

*“Recoding” Intellectual Property and Overlooked Audience Interests*

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Intellectual property is traditionally justified as an ex ante incentive structure to produce social wealth by “promot[ing] the Progress of Science and the useful Arts.”<sup>1</sup> It has also been observed that intellectual property can be a means to protect the personality interest or “personhood” of individual creators.<sup>2</sup> A person may view her intellectual creations as a \*924 statement or manifestation of her spirit, creativity, and identity. This “personality theory” naturally leads to concern that laws protect the integrity of, and the creator’s prerogatives over, intellectual products. In this vein, personhood proponents should occupy the vanguard of “moral rights” for authors<sup>3</sup> and publicity rights for celebrity performers.<sup>4</sup>

In the last few years, this generally pro-property personhood theory has been met with a scholarly reply specific to intellectual property: that owners’ rights to control their intellectual property are really rights about who controls social meaning. For example, one commentator has noted that disputes over unauthorized uses of copyrighted photographs tend to reduce to one question: “At what point, courts must decide, does a change in context or use transform an image’s meaning?”<sup>5</sup> For this deconstructionist perspective,<sup>6</sup> changes in meaning are welcome and property rights should be limited to give non-owners greater breadth to shape their own messages and, thereby, increase the personhood benefits that intellectual creations brings to those non-owners. In other words, true solicitude for personal development calls for weakening some of the barriers created by intellectual property. Along these lines it is argued that authors need greater latitude to quote existing texts, that performing artists need more liberty to interpret theatrical works, that minority groups need greater liberty to manipulate or “recode” existing cultural symbols like celebrity images, and that the Internet opens up a bold new world in which \*925 “author” and “work”--cornerstones of copyright theory--lose their very meaning.<sup>7</sup>

This demarche against intellectual property is informed by, and forms part of, a critical zeitgeist in which legal institutions which were widely taken to be neutral are scrutinized for bias against disenfranchised or less enfranchised groups. But this critique of intellectual property is more than just the application of current intellectual fashions to a set of well-known legal doctrines--it is more precisely because the critique comes at a time when the legal devices are themselves in vogue. There is no question that intellectual property is a “hot” practice area, that the United States sees the extension and stabilization of intellectual property rights as one its main goals in

international commerce, and that property notions are being applied-- implicitly and explicitly--to a wider variety of social issues. Property law language now appears even in First Amendment jurisprudence.<sup>8</sup> When grappling with problems like welfare reform or immigration, people in the late 1990s speak less of “interest groups” and more of “stakeholders,”<sup>9</sup> as though everyone who has an interest in a problem is a settler on the Western frontier.

**\*926** Although this makes the deconstructionist critique timely, it does not make it correct or even complete. Long before Foucault, Montaigne offered the first conceptual step in this argument when he observed that “the word is half his that speaks and half his that hears it.”<sup>10</sup> If the word is so shared, why should the “speaker”--the original artist, composer, or author--have such powerful control over the word’s fate? The deconstructionist would liberate the word from the speaker’s control and give everyone more freedom to recode intellectual property.

The problem with the deconstructionist argument for “recoding freedom” is that it does not consider the recipient of a cultural image as a listener. It focuses on the recipient as a new speaker--or a secondary user--someone who will “utter” the cultural object again for her own act of communication.<sup>11</sup> This argument passes over the interest of a vast number of non-owners in having cultural objects with stable meanings. Even in the age of the Internet, the interests of these passive non-owners can be in synch with those of the intellectual property owner. Deconstructionists rarely acknowledge that non-owners commonly benefit from owner control that is used to keep a cultural object “stable.”<sup>12</sup> But non-owner benefits are common with other forms of property. For example, non-owners of real property frequently benefit from owners’ control of their own property--as when visitors promenading on public sidewalks enjoy a cityscape which is an amalgam of privately-maintained buildings.<sup>13</sup>

**\*927** There may also be another situation the deconstructionists overlook: occasions when passive non-owners have even greater interests in a stable cultural object<sup>14</sup> than the owner does. The owner, after all, may see either economic gain or further self-expression in a dramatic change in the work’s meaning. The question then is whether these non-owners warrant any legal protection. Viewed as a question about property law, the issue is whether non-owners can have a “reliance interest” in property<sup>15</sup> that limits the uses to which the owner can put the property. By analogy, some reliance interests exist in real property, as when a landowner has come to rely on support or sunlight from an adjacent parcel. But intellectual property is often speech; through that lens, listeners’ controlling the content of a message seems--plainly and simply--beyond the constitutional pale.

In simplified form, then, we can imagine the following three situations about recoding the meaning of a cultural object: (1) the deconstructionist’s situation in which the property owner wants a stable work and the non-owner wants to recode; (2) a situation in which both the property owner and the non-owner want a stable work; and (3) a situation in which the non-owner wants a stable work and the owner wants to “recode.” At any one time, (1) and (2) could apply to the same intellectual property. Yet another situation could exist: (4) both the

non-owner and the owner want to “recode,” possibly in different ways. The conflicting interests of owners and non-owners in situation (4) would then tend to repeat situation (1).

The central proposition of this Article is simple: if we are genuinely concerned for the personhood interests of all non-owners, we must recognize situations (2) and (3) as well as considering situation (1), the \*928 “recoding freedom” for secondary users<sup>16</sup> developed in much recent scholarship. Although we have no reliable empirical evidence on the varied interests of non-owners, there is good reason to think that the utility derived by passive non-owners from the stability of propertized cultural objects is greater than the utility that would accrue to non-owners who want to recode cultural objects so much that those non-owners need to be freed from existing legal constraints. When we consider situations (1), (2), and (3), maximizing personhood interests becomes a far more indeterminate foundation for how much recoding we permit.

Part I below describes some of the deconstructionist literature on this topic and considers a set of recent cases bearing on recoding freedom. Part II then presents an analysis that suggests, in two approaches, how non-owners have a great interest in cultural objects having stabilized meanings. First, we will consider how the very examples used to support a “right to recode” show that even the secondary user relies on the cultural object maintaining background stability. Second, the deconstructionist formula of owner-versus-secondary user overlooks the vastly larger part of the consumer audience: those who use a cultural object without wishing to amend its meaning.

Although Part II aims to show that non-owner interest in image stability may be at least as great as non-owner interests in recoding, Part III approaches the problem with further analysis that might support increased freedom to recode, particularly by considering cultural objects whose meanings seem stable without propertization, by pondering the cumulative effect of property rights over some cultural objects, and by noting that non-owners would gain some new utility from recoding as listeners that will compensate to some degree for the lost stability of the original cultural object. This returns us to a query about the recoding non-owners; in other words, would all secondary users benefit from greater recoding freedom? And, if not all, who would and who would not?

Finally, Part IV looks at the owner-versus-non-owner balance through a different prism: a possible reliance interest for non-owners, particularly in light of free speech concerns. If non-owners had reliance interests that could hold a cultural object static in the face of an owner intent on changing the object’s meaning, this would be in keeping with the deconstructionist’s goal of removing the “author” construct from its privileged position. But reliance interests would bring down the “author” at the price of further elevating the “work”--another construct some would like to deconstruct.

\*929 Reliance interests are theoretically intriguing, but in practice they would immediately run afoul of both First Amendment and privacy concerns; they would be a kind of non-owner prior

restraint on an intellectual property owner trying to say what they wish to say with their own property.<sup>17</sup> On this count, it should be noted that the deconstructionists often cast the owner in a corporate or, at minimum, unsympathetic role. This tilts the conversation away from real situations in which individuals who create intellectual works, control those works, and both identify themselves and are identified by us with those works. Although American culture commodifies intellectual works to a high degree,<sup>18</sup> there remains a strong identification of art with artist that applies to books, plays, songs, the fine arts, and films. It obviously-- and axiomatically--applies with personas. Pat Boone, approaching the millennium “in a metal mood,”<sup>19</sup> may no longer want to be identified with his previous, wholesome constituencies--although they may cling to the older image of Mr. Boone. Copyright and the right of publicity should protect such a “freedom not to speak publicly”<sup>20</sup> for causes and groups in which one does not believe. This point applies to authors who want to recode themselves and to authors who want to stop recoding by others; it is a point generally overlooked by the deconstructionists.

## **I. The Deconstructionist Critique of Intellectual Property Protection**

In 1987, a Seventh Circuit panel commented, “If any monopolies harmful to the public have ever been built on invalid copyrights, we have not heard of them.”<sup>21</sup> Of course, the Seventh Circuit was not privy to the \*930 deconstructionist articles of the 1990s that claim valid copyrights are harmful to the public or parts thereof. The deconstructionist or post-structuralist argument is that some forms of intellectual property we recognize as defending realms of personal expression (copyright, trademark, the right of publicity) may suppress personal expression by putting important cultural symbols off limits to non-owners.<sup>22</sup> To correct this problem, the deconstructionists propose to limit intellectual property, thereby “freeing up more materials and opening up more cultural space for ‘talking back’ at, or through, the pervasive and dense media languages which constitute much of our social environment.”<sup>23</sup>

For example, Michael Madow and Rosemary Coombe have forcefully brought personhood arguments against the right of publicity.<sup>24</sup> Madow’s thesis is that the right of publicity has become a de facto control mechanism for meaning in popular culture. Madow writes:

The question “Who owns Madonna?” is not just a question about who gets to capture the immense economic values that attach to her persona. The question is also, even chiefly, about who gets to decide what “Madonna” will mean in our culture: what meaning(s) her image will be used to generate and circulate, and what meaning(s) she will have for us.<sup>25</sup> Arguably, giving this power to the celebrity causes “top-down management of popular culture and constricts the space available for alternative and oppositional cultural practice.”<sup>26</sup> Coombe gives a more elaborate statement of the problem: “Intellectual property laws stifle dialogic practices--preventing us from using the most powerful, prevalent, and accessible cultural forms to express identity,

community and difference.”<sup>27</sup>

**\*931** Such deconstructionist writings tend to focus on marginalized groups-- gay men, lesbians, Native Americans, adolescents, and feminists--as people who may especially want to use protected images for their own communications in ways that challenge or subvert the “preferred meaning.”<sup>28</sup> Two real-life examples are greeting cards depicting well-known male icons (John Wayne and Clark Gable) with gay themes. In each case, the heirs of the celebrity objected to the connection of their ancestor with homosexuality. These situations raise the specter that the intellectual property rights held by a celebrity could become “power to deny to others the use of her persona in the construction and communication of alternative or oppositional identities and social relations; power, ultimately, to limit the expressive and communicative opportunities of the rest of us.”<sup>29</sup>

This problem, of course, is at least as intense in the realm of copyright and trademark as in the right of publicity area. Keith Aoki advocates less intellectual property protection so that “individuals and groups would be able to legally engage in ‘recoding’ texts which had heretofore been ‘frozen,’”<sup>30</sup> and Coombe’s larger project describes “practices in which the signifying properties of authors are reappropriated by others, who simultaneously inscribe their own authorship of those works the law deems to be owned by their corporate disseminators.”<sup>31</sup> This analysis may even extend to expressions not generally understood as subject to property regimes, as in Madhavi Sunder’s observation of an “intellectual propertization” of First Amendment jurisprudence that she critiques as built “on principles of exclusion and despotic dominion over discourse and **\*932** symbolic images,”<sup>32</sup> which “forcibly halts the evolutionary process of changing meanings.”<sup>33</sup>

More recently, the deconstructionists’ arguments have turned to the public debates over what property regime, if any, should govern the flow of information and ideas over the Internet. What has become clearer is that these commentators are concerned that intellectual property laws have become principally an instrument of large corporations. Professor Aoki writes, for example, that “[t]he regulatory capture of United States copyright law by private copyright-based industries works at cross-purposes with the interests of the public--comprised of private individual users of copyrighted works-- which copyright law is theoretically supposed to advance.”<sup>34</sup> Another commentator puts the issue more directly in the defense of “fan fiction” about characters from popular television shows: “When most creative output is controlled by large corporations, freedom to modify and elaborate on existing characters is necessary to preserve a participatory element in popular culture.”<sup>35</sup> In discussing the merger of communication companies in the 1990s (like Turner Broadcasting and Time Warner), Aoki expresses concern that these developments coupled with the effects of the Internet and digital media “create giant companies premised on copyright control of intellectual property from conception to delivery via media links to consumers, and presents us with the distinct prospect of ‘creation of private domain.’”<sup>36</sup>

These passages evince one of the underlying concerns of this school of scholarship--that corporations, more than individuals, gain from intellectual property laws.<sup>37</sup> Given developments in the last decade--both domestic and international<sup>38</sup>--the advantages enjoyed by large corporations from intellectual property law<sup>39</sup> certainly should be scrutinized, but \*933 hands-on experience with the entertainment industrial complex may still suggest that intellectual property law is an important tool--one of the few viable tools--for individual and small group creators.

