

Texas Intellectual Property Law Journal
Spring, 1997

Note

COPYRIGHT AND TRADEMARK: ARE THEY TOO SUBSTANTIALLY SIMILAR FOR LITERARY WORKS?

Jim Jubinsky^a

Copyright (c) 1997 by the State Bar of Texas, Intellectual Property Law Section; Jim Jubinsky

I. Introduction

There are three main branches of intellectual property law: patents, copyrights and trademarks. Patent law grants patentees the right to exclude others from making, using or selling their patented inventions. Copyright law grants authors or artists the right to prohibit copying of their works. Trademark law grants owners the right to prevent the use of similar marks on goods or services that would likely cause confusion to the consumer. Thus, the scope of each branch of intellectual property law is defined quite differently.

Recent decisions have reduced the difference between copyright and trademark law by using the copyright doctrines of “originality” and “substantial similarity” in trademark cases. The Second Circuit in *Waldman Publishing Corp. v. Landoll, Inc.*,¹ extended the reach of trademark law into the realm of literary works, which has traditionally been the subject of copyright law. The purpose of this Note is to *390 discuss *Waldman* and its implications for intellectual property law,² to review how other circuits have analyzed similar cases,³ and finally to demonstrate that copyright protection should be the exclusive remedy for cases involving literary or creative works.⁴

II. Purpose of Copyright and Trademark Law

The purpose of copyright law is to protect “original works of authorship fixed in any tangible medium of expression.”⁵ Works of authorship include literary, musical, dramatic, pantomime, choreographic, pictorial, graphic, sculptural, motion picture, sound recording, and architectural works.⁶ Protection of copyright is based in the Constitution wherein the founding fathers attempted to promote the useful arts by securing for authors a limited time of exclusivity in their writings.⁷ Copyright infringement requires the copying of a protected work or, in the absence of exact copying, requires proof of both substantial similarity and access to the copyrighted work.⁸ For a work to be protected by copyright, it must entail some amount of originality and a minimal amount of creativity.⁹

Trademark law, on the other hand, does not protect originality or creativity: it protects identifying symbols or marks.¹⁰ The purpose of trademark law is to protect the goodwill of the mark owner who, by use and advertising, creates in the mind of the consumer a link between the mark and the producer.¹¹ Trademark law prevents the use of confusingly similar marks on similar or related goods and services of others, thus giving the consumer a chance to decide whether to purchase the same or similar products from the same company in the future. The standard for infringement of a trademark is whether use of a similar mark would create a *391 likelihood of confusion.¹² A trademark may be registered,¹³ but unregistered trademarks are also protected.¹⁴ Section 43(a) of the Lanham Act, which has seen an explosion in the kinds of actions brought under its provisions since 1954,¹⁵ was considered by the court in *Waldman*.

III. *Waldman Publishing Corp. v. Landoll, Inc.*

In *Waldman*, the plaintiff published a series of children’s books based on adaptations of public literary classics, including *Oliver Twist*, *Robin Hood*, *Black Beauty*, and *David Copperfield*.¹⁶ The adaptations were abbreviated versions of the original works and were written in simplified language to make them more appealing to young children.¹⁷ *Waldman Publishing Corp.*

(Waldman) contracted writers to adapt the text and credited the authors in the front of each book, including a copyright notice on behalf of itself and its distributor, Playmore.¹⁸

Landoll, the defendant, also published children's books and began selling adaptations of the same literary classics as Waldman.¹⁹ Landoll's books were not exact copies of Waldman's, and it was undisputed that the cover designs were not confusingly similar.²⁰ The district court found, however, that Landoll's arrangement of the chapters, written text, and illustrations closely followed Waldman's books.²¹ Landoll received its adaptations from an independent publisher and accredited both the writer and the illustrator in each book.²² Landoll displayed its logo on each work and also had a copyright notice on behalf of itself on the front cover of each work.²³

***392** Waldman filed suit and asked for a preliminary injunction claiming that Landoll's conduct violated section 43(a) of the Lanham Act, since Landoll's books entered into the stream of commerce with a false designation of origin.²⁴ Waldman alleged that the designation of origin was false because purchasers of the books would likely think that the books originated with Landoll, when, in fact, they originated with Waldman.²⁵ However, since Waldman did not register its works with the Copyright Office, it could not bring a copyright suit.²⁶

Indeed, one of Landoll's defenses was that it could not be held liable for copying Waldman's books because Waldman had not registered its copyright.²⁷ The Second Circuit rejected that argument by stating that section 43(a) of the Lanham Act recognizes reverse passing off, and reverse passing off in a written context involves the misappropriation of credit properly belonging to the original creator of the work.²⁸

The court stated that Landoll could be held liable under section 43(a) if Waldman's books were original enough to raise a "false designation of origin" problem, or if Landoll's books were similar enough to constitute false labeling.²⁹ ***393** Under both theories, the Second Circuit used copyright analysis to determine that Landoll's conduct did indeed violate section 43(a).³⁰ The court reasoned that the adaptation of the original works—which consisted of editorial revisions, elaborations, and other modifications—was sufficient to meet the test for originality under copyright law.³¹

