

Originally published Law & Contemporary Problems, Autumn 1981  
Law & Contemp. Probs., Autumn 1981, at 147.

## RECOGNIZING THE PUBLIC DOMAIN

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In a celebrated lecture on the law of copyright, Zechariah Chafee suggested that objections to intellectual property are probably rooted in a more general distaste for private property. He acknowledged, however, that differences among species of property can justify differences in their treatment in law.<sup>1</sup> In this brief essay, I will recall some of the attributes of intellectual property that justify particular concern when new rights are being recognized or existing ones enlarged. I will argue that the growth of intellectual property in recent years has been uncontrolled to the point of recklessness. And I will suggest that recognition of new intellectual property interests should be offset today by equally deliberate recognition of individual rights in the public domain.<sup>2</sup>

The chief attribute of intellectual property is that apart from its recognition in law it has no existence of its own. It is in fact as well in definition the stuff of an intellectual, rather than a felling, accord. Lacking tangible substance altogether, its boundaries cannot be recognized through the medium of the human senses. In this respect the subject matter of intellectual property is unlike the subject matter of more conventional forms of property which have in common an underlying attribute of tangibility and are in consequence susceptible to some form of sensory perception.<sup>3</sup>

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<sup>1</sup> Chafee, *Reflections on the Law of Copyright*, 45 COLUM. L. REV. 503, 510 (1945). See also B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 74 (1966). I am indebted to members of my 1981-82 class in Law and the Arts - upon whom I tested some of the ideas in this essay - for the reference to Chafee in this setting.

<sup>2</sup> A work is in order about terminology. I am aware that the term "property" is of doubtful utility in the context of rights and interests like the ones I propose to consider. See, e.g., B. KAPLAN, *supra* note 1, at 74. But I shall use it in this essay generally to call attention to the attribute of exclusivity which is of concern to me. See Brenner, *what's In A Name and Who Owns It?* 6 BARRISTER 42,44 (1979) ("[W]e tend to call that which one can sell (or prevent others from selling), 'property'"); cf. Arnold, *A philosophy on the Protections Afforded By Patent, Trademark, Copyright and Unfair Competition Law: The Source and Nature of Product Simulation Law*, 54 TRADE-MARK REP. 413 (1964)

<sup>3</sup> I take these observations to be common ground, though I have the uneasy feeling that I have seen them expressed in substantially these terms before. If so, I have nonetheless been unable to locate the source. Meanwhile, similar observations can be found. E.g., Note, *Copyright: Moral Right - A Proposal*, 43 FORDHAM L. REV. 793, 795 (1975) ("The theory of copyright as

Of course, it is this distinction, an elementary one readily understood by all intellectual property lawyers, which makes the subject challenging and fun. How richly conceptual an undertaking it is to have to recognize the existence of an interest in the very act of protecting it. And yet if one does not exercise restraint, how preposterous an undertaking it becomes as well. Tom Wolfe's observations on a recent development in American art come to mind:

In the late 1960's the Conceptualists began to ask: Suppose the greatest artist in the history of the world, impoverished an unknown, had been sitting at a table in the old Automat at Union Square, helping himself to some free water and hoping to cop a leftover crust of toasted corn muffin or a few abandoned translucent chartreuse waxed beans of some other item of that amazing range of Yellow Food the Automat went in for- and suddenly he got the inspiration for the greatest work of art in the history of the world? Possessing none even so much as a pencil or a burnt match, he dipped his forefinger into the glass of water and began recording this greatest of all inspirations, this high point in the history of man as a sentient being, on a paper napkin with New York tap water as his paint. In a matter of seconds, of course, the water had diffused through the paper and the grand design vanished, whereupon the greatest artist in the history of the world slumped to the table and died of a broken heart, and the manager came over, and he thought that here was nothing more than a dead wino with a wet napkin. Now, the question was: Would that have been the greatest work of art in the history of the world or not?<sup>4</sup>

Intellectual property lawyers would side-step the question about the merits of the work, but would litigate cheerfully, for years, the separate question of its entitlement to protection as property.

The grand design probably would not have been entitled to protection under the 1909 Copyright Act because of the ephemeral medium in which it was recorded,<sup>5</sup> and such doubt as the

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property is not easily molded into the traditional concept of property: *e.g.*, it is not possessory and it is not perpetual . . . [nor is it] property in the material product created . . .") *See also* Patterson, *Private Copyright and Public Communication: Free Speech Endangered*, 28 Vand. L. Rev. 1161, 1208-09 (1975); N. HENRY, *COPYRIGHT/INFORMATION TECHNOLOGY /PUBLIC POLICY, PART I*, 55 (1975); Nevins, *The Doctrine of Copyright Ambush: Limitations of the Free Use of Public Domain Derivative Works*, 25 ST. LOUIS U. L. REV. 58, 72 (1981).

<sup>4</sup> T. WOLFE, *IN OUR TIME* 80 (1980)

<sup>5</sup> *See* 1 M. NIMMER, *NIMMER OF COPYRIGHT* §§ 1.08[C], 2.03[B] (1981). The term "ephemeral" has taken on technical significance in copyright law. *See* H.R. Rep. No. 1476, 94<sup>th</sup> Cong., 2d Sess. 101-05 (1976), *discussed in* 2 M. NIMMER, *supra*, § 8.06[A], at 8-91 to-92. I am of course using it simply as a generic term.

For an argument that at least some ephemeral works amounting to an "art" could be protected under the 1909 Act, 17 U.S.C. §§ 1-180 (1976), *see* J. WHICHER, *THE CREATIVE ARTS AND THE JUDICIAL PROCESS*, 73-74, 81-84 (1965). But this argument, it will be seen upon examination, may derive from an essentially different definition of ephemeral works that is implicit in the 1976 Act's "fixation" requirements. *See* note 6 *infra*.

1909 Act might have allowed would have been resolved under the 1976 General Copyright Revision: the work clearly was not “fixed” in a “tangible medium of expression.”<sup>6</sup> On the other hand, as against either Act, the composition could have acquired the protection of common law copyright- assuming, that is to say, that the State of New York would think it a suitable object for largesse.<sup>7</sup> There is good reason to suppose that New York would.

The fact that the composition was recorded in an ephemeral medium would not necessarily disqualify it from protection in that State. Indeed, New York has given us what is probably the leading case on the subject of common law copyright in ephemeral works, that State’s court of appeals having concluded in dictum, in *Estate of Hemingway v. Random House, Inc.*,<sup>8</sup> that even a spoken conversation with a friend may be eligible for common law copyright if sufficiently “marked off” by its author to indicate his clear intention to protect it.<sup>9</sup> To be sure, in common law copyright the interest ordinarily springs into being without formal attendants. In the *Hemingway* case, however, the marking-off requirement was suggested by the court apparently in order to permit some initial identification of the subject matter of the work, as well as to offset the more normal presumption that ordinary speech is not to be protected.<sup>10</sup> In the case of the dead wino’s composition, the problem of initial identification - which obviously can arise in any ephemeral work - is surely satisfied by the tracing on the napkin (subject only to niddling problems of proof); meanwhile, the presumption almost certainly accorded to works of fine art, unlike conversations, is that they are entitled to protection.<sup>11</sup> There is some suggestion in *Hemingway* that the ephemeral work may have to meet a standard of creativity higher than is usually required in copyright.<sup>12</sup> But that suggestion has been criticized<sup>13</sup> and, in any event, a work of art even putatively the greatest in the history of the world - much less the high point in the history of man as a sentient being - surely comports with whatever standard is finally to be settled upon.

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<sup>6</sup> “Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . .” 17 U.S.C. 102(a) (1977). “A work is “fixed” in a tangible medium of expression when its embodiment . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101 (1977). See generally 1 M. NIMMER, *supra* note 5, § 203[B][2].

<sup>7</sup> See 1 M. NIMMER, *supra* note 5, § 2.02, at 2-18.

<sup>8</sup> 23 N.Y. 2d 341, 244 N.E. 2d 250, 296 N.Y.S.2d 771 (1968)

<sup>9</sup> *Id.* at 349, 244 N.E.2d at 256, 296 N.Y.S.2d at 779.

<sup>10</sup> *Id.* Professor Nimmer, however, is critical of this portion of the opinion: “[T]o require that the speaker ‘indicate’ that he claims copyright in his expression is to create the need for a kind of oral copyright notice that is difficult to justify. A commendable aspect of common law copyright has been that it, like copyright systems throughout the rest of the world and unlike statutory copyright within the United States, requires no formalities.” 1 M. NIMMER, *supra* note, 5, § 2.20, at 2-21 to -22.

<sup>11</sup> Cf. 1 M. NIMMER, *supra* note 5, § 2.08[B], at 2-84 (“[T]he courts are rightly inclined to accept as a work of art any work which by the most generous standard may arguably be said to evince creativity”)

<sup>12</sup> *Estate of Hemingway v. Random House, Inc.* 23 N.Y.2d 341, 348-49, 244 N.E.2d 250, 255-56, 296 N.Y.S.2d. 771, 778-79 (1968)

<sup>13</sup> See 1 M. NIMMER, *supra* note 5, § 2.02, at 2.21: “[I]t is most unfortunate to introduce the concept that only a ‘unique intellectual product’ may command common law copyright protection. This suggests a standard of creativity, or of novelty, or of both, that is contrary to prevailing copyright standards, and which has no greater justification in oral than it does in written works.” But see Note, *Beyond the Realm of Copyright: Is There Legal Sanctuary for the Merchant of Ideas?* 41 BROOKLYN L. REV. 284, 295-96 n. 48 (1974). See also text accompanying notes 127-28 *infra*

We can safely conclude, then, that here is an example of intellectual property in its purest form, entirely conceptual and yet entitled to the full protection of law - protection, indeed, which in the case of common law copyright may endure forever.<sup>14</sup> I think it is useful to remember, however, that what we are talking about, insofar as our senses can perceive it, is still a wet spot on the dead wino's napkin. Everything else is hypothesis.

The hypothetical nature of intellectual property means that boundaries inevitably prove troublesome to fix. Rarely can we be sure that our perception of a particular interest is more than an approximation of someone else's perception of the same interest. And unlike real estate or personalty, intellectual property is subject to unlimited recreation in the mind of each observer.<sup>15</sup> This causes trouble enough in the task of establishing recognizable boundaries. But the real difficulty arises from the fact that more than one person sensibly may assert a proprietary interest in what looks like the same property. Learned Hand's useful dictum anticipates this phenomenon in the law of copyright and offers a neat solution.<sup>16</sup> But not all of these conflicts are so easily resolved. Hand's dictum is a rule of copyright but not of patents. And even in copyright, the theory of derivative works makes no adequate allowance for the copier whose recreation of an earlier work is also a substantial improvement.<sup>17</sup>

What I would suppose, then, is not that intellectual property is undeserving of protection, but rather that such protection as it gets ought to reflect its unique susceptibility to conceptual imprecision and to infinite replication.<sup>18</sup> These attributes seem to me to require the recognition of two fundamental principles. One is that intellectual property theory must always accept something akin to a "no-man's land" at the boundaries; doubtful cases of infringement ought always to be resolved in favor of the defendant.<sup>19</sup> The other is that no exclusive interest should ever have affirmative recognition unless its

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<sup>14</sup> The New York Court of Appeals in *Estate of Hemingway v. Random House, Inc.* 23 N.Y.2d at 346 n.1, 244 N.E.2d at 254 n.1, 296 N.Y.2d at 776 n. 1, assumed an "indefinite" term for common law copyright prior to publication. Whether the court would have allowed protection to survive in a published work is not clear- although, apparently, as far as the Constitution is concerned, a state court may protect published work which is neither eligible for nor preempted by statutory copyright. See *Goldstein v. California*, 412 U.S. 546, 570 n.28 (1973). Whether it should do so is another, more complicated, issue into which I do not want to be drawn just now except so far as is necessary to agree that, clearly at some point, perpetual protection "cheats the public domain." B. KAPLAN, *supra* note 1, at 96. See generally *id.*

<sup>15</sup> See Kaplan, *supra* note 1, at 74.

<sup>16</sup> "Borrowed the work must indeed not be, for a plagiarist is not himself pro tanto an 'author'; but if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's." *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936).

<sup>17</sup> See generally I M. Nimmer, *supra* note 5, § 3.01-.07. Cf. B. KAPLAN, *supra* note 1, at 19-21. Some recognition of the contributions made by an infringing ("derivative") work is reflected in the rule permitting an apportionment of profits, however. See *e.g.*, *Sheldon v. Metro-Goldwyn Pictures, Corp.* 309 U.S. 390, 403-06, 407-09 (1940). I suspect that this potential loss of works by the "inventive improver" is a general problem we ought to be more concerned about. See Jaszi, *When Works Collide: Derivative Motion Pictures, Underlying Rights, and the Public Interest*, 28 U.C.L.A. L. REV. 715 733-38 (1981) (arguing for recognition of "quantitative distinctions" among derivative works). See also B. KAPLAN, *supra* note 1, at 57-58; Brenner, *supra* note 2, at 46.

<sup>18</sup> See B. KAPLAN, *supra* note 1, at 74-76

<sup>19</sup> Cf. Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 988, 1000-01 (1970). *But cf.* Derenberg, *Copyright No-Man's Land: Fringe Rights in Literary and Artistic Property*, 35 J. PAT. OFF. SOC'Y 770 (1953)

conceptual opposite is also recognized. Each right ought to be marked off clearly against the public domain.<sup>20</sup>

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(approaching the same terrain from a fundamentally dissimilar perspective and lamenting the unavailability of greater protection against copying).

<sup>20</sup> Cf. Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 112 (1980) ("One man's right is another man's restraint, and to set levels of protection in the intellectual property and unfair competition fields only in response to the needs of one group . . . distorts the function of these laws . . ."). See also B. Kaplan, *supra* note 1, at 74-77 (expressing a similar concern for the "public obligation" in copyright).

Remarkably little direct attention has been paid to the public domain in recent years; there seem to have been no extended treatments of the subject in its own terms. The Copyright Society's *Studies on Copyright*, for example, contains only two references to public domain in the Index, neither of them consequential in terms of general theory. See COPYRIGHT SOCIETY STUDIES ON COPYRIGHT 819, 924 (Arthur Fisher Memorial Edition 1963). The prevailing view probably was expressed by the writer who observed that simply the reflection of an ultimate legal conclusion." Stern, *A Reexamination of Preemption of State Trade Secret Law After Kewanee*, 42 GEO WASH. L. REV. 927, 967 n.184 (1974). Compare Krasilovsky, *Observations on Public Domain*, 14 BULL. COPYRIGHT SOC'Y 205 (1967) ("Public domain in the fields of literature, drama, music and art is the other side of the coin of copyright. It is best defined in negative terms. It lacks the private property element granted under copyright in that there is no legal right to exclude others from enjoying it and is "free as the air to common use").

In approaching an area of law as undeveloped as this I have found it pessary to make some arbitrary judgments about both scope and depth of research. As for cases, I have attempted neither a general synthesis nor extended doctrinal analysis - this for reasons explained in the text. In terms of the literature - in order to cast a wider net than would otherwise have been possible - I have thought it enough for my purposes to look closely for public domain-oriented writings back to 1964 when the decisions in *Sears* and *Compco* appeared. See note 23 *infra*. Beyond that time, I have considered materials only as I already know them or as they came to light in the course of reading or otherwise. I am not uneasy about these self-imposed limits- especially not in view of the tendency for worthwhile works to live on well beyond their time as research collected in later works - but it is necessary to acknowledge the very real possibility the something of consequence in the older literature may not have been discovered, and the possibility as well that in the unsystematic current literature on the subject something else may have gone unappreciated or unnoticed. These possibilities, inevitable in any research and especially so among diffuse materials, are particularly real in the case of works on fair use and the first amendment to which I have not paid close attention - in the former case for obvious reasons having to do with the usual perspective of that subject matter, and in the latter case for reasons I have explained later in this essay. See note 74 and accompanying text *infra*. I have paid somewhat closer attention to the literature of preemption (where one would expect to find the public domain treated and where, indeed, it has had some useful development, particularly in the work of Professor Brown); but, not supposing that the subject matter of public domain ought merely to reflect constitutional doctrines, I have also considered some writing in the history and philosophy of intellectual property; and, I can report with misgivings, I have gone on some excursions into the land of that knave of torts, unfair competition, and its neighbor-in-darkness, trademark law, which have contributed so much to the debasement of intellectual property in this century but which, not altogether paradoxically, have produced some useful literature- this literature I have attempted to discover while exercising a necessary selectivity. In the field of publicity law I was already reasonably well-versed and so it was convenient to extend that research assistant Paul Kramer) reflect more nearly the whole of the field than is true of the other research areas touched on in this essay. Finally, I have left patent law almost entirely alone; whatever public domain problems may be lurking in this field seem to be the least of our concerns just now.