Despite these media giants, the “conception” phase of most intellectual productions remains very oriented toward independent individuals and small groups. Consolidation of the music industry has created six major distribution channels, but aspiring musicians still form bands, write their own material, play gigs in small venues, struggle to survive, make demo tracks, and hope to get “signed.” Despite in-house writing teams for sit-coms and soap operas, thousands, perhaps tens of thousands, of people are writing movie and television scripts. The giant companies in both music and film now cultivate “indies”--record labels and films produced outside the studio system--precisely because they have realized that fresh, talented creativity thrives best in (dare we say) “entrepreneurial” milieus. Without question, the creative agendas of these individuals and small groups will be influenced by the major corporations which provide channels of distribution to audiences, but these agendas are largely formed by the time the financial backer, large or small, comes into the picture.<sup>40</sup> And these are the creative works that do become part of the entertainment industrial complex; this says nothing at all about the ongoing creation of works that stay completely outside the system of large corporations and the ongoing creation of novel, sometimes maverick distribution systems that bring works to substantial numbers of people.<sup>41</sup> The Internet offers a prospective world in which every creator will have an affordable channel to reach millions of people \*934 without need of the large distribution companies,<sup>42</sup> but with need of intellectual property protection.<sup>43</sup>

Every individual who ever submits a treatment to a studio, a script to a production company, or a manuscript to a publisher has a fear that the company--giant or otherwise--will “steal” his or her ideas. To express the problem in more doctrinal terms, they are concerned that the company will reject their expression, but embrace the underlying, unprotected ideas. It is difficult to believe that these people--the ones who are truly at the conception of intellectual works--would benefit by weakening the limited protections they now have. The importance of intellectual property laws to individual and small group creators in the entertainment industry may be critical to curbing the rapacious practices of giant companies.<sup>44</sup>

The demographics of actual and threatened recoding lawsuits also show the importance of existing intellectual property protection for individuals and small groups. For example, efforts to stop less-than-tasteful uses of the Mickey Mouse March and The Boogie-Woogie Bugle Boy were efforts to prevent recodings of these songs--one as a theme for the passage to adulthood in the movie version of *The Happy Hooker*,<sup>45</sup> the other as an off-Broadway celebration of oral sex.<sup>46</sup> In both of these cases, the \*935 plaintiff was an entertainment giant--as appears to be the situation with many cases involving the Internet.<sup>47</sup> But in other cases, property rights are wielded

by individuals or small entities. In the realm of theater, individual playwrights have used the power of copyright to inhibit recoding of their works--as when Samuel Beckett threatened productions of his minimalist *Endgame*, set in post-WWIII subway ruins and a bare, but oddly lighted stage,<sup>48</sup> or when Beckett, Edward Albee, Tennessee Williams, and Robert Harling blocked “cross-gender casting” of their respective works.<sup>49</sup> In the world of Hollywood, individuals--directors and cinematographers--have sought the creation of new rights against the wishes of the studios.<sup>50</sup> In “sound-alike” cases, individuals often take on large corporations that want a famous voice to draw attention to their products--regardless of how this recodes the general public’s impression of the artist.<sup>51</sup> In short, individuals and small groups often use intellectual \*936 property laws against large corporations intent on recoding their personal images,<sup>52</sup> their music,<sup>53</sup> and their visual works.<sup>54</sup>

A splendid example of an individual using intellectual property law to fight a corporate recoding of his work is the 1997 case brought by Frederick E. Hart, creator of *Ex Nihilo*, a sculpture installed over the main door of the National Cathedral in Washington, D.C. Best known for his sculpture of three soldiers at the Vietnam Memorial in Washington, Mr. Hart is a religious person and intended his cathedral sculpture as sacred art. Instead, he found it used in the movie *Devil’s Advocate*. The sculpture--or something very, very similar to it--is the backdrop for the office of the devil incarnate--living in New York, of course. The devil’s sculpture “comes to life and plays a central role in a climatic scene at the end of the movie.”<sup>55</sup> Mr. Hart strenuously objected to the recoding of his work by \*937 Warner Brothers: “[T]hey took a work that was the definitive act of my artistic career and . . . turned it into an image of demonization.”<sup>56</sup> In a lesson to large entities exploiting the art of individuals, Judge Ellis threatened to hold up video distribution of the movie--potentially costing Warner Brothers millions of dollars--if a settlement with the artist was not reached.<sup>57</sup>

The point is not to conduct a counting match between individual plaintiffs and corporate plaintiffs;<sup>58</sup> the point is that many well-known infringement cases are, in fact, recoding situations and a significant enough number of those cases are brought or threatened by individuals for us to believe that individuals and independent small groups derive substantial benefits against anonymous corporations from the intellectual property laws. Although these situations are rarely discussed in the deconstructionist literature, they are all arguably cases in which the secondary user seeks to recode the original message. This recoding is, in Coombe’s terminology, “the consumption of commodified representational forms [in a] productive activity in which people engage in meaning-making to adapt signs, texts, and images to their own agendas.”<sup>59</sup> Unfortunately, the “agenda” is often corporate, the “people engage[d] in meaning-making” often come from the marketing department, and the pre-existing “representational forms” are sometimes the life-work of individuals or small, noncommercial groups.<sup>60</sup>

In the early 1990s, artist Jeff Koons became a kind of General McClellan of this deconstructionist analysis, single-handedly sustaining a series of legal defeats in which courts repeatedly rejected his argument for a right to recode works by other artists. The Koons cases<sup>61</sup>

all revolved **\*938** around Koons's efforts to "recontextualize" existing copyrighted works into three-dimensional sculptures.<sup>62</sup> Only one of his battles was directly against a faceless corporation; his first defeat came at the hands of an individual artist who did not want his work to be recoded.<sup>63</sup> The court's description of Koons's work sounds like it could have come from Coombe, Aoki, or Madow: "Koons is part of a contemporary movement which takes images from popular culture and 're-conceptualizes' them in a work of art in an effort to convey a certain message or idea to the viewer."<sup>64</sup> Evidence given by Koons himself showed that the artist took existing copyrighted images--like the "Odie" dog character from Garfield--and instructed artisans to reproduce these images "as closely as possible" as elements in his sculptures.<sup>65</sup> None of the copyright holders gave their permission. Borrowed or kidnapped, these original images were incorporated by Koons into sculptures in an exhibition entitled "The Banality Show."<sup>66</sup>

In the sculpture *Wild Boy and Puppy*, Koons juxtaposed a three-dimensional Odie against a stuffed doll of a wild-haired little boy and a "butterfly-bee,"<sup>67</sup> a cheerful-faced insect sitting on a basket. In *String of Puppies*, a warm photographic image of a couple holding a litter of German shepherd puppies was transformed into a large, three-dimensional, polychromed-wood sculpture faithfully recreating the poses and figures of the photo, but all "painted in shades of blue."<sup>68</sup> The artist was using protected images for his own communicative message, but admitted to the courts that he was not parodying the images.<sup>69</sup> Koons was using **\*939** copyrighted images "to symbolize the cynical and empty nature of society"<sup>70</sup> and "as a satire or parody of society at large which showed that mass production of commodities and images had led to a deterioration of the quality of society."<sup>71</sup> (One wonders if that included a deterioration of the quality of art.)

If there is any sense in which Koons was an ill-chosen standard bearer for the deconstructionist argument, it may have been in the courts' perception that Koons was not an "artist" in the creative sense:

Koons did not physically make any of the sculptures for this Banality Show. Instead, Koons was the "producer" of the sculptures--that is, he thought of the ideas for the sculptures and made the decision as to the materials to be used, as well as the sculpture's form, shape, size, and color.<sup>72</sup> It is not clear who suggested the word "producer" to describe Koons's role,<sup>73</sup> but the court's comment about sculpting was equally problematic; sculptors-- particularly those casting in metals--have always relied on assistants for the production of larger works. The court's true concern seems to have been that Koons did not sculpt--did not with his hands make models and casts of his works. Although this may or may not be a measure of creativity,<sup>74</sup> we can understand how unconventional Koons appeared as an artist<sup>75</sup> and how this unconventional artistic role, coupled with the high price of the pieces, made Koons a less-than-sympathetic defendant. The Second Circuit found that there was "simply nothing in the **\*940** record" to indicate that Koons produced his work "for anything other than sale as high-priced art."<sup>76</sup>



There's no question that Koons's works of this period are examples of the sort of recoding the deconstructionists should seek to protect. In this sense, the Koons cases were instructive as a test situation because on the one hand, the issue of reusing protected objects was presented without any of the familiar fair use categories (like parody), and on the other hand--unlike many infringement cases--there was no defendant-damaging patina of pornography. In this stripped-down version of recoding, Koons's works were found repeatedly to infringe rights to the underlying cultural objects, some under corporate, some under individual control.

## **II. Non-Owners' Interests in Stable Cultural Objects**

The Koons cases can serve the deconstructionist as examples of intellectual property laws used by owners to suppress the expression of non-owners. The primary concern, however, is not the interests of owners--those interests have been widely explored by courts and commentators in terms of privacy,<sup>77</sup> false light or unfair competition,<sup>78</sup> personhood<sup>79</sup> and free speech.<sup>80</sup> As described in the articles discussed \*941 above, the general conflict is one between the interests of the image owner and the interests of secondary users--people who want to manipulate the existing image to produce their own meaning. On the rare occasions when "audience interests" are mentioned in intellectual property discussions, it often coincides with concern about the use of intellectual property laws to limit access to information.<sup>81</sup> That issue is different from the value to audiences of the use of intellectual property laws to limit reworking of existing meanings.

The problem is that putting the focus on the need of some non-owners to recode the cultural object de-emphasizes how much all non-owners rely on that same cultural object having a stable, commonly understood set of meanings. This need for stability exists both for the non-owners who want to recode and for a vast, (literally) silent majority who derive utility from the object's stable meanings. In economic terms, the deconstructionist account looks to only one type of externality generated by the intellectual property in question, but there may also be significant positive externalities in the cultural object having a stable meaning.<sup>82</sup> In a sense, the ability of copyright laws to stabilize meanings is an enhancement of the effects of written language in the development of civilization; as Edward Gibbon noted, "Without that artificial help, the human memory soon dissipates or corrupts the ideas intrusted to her charge."<sup>83</sup> It is hard to question the observation that the embodiment of ideas and expressions in written form helps hold those ideas and expressions more constant across time and space. In this broad sense, copyright may augment this constancy that gives the culture cohesion at any one time and the civilization cohesion over time.

The discussion in this Part considers four general ways in which there may be social utility in the cultural object being protected by intellectual property laws from substantial recoding. The first involves circumstances in which a non-owner wants to express herself through acts which

are \*942 arguably recordings of the cultural object. Even in these situations, the non-owner usually needs a stable, well-known meaning from which her own meaning will arise and against which it will reverberate. The discussion considers five examples, largely from the deconstructionist literature, of what appears to be the first situation described in the introduction: the owner wants a stable work and the non-owner wants to “recode.” But on closer scrutiny, it seems that, although all these situations require a stable background meaning for the cultural object, not all of these situations may really merit being called “recoding.”

The second way in which there is social utility from a cultural object having a stable meaning is through the information non-owners derive from the object’s use. These are situations in which both the owner and the non-owner want a stable work: the second situation described in the introduction. Trademark and product endorsements (that is, the right of publicity) are the prime examples in this area. Another, more important group of second-situation instances form the third area discussed: when non-owners derive substantial noninformational utility from the stable meaning of a cultural object. Examples here come from copyright as frequently as from trademark and right of publicity. Finally, this Part considers a final argument for social utility from substantial owner control of the meaning of cultural objects: the argument is that control spread among divergent individuals enhances the diversity of meanings in a culture and provides a valuable barrier against homogenization of ideas, a race to the bottom in cultural meanings, and even government “hijacking” of cultural objects through recoding freedom.

### **A. Recoding Itself Requires a Stable Cultural Object**

Neither Jeff Koons’s situation nor the deconstructionists’ examples of the need to recode are as pure as they first seem. Many of these occasions are, in fact, situations in which the secondary user’s communication to others relies on the underlying stability of the image. Consider the following situations.

#### 1. Aryan Madonna.

“The choice of which Madonna T-shirt to buy is a choice about which meanings of Madonna to circulate.”<sup>84</sup>

Just as a person may choose to “say something” with a Gucci purse or cowboy boots, another person may use Madonna’s image to speak for him or her. But what Madonna’s image says depends on \*943 its meaning remaining stable. Imagine a young woman in the early 1990s who buys a Madonna T-shirt at Venice Beach and wears it on a trip to Oregon. She intends to use the T-shirt’s “meaning” (that is, the meaning of this particular Madonna image) to convey her rebelliousness and sensuality; in fact, among Madonna poses, new and old, with varying degrees of risquéness, she chooses one conscious of this mix.

But let us imagine that Oregon, following the deconstructionist advice, has loosened the right of publicity. As a result, in Oregon, Madonna's image has been usurped by a militant, pro-Aryan racist leader who, blinded by her once platinum-colored hair (and to the fact that she's of Italian descent), has taken Madonna as his group's poster girl. Our wayward Angelena gets some unexpected negative reactions on her trip to an Oregon college town--in fact, finds herself accosted and harassed--precisely because her self-expression was dependent on Madonna having a fairly stable meaning that no longer exists in Oregon.