The court also used the substantial similarity test to determine whether Landoll's failure to credit Waldman amounted to a false designation of origin.³² The court reasoned that since there was minimal difference between the versions, and since Landoll had access to Waldman's texts, Landoll must have copied Waldman's books.³³ As a result, the court concluded that Landoll's books were falsely designated.³⁴

Section 43(a) also requires a likelihood of confusion, and the appellate court concurred with the district court that consumers would likely be confused by Landoll's misrepresentation as to the source of the books.³⁵ The district court found that consumers, especially those who buy children's books, would be deceived by Landoll's marketing.³⁶ No further inquiry into likelihood of confusion appears to have been necessary.³⁷

The appellate court, however, vacated the district court's injunction that prohibited Landoll from publishing and selling any books that were substantially similar to Waldman's books.³⁸ In support of its decision, the appellate court noted that since Landoll could only be enjoined for violating section 43(a) of the Lanham ***394** Act, it could only be enjoined from falsely representing the source of the books.³⁹ Hence, Landoll could publish as long as it properly credited the books' authors.⁴⁰

IV. Approaches Taken by Other Circuits

The Ninth Circuit's approach to Lanham Act violations in these types of cases is quite distinct from the Second Circuit's approach. Instead of using the substantial similarity test for determining whether there has been a false designation of origin, the Ninth Circuit uses "bodily appropriation."⁴¹

In *Shaw v. Lindheim*,⁴² the plaintiff sued for copyright infringement and for violation of state unfair trade practice law, claiming that the defendant used the plaintiff's pilot script as the basis for his own television show.⁴³ The Ninth Circuit reversed the summary judgment of non-infringement of copyright because the plaintiff had supplied enough evidence of substantial similarity to present a triable issue of fact.⁴⁴ However, the appellate court sustained the district court decision with regard to the Lanham Act claim, stating that the work must be bodily appropriated to create a likelihood of confusion in reverse passing off cases.⁴⁵ The court also showed its disfavor toward recognizing Lanham Act claims in literary misappropriation cases: "We decline to expand the scope of the Lanham Act to cover cases in which the Federal Copyright

Act provides an adequate remedy.”⁴⁶

In *Roho, Inc. v. Marquis*,⁴⁷ the Fifth Circuit appeared to use a standard similar to that used by the Ninth Circuit. In this case, the defendant removed the labels from certain wheelchair cushions that he purchased, and subsequently used them to make *395 mattresses in direct competition with the plaintiff’s products.⁴⁸ The plaintiff claimed that the defendant’s conduct constituted both reverse passing off and a false designation of origin.⁴⁹ The Fifth Circuit ruled that reverse passing off only involves products that are slightly modified, and since the defendant made substantial changes to the cushions that resulted in a different marketed product, there was no likelihood of confusion.⁵⁰ Although the *Roho* case did not involve copyrightable subject matter, the standard for reverse passing off suggests the Fifth Circuit will treat such cases similar to the Ninth Circuit.⁵¹

Even though the Fifth and Ninth Circuits appear to be in conflict with the Second Circuit, some of the remaining circuits tend to follow a much more lenient approach in their Lanham Act analyses when dealing with literary or creative works. In particular, the Third, Tenth, and Eleventh Circuits tend to align themselves more closely with the Second Circuit.

For example, the Tenth Circuit upheld a temporary injunction against a greeting card manufacturer because the manufacturer took the overall look of the plaintiff’s cards.⁵² The court relied on trade dress under section 43(a) of the Lanham Act in accepting the district court’s decision that the overall design was non-functional because other alternatives were available.⁵³ The appellate court explicitly *396 rejected the arguments that this decision conflicted with the policy of copyright law and gave the plaintiff exclusive rights in a concept, idea, or theme of expression.⁵⁴

An Eleventh Circuit opinion involved the making and selling of soft-sculptured dolls with adoption papers.⁵⁵ The appellate court affirmed the decision that the defendant had infringed the plaintiff’s copyright.⁵⁶ The court also upheld a finding that the defendant had violated the Lanham Act, since the defendant’s dolls were similar to the plaintiff’s and since there were so many alternate ways to market those goods.⁵⁷ The Eleventh Circuit noted that courts should look with suspicion upon businessmen who dress their goods to look like a competitor’s in an effort to confuse the public.⁵⁸

In another case from the Eleventh Circuit, *Campbell v. Osmond*,⁵⁹ the United States District Court for the Middle District of Florida explicitly rejected the bodily appropriation approach of *Shaw* and accepted the substantial similarity test of *Waldman*.⁶⁰ In *Campbell*, the plaintiff sued the defendant for commercializing two doll head sculptures that the plaintiff gave to an agent of the defendant for non-commercial purposes.⁶¹ As one of its defenses, the defendant argued that, in the absence of bodily appropriation, copyright protection should be the plaintiff’s sole remedy since any Lanham Act claim would be automatically “subsumed” into the copyright claim.⁶² The district court rejected this defense, stating that the damages attributable to consumer confusion are separate from copyright damages.⁶³

*397 In *American Greetings Corp. v. Dan-Dee Imports, Inc.*,⁶⁴ the Third Circuit decided a case involving teddy bears depicting “tummy graphics.”⁶⁵ Examples of the tummy graphics included a heart symbolizing love and caring, a smiling sun indicating fun and laughter, and a four leaf clover signifying good luck.⁶⁶ The appellate court held that the district court did not clearly err in finding that the tummy graphics were functional.⁶⁷ The appellate court went on to hold that the defendant could not be prohibited from marketing similar teddy bears unless there was no other way to market tummy graphics without causing a likelihood of confusion.⁶⁸ Essentially, the court did not want to give the plaintiff a monopoly on the use of tummy graphics in connection with teddy bears.⁶⁹

The Sixth, Seventh and Eighth Circuits have also addressed cases involving both Lanham Act and copyright law issues. However, because these cases did not find substantial similarity, one cannot compare them easily with the Second, Fifth, and Ninth Circuit approaches.⁷⁰

398 V. Criticisms of the Second Circuit’s Decision in *Waldman

The Second Circuit’s decision in *Waldman* not only severely encroaches on copyright law, it makes the Copyright Act surplusage for literary works since the *Waldman* court used the traditional copyright tests of originality and substantial similarity to find a false designation of origin needed for a violation of the Lanham Act. In so doing, the *Waldman* court acted contrary to Supreme Court precedent, which has historically disfavored the transfer and application of legal doctrine from one area of intellectual property law to another.⁷¹ Also, *Waldman* appears to disregard the likelihood of confusion requirement by indicating that likelihood of confusion is automatically established where the defendant falsely designates the

origin of a good.

The *Waldman* decision allows every plaintiff to include a Lanham Act claim when there is a copyright claim. Since the Second Circuit's tests for trademark and copyright infringement are the same, a defendant found liable under copyright law would automatically be liable under trademark law. However, the potential copyright defendant faces a dilemma in attempting to avoid both trademark and copyright infringement. If a defendant tries to credit a person on the work to avoid trademark infringement, he would automatically create copyright liability by acknowledging that he copied another's work. Thus, this kind of admission would almost never occur.

The *Waldman* court only gives a short discussion on the likelihood of confusion. Intuitively, there would be a small likelihood of confusion if the covers of the works at issue—as was admitted by both parties—were not similar. The only way a consumer might be confused is by opening the covers of both works and comparing the literary material within. However, it is unlikely that the average consumer would make that kind of comparison.

In order to prove that a mark is protectable the plaintiff's mark must either have secondary meaning, or be inherently distinctive.⁷² The defendant in *Waldman* argued that since Waldman's books were neither inherently distinctive nor had secondary meaning, the district court had misapplied trademark law.⁷³ However, the Second Circuit rejected this argument, noting that it was Waldman's own lack of distinctiveness and secondary meaning that would mislead consumers into believing that Landoll's books actually originated with Landoll and not Waldman.⁷⁴ This *399 decision appears to contradict established case law because inherent distinctiveness or secondary meaning would no longer be required for trademark protection.⁷⁵

The *Waldman* decision runs counter to the purpose of trademark law in other respects. One of the primary purposes of trademark and trade dress law is to protect the goodwill of the company that invests in the mark or trade dress.⁷⁶ In essence, trademark law prevents one producer from using another's mark or trade dress to sell its own goods.⁷⁷ This kind of appropriation did not occur in *Waldman* because Landoll used its own mark, and the covers were not confusingly similar. Trademark law is also designed to protect consumers from shoddy merchandise by allowing them the option of complaining to the company that sold the defective product, or deciding not to buy that company's product in the future.⁷⁸ Again, since Landoll used its own mark, consumers would almost certainly approach Landoll if the product were deemed defective. The Second Circuit decision does not protect Waldman's goodwill because, as Waldman admitted, consumers did not know about Waldman's product or its name.⁷⁹

The Second Circuit had good reason to protect Waldman: the court wanted to protect the plaintiff's creative product against plagiarism. However, there are other laws to protect against that kind of inequitable conduct.⁸⁰ The trademark laws are not designed to protect creativity per se. For example, use of a highly creative mark can be limited if another registers the same mark with the Patent and Trademark Office, even though that registrant was not the original creator.⁸¹ Also, a creative mark can be lost if it is abandoned or becomes generic.⁸² Furthermore, even a creative trademark does not qualify for protection if the creator does not make bonafide *400 use of it in commerce.⁸³ Therefore, trademark laws are not intended to protect the creativity of particular works.

Another concern about the *Waldman* decision is that it allows defendants to protect works that are in the public domain. Normally, when a literary work is in the public domain, anyone can freely copy it. Although the court correctly announced that Waldman's adaptation was sufficiently original because Waldman made a selection of episodes and redrafted the text, under copyright law, the scope of protection would be limited to the original expression that Waldman contributed. Any competitor should be allowed to use the same structure and texts as were in the original classics. It appears that neither the district court nor the Second Circuit attempted to conduct this type of analysis.⁸⁴

The appellate court indicated that Landoll could continue publishing its books if it correctly credited Waldman's authors.⁸⁵ However, it is not clear whether this approach would work in all cases. For example, a D.C. Circuit opinion held that the defendant was liable even when it inserted a disclaimer stating that its magazine was not associated with the plaintiff's similarly-styled publication.⁸⁶ Furthermore, defendants are placed in a "catch twenty-two" situation when it comes to accreditation. If a defendant believes that it created a work independently, it could still be liable simply because another person created it first. Moreover, if the defendant does credit an author, and the author does not like it, or does not appreciate having his name associated with the work, the original author could still claim a false designation of origin.⁸⁷

*401 VI. Copyright Exclusivity for Literary Works

Instead of using trademark law to protect works that fall within the subject matter of copyright, a better approach is to simply follow copyright law. Not only does copyright law offer similar remedies to trademark law, it also provides better tools for analyzing and resolving disputes concerning literary works.

For example, in the *Waldman* case, the copyright laws would have allowed the plaintiff the option of stopping the defendant from publishing the books, or, in the alternative, would have allowed the defendant the option of continuing with publication so long as proper accreditation were provided. In that case, the defendant could have used the defense of independent creation, which is not available under trademark law.

Furthermore, with regard to the Third Circuit's opinion in *American Greetings*, the court seemed to indicate in that case that it did not want the plaintiff to have a monopoly on teddy bears with tummy graphics. In reality, though, the court did not want the plaintiff to have a monopoly over the use of public domain symbols. The court held that the graphics were functional, and thus were not protected under trademark law. However, the tummy graphics were, in fact, non-functional, since they served to identify the Care Bear line of products, and indeed, the plaintiff's company.

A more principled approach to preventing the plaintiff in *American Greetings* from acquiring a monopoly over the use of hearts and smiling faces to signify love and happiness would be to invoke the concepts of merger and *scenes a faire* under copyright law.⁸⁸ By relying on these concepts, the court in *American Greetings* could have enabled the defendant to use the public domain symbols without resorting to the more unpersuasive reasoning that the plaintiff's expressions were functional. Copyright law is much better suited for this purpose since the symbols clearly fall within the subject matter of copyright.

Similarly, the Tenth Circuit could have used copyright law to determine the outcome of the *Hartford House* case.⁸⁹ Again, the major issue in that case was whether the appearance of the cards was functional in nature.⁹⁰ Functionality will always be a difficult issue in literary cases because expression could either add to the value of the product or serve to identify the product itself. In fact it will almost always do both. In these literary cases, what the courts are actually trying to protect is the artistic expression of the company. In *Hartford House*, the court stated: "It is *402 Blue Mountain's specific artistic expression, in combination with other features to produce the overall Blue Mountain look, that is being protected."⁹¹ If artistic expression is what is being protected, then copyright law should be used since trademark law is not designed to protect the creativity of a particular work.

The idea that copyright law, rather than trademark law, should be used to protect artistic expression is firmly rooted in the Constitution.⁹² Historically, Congress could not even protect marks for a product or service. In 1879, the Supreme Court rejected the argument that Congress has powers to regulate trademarks under the patent and copyright clause in the Constitution.⁹³ Congress now only has the power to regulate trademarks under the commerce clause provision, and as a result, Congress can only protect marks that are used or are intended to be used in interstate or foreign commerce.⁹⁴ Therefore, copyright law has an earlier and better foundation in the Constitution for protecting artistic expression in literary works.

The Supreme Court has also stated that doctrines developed in one area of the law should not be applied in another. This is important because the Supreme Court does not consider copyright law and trademark law to be similar.⁹⁵ In *Sony*, the Supreme Court specifically stated:

The two areas of the law [patent and copyright], naturally, are not identical twins, and we exercise the caution which we have expressed in the past in applying doctrine formulated in one area to the other.

We have consistently rejected the proposition that a similar kinship exists between copyright law and trademark law, and in the process of doing so have recognized the basic similarities between copyrights and patents. Given the fundamental differences between copyright law and trademark law, in this copyright case we do not look to the standard for contributory infringement set forth in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 854-55 (1982), which was crafted for application in trademark cases.⁹⁶

This language indicates that the Supreme Court would be less than sympathetic to the Second Circuit's attempt to use the copyright doctrines of originality and substantial similarity in the trademark context.

*403 Furthermore, the Copyright Act states that "all legal or equitable rights that are equivalent to any of the exclusive rights

within the general scope of copyright as specified by section 106 ... and come within the [same] subject matter ... are governed exclusively by this title.⁹⁷ Thus, it appears that Congress's intent was to have copyright law govern literary works, like the ones in *Waldman*. The district court, however, rejected this reasoning because section 301(d) of the Copyright Act states: "Nothing in this title annuls or limits any rights or remedies under any other Federal statute."⁹⁸

However, the district court's reasoning can be countered by arguing that at the time Congress passed the Copyright Act, encroachment of copyright law by trademark law had not yet occurred.⁹⁹ Moreover, since the Copyright Act is firmly rooted in the Constitution, it should supersede common law later enacted by the courts. Also, Landoll's conduct included copying, and copying without permission comes within the subject matter of copyright.

The Lanham Act, as analyzed by the Second Circuit, could conceivably protect literary works that have fallen into the public domain and would otherwise be freely copyable.¹⁰⁰ A defendant who makes derivative works based on public domain material and who puts its name on the product could now be liable under trademark law, even though the defendant would have a right to do so under the Copyright Act. The defendant company might have to pay damages to the plaintiff, withdraw its product, and re-label the good to avoid a trademark violation. This would result in considerable expense. Also, if the defendant company does re-label the product, the consumer might still be confused as to who actually made the product if there are a plethora of names on the package.

VII. Conclusion

By utilizing the Lanham Act in literary or creative contexts, the plaintiff gets two bites at the same apple—copyright and trademark. The plaintiff may be able to protect works that have fallen into the public domain, or may be able to limit the defenses that the defendant can utilize, such as independent creation or fair use. The copyright law is sufficiently broad to provide appropriate remedies to plaintiffs who *404 author literary or creative works and who suffer injury as a result of misappropriation. There is no need for the expansion of trademark law that occurred in *Waldman*. The *Waldman* decision makes many copyright claims into trademark claims, and the smart attorney would always bootstrap both claims. The Second Circuit's opinion needlessly complicates matters by punishing plagiarists and copyists under trademark law when copyright law provides appropriate remedies.

Footnotes

^a J.D. Candidate, The University of Texas School of Law, May 1997.

¹ 43 F.3d 775, 33 U.S.P.Q.2d (BNA) 1266 (2d Cir.1994).

² See Part III.

³ See Part IV.

⁴ See Parts V and VI.

⁵ 17 U.S.C. § 102(a) (1994).

⁶ *Id.*

⁷ U.S. CONST. art. I, § 8, cl. 8.

8 Lipton v. Nature Company, 71 F.3d 464, 470-71, 37 U.S.P.Q.2d (BNA) 1012, 1016 (2d Cir.1995). Substantial similarity is a complex issue, and its analysis varies between the circuits. Basically, it involves the filtering out of non-expressive and public domain material from the plaintiff's work and comparing the remaining expressions with the defendant's work to determine whether there is sufficient similarity.

9 See Feist Publications, Inc. v. Rural Tel. Serv., Inc., 494 U.S. 340, 345, 18 U.S.P.Q.2d (BNA) 1275, 1278 (1991).

10 For a good discussion of the purpose and theories of trademark protection see Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA.L.REV. 1079, 1082-1092 (1986). See also 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §§ 2:1-2:38 (4th ed. 1996).

11 See 1 MCCARTHY, *supra* note 10, § 3:2.

12 15 U.S.C. § 1114 (1994) (indicating that any person who, without the consent of the registrant, uses in commerce any reproduction of a mark in the sale of goods which would likely cause confusion, mistake, or deceit will be held liable for trademark infringement).

13 *Id.* § 1051 (indicating that trademarks may be registered by identifying the mark, describing how, when, and where it will be used, and describing the mark in detail).; see also 15 U.S.C. § 1057(1)(B) (noting that a drawing is needed if the trademark incorporates more than just words).

14 *Id.* § 1125(a). This section, also identified as § 43(a) of Lanham Act, does not require registration of the trademark for protection.

15 Joseph P. Bauer, *A Federal Law of Unfair Competition: What Should Be the Reach of Section 43(a) of the Lanham Act?*, 31 UCLA L. REV. 671 (1984).

16 *Waldman*, 43 F.3d at 778, 33 U.S.P.Q.2d at 1267.

17 *Id.*

18 *Id.*

19 *Id.* at 779, 33 U.S.P.Q.2d at 1267.

20 *Id.*

21 *Id.*

22 *Id.*, 33 U.S.P.Q.2d at 1267-68.

23 *Id.*, 33 U.S.P.Q.2d at 1268.

24 *Id.* Section 43(a)(1) of the Lanham Act states:

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

false or misleading representation of fact, which—

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

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such an act.

15 U.S.C. § 1125(a)(1994).

25 *Waldman*, 43 F.3d at 779, 33 U.S.P.Q.2d at 1268. The original complaint also alleged trade dress infringement in violation of section 43(a), but Waldman eventually dropped the trade dress issue from its complaint. *Id.* at 779 n.2, 33 U.S.P.Q.2d at 1268 n.2. Trade dress includes the design and packaging of materials, but can also include the appearance of the product itself. *Hartford House, Ltd. v. Hallmark Cards, Inc.* 846 F.2d 1268, 1271, 6 U.S.P.Q.2d (BNA) 2038, 2041 (10th Cir.1988). Trade dress may include a variety of features, such as size, color, color combinations, graphics, and arrangement. *Id.*

26 *See Waldman Publ'g. Corp. v. Landoll, Inc.* 848 F.Supp. 498, 499 (S.D.N.Y. 1994) *vacated in part* by 43 F.3d 775, 33 U.S.P.Q.2d 1266 (2d Cir.1994). 17 U.S.C. § 411(a) states that a copyright suit cannot be filed until the work has been registered with the Copyright Office.

27 *Waldman*, 43 F.3d 780 at 781, 33 U.S.P.Q.2d at 1269.

28 *Id.* at 780-81, 33 U.S.P.Q.2d at 1269. Reverse passing off occurs when A replaces the label on B's product with A's own mark. *Id.* at 780, 33 U.S.P.Q.2d at 1269. This is in contrast to the typical passing off cases encountered in trademark law in which A manufactures its own product and uses B's label. *Id.*

29 *Id.* at 781, 33 U.S.P.Q.2d at 1270.

30 *Id.* at 781-82, 33 U.S.P.Q.2d at 1270-72.

31 *Id.* at 782, 33 U.S.P.Q.2d at 1270.

32 *Id.* at 782-83, 33 U.S.P.Q.2d at 1270-71.

33 *Id.* at 783, 33 U.S.P.Q.2d at 1271.

34 *Id.*, 33 U.S.P.Q.2d at 1270-71.

35 *Id.* at 784, 33 U.S.P.Q.2d at 1272.

36 *Waldman*, 848 F.Supp. at 504 n.5. This part of the decision was rather conclusory, it appears that once the court determined that the designation of origin was false, it almost automatically ruled that consumers would likely be confused in reverse passing off cases. No real evidence of consumer confusion was discussed in the opinion. *See id.*

37 Landoll asserted that the district court applied an improper legal standard because the district court did not determine whether Waldman's books had achieved secondary meaning. The court responded that proof of secondary meaning is only required in passing off cases involving trademarks or trade dress where the symbols are not inherently distinctive and the plaintiff would have to prove consumer confusion through a showing of secondary meaning. *Waldman*, 43 F.3d at 784 n.7, 33 U.S.P.Q.2d at 1272 n.7. In this case, the lack of secondary meaning may have actually helped the plaintiff because the plaintiff argued that lack of

secondary meaning allowed confusion to occur. *Id.*

38 *Id.* at 785, 33 U.S.P.Q.2d at 1273.

39 *Id.*

40 *Id.* This decision suggests that the Second Circuit will allow invocation of the Lanham Act when someone copies without properly crediting the author. Therefore, it would appear that this type of claim could be used whenever a copyright lawsuit is filed. A copyright defendant will seldom credit another for creating a work because if he did, he would automatically suffer copyright liability. Since the same test is used for both trademark and copyright violation—namely, substantial similarity—a defendant will almost always be liable for both false designation of origin and false labeling in addition to copyright infringement.

41 “Bodily appropriation” is defined by the Ninth Circuit as the “copying or unauthorized use of substantially the entire item.” *Cleary v. News Corp.*, 30 F.3d 1255, 1261, 31 U.S.P.Q.2d (BNA) 1760, 1764 (9th Cir.1990) (quoting *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205, 12 U.S.P.Q.2d (BNA) 1779, 1786 (9th Cir.1989)).

42 919 F.2d 1353, 15 U.S.P.Q.2d (BNA) 1516 (9th Cir.1990).

43 *Id.* at 1355, 15 U.S.P.Q.2d at 1517.

44 *Id.* at 1363-64, 15 U.S.P.Q.2d at 1524.

45 *Id.* at 1364-65, 15 U.S.P.Q.2d at 1524-25.

46 *Id.*, 15 U.S.P.Q.2d at 1525.

47 902 F.2d 356, 15 U.S.P.Q.2d (BNA) 1057 (5th Cir.1990).

48 *Id.* at 357, 15 U.S.P.Q.2d at 1058.

49 *Id.* at 358, 15 U.S.P.Q.2d at 1059. (This court used the synonym “reverse palming off,” instead of “reverse passing off.”)

50 *Id.* at 360-361, 15 U.S.P.Q.2d at 1061.

51 In an earlier district court case in the Fifth Circuit, *Dr. Pepper Co. v. Sambo’s Restaurants, Inc.*, 517 F.Supp. 1202, 214 U.S.P.Q. (BNA) 947 (N.D. Tex. 1981) the court found a defendant liable under copyright law as opposed to under the Lanham Act, when the plaintiff presented both types of claims before the court. In *Dr. Pepper*, the defendant used the plaintiff’s Dr. Pepper jingle in a media advertisement. *Id.* at 1204, 214 U.S.P.Q. at 948. The defendant admitted that it was trying to parody Dr. Pepper’s commercials. *Id.* at 1206-08, 214 U.S.P.Q. at 950-52. The district court ruled that the Dr. Pepper commercial jingle was copyrighted, and that the defendant’s claim of fair use parody was unpersuasive. *Id.* at 1207-08., 214 U.S.P.Q. at 950-51. However, the district court also ruled that because “[a]s a matter of formal logic, the ‘Be A Pepper’ jingle is copyrighted, Plaintiff’s property interest in it is protected by the copyright law [and] not by either the state or federal trademark laws.” *Id.* at 1206, 214 U.S.P.Q. at 950. The court held that there was no likelihood of confusion because a survey commissioned by the defendant showed that only 8% of consumers thought the defendant’s commercial was similar to the Dr. Pepper ad. *Id.* at 1205-06, 214 U.S.P.Q. at 949. Thus, although the advertisements were similar enough to support a claim for copyright infringement, there could be no violation of the Lanham Act.

52 Hartford House, Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268, 1275, 6 U.S.P.Q.2d (BNA) 2038, 2044 (10th Cir.1988).

53 *Id.* at 1272, 6 U.S.P.Q.2d at 2041 (indicating that functionality should be decided on “whether the protection of the [feature] would hinder competition or impinge upon the rights of others to compete effectively in the sale of goods”) (quoting Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co., 791 F.2d 423, 426 n.3, 230 U.S.P.Q. (BNA) 118, 119 n.3 (5th Cir.1986)).

54 *Hartford House*, 846 F.2d at 1274, 6 U.S.P.Q.2d at 2043. The plaintiff’s cards had backgrounds primarily consisting of soft colors depicting simple landscape and nature themes. *Id.* at 1269, 6 U.S.P.Q.2d at 2039. The defendant argued that the district court’s decision gave the plaintiff exclusive rights in artistic style. *Id.* at 1274, 6 U.S.P.Q.2d at 1243.

55 Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821, 823-24, 215 U.S.P.Q. (BNA) 745, 747 (11th Cir.1982).

56 *Id.* at 830, 215 U.S.P.Q. at 753.

57 *Id.* at 832, 215 U.S.P.Q. at 754.

58 *Id.* at 832, 215 U.S.P.Q. at 754.

59 917 F.Supp. 1574, 39 U.S.P.Q.2d (BNA) 1011 (M.D. Fla. 1996).

60 *Id.* at 1583, 39 U.S.P.Q.2d at 1017.

61 *Id.* at 1577, 39 U.S.P.Q.2d at 1013.

62 *Id.* at 1582, 39 U.S.P.Q.2d at 1017 (citing *Shaw v. Lindheim*, 908 F.2d 531 (9th Cir.1990), superseded by 919 F.2d 1353, 15 U.S.P.Q.2d (BNA) 1516 (9th Cir.1990)).

63 *Id.* at 1583, 39 U.S.P.Q.2d at 1017-18. The analyses of *Campbell* and *Waldman* suggest that trademark law and copyright law have equivalent standards. However, trademark remedies are not subsumed by copyright law because of the additional requirement that consumer confusion be established for trademark infringement. Consumer confusion arises when two marks are substantially similar. For copyright infringement substantial similarity is the method used to determine whether a defendant copied the plaintiff’s work. Thus, it would appear that the only claim a defendant could be accused of is copying, which falls within the exclusive right of copyright. However, consumer confusion and copying are not deemed equivalent in these two opinions.

64 807 F.2d 1136, 1 U.S.P.Q.2d (BNA) 1001 (3d Cir.1986).

65 *Id.* at 1138, 1 U.S.P.Q.2d at 1002. The “tummy graphics” were symbols and words printed on the stomachs of the bears to identify each bear’s “personality.” *Id.* at 1139, 1 U.S.P.Q.2d at 1002.

66 *Id.* at 1143, 1 U.S.P.Q.2d at 1006.

67 *Id.* at 1149, 1 U.S.P.Q.2d at 1011.

68 *Id.* Functionality is determined by whether a feature is substantially related to the value of the product or whether it serves primarily to identify the provider. *Id.* at 1142, 1 U.S.P.Q.2d at 1005.

69 *Id.* at 1148-49, 1 U.S.P.Q.2d at 1010.

70 The Seventh Circuit found that both the Lanham Act and federal copyright law could support a cause of action when the Roman Catholic Church copied and distributed the plaintiff's hymn book in violation of a license. *F.E.L. Publications, Ltd. v. Catholic Bishop of Chicago*, 214 U.S.P.Q. (BNA) 409, 411-13, 416-17 (7th Cir.1982). Since this case involved exact copying, one cannot tell whether it followed the Second or Ninth Circuit approach.

The Sixth Circuit found that there was no violation of either the Lanham Act or the Copyright Act because the defendant's bumper sticker slogan was not substantially similar to the plaintiff's materials and expression. *Mihalek Corp. v. Michigan*, 814 F.2d 290, 294-95, 2 U.S.P.Q.2d (BNA) 1161, 1163-66 (6th Cir.1987).

The Eighth Circuit found that both trademark law and copyright law could be invoked when the defendant copied the plaintiff's catalogue, eliminated the plaintiff's name, and substituted its own name, which was confusingly similar. *Metric & Multistandard Components Corp. v. Metric's, Inc.*, 635 F.2d 710, 713-15, 209 U.S.P.Q. (BNA) 97, 100-01 (8th Cir.1980). However, the court only addressed the Lanham Act claims on appeal and upheld the injunction on those terms. *Id.* at 715, 209 U.S.P.Q. at 101. Since this case involved both bodily appropriation and similar company names, one cannot determine whether the Eighth Circuit was more sympathetic to the Second or the Ninth Circuit approach.

However, the Eighth Circuit has also held that trademark law cannot be used when the plaintiff fails to prove substantial similarity in its copyright case. *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120-21, 4 U.S.P.Q.2d (BNA) 1864, 1866-67 (8th Cir.1987) (disallowing trademark claims when there was no showing of likelihood of confusion or substantial similarity). *Id.* at 121, 4 U.S.P.Q.2d at 1866.

71 *See infra* text accompanying note 96.

72 *See* 1 MCCARTHY, *supra* note 10, §§ 8:10-8:11.

73 *Waldman*, 43 F.3d at 784, n.7, 33 U.S.P.Q.2d at 1272, n.7.

74 *Id.*

75 *See, e.g.* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 U.S.P.Q.2d (BNA) 1081 (1992).

76 *Waldman*, 43 F.3d at 785, 33 U.S.P.Q.2d at 1272-73 (quoting *Smith v. Montoro*, 648 F.2d 602, 211 U.S.P.Q. (BNA) 775 (9th Cir.1981)).

77 *See* 1 MCCARTHY, *supra* note 10, § 3:4.

78 *See* 1 MCCARTHY, *supra* note 10, §§ 2:4-2:5, 3:10.

79 *Waldman*, 43 F.3d at 784 n.7, 33 U.S.P.Q.2d at 1272 n.7. *Waldman* contended that because the books did not have secondary meaning, consumers would be confused and believe that the books were created by Landoll. *Id.*

80 *See* Part VI of this article, which advocates reliance on copyright law when the subject matter of a particular dispute falls within the provisions of the Copyright Act.

81 *See* 15 U.S.C. § 1051 (1994) (indicating that one who originates a trademark may have a defense of limited area and can claim priority in the geographic area in use before registration, but can not expand into other areas).

82 *See, e.g., Exxon Corp. v. Humble Exploration Co.*, 695 F.2d 96, 217 U.S.P.Q. (BNA) 1200 (5th Cir.1983) (holding that the plaintiff Exxon Corporation had essentially abandoned the use of the mark HUMBLE).

83 *See, e.g., Blue Bell Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1265, 185 U.S.P.Q. (BNA) 1, 4 (5th Cir.1975) (finding that a trademark was lost because secret internal shipments did not qualify as “use in commerce,” and the shipments were not a bona fide attempt to use the mark in the future).

84 The appellate court said that for a derivative work to be copyrightable, it must not infringe the original work. That issue was deemed moot in *Waldman*, however, since the original works upon which Waldman based its own books were already in the public domain. *Waldman*, 43 F.3d at 782 n.4, 33 U.S.P.Q.2d at 1270 n.4. To analyze this issue correctly, the appellate court should have compared the original works with Waldman’s own books to see how much expression Waldman incorporated that was already in the public domain. Only original expression should be protected, and the rest should be filtered out and excluded from comparison when analyzing Landoll’s books. In this case, it appears that the plaintiff’s and defendant’s books were compared to each other without filtering out the original expression from the plaintiff’s works beforehand. *See Waldman*, 43 F.3d at 783, 33 U.S.P.Q.2d at 1271.

85 *Id.* at 785, 33 U.S.P.Q.2d at 1273. However, Landoll would ostensibly have to make an accurate accreditation by stating that Waldman’s authors adapted their own books from works authored by someone else. *Id.* at 785 n.8, 33 U.S.P.Q.2d at 1273 n.8.

86 *Reader’s Digest Ass’n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 805, 3 U.S.P.Q.2d (BNA) 1276, 1279-80 (D.C. Cir.1987) (holding that the cover designs of two magazines were sufficiently similar even though the defendant put a wrapper over its cover to disclaim any association with the plaintiff’s publication).

87 *See Gilliam v. American Broad. Co. Inc.*, 538 F.2d 14, 192 U.S.P.Q. (BNA) 1 (2d Cir.1976) (finding liability where members of the Monty Python troupe sued a television company for severely editing a broadcast of one of its shows). *See King v. Innovation Books*, 976 F.2d 824, 24 U.S.P.Q.2d (BNA) 1435 (2d Cir.1992) (prohibiting distributors and producers of a film from using the author’s name to indicate that the author had a possessory interest in the movie).

88 *See* 3 DAVID NIMMER and MELVILLE B. NIMMER, NIMMER ON COPYRIGHT §§ 13.03[B][3] & 13.03[B][4] (1996) (discussing merger and *scenes a faire*, respectively).

89 *See supra* notes 52-54 and accompanying text.

90 The defendant did not contest the district court’s ruling regarding likelihood of confusion or whether the plaintiff’s work had acquired secondary meaning. *Hartford House*, 846 F.2d at 1271-72, 6 U.S.P.Q.2d at 2040-41.

91 *Id.* at 1274, 6 U.S.P.Q.2d at 2043.

92 U.S. CONST. art 1, § 8, cl 8 (indicating that Congress has the power “to promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).

93 *See* 1 MCCARTHY, *supra* note 10, § 6:2 (discussing the Supreme Court Trade Mark Cases, 100 U.S. 82 (1879)).

94 *Id.*

95 *See Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 439 n.19, 220 U.S.P.Q. (BNA) 665, 677 n.19 (1984).

96 *Id.*

⁹⁷ 17 U.S.C. § 301(a) (1994). Section 106 deals with exclusive rights in copyright law, such as the right to make copies, prepare derivative works, distribute copies, perform copyrighted materials, and display copyrighted materials. *Id.* § 106.

⁹⁸ *Id.* § 301(d). At the district court level, the defendant in *Waldman* tried to make this preemption argument, but it was rejected by Judge Haight. *Waldman Publ'g Corp. v. Landoll, Inc.*, 1994 WL 116088 (D.D.N.Y. 1994). *See also supra* note 16 and accompanying text.

⁹⁹ *See Bauer, supra* note 15, at 689 nn.75-76. All cases cited by Bauer that involved both copyright law and trademark law were decided after the enactment of the Copyright Act in 1976. *Id.*

¹⁰⁰ For example, prior to the 1989 Berne Amendment, most copyrighted subject matter that did not have a copyright notice fell into the public domain and could be freely copied. *See* 17 U.S.C. § 405 (1994).