I have not attempted in this essay to formulate a general public domain theory, although one inevitably has begun to suggest itself. See note 137 *infra*. I have simply presupposed a universal acknowledgment of what amounts to a dark star in the constellation of intellectual property and I have hoped to encourage a wider concern for its definition in case law and literature alike.

Meanwhile it is clear that the existing literature is now in at least a rich progenitive state: Professor Brown of Yale deserves particular mention for his persistent expressions of concern for the public domain., some of which I discuss more fully in later notes. See generally Brown, *Unification*]; Brown, *Publication and Preemption in Copyright Law: Elegiac Reflections on Goldstein v. California*, 22 U.C.L.A. L. Rev. 1022 (1975) [hereinafter cited as Brown, *Elegiac Reflections*]; Brown, *Product Simulation: A Right or a Wrong?* 64 COLUM. L. REV. 1216 (1964) [hereinafter cited as Brown, *Product Simulation*].

An earlier effort to summarize the public domain deserves particular mention also:

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Regardless of the variations of terminology occasioned by the limitations of the English language in treating with such evanescent abstractions, the cases generally exhibit a surprising uniformity of approach and conception. The courts wholeheartedly recognize that ideas, new or old, when once disclosed must be kept “free as air” for all to use. They recognize further that the vast accumulation of human experience, the character of man and his world in all its varying phases, and the relationships of each to the other and to other men and other things, not only in the general but the specific, are not and cannot become the “property” of anyone regardless of how they are expressed. These things are the universal heritage, the public commons, from which all may freely draw sustenance and which all may use as seems most satisfactory to them.

For that reason the law limits the claim of private protectible property to the adornments and embellishments, great or small, that the individual gives to his share of the common property; the individual’s “form and manner of expression” or his “development” or “treatment.” It denies such claim to the relationships (“situations” or “concepts”); or to the results human experience shows ordinarily will or may occur from such relationships (“dramatic cores,” “themes,” “skeleton plots,” “scenes a faire,” “pessary or routine incident”). It denies such claim to background, locale, or historic facts either in or out of juxtaposition with other unprotectible elements. And since man is man regardless of the particular experiences to which he is subjected, it should and probably does deny any property right in any “character” apart from any particular series of events in which he acts.

These elements may be encompassed by the general work “ideas,” for lack of more accurate term. They are denied protectibility because of their universality; they are the raw materials with which creative imaginations must work, and under no circumstances can they in and of themselves become the private property of any individual.

There are many differences in terminology and each case presents individual facts. Nevertheless, a study of the opinions leads one to the clear conclusion that in general the courts appreciate the vital importance of preventing this public commons from being fenced in by any private individual, and have recognized its scope and extent.

Carmen, *The Function of the Judge and Jury in the “Literary Property” Lawsuit*, 42 Calif. L. Rev. 52, 57-59 (1954), cited with approval in *Desny v. Wilder*, 46 Cal.2d 715, 727 n.5, 299 P.2d 257, 262 n.5 (1956).

For additional direct comments of importance, see especially Note, *Copyright Law Revision and the Kewanee Preemption Issue: Is There a Doctrine in the House?*, 16 SANTA CLARA L. REV. 609 (1976) [hereinafter cited as Note, *Copyright Law Revision*], See generally Sims, *Right of Publicity: Survivability Reconsidered*, 47 FORDHAM L. REV. 453, 480 (1981); Brenner, *supra* note 2, at 44; Stern, *A Reexamination of Preemption of State From Secret Law After Kewanee*, 42 GEO WASH. L. REV. 927 (1974); Goldstein, *The Competitive Mandate: From Sears to Lear*, 59 CALIF. L. REV. 873 (1971), cited in Note, *Copyright Law Revision, supra*; Nathan, *Unfair Competition in Intellectual Products in the Public Domain*, 18 CLEV.-MAR. L. REV. 92 (1969); Comment, *Copyright Preemption and Character Values: the Paladin Case as an Extension of Sears and Compco*, 66 MICH. L. REV. 1018, 1037-39 (1968) [hereinafter cited as Comment, *Copyright Preemption and Character Values*]; Krasilovsky, *Secrets and Their Protection: The Public Domain and the “Unified Description” Requirement*, 54 KY. L. J. 190 (1965); Spiegel, *Intellectual Productions: A Policy Orientation*, 36 S. CAL. L. REV. 500 (1963); Stern & Hoffman, *Public Injury and the Public Interest: Secondary Meaning in the Law of Unfair Competition*, 110 U. L. REV. 935 (1962).

For works somewhat less immediate, but nonetheless useful in deriving a public domain theory, see N. HENRY, COPYRIGHT/INFORMATION TECHNOLOGY/PUBLIC POLICY (1975, 1976) (a valuable two-part examination of “the social, political, and economic impact of the new information technologies . . .”). By no means an exegesis of the public domain, it is nonetheless useful for the perspective it offers on the position of the “copyright user” and for the corresponding doubts it raises or expresses about the usefulness of intellectual property. See, e.g. 1 *id.* at 54-57, 2*id.* At 144; COPYRIGHT: CURRENT VIEWPOINTS ON HISTORY, LAWS, LEGISLATION (A. KENT & H. LANCOUR eds. 1972) [hereinafter cited as A. KENT & H. LANCOUR] (a collection of essays, some of them useful in defining the public domain from a user’s point of view); L. PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE (1968) (an essential work on the historical underpinning of copyright; also develops a theoretical history that could be used in defining the public domain, *id.* at 215-21; see note 137 *infra*); B. KAPLAN, *supra* note 1 (does not address the public domain directly, but written from a “low protectionist bias . . . with a concern for easy public access to, and use and improvement of products of the mind,” *id.* at 125 thus, a valuable research source for anyone interested in assessing the

## II

Until perhaps ten years ago, it might have appeared that these principle were reflected in the concern courts seemed to have that the rules of conduct in the field of intellectual property not favor one contender unwisely, unfairly, or adventitiously - in the last case, that is to say, merely because that contender happened to have been the first to come forward with a claim.<sup>21</sup> Then, coinciding roughly with the appearance of the trial court's opinion in *Lugosi v. Universal Pictures Company, Inc.*<sup>22</sup> in 1972, the law seemed suddenly to metastasize. Since then, I would argue, it has developed too rapidly and in too many ill-defined directions, with the consequence that in numerous instances exclusive rights

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scope of the public domain); J. MARKE, COPYRIGHT AND INTELLECTUAL PROPERTY (9167) ( a pamphlet prepared under the auspices of the Fund of the Advancement of Education; deals with the question of public domain status for government-assisted research as well as with problems in information retrieval and photocopying; does not develop a general theory); J. WHICHER, *supra* note 5 (an idiosyncratic work, not readily summarized, taking the view in passing that the public domain is an essentially empty concept conferring no "vested" or "affirmative" rights at all, *see id.* at 203; still a useful work, particularly in the insights suggested into the history of intellectual property theory and philosophy); S. LADAS, INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY (1938) ( a dated but still useful two-volume work; contains two sections on "lawful borrowing" and "indirect appropriation" that shed indirect light on the public domain but do not deal with the subject in its own terms, *see id.* at 530-75; in addition, fragmentary recognition of the public domain is extended in the context of a discussion of the 1909 Act); Jaszi, *supra* note 17 (an important article, equally impressive in both scholarly and practical insights, treating the subject of derivative works theory in motion picture production from a perspective consistent with a more general concern for the public domain); Nevins, *supra* note 3 (critical of conventional derivative works theory as it applies to derivative works which have fallen into the public domain; does not develop a general public domain theory and, indeed, observes that "the concept of the public domain needs very little elucidation . . .," *id.* at 59); Patterson, *supra* note 3 (useful for its insight into the evolution of copyright - and, by implication, other forms of intellectual property law- from its origins in natural law theory to new roots in legal positivism; the effect of this shift is to introduce substantial new threats to free expression); Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies and Computer Programs*, 84 HARV. L. REV.281 (1970); Liebig, *Style and Performance* , 17 BULL. COPYRIGHT SOC'Y 40 (1969) (arguing against recognition of separate protection for "style" and "performance" from a perspective essentially consistent with a large public domain theory); Treece, *Copying Methods of Product Differentiation: Fair or Unfair Competition*, 38 NOTRE DAME LAW.244 (1962) (developing an argument analogous to public domain theory).

For selected readings in the literature on the first amendment of value in deriving a public domain theory, see generally, Kulzick & Hogue, *Chilled Bird: Freedom of Expression in the Eighties*, 14 LOY. L.A. L. REV. 57 (1980); Patterson, *supra* note 19; Nimmer, *Copyright v. the First Amendment*, 17 BULL. COPYRIGHT SOC'Y 255 (1970).

And finally, for works expressing reservations or doubts of some consequence in deriving a public domain theory, see Comment, *The Right of Publicity: Premature Burial for California Property Rights in the Wake of Lugosi*, 12 PAC. L. J. 987, 995-96 (1981) [hereinafter cited as Comment, *Premature Burial*]; Note, *The Right of Publicity - Protection for Public Figures and Celebrities*, 42 BROOKLYN L. REV. 527 , 549 (1976) [hereinafter cited as Note, *Right of Publicity*]; Derenberg, *Product Simulation: A Right or a Wrong?* 64COLUM. L. REV. 1192, 1213 (1964); Handler, *Product Simulation: A Right or a Wrong?* 64 COLUM. L. REV. 1183, 1188-91 (1964)

<sup>21</sup> See Carman, *supra* note 20, at 58-59. Professor Kaplan expressed similar confidence in the common law processes. See B. KAPLAN, *supra* note 1, at 77. Cf. Derenberg, *supra* note 19

<sup>22</sup> 172 U.S.P.Q. 541 (1972), *rev'd*, 70 Cal. App. 3d 552, 139 Cal. Rptr. 35 (1977), *aff'd*, 25 Cal. 3d 813, 603 P.2d. 425, 160 Cal. Rptr. 323 (1979)

have been recognized in contenders who simply have not demonstrated a legitimate claim.<sup>23</sup> The opinion in *Lugosi* was an event in its own day. It is still worth recalling despite its familiarity and its subsequent reversal. Bela Lugosi's widow and son had brought suit to enjoin Universal Pictures from exploiting the deceased actor's likeness. Their contention was that in licensing commercial representations of the character Dracula, made to resemble Bela Lugosi as he had portrayed that character in movies, Universal was appropriating an important right which had belonged to Lugosi during his lifetime and which, as part of his estate, had devolved on the plaintiffs themselves upon his death. As all students of intellectual property know, the trial court upheld that claim.<sup>24</sup>

The decision clearly was important in its own terms. Prior to 1970 the writing in the field of publicity had been relatively sparse. There were some good works, beginning with an article by Melville Nimmer which appeared in this journal.<sup>25</sup> The gist of the literature was that there ought to be an alternative to the fourth branch of privacy- the appropriation of personality branch identified by Dean Prosser<sup>26</sup> - that would permit its possessor to exploit his own personality more efficiently than was possible under prevailing doctrines, particularly as they applied to such personal interests as the older right of privacy.<sup>27</sup> But not all of the earlier writers had addressed the prospect which *Lugosi* faced

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<sup>23</sup> I mark this metastasis from the appearance of *Lugosi*. Another more comprehensive frame of reference may be seen as having begun with the appearance of *Sears, Roebuck & Co. v. Stiffel, Co.*, 376 U.S. 225 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.* 376 U.S. 234 (1964) and *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969), followed by *Goldstein v. California*, 412 U.S. 546 (1973) and *Kewanee Oil Co. v. Bicron*, 416 U.S. 470 (1974) - the latter two cases, of course, coinciding almost exactly with the trial court opinion in *Lugosi*. Perhaps the movements in intellectual property which I find troubling and which are the occasion for this essay need to be understood as originating in the currents of opinion which have followed in the wake of all of these cases. Compare, e.g. Note, *Intellectual Property - Performer's Style - A Quest for Ascertainment, Recognition and Protection*, 52 DEN. L. J. 561, 578-80 (1975) [hereinafter cited as Note, *Performer's Style*]. And it was no doubt of particular significance that *Sears-Compco* and the later cases gave such a boost to misappropriation theory just as the publicity field itself was about to explode. Cf. Brown, *Elegiac Reflections*, *supra* note 20, at 1041-43; Note, *The "Copying-Misappropriation" Distinction: A False Step in the Development of the Sears-Compco Preemption Doctrine*, 71 COLUM. L. REV. 1444, 1458-73 (1971) [hereinafter cited as Note, *Copying Misappropriation*]. See also Nathan, *supra* note 20. On the impact of *Sears-Compco*, see generally Symposium, *Product Simulation: A Right or a Wrong?*, 64 COLUM. L. REV. 1178, cited (with amused appreciation in B. KAPLAN, *supra* note 1, at 94. See also Nathan, *supra* note 20. On the impact of *Lear*, see generally Goldstein, *supra* note 20. On the impact of *Goldstein*, see generally Brown, *Elegiac Reflections*, *supra* note 20. On the impact of *Kewanee*, see generally Stern, *supra* note 20. For a brief, practical summary of the movement from *Sears-Compco* through *Kewanee*, see generally Dannay, *The Sears-Compco Doctrine Today: Trademarks and Unfair Competition*, 67 TRADE-MARK REP. 132 (1977)

An important advantage of appreciating the signal influence of these additional cases is that some of the difficulties that otherwise attend an effort to characterize as "new" the overlapping jurisdictions of trademark-unfair competition-copyright (which are not in fact new phenomenon at all) are thereby alleviated: one is permitted to understand that some old problems have taken on new significance in a period of expanding intellectual property litigation.

<sup>24</sup> "It is this court's holding that Bela Lugosi's interest or right in his likeness and appearance as Count Dracula was a property right of such character and substance that it did not terminate with his death but descended to his heirs." *Lugosi v. Universal Pictures, Inc.* 172 U.S.P.Q. 541, 551 (1972), *rev'd* 70 Cal. App. 3d 552, 139 Cal. Rptr. 35 (1977), *aff'd*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

<sup>25</sup> Nimmer, *The Right of Publicity*, 19 LAW & COMTEMP. PROBS. 203 (1954)

<sup>26</sup> See generally Prosser, *Privacy*, 48 CALIF. L. REV. 383, 401-07 (1960)

<sup>27</sup> A number of writers prior to *Lugosi* suggested a property right in publicity. E.G. Comment, *Commercial Appropriation of an Individual's Name, Photograph, or Likeness: A New Remedy for Californians*, 3 PAC.L.J. 651 (1972); Donenfeld, *Property or Other Rights in the Names, Likenesses, or Personalities of Deceased Persons* 16 BULL. COPYRIGHT



squarely: that if the right of publicity was to be a new species of property it could in theory devolve and descend forever.<sup>28</sup> This central point, made compellingly clear by the trial court's decision in *Lugosi*, led to a profusion of writing about the expanding field of publicity which at times since has seemed almost frenzied.<sup>29</sup>

The nature of the right, its scope and the question of "descendibility" (as it has come to be

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SOC'Y 17 (1968); Note, *Right of Privacy-Property Rights*, 11N.Y.L. F. 120 (1965); Gordon, *Rights of Property in Name, Likeness, Personality and History*, 55 NW. U.L. REV. 553 (1960); Note, *Hogan v. A.S. Barnes & Co.*, 31 TEMP. L. Q. 224 (1958); Nimmer, *supra* note 25.