## 2. Gay Men and Judy Garland.

Madow characterizes the gay community's use of Judy Garland as an act of "rework[ing] or recod[ing] Garland in a way that served their own particular subcultural needs and interests."<sup>85</sup> He contrasts MGM's manufactured Judy Garland image--"the girl next door"--with the gay community's image of her.<sup>86</sup>

But by the time gay men in the 1950s "seized on the image of Judy Garland," her public persona was arguably no longer that All-American neighborhood sweetheart.<sup>87</sup> In 1949, Garland had the oddly revealing last line in the movie *In the Good Old Summertime*: "Psychologically, I am very confused. Personally, I feel just fine."<sup>88</sup> Sometime in the 1950s, the second part of that line unraveled. In 1954, Garland starred in the remake of *A Star Is Born*, a tragedy that portrayed her as an ultimately unhappy person forced into a false public image in order to succeed.<sup>89</sup> More \*944 importantly, her real life had come to overshadow the silver-screen image: "The news Judy made in the late 50s involved lawsuits, counterlawsuits, nervous breakdowns, suicide attempts, and recurrent breakups with [her third husband]."<sup>90</sup>

When gay men adopted her as an icon, were they engaged in recoding? Or were they adopting her image largely for what it had already come to mean--a vulnerable, unhappy person who had been fired by her employer (for being what she really was) and who had attempted suicide because of personal problems? It seems possible that the gay community's use of Garland depended on her already-evolved image--a suffering, misunderstood person. Her image had already drifted away from the content intended by its studio creators; it had so drifted despite whatever rights Garland and MGM exercised or could have exercised.<sup>91</sup>

## 3. Koons and Garfield.

To return to one of the Koons cases, there is the question whether the image of Odie would have had the same impact when it was integrated into *Wild Boy with Puppy* if Odie had already been recoded at will by other artists. Part of the value of using Odie was that his audience was seeing

a familiar image in an unfamiliar (unpermitted) milieu; his audience confronted an image with a familiar personality having familiar characteristics cultivated in one forum: a newspaper cartoon strip. What if Tim Slowinski, Barbara Rachko, or David Madzo<sup>92</sup> had already used Odie in provocative, camp art works? Would Koons have had to search the comic pages for another image? And what to do if none of the images was virgin material for recoding in sculptures?

#### 4. “John Wayning It” in the Army.

Madow reports that in military training, it is common to talk of “John Wayning it”--“trying foolishly to hold out against brutal torture.”<sup>93</sup> He calls this an “against-the-grain reading of John \*945 Wayne.”<sup>94</sup> The phrase “John Wayning it” probably has (or had) broader usage in the armed forces as an unflattering, sarcastic way to refer to impractical or dangerous behavior, that is, carrying a machine gun at mid-waist or wearing a helmet askew. A lot of the same behavior--particularly taking unnecessary risks--is denigrated in the military with other characters, in other words, being a “cowboy” or a “Rambo.”

But these references to John Wayne, cowboys, and Rambo may not recode the respective images. The meaning of “John Wayning it” is to confront numerically superior enemies, torture, or general adversity as we know John Wayne would confront it. Rambo survives the hail of bullets, but he is obviously an idiot for not keeping his head down.<sup>95</sup> John Wayne’s and Rambo’s behavior may save the day in the movies, but military officers who use these phrases pejoratively are likely to be thinking that Wayne and Rambo were not team players, took unnecessary risks, and were, as one officer said to me, “loose cannons.”<sup>96</sup> These uses acknowledge the stable images for what they are, then say that the speaker does not identify with the stable image and thinks poorly of those who do. This situation may only count as recoding if rejecting an image is recoding.

#### 5. Enterprising Feminists

One of the most fascinating cases of alleged recoding is Coombe’s report of “[t]housands of women [who] use Star Trek characters to rewrite the masculine, re-imagine the male body, and engender utopian ‘alternative universes.’”<sup>97</sup> Coombe builds on the work of Camille Bacon-Smith<sup>98</sup> to describe how Star Trek has a distinct “fanzine community [that] is almost exclusively female and predominantly heterosexual” in which \*946 contributors . . . employ images, themes, and characters from a canonized set of mass-culture texts (the Star Trek television series episodes, films, and commercially produced novels) to explore their own subordinate status, voice frustration and anger with existing social conditions, envision and construct alternatives, share new meanings, and express utopian aspirations.<sup>99</sup>

In the early days of these fanzine communities, women frequently wrote “Mary Sue” stories in which a woman character is introduced into, and becomes popular with, the Enterprise crew.<sup>100</sup> Coombe believes that subsequent fanzine stories “appear to be more engaged in rewriting the masculine gender” through plots in which “[t]he female heroine . . . helps her partner to accept his emotions and recognize that true love and sexual satisfaction grow out of mutual respect and trust.”<sup>101</sup>

While these fanzine works are clearly derivative works, they may not be “recodings.” At least, they do not sound like extreme recodings since they appear to accept much of the Star Trek canon--not just the characters, but the principles and ideas that govern the Federation world. After all, Spock was already a fairly “re-imagine[d] . . . male body” and mutual respect and trust are strong themes of Star Trek, present--if not dominant--even in Captain Kirk’s “mass-culture text” romantic exploits.

Further afield from the original codings of Star Trek are the “Slash” stories in which “women write erotic stories and draw illustrations depicting a love relationship between Kirk and Spock”<sup>102</sup> as well as similar stories coming from Star Trek’s “Gaylaxian” fan group.<sup>103</sup> These seem more definitely “recodings” of the original cultural objects, although even there the relationship between Kirk and Spock as two interdependent bachelors, each unable to find long-term commitment to a female, was arguably an ambiguous element in the original coding of the franchise, particularly as it moved into the 1980s and 1990s.<sup>104</sup>

There are two points in discussing all of these examples. First, it is important to understand better what constitutes recoding because it is \*947 possible that there actually is little recoding going on. Second, whatever recoding is going on depends on the image itself retaining background stability. It cannot be that recoding is only what a person thinks to himself. For example, if a man sees John Wayne and thinks to himself, “effeminate, socialist, Boston Brahmin,” surely he would not be recoding.<sup>105</sup> No changes in the legal structure are needed to secure this kind of freedom. Recoding must be using the cultural object or recognizable elements of the object in a forum for third persons to achieve different effects than those generally achieved already by the object; the different results must affect the meaning of the original object in the social discourse. So understood, not all recoding runs afoul of existing law--particularly not recoding that uses only some elements of the object.

After discussing how current “superstars” rely on “evocative signifiers” drawn from recent entertainment history, Coombe stresses that “such authorial processes ought not to be frozen, limited, or circumscribed by the whims of celebrities or the commercial caprice of their assignees.”<sup>106</sup> But many of the examples she gives have not been circumscribed by existing laws: Madonna, Prince, and Elvis Costello have drawn from Marilyn Monroe, Jimi Hendrix, and Buddy Holly, respectively--heavily, successfully, and apparently without debilitating legal obstacles. But there is a great difference between Elvis Costello and a Buddy Holly

impersonator. Few confuse Prince with Jimi Hendrix, just as few confuse Picasso's *Las Meninas* with the Velazquez painting that inspired it or Cezanne's stylized renditions of Sebastiano del Piombo's *Christ in Limbo* with the original.

The examples of Madonna, Prince, and Elvis Costello are instructive because there is no question that their use of bits and pieces of prior pop icons is acceptable both culturally and legally. A common mistake of the deconstructionist position is to hyperbolize how much "intervention" by the law "forcibly halts the evolutionary process of changing meanings."<sup>107</sup> Aoki writes, "Increasing aspects of our cultural imaginary are being fenced 'off-limits,' as intellectual property, marked with the equivalent of 'no-trespassing' signs."<sup>108</sup> James Boyle, for example, stresses that

**\*948** [e]ach intellectual property right, in effect, fences off some portion of the public domain, making it unavailable to future creators. If one is concerned about promoting future production of books, ideas, inventions, and works of art, then one must be just as careful in one's protection of a vigorous and diverse public domain, a "commons" of scientific, literary, and artistic raw material, as one is in one's protection of the author's rights and incentives.<sup>109</sup> This is clearly correct, but in the real world, the "evolutionary process of changing meanings"<sup>110</sup> now moves at a wonderfully dizzying pace and a variety of legal doctrines are deployed to protect such "recoding." Although discussing a comic strip, Judge Newman's observation in *Warner Bros. v. American Broadcasting Cos.*<sup>111</sup> also applies to celebrity images, fictional characters, pop songs, movies, and television shows:

Especially in an era of mass communications, it is to be expected that phrases and other fragments of expression in a highly successful [protected] work will become part of the language. . . . It is decidedly in the interests of creativity, not piracy, to permit authors to take well-known phrases and fragments from [protected] works and add their own contribution of commentary or humor.<sup>112</sup> To make the case that the present regime stifles expression, scholars must show that such solicitude does not adequately protect recoding. If the present levels of protection were lowered, which recordings would actually occur, and would they be valuable? Survey evidence could give meaningful answers. What does not advance our thinking is the occasional railing against the straw-man of "complete author's rights,"<sup>113</sup> a strangling level of property exclusion that does not exist today.

**\*949** Instead, substantial recoding occurs under activities protected by *scènes à faire*,<sup>114</sup> parody,<sup>115</sup> artistic freedom,<sup>116</sup> general fair use,<sup>117</sup> or simply the "thinness" of copyright.<sup>118</sup> Trademark law has similar fair use and parody exceptions. Public figure doctrine in the law of

publicity also permits a wide range of “recoding.”<sup>119</sup> Some of these exceptions are judicial; many are statutory.<sup>120</sup> Consider the scenes à faire doctrine \*950 in copyright law and the limits of the right of publicity as it has developed in state law.

Although not the most rigorously formulated doctrine, the scenes à faire principle permits authors to use scenes, incidents, or elements in their story that “flow naturally from a basic plot premise”<sup>121</sup> even though those elements may come close to elements in existing, copyrighted works. Scenes à faire doctrine arguably permits a production like *Battlestar Galactica* to use elements made familiar to the audience by *Star Wars*--rebel humans evading a bureaucratic empire, destroyed home worlds, aircraft carrier-like space ships that launch smaller fighters, space dog-fights, daring young pilots as heroes, and so on<sup>122</sup>--because these are common elements of a certain subgenre of science fiction as surely as oysters, a full wine glass, and an upturned chalice were common elements of seventeenth century Dutch still-life paintings.<sup>123</sup> In some sense, the scenes à faire doctrine is a shadow of the more fundamental proposition that there is no copyright in facts: scenes à faire are akin to abstract “facts” about particular times and places.<sup>124</sup> In the case of a historical \*951 work, the scenes à faire are replaced by specific facts.<sup>125</sup> Although developed in the literary tradition of plot-- novels, scripts, plays, films, and television--the scenes à faire doctrine has been applied to musical motifs,<sup>126</sup> toys,<sup>127</sup> and computer software.<sup>128</sup>

Similarly, California’s right of publicity--one of the most developed laws in this area because of the state’s industries--expressly permits use of anyone’s likeness or voice for “news, public affairs, . . . or any political campaign,”<sup>129</sup> and more importantly for recoding purposes, permits a wide range of uses of likenesses in fiction.<sup>130</sup> The latter exception probably includes the use in Steve Martin’s 1990s play *Picasso at the Lapin Agile*<sup>131</sup> of a time-traveling character who looks, dresses, walks, and sounds like Elvis Presley. He talks like a mid-twentieth-century American celebrity about fame, death, and seeing his name “in lights.” Neither “Elvis” nor “Presley” is ever spoken, but everyone will know that this is “the King,” and this knowledge is played to comic effect.<sup>132</sup>

\*952 These are just two of the robust doctrinal areas that protect recoding activities; the present legal regime stabilizes meanings to some degree but does not fence off as much as some think.

## **B. Stable Images as Sources of Consumer Information**

The owner-versus-secondary user equation overlooks the interest of true listeners--purely passive non-owners. These listeners may have an interest in the stability of meaning in a wide range of cultural objects--from trademarks used for medical products to copyrighted characters in children’s fiction<sup>133</sup> to cultural icons, like Jerry Garcia or William Faulkner, who become the centers of significant, self-identified followings. Often the passive owner’s interest stems from information conveyed: the most obvious example is trademarks that provide the consumer with

shorthand information about the quality of a product. But passive owners also derive noninformational utility from the intellectual property of others--particularly images.

Madow believes that he deflates any passive non-owner interest in celebrities' right of publicity by showing how the "focus of the right of publicity is not the interest of the consuming public in freedom from deception."<sup>134</sup> But even if he were correct that the right of publicity does not protect the informational interests of consumers--a point still empirically unproved--his argument says nothing about the broader relationship between the right of publicity and the public's noninformational interest in stable cultural images.

As to the relationship between consumer beliefs (conveyed information) and celebrity endorsement (image control), Madow concludes that consumers do not believe celebrities investigate or even use the products they endorse.<sup>135</sup> In other words, a celebrity endorsement may get a consumer's attention but it does not convey information concerning the product. But there are some contra-indications. For example, sport celebrities are seen using many of the products they endorse, reinforcing the image that celebrities do use the chattels they advertise (and that the chattels are good enough for such use). Absent reliable empirical evidence--which could be obtained with simple polling techniques--we do not know what beliefs consumers glean from a celebrity endorsement. Consumer beliefs may vary greatly with the consumer's age, education, and exposure to advertisements as well as the nature of the endorsement. \*953 There is a potentially great difference between a celebrity lending her voice to a "voiceover" for a television commercial and the same celebrity giving a strong, express endorsement, such as, "Hello, I'm X, and I personally recommend that you use Drug Y when you have a cold."

Madow believes not only that consumers think that celebrities do not use products that they endorse, he also believes that consumers are justified because "celebrities have not shown either the inclination or the ability to 'channel' consumer behavior in socially desirable ways,"<sup>136</sup> a conclusion he supports with examples of well-known celebrity endorsements of dangerous products and of "products whose effectiveness or soundness they have neither investigated nor verified."<sup>137</sup> But because statistical evidence is unavailable, we are left to pass the time jousting with anecdotes. For every celebrity who endorses products they do not use, there is a celebrity who refuses to do commercials<sup>138</sup> or who insists on personally testing or using the product they proffer to audiences. For years, Casey Kasem, the late-twentieth-century music countdown king, was the spokesperson for Dairy Queen, but decided not to renew that contract when he became a vegetarian.<sup>139</sup> Similarly, Bruce Springsteen turned down a multimillion dollar offer to use Born in the USA in a car ad.<sup>140</sup>

Beyond Madow's descriptive claims that consumers do not link celebrity images to any information and that consumer behavior is justified because celebrities do not sufficiently regulate their images, he reasons that even if present-day consumers gained product information from celebrity endorsements, this linkage is itself a product of the background legal system:



Presumably, consumers who purchased Ben Franklin clocks and snuff boxes in the 1770s, for example, did not believe that Franklin had licensed or otherwise authorized their production. Consumers in the 1880s presumably realized that Oscar Wilde had not approved the use of his photograph on trade cards for Marie Fontaine's Moth and Freckle Cure. In short, the reaction of today's consumer to \*954 celebrity advertising and merchandise is neither "natural" nor inevitable.<sup>141</sup> Madow may be correct, but the opposite could be assumed just as comfortably, that is, that some of the paraphernalia sold in late eighteenth century Paris with Benjamin Franklin's image was marketed as being "American" in style, with the implication that it was a style that Franklin used, knew of, and thought well of.

Assuming Madow is correct--that any current linkage between endorsement and information transfer is the result of the legal background--that does not lessen the initial loss in utility that consumers could suffer from denying celebrities their right of publicity. Is it likely that during the considerable amount of time in which consumers would still link images with endorsement (information), advertisers--mainly large corporations--would be milking celebrity images for all that they were worth?<sup>142</sup> Should Nike pay athletic star Michael Jordan even less than it pays Indonesian workers?

The case *Russell v. Marboro Books*<sup>143</sup> offers insight into who would profit if celebrities and models could not control their own images. In *Russell*, the respected--and apparently very respectable--model Mary Jane Russell had done educational book ads that showed a man and woman, in a pair of twin beds, with the caption "For People Who Take Their Reading Seriously."<sup>144</sup> The book company later sold the negatives to a bed sheet company that, without Russell's consent, doctored the photo so that she was portrayed with a much older gentleman, what the court described as "a bedsheet advertisement portraying a willing call girl waiting to be used by a stranger whetting his sexual appetite."<sup>145</sup> Russell ultimately prevailed against the company.<sup>146</sup> In a legal system that allows companies to use a Mary Jane Russell image freely, surely it is not the public that would directly economically profit from loosening the celebrity's right of publicity.

### **\*955 C. Non-Owners' Interests in Stable Cultural Objects for Noninformational Utility**

The previous discussion is separate from the larger issue of noninformational utility derived by passive listeners. The larger issue is to consider the listener's interests as more than information-gathering consumers. Consumers of an image--the "audience" for that image--derive utility from processing that image. If they do not derive utility, they do not consume. They turn off the John Wayne movie or ignore the Marilyn Monroe poster. Call it beauty, comeliness, sex appeal, humor, wit, entertainment value, amusement--it is utility itself

for the audience.

In addition to simply enjoying the cultural object, many in the audience may derive noninformational utility from it by identifying with it, by communicating with it, or by using it as a cultural reference. They may use the image as “a projection screen” on which they bring their own “feelings, thoughts, and experiences to focus.”<sup>147</sup> In the early 1970s that sunny poster of Farah Fawcett-Majors initially became popular because she was beautiful, but by the time one found it in workshops, locker rooms, and men’s dorm rooms all over the country, it had become more: a symbol for men, what in scholarly writing might have been called something like “an implicit group assertion and focus point of their active heterosexuality achieved by objectifying one female form.” Such members of the audience may manipulate the image internally, endowing it with different shades of personal meaning--a polite way to say fantasies--but they do not recode it publicly.

Before Farah Fawcett and Madonna were out of baby clothes, Nelson Algren commented on the increasing power of labels in American society: “Now we have among us . . . the man so disconnected from reality that he pays fifty dollars for a key with a bunny engraved on it in order to obtain recognition of his personality as being, officially, that of a Playboy.”<sup>148</sup> \*956 Deyan Sudjic has offered a more complete view of why people are drawn to cultural images attached to--or in the form of--consumer goods:

Part of the explanation seems to lie in the changing relationship between consumers and mass-produced goods. Of course, we are all very well aware that shops are full of inanimate, machine-made objects, but emotionally we want them to be more. And we want to use our possessions to express our sense of individuality and identity. At the same time there is a yearning to belong, to be able to define yourself as one of a group of a particular kind of people. And it is the definition of these groups that possessions which can express a personality have a role to play. The secret for a manufacturer is to choose the appropriate personality for the product he is offering, one which expresses the right message to his target audience, one that matches their aspirations.<sup>149</sup> People achieve recognition of their individual personalities wearing a designer label, ordering a particular dish, driving a well-known automobile or, as Judith Martin has observed, reading a particular book.<sup>150</sup> This recognition is sought through a relatively passive use of the cultural object that involves no (or virtually no) recoding.

It is precisely because so many people derive these types of utility from cultural objects without pondering, rethinking, or recoding them that \*957 each new generation of parents rings alarm bells about each new generation of rock stars; it is for just this reason that social conservatives attack television programs like *Ellen*<sup>151</sup> and social liberals criticize politically ill-considered

names like the Washington “Redskins.”<sup>152</sup>

Focusing on a few people who consciously want to redefine cultural objects overlooks this vast majority--people who want the images to redefine them. The average American may not want responsibility for shaping the message she receives. She may not want to code the football game by constantly choosing the camera angle and she may not want to recode her movies by changing the endings.<sup>153</sup>

Laura Miller has pointed out how interactive, hypertext novels--“an almost embarrassingly literal embodiment” of anti-authorial, deconstructionist literary theories--have yet to catch on.<sup>154</sup> These works that “liberate” the reader from the “oppression” of linear narration have yet to become the sort of thing friends recommend to one another over dinner conversation.<sup>155</sup> Miller thinks the reason is clear: people read novels because they want to be told a story.<sup>156</sup> And even the strong “linear narration” implicit in a “story” is not a necessary condition for most non-owners to happily cede control to an author; if it were, how would we explain the appeal of music videos or, indeed, of most pop songs? Some pop songs and videos tell linear stories,<sup>157</sup> but most are more “cyclical” in nature. For all these cultural objects, most Americans do not seek to recode; they just switch products or pop icons when they will get more utility from consuming and expressing themselves from other sources. In that spirit, it is not clear why we should focus on the expressive needs of \*958 secondary users without worrying about the personality needs of passive non-owners who rely on a stable image for self-definition or expression. What justifies concern for the gay artist who wants to print postcards of John Wayne wearing pink lipstick but no concern for the young, heterosexual army recruit who wants to identify with a stable image of John Wayne?

The focus on second-generation users may say more about those of us who write law review articles than it says about the balance of interests in the real world. Is it any wonder that skilled, creative people who are successful, but not on the numbing scale of James Dean or Samuel Beckett, would write about the need to give more freedom to other skilled, creative people who themselves have not yet enjoyed the numbing success of a James Dean or Samuel Beckett?<sup>158</sup> In beginning her own critique of the right of publicity’s effect on recoding, Coombe says that “the celebrity form attracts the authorial energies of those for whom identity is a salient issue and community an ongoing dilemma.”<sup>159</sup> Yes, but identity is a “salient issue” for suburban heterosexual teenagers in Ohio as well as gay men in Greenwich Village, and “community” is a “dilemma” for middle class Angelenos as surely as it is for feminists on the Internet.

There is a helpful, albeit imperfect, analogy between this recoding issue in intellectual property and certain disputes about real property. The claims of secondary users against image owners of intellectual property may bear some resemblance to the interests of would-be suburbanites against an old estate owner. The would-be suburbanites may think it will increase everyone’s utility for the estate owner to subdivide his grounds into a neighborhood of tract houses and backyards. They may be right, but they may also be wrong. Not everyone would get to move

into the development; people who did not might be better off with the pastoral, undeveloped estate nestled in the existing neighborhood. Both the property owner and a large chunk of the non-owning community may have convergent interests in maintaining the status quo.<sup>160</sup>

**\*959** Another way to think of this is that while a secondary user may gain utility from recoding an existing cultural object, other non-owners-- those who have invested in the object's original meaning--may suffer disutility as a consequence of the recoding.<sup>161</sup> A preceding discussion considered all the ways the right of publicity still permits the manipulation of public personas,<sup>162</sup> but it is worth saying that not everyone is happy with such manipulation. Not only are descendants of a famous person frequently unhappy with these recodings, but pure non-owners--consumers--may also suffer a loss in utility from the displacement of the meaning. In lamenting "nonfiction novels" and "factions," Max Frankel writes: "As for television, it routinely appropriates the personas of celebrities and crudely distorts their words, thoughts and features. Just the other night, I watched impostors trying to steal my treasured images of John and Robert Kennedy and Frank Sinatra, Sammy Davis Jr. and the rest of the Rat Pack."<sup>163</sup> This disutility can occur with many intellectual properties. This is not an argument that recoding should be further restricted--only that advocates of more recoding freedom need to acknowledge all of the interests at stake.

For example, was there an increase in social utility when George Gershwin's Rhapsody in Blue was taken as the theme music of United Airlines in the early 1990s?<sup>164</sup> There were gains in utility: a beautiful tune more often on the airwaves and perhaps some special pride instilled in United's management, employees, and frequent flyers. But was there a decrease in overall utility as a classic, soaring melody that symbolized America's coming of age was recoded to mean a 777 banking toward O'Hare? Does everyone gain or lose when a Cole Porter classic is recoded by a toilet bowl cleaner to be I've Got You Under My Rim?<sup>165</sup>

Non-owners may have an interest not only in the object's meaning but in the level of its presence in the cultural landscape. Part of the purpose of a celebrity endorsement is to draw attention to (and, eventually, immediate recognition for) a product;<sup>166</sup> this is what happens when a **\*960** supermodel appears in print advertisements for a watch or a Shakespearean actor lends his voice to hawk automobiles. But if a cultural image may be used freely by non-owners, it may be exploited excessively, become exhausted as it loses its ability to attract attention, and disappear from the cultural discourse. This already happens with many propertized objects. For example, Rhapsody in Blue may be heard more in the years it serves as the theme for United Airlines, but eventually United Airlines will change marketing strategies--partly because the theme will no longer command attention--and the music may then be heard much less: United will not play the music and others then will play it much less because of the commercial patina it would carry. United Airlines will have benefited greatly from the recoding experience, but over the long haul, will most non-owners?

One cannot empirically demonstrate that the bulk of non-owners derive more utility from a

cultural object having a stable, widely shared content than a smaller, more activist group would derive from greater freedom to recode. We also cannot estimate a priori how much utility non-owners would gain from new recordings. In some cases, the value of the new recordings may far exceed the disutility from confusion and dissipation of the original meaning. These uncertainties do not detract from the basic points in this discussion: (1) the commentators generally do not consider the interests of passive non-owners in objects having stable meanings, an odd oversight when one considers how much twentieth-century music has been devoted to discussing social needs for stable meanings;<sup>167</sup> (2) there is reason to think that these interests are substantial; and (3) consideration of non-owner utility as listeners undoes the calculus on which the deconstructionist argument is built.<sup>168</sup>

**\*961** One reply is to recognize these interests but deny that laws are needed to protect them. That people need some stability in the meaning of cultural objects does not mean that laws are needed to ensure that stability. Many cultural objects retain stable meanings even when they are unprotected. Examples might be the Statue of Liberty, the Mona Lisa, Mount Rushmore, and the Eiffel Tower. The Statue of Liberty has been recoded into hundreds of provocative images: from the ruined statue at the end of Planet of the Apes signaling that mankind destroyed itself to television or print commercials in which Lady Liberty shows interest in cellphones, automobiles, or pizza. Yet the Statue of Liberty retains a core set of meanings as a symbol of democracy, the promise of America, and the city of New York. Despite some vulgar recordings, the Eiffel Tower remains an elegant symbol of Europe, France, Paris, and romance.

Historical figures like Abraham Lincoln, George Washington, and Ben Franklin are used to hawk mundane commercial goods without apparent disturbance of their core meanings. Similarly, copyrights expire: what happens to the meaning of characters that are no longer protected--or never were protected? Cleopatra, Dracula, Frankenstein, Hamlet, Dr. Pangloss, Robin Hood, Romeo and Juliet, Sampson, Santa Claus, Scrooge, Uncle Sam, and Merlin the Magician are all characters that seem to have stable, commonly known meanings.

Finally, the deconstructionist may guess that the total effect of recoded uses will not seriously disrupt the existing meaning of the cultural object. If Jeff Koons were permitted to use the Odie character in a handful of sculptures, would this really pose any threat to the meaning of Odie as it is promulgated and reinforced by millions of newspaper readers each **\*962** day?<sup>169</sup> Cultural objects that get recoded are likely to be those that are widely disseminated; therefore, the recordings themselves will rarely approach the circulation of the original. Gaslight still plays in arts theater houses and yuppie VCRs; how many people watch Jack Benny reruns?<sup>170</sup>

Yet these things are not always true. Some recordings approach or overpower the originals, whether or not the original was propertized. Which had the greater audience over time--New York City's I Love New York song or Saturday Night Live's I Love Sodom parody--considering the latter still sells on video? Many unprotected characters--factual and fictional--have experienced significant "drift" in their meaning, although sometimes it is

difficult to determine whether the core meaning has changed or a derivative character has appeared. Bram Stoker's *Dracula* usurped the Transylvania throne from the historical figure; Bela Lugosi's rendition then came to dominate other versions of the Bram Stoker character, and hence, popular American impressions of *Dracula*.<sup>171</sup> Yet there have still been shifts in *Dracula*'s meaning since the 1931 movie.<sup>172</sup> Today the best known forms of many nominally unprotected characters are themselves protected--the Disney studio vaults providing dozens of examples. Similarly, the "franchise" of important cultural objects promotes the development of derivative works and arguably recodes the meaning of that particular oeuvre, as in Kenneth Anderson's characterization of *Star Trek*: "Spanning thirty years, with several incarnations decades apart, and including dozens of different writers, directors, producers and novelists, *Star Trek* remains open-ended to the point that hardly anything constrains interpretation in even the most ordinary, untheoretical sense."<sup>173</sup>

**\*963** Perhaps we can draw a general spectrum on how much a recoding of a cultural object "replaces" the object in the cultural discourse.<sup>174</sup> At one extreme, what remains in our social consciousness of *Cinderella* or *Snow White* outside Disney's versions?<sup>175</sup> At the other extreme, *Robin Hood*, *Camelot*, and *Huckleberry Finn* have been the raw material for many different recodings, none overwhelming the original story in the social discourse. In between the two extremes, are Disney's *Jungle Book* and *Peter Pan* dominant, but perhaps not overpowering, recodings of the original works by Rudyard Kipling and J.M. Barrie?<sup>176</sup> Are the 1930s horror classics the dominant codings of *Frankenstein*, the *Werewolf*, and *Dracula*, but still leaving enough of the original cultural objects to permit recodings such as Mary Shelley's *Frankenstein*,<sup>177</sup> *An American Werewolf in London*,<sup>178</sup> or Coppola's *Bram Stoker's Dracula*?<sup>179</sup> Finally, the dominance of a recoding may depend on the generation in which one lives: at this end of the century, Baby Boomers and Generation X may have a general public-domain meaning for the Greek hero *Hercules* while children under fifteen may have a meaning dominated by the recently released theatrically-animated *Hercules*.<sup>180</sup>

#### **\*964 D. General Interests in the Diversity of Ideas**

If the considerations just discussed or the vexing questions of who derive what utility did not muddy the waters enough, there is a simple argument that even if some unprotected cultural objects have stable meanings now, any new cultural object needs legal protection while its meaning becomes diffused in the culture. I have made this argument elsewhere<sup>181</sup> in discussing how the limited duration of intellectual property protection permits owners to both promote and protect a cultural object for a time, but then releases the cultural object to the vagaries of the open culture. This respects the "marketplace of ideas," but recognizes that there are market imperfections. For a new cultural object's original meaning to be tested properly it must cross some threshold of diffusion. Society often takes some time to recognize a good idea--or passing fashion might hijack a good idea for some less desirable purpose. These problems are ameliorated by giving one person, for a time, rights to establish and promote one particular

meaning for a cultural object.<sup>182</sup>

For deconstructionists, advocacy of greater recoding freedom is premised on the proposition that greater recoding will necessarily enrich the marketplace of ideas. But the wealth of this marketplace is measured in terms of both the quantity and the quality of ideas; we want a system that delivers a wide range of ideas to citizens including ample radical expressions at all extremes. True, many of the recoding disputes arise when a secondary user wants to radicalize an existing work--as in cross-gender casting of *Steel Magnolias* or *Waiting for Godot*.<sup>183</sup> But protecting works from too much recoding also means protecting radical works from recoding that would tend to muffle extreme messages. This is the lesson of *Gilliam v. American Broadcasting Cos.*,<sup>184</sup> in which the Monty Python troupe succeeded in stopping the ABC television network from bowdlerizing its comedy sketches.<sup>185</sup> This point is easily lost sight of, as in one early comment which stated that:

A free society has an interest in promoting (or at least protecting) such radical, emotive speech, since the voicing of radical concepts leads to the adoption of moderate, beneficial reforms. Protection of radical ideas is, therefore, essential to societal progress.

Restrictive qualities of copyright are legitimately used to prohibit piracy . . . but restriction is inappropriate when an infringer \*965 incorporates the visual image into a new artistic work that adds to society's cultural legacy.<sup>186</sup>

This passage assumes that the “restrictive qualities of copyright” diminish the storehouse, but the wealth of the “cultural legacy” may hinge on “protection of radical ideas” from too much recoding. That protection can be achieved with copyright. In the throes of the French Revolution, the revolutionary government in Paris did away with copyright--in the name of unfettered free speech. The result was a massive “race to the bottom” in which easy to produce (often scandalous) pamphlets flourished while serious journals and the great books of the Enlightenment--including editions of Voltaire's works--fell out of print.<sup>187</sup> Charles Mann has drawn a parallel between that chaotic time and the need for viable copyright in the digital era. Mann notes that “[t]he problem in post-privileged France was not the shallowness of what was produced (not that it was cause for joy either) but its homogeneity.”<sup>188</sup> He recognizes that the control granted by copyright can foster unique content through those content providers who adopt a strategy of

try[ing] to produce works with some special quality, and thereby attract a small, loyal audience. High brow artists adopt this method, and so does almost everyone who isn't purveying animal-attack videos . . . . This strategy produces most of the [cultural] diversity. From the standpoint of society, a major goal of copyright is to smooth

diversity's path, by giving creators special rights to exploit their work. If copyright becomes meaningless, [it will be] almost impossible to create works for small, specialized audiences, and an awful [lot of] shrieking homogeneity will beset the culture.<sup>189</sup> Admittedly, advocates of recoding freedom are not proponents of the destruction of copyright in the 1789 Paris sense, but they still need to describe a regime of loosening intellectual property laws that would not tend to be used by those out to use recordings to profit financially--rather than to express themselves personally. Even if one believes that today's pop culture produces the wrong "mix" of cultural objects,<sup>190</sup> this does \*966 not mean that it would be desirable to enhance recoding by corporate entities or invite recoding by the government. This final point may sound farfetched but not only are large corporate entities--likely beneficiaries of increased recoding freedom--not known for promulgating radical ideas, but lower intellectual property protection could also raise the issue of possible government efforts to recode private expression.

Fortunately, we do not live in a society where we can point to many examples of the government taking private people's expressions and trying to recode those expressions, but a glint of what would be at stake is visible in cases that consider whether the government has "taken" a copyrighted work.<sup>191</sup> It is not difficult to imagine circumstances in which national leaders might want to dull certain cultural objects by recoding (Doonesbury) or a government might want to recode popular images for its own purposes, whether they be Norman Rockwell paintings or Madonna's image.<sup>192</sup>

### **III. The Problem of "Enough and As Good"**

While the discussion above emphasizes how the balance of interests might tip against recoding freedom, we should consider whether the cumulative effect of property rights over cultural objects inhibits expression in a way that is not detected from a compendium of individual examples. In the late 1980s Daniel Boorstin made an observation in keeping with the deconstructionists' concerns: in old-world societies it was in "high" culture--churches, universities, and the guilds--where control was \*967 centralized, and "low" or popular culture was diffuse and uncontrolled.<sup>193</sup> "In our society, however," Boorstin wrote,

we seem to have turned all of this around. Our high culture is one of the least centralized areas of our culture. And our universities express the atomistic, diffused, chaotic, and individualistic aspect of our life. . . . We are perhaps the first people in history to have a centrally organized mass-produced folk culture.<sup>194</sup>

For reasons described above, this "centrally organized . . . folk culture" is not the same thing as



saying that the centralized mechanisms suppress individual expression. Moreover, no one knows to what degree this centralization of popular culture is the result of intellectual property laws--versus, say, the result of technology or the concentration of capital (itself a result of other property laws). In the second half of the twentieth century, the Soviet Union and China also centrally organized folk culture and did so without a full range of intellectual property laws. The cumulative effect of intellectual property rights on popular discourse can not be gauged because there is no "control"--a society with a similar level of economic development, similar civil liberties, but no intellectual property rights over cultural objects.

Still, theorists walk freely where empirical researchers know they will never tread; the questions raised by writers like Coombe, Madow, and Aoki return us to John Locke's theory of private property. In Locke's political philosophy, the acquisition of private property can be justified under certain conditions, one being that after particular property rights are granted to one person, there will still be "enough and as good" to be propertized by others.<sup>195</sup> Locke sets out this condition in describing how people convert parts of the commons in a presociety setting into private property; he proposes that in this primitive state there are enough unclaimed goods so that everyone can appropriate the objects of his or her labors without infringing on the opportunity for others to appropriate similar goods.<sup>196</sup>

The enough and as good condition harmonizes some potentially conflicting propositions in Locke's philosophy. First, each person both \*968 "plots a course for his own preservation" and "is under a natural obligation to ensure that this conduces to the preservation of all."<sup>197</sup> The condition ensures that actions taken for self-preservation, in other words, seizing natural resources, do not disturb the prospects of others for self-preservation. Locke also posits that things in nature belong to all in common, but if the common is owned by everyone, then universal consent would be needed to justify an act of privatization; Locke overcomes this issue by understanding the community right in the commons as a right of opportunity, so that consent is not needed to take property from the commons as long as enough opportunities remain for others.<sup>198</sup> Much has been written about the application of this "proviso" to modern society.<sup>199</sup> Cast in Locke's light, the deconstructionist argument could say that once all the controls over images now inherent in copyright, trademark, and the right of publicity are recognized, there will not be enough and as good cultural "material" to be used by others (propertized or not) for their own self-expression.

Unfortunately, this gestalt argument makes the enough and as good condition impossible to test. We can hint at the potential problem, but remain mired in individual examples. Consider the problem of Elvis Presley. Professor Coombe criticizes intellectual property rights for stifling community expression, citing the case of the Elvis Presley estate preventing the City of Memphis from issuing pewter replicas of "the King" in order to fund a monument to him. She reasons that the existing right of publicity for this one celebrity obstructs "the preservation of our collective cultural heritage and . . . our future cultural development."<sup>200</sup> \*969 Coombe argues that this is an example of the present right of publicity going beyond any Lockean justification

because Locke's labor theory permits property rights "only insofar as the exercise of this right does not harm the rights of others."<sup>201</sup>

This use of Locke's condition might disturb the Locke purist,<sup>202</sup> but Coombe is certainly correct that the enough and as good condition has a powerful intuitive appeal as a principle of just distribution that one can apply to opportunities for economic well-being, personal growth, and self-actualization. The problem is--with due respect to rock and roll's early innovators--that it is difficult to believe that there is anything that the Elvis Presley estate can do to prevent the individuals who live in Memphis, individually or collectively, from having enough and as good for their personal spiritual, psychological, and intellectual growth. In the pre-property state, Cain might propertize a particular meadow or a particular point on the coast; as long as there were other good meadows, beaches, and streams to be propertized, even if Abel wanted that piece of the shore, Abel would not have a Lockean claim that there was no longer enough and as good.

Of course it can be argued that Elvis is special--that the Memphis community cannot substitute other local history for the King. Perhaps that claim is more persuasive than if, say, Cleveland wanted to build an Elvis Presley memorial. But it is hard to believe that the people of Memphis could not equal or exceed their self-actualization through some other civic efforts-- memorials to Martin Luther King, Jr., the greats of the blues tradition, or non-Memphis historical figures that could expand the horizons of the local citizenry. A claim that there is not enough and as good seems less persuasive than a parallel claim about real estate: imagine that the citizenry of Memphis needed a particular city block to build a park for their new memorial and no other city block would be so conducive to the city's new urban plan as yours. Should you be required to donate your house to be bulldozed down to make way for a bronze life-size King?<sup>203</sup>

**\*970** In the 1990s, the city of Cleveland did build an I.M. Pei-designed Rock and Roll Hall of Fame. This brings us closer to the gestalt problem: what if the intellectual property rights of rock and roll musicians had collectively frustrated this enterprise? Since there were not Clevelanders spontaneously clamoring in the streets for a rock and roll museum, it is still difficult to say that this would have frustrated their community expression. If the city leaders wanted a civic anchor to help revitalize part of the city, perhaps they could have built a museum of science or an air and space museum. (Would inability to get sufficiently high-quality historic airplanes--physical property--have produced an enough and as good condition?) If a variety of equally viable options were available to the city leadership, then if some of those options were foreclosed because of property rights, this should not create an enough and as good problem.<sup>204</sup>

In the case of individual images and whether there is enough and as good for private individuals, some of us will disagree about how vital certain images are to self-realization. Some may think that the images of Madonna, Elvis, James Dean, and John Wayne are vital instruments of self-expression and self-realization for many people. But the argument on the other side--that none of these images is so vital--is strong, either on the grounds that no single cultural object is so vital or that, if there can be such vital objects, none of these images rises to that level. These

images may be vital for some very limited purposes--like reporting news events, but rights of publicity and other intellectual property rights are already tailored to permit such uses.<sup>205</sup>

**\*971** If there are vital or “key” cultural objects that can trigger the Lockean proviso, they are objects with more historical and cultural importance than James Dean. The following are four cases: two about recoding propertized words and two that can be interpreted as the recoding of nonpropertized cultural objects. The cases in the first pair concern the word “Olympic” and the phrase “Pink Panther,” respectively. In each case, the words’ owners--for some purposes--sought to stop other groups from using the words for laudable, nonprofit activities. In the second pair of cases, the issue was whether significant cultural objects--in one case a parade, in the other case the U.S. flag--could be freely recoded. Of these four cases, I suggest only one, *International Olympic Committee v. San Francisco Arts & Athletics*,<sup>206</sup> reached the wrong result.

In *Olympic Committee*, the Court upheld the right of the United States Olympic Committee to prevent use of the word “Olympic” in conjunction with gay and lesbian athletic games;<sup>207</sup> in the *Pink Panther* dispute, the copyright holder for the *Pink Panther* movies<sup>208</sup> prevented the “*Pink Panther Patrol*” from being used as the name of a civic group in Manhattan formed to combat gay bashing.<sup>209</sup> In both cases, property rights prevented recoding by a minority group; if the wrong result was reached in either case, I suggest it was in the *Olympic* opinion.<sup>210</sup>

In the *Olympic* case, liability for the use of the word “Olympics” rested on the 1978 Amateur Sports Act,<sup>211</sup> which granted the United States Olympic Committee the exclusive right to use the word “Olympic.”<sup>212</sup> In other words, Congress propertized a word that already had a well-established, broad usage, so much so that the legislation had to “grandfather” scores of usages. The Supreme Court affirmed the Olympic Committee’s control of the word, but as Justice Brennan noted in his **\*972** dissent, the word “Olympic” was used by over two hundred organizations in the Manhattan and Los Angeles phone books alone.<sup>213</sup> It is a name used by an exclusive club,<sup>214</sup> the national airline of Greece (which flies into New York and Boston), and a major thoroughfare in Los Angeles.

Not only are the word “Olympic” and its variants widely used, but the word is particularly used for important competitive games, including “Special Olympics” all over the United States for handicapped persons,<sup>215</sup> international “Olympiads” sponsored by UNESCO in mathematics and the sciences,<sup>216</sup> and just about any competitive forum that wants an august sounding name.<sup>217</sup> This usage suggests that there are no easy replacements for the idea of an “Olympics” any more than for the idea of the “Forum” or the “Academy.” In the ancient world, all three of these words defined spatially and temporally specific points; now, all three of these words are generalized but with a glow from our Renaissance-born admiration of the ancient world that seems fairly consistent through generations of English speakers. To use the word “games” to replace “Olympics” is like using the word “meeting place” to replace “Forum” or “school” to replace “Academy.”<sup>218</sup> Ironically, in describing the “World Scholar Athlete Games” held at the University of Rhode Island--an event which may have intentionally avoided or been refused use

of the word \*973 “Olympics”--an Associated Press writer was reduced to describing it as “a kind of Olympics of the mind and body.”<sup>219</sup>

Propertizing the word “Olympic” also generated a separate enough and as good problem for those who live in areas with long-standing geographic names using the word, particularly in western Washington state. Recognizing this problem, Congress recently amended the grant of “Olympic” to the United States Olympic Committee to create “a clear safe harbor for businesses using the word ‘Olympic’ when they operate and conduct most of their sales and marketing west of the Cascades” in Washington State.<sup>220</sup>

In comparison, the Pink Panther dispute<sup>221</sup> involved a phrase that was not widely used before it became the subject of property rights; it has no historical or cultural reference outside the chain of title leading from its creators to its present owners. The Pink Panther is a memorable cartoon character and a memorable image, but one does not frequently hear references like “He’s the Pink Panther of banking,” “She’s the Pink Panther of the historic preservation movement,” or “it’s a Pink Panther lifestyle.” While “Pink Panther Patrol” would have been a clever choice for the group’s name, a number of equally effective alternatives probably exists.<sup>222</sup> The “Guardian Angels,” for example, succeeded in quickly creating a positive image for a similar civilian patrol--without needing to recode someone else’s cultural reference.

Recoding a well-known cultural reference is the core of two of the Supreme Court’s recent free speech cases: *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*<sup>223</sup> and *Texas v. Johnson*.<sup>224</sup> In *Hurley*, the Supreme Court concluded that sponsors of Boston’s annual St. Patrick’s Day parade could bar a gay rights group from participating in the \*974 parade with their own banner.<sup>225</sup> In *Texas v. Johnson*, the Court concluded that the State of Texas could not prosecute Johnson for burning the American flag.<sup>226</sup>

A good argument can be made that there is an important distinction between the two cases in terms of the enough and as good condition: there have proved to be viable substitutes for the St. Patrick’s Day parade, while it is difficult to imagine an adequate substitute for the American flag in terms of a political reference. While the Olympic case may have been wrongly decided, the *Hurley* and *Johnson* results track the enough and as good distinction well. In *Hurley*, the state trial court found that it was “impossible to discern any specific expressive purpose” to the Boston St. Patrick’s Day Parade and concluded that it was not protectable expression.<sup>227</sup> Applying anti-discrimination statutes for public facilities, the court ruled that the parade’s sponsors, the South Boston War Veterans’ Council, could not keep the banner of the Boston gay, lesbian, and bisexual organization (known by the acronym “GLIB”) off the parade route.<sup>228</sup>

The Supreme Court reversed. Noting that “parades are public dramas of social relations,” the Court concluded that all parades “are thus a form of expression, not just motion”; therefore, the St. Patrick’s Day parade was speech over which the Veterans’ Council should have control.<sup>229</sup> Once the Court found that the parade was capable of being content-laden speech, the error of the

state court decision was evident:

the state court's application of the statute produced an order essentially requiring petitioners to alter the expressive content of their parade. . . . [O]nce the expressive character of both the parade and the marching GLIB contingent is understood, it becomes apparent that the state court's application of the statute had the effect of declaring the sponsors' speech to be a public accommodation.<sup>230</sup> Thus, as formulated by the Court, the implicit question was whether the parade was "speech" or a public space for speech--whether it was the nonpublic content or the public receptacle in which the content occurs. Once the parade was found to be speech, application of the state statute "violate[d] the fundamental rule of protection under the First Amendment that a speaker has autonomy to choose the content of his own message."<sup>231</sup>

**\*975** Madhavi Sunder insightfully analyzes Hurley as an example of the "intellectual propertization" of First Amendment discourse.<sup>232</sup> Sunder clearly believes that GLIB should have been permitted to march in the parade and supports this conclusion with an argument that First Amendment jurisprudence should be moved away from property concepts which use "speaker autonomy as a shield around a speaker's message [to] create an intellectual property right in contested ideas."<sup>233</sup> Sunder believes that this is a "property-like approach that preserves what may be characterized as dying ideas or communities at the expense of internal cultural critique and growth."<sup>234</sup> On this count Sunder seems to believe that the traditional "family values" of the Boston Irish-American community, if not the community itself, are dying institutions that should be challenged--through the St. Patrick's Day Parade--by newer notions. Sunder does not believe that the court erred by finding that the parade was not public space: Sunder agrees that the parade has content, but contends that GLIB should have been able to insert its message into "the discursive space occupied by the idea of the parade."<sup>235</sup>

Sunder's view is a variant on the recoding argument, and understanding the full scope of the argument in the Hurley context highlights how wide the recoding argument could cut. Recoding should not be only selectively available; what is good for the goose is good for the gander. Should free speech allow the Christian Coalition and the Promise Keepers to force their way into every Gay Pride parade across the country? Should controversial issue statements--pro-choice, anti-immigrant, pro-logging, etc.--have the right to place themselves in the Rose Bowl Parade or the Macy's Parade? Should organizers of jazz, rock, or film festivals have to permit the Ku Klux Klan to participate in their events?<sup>236</sup> Sunder hints at recognizing the problem by remarking that: "it is unfair for a feminist to infiltrate the Federalist Society even under the dialogic approach, since a certain amount of discrete space is necessary to properly shape one's ideas for presentation in opposition to other ideas."<sup>237</sup> The approach that this suggests is unworkable: that one could have autonomy in forming the intent for one's speech, although one is no longer free from interference in actually speaking. Of course, we should ask, why would anyone need **\*976** "space" to "properly shape one's ideas for presentation" since the

moment one begins to “present” those ideas, the expression of those ideas can be occupied, co-opted, or hijacked by others? Doesn’t the expression itself need a guarantee of some “space” ? Perhaps Sunder would believe that some subunits of the parade should have the right to present their message with autonomy; in other words, what if the Christian Coalition surrounded the GLIB banner with “God Saves Sinners” posters and infiltrated the GLIB contingent with Irish gospel singers?<sup>238</sup>

If one recognizes that GLIB--and other small cells within the parade-- should have some autonomous space for their expressions, then the “dialogic” approach is not so radical. Indeed, it would become, once more, a recognizable dialogue. Sunder asserts that Hurley treats speakers as “authors with impermeable identities whose genius or moral rights stands above societal dialogue.”<sup>239</sup> That characterization is wrong: authors are far from being “above societal dialogue,” authors produce the basic units of dialogue. Speakers produce speech acts--units out of which social discourse is built.<sup>240</sup> This is why “a conception of each particular idea or expression as itself a site of contest has been foreign to [First Amendment] jurisprudence.”<sup>241</sup> We may argue about the proper size of the speech act--we may say that a big parade is too unwieldy, too amorphous to be a single speech act entitled to some autonomy; that, apparently, was the Massachusetts trial court’s conclusion. But that does not deny that there is a unit, of some size, entitled to control by the “author.”

At that point, Sunder’s concern appears much more like a question about enough and as good. The Supreme Court casts the issue as whether or not the parade was speech; Sunder casts the issue as whether the speech of the parade is exclusively controlled by one party or can be affected by \*977 many parties.<sup>242</sup> But the issue can be put another way: whether the parade is such an irreplaceable cultural object that giving exclusive control over it to one party will deny other parties enough and as good for their own communications.

In Hurley, there were powerful enough and as good arguments on both sides. On the one hand, the Boston St. Patrick’s Day--like its counterparts in other Eastern cities--is a unique, politically important event. The Court was certainly aware of this fact, but implicitly rejected the notion that there are not enough and as good means to disseminate GLIB’s message, because “the size and success of petitioner’s parade makes it an enviable vehicle for the dissemination of GLIB’s views, but that fact, without more, would fall far short of supporting a claim that petitioners enjoy an abiding monopoly of access to spectators.”<sup>243</sup> Subsequent events reinforce the Court’s comment: after GLIB was refused access to the South Boston parade, a new, liberal St. Patrick’s Day parade has started in Cambridge.<sup>244</sup> And all of Massachusetts’s significant politicians--like Boston Mayor Thomas Menino and Governor William Weld--have recently shunned the South Boston parade.<sup>245</sup> Apparently, in their political judgment, the traditional parade was not irreplaceable.

Contrast that with *Texas v. Johnson*, in which the Supreme Court overturned a state law protecting the American flag from desecration.<sup>246</sup> Emotions on the Court ran high--witness the

fragmented opinions, the majority's pains to express its respect and concern for the flag, and Justices Rehnquist's and Stevens's patriotic dissents. In the end, the five-member majority concluded that flag burning was expressive political speech protected by the First Amendment; they refused to create a "flag exception," noting that the Court had "never held that the Government may ensure that a symbol be used to express only one view of that symbol or its referents."<sup>247</sup> To the deconstructionists, however, this is not true: the \*978 law often does censor meaning in favor of "only one view of [a] symbol" when intellectual property rights are recognized and enforced.<sup>248</sup>

In *Johnson*, the majority adopted the deconstructionists' preferred holding: that the cultural object should be kept available to a wide variety of users. There is no question that the issue was conceived as whether the flag could be recoded to have some meaning--or be used in some meaning--contrary to its traditional, patriotic meaning. The majority so characterized Texas's concern:

The State, apparently, is concerned that such conduct will lead people to believe either that the flag does not stand for nationhood and national unity, but instead reflects other, less positive concepts, or that the concepts reflected in the flag do not in fact exist, that is, that we do not enjoy unity as a Nation. These concerns blossom only when a person's treatment of the flag communicates some message . . . .<sup>249</sup> Putting it more bluntly, the Court concluded that "the State's claim is that it has an interest in preserving the flag as a symbol of nationhood and national unity; a symbol with a determinate range of meanings."<sup>250</sup>

How do we justify property-esque *Hurley* and free-recoding *Johnson*? Although never identified as such, the battle fought within the Court over the *Johnson* ruling was, in part, a debate about recoding and the enough and as good condition.<sup>251</sup> The Justices went to lengths to agree on the flag's symbolic importance. The majority wrote that "the very purpose of a national flag is to serve as a symbol of our country,"<sup>252</sup> while Justice Kennedy eloquently wrote that "the flag holds a lonely place of honor in an age when absolutes are distrusted."<sup>253</sup> Justice Brennan quoted Justice Rehnquist's characterization of the flag as "'the one visible manifestation of two hundred years of nationhood.'" <sup>254</sup> Rehnquist further identified the flag as a unique cultural object: "The flag is not simply another 'idea' or \*979 'point of view' competing for recognition in the marketplace of ideas. Millions and millions of Americans regard it with an almost mystical reverence . . . ."<sup>255</sup>

The majority disagreed with the dissenters on both whether the state could "fix" a meaning for a symbol and on how important this particular symbol--the national flag--is for the social discourse. The majority criticized Justice Rehnquist for being inconsistent on this second point. In a very real sense, the majority believed that there would be an enough and as good problem if the meaning of the flag were fixed:

The Chief Justice's dissent appears to believe that Johnson's conduct may be prohibited and, indeed, criminally sanctioned because 'his act . . . conveyed nothing that could not have been conveyed and was not conveyed just as forcefully in a dozen different ways.' . . . [T]his assertion sit[s] uneasily next to the dissent's quite correct reminder that the flag occupies a unique position in our society--which demonstrates that messages conveyed without use of the flag are not 'just as forcefu[l]' as those conveyed with it . . . .<sup>256</sup> Thus, the importance of the national flag in discourse far exceeds any single parade, any historic name for athletic games, and any clever character from films.

The earlier discussion raised the point that deconstructionists could defend a loosening of intellectual property rights on the grounds that those cultural objects tending to be recoded will be cultural objects that already have a strong, not-easily-corrupted core meaning.<sup>257</sup> The majority in Johnson made this same argument in justifying their refusal to protect the flag's core meaning:

We are fortified in today's conclusion by our conviction that forbidding criminal punishment for conduct such as Johnson's will not endanger the special role played by our flag or the feelings it inspires. To paraphrase Justice Holmes, we submit that nobody can suppose that this one gesture of an unknown man will change our Nation's attitude toward its flag.<sup>258</sup>

With a little effort, we could construct a descending scale of cultural objects whose "proPERTIZATION" might breach the enough and as good condition. In a category all by themselves might be the American flag, the Christian cross, the Bible, the Star of David, and the Declaration of Independence--not to mention symbols of evil like the swastika. The \*980 Statue of Liberty, the facade of the White House, Abraham Lincoln, and others might form a second tier.<sup>259</sup> In other cases--further out--some people might argue that the words or images are so central or functionally nonsubstitutable that the enough and as good condition would be broken if they were proPERTIZED.<sup>260</sup> At some point, Coombe and Madow would make the case for James Dean and Madonna, while others would not consider them so vital.

What difference can be drawn between the flag and "Olympics," on the one hand, and a St. Patrick's Day parade, the Pink Panther, Elvis Presley, and Madonna on the other? One obvious possibility is how long rights of exclusion would affect expression--it's easy to think that people will want to call athletic games "Olympics" for generations to come, while discussions of the need to recode a platinum-blond Madonna already seem dated. But the duration that people want to recode a cultural object may not bear on the intensity of that need when it does exist: in other words, how much a young woman may have needed to identify with Madonna in 1990. Part of



this answer has to lie in the level of frustration; that is difficult to judge, even after the fact. Just as the folks who wanted to organize the Pink Panther Patrol could have organized under a different name, GLIB and its friends now have a successful (counter) parade. The “Gay Games”--not to mention Jewish athletic games--have apparently flourished without the word “Olympics.”<sup>261</sup> That is a critical point in considering the enough and as good issue.

Deconstructionist discussions tend to assume that the secondary user is “frustrated” if recoding is not permitted.<sup>262</sup> But this depends on an **\*981** implicit judgment about people and their level of creativity. By allowing creators to borrow some, but not borrow too much, intellectual property laws force creators to express themselves by differentiating themselves from what has come before. In *Lotus Development Corp. v. Borland International, Inc.*,<sup>263</sup> Judge Boudin observed that

in the context of literary works such as novels, plays, and films. . . . [T]he principal problem--simply stated, if difficult to resolve-- is to stimulate creative expression without unduly limiting access by others to the broader themes and concepts deployed by the author. The middle of the spectrum presents close cases; but a “mistake” in providing too much protection involves a small cost: subsequent authors treating the same themes must take a few more steps away from the original expression.”<sup>264</sup>

Perhaps Prince started out his career really only wanting to be a Jimi Hendrix clone; perhaps for a time Madonna wanted only to be a Marilyn Monroe imitator; if intellectual property laws actually pushed these people away from existing cultural objects, are we not pleased, both for them and for us? The music scene of any major American city is filled with bands that write their own material when it would be so much easier--but so much less expressive of their individuality--for them to cover well-known songs. Could Mario Vargas Llosa have become a great writer if he had only imitated Faulkner’s style and not found his own “voice” ? How many worlds of science fiction, how many characters in mystery stories would not have been created if people could recode Isaac Asimov’s *Foundation* or Agatha Christie’s *Hercule Poirot*? Beyond cultural progress, issues of social progress may also be affected. If one believes that the traditional values embodied in Boston’s St. Patrick’s Day Parade are already dying,<sup>265</sup> are they killed off more quickly by a GLIB contingent marching in the customary (now recoded) parade or by a whole new parade that gets its own television and radio attention in direct competition with the customary parade?

Admittedly, Judge Boudin’s insight simplifies the situation. Among non-owners there will be people of varying degrees of creativity; not all will be able to take “a few steps” away from the existing expression. In rough carpentry, we might assume that the truly noncreative people are the passive listeners. But among the secondary users, there will be some who are more creative, some who are less. The more creative individuals will be able to continue expressing themselves--seeing any legal prohibitions as **\*982** an obstacle, but not a bar to expression. For

many of them, their expression may become stronger--more original, more genuinely their own--precisely because it is not acceptable to mimic Buddy Holly or Jorge Borges too much. In the end, not all secondary users are alike; the interests of secondary users who actually benefit from the prohibition have to be weighed in the balancing of interests related to recoding freedom. This creative group does not appear to suffer from a failure of the enough and as good condition.

This still admits that for some secondary users the (somewhat porous) prohibition on recoding will suppress expression; they will express less than they would have but for the recoding prohibition. A small group within this group will be genuinely frustrated: those who will not express themselves at all because the only vehicles they are willing (or able) to use already belong to someone else. These people do suffer in a way that may implicate the enough and as good condition. Two questions remain: First, how large is this group? Is this a genuine problem with a large enough group that they should be accounted for in our legal regime? Second, is their personal development proceeding on a desirable path? What about the teenager who can only express himself as a James Dean imitator or the soldier who spends his off-duty time living the role of John Wayne?

Perhaps another enough and as good problem with propertized cultural objects arises in the literary genre of parody, an area of intellectual property law in which recoding is expressly permitted through a branch of the fair use doctrine. Parody and satire are creative genres that seem to uniquely rest on express recoding of pre-existing works.<sup>266</sup> Parody doctrine permits a new work to “recall or conjure up”<sup>267</sup> the image of the subject work, indeed to bring the subject work to mind repeatedly. A parody song may be most effective if each set of lyrics parallels a set of lyrics in the original work; a comic parody of a movie condenses familiar scene after familiar scene. A parody of Leonardo da Vinci’s Last Supper would include not just a Christ and twelve apostles but would arrange the diners in arched trios, all sitting oddly on the same side of a dining table. As the court in *Elsmere Music, Inc. v. National Broadcasting Co.*<sup>268</sup> stated,

**\*983** the concept of “conjuring up” an original came into the copyright law not as a limitation on how much of an original may be used, but as a recognition that a parody frequently needs to be more than a fleeting evocation of an original in order to make its humorous point.<sup>269</sup>

The court held that more extensive use than was necessary to “conjure up” would “still be fair use, provided the parody builds upon the original as a known element of modern culture.”<sup>270</sup> The Ninth Circuit has similarly concluded that a parody will be fair use when it “takes no more from the original than is necessary to accomplish a reasonably parodic purpose.”<sup>271</sup>

It can be argued that the copyright parody case law is richly inconsistent; although copyright law

is supposed to be content neutral, no single factor seems to affect whether a parody will be found to be a noninfringing fair use more than whether or not the parody is pornographic.<sup>272</sup> In cases like *Walt Disney Productions v. Mature Pictures Corp.*,<sup>273</sup> *MCA, Inc. v. Wilson*,<sup>274</sup> and *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*,<sup>275</sup> lewd recordings of cultural objects were found impermissible, but in *Elsmere Music, Inc. v. National Broadcasting Co.*,<sup>276</sup> *Warner Bros. v. American Broadcasting Cos.*,<sup>277</sup> and *Berlin v. E.C. Publications, Inc.*,<sup>278</sup> recordings that were \*984 as or more extensive, but not lewd, were found to be fair uses under copyright law.<sup>279</sup>

As disturbing as this lewd-decent bifurcation in the cases may be for the content-neutral goals of copyright law, it might have a certain sensibility from the perspective of recoding and overall utility measures. First, although the law permits a wide range of personal expression through already propertized objects, a society might say that certain types of personal expression do not count as human flourishing. Although we can and do permit lewd expression, we might conclude that we will not give it the full range of support that we give to more favored substantive expressions. The dichotomy in the cases is based, in this sense, on our solicitude--or lack thereof--for the secondary user of the existing material.

There is also an explanation based on the utility interests of passive listeners who depend on image stability. People who have lily-white images of Mickey Mouse and Happy Days feelings about The Boogie-Woogie Bugle Boy may suffer disutility when these wholesome cultural objects are suddenly recoded to express more prurient interests of the society. Each time a court discusses “harm” to an original image, it could be this interest--as well as the copyright owner’s--that is coming into play.

There are a couple problems with the idea that consumer interests explain the harsher treatment of lewd recordings in parody cases. First, it is not clear that those who rely on the existing “clean” cultural object will ever be exposed to the lewd recording. Given the demographics of off-Broadway musical audiences, it was probable that the audiences of *Let My People Come--a Sexual Musical* who heard the *Cunnilingus Champion of Company C* would be consumers of *The Boogie-Woogie Bugle Boy*.<sup>280</sup> In contrast, some commentators believe that the Mickey Mouse cases<sup>281</sup> were wrongly decided on this question of who is exposed to the original compared to who is exposed to the parody. In *Mature Pictures*, the consumers of the *Happy Hooker* movie are hopefully not the regular consumers of Mickey Mouse cartoons and books. In *Air Pirate Funnies*, although \*985 both the original and the derivative works were printed cartoons, the *Air Pirates Funnies* used Disney characters in overt sexual and drug-use situations; hopefully the “funnies” were not reaching many children. Critics of Disney’s successes in these cases typically conceive of this as a “market” issue--different people self-select exposure to the original or to the parody--so the original suffers no commercial damage:

[T]he parody [should have been] protected because *Air Pirate Funnies* is an adult magazine with a clearly different purpose and audience than Disney’s. Someone

interested in reading a Disney comic book would not turn to Air Pirate Funnies instead, and vice versa. . . . Therefore, the fair use defense should be permitted, even if there is near verbatim copying of the original.<sup>282</sup> Most commentators analyze the issue through the economic damage criteria of the fair use defense,<sup>283</sup> but the effects of a defendant's activities can also be viewed as "image damage" or general damage to the stable meaning of the cultural object. On this count, perhaps there is more overlap than an economic perspective permits. The young people who read Air Pirate Funnies in the 1980s were the children who read Disney comics in the 1960s--and the parents who will prescribe or proscribe Disney comics for their children in the 2000s.

A further distinction might be drawn between, on the one hand, lewd recordings of Mickey Mouse and, on the other hand, the breast-exposed excheerleaders of the Dallas Cowboys Cheerleaders parody poster.<sup>284</sup> After all, the Dallas Cowboys Cheerleaders have always traded on sex--that is what their appeal is supposed to be. Any Dallas Cowboys corporate-speak about the Cheerleaders maintaining an image of purity would surely be tongue-in-cheek capitalism. When some of the Cheerleader alumni are seen topless, it really does not seem to "contaminate" the existing cultural object much. Mickey Mouse shooting up heroin puts a lot more stress on our communal image of Mickey Mouse than seeing a Dallas Cowboys Cheerleader topless puts on our communal image of the Cheerleaders. "[P]arody can legitimately aim at artistically destroying the original, despite the economic repercussions."<sup>285</sup> That \*986 sounds correct from a First Amendment perspective, but "artistically destroying the original" may have more than significant "economic repercussions" for the owners; it may also have significant utility loss for non-owners who have come to identify with Mickey Mouse as a central part of wholesome Americana.

What makes parody so interesting from the deconstructionist perspective--and the issue of the enough and as good condition--is what it does not permit. Jeff Koons's sculptures were not permissible parodies because they made fun of society at large, not the images Koons appropriated: "[T]hough the satire need not be only of the copied work and may . . . also be a parody of modern society, the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work."<sup>286</sup> This aspect of parody doctrine returns us to the "gestalt" enough and as good problem. If a parody must make fun of the particular cultural object being used as the vehicle of communication, what do we use to satirize the entire society at a more abstract level? One may appropriate any propertized image to critique that image itself, but there are no propertized images available to poke fun only at the society at large. A conspiracy theorist might see a master plan here: the establishment permits criticism of individual cultural objects, but restricts criticism of the general social order.

A more cogent explanation goes to the nature of recoding as part of an ongoing dialogue. If a cultural object is a "speech act" in the cultural discourse, a parody is a direct reply. A parody is a

reply which acknowledges both the original coding of the subject work and the original work's social place; as the district court in *Elsmere* wrote, "[P]arody is an acknowledgment of the importance of things parodied."<sup>287</sup> For Saturday Night Live's *I Love Sodom* to be an effective parody of the song *I Love New York*, the former has to do more than conjure up the latter: the parody song is funny only as much as it reminds you that the original song promotes New York City with a Prozac-upbeat, unrealistic image of the Big Apple.

If we accept what the courts said about Koons's artwork, then his artwork represents a fairly rare type of expression--an expression that pokes fun at the society at large without poking fun at any of the cultural objects \*987 it uses. Such "parody" of the society as a whole is very abstract--it is not obvious that *Wild Boy with Puppies* is making fun of society in the way that *I Love Sodom* was obviously making fun of *I Love New York*. In such situations, intellectual property laws are arguably preventing enough and as good source material from being available to some secondary users. There are still many secondary users who will work around the problems. The question is whether there are enough secondary users so deprived to justify shaping the legal system to respond to their needs.<sup>288</sup>

#### IV. The Law and Listener Interests

A keener awareness of the interests of different groups leads to another question: what to do about the third situation sketched out in the introduction--in which it is the owner of a cultural object who wants to re-code, and it is the non-owners who want the cultural object to maintain its present meaning. Courts have recognized that listeners have an interest in communications. The Supreme Court, while recognizing First Amendment protection for commercial speech in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*,<sup>289</sup> noted that "[a]s to the particular consumer's interest in the free flow of commercial information, that interest may be as keen, if not keener by far, than his interest in the day's most urgent political debate."<sup>290</sup> Also, Robert Bork writes that the benefits described by Brandeis in his *Whitney v. California*<sup>291</sup> concurrence "may be found, for both speaker and hearer, in all varieties of speech."<sup>292</sup>

\*988 These jurisprudential observations about consumers' or listeners' interests are usually plugged into a dynamic model about the "flow" of information. Yet it is easy to imagine situations where members of the audience will have an interest in holding an image stable while it is the image owner that wants "flow." As Sudjic has noted:

Mary Pickford . . . had to go on playing adolescent girls well into her thirties, and provoked a revolt from her fans when she finally cut the curls that had become her trademark. Once the real figure beneath the image started to surface, when Chaplin's outspokenness was deemed un-American, or Pickford went through a messy divorce, the audience was scandalized at this threat to their perception of the star.<sup>293</sup> In his 1995

novel, Slowness, Milan Kundera elaborates on how--in the modern era--people have come to rely on allusions to celebrities for self-expression:

[T]he era founded on the invention of photography comes to the rescue with its stars, its dancers, its celebrities, whose images, projected onto an enormous screen, are visible from afar by all, are admired by all, and are to all beyond reach. Through a worshipful fixation on famous people, a person who sees himself as elect serves public notice of both his membership in the extraordinary and his distance from his ordinary. . . .

Thus famous people have become public resources like sewer systems, like Social Security, like insurance, like insane asylums.<sup>294</sup> A celebrity image, like a public resource, is something upon which one may make demands (and have expectations of) without being the “owner.”

And celebrities are not alone: There are audience expectations for works protected by trademark and copyright as well. People who read a particular novel may not want to see it turned into a movie; fans of a book, movie, or play may oppose the creation of a sequel. How many devotees of *Gone with the Wind*<sup>295</sup> were opposed to the 1990s sequel *Scarlett*?<sup>296</sup> \*989 How many fans of the book *Dune*<sup>297</sup> were opposed to the movie<sup>298</sup> version? How many comic book readers of old have been saddened as the look and feel of Batman or Spiderman have changed over the years?<sup>299</sup> It is probably accurate to say that these situations in which the owner desires to recode tend to occur when there is an effort to reap greater commercial advantage from an existing cultural object. This is true not only of same-medium sequels and novels made into motion pictures, but also of colorization of motion pictures, remakes of motion pictures, books or motion pictures converted into comic books, posters made from great photographic images, and Muzak versions of rock and roll hits.<sup>300</sup> As one commentator noted, “Fans also see themselves as guardians of the texts they love, purer than the owners in some ways because they seek no profit.”<sup>301</sup>

These cases are different from the Mary Pickford situation--a single celebrity persona's evolving--because derivative works are being created. Still, the meaning of the original cultural object is at issue. That meaning can be changed as follows: (1) by altering the original object,<sup>302</sup> (2) by creating a derivative object which largely supplants the original object in the market of objects and ideas,<sup>303</sup> or (3) by creating a derivative object that independently influences the meaning of the original object. Whatever the source of the threat to the original meaning, listener interests in the stability of a cultural object can continue long after any property rights have expired.<sup>304</sup> From one perspective, this issue is kin to the larger \*990 problem of the reliance interests of non-owners vis-a-vis all types of property. Although there is no cohesive reliance

doctrine for property law as there is for contract law, the strands of such a doctrine have been noted by Joseph Singer in the areas of tenants' rights, adverse possession law, prescriptive easements, easements by estoppel, historic preservation laws, and equitable property divisions in divorce proceedings--all areas in which the non-owner develops some claims of control over the property.<sup>305</sup>

An approximation of what "listener's interests" could look like is the unusual result of a 1989 suit over Ansel Adams's name. In *Adams v. Day Dream Publishing Inc.*,<sup>306</sup> Ansel Adams's estate sought to stop a publisher from using the photographer's name on calendars, posters, and a book that used copies of photos Ansel Adams did for the National Park Service in 1941-1942. For \$5.25 each, the publisher, Day Dream Publishing, had obtained copies of prints made by Adams from the National Archives.<sup>307</sup> Judge Keller, issuing an injunction, agreed with the estate that prints made by photographing copies of Adams's prints were not true Ansel Adams works.

But Judge Keller went further by setting out requirements for a print to be a true Ansel Adams work: that the great photographer developed the negative himself, that the print be made from that original negative using Adams's "zone method" of printing, and that the published reproductions be printed using an ink Adams developed.<sup>308</sup> One journalist called this a "truth-in-labeling decision."<sup>309</sup> In one sense, Judge Keller struck a blow for audience interests. That interest may only be a "consumer confusion" issue about the quality of goods. The order was also a statement of the audience interest in the artistic integrity of the photographic images as cultural objects. Judge Keller's ruling can be seen as an effort to fix the meaning of an "Ansel Adams photograph" as roughly what it meant at the time Adams ended his career. The ruling crafted by Judge Keller constrained the "owners" of Ansel Adams's name and his image in order to protect the interests of non-owners.

**\*991** While Judge Keller's ruling may be appealing in the case of great artists' works, it also demonstrates the problem with broad recognition of such interests. Imagine that Honda decided to devalue its "Acura" trademark for expensive, luxury automobiles by selling decidedly inferior cars as Acuras-- something of the quality of the old Yugo. There is no question that people in America use cars as devices for self-expression.<sup>310</sup> Could people who bought the new, inferior cars have any claim based on their reliance on the established meaning of "Acura" ? Could the trademark owner be guilty of the same offense as trademark infringers: deceit of new purchasers? Full-blown reliance interests could also raise the specter of old Acura owners having a claim for diminution of whatever value in their cars had been based on the powerful trademark. In effect, this would be a dilution claim against the trademark owner.<sup>311</sup> This is just the tip of the iceberg of problems that would arise with such reliance interests. No wonder trademark and copyright law give non-owner interests an awkward embrace. For example, while "consumer confusion" is the main avenue to prove trademark infringement, consumers themselves do not have a cause of action when they are confused by unauthorized use of a trademark. A survey of some aspects of the caselaw reveals why reliance interests in property would not work in the case of most intellectual property.

## A. Trademark Law and the Non-Owner

At first blush, trademark law seems to fulfill Virginia Pharmacy's promise of recognition of non-owner interests. Although at a distance from the copyright and persona interests that motivated the deconstructionist critique, it is worthwhile to consider the balance of owner and non-owner interests in this area of intellectual property. In trademark law, a trademark owner has the right to control what goods are sold under that trademark, but "the rationale for this requirement" is the reliance non-owners place in the mark: "marks are treated by purchasers as an indication that the trademark owner is associated with the product."<sup>312</sup> In other words, the rationale for owner control of these symbols is that non-owners \*992 (purchasers and consumers) rely on these cultural symbols to have a stable meaning. The principle was stated, albeit in a slightly different context, as follows:

The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting consumers from confusion as to source. While that concern may result in the creation of "quasi-property rights" in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation.<sup>313</sup> The trademark owner's failure to control the quality of licensed products can cause loss of the trademark through "abrogation of the licensor's duty to protect the informational value of the mark."<sup>314</sup> The logic of non-owner interests may also provide benefits to owners: in a trademark or trade dress action, the plaintiff does not have to show economic loss precisely because, doctrinally, it is the consumer, not the plaintiff, who the law protects.

Protection of the informational value of a trademark to non-owners can even lead to enforcement of meanings--that is, holding stable meanings--that are contrary to plain English. For example, the Idaho Potato Commission holds the trademark to the phrase "Grown in Idaho" and the "Idaho" seal for potatoes.<sup>315</sup> The Commission permits these to be used for only one species of potatoes--the Russet Burbank; other types of potatoes actually grown in Idaho may not be labeled "Grown in Idaho." The commission has successfully enforced these counter-to-plain-English meanings for its trademarks by showing "that most consumers believed they were purchasing Russet Burbanks when buying 'Idaho' potatoes."<sup>316</sup>

\*993 In traditional doctrine, a trademark did "not exist as an abstract right disconnected from the business in which it is used;"<sup>317</sup> the trademark had to be transferred with whatever it was used to denote, by sale of an entire business or by assignment or license of the patent used to make the trademark product. This rule has wavered, and it is now subject to a general exception that a trademark can be transferred freely when it has been "deprived of its personal nature and has come to indicate that the goods bearing it are of a certain standard, kind or quality."<sup>318</sup> In fact,



American law is now obliged to follow the intellectual property obligations of the World Trade Organization; these require that “the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.”<sup>319</sup>

## **B. Consumer Confusion Tests in Trademark and Copyright**

Because trademark laws are intended to increase efficient communication of accurate information to the public,<sup>320</sup> it is no surprise that the central inquiry in a trademark or trade dress action has traditionally been whether consumers are likely to be confused by the similarity between two marks or two products into thinking they came from the same source.<sup>321</sup> As one court sagely noted,

Interested businessmen may sue for trademark infringement in the course of protecting their pocketbook. But it is one of the geniuses of what has been called the “free enterprise” system (but which, in its proper operation, might be better described as “consumer-choice” system) that the interests of the consuming public and of the entrepreneur are to the maximum extent paralleled. Thus the public need not rely wholly on government for protection against confusion, and need not pay the taxes such reliance would entail.<sup>322</sup> \*994 Of course, the virtue of such enforcement is not that there are no costs, but that the “taxes” are passed on by the private enforcers as business costs and, therefore, concentrated in those non-owners who rely most on the stability of the trademark’s meaning.<sup>323</sup>

Likelihood of confusion in trademark law richly reflects the interests of non-owners: the test investigates the “likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question” or that there may be confusion as to the plaintiff’s sponsorship or identification of the allegedly infringing mark.<sup>324</sup> Confusion is judged from the point of view of a consumer who encounters the mark individually;<sup>325</sup> this standard--versus requiring a showing of likelihood of confusion when the marks or products are side-by-side--is solicitous of the actual circumstances of non-owners’ reliance on meanings. Except for expensive or professional goods, it is assumed that consumers “do not stop to analyze, but are governed by appearances and general impressions;”<sup>326</sup> one court pondered whether “the average purchaser undergoes, while in the supermarket, an experience not unlike that of hypnosis.”<sup>327</sup> The relevant non-owners are the specific consumers of a product or image.<sup>328</sup> Further evidence that the law looks \*995 to actual non-owner interests is the lower threshold for showing confusion with medical products;<sup>329</sup> as a practical matter, non-owners receiving blurred meanings are more likely to be harmed by confusion of medical products.

Except for inherently distinctive marks, most trademark owners need to show that their marks have acquired “secondary meaning”; in other words, a demonstration that “International Business Machines” means more to consumers than the sum of its parts.<sup>330</sup> The trademark owner can establish secondary meaning by showing that the primary significance of the mark “is to identify the source of the product rather than the product itself.”<sup>331</sup> The determination whether a trademark or trade dress has acquired secondary meaning is primarily an empirical inquiry into current consumer associations.<sup>332</sup>

It is a testament to the consumer confusion doctrine’s actual regard for the meaning non-owners place on a trademark that survey data has become widely recognized as the most probative evidence for establishing actual confusion or probable likelihood of confusion.<sup>333</sup> The case law \*996 suggests that once a reasonably dependable survey<sup>334</sup> shows confusion in the low double digits, courts will tend to rely on such evidence to find trademark infringement.<sup>335</sup> That a low percentage of confused non-owners would support a finding of infