advertising and publicity of the mark, the extent of sales of goods or services bearing the mark, and the actual recognition of the mark.³¹¹ Contrary to *Moseley*, the TDRA does not require a

³⁰⁷ 15 U.S.C. §1125(c)(2)(B)(i-vi) (2006).

³⁰⁸ 15 U.S.C. §1125(c)(2)(C) (2006).

³⁰⁹ 15 U.S.C. §§1125(c)(1)-1125(c)(2)(A) (2006). The modified clause states that “[f]or purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” *Herman Miller, Inc. v. A. Studio s.r.l.*, 79 U.S.P.Q.2D (BNA) 1905, 1909 (W.D. Mich. 2006) (court concluded that Herman Miller had provided sufficient evidence of acquired distinctiveness of its lounge chair design for purposes of trademark and trade dress blurring claims). Some commentators have indicated that this change serves only to strengthen protections for already powerful marks or Supermarks. Hofrichter, *supra* note 229, at 1939-40; GILSON, *supra* note 224, at §5A.01[4][a].

³¹⁰ GILSON, *supra* note 224, at §5A.01[4][c][ii][C]. Protection of fame within a niche or local consumer market which will be left up to state protection. *Id.*; Whittaker, *supra* note 253, at 915. “Plaintiffs with marks that are well-known only locally should note that they might succeed under a state dilution statute. The FTDA does not preempt state anti-dilution statutes.” GILSON, *supra* note 224, at §5A.01[4][c][ii][C]. *See, e.g., Montalto v. Viacom Int’l, Inc.*, 545 F. Supp. 2d 556, 562 (S.D. Miss. 2008) (court dismissed musical artist’s claim of trademark dilution against cable TV program, “The Joe Schmo Show” because he failed to show that his mark, “Joe Shmo” was famous under state dilution statute). *See supra* notes 280, 285 and accompanying text.

³¹¹ 15 U.S.C. §§1125(c)(2)(A)(i)-1125(c)(2)(A)(iv) (2006). The relevant portion of the Act states that, In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

showing of any actual economic harm, only a likelihood of dilution, similar to earlier state statutes.³¹² The TDRA retains the primary remedy of injunctive relief for successful dilution claims with any additional remedies subject to judicial discretion, such as monetary damages for willful dilution.³¹³

Lastly, the revised Act further clarifies the fair use exemption for dilution actions. Seeking to address free speech concerns, the TDRA adds a clause explicitly indicating that if marks are “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner” then there is no actionable claim in dilution.³¹⁴ Although the dilution theories encompassed under the TDRA are criticized for “chilling” free speech,³¹⁵ the revised language clearly seeks to strike a more fair balance between the interests of free speech with the goodwill interests of trademark holders.³¹⁶

In the initial case decided after the enactment of the TDRA, *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*,³¹⁷ the court considered trademark

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- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
 - (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
 - (iii) The extent of actual recognition of the mark.
 - (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

³¹² §1125(c)(1). *See, e.g.,* Starbucks Corp. v. Wolfe’s Borough Coffee, Inc., 559 F. Supp. 2d 472 (S.D.N.Y. 2008) (court found Starbucks’ failed to show likelihood of dilution for its trademark blurring and tarnishment on defendant’s use of “Mr. Charbuck’s” and Mister Charbuck’s” one some of its coffee products); Adidas Am., Inc. v. Payless Shoesource, Inc., 546 F. Supp. 2d 1029, 1061 (D. Or. 2008) (TDRA’s “likelihood of dilution” standard applicable retroactively to adidas’ claims for injunctive relief); Nissan Motor Co. v. Nissan Computer Corp., 2007 U.S. Dist. LEXIS 90487, at *60 (C.D. Cal. Sept. 20, 2007) (Nissan Motor failed to provide sufficient proof of likelihood of dilution of its mark by computer company’s use of domain name, www.nissan.com); The TDRA also retains protections for trade dress subject to proof of fame and nonfunctionality. 15 U.S.C. §§1125(c)(4)(A)-1125(c)(4)(B) (2006). *See GILSON, supra* note 224, at §5A.01[8]. *See supra* notes 240-55 and accompanying text.

³¹³ 15 U.S.C. §1125(c)(5) (2006). *See GILSON, supra* note 224, at §5A.01[8]. *See, e.g.,* Qwest Communs. Int’l v. Sonny Corp., No. C06-0020P 2006 U.S. Dist. LEXIS 87007, at *14 (W.D. Wash. Nov. 30, 2006) (under TDRA, court indicates that Qwest is entitled to injunctive relief with additional remedies available in certain circumstances for dilution of its mark regarding marketing and sales of “Qwesty” plush toys).

³¹⁴ 15 U.S.C. §1125(c)(3)(A)(ii) (2006). *See supra* notes 254, 281-86 and accompanying text.

³¹⁵ *See supra* notes 22, 254 and accompanying text.

³¹⁶ *See infra* notes 318-23 and accompanying text.

³¹⁷ *Louis Vutton Malletier S.A. v. Haute Diggity Dog*, 464 F. Supp. 2d 495 (E.D. Va.

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tarnishment and blurring in connection with a parody of a famous mark.³¹⁸ Louis Vuitton brought various trademark and copyright claims against a company that marketed “Chewy Vuitton” dog toys with an interlinking C and V similar to the Louis Vuitton logo and colors similar to Louis Vuitton’s trade dress.³¹⁹ The court concluded that when “the association is made through harmless or clean puns and parodies. . . . tarnishment is unlikely.”³²⁰ In addition, the court held that considering the strength of Louis Vuitton’s mark that the company’s products are “not likely to be blurred by a parody dog toy product.”³²¹ Other subsequent cases have refused to issue injunctions against parodies, critiques, and commentaries under the TDRA’s expanded fair use exemption.³²²

2006).

³¹⁸ The defendants marketed a parodic line of pet items with names such as, Chewnel # 5, Dog Perignon, and Sniffany & Co. to pet stores. *Id.* at 498-99.

³¹⁹ *Id.* at 497-98. In reviewing Louis Vuitton’s trademark infringement claim, the court noted that Louis Vuitton sold its own luxury line of dog leashes and collars, priced between \$215 and \$1,600, while the defendants’ products were generally under \$10. *Id.* The court found it unlikely that consumers would confuse the junior use with the senior mark and would recognize it as a parody, defeating trademark infringement. *Id.* at 502.

³²⁰ *Id.* at 505. The court could not help itself from using a few puns of its own in beginning the decision, stating that “[t]his ‘dog of a case’ gave the Court a great amount of facts to chew upon and applicable law to sniff out. Nonetheless, having thoroughly gnawed through the record, this Court finds that no material dispute of fact remains, and summary judgment is appropriate on all counts.” *Id.* at 497. The court also invoked parody grounds under copyright law as protecting the defendants from copyright liability. *Id.* at 506-507.

³²¹ *Id.* at 505.

³²² *See, e.g.,* Smith v. Wal-Mart Stores, Inc, 537 F. Supp. 2d 1302, 1340 (N.D. Ga. 2008) (court rejected tarnishment claims against satirist’s parodies of Wal-Mart slogans as protected noncommercial speech); Utah Lighthouse Ministry, Inc. v. Discovery Computing, Inc., 506 F. Supp. 2d 889, 902 (D. Utah 2007) (court found no dilution in noncommercial web site parodies of critics of LDS church); Burnett v. Twentieth Century Fox Film Corp., 491 F. Supp. 2d 962, 974-75 (C. D. Cal. 2007) (court reluctantly refuses to find either trademark blurring or tarnishment in Family Guy episode that parodied Carol Burnett’s famous Charwoman character); GTFM, LLC v. Universal Studios, Inc., 79 U.S.P.Q.2D (BNA) 1213 (S.D.N.Y. 2006) (finding no trademark dilution in brief movie parody of “FUBU” mark). The court in the Burnett case lamented the crudeness of contemporary parody, stating that,

Carol Burnett is an icon in American culture as is her character the “Charwoman.” The Court has no doubt that she is, and rightly so, well known, respected, and beloved by a large segment of the American public based upon her persona and her outstandingly successful entertainment career. The Court fully appreciates how distasteful and offensive the segment is to Ms. Burnett. Debasing the “Charwoman” and also making Ms. Burnett’s parents participants in a crude joke is understandably disheartening to Ms. Burnett, her family, and many fans. To some extent this dispute is indicative of just how far the “new media” has come from the “old media.” The old media harkens

After a careful reading of *Hasbro, Inc. v. Chang*,³²³ it can be inferred that not all parodies will eviscerate the trademark dilution protections of the TDRA. In the *Chang* case, the court enjoined the sale of “Ghettopoly” as an “offensive and racist knock-off of Hasbro’s popular Monopoly game.”³²⁴ Hasbro claimed that sales of the game caused and continued to harm its business reputation and goodwill.³²⁵ Accepting the findings of a magistrate’s report, the court found that the game tarnished the senior mark because “Hasbro . . . received numerous complaints from consumers who are offended by GHETTOPOLY and mistakenly believe that Hasbro is in some manner associated with the game.”³²⁶ The court also enjoined Chang’s use of other similarly offensive names in the sale and distribution of other property games, including “Redneckopoly, Hiphopoly, Hoodopoly, Thugopoly and Latinopoly.”³²⁷

In sum, the evolution of trademark dilution illustrates that harm can be suffered in the absence of actual infringement. A business’ trademarks, goodwill, and reputation are important assets that are deserving of protection, outside of actual consumer confusion or unfair competition between competing business entities. Under the blurring theory, marks can be protected from efforts to use similar marks that impair or free-ride off of a mark’s distinctiveness. Trademarks may also be protected from alteration or disparaging uses that may try to connect the brand with pornographic materials, crude language or humor, unflattering product associations, or illicit drug activities.

Yet, fair use, including a broadened provision encompassing parody,

back to days when crude jokes and insensitive, often mean-spirited, programming was perhaps found in live night club performances but was not present on television. In the new media, any self-imposed restraint essentially has been eliminated. Public figures, such as Ms. Burnett, are frequent targets of parodies and crude innuendo. As Ms. Burnett well knows, it takes far more creative talent to create a character such as the “Charwoman” than to use such characters in a crude parody. Perhaps Ms. Burnett can take some solace in that fact. However, the law, as it must in an open society, provides broad protection for the defendant’s segment.

491 F. Supp. 2d at 974-75.

³²³ CA 03-482 T, 2006 U.S. Dist. Lexis 35529 (D. R.I. May 9, 2006). Although it is unclear if Chang raised any claim of parody before the magistrate, the court did not explicitly address the parody issue in its decision.

³²⁴ *Id.* at *2-5.

³²⁵ *Id.* at *4.

³²⁶ *Id.*

³²⁷ *Id.* at *1-2. The court also affirmed \$400,000 in damages for infringement based upon Chang’s own claims in his deposition about the amount of profit he derived from the sales of the game. *Id.* at *10-12.

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commentary, and critiques, helps to balance defense of the interests of the trademark holder with vital free speech rights. Lastly, upon a showing of a likelihood of harm, the mark holder may seek injunctive relief or other suitable remedies in the court's discretion to protect its mark. It is these basic aspects of trademark dilution that provide the analytical framework for the proposed concept of copyright dilution to protect the rights of attribution and integrity for creative individuals.³²⁸

IV. CONTOURS OF PROPOSED COPYRIGHT DILUTION ACT

Drawing from the field of trademarks, creative individuals and the works they create become the foundation for their individual artistic brand.³²⁹ Like a trademark, a creative person's calling card is her artistic reputation which evinces the quality and distinctiveness of her creative works.³³⁰ If her work is copied by others, which can be done so easily with the tools of the digital age, her distinctive style may be blurred and lose its distinctive power in the commercial marketplace and in the overall marketplace of ideas.³³¹ Similarly, the reputation of an artistic person and her work can be damaged when tarnished through associations with pornography, illegal activities, or other denigrating connections.³³² With the global reach of the Internet, the reputations of creative people can be destroyed worldwide in an instant or her works altered or replicated digitally in a manner that erodes her works' uniqueness over time.³³³ Despite the criticisms of trademark dilution in

³²⁸ See Aoki, *supra* note 31, at 248. Although critical of notions of trademark dilution, Professor Aoki states that,

The expansion of anti-dilution theory allows corporate trademark owners to manage closely their public personas, serving as a distant analog of an individual artist's "moral rights" of attribution and integrity, which protect an artist's work against downstream modification, distortion or mutilation, or a celebrity's right of publicity. Anti-dilution theory, however, is all the more curious because of the complete absence of an explicit authorial figure in trademark law, whose personal (as opposed to economic) interests would be served by protecting a mark from "unauthorized" downstream modifications by non-competing users. (footnotes omitted)

Id. at 246-47.

³²⁹ Bird & Ponte, *supra* note 22, at 281. The authors state that "[b]oth brands and artistic works are creative expressions, the main difference being that brands inherently further a commercial purpose while a painting or musical expression can generate commercial value, but is not inherently commercial in nature." *Id.* See *supra* notes 224-27 & 329 and accompanying text.

³³⁰ See *supra* notes 85-87 and accompanying text.

³³¹ See *supra* notes 234-43 and accompanying text.

³³² See *supra* notes 246-50 and accompanying text.

³³³ See *supra* notes 5-8, 242-43 & 246 and accompanying text. See Lemley, *supra* note 31, at 1693 (although critical of trademark dilution, author indicates that in global economy

academic circles,³³⁴ this statutory cause of action may provide a familiar and acceptable framework for Congress to consider long-overlooked moral rights obligations.³³⁵

The proposed adoption of a Copyright Dilution Act would be a major stride towards safeguarding creative individuals and their creative works in a manner similar to how state and federal anti-dilution statutes protect trademarks and the interests of trademark owners.³³⁶ The proposed law will either amend the Copyright Act³³⁷ and repeal VARA or creating a distinct copyright dilution statute that dramatically revamps the provisions of VARA. Since copyright law is federal, the planned copyright dilution statute would be federal as well,³³⁸ unlike trademark dilution which is a patchwork of federal and state anti-dilution laws.³³⁹ The proposed act borrows from the TDRA, VARA, existing U.S. copyright law, and aspects of the French moral rights code to create a new approach to protecting moral rights that supplements current copyright infringement actions. The proposed law will supplement existing copyright infringement claims and will outline reasonable moral rights parameters to avoid swallowing up existing copyright laws and industry attribution norms.

A. *What Works and Who Will Be Protected under Proposed Copyright Dilution*

The threshold questions under a proposed copyright dilution statute are (1) what creative works will be covered and (2) who will receive its protection. The creative works to be covered will track the creative works protected under existing copyright law, including, but not limited to, music, film, books, electronic publications, video, and other audiovisual works that are creative original works in fixed form.³⁴⁰ Using this approach, moral rights will be

where “the subject matter of commercial transactions becomes more complex and less tangible, reputation becomes more central”).

³³⁴ See *supra* notes 31 and accompanying text.

³³⁵ See *supra* notes 16-20, 28-32 and accompanying text.

³³⁶ Bird & Ponte, *supra* note 22, at 281.

³³⁷ See *supra* note 89 and accompanying text.

³³⁸ See *supra* note 68, 123, 137-39, 200-01, 261 & 311 and accompanying text.

³³⁹ See *supra* notes 68 & 261 and accompanying text.

³⁴¹ 17 U.S.C. § 102 (2006). The statutory provision states that

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;

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placed on a more equal footing with the economic rights embodied in U.S. copyright.³⁴¹ If the Copyright Act is amended to include additional works, then the Copyright Dilution Act will be similarly amended to keep moral rights protections in step with economic-based copyright interests. Borrowing from VARA, a creative individual will have the option of registering her creative work in a Moral Rights Registry.³⁴²

Individual creators of the work, limited to natural persons, may bring an action under copyright dilution. If the creator is also the copyright holder, the copyright dilution claim is an additional legal action aside from infringement, similar to trademark owners who may bring both dilution and infringement claims. Just as a copyright and trademark holder must prove her ownership, a party raising a copyright dilution claim will have the burden of proving that she was the creator or one of the creators of the creative, original work in fixed form.³⁴³

The creators would then be entitled to receive moral rights safeguards as to both attribution and integrity for their creative, original works.³⁴⁴ It is important to note that these notions of attribution and integrity are not intended to vitiate independent creation as to original creative works.³⁴⁵ Copyright

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- (2) musical works, including any accompanying words;
 - (3) dramatic works, including any accompanying music;
 - (4) pantomimes and choreographic works;
 - (5) pictorial, graphic, and sculptural works;
 - (6) motion pictures and other audiovisual works;
 - (7) sound recordings; and
 - (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Id. See Ginsburg, *supra* note 89, at 301 (author calls for all creative works to be covered, including “works made for hire”).

³⁴¹ See *supra* note 341 and accompanying text.

³⁴² See *supra* note 66 and accompanying text.

³⁴³ See *supra* note 265 & 341 and accompanying text.

³⁴⁴ Bird & Ponte, *supra* note 22, at 281.

³⁴⁵ See 1-2 NIMMER ON COPYRIGHT, §§2.01[A], 8.01 [A] (2008) [hereinafter NIMMER].

Prof. Nimmer stated that

Originality in the copyright sense means only that the work owes its origin to the author, *i.e.*, is independently created, and not copied from other works. Therefore, a work is original and may command copyright protection, even if it is completely identical with a prior work, provided it was not copied from such prior work but is rather a product of independent efforts of its author.

Id. See *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345-46 (1991).

dilution would allow creative persons to build upon earlier information, themes, or ideas expressed in a prior work under the idea/expression dichotomy.³⁴⁶ As in copyright infringement, a person need only display a modicum of originality in subsequent works to avoid legal obligations or liability under copyright dilution.³⁴⁷ Since the level of originality is very low in copyright infringement matters, copyright dilution will similarly provide expansive breathing room for creativity.³⁴⁸ Only where there is actual copying, in part or whole, from the earlier work would there be a requirement for appropriate attribution to the original creator or a basis for copyright tarnishment claims for disparaging or damaging associations.³⁴⁹ Therefore, similar to copyright infringement claims, works that are substantially similar, but created independently without copying, would not be legally subject to the

³⁴⁶ See Feist, 499 U.S. at 349-50, 359-60 (in reviewing the idea/expression dichotomy, Supreme Court points to originality, not sweat of the brow, as foundation of copyright); Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 556 (1985) (as regards idea/expression dichotomy, Court notes that “no author may copyright his ideas or the facts he narrates”). See also Heymann, *supra* note 85, at 1444. See Bridgeport Music v. Dimension Films, 383 F.3d 390 (6th Cir. 2004), *aff’d in part, rev’d in part*, 230 F. Supp. 2d 830 (M.D. Tenn. 2002) (appeals court determined that digital sampling of copyrighted song was *per se* infringement). In this music sampling dispute, the district court noted that

[T]he purposes of the copyright laws is to deter wholesale plagiarism of prior works. However, a balance must be struck between protecting an artist’s interests, and depriving other artists of the building blocks of future works. Since the advent of Western music, musicians have freely borrowed themes and ideas from other musicians.

230 F. Supp. 2d at 842. Applying this dichotomy to her concept of authorship and authorial attribution, Prof. Heymann indicates that,

authors would [not] be precluded from borrowing themes, ideas, or even characters from other writers: Leonard Bernstein’s West Side Story need not credit William Shakespeare and Bizet’s Carmen need not credit Prosper M’erim’ee. As with parody, the reader’s understanding of thematic continuity is part of the conceit. It is therefore not likely to be confusing for readers and critics to recognize that the film Clueless echoes Jane Austen’s Emma even though the author fails to make this statement directly. But where a subsequent author adopts the work of a previous author wholesale and passes it off as his own, the passing off is almost certainly not part of the conceit, and attribution is warranted to allow readers to appropriately organize their interpretive reactions. (citations omitted)

Id. See *supra* note 111 and accompanying text. See *infra* note 354 and accompanying text.

³⁴⁷ NIMMER, *supra* note 345, at §2.01[B]. Prof. Nimmer noted that the “quantum of originality” requires only “a scintilla of creativity.” See Feist, 499 U.S. at 349-50, 359-60 (Supreme Court indicates that “level of creativity is extremely low” for finding originality).

³⁴⁸ *Id.* at §2.01[B]. See Eldred v. Ashcroft, 537 U.S. 186, 211 (2003) (Court notes that originality will only not be found where “the creative spark is utterly lacking or is so trivial as to be virtually nonexistent”).

³⁴⁹ NIMMER, *supra* note 345, at §8.01[A].

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demands of copyright attribution or charges of copyright tarnishment. Copyright dilution examples discussed in this article typically involve some form of direct copying and do not tamper with existing copyright notions of originality or independent creation.

For example, in a recent case that impliedly involves a copyright blurring claim, *Satava v. Lowry*,³⁵⁰ a glass artist sought to protect his distinctive creation of jellyfish sculptures and enjoin others who might independently create substantially similar glass-in-glass jellyfish sculptures.³⁵¹ In relying upon the idea/expression dichotomy, the *Satava* court indicated that his works failed to meet the originality requirement needed for copyright as Satava “may not prevent others from copying elements of expression that nature displays for all observers, or that the glass-in-glass medium suggests to all sculptors.”³⁵² Therefore, the court concluded that he could only protect some very limited original contributions he made to his sculptural works.³⁵³ Under the proposed theory of copyright dilution, a similar analytical approach would be applied and would not alter notions of copyright originality or prevent independent creation.

While VARA prevents any post-mortem actions,³⁵⁴ copyright dilution will provide post-mortem rights in accordance with the length of existing copyright protections for individual authors.³⁵⁵ Currently, for works created after

³⁵⁰ *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003).

³⁵¹ *Id.* at 808-09.

³⁵² *Id.* at 812.

³⁵³ *Id.* The court stated that, some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes’ bells. To the extent that these and other artistic choices were not governed by jellyfish physiology or the glass-in-glass medium, they are original elements that Satava theoretically may protect through copyright law. . . . Satava possesses a thin copyright that protects against only virtually identical copying.

³⁵⁴ 17 U.S.C. §106A(d)(2) (2006). The durational provision of VARA states that,

(d) Duration of rights.

(1) With respect to works of visual art created on or after the effective date set forth in section 610(a) of the Visual Artists Rights Act of 1990 [note to this section], the rights conferred by subsection (a) shall endure for a term consisting of the life of the author.

³⁵⁵ See Ginsburg, *supra* note 89, at 302 (author proposes duration of right of attribution for same period as copyright protection). The Berne Convention indicates that these moral rights should last as long as the protection of economic rights in signatory nations, or at a minimum until the death of the creator of the artistic work. Section 2 of Article 6bis states that,

(2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed. However, those countries whose legislation, at the

January 1, 1978, the copyright endures for a term consisting of the life of the author plus seventy years after the author's death, or the last surviving author's death in cases of works with two or more authors.³⁵⁶ Therefore, the progeny of creative individuals may seek to protect the creative artist's post-mortem moral rights for the same length of time that one may protect economic interests under copyright laws.³⁵⁷

Applying these time limits to the earlier Bob Dylan example, the Civil War era poem and slave ballad are clearly beyond the period of copyright protection and will not provide a basis for a copyright dilution claim. However, Muddy Waters died in 1983,³⁵⁸ so the obligation of attribution continues as to the song, "Rollin' and Tumblin'," since the copyright period has yet to expire. In addition, Dylan may still have a professional obligation to attribute the disputed lyrics to these earlier creators under music industry norms or attribution schemes.³⁵⁹

Individual creators of the work, limited to natural persons, may bring an action under copyright dilution. If the creator is also the copyright holder, the copyright dilution claim is an additional legal action aside from infringement, similar to trademark owners who may bring both dilution and infringement claims. Just as copyright and trademark holders must prove their ownership, a party in a copyright dilution claim will have the burden of proving that she was the creator, or one of the creators, of the creative, original work in fixed form in dispute.³⁶⁰

B. *Defining Attribution and Integrity*

As to attribution, the individual creator has a right to receive credit for the authorship of the original creative work as well as the right of misattribution to prevent the use of a creator's name on works that she did not author or create. Appropriate attribution, at minimum the name of the creator, will provide proper designation to the creator and will avoid weakening her distinctive brand or creative style in the marketplace. Although works made for hire will

moment of their ratification of or accession to this Act, does not provide for the protection after the death of the author of all the rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained.

Id. While France offers perpetual moral rights, Germany and the Netherlands end moral rights at the same time as the expiration of copyright. Kwall, *supra* note 15, at 15.

³⁵⁶ 17 U.S.C. at §302 (2006).

³⁵⁷ See *supra* notes 151-64 and accompanying text.

³⁵⁸ Martin and Lisa Adelson, *The Penguin Biographies, Muddy Waters*, 2002, available at <http://www.fleetwoodmac.net/penguin/muddy.htm>.

³⁵⁹ See *supra* notes 100-13 and accompanying text.

³⁶⁰ See *supra* note 265 & 341 and accompanying text.

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not be covered under the new law, copyright dilution is not meant to prescribe or alter existing industry or disciplinary attribution systems.³⁶¹ The new law will provide a legal basis for action that will supplement without preempting existing attribution schemes.³⁶²

Under the right of integrity, the creative person will have the right to protect her work from distortion, mutilation, or other uses that will harm her honor or reputation. The right of integrity will help a creative individual to stop alteration, distortion, or destruction of her distinctive creative work or to prohibit presentation of her work in derogatory manner.³⁶³

Federal trademark dilution requires national fame while state anti-dilution laws prevent harm to creative individuals in niche or local markets. Unlike trademark law, copyright law is applied nationally and preempts state actions. Thus, the new law will be enacted as federal statute and capture the moral rights interest of both national and local artists and authors. In light of this approach, copyright dilution will address distinctive creative works, returning to Professor Schechter's earlier proposal, rather than famous ones under the TDRA.³⁶⁴ Proof of creation and distinctive quality can be derived from a variety of sources, including, but not limited to, expert or witness testimony, documents, surveys, contracts, or copyright or moral rights registration.³⁶⁵

A creative individual may vindicate her moral rights to distinctive creative works through copyright dilution actions for copyright blurring or copyright tarnishment.³⁶⁶ Following from earlier state statutes and the TDRA, the standard of proof for either cause of action is the likelihood of harm – not actual economic injury.³⁶⁷ In bringing these claims, the primary remedy will remain injunctive relief as in trademark dilution cases.³⁶⁸ The individual, however, may seek damages in cases of willful dilution and other remedies deemed appropriate in a court's discretion.³⁶⁹

Borrowing from the TDRA's text on trademark dilution, copyright blurring would be defined as "an association arising from copying by a junior creative work of a senior creative work that impairs the distinctiveness of the senior

³⁶¹ See *supra* notes 100-13 and accompanying text.

³⁶² See Fisk, *supra* note 82, at 73-76 (author calls for six factors of transparency, participation, equality, due process, efficiency, and substantive fairness in assessment of attribution schemes and in judicial evaluation of right of attribution contractual claims).

³⁶³ See *supra* notes 144-81 and accompanying text.

³⁶⁴ See *supra* notes 234-38 and accompanying text.

³⁶⁵ See Bird & Ponte, *supra* note 22, at 281.

³⁶⁶ See Bird & Ponte, *supra* note 22, at 281.

³⁶⁷ See *supra* notes 244 & 313 and accompanying text.

³⁶⁸ See *supra* note 314 and accompanying text.

³⁶⁹ See *supra* notes 314 and accompanying text. See Ginsburg, *supra* note 89, at 306 (calling for injunctive relief and monetary damages for violations of right of attribution).

creative work.”³⁷⁰ This action will serve to insure proper attribution and protect an artist’s distinctive work or brand in the marketplace from appropriation and will help prevent misattribution of an individual’s creative efforts.³⁷¹

Courts may consider the following nonexclusive factors for determining the likelihood of copyright blurring, drawn from the TDRA, including, but not limited to, (1) the degree of inherent or acquired distinctiveness of the senior creative work; (2) the degree of recognition of the distinctive senior creative work in a local or national marketplace; (3) whether the user of the junior creative work intended to create an association with the senior distinctive work; and (4) any actual association created between the junior creative work and the senior creative work.³⁷²

Copyright tarnishment will be defined as “an association arising from the copying by a junior creative work of a distinctive senior creative work or the distortion, mutilation or other use of a distinctive senior creative work that harms the reputation or goodwill of the creator(s) of the senior creative work.”³⁷³ This tarnishment approach will primarily address claims of violations of one’s moral right of integrity and apply to both physical distortion and contextual claims.³⁷⁴

C. Other Reasonable Limits on Copyright Dilution

Reasonable limits are needed as some legal experts might become concerned about a costly and time-consuming stampede of cases if this new theory is recognized. First, the proposed Copyright Dilution Act will apply prospectively, since the protection of moral rights for a wide range of creative works has not been previously recognized in law nor contemplated in earlier commercial agreements.³⁷⁵ Therefore, to prevent chaos in the intellectual property marketplace, creative individuals will only be allowed to bring actions against future abuses of their moral rights.³⁷⁶ Furthermore, with prospective

³⁷⁰ See *supra* note 302 and accompanying text.

³⁷¹ See Bird & Ponte, *supra* note 22, at 281.

³⁷² See *supra* note 303 and accompanying text.

³⁷³ See *supra* note 304 and accompanying text.

³⁷⁴ See Bird & Ponte, *supra* note 22, at 281.

³⁷⁵ See *supra* note 22 and accompanying text. The courts were divided over whether or not relief from trademark dilution should be applied only prospectively or retroactively to continuing conduct that occurred prior to the passage of the TDRA. GILSON, *supra* note 224, at §5A.01[10].

³⁷⁶ See *supra* note 22 and accompanying text. See also Ian Eagles & Louise Longdin, *Technological Creativity and Moral Rights: A Comparative Perspective*, 12 INT’L J.L. & INFO. TECH. 209, 221 (2004). In the software environment, Professors Eagles and Longdin state that “it is the fear that software creators will use any moral rights that they are awarded

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application of copyright dilution, future artistic persons can directly copy or borrow from centuries of earlier creative works without being subject to copyright dilution claims.

Second, a creative person may try to block parodies or critiques of their creative work, which often disparage, ridicule, or condemn an earlier work.³⁷⁷ To avoid concerns about the development of private censorship through the exercise of an “aesthetic veto,”³⁷⁸ the new copyright dilution law will apply the fair use exemption used in copyright infringement cases.³⁷⁹ Parodies, critiques,

to disrupt the orderly development of, and investment in, technology markets or renegotiate economic rights which they have ceded away (or which by virtue of their employment they never had) which has fuelled the hostility and suspicion with which copyright owners and their financial backers tend to approach such rights.” *Id.*

³⁷⁷ See Heide, *supra* note 5, at 225; Yonover, *supra* note 45, at 103-04. Prof. Yonover indicated that,

[p]arody, by its very nature, smacks of irreverence. . . [A] parody is almost always quasi-revolutionary in concept, and rarely is it a loving, respectful, or deferential use of the underlying work. . . . Indeed, the authors of a leading copyright casebook note that a licensed parody is oxymoronic. To obtain permission from an artist who may assert personal, moral rights would seem to be virtually impossible. Further, we may well wonder how parody could function effectively as commentary and critique if the authority to satirize, criticize, ridicule, or jibe is given. Permission connotes approval - few parodists wish that blessing, and few artists whose moral rights of integrity are at risk would wish that curse.

Yonover, *supra* note 45, at 103-04 (footnotes omitted). Some legal scholars contend that parodies should not require attribution since the effectiveness of the parody is its ability to comment on the earlier work without attribution. Heymann, *supra* note 85, at 1443; Tushnet, *supra* note 89, at 810-11. Yet, determining what constitutes a parody is “not always perfect, thus rendering the line between ‘parody’ and ‘misappropriation’ (or even ‘hoax’) somewhat hazy.” Heymann, *supra* note 85, at 1443, n. 210.

³⁷⁸ Settlemeyer, *supra* note 22, at 2309-10.

³⁷⁹ 17 U.S.C. § 107 (2006). The fair use provision states that,

[n]otwithstanding the provisions of sections 106 and 106A [17 USC §§ 106 and 106A], the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include- -

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the

commentaries, news reporting, educational, and scholarly research will be exempt from copyright dilution actions in the same manner as in copyright infringement cases.³⁸⁰

Under the French moral rights code, a creator may not abuse her exercise of moral rights, with the courts being the assessor of the reasonableness of the creator's claims.³⁸¹ Therefore, courts will apply a reasonableness standard in determining cases of attribution and integrity.³⁸² However, if the creative individual can prove copying, mutilation, or distortion of the creative, original work or the other party admits to such conduct, the notion of *de minimis* copying will not be allowed to rescue the offending party from a copyright dilution claim. This approach will maintain a balance between fair use and standards of reasonableness imposed on the creator with the duty placed on a third party not to copy another's work without attribution or alter or distort another's work in a manner that tarnishes a creative person's distinctive brand. Some courts already disregard the notion of *de minimis* when actual copying has occurred finding *per se* infringement.³⁸³ Following the bright line rule of *Bridgeport Music* and *Upright Music*, any actual copying from or manipulations or distortions of a creative, original work could provide the basis for copyright dilution claim. Providing attribution to one whose work you have copied is not an onerous burden. In addition, the creative individual raising a copyright dilution claim would still need to show how the copying, even in small amounts, actually harmed her reputation or brand to succeed under a copyright tarnishment action.

copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

Id. See, e.g., Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 587-88 (1994) (Court determined 2LiveCrew's parody of Roy Orbison's classic song, *Pretty Woman*, as fair use despite substantial copying of distinctive guitar riff and revision of song's lyrics); Fisher v. Dees, 794 F.2d 432, 434 n.2 (9th Cir. 1986) (court found fair use in copying six of the thirty-eight bars of 1950s song, *When Sunny Gets Blue* for parody entitled, *When Sonny Sniffs Glue*); MCA, Inc. v. Wilson, 677 F.2d 180, 185 (2d Cir. 1981) (cabaret show's song *Cunnilingus Champion of Company C* was not parody of *Boogie Woogie Bugle Boy of Company C* and, therefore, not fair use); Elsmere Music, Inc. v. Nat'l Broad. Co., 482 F. Supp. 741, 747 (S.D.N.Y. 1980) (parody of *I Love New York* jingle in song, *I Love Sodom*, in Saturday Night Live skit is fair use).

³⁸⁰ See *supra* notes 315-23 and accompanying text.

³⁸¹ Heide, *supra* note 5, at 247-48. See *supra* note 367 and accompanying text.

³⁸² Bird & Ponte, *supra* note 22, at 230, 233, 241. See Ginsburg, *supra* note 89, at 303-04 (author suggests use of Australian standard that puts burden on party using creative work to show reasonableness).

³⁸³ See *supra* note 347 and accompanying text.

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Third, it is important to note that “works made for hire,”³⁸⁴ created in the employment relationship, or through a specific commission as an independent contractor, will not be covered works under copyright dilution.³⁸⁵ Traditional moral rights apply only to an individual’s creative output and not to the creative efforts of corporations or businesses.³⁸⁶ In part, the incentive function of creativity is already met through company salaries and employment or commission compensation for independent contractors which will promote continued creativity.³⁸⁷ Secondly, creativity within the confines of

³⁸⁴ 17 U. S. C. §101 (2006). The relevant portion states that,

A “work made for hire” is—

- (1) a work prepared by an employee within the scope of his or her employment; or
- (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a “supplementary work” is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an “instructional text” is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

Id.

³⁸⁵ Such works are currently excluded from the provisions of VARA. *See supra* notes 67-68 and accompanying text. *But see* Ginsburg, *supra* note 89, at 301-02 (author calls for inclusion of works for hire under right of attribution); Fiske, *supra* note 82, at 111-12 (author seeks attribution rights in every employment agreement, subject to waiver).

³⁸⁶ *See* Antezana, *supra* note 15, at 421. Under the personality theory, “[o]nly individuals can be “creators;” companies and organizations *per se* cannot be “creators” because they lack the (essential) “person” in “personality.” *Id.* *See also* Pink *supra* note 15, at 183 (author discusses Canada’s “natural person” approach to moral rights). *See supra* note 49 and accompanying text.

³⁸⁷ Despite calling for a legal right to attribution for “works made for hire,” Professor Fisk does recognize that,

Even today, it is widely recognized that the reward function of attribution underpins the system of corporate ownership of workplace knowledge. The economic critique of employee ownership of workplace intellectual property rests on the contention that individuals do not need the incentive of intellectual property ownership because lucrative employment provides sufficient incentive. Thus, the argument goes, the reward function of intellectual property ownership is most efficiently allocated to the firm. The analysis rests on the assumption that the inventive employee will at least be credited with the invention so that his employment will be lucrative in proportion to his creativity and, thus, the incentive to invent will remain.

Fiske, *supra* note 82, at 60.

employment or independent contractor relationship reflects a corporation's agenda or economic goals and not individual self-expression or personality intended to be sheltered under moral rights.³⁸⁸ Lastly, once copyright dilution has been initially implemented, then it can be determined whether moral rights should be extended further to works made for hire.

Fourth, the issue of contractual waivers of moral rights is a difficult, but necessary, limitation. In enacting VARA, Congress realized that waivers could undermine moral rights protections due to the generally weak bargaining position of most artists in the commercial marketplace.³⁸⁹ Similar to VARA, blanket waivers will not be permitted under the new law to avoid defeating an individual's moral rights.³⁹⁰ Also similar to VARA, under the new law, a creative person will be free to provide limited waivers of her moral rights, just not blanket ones.³⁹¹ Unlike VARA, all joint authors or creators must waive their moral rights to a creative work to avoid dilution issues and one creator may not waive rights for all.³⁹² The limited waivers must be in a signed writing, identifying the particular work, indicating the specific planned uses of the work and the rights to be waived,³⁹³ and providing satisfactory compensation for the rights waived.³⁹⁴ Uses outside the stated purposes in the

³⁸⁸ See Heymann, *supra* note 85, at 1393-94. See *supra* notes 44-49 and accompanying text.

³⁸⁹ Alexander, *supra* note 73, at 1490-91; Chang, *supra* note 73, at 132. Congress mandated that the U.S. Copyright Office undertake a study of the waiver issue in 1995. Alexander, *supra* note 73, at 1490-91; Chang, *supra* note 73, at 132. The eventual waiver report was "inconclusive" as to its impact on artists' moral rights and no subsequent Copyright Office study was undertaken. Chang, *supra* note 73, at 132. Congress never revisited the VARA waiver issues since the results of the 1995 survey. *Id.* at 138.

³⁹⁰ 17 U.S.C. at §106A(e)(1) (2006). The relevant portion of VARA states that,
(e) Transfer and waiver.

(1) The rights conferred by subsection (a) may not be transferred, but those rights may be waived if the author expressly agrees to such waiver in a written instrument signed by the author. Such instrument shall specifically identify the work, and uses of that work, to which the waiver applies, and the waiver shall apply only to the work and uses so identified. In the case of a joint work prepared by two or more authors, a waiver of rights under this paragraph made by one such author waives such rights for all such authors.

Id.

³⁹¹ *Id.* See Fisk, *supra* note 82, at 111-12 (author proposes allowing waivers provided that process is fair and compensation is adequate); Ginsburg, *supra* note 89, at 305 (calling for limited narrow waivers as found under Australian law).

³⁹² *Id.* See generally Sherman, *supra* note 15, at 416-29 (discussing various waiver provisions in detail and proposes uniform waiver clauses under VARA).

³⁹³ See 17 U.S.C. §106A(e)(1) (2006); Ginsburg, *supra* note 89, at 305.

³⁹⁴ See Fisk, *supra* note 82, at 112.

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waiver would give rise to potential claims in copyright dilution or contractual actions to safeguard moral rights.

D. Applying the Proposed Theory to Case Examples

Applying the copyright dilution concept to several earlier examples will help to illustrate its potential value for creative individuals. In the instance of Google's use of Miró's artistic style in its logo, his heirs could bring post-mortem claims of both copyright dilution and blurring. If it is determined that Google copied all or part of a Miró painting, then copyright dilution would apply. Since the artist died in 1983, his heirs will be able to bring a copyright blurring action within the time limits of copyright safeguards.³⁹⁵ An art historian's testimony and the value of Miró's paintings in private collections and museums will show the international degree of inherent or acquired distinctiveness of his senior creative works. In trying to mimic Miró's artistry on its web page, there is a high and intended degree of similarity between Google's junior creative work and Miró's distinctive senior creative work. In addition, Google admitted that it intended to actually create an association between its logo and Miró's senior distinctive work. Therefore, the heirs may seek injunctive relief against Google (if the company had not already removed the junior work from its site) and other relief a court would deem appropriate.

In the Carl Perkins example, one may apply to copyright tarnishment in a contextual claim. In that situation, the composer did not hold the copyright to the sound recording of "Honey Don't." Yet he claimed that its use in the *Prince of Tides* scene of child rape, harmed his reputation as a musician and a child abuse prevention advocate.³⁹⁶ Clearly, the film copied a portion of the song for the scene, so copyright dilution could be used to protect Perkins's moral rights. He may bring a copyright tarnishment action, seeking to enjoin the use of that song in the movie, because it associated him and his music with a violent crime against a child. The court would then need to review his claims under standards of reasonableness. A court would also have to examine whether the use of the music falls within notions of protected social commentary, and therefore be exempt from a copyright dilution claim under fair use. A court must balance the fair use exemption with the reasonableness of his tarnishment claim.

Taking the example of the *Newton* case, one can see how a copyright dilution claim might proceed under both blurring and tarnishment.³⁹⁷ In the above-cited *Newton* case, the renowned flutist, was the undisputed creator of the composition and performance of the music that had been digitally sampled.

³⁹⁵ See *supra* notes 151-52 and accompanying text.

³⁹⁶ See *supra* notes 222-23 and accompanying text.

³⁹⁷ See *supra* notes 211-18 and accompanying text.

Although he did not own the copyright to the sound recording, he did retain his moral rights to the creative work, both his composition and musical performance.

Newton may assert a copyright blurring claim, as the disputed sample of his music was copied from his performance and looped over forty times in the song. Through expert testimony of a musicologist and professional records, he could provide evidence of the degree of inherent or acquired distinctiveness of his senior creative work and the distinctive nature of his innovative jazz flute-playing. He can also point to his numerous accolades, prestigious awards, and fellowships to show the degree of recognition of his distinctive work on a national basis.

These factors, however, must be weighed against other elements that favor the Beastie Boys. First, the degree of similarity is low between the junior creative work, a rap song, and the senior creative work, an improvisational jazz composition. Secondly, it is unlikely that the Beastie Boys either intended or actually created an association between their song and Newton's distinctive jazz composition. Furthermore, applying standards of reasonableness, Newton would be unlikely to bring an effective action in blurring. First, he did receive attribution on the Beastie Boys compact disc so it would be difficult to argue that the group intended to take credit for his senior work, blurring its value in the marketplace. Second, the digital sample does not impair the overall distinctive nature of his music since its unique qualities led the group to choose the sample.

Newton may have a stronger claim under copyright tarnishment, looking at both physical distortion and contextual associations that harm his reputation. The Beastie Boys distorted the tone and tempo of his work and then looped the altered samples throughout their song. The change in the sample does not destroy the recording in any permanent way. He may, however, be able to succeed if he can reasonably show that their graphic music was inconsistent with his Christian values that inspired the original song and harmed his reputation as a serious jazz artist. Since the Beastie Boys were not using the sample for purposes of a parody or for noncommercial purposes, the fair use exemption may not provide an adequate defense. Newton may seek to enjoin their use of his music or other seek other remedies that the court deemed appropriate.

In the *Laws* case, however, the plaintiff would likely fail under both copyright blurring and tarnishment.³⁹⁸ Laws, whose voice was copied and looped through another song, did receive attribution for the digital sample contained in the newer song, as did Newton. In her suit, she did not claim that the use of the digital sample harmed the distinctiveness of her music or that her music was altered in a manner that harmed her reputation within the industry.

³⁹⁸ See *supra* notes 202-06.

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Rather, her legal action centered primarily on the failure of Elektra Records to seek her prior consent and to share royalties from the hit song that sampled her music. While she might retain a contractual action against Elektra records, she is unlikely to prevail under a copyright dilution claim.³⁹⁹

These examples illustrate different outcomes that may be achieved through copyright blurring and tarnishment. Creative individuals may not succeed in very case, just as trademark holders do not automatically prevail in their dilution actions. However, this proposal provides an opportunity to broaden the protections of moral rights and to permit artists to safeguard their reputations and creative works in a manner similar to trademark holders.

V. CONCLUSION

The identity of the creator and her creative works form the basis of an individual's artistic reputation. The creative person's brand provides consumers with evidence of the quality and distinctiveness of her creative works. In a digital environment, it is dramatically easier to copy or manipulate the distinctive works of others, weakening the distinctive character of creative works and tarnishing reputations and creative works through associations with pornography, illegal activities, or other denigrating connections. With the Internet's global reach, the reputation of a creative person may be destroyed worldwide in an instant or her works altered or replicated digitally in a manner that erodes her work's unique qualities over longer periods of time.

The U.S. has long ignored its moral rights obligations of attribution and integrity. While Congress has enacted statutes to protect the brands and goodwill of trademark holders, a similar set of protections, grounded in moral rights, should protect creative individuals. Theories of copyright blurring and tarnishment will provide options to safeguard the moral rights of attribution and integrity in instances where a third party has copied or manipulated or altered an original creative work. The inclusion of a fair use exemption, standards of reasonableness, post-mortem rights based on copyright, options for limited contractual waivers, and prospective application of the law provide appropriate limitations on these actions. The proposed legal theory of copyright dilution does not ensure that creative individuals will always win their cases for blurring and tarnishment. Instead, this approach permits creators to be placed on a more equal footing with copyright holders, and provides creative people with the opportunity to protect their reputation or brands in a manner similar to trademark owners. As we enter an era of increased open content sites and seemingly endless opportunities for digital exploitation, the time has come for copyright dilution to safeguard the moral

³⁹⁹ See *supra* notes 197-201 and accompanying text.

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rights of creative people.