Few pre-*Lugosi* writers were opposed to the recognition of publicity rights. *But see* Liebig, *Style and Performance*, 17 BULL. COPYRIGHT SOC'Y 40 (1969).

<sup>28</sup> Some writers who had suggested a property right in publicity had also argued for descendibility. *E.g.* Comment, *supra* note 27; Donenfeld, *supra* note 27; Gordon, *supra* note 27.

And others had approved of descendibility even without recognizing publicity as a property right. *E.g.*, Note, *The Right to Privacy in the Name, Reputation, and Personality of a Deceased Relative*, 40 NOTRE DAME LAW. 324 (1965); Note, *Lahr v. Adell Chem. CO.*, 48 CORNELL L. Q. 360 (1962)

<sup>29</sup> Most of the post-*Lugosi* writing on the right of publicity has approved of (or accepted) its descendibility. *E.g.*, Comment, *Assesment of the Copyright Model in Right of Pulicity Cases*, 70 CALIF. L. REV. 768 (1982); Note, *Lugosi v. Universal Pictures: Doornail on Descendibility in California*, 13 U.W.L.A. L. REV. 203 (1981); Phillips, *A Haystack in the Hurrigan: Divergent Case Law on the Right of Publicity and the Copyright Act of 1976*, 63 J. PAT.OFF.SCO'Y296 (1981); Comment, *Premature Burial*, *supra* note 20; Saret & Stern, *Publicity and Privacy - District Interests on the Misappropriation Continuum*, 12 LOY. U. CHI. L.J. 675 (1981); Winner, *Right of Identity: Right of Publicity and Protection for a Trademark's "Persona,"* 71 TRADE-MARK REP. 193 (1981); Sims, *supra* note 20; Lazar, *Towards a Right of Biography: Controlling Commercial Exploitation of Persnal History*, 2 COM/ENT. L. J. 489 (1980); Pilpel, *Right of Publicity*, 27 BULL. COPYRIGHT SOC'Y 249 (1980); Note, *Descendibility of the Right of Publicity*, 14 GA. L. REV. 831 (1980); Note, *Descendibility of Celbrity's Right to Benefit from Fame*, 47 TENN. L. REV. 886 (1980); Note, *Inheritability of the Right of Publicity Upon the Death of the Famous*, 33 VAND. L. REV. 1251 (1980); Brenner, *supra* note 2; Note, *Lugosi v. Universal Pictures: Descent of the Right of Publicity*, 29 HASTINGS L. J. 751 (1978); Note, *Communitcy Property Interests in the Right of Publicity*, 25 U.C.L. A. L. REV. 1095 (1978); Comment, *The Tort of Misappropriation of Name of Likeness under Wisconsin's New Privacy Law*, 1978 WIS. L. REV. 1029; Comment, *Privacy, Appropriation, and the First Amendment: A Human Cannonball's Rather Rough Landing*, 1977 B.Y.U.L. REV. 579; Comment, *Appropriation oof a Peformer's Act by the News Media: Is it Privileged?*, 16 WASHBURN L. J. 786 (1977); Note, *Performer's Right of Publicity: A Limitation on News Privilege*, 26CLEV. ST. L. REV. 587 (1977); Note, *The Right of Publicity*, *supra* note 20, Comment, *Transfer of the Right of Publicity: Dracula's Progeny and Privacy's Stepchild*, 22 U.C.L.A. L. REV. 1103 (1975); Sobel, *Count Dracula and the Right of Publicity*, 47 L.A. BAR BULL. 373 (1972).

Some writers have tried to reconcile the California and New York positions by placing *Lugosi* under the exceptiono for publicity rights not exploited before death. They would approve of descendibility if the right were exercised during the possessor's lifetime. *E.g.*, Philips, *supra*; Note, *Lugose v. Universal Pictures: Doornail on Descendibility in California*, *supra*.

Still others would approve of descendency if a contract for the exploitation of the possessor's publicity right was in existence before his death. *E.g.* Felcher & Rubin, *Descendibility of the Right of Publicity: Is There Commercial Life After Death?* 89 YALE L.J. 1125 (1980) [hereinafter cited as Felcher & Rubin, *Descendability*]; Felcher & Rubin, *Privacy, Publicity, and the Portrayal of Ral People by the Media*, 88 YALE L. J. 1577 (12979) [hereinafter cited as Felcher & Rubin, *Real People*].

A few articles have disapproved of decendency. *E.g.*, Note, *Publicity as an Aspect of Privacy and Personal Autonomy*, 55 CAL. L. REV. 727 (1982) [hereinafter cited as Note, *Personal Autonomy*]; Hoffman, *supra* note 20.

And a few have discussed the right of publicity without consideration of its decendency. *E.g.*, Note, *Entertainment Law - An Injunction Restricting an Actor's Right of Publicity and First Amendment Righs Is Against Public Policy*, 21 SANTA CLARA L. REV. 845 (1981); Note, *First Amendment Theory Applied to the Right of Publicity*, 19 B.C.L. REV. 277 (1978) [hereinafter cited as Note, *First Amendment Theory*]; Note, *Performenn's Style*, *supra* note 23, Treece, *Commrecial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV.637 (1973).

called) continue to be subjects for debate.<sup>30</sup> But *Lugosi's* impact has been wider than that. The opinion seemed to encourage a general interest in new causes of action so that, although the right of publicity itself may well be moving toward grater restraints,<sup>31</sup> in the filed of intellectual property at large

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<sup>30</sup> The courts, or course, are having the last work, although lines of authority diverge even within the sam jurisdiction. Numerous decisions have suggested or expressly recognized that the right to publicity is a species of property. *E.g.* Fler Corp. V. Topps Chewing Gum, Inc. 658 F.2d 139 (3d Cir. 1981); Groucho Marx Prodcutions, Inc. v. Day & Night Co. 523 F. Supp. 485 (S.D.N.Y. 1981); Factors Etc., Inc. v. Pro Arts, Inc. 652 F.2d 278 (2d Cir. 1981); *cert. Denied*, 102 S. Ct. 1973 (1982); Winterland Concessions Co. v. Sileo, 528 F. Supp. 1201 (N.D. Ill. 1981); Lerman v. Chuckleberry Bup. Inc., 521 F. Supp. 228 (S.D.N.Y. 1981); Estaste of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981); Martin Luther King, Jr. v. American Heritage, 508 F. Supp. 854 (N.D. Ga. 1981); First Victoria Nat'l Bank v. United States, 620 F.2d 1096 (5<sup>th</sup> Cir. 1980); Carson v. Her's Johnny Portable Toilets, 498 F. Supp. 71 (E.D. Mich. 1980); Gee v. CBS, 471F. Supp. 600 (E.D. Penn. 1979); Hirsch v. Johnson & Son, 90 Wis. 2d 379, 280 N.W. 2d 129 (1979); Hicks v. Casablanca Records, Inc. 464 F.Supp. 426 (S.D.N.Y. 1978); Price v. Worldvision Enterprises, Inc. 455 F. Supp. 252 (S.D.N.Y. 1978); Ali v. Playgirl, Inc. 447 F.Supp. 723 (S.D.N.Y. 1978); Factors Etc., Inc. v. Creative Card Co., 444 F. Supp. 279 (S.D.N.Y. 1977); Universal City Studios v. Ideal, Inc. 195 U.S.P.Q. 761 (S.D.N.Y. 1977); Lombardo v. Doyle, Dane & Bernbach, Inc. 58 A.D.2d 260, 396 N.Y.S. 2d 661 (2dDept. 1977); Price v. Hal Roach Studios, Inc. 400 F. Supp. 836 (S.D.N.Y. 1975); Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973); Uhlaender v. Henricksen, 316 F.Supp. 1277 (D. Minn. 1970); Cepeda v. Swift & Co. 415 F.2d 1205 (8<sup>th</sup> Cir. 1969); Cabaniss v. Hipsley, 114 Ga. App. 367, 151 S.E. 2d 496 (1966); Sharman v. C. Schmidt & Sons, 216 F.Supp. 401 (E.D. Penn. 1963); Ettore v. Philco Television Broadcasting Corp. 229 F.2d 481 (3d Cir.), *cert. Denied*, 346 U.S. 816 (1953).

Others have recognized the right of publicity but have not defined it as a property rights. *E.g.*, Rock Tours, Ltd. v. Does, 507 F. Supp. 63 (N.D. Ala. 1981); National Bank of Commerce v. Shaklee, 503 F. Supp. 533 (W.D. Tex. 1980); Ann-Margaret v. High Society Magazine, 498 F. Supp. 401 (S.D.N.Y. 1980); Memphis Development Foundation v. Factors Etc., Inc. 616 F.2d 956 (6<sup>th</sup> Cir.), *cert. Denied*, 449 U.S. 953 (1980); Guglielmi v. Spelling-Goldberg Prod., 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 323 (1979); Motschenbacher v. Reynolds Tobacco CO. 498 F.2d 821 (9<sup>th</sup> Cir. 1974); Boothe v. Colget-Palmolive Co., 362 F. Supp. 343 (S.D.N.Y. 1973); Current Audio v. RCA, 71 Misc. 2d 831, 337 N.Y.S. 2d 949 (1972); Rosemont Enterprises, Inc. v. Random House, Inc. 58 Misc. 2d. N.Y.S. 2d 122 (1968); Palmer v. Schonhorm, 96 N.J. Super. 72, 232 458 (1968).

Meanwhile, some decisions recognize descendibility if the right to publicity is exercised before the possessor's death. *E.g.* Groucho Marx Production, Inc. v. Day & Night CO., 523 F. Supp. 485 (S.D.N.Y. 1981); Lerman v. Chuckleberry Pub., Inc. 521 F. Supp. 228 (S.D.N.Y. 1981); martin Luther King, Jr. v. American Heritage, 508 F. Supp. 854 (N.D. Ga 1981); Commerce Union Bank v. Coors, 7 Med. L. Rptr. 2204 (No. 81-1252-III, Tenn. Ch., Oct. 2, 1981); Hicks v. Casablanca Records, 464 F. Supp. 426 (S.D.N.Y. 1978); Factors Etc., Inc. v. Creative Card Co. 444 F. Supp. 279 (S.D.N.Y. 1977).

Other recognize descendibility regardless of pre-death exercise. *E.g.* Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981); Lombardo v. Doyle, Dane & Bernbach, Inc.58 A.D. 2d 620, 396 N.Y.S. 2d. 661(2d Dept. 1977); Price v. Hal Roach Studios, Inc. 400 F. Supp. 836 (S.D.N.Y. 1975).

And some cases hae rejected descendibility. *E.g.* Factors Etc., Inc. v. Pro Arts, Inc. 632 F.2d 278 (2d Cir. 1981) (following Tennessee law), *cert. Denied*, 102 S. Ct. 1973 (1982) (*Factors II*); Frosch v. Grossett & Dunlap, 75 A.D. 2d 768, 427 N.Y.S. 2d 828 (2d Dept. 1980); Memphis Development Foundation v. Factors Etc., Inc. 616 F.2d 956 (6<sup>th</sup> Cir.) *cert. Denied*, 449 U.S. 953 (1980); Guglielmi v. Spelling-Goldberg Prod., 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979); Lugosi v. Universal Pictures, Inc. 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (9179).

*Factors II* rejected descendibility following Tennessee law as interpreted by the Sixth Circuit in *Memphis Development Foundation*, which noted that , "Tennessee courts have not addressed this issue directly or indirectly, and we have no way to assess their predisposition." 616 F.2d at 958. But when a Tennessee court finally did speak last year, it was to uphold descendibility. Commerce Union Bank v. Coors, 7 med. L. Rptr. 2204 (No. 81-1252-III. Tenn. Ch. Oct. 2, 1981). The Southern District of New York to which *Factors II* was remanded for entry of judgment has since granted a stay pending plaintiff's petition to the Second Circuit to rehear the case in light of *Commerce Union Bank* No. 77 Civ. 4704, slip op. (S.D.N.Y. May 11, 1982).

<sup>31</sup> The California Supreme Court's decision in *Lugosi* has restored some sense of perspective in this filed. Meanwhile, law review writers are beginning to suggest that publicity rights need to be taken in hand. *See, e.g.* Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV.673 (1981); Hoffman, *supra* note 20.

there now appear to be more candidates for protection than one can safely categorize.<sup>32</sup> Much of the writing and many of the cases have defended this profusion on the ground of exigent economic necessity. The interests newly advanced are *valuable*, we are told, and therefore deserve protection.<sup>33</sup> But to one who is unimpressed by this explanation - who sees it, indeed, as a massive exercise in question - begging the field of intellectual property can begin to resemble a game of conceptual Pac Man in which everything in sight is being gobbled up.<sup>34</sup>

The fact that the 1909 Copyright Act still was undergoing a general revision in the same decade in which *Lugosi* appeared also must be credited with having given impetus to the new activity. The 1909 Act clearly needed revising and the revisions it got seem, in the main, to have been sensible ones.<sup>35</sup> Yet the 1976 Act itself reflects some of the new rapaciousness. The copyright term has been increased by approximately 50 percent.<sup>36</sup> And much of common law copyright is now the subject of federal law.<sup>37</sup> Indeed, the reach of the new Act can seem ludicrous: notes to babysitters, instruction to chimney sweeps, direction to my house - all of these almost certainly meet the minimal standards of creativity required by the law of copyright and, assuming that they are recorded in some tangible medium of expression (such as pencil on paper), can command statutory copyright without any other affirmative act whatsoever.<sup>38</sup> I suspect this would impress most lay persons learning of it for the first time as unimaginably foolish. At the least, it reflects what I (and a number of others) think to be the

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*See also* Felcher & Rubin, *Real People*, *supra* note 29, at 1619.

<sup>32</sup> *Cf.* Brown, *Elegiac Reflections*, *supra* note 20, at 1044-45 (commenting on the emergence of new theories inspired by *Goldstein v. California*).

<sup>33</sup> *See, e.g.*, Lazar, *supra* note 29, at 523-43. *See also* Winner, *supra* note 29; Note, *The Right of Publicity as a Means of Protecting Performers' Style*, 14 LOY.L.A. L. REV. 129 (1980).

<sup>34</sup> *Cf.* Goswell, *The Viewpoint of the Librarian and Library User* in A. KENT & H. LANCOUR, *supra* note 20, at 63 ("One member of a self-appointed committee of copyright lawyers has boasted that they have developed restrictions on every means of transmission of thought except smell, taste, and extrasensory perception"). *But see* Rose, *Current Trends in Entertainment Litigation: the Insurance Empire Strikes back*, 1 ENTERTAINMENT & SPORTS LAW. 1 (1982) (suggesting that the defenses against overreaching literary property claims are becoming tougher and more frequently successful).

<sup>35</sup> *See generally*, *Symposium: the Copyright Act of 1976*, 24 U.C.L.A. L. REV. 951 (1977)

<sup>36</sup> The comparison drawn here is between the 56-year term available under the 1909 Act and the assumption by the draftsmen of the General Revision that the 1976 Act would probably provide an average term amounting to 75 years. *See* 2 M. NIMMER, *supra* note 5, § 9.01[A], at 9-10. Compare the more substantial criticism of the (then pending) term in Breyer, *supra* note 20, at 323-29. *See also* B. KAPLAN, *supra* note 1, at 111-17. *Cf.* Patterson, *Copyright and The Public Interest* in A. KENT & H. LANCOUR, *supra* note 20, at 47 ("As copyright law has developed in this country . . . the public interest has continually receded into the background as the copyright industry has become more and more powerful").

<sup>37</sup> *See generally*, Brown, *Unification*, *supra* note 20.

<sup>38</sup> Compare the similar list in Brown, *Unification*, *supra* note 20, at 1079. My point here is subject to attack on two grounds: first, that the 1976 Act is merely picking up interest that probably would have been covered by common law copyright anyway; and second, that even the longer term of the new Act is shorter than forever (that is to say, shorter than the term of the common law right). *See, e.g.*, B. KAPLAN, *supra* note 1, at 116; Brown, *Unification*, *supra* note 20, at 1079-80. But, as is frequently noted, statutory copyright protection clearly is more valuable than common law protection and, in any event, the more important point is that "junk interest" like these probably should not be protected as property at all. *See id.* at 1097-98. *But cf. id.* at 1079-n.53

generally debatable reach of even as well-thought-through an area of law as copyright.<sup>39</sup>

But statutory copyright probably is not the most important source of problems in the intellectual property field just now. With its doubtful premises and its conceptual perplexities, the law of copyright nonetheless reflects a substantial and fairly satisfactory set of accords. The problem of marking off boundaries has been addressed in the requirement of tangibility<sup>40</sup> and also in the elaborate provisions for notice as well as deposit and registration.<sup>41</sup> Copying must be substantial before it is actionable;<sup>42</sup> and the law at least approaches, if it does not wholly succeed in resolving, the troublesome possibilities of legitimate multiple claims in a work.<sup>43</sup> In short, copyright seems to be in a state of reasonable equilibrium,<sup>44</sup> and though I confess to substantially less familiarity with patent law, I think that much the same assessment probably can be made of that field as well.<sup>45</sup> The principal problems in intellectual property law are to be found instead in a host of other, less well-worked-out, property-equivalent theories which are appearing in sporadic, ad hoc fashion in the literature and, what is more important, in state and federal courts across the country. I have already observed that it is probably impossible to identify all of these theories; in any event, exhaustive categorization and doctrinal analysis are foreign to my purpose. In this essay, I intend rather to record the insistent impression I have that certain claims, essentially new, have begun to appear in disparate settings and have not yet been met with an adequate concern for the encroachments they are making into the public domain.<sup>46</sup>

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<sup>39</sup> See B. KAPLAN, *supra* note 1, at 114-17. See generally *id.* at 78-125. See also Brown, *Unification*, *supra* note 20. Cf. Breyer, *supra* note 20, at 323-29

<sup>40</sup> See note 6 and accompanying text *supra*.

<sup>41</sup> Cf. Levine & Squires, *Notice, Deposit and Registration: the Importance of Being Formal*, 24 U.C.L.A. L. REV. 1232, 1232-36 (1977). See generally 2 M. NIMMER, *supra* note 5, §§ 7.16-21 (as to registration and deposit).

<sup>42</sup> See M. NIMMER, *supra* note 5, § 13.03[A], at 13-16, 13-30 to 35.

<sup>43</sup> See notes 15-17 and accompanying text *supra*

<sup>44</sup> An equilibrium, at least, in basic theory; many questions remain unresolved. See, e.g., Ringer, *The Unfinished Business of Copyright Revision*, 24 U.C.L.A. L. REV. 951 (1977)

<sup>45</sup> See Bowes, *Patents and the Public Interest*, 61 A.B.A.M. 1521 (1975). See generally PRESIDENT'S COMMISSION ON THE PATENT SYSTEM, "TO PROMOTE THE PROGRESS OF . . . USEFUL ARTS" 2 (1966) ("Agreeing that the patent system has in the past performed well its Constitutional mandate 'to promote the progress of . . . useful arts,' the Commission asked itself: What is the basic worth of a patent system in the context of present day conditions? The members of the Commission unanimously agreed that a patent system today is capable of continuing to provide an incentive to research, development, and innovation. They have discovered no practical substitute for the unique service it renders.") But see Topol, *Patents and Hunting Licenses- Some Iconoclastic Comments and an Irreverent Solution*, 17 AM. U.L. REV. 424 (1968).

<sup>46</sup> I persist throughout this essay in describing the current assaults upon the public domain as "new"- and in terms of their frequency and the relentless inventiveness of the writers, lawyers and clients who are mounting them I think I am essentially correct. Still, an author's conceit can be treacherous and I have tried to be sensitive to earlier expressions of similar concern.

My discussion has been abstruse, but it comes down to this. A huffer-mugger over the concept of "publication" beginning a half-century ago has generated interesting possibilities of evading the controls of the Copyright Act even as to subject matter plainly within its reach. False classification of a copyright problem as being something different from that can have the same effect of evasion. As to subject matter not admitted to copyright by the present act, we have a turbulent condition of the law. And over the scene sound the oracular words of the Supreme Court, which must chill the blood of any dues-paying Manichaeans.

B. KAPLAN *supra* note 1 at 96. See generally *id.* at 83-99. Professor Kaplan was at pains, however, to deny and "[suggestion]

Three recent cases will suffice as examples of my point. One of these, the most recent of the Marx brothers cases,<sup>47</sup> illustrates, as I shall show, how publicity theory can go wrong when courts are too quick to pass the basic issues presented in this field of law. The second case,<sup>48</sup> which involves litigation initiated by the proprietors of the character Superman to prevent the students at Chicago's Daley College from naming their campus newspaper *The Daley Planet*, is an example of how the law to trademarks - which, like copyrights and patents, is at least susceptible to confinement within reasonable limits<sup>49</sup> - has begun to spill over its boundaries and encroach into territories in which trademark protection amount to trespass. And the third case,<sup>50</sup> perhaps the most striking of the three, has resulted in a preliminary injunction which prevents the United States Marine Corps League from drawing any prominent connection between its "Semper Fidelis Band Award," given annually to high school students, and John Philip Sousa, the celebrated conductor of the Marine Corps Band, whose stirring march *Semper Fidelis* was composed in 1888 during his service to the Corps from whose own motto he had taken the title to his work *verbatim*. Against the vigorous appeal of this passage from American history, the injunction reflects the law's delicate concern for the exclusive rights to Sousa's name and likeness, claimed, since 1973, by a high school band magazine headquartered in Evanston, Illinois. Together, these three cases suggest something of the current thrust of the law into once-uncharted fields.

Consider, first *Groucho Marx Productions, Inc. v. Day and Night Co., Inc.*,<sup>51</sup> decided in the United States District Court for the Southern District of New York. The plaintiffs claimed standing as successors to rights in the names and likenesses of Groucho, Chico and Harpo Marx, deceased. The defendants were the production company of the Broadway play *A Day in Hollywood, A Night in the Ukraine* and its producers, as well as the authors of the play who were brought into the litigation as third party defendants. The circumstances were these: the authors wishing to create a "spoof" on the excesses of Hollywood and Hollywood movies in the thirties, wrote a play in which they used the Marx Brothers as characters. The play was produced in England where it enjoyed a substantial success, and

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that the law is undergoing a general, wicked deterioration," *id.* at 77. See also *id.* note 21, *supra*. He appeared to believe that changes in the Copyright Act would "respond reasonably . . . to the current problems both legal and practical." *Id.* at 97.

The "Manichaeic heresy" implicated in what even Professor Kaplan described as the "aberrant drive toward irregular protection," *id.* at 97, was a metaphor suggested still earlier by Professor Brown. See Brown, *Product Simulation*, *supra* note 20, at 1227. In general, as I have noted, Professor Brown has been especially persistent in calling attention to threats to the public domain. See note 20 *supra*, notes 111-36 and accompanying text *infra*.

Other warnings also have been sounded. See generally Shipley, *supra* note 31; Hoffman, *supra* note 20; Laff & Saret, *Further Unraveling of Sears-Compco: Of Patches, Paladin and Laurel & Hardy* 7 LOY. U. CHI.L.J. 33, 55-56 (1976) ("The law of intellectual property has been undergoing an eccentric reconceptualization in recent years"); Liebig, *supra* note 27, at 42; Krasilovsky, *supra* note 20.

<sup>47</sup> *Groucho Marx Productions, Inc. v. Day & Night Co.*, 523 F.Supp. 485 (S.D.N.Y. 1981)

<sup>48</sup> *DC Comics, Inc. v. Board of Trustees*, No. 81 C 2402 (N.D. Ill., filed June 17 1981)

<sup>49</sup> For a useful recent treatment of this subject matter, see generally McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 TRADE-MARK REP. 305 (1979).

<sup>50</sup> *Instrumentalist Co. v. Marine Corps League*, 509 F. Supp. 323 (N.D. Ill. 1981).

<sup>51</sup> 523 F. Supp. 485 (S.D.N.Y. 1981)

then was brought to New York where it met similar enthusiasm.<sup>52</sup> The plaintiffs claimed that in the appropriation of the Marx Brothers characters the defendants had taken or violated several of the plaintiffs' own interest, one of them the right of publicity. On the basis of an examination of New York law - a body of law which exists mainly in the form of hypothesis by the Second Circuit<sup>53</sup> - the district court agreed with the plaintiffs. The court rejected the authors' claim of a first amendment privilege on the ground that although they had added "a new situation with original lines," still, as to the Marx Brothers, they had succeeded only in creating an imitative work lacking in "significant value as pure entertainment" and therefore exceeding the boundaries of first amendment protection.<sup>54</sup> Commenting on this aspect of the court's opinion, an editorial writer in *Fortune* had the following to say:

The "Ukraine" part, for those who missed this dichotomous production, was an inspired romp in which playwright Richard Bosburgh fancifully imagined how the Marx Brothers would have interpreted Chekhov's play *The Bear* . . . . [D]oes it rally make sense to say that a conception as starkly original as [this] . . . is just an "imitation" of the Marx Brothers? Well. . . [the district court] is indeed saying that (while adding the self-under-mining qualification that the imitation comes "in a new situation iwth new lines"). In the immortal words of Rufus T. Firefly, the Groucho character in *Duck Soup*: "A four-year-old child could understand this . . . . Run our and find me a four-year-old child."<sup>55</sup>

I am frankly critical of the conclusion reached in this opinion almost without exception. But the mistakes are not entirely of the trial judge's making. In the main, the opinion appears to be an earnest restatement of the law. The real fault is in the law itself and, if we are to see why, we must ask questions that go somewhat deeper into the case than does the opinion.

What we need to ask is why a property right of any kind ought to be recognized in characters like the ones created by th Marx Brothers. If we were to reply in terms of copyright law the answer to

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<sup>52</sup> 'A Day in Hollywood,' a British import about the heyday of Hollywood musicals and comedies, has ingratiating performances . . . . The first half of the evening is a comic tribute to movie musicals and the second half is a slap-happy send up of Chekhov's short play, "the Bear," as performed by three newly invented stand-ins for the Marx Brothers. Gussow, *Three Musicals, Three 'Stars*,' N.Y. Times, May 11, 1980, § 2, at 7, col. 3

<sup>53</sup> Federal courts have recognized a right of publicity in New York decisional and statutory law. See *Lerman v. Chuckleberry Pub. CO.*, 521 F.Supp. 228 (S.D.N.Y. 1981); *Ann-Margaret v. Hight Society Mag.*, 498 F. Supp. 401 (S.D.N.Y. 1980); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978); *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279 (S.D.N.Y. 1978); *Universal City Studios v. Ideal, Inc.* 195 U.S.P.Q. 761 (S.D.N.Y.1977); *Hicks v. Casablanca Records*, 464 F. Supp. 426 F.Supp. 426 (S.D.N.Y. 1978); *Price v. Hal Roach Studio, Inc.* 400 F. Supp. 836 (S.D.N.Y. 1975); *Grant v. Esquire, Inc.* 367 F.Supp. 876 (S.D.N.Y. 1973); *Haelen Laboratories, Inc. v. Topps Chewing Gun, Inc.* 202 F.2d 866 (2d Cir.), cert. Denied, 346 U.S. 816, (1953).

<sup>54</sup> 523 F.Supp. at 492-94

<sup>55</sup> Seligman, *Keeping Up*, FORTUNE , Nov. 16, 1981, at 50.

this question would seem reasonably clear.<sup>56</sup> But what is the basis for a claim of additional interests? I think the answer to that question is still far from clear. It is sometimes said that the right of publicity rests on the commercial value of the interest itself,<sup>57</sup> but that explanation is nonsense without something more. A claim of this sort will have commercial value only if it also has the protection of the law. In a sense, the value of this property stems from the fact that the law recognizes it and protects it.<sup>58</sup> Perhaps the question to be considered, then, is really two questions: first, whether there is a sensible basis upon which a claim can be made to rest beyond the value which protection undoubtedly will confer, and second, whether there is any offsetting consideration which might lead one to conclude that protection ought not be granted even though there is some legitimacy in the claim.<sup>59</sup> I think that on both of these considerations the right of publicity as we see it in case like *Day and Night* fails to justify itself by a wide margin.

First, as to the basis for protection, we might simply wish to recognize an original creation and acknowledge its value - that is, its value to its creator, measured in terms of some personal investment in invention, and its value to the public, which can sensibly prize any true creation.<sup>60</sup> Then, no matter where the mine finally is to be drawn as to the term of a claim - whether at the death of the creator or some time later - at least after death the value of the invention ought to be assessed more insistently in terms of some demonstrated creativity, since by that time the more personal aspects of the undertaking presumably will matter less insistently to the creator.<sup>61</sup> This seems to me to be a shifting equation of some obviousness, but also of some considerable importance. Yet one of the most troublesome aspects of the publicity cases is that they have so frequently been brought on by persons other than the actual creators of the interests advanced. The *Day and Night* case is a good example of what I mean. The plaintiffs in this case are not the Marx Brothers themselves, but rather their legal successors, so that we do not see in the plaintiffs any direct, personal entitlement to protection. Such claims as they may

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<sup>56</sup> The rationale for recognizing copyright is typically expressed in terms of a barter transaction in which the author's efforts are encouraged by the prospect of a limited monopoly; ultimately the public benefits from incremental additions to the public domain. See, e.g., 1 M. NIMMER, *supra* note 5, §§ 1.03[A], 1.05[D], 4.03. Cf. *Mazer v. Stein*, 347 U.S. 201, 219 (1954). (Of course I do not mean to address the quite separate problem of recognizing characters in copyright generated by the so-called *Sam Spade* doctrine. See generally 1 M. NIMMER, *supra* note 5, § 2.12, at 2-171 to -172.

<sup>57</sup> E.g., Gordon, *supra* note 27, at 555-57; Comment, *Premature Burial*, *supra* note 20, at 995-97

<sup>58</sup> As has been suggested before, e.g. Bloustein, *Privacy Is Dear At Any Price: A Response to Professor Posner's economic Analysis*, 12 GA. L. REV. . 429, 448 (1978); Comment, *Copyright Preemption and Character Values*, *supra* note 20, at 1027.

<sup>59</sup> Questions like these are beginning to appear in the literature with some frequency. See Hoffman, *supra* note 20, at 116-33. See also Note, *Personal Autonomy*, *supra* note 29, at 729-51; Felcher & Rubin, *Descendibility*, *supra* note, 29, 1128

<sup>60</sup> Compare, for example, the suggestions in Note, *Personal Autonomy*, *supra* note 29, at 730; Felcher & Rubin, *Descendibility*, *supra* note 29, 1128; Hoffman, *supra* note 20, at 116-18; Comment, *An Artist's Personal Rights in His Creative Works*, 9 PAC. L. J. 855, 888 (1978)); Comment, *Copyright Preemption and Character Values*, *supra* note 20, at 1034-36. Cf. Carman, *supra* note 20, at 60-61; Krasilovsky, *supra* note 20 at 215; Speigel, *supra* note 20, at 503-04; Katz, *Copyright Preemption Under the Copyright Act of 1976: Case of Droit de Suite*, 47 GEO. WASH. L. REV. 200, 217 (1976). See also L. PATTERSON, *supra* note 20, at 215-21; Whicher, *The Ghost of Donaldson v. Becket* (pts. 1 & 2), 9 BULL. COPYRIGHT SOC'Y 102, 124-25, 194, 219-22 (1962).

<sup>61</sup> See Note, *Personal Autonomy*, *supr* note 29, at 753 n. 149; Hoffman *supra* note 20, at 135-39; Felcher & Rubin, *Real People*, *supra* note 29, at 1618-19; cf. Nevins, *supra* note 20, at 72; Goldstein, *supra* note 19, at 1016. *But cf.* Sims, *supra* note 20, at 472-81.

have rest entirely in the remnant position of their predecessors.<sup>62</sup> This is just the point at which we ought to take a more demanding look at what their predecessors have left us. Unfortunately, however, when we examine the record of the Marx Brothers, it is difficult - as is in most cases impossible, given the very different perspective of the law in earlier times - to distinguish what they invented from what they converted. The dimensions of their bequests are unclear. The result is that we cannot sensibly judge what portions of their successors' claims to accept.

That the characters were successful in one sense is clear and that they were the products of some creative invention seems probable as well: the Marx Brothers are commonly thought to have been as creative a group as any to emerge from American vaudeville. But what we cannot know in fact, and what I suspect strongly could not be proven now if one set out to do so with the best will in the world, is how much the characters created by the Marx Brothers owe to the work of tens, scores, perhaps hundreds of other vaudeville and burlesque performers with whom they came into contact during their early years in the business. What we do not know, in short, is how much of these characters the Marx Brothers themselves appropriated from others. All that is certain is that they created themselves, individually and collectively, as a kind of living derivative work. That much Groucho himself has told us,<sup>63</sup> but even without his candid admissions, it would be foolish and indeed ignorant of the history of burlesque and vaudeville to doubt that they took what they wanted from what they observed among the performers they grew up with, perhaps adding in the process important new material of their own.<sup>64</sup> To

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<sup>62</sup> Cf. Hoffman, *supra* note 20, at 136 (“[I]f defendants in publicity cases are accused of unjust enrichment, the accusation might be hurled with equal vigor at the heirs of a celebrity. It is the celebrity, not his heirs, whose labors created the publicity value”)

<sup>63</sup> I believe all comedians arrive by trial and error. This was certainly true in the old days of vaudeville, and I'm sure it's true today. The average team would consist of a straight man and a comic. The straight man would sing, dance or possibly do both. And the comedian would steal a few jokes from other acts and find a few in the newspapers and comic magazines. They would then proceed to play small-time vaudeville theaters, burlesque shows, night clubs and beer gardens. If the comic was inventive, he would gradually discard the stolen jokes and ones that died and try out some of his own. In time, if he was any good, he would emerge from the routing character he had started with and evolve into a distinct personality of his own. This has been my experience and also that of me brothers, and I believe this has been true of most of the other comedians.

G. MARX, GROUCHO AND ME 88(1959)

Of course, what Groucho is saying in this passage is that although he and his brothers began as borrowers they ended as inventors. That may be true but if it is, we want more proof of it than is in the *Day and Night* case. The point here is that we-and not the artist or his heirs-must be the ones to judge how much of the borrowed has been discarded in favor of the invented. If the invented is merely a compilation of discrete public domain elements (Groucho's “moustache, cigar, slouch, and leer,” for example; see *Day and Night*, 523 F. Supp. at 491) bound together by the now-disintegrating fabric of a man's one-time personality, it may make no sense at all to protect it as an abstraction after his death-which is essentially the point made by the authorities in note 61, *supra*; and if indeed, the effect of extending protection would be to preclude his reincarnated self from starting over, as seems likely, then the result truly becomes as perverse as the contemplation of it. For the central lesson in the passage from Groucho's book is that the process of creativity inevitably begins in borrowing. Compare Liebig, *supra* note 27, at 46-47 (quoted at note 129 *infra*). It is a central failing in the contemporary intellectual property literature and case law that that lesson, so widely acknowledged, is so imperfectly understood. Indeed, the absolute necessity of the trial-and-error process often seems to escape those proponents of new rights who appear to understand the process well. Compare, e.g. Note, *Performer's Style*, *supra* note 23, at 591-94.

<sup>64</sup> It is not churlish to demand proof of invention. Theft of material, through disapproved of, was endemic among vaudevillians:



be sure, the Marx Brothers became celebrities as most vaudevillians did not. But surely we are not rewarding them on that ground alone. Even in an age as celebrity-haunted as this, we cannot mean to establish dynasties on the memory of fame.<sup>65</sup> Our acknowledgment must be rooted in some legitimate perception of merit. Fame is not inconsistent with merit but neither is it evidence of merit. And if, as in the case of the Marx Brothers, we cannot judge the question of how much of their success was rooted in the original merit of others, then how are we to recognize the equity in their successors' claims? There is a failure of proof here: a failure originally to mark off the boundaries of the claim; a failure now to establish a right to title.<sup>66</sup>

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In his quest for material the vaudevillian too often stepped on his fellow artist, casing bitterness among the performers. *Variety* observed in 1928 that not only was material being lifted, but many acts credited the source of their piracy. Joe Laurie, Jr. believed that the stealing helped kill vaudeville because eventually it seemed as though everyone was doing the same act. Comedy acts were the easiest targets for piracy and for many years there was nothing that could be done. At any Palace opening matinee many small-timers sat in the audience, on the prowl for fresh material from headliners, since it afforded their theaters topflight material. Often an entire act was stolen. As Benny Rubin related, "Mel Klee did Al Herman, Mary May did Jack Benny . . . Sid Marion did Jack Pearl [and] there were more."

J. DiMEGLIO, VAUDEVILLE, U.S.A 76 (1973)

Sometimes, those who denounced piracy in others were not above reproach themselves:

Ben Blue was once accosted by W.C. Fields, himself notorious for lifting lines, and was accused of stealing a routine. Blue call Fields a liar and other performers finally convinced Fields that he had originally stolen the material from Blue. In an open letter in *Variety*, Bert Lahr accused Joe E. Brown of having stolen the Lahr character. Though Brown never replied, Sam Sidman, an old-time Dutch comedian, did, angrily. He claimed Lahr had stolen the character from him and not only that, but Sidman had stolen it from Sam Bernard. "I admit it, why don't you?": demanded Sidman of Lahr.

*Id.* at 77

I suspect that in some instances the taking was unintentional - a case, at worst, of unconscious plagiarism; in others, the taking (through intentional) may have been forgotten over the years, particularly as it joined with others in the evolution of "derivative works"; in still other instances, there may have been no talking at all the conventions of vaudeville and the expectations of audiences must have produced frequent similarity without deliberate theft. *See generally id.*

In any event, as I have suggested, it is entirely fair to inquire into claims of originality or invention, even among celebrities.

<sup>65</sup> *See* *Memphis Development Foundation v. Factors Etc. Inc.*, 616 F.2d 956, 959 (6<sup>th</sup> Cir. 1980)(Merritt, J.) ("Fame falls in the same category as reputation; it is an attribute from which others may benefit but may not own"). *See also* Hoffman, *supra* note 20, at 114 ("[I]n our publicity-conscious society, where anyone may achieve instant fame through media exposure, the large number of potential right of publicity plaintiffs . . . [suggests] that the scope of the right ought to be delineated with caution"). *See also id.* at 136-37. *But cf.* Sims, *supra* note 20, at 497; Brenner, *supra* note 2, at 46 ("By limiting descendibility to the standard used by copyright law, we can be fairly sure that history will not become the subdivided satrapy of descendants of once-famous people").

<sup>66</sup> *Cf.* Hoffman, *supra* note 20, at 142-43. Rarely, in a case with facts like the ones in *Day and Night*, has a court required a successful plaintiff to sustain even these preliminary, elementary burdens of proof. In general, the question of originality is ignored or taken for granted, *e.g.*, *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975), treated as though it were an existential quality presumptively evidenced by the fact of the defendant's borrowing, *e.g.* *Factors Etc. Inc. v. Pro Arts, Inc.* 579 F.2d 215, 221-22 (2d Cir. 1978), or reduced to the level of near-fawning: "An original creation of a fictional figure played exclusively by its creator may well be protectible. This Groucho Marx just being Groucho Marx, with his moustache, cigar, slouch and leer, cannot be exploited by others." *Lugosi v. Universal Pictures, Inc.* 25 Cal. 3d 813, 825-26, 603 P.2d 425, 432, 160 Cal. Rptr. 323, 330 (1979) (Mosk, J., concurring), *quoted with approval in* *Groucho Marx Productions, Inc. v. Day & Night Co.*, 523 F. Supp. 485, 491-92 (S.D.N.Y. 1981)). *But see* *Miller v. Universal Pictures Co.*, 10 N.Y. 2d 972, 180 N.E. 2d 248, 224 N.Y.S. 2d 662 (1961), *discussed in* *Whicher*, *supra* note 60, at 221. *Cf.* *KGB, Inc. v. Giannoulas*, 104 Cal. App. 3d 844, 164 Cal. Rptr. 571 (1980), *noted in* 21 SANTA CLARA L. REV.845 (1981)

The second question we must raise is whether offsetting costs to society may outweigh whatever equity there is in the claim. Again this is a question of some subtlety,<sup>67</sup> but we can begin by examining the position of the writers in the *Day and Night* case. What they sought to do, by their own account, “was to write a satiric comment on Hollywood movies using a parody of the Marx Brothers movies as one of the literary devices.”<sup>68</sup> The work they produced earned substantial public acceptance and, despite the court’s opinion, has a least some claim to acceptance as a creative success as well.<sup>69</sup> Yet the result of this litigation is that the work no longer can be performed as written without accommodating the plaintiffs in some fashion. In a case like this, then, what society loses is a right of access amounting to an easement. In at least a preliminary sense, this is always the result of upholding a claim to a right of publicity. Such disputes as there may be about this cost can never amount to more than an attack on the value of the work; the loss itself is a constant. We see this lesson in *Day and Night* in the trial judge’s dismissal of that work as imitative. But the decision whether society’s loss should be borne in a given case should not turn on the unlettered opinion of a trial judge about the merits of a defendant’s work. Trial judges’ opinions in matters of this sort are notoriously apt to be foolish or bourgeois or both or worse. And as long as a plaintiff’s claim is accepted without substantial inquiry into its underlying merits, the effect of the law will be to create an undeserved presumption in favor of plaintiffs which will cast the burden of proof and persuasion alike on defendants and will subject us all to the risk of exactly the sort of judgment we see in the *Day and Night* case.

Meanwhile, the most startling fact about the law of publicity is that, until claims like these began to be recognized a decade or so ago, the writers in the *Day and Night* case would have had a right to do exactly as they did.<sup>70</sup> In other words, here is a case in which recognition of the plaintiffs’ claim—which rests so far as we can tell on no more than the commercial value of the claim itself - results in the appropriation of what is an equally valuable interest which, until recently, would have belonged to the defendants. And I must say that I am at a loss to understand the casual, tendentious, self-assertive basis upon which so fundamental and sweeping a transfer of interests has been made. Certainly, it cannot legitimately turn of anything as simple as a proposition about where the economic value of the

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<sup>67</sup> See Hoffman, *supra* note 20, at 122-33

<sup>68</sup> Groucho Marx Productions, Inc. v. Day & Night Co. 523 F.2d. 485, 493 (S.D.N.Y. 1981)

<sup>69</sup> “A Night in the Ukraine,” . . . is the screenplay that Anton Chekhov did not write for the Marx Brothers. The source of the script is Chekhov’s “The Bear,” that short vaudeville that made Tolstoy laugh. If he had seen “A Night in the Ukraine,” Tolstoy might have grinned all the way home to Yasnaya Polyana. . . . As written by Mr. Vosburgh, this is a crackling compendium of Marx Brothers comedies. . . .

Gussow, *Theatre: ‘Hollywood/Ukraine,’* New York Times, May 2, 1980, at C3col. 1. See also notes 52, 55 *supra*. But see Rich, *Stage View: shows That Examine Showbiz,* N.Y. Times, May 18, 1980, § 2, at 3 col. 3 (“All the old movie routines are down pat, but they aren’t refracted through a new sensibility . . . The authors don’t parody or comment upon the Marx Brothers. . . . This flat rehash seems superfluous and decadent”).

<sup>70</sup> The point was sometimes made in the pre-Lugosi literature that “on the practical side. . . most authors and producers of properties which exploit deceased persons obtain releases rather than lawsuits” Donenfeld, *supra* note 27, at 25. But the law itself did not require such precautions:

In summary, the law as it now stands does not afford any right of action for the use of the name, likeness or personality of a deceased person. The personal representatives and heirs of a personality are without recourse to the courts unless their own right of privacy has been infringed.

*Id.* at 25.

interests reside; they reside wherever the law permits them to reside.<sup>71</sup> It simply is not clear why suddenly the law should recognize claims in plaintiffs when recognition can come only at the expense of interests previously recognized in defendants.<sup>72</sup> The only real explanation for this anomaly appears to be that the defendants' interests amounted to no more than individual rights in the public domain. And as such, they received no more adequate recognition than does the public domain itself.

What the *Day and Night* case reveals, then, are two of the more serious recurring problems in this important new field of intellectual property law. One is that the plaintiff's action, to borrow an idea from the late Harry Kalven, lacks "profile"; the prima facie case is too indistinct, the presumption accorded to the plaintiff too generous.<sup>73</sup> The second is that the defenses now available are equally too indistinct; the first amendment is wholly inadequate as a tool for controlling the development of intellectual property rights<sup>74</sup> and there is no other defense reliably available on more than an ad hoc basis.<sup>75</sup> The result of the interaction between these two inadequacies in the law is to allow the preemption by default of substantial individual rights in the public domain. As access to the public domain is choked, or even closed off altogether, the public loses too: loses the rich heritage of its culture, the rich presence of new works derived from that culture, and the rich promise of works to come. If we must make room in the law for claims of publicity rights, then we must also make an equally clear, discerning and forthcoming reservation of the rights to be enjoyed freely by individuals in the public domain. Otherwise this area of law promises to go on providing, as I think it has done in the past ten years, examples of simple opportunism perhaps without parallel in the history of intellectual

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<sup>71</sup> Cf. Breyer, *supra* note 20, at 284-86. *But see* Comment, *Premature Burial*, *supra* note 20, at 995-97. The author of the Comment proposes reliance on a more general economic analysis of privacy (and, in passing, publicity) by Professor Posner which I find largely unpersuasive but which, happily, has been denounced in satisfactory measure by others. *See generally* Symposium, *Privacy and Economics*, 12 GA. L. REV. 393-534 (1978). *See* Bloustein, *id.* at 448.

<sup>72</sup> *See* Hoffman, *supra* note 20, at 122-23. My point here is limited to the post-death claims of successors in interest. *See* Memphis Development Foundation v. Factors Etc., Inc. 616 F.2d 956, 959-60 (6<sup>th</sup> Cir.1980). Different considerations make the personal claims of a celebrity (or other person) during his lifetime appear to be substantially less objectionable. *See* Hoffman, *supra* note 20, at 133-39; *cf.* Lugosi v. Universal Pictures, Inc. 25 Cal. 3d. 813, 821-22, 603 P.2d 425, 430, 160 Cal. Rptr. 323, 328 (1979)

<sup>73</sup> *See* Kalven, *Privacy in Torts Law- Were Warren and Brandeis Wrong?*, 31 LAW & COMTEMPS. PROBS. 326, 333 (1966). *Cf.* Felcher & Rubin, *Real People*, *supra* note 29, at 1622.

<sup>74</sup> Although it has become conventional to discuss the right of publicity in terms of first amendment values, *e.g.* Note, *First Amendment Theory*, *supra* note 29, the first amendment is too broad-gauged to lend itself to useful reduction in the service of property theories. On the one hand, for example, it is likely to be unavailable when the challenged appropriation seems "exploitative," Felcher & Rubin, *Real People*, *supra* note 29, at 1606, 1622, or "trivial," *see e.g.*, Hoffman, *supra* note 20 at 127, even though a careful economic assessment of public domain theory might lead to an entirely different outcome. *See* Memphis Development Foundation v. Factors Etc. , 616 F.2d 956, 959-60 (6<sup>th</sup> Cir. 1989). On the other hand, first amendment theory itself may be insufficiently sensitive to legitimate economic interest. *See* Nimmer, *The Rights to Speak From Times to Time*, 56 CALIF. L. REV. 935, 957-58 (1968). *But see* Goetsch, *Parody as Free Speech - The Replacement of the Fair Use Doctrine By First Amendment Protection* 3 W.NEW ENG. L.REV. 39 58-66 (1980); Kulzick & Hogue, *supra* note 20; Patterson, *supra* note 3; Goldstein, *supra* note 19; Nimmer, *supra* note 20. *Cf.* Leavens, *In Defense of the Unauthorized Use: Recent Developments in Defending Copyright Infringement*, 44 LAW & COMTEMP. PROBS. 279, 298-302 (1982).

<sup>75</sup> *See* Hoffman, *supra* note 20, at 145 ("The precise contours of the right of publicity continue to be drawn on a case-by-case basis"). *Cf.* Shipley, *supra* note 31, at 737 (suggesting categories of publicity rights that ought to be subject to preemption but concluding that preemption will have to be worked out "on a case-by-case basis").

property.<sup>76</sup>

In the concluding section of this article, I will suggest some of the ways in which courts ought to begin to make deliberate provision for these public domain interests, but before I come to those suggestions, I want to pay attention to two additional cases which shed light on other ways in which intellectual property claims have been proliferating in recent years.

In *DC Comics, Inc. v. Board of Trustees*,<sup>77</sup> we see how easily the “unfair competition” can be invested with fresh and ironic meaning by overzealous plaintiffs. At the Richard J. Daley campus of the City Colleges of Chicago a group of students decided to call their school paper *The Daley Planet*. That they did so having in mind the “Daily Planet” of Superman fame would have seemed probable to anyone whose own childhood had occurred since the late 1930s, but, as if to remove any doubt, the students also selected for their masthead a log in the form of a planet was well as the motto “Truth, Justice and the American Way.”<sup>79</sup> There is, in short, no question that the students were influenced by some appreciation for the newspaper which had figured prominently in the private life of Clark Kent. This much can be taken as a given, though the question might be asked how anyone but the students could have cared.

As it happened, the owners of Superman did care. DC Comics, Inc., as plaintiff, brought suit against the Board of Trustees of Chicago’s City Colleges on no fewer than four claims of important violations of the plaintiff’s interest. The first claim was that the students’ selection of the name and the slogan amounted to “a false designation or representation as to the source of origin or sponsorship thereof,” a violation of section 43(a) of the Lanham Act.<sup>80</sup> The second claim alleged the plaintiff’s ownership of a registered mark in the “Daily Planet in conjunction with the Representation of a Planet for a newsletter in the form of a newspaper dealing with comic book news and characters,” and charged that “use of the designation Daley Planet . . . [was] likely to cause confusion or to cause mistake or to deceive . . . ,” in violation of the Trademark Act of 1946.<sup>81</sup> A third claim alleged that the name *Daley Planet* was “likely to dilute the distinctive quality of plaintiff’s Daily Planet name and trademark and . . . [was] likely to injure the plaintiff’s business reputation,”<sup>82</sup> in violation of the Illinois Anti-Dilution Statute (to which I shall pay more particular attention later in this essay).<sup>83</sup> The final law trademark infringement and unfair competition as well as deceptive trade practices within the meaning

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<sup>76</sup> Compare *Memphis Development Foundation v. Factors Etc., Inc.*, 616 F.2d 956, 959 (6<sup>th</sup> Cir. 1980) (Merritt, J.) (“Heretofore, the law has always thought that leaving a good name to one’s children is sufficient reward in itself for the individual, whether famous or not. Commercialization of this virtue after death in the hands of heirs is contrary to our legal tradition and somehow seems contrary to the moral presuppositions of our culture”).

Compare also the prophetic (1969) warning in Liebig, *supra* note 27, at 46-47 (quoted at note 129 *infra*).

<sup>77</sup> No. 81 C 2402 (N.D. Ill, filed June 17, 1981).

<sup>79</sup> See Defendant’s Answer, *DC Comics, Inc. Board of Trustees*, No. 81 C 2402 (N.D. Ill, filed June 17, 1981)

<sup>80</sup> *Id.* at 8

<sup>81</sup> *Id.* at 10.

<sup>82</sup> *Id.* at 12.

<sup>83</sup> See text accompanying notes 105-09 *infra*

of the Illinois Uniform Deceptive Trade Practices Act . . . in that said uses . . . [were] likely to cause confusion or misunderstanding as to the source, sponsorship or approval of defendant's newspapers [*sic*], and . . . [were] likely to cause confusion or misunderstanding as to the affiliation, connection or association of Defendant with Plaintiff.<sup>84</sup>

The defendants, of course, were obliged to take each of these claims seriously and to respond to them with earnest denials rooted firmly in law.<sup>85</sup> But I am free to recognize them for the utter nonsense they are. Legitimate works deserve protection from real threats. But claims of this kind are so extravagant in relation to the reality from which in theory they ought to spring that one is tempted not merely to dismiss them as nonsense, but to suggest in addition that one day one of them ought to be made the subject of a serious counterclaim for punitive damages rooted in some new tort designed expressly for the purpose, perhaps to be termed "unconscionable overreaching."<sup>86</sup> Not, let me hasten to add, that either the plaintiff or the lawyers who filed the complaint in this case necessarily acted in bad faith. There is not room in this essay for an extended review of the law of trademarks and unfair competition.<sup>87</sup> But if I am to call attention to one unacceptable development in the law, I must also acknowledge another, that trademark proprietors and their lawyers are probably sometimes forced into unwelcome police actions on behalf of their marks by the realistic concern that inaction can lead to a weakened mark or even to its loss. The truth is, I am afraid, that overreaching claims are virtually synonymous with sound trademark management.<sup>88</sup> If so, it would hardly be fair to single out one recent complaint for harsh criticism derived from a premature conception of bad faith.

But it does not follow that we must be respectful toward the claims actually advanced in this setting. In a very real sense, they themselves are contemptuous of the ordinary discourses one would

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<sup>84</sup> Defendant's Answer, *DC Comics, Inc. v. Board of Trustees*, No. 81 C 2402 (N.D. Ill., filed June 17, 1981), at 14

<sup>85</sup> *See generally id*

<sup>86</sup> *Cf. Gibbs, Copyright Misuse: Thirty Years Waiting for the Other Shoe*, 23 ASCAP COPYRIGHT L. SYMP. 31, 78-79 (1973). *But cf. Derenberg, supra* note 20, 1213.

<sup>87</sup> *See generally McClure, supra* note 49

<sup>88</sup> Consider, for example, the following advice to be found in a leading treatise in the field: However tenuous his position, the trademark owner must take measures calculated to preserve the distinctiveness of his mark. Many cases have turned on the owner's conduct in this regard and the fate of his mark may depend upon his action or inaction. He must in proper time, and with proper means protect against and take affirmative action to prevent the use of the trademark by others. He must also make objection to the appearance of his mark in dictionaries, essays, scientific articles and the like, though reference thereto in such publications is not conclusive proof of its generic nature. The evolution of a distinctive word into a generic term is only possible in the undisturbed course of common usage.

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The action of the trademark owner against one who makes use of his mark in a descriptive sense—he need not be a competitor; he may be the author of a scientific article—is a typical property case. The plaintiff sues to prevent an imminent or future loss of his trademark by dilution. In such a case, the court must not only decide whether the defendant is likely to continue his injurious acts, but also whether the injury, if continued, is likely to deprive the trademark of its distinctiveness; this, of course, involves a prediction of future developments, which may be too remote to warrant consideration. In principle, however, the issue is similar to that involved in a suit by a trademark owner against one who uses a confusingly similar mark. In both cases, the trademark runs the risk of becoming *publici juris*.

3 R. CALLMAN, *THE LAW OF UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES* § 74.2, at 240-43 (3d. Ed. 1969). *Abut cf. Behrendt, Trademarks and Monopolies—Historical and Conceptual Foundations* 51 TRADEMARK REP. 853 (1961)

sensibly expect a society to permit. I have acknowledged that in selecting the name, logo and slogan for their school paper, the students at Daley City College undoubtedly knew that the origins of their inspiration lay partly in the development of the Superman character. At the same time, the conversion of “Daily” to “Daley” - with its explicit invocation of the college’s own name, and perhaps an implicit suggestion of some relationship to a colorful former Chicago mayor whom many saw as a “Superman” in his own right - ought to be enough to signal that the students were having, as students will, a bit of sport. Far from diluting anyone’s mark, much less misleading the public, they were simply essaying a modest joke. Even the Man of Steel must yield to gentle humor.<sup>89</sup>

The immediate lesson in the Daley Planet case seems clear enough. When the proprietor of a mark presumes to intrude into the relationship which the subject of the mark may have contracted with the public in some setting essentially beyond the proprietor’s own undertakings - as Superman and all his friends and enemies have a place in the estimation of the American public that simply has nothing to do with the parochial interests of DC Comics, Inc. - proprietor goes well beyond any purpose legitimate in the law of trademarks and begins, indeed, to engage in an appropriation of its own. It is tempting, but inadequate, to see this as simply a corollary of the rule that trademarks are lost as they take on generic significance.<sup>90</sup> The lesson in the *Daley Planet* case ought to derive instead from a more fundamental recognition of separate rights in the public domain.

Meanwhile, there are two additional lessons in this case that go beyond its own facts. One (again) is that proprietors of trademarks and related impedimenta are subject to natural pressures to expand the boundaries of their interests, even at the risk of appearing silly or rapacious and not infrequently at the cost of expropriatory incursions into the public domain. The pressures are acute, a trademark exists only insofar as the proprietor can persuade the public to recognize it from time to time.<sup>91</sup> Proprietors cannot be expected to restrain themselves. It is all the more essential, then, that courts respond firmly and clearly to threats to the public domain in these cases. The second lesson is akin to the first, but is broader in its implications. In his original article proposing a right of publicity almost thirty years ago, Professor Nimmer warned that a broad theory of unfair competition would prove unsatisfactory as an alternative to a discrete property theory. In essence, he argued that a broad theory could not be satisfactorily contained.<sup>92</sup> Our experience with the expanding boundaries of trademark and unfair competition cases shows, at least indirectly, just how right he was. Unfair competition theory no longer is confined to its legitimate original purpose, which was to prevent deception or confusion in the context of actual competition.<sup>93</sup> Nor is it confined to its later, more

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<sup>89</sup> See *Carson v. Her’s Johnny Portable Toilets, Inc.* 498 F. Supp. 71 (E.D. Mich. 1980).

I should perhaps add at this point that my own, more caustic comments on this pending litigation are meant to be taken only semi-seriously, and not at all *ad hominem*. To be sure, I am genuinely horrified by the sweep and direction of contemporary trademark and unfair competition law - and the *Daley Planet* case is as good an example as any of what seems undesirable in this law - but still, my criticism is of theories rather than parties. And I recognize that the plaintiffs in this litigation may yet have the last laugh

<sup>90</sup> See generally 3 R. CALLMAN, *supra* note 88 § 74.2 (Supp. 1981)

<sup>91</sup> See *id.* § 84.2, at 955

<sup>92</sup> Nimmer, *supra* note 25, at 213-14

<sup>93</sup> See Laff & Saret, *supra* note 46, at 50. See generally McClure, *supra* note 49; cf. Stern & Hoffman, *supra* note 20

doubtful task of preventing competitive misappropriations.<sup>94</sup> Today, the theory has been expanded to embrace not merely threats arising from the marketplace but threats from any quarter to an intellectual property *res* itself infinitely protean.<sup>95</sup> The resulting protection guards against the adverse consequences of unfair competition, as it always did, but it does more than that, by far: in effect, it runs against any diminution in the value of any hypothetical interest, and thus it converts each interest into a mutable species of mutant property distastefully reminiscent of *The Alien*<sup>96</sup>.

The existence of this new form of property is implied in the plaintiff's claims in the *Daley Planet* case. But its existence is to be seen even more clearly in the opinion in another case which also was filed in the Northern District of Illinois. In *Instrumentalist Co. v. Marine Corps League*,<sup>97</sup> the mere threat of a dilution of the plaintiff's interest in a mark was held sufficient to justify injunctive relief. This was so, as we will see, not merely in spite of or in addition to some prospect of deception or confusion or mistake, but rather because there were no such prospects at all.

In *Marine Corps League*, the plaintiff was the corporate publisher of a magazine called *The Instrumentalist*, described in the opinion as "a national music magazine devoted exclusively to school

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<sup>94</sup> See Note, *Copying-Misappropriation*, *supra* note 23, at 1458-73

<sup>95</sup> Cf. Brown *Elegiac Reflections*, *supra* note 20, at 1044 (commenting on the impact of *Goldstein v. California* before the passage of the 1976 Act: "So instead of a shapeless tort (or crime) of misappropriation, we have the new recognition of a state copyright power that may extend to any kind of work that is not explicitly preempted").

<sup>96</sup> In a sense it is somewhat misleading to refer to this kind of property as "new" since, in the form of dilution at least, it has had its advocates in this country for years. See Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927). But Schechter was concerned for the protection of "distinctive" marks or names in the marketplace; there is nothing in his work to suggest that he would have subscribed to the broader effort toward apotheosis for a mark implicit in a case like *Daley Planet*. Moreover, courts had not proved receptive to dilution theory until recent years. See Patishall, *The Dilution Rationale for Trademark*, 71 NW. UNIV. L. REV. 618, 621-22, 631-33 (1976); McClure, *supra* note 87, at 345. See also *Winner*, *supra* note 88 § 84.2, at 956-64 (Supp. 1981). Thus the appearance of cases applying dilution theory in the absence of competition, e.g., *Edgewater Beach Apts. Corp. v. Edgewater Beach Mgmt. Co., Inc.*, 12 Ill. App. 3d. 526, 299 N.E.2d 548 (1<sup>st</sup> Dist. 1973), followed in *Instrumentalist Co. v. Marine Corps League*, 509 F. Supp. 323 (N.D. Ill. 1981), can be described as "new" though the theory itself is not. Cf. 3 R. CALLMAN, *supra* note 88, § 84.2 at 959-60 (:Some opinions suggest increasing judicial perception along these lines, but the optimism they generate is negated by other opinions which demonstrate the difficulty of 'adjusting' our courts to a comparatively new concept"). Cf. *Winner*, *supra* note 29, cited in note 110 *infra*.

On the nature of dilution theory, Callmann has written: "One court, construing the Illinois statute properly remarks that . . . '[its scope] is at least as broad as infringement under the Lanham Act or unfair competition under the Illinois law.' It is, however, much broader because it is a law which is directed not against unfair competition as such, but against trespass on the property right in the trademark." 3R. CALLMANN, *supra* note 88, § 84.2, at 963. *But cf. id.* at 962 ("A dilution statute does not replace the common-law of unfair completion. It merely widens and clarifies one area of unfair competition and is a supplement to the common law rights. The statutes go further in that they provide protection against the 'likelihood of dilution' . . . "The dilution statutes presently limit relief to the injunction. The plaintiff cannot claim damages or seek an accounting for profits"). This is a useful and accurate summary of dilution theory up to a point. What it does not take into account, however, is that once a plaintiff has obtained an injunction, it may then seek royalties under a license. Thus, the similarities between dilution theory and common law copyright (or other, similar forms of intellectual property) are potentially much greater than may at first appear. *Id.* At 963.

Meanwhile, in a still more general sense, the laws of copyright, trademarks and unfair competition have long been recognized as overlapping. See generally, e.g., Laff & Saret, *supra* note 3, at 1193-1200; McClure, *supra* note 49. Cf. Brown, *Elegiac Reflections*, *supra* note 20, at 1044. Compare Whicher, *supra* note 60, at 219-20; Liebig, *supra* note 27, at 42

<sup>97</sup> 509 F. Supp. 323 (N.D.Ill. 1981).

band and orchestra directors and to teachers of instrumental music.’<sup>98</sup> Annually, for some years, *The Instrumentalist* had made awards to outstanding high school band members and musicians. The awards were called the “John Philip Sousa Band Award” and featured the name and likeness of Sousa, reproduced in various prizes associated with the award (such as lapel pins or marble desk pieces) as well as in the certificate itself.<sup>99</sup> *The Instrumentalist* had acquired “authorization” to issue the award from Sousa’s children in 1954.<sup>100</sup> On one occasion, some twelve years later, *The Instrumentalist* had sought unsuccessfully to register the Sousa likeness with the Patent Office, but it was not until 1973 that Sousa’s name finally was made the subject of a successful application.<sup>101</sup>

Meanwhile, the Marine Corps League, which is affiliated with the United States Marine Corps, also had given annual awards for outstanding musicianship. In 1980, at the urging of its Director, a retired Marine General, the League proposed to call its award the “John Philip Sousa Award for Musical Excellence.” At the time, the League knew nothing of *The Instrumentalist*, but when it learned of the magazine’s priority in the use of Sousa’s name, it decided to change the name of its own award to the Semper Fidelis Award.” That name the League derived from the motto of the Corps as well as from the march which Sousa had composed while he was still Director of the Marine Corps Band.<sup>102</sup> The League continued to use Sousa’s picture as a prominent part of its award. The award also included a biographical sketch of Sousa’s association with the Marine Band.<sup>103</sup>

Learning of the continued uses of Sousa’s name and likeness, and taking them to be violations of understandings reached in earlier correspondence with the League, the plaintiff brought suit alleging Lanham Act violations as well as common law trademark infringements and unfair competition.<sup>104</sup> In the course of a hearing on a motion for preliminary injunction, the plaintiff also sought the protection of the Illinois Anti-Dilution Statute,<sup>105</sup> which provides that any use of a mark in circumstances in which “there exists a likelihood of injury to business reputation or of dilution of a distinctive quality of . . . [a prior user’s] mark” maybe enjoined “notwithstanding the absence of competition between the parties or confusion as to the source of goods or services . . .”<sup>106</sup> In deciding whether to issue a preliminary injunction against the League, the court found that there was insufficient evidence of probable confusion

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<sup>98</sup> *Id.* at 325.

<sup>99</sup> The awards and related impedimenta actually appear to have been sold to schools which elected to take advantage of the magazine’s program; but it is clear that the awards were highly regarded by those who received them. *See id.* at 326, 332.

<sup>100</sup> *Id.* Sousa had died in 1932. The nature of the permission granted is not clear. Apparently, Sousa’s children had engaged in some efforts to promote their father’s memory on the centennial anniversary of his birth. *See* P. BIERLY, JOHN PHILLIP SOUSA: AMERICAN PHENOMENON 215-17 (1973).

<sup>101</sup> 509 F. Supp. at 326. The application was filed in 1973; the certificate issued in 1976. As the court noted, a service mark registration might have seemed more appropriate in the circumstances of the case, *see id.* at 325 n.1, 326, but if so that does not appear to have been the magazine’s fault; the application originally called for a service mark but was amended “in response to Patent and Trademark Office Actions . . .” *Id.* at 326.

<sup>102</sup> *See id.* at 326-27. *See also* P. BIERLY, *supra* note 100, at 47

<sup>103</sup> 509 F.Supp. at 327

<sup>104</sup> *Id.* at 325

<sup>105</sup> 509 F. Supp. at 327; Illinois Trademarks Act, ILL. REV. STAT. Ch. 140, § 22 (Supp. 1981-82)

<sup>106</sup> Illinois Trademarks Act., ILL. REV. STAT. Ch. 140, § 22 (Supp. 1981-82)



to warrant relief on trademark of unfair competition grounds.<sup>107</sup> But the court held that an injunction could be issued to prevent the “dilution” forbidden by the Illinois statute. Indeed, the court noted, the statute did not require either a likelihood of confusion or even competition between the two uses: “in fact Illinois case law indicates that the statute was intended to operate *only* where relief is unavailable under traditional theories of unfair competition, under which likelihood of confusion and existence of competition are usually requisite elements.”<sup>108</sup> The effect of the dilution statute, then, was to convert the very weaknesses in the plaintiff’s trademark and unfair competition claims into an advantage:

[A]lthough (or perhaps because) Instrumentalist has not shown the requisite likelihood of confusion to support an injunction under the Lanham Act, Instrumentalist may still obtain relief under the Illinois Anti-Dilution statute provided it demonstrates a “likelihood of success on the merits” as to whether the Semper Fidelis Award “dilutes” the Sousa Award.<sup>109</sup>

Given the thrust of the statute, it will surprise no one to learn that the court found that the League’s use of the name and likeness of John Philip Sousa in connection with its award would tend to “dilute” the “distinctiveness” of the plaintiff’s mark.

It is surely unnecessary to comment at length on this case. The Marine Corps - which gave birth and direction to Sousa’s musical career, which sustained him as he composed some of his most important marches, and from whose own motto he appropriated the title to one of the most memorable of his works - may not draw “prominent” attention to its relationship with the composer because of the adventitious earlier use of his name and likeness by an obscure band magazine licensed to those uses by the composer’s children. The case is a paradigm. The result speaks for itself. But what makes *Marine Corps League* truly archetypal among the forces at play in contemporary intellectual property theory is the virtual absence of recognizable legal principle in this result. Indifferent to discovery or invention, indifferent as well to deception or confusion or competition, but responsive to mere priority, the law of dilution tugs at its own bootstraps and succeeds in lowering itself to a level of supervenience at which all thought of the public domain has been lost.<sup>110</sup>

### III

I have sketched, in deliberately impressionistic fashion, some directions in the field of intellectual property which I believe to have been taken unwisely in recent years. I have meant to convey two principal objections to the new thrust of the definition and frequently lacks either a substantial showing

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<sup>107</sup> 509 F. Supp. at 327-31

<sup>108</sup> *Id.* at 332 [emphasis in original]. *See id.* at 331-32

<sup>109</sup> *Id.* At 332.

<sup>110</sup> *But see* Whinner, *supra* note 29, at 205-06 (noting *Marine Corps League* with favor, characterizing it as an “exception rather than the rule,” and offering a more general defense of “undiluted dilution” theory). Ms. Winner’s article is of additional interest in that it suggests an explicit link between dilution theory and the right of publicity. *See generally id.* Cf. Laff & Saret, *supra* note, 46, at 55.

of entitlement or any realistic evidence of a taking. The other is that the very momentum of these expanding claims tends to blur, and then displace, important individual and collective rights in the public domain.<sup>111</sup>

The plaintiffs in these cases rarely are in a position to demonstrate the extent of their inventions. Bella Lugosi was not the first actor to impersonate a figure of horror; the Marx Brothers were not the only vaudevillians to move from split weeks in Waukegan to success on a wider stage. How much did they borrow? How much did they create? The proprietors of Superman may be in a position to show that their predecessors did invent the name “daily Planet,” but they have not suffered any taking. And in the case of John Philip Sousa, his career cannot sensibly be made the exclusive property of anyone. As with any other figure in American history, he belongs to the American people, individually as well as collectively, and I would think to the United States Marine Corps, to whom he owed much, as well.

I take satisfaction in knowing that Groucho Marx would have agreed with these objections completely. He voiced them himself in a letter he wrote to Jack and Harry Warner in the course of pre-production for *A Night in Casablanca*. The Warners were claiming a proprietary interest in the title *Casablanca* which, the said, would be adversely affected if the Marx Brothers released their picture under its proposed title. “Dear Warner Brothers,” Groucho replied:

Apparently there is more than one way of conquering a city and holding it as your own. For example, up to the time that we contemplated making this picture, I had no idea that the city of Casablanca belonged exclusively to Warner Brothers. However, it was only a few days after our announcement appeared that we received your long, ominous legal document warning us not to use the name Casablanca.

It seems that in 1471, Ferdinand Balboa Warner, your great-great-grandfather, while looking for a shortcut to the city of Burbank, had stumbled on the shores of Africa and, raising his alpenstock (which he later turned in for a hundred shares of the common), named it Casablanca.

I just don’t understand your attitude. Even if you plan on rereleasing your picture, I am sure that the average movie fan could learn in time to distinguish between Ingrid Bergman and Harpo. I don’t know whether I could, but I certainly would like to try.<sup>112</sup>

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<sup>111</sup> “Emphasis on the protected domain leads to neglect of the public domain.” Brown, *Unification*, *supra* note 20, at 1093. *See also* B. KAPLAN, *supra* note 1, at 76-77.

For a suggested comparison between individual and collective interests in the copyright field, see Patterson, *Copyright and the Public Interest* in A. KENT & H. LANCOUR, *supra* note 20, at 48. *See also* Goldstein, *supra* note 19, at 1014-15. *Cf.* Krasilovsky, *supra* note 20, at 213 (“The public in whose interest the public domain is established wears several hats . . . the manufacturer-producer . . . the creative artist . . . [and] the consuming public . . .”)

<sup>112</sup> THE GROUCHO LETTERS 14 (A. Sheedman ed. 1967).

There was more. Warning to his subject, he continued:

You claim you own Casablanca and that no one else can use that name without your permission. What about “Warner Brother”? Do you own that, too? You probably have the right to use the name Warner, but what about Brothers? Professionally, we were brothers long before you were. We were touring the sticks as The Marx Brothers when Vitaphone was still a gleam in the inventor’s eye, and even before us there had been other brothers - the Smith Brothers; the Brothers Karamzov; Dan Brothers, and outfielder with Detroit, and “Brother, Can you Spare a Dime? (This was originally “Brothers, Can You Spare a Dime?: but this was spreading a dime pretty thin, so they threw out one brother, gave all the money to the other and whittled it down to, “Brother, Can You Spare a Dime?”). Now Jack, how about you? Do you maintain that yours is an original name? Well, it’s not. It was used long before you were born. Offhand, I can think of two Jacks - there was Jack of “Jack and the Beanstalk,” and Jack the Ripper, who cut quite a figure in his day. As for you, Harry, you probably sign your checks, sure in the belief that you are the first Harry of all time and that all other Harrys are imposters. I can think of two Harrys that preceded you. There was Lighthouse Harry of Revolutionary fame and a Harry Appelbaum who lived on the corner of 93<sup>rd</sup> Street and Lexington Avenue. Unfortunately, Appelbaum wasn’t too well known. The last I heard of him, he was selling neckties at Weber and Helibroner.<sup>113</sup>

But Groucho was willing to entertain he thought that the Warners themselves might be innocent:

This all seems to add up to a pretty bitter tirade, but I assure you it’s not meant to. I love Warners. Some of my best friends are Warner Brothers. It is even possible that I am doing you an injustice and that you, yourselves, know nothing at all about his dog-in-the Wanger attitude. It wouldn’t surprise me at all to discover that the heads of your legal department are unaware of this absurd dispute, for I am acquainted with many of them and they are fine fellows with curly black hair, double-breasted suits and a love of their fellow man that out-Saroyans Saroyan.

I have a hunch that this attempt to prevent us from using the title is the brainchild of some ferret-faced shyster, serving a brief apprenticeship in your legal department. I know the type well-hot out of law school, hungry for success and too ambitious to follow the natural laws of promotion. This bar sinister probably needled your attorneys, most of

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<sup>113</sup> *Id.* at 14-15

whom are fine follows with curly black hair, double-breasted suits, etc., into attempting to enjoin us. Well, he won't get away with it!! We'll fight him to the highest court! No patsy-faced legal adventurer is going to cause bad blood between the Warners and the Marxes. We are all brother under the skin and we'll remain friends till the last reel of "A Night in Casablanca" goes tumbling over the spool.<sup>114</sup>

In the last paragraph of his letter, I have a hunch Groucho may have given us an example of what Professor Kalven called "an insight more fundamental than we can use."<sup>115</sup> But at least the suggestion that the public could be relied onto do its own refereeing among claims was sound advice when he offered it and still is.<sup>116</sup> In this final portion of my own essay, I will suggest some other ways courts might respond when unwarranted claims of intellectual property are advanced.

First, courts might begin to deal with overreaching plaintiffs as competent parents learn in time to deal with greedy children, by saying "no." In some instances, the negative response ought to be categorical; dilution theory as reflected in *Marine Corps League*, for example, is probably always unsound.<sup>117</sup> In this area, and others affected by statutes, courts should be particularly attentive to the possibility of preemption under the 1976 Copyright Act.<sup>118</sup> Claims of injury to business reputation presumably would be beyond the reach of preemption;<sup>119</sup> but section 301 would appear to allow preemption of at least as much of state dilution laws as are protective of property-equivalent interests

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<sup>114</sup> *Id.* At 16

<sup>115</sup> Kalven, *Broadcasting, Public Policy and the First Amendment*, 10 J. LAW & ECON. 15,30 (1967)

<sup>116</sup> Cf. B. KAPLAN, *supra* note 1, at 57 ("Passing off theory is naturally invoked when the copyright theory seems thin, but will often be found a pretense, the public being neither concerned not confused about source").

<sup>117</sup> If dilution theory were confined strictly so as to apply only to appropriations of highly distinctive marks in the course of marketplace transaction- essentially as Schechter himself seems to have envisioned, *see* note 96 *supra* - then perhaps it would prove less troublesome. But it would still be subject to criticism on grounds of lack of adequate definitional precision. Cf. Laff & Saret, *supra* note 50-56.

<sup>118</sup> 17 U.S.C. § 301 (Supp. I 1977):

(a) On and after January 1, 1978, 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 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes or any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to -

(1) subject matter that does not come within the subject matter of copyright as specified by section 102, and 103, including works of authorship not fixed in any tangible medium of expression; or  
(2) any cause of action arising from undertakings commenced before January 1, 1978; or  
(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.

<sup>119</sup> Rights in reputation would not normally be "equivalent" to the sort of property rights protected by § 106 of the Act, and thus would be exempt from preemption pursuant to the terms of § 301(b)(3). *See* H.R. REP., *supra* note 5, at 132. *See also* 1 M. NIMMER, *supra* note 5, § 1.01[B], at 1-13.

expressed in tangible form.<sup>120</sup> Professor David Shipley has published an article recently in which he has carefully demonstrated how publicity theory also is vulnerable to preemption under section 301.<sup>121</sup> In general, preemption should be recognized readily, not grudgingly, in all permissible fields of intellectual property theory, and as broadly as the limits of section 301 permit.<sup>122</sup> Even when a categorical negative response appears unwise, a court should not hesitate to say “no” in less sweeping terms. One writer has suggested, for example, that a fair use doctrine be applied to publicity theory to augment the inadequate defenses now available in that field.<sup>123</sup> Meanwhile, courts must be sensitive to the taking too trivial to be actionable<sup>124</sup> as well as the taking which produces apportionable profits.<sup>125</sup> In doubtful cases, for reasons I have previously addressed, the defendant ought always to prevail.

Second, courts ought to indulge at least a presumption against new claims. Perhaps it is too

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<sup>120</sup> See Brown, *Unification*, *supra* note 20, at 1097-99; cf. Goldstein, *Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright* 24 U.C.L.A. L. REV. 1107, 1116-17 (1977). This would appear to be so even though most of the expression protected by dilution theory probably would be ineligible for copyright protection as such because of its insubstantiality. See H.R. REP., *supra* note 5, at 131; Goldstein, *supra*, at 1119 n. 52; 1 M. NIMMER, *supra* note 5, § 1.01 [B], at 1-21, 1-24 n. 106.

<sup>121</sup> Shipley, *supra* note 31. Professor Shipley’s analysis “suggests] that state common law publicity interests in performance, likenesses, characters, and characterizations are subject to preemption by federal copyright law.” *Id.* at 710. He is persuasively critical of recent judicial opinions which have failed to recognize the relationship between preemption and publicity. See *id.* at 708-09 n. 252. See also Hoffman, *supra* note 20, at 130-33.

<sup>122</sup> See Brown, *Unification*, *supra* note 20, at 1093-99. Professor Brown offers a particularly important comment on the value of preemption in the context of an equally important insight into the nature of the public domain:

What has this to do with preemption? Are not the states as capable of protecting the public domain as is the Congress? The answer, from my observation, is no. Suitors before state courts and legislatures are interested in extending the protected domain; and one has to look hard to find state statutes or decisions running counter to these pressures. Congress is of course equally besieged by interests seeking protection. But it hears other voices. . . Congress can and does preempt works of authorship, forcing them into the public domain as well as into the protected domain; and some reasonable implication is permissible to find that it has done so.

*Id.* at 1093-94. See also *id.* at 1105-06; Note, *Copyright Law Revision*, *supra* note 20, at 631-32. But see Note, *supra* note 13, at 323-24

<sup>123</sup> See Hoffman, *supra* note 20, at 139-45. On difficulty with this suggestion is that, in conventional modern, copyright usage, fair use often presupposes a protected interest. See 3 M. NIMMER, *supra* note 5, § 13.05[A], at 13-55 to 56. This, an incautious reliance on fair use could lead to the undesirable result to recognizing as protectible, initially, interests which might better be judged lacking in protection altogether. This is not a compelling reason for rejecting an essentially useful suggestion, however, particularly if courts prove willing to heed the additional advice by its author that the fair use doctrine in publicity should be developed with publicity theory itself specifically in mind. See Hoffman, *supra* note 20, at 140.

Meanwhile, an interesting suggestion advanced in other articles is that the burden of proof in fair use cases should be shifted to the plaintiff. See, e.g., Kulzick & Hogue, *supra* note 20, at 77-78; Rosenfeld, *Constitutional Dimension of “Fair Use” in Copyright Law*, 50 NOTRE DAME LAW, 790, 804 (1975). See also Brenner, *supra* note 2, at 46 (because creative originality may be less than in copyright, “allowances for ‘fair use’ would be more freely granted in a right-of-publicity case,” fair use also suggested for the inventive imitator).

<sup>124</sup> Cf. Brown, *Unification*, *supra* note 20, at 1097-98. Professor Brown argues that there are “levels of authorship that are public-domain preempted” by section 301 of the Copyright Act even though they are not specifically enumerated or identified in the Act. *Id.* at 1096 [emphasis in original]. They include both “the high-level paradise of ideas, concepts, and principles” and “the low-level inferno of things too small or routine for copyright.” *Id.* Compare Note, *Copyright Law Revision*, *supra* note 20, at 624-25, 626 n.96; Leavens, *supra* note 74, at 280-81.

<sup>125</sup> This concept, of course, is already well established in copyright law. See, e.g., M. NIMMER, *supra* note 5, § 14.03[C]

much to reject them categorically. It is not too much, however, to erect barriers not to be hurdled by plaintiffs relying on casual proof. Important questions ought to be asked of the plaintiff who seeks to establish a prima facie case. In what legitimate sense did that plaintiff's predecessors actually create the interests from which protection now is sought? How can these interests clearly be identified and confined? The court must ask itself some equally important questions. For what length of time is it appropriate to reward such efforts at creativity as are demonstrated in the case?<sup>126</sup> What test of invention should the proponent of a claim be required to meet? Is it too much to impose a requirement virtually amounting to uniqueness, as was suggested by the court in *Estate of Hemingway*?<sup>127</sup> To be sure, that would exceed the usual requirement in copyright; but are not fragmentary or ephemeral interests more tentative in their claim to recognition? And is it not fair, then, to expect their proponents to show more?<sup>128</sup> Third, as an additional part of the plaintiff's prima facie case, it would seem fair to require the submission of proof concerning the likely impact that recognition of the plaintiff's claim might have on subsequent claims. For example, if rights are to be recognized in the creative efforts of the Marx Brothers, it would seem important to ask not only how much of their characters they invented themselves, but also how many subsequent generation of performers might be adversely affected if protection were now to be accorded to the Marx Brothers' successors. The analogy that comes to mind is the environmental impact statement that must be prepared when, for example, government agencies propose to make some doubtful use of lands. The purpose of these statements is generally to require that, as against the uncontrolled ravages wrought in earlier times, would-be users today assure us that their proposals will not heedlessly affect the interests of individuals in generations to come.<sup>129</sup>

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<sup>126</sup> For other suggestions, see Saret & Stern, *supra* note 29, at 697-98; Hoffman, *supra* note 20, at 142-45; Note, *supra* note 13, at 323-24. Recent opinions posing these and other, similar challenges or questions also can be found. See, e.g., *Memphis Development Foundation v. Factors, Etc., Inc.* 616 F. 2d 956 (6<sup>th</sup> Cir. 1980); *Lugosi v. Universal Pictures, Inc.*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979). Compare, again, the intriguing possibilities in shifting burdens of proof in fair use cases, thus converting the principles of an affirmative defense into principles of presumptive entitlement. See note 123 *supra*

<sup>127</sup> *Estate of Hemingway v. Random House, Inc.*, 23 N.Y.2d 341, 348, 349, 244 N.E. 2d. 250, 255, 256, 296 N.Y.S.2d 771, 778, 779 (1968). See notes 12-13 and accompanying text *supra*

<sup>128</sup> Cf. Brown, *Unification*, *supra* note 20, at 1097-98. See also Note, *supra* note 13, at 295-96 ("that a lesser requirement is necessary for the protection of copyrighted material reflects the pervasive public interest in encouraging authors to copyright and to disclose their material. Were the same lenient standards applicable to ideas through common-law protection, the motivation to obtain copyright would be drastically reduced"). But see M. NIMMER, *supra* note 13.

<sup>129</sup> See generally F. ANDERSON, *NEPA IN THE COURTS* (1973).

A California practitioner, writing some years ago in response to then-recent litigation involving Nancy Sinatra and the Fifth Dimension, captured the essence of the concerns expressed in the text at this point:

From the standpoint of performers . . . the right to perform in the popular genre or style is essential. Freedom of a performer to earn a living by adopting - either consciously or because he is "influenced" or simply "with it" - current modes and styles which may be widely or even uniformly demanded is, indeed, imperative. How else can he support himself and develop? Any limitation upon absolute freedom of performance- while it might result in short-lived bonanzas for one or two performers- would self evidently be stultifying to performers as a class.

Just how stultifying becomes clear when one considers that predictable volume of litigation and threatened litigation which would follow from any such limitation coupled with the equally predictable inconsistency of result. After several hundred years copyright infringement, which involves only comparison of dimensional self-described works, is still a mystery . . . We could hardly expect the courts to set parameters and fashion workable, understandable standards of comparison in "imitation" cases in this century! In the meantime, what about the performers and artists and their disseminators who wish to go about their business unhindered?

The analogy here seems apt; in certain useful respects the public domain in the field of intellectual property today can be compared to the public grazing lands on the Western plains of a century ago.<sup>130</sup> Indeed, so insubstantial is the stuff of intellectual property that the more insistent image is not the sturdier lands of the American West but the more fragile tundra of the Alaskan North: wild, vast, inaccessible, beautiful, but singularly unsuited to colonization.<sup>131</sup> If it is fair, as we seem to have decided in this century it is, to require the users of public lands to prepare impact statements as a condition of their use, then perhaps it is also fair to require similar assurances before we permit the outright appropriation of the territory of the creative subconscious.<sup>132</sup>

Fourth, it would be possible, and occasionally desirable, for courts to appoint counsel to act, in effect, as guardian ad litem for the public domain in cases in which new intellectual property interests are being advanced.<sup>133</sup> At the least, courts should solicit and welcome amicus participation.

Fifth, in cases in which it appears sensible to recognize new (or doubtful) intellectual property claims, it will be appropriate for the court to explain what is not covered by the grant as well. An explicit reservation of the public domain in these circumstances must be seen as a part of the court's obligation to be clear about the holding in the case rather than as a mere exercise in advisory opinion

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From the standpoint of the audience, society at large, and cultural growth, encroachment on the freedom of performance would be destructive both qualitatively and quantitatively. Consider any artist, musician, or performer of any era and ponder what his *oeuvre* would have amounted to had he been precluded from utilizing the brush techniques, color principles, scales, metres, cadences, sounds, moods and methods - in short, the styles- of those who have gone before. Would the classical periods of music and painting have been limited to but one producer each? Would Presley have been foreclosed as an imitator or would he have had the right to foreclose those who came after him? Would the lost generation of American writers have wasted itself in litigation to determine who "got with it" first? Indeed, could there have been a Renaissance? Would we have had a Brahms, a Rubens, a Steinbeck? Or, for that matter, a Sinatra or Fifth Dimension?

Liebig, *supra* note 27, at 46-47

<sup>130</sup> Or to public lands of other sorts. See Krasilovsky, *supra* note 20, at 205, 225-26

<sup>131</sup> *But cf. id* at 225-26 (suggesting the development of the Alaskan crab and shrimp industries as examples of how a federal bureau might be established to manage, conserve and develop the public domain). If this alarming suggestion were followed, impact statements would be even more relevant.

I should perhaps say clearly at this point that of course I do not mean to be taken literally when I suggest analogy to public lands. Proposals of that sort too quickly lead to analysis rooted in reductive nonsense. Cf. Comment, *Premature Burial*, *supra* note 20, 996-97.

<sup>132</sup> One author has used the term "public commons" to describe "the raw materials from which creative imaginations must work" and which therefore cannot be "fenced in" in any circumstances. Carman, *supra* note 20, at 58, 59. Cf. Nimmer, *supra* note 20, at 266.

<sup>133</sup> Cf. Stone, *Should Trees Have Standing? - Toward Legal Rights for Natural Objects*, 45 S. CAL. L. REV. 450 (1972).

I would not advocate "cheap" standing, and particularly not when derived from an environmental law analogy; clearly, that analogy can lend itself as readily to an argument or new property interests as against them. See Gantz, *Protecting Artists' Moral Rights: A Critique of the California Art Preservation Act as a Model for Statutory Reform*, 49 GEO. WASH. L. REV. 873, 888-90 (1981). Still, there are times when something amounting to guardianship protection does seem necessary. It is a small scandal, for example, that the *Betamax* litigation has moved all the way to the Supreme Court on an assessment of in-home recording as fair use apparently without a single genuine in-home defendant in the case. See *Universal City Studios, Inc. v. Sony Corp.* 480 F.Supp. 429 (C.D. Cal. 1979), *rev'd in part and aff'd in part*, 659 F.2d 963 (9<sup>th</sup> Cir. 1981), *cert. Granted*, 50 U.S.L.W. 3973 (U.S. June 14, 1982) (No. 81-1687). See Note, *Betamax and Infringement of Television Copyright*, 1977 DUKE L.J. 1181

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writing.<sup>134</sup> Precision in drafting the terms of a conveyance is essential in any property case; and legal descriptions often define what is to be included by referring explicitly to that which is to be excluded. In this sense, the proposal here is entirely unremarkable. But there is an even greater need for efforts aimed at precision in defining intellectual property. As we have seen, the subject matter itself is inherently less susceptible to recognition than are most forms of property. Interest in the public domain, meanwhile, are rarely advanced first in their own right. Such definition as they now have tends to come only through derivation and intuition, available more often in cases establishing or extending property interests than in cases limiting them.<sup>135</sup> In contrast to the interests which receive recognition, the public domain tends to appear amorphous and vague, with little more of substance in it than is invested in patriotic or religious slogans on paper currency. It is this impression of insubstantiality that courts must dispel first. Inevitably, the work of defining the public domain (which is essentially beyond the scope of this essay) will follow and, we can hope, a more appropriate balance will be restored to the field of intellectual property.

Finally, as often as possible courts ought to divert claims away from intellectual property theory and into such adjacent areas of law as the original form of unfair completions, contracts or, perhaps, some species of moral rights. There can be little damage to the public domain in requiring precautions designed to prevent genuine deception or confusion; *Sears and Compco* would have permitted as much.<sup>136</sup> Nor does there seem to be any legitimate objection to moral rights requirements such as attribution of authorship, although rights against distortion, truncation, mutilation and the like are obviously another matter.<sup>137</sup> In California, meanwhile, the supreme court's decision in *Lugosi* the

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<sup>134</sup> Cf. Note *supra* note, 13, at 324

<sup>135</sup> See Brown, *Unification*, *supra* note 20, at 1093

<sup>136</sup> See *Sears, Roebuck & Co. v. Stiffel*, 376 U.S. 225, 232 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.* 376 U.S. 234, (1964); Brown, *Unification*, *supra* note 20, at 1097-98

<sup>137</sup> Of course, the initial question in any "moral rights" case is whether rights of this sort are to be recognized explicitly. See generally 2 M. NIMMER, *supra* note 5, § 8.21. See also Diamond, *Legal Protection for the "Moral Rights" of Authors and Other Creators*, 68 TRADE-MARK REP. 244 (1978). In general, I should think, the law ought to distinguish between "moral rights" which serve to insure recognition for the more personal investment of an artist, cf. *Clemens v. Press Publishing Co.*, 67 Misc. 183, 183-84, 122 N.Y.S. 206 207-08 (1910) (Seabury, J.) (Attribution of authorship) and "moral rights" which have the effect of protecting some form of exclusive possessory interest, cf. *Gilliam v. American Broadcasting Co., Inc.* 538 F.2d 14, 23-25 n. 13 (Cir. 1976) ("artistic deformation" not adequately addressed by disclaimer as to original authorship). Rights of the latter sort clearly may be in potential conflict with individual rights in the public domain and ought therefore to be recognized more carefully. Compare, e.g. *Gantz*, *supra* note 133. Cf. *Jaszi*, *supra* note 17, at 753-58. One writer, considering the California Resale Royalties Act in terms of its susceptibility to § 301 preemption, has made a serious effort to take the public domain into account; the effort is commendable although her conclusion-that preemption is not preemption is not required- may be doubted. See Note, *The California Resale Royalties Act as a Test Case for Preemption Under the 1976 Copyright Law*, 81 COLUM. L. REV. 1315, 1328-32 (1981). Compare *Katz*, *supra* note 60, at 219-22.

It may be that the key to defining the scope of the public domain in a satisfactory way is to be found in a comparison of the natural law (or "moral") basis of intellectual property with the more specific, occasional need to define and provide for certain economic or commercial interests not necessarily limited to authors and not necessarily to products of authorship. Compare *Streibich, Moral Right of Ownership to Intellectual Property: (Part I) From the Beginning to the Age of Printing*, 6 MEM. ST. U. L. REV. 1 (1975) and *(Part II) From the Age of Printing to the Future*, 7 MEM. ST. U.L. REV. 45 (1976) with L. PATTERSON, *supra* note 20. See L. PATTERSON, *supra* note 20, at 215-21. Cf. B. KAPLAN, *supra* note 1, at 78; Krasilovsky, *supra* note 20, at 216-17; *Katz*, *supra* note 60, at 217-22. See also Comment, *Copyright Preemption and Character Values*, *supra* note 20, at 1037.



publicity rights are alienable personal interests, but as such do not survive the death of the original possessor,<sup>138</sup> is evidence that courts can respect the public domain while remaining responsive to the legitimate arguments raised by Professor Nimmer in 1954. Indeed, California has a unique history of recognizing the public domain, which is exemplified in the supreme court's careful holdings limiting the subject matter of ideas to the protection of true contract theory.<sup>139</sup>

These suggestions are not meant to be exhaustive,<sup>140</sup> but if courts were to act on them they would begin to offset the more egregious consequences of the new currents in intellectual property theory. The problems will not be resolved until courts have come to see the public domain not merely as an unexplored abstraction but as a field of individual rights fully as important as any of the new property rights. The field of intellectual property law at large sometimes seems to be beyond the possibility of exhaustion. But then, that was the view taken by the public toward the buffalo as they were being hunted one hundred years ago. And where are the buffalo now?

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<sup>138</sup> *Lugosi v. Universal Pictures, Inc.* 25 Cal. 3d 813, 820-24, 603 P.2d 425, 429-31, 160 Cal. Rptr. 323, 327-29 (1979).

<sup>139</sup> *See Desny v. Wilder*, 46 Cal. 2d. 715, 734-39, 299 P.2d. 257, 267-70 (1956); *Weitzenkorn v. Lesser*, 40 Cal. 2d. 778, 794-95, 256 P.2d. 947, 959 (1953); *Donahue v. Ziv Television Programs, Inc.* 245 Cal. App. 2d. 593, 604-06, 54 Cal. Rptr. 130, 137-38 (1966). *See also* 3 M. NIMMER, *supra* note, 5, §§ 16.01-05. Compare *Liebig*, *supra* note 27, at 42. *But cf.* Note, *supra* note 13.

<sup>140</sup> Compare the suggestions advanced in *Krasilovsky*, *supra* note at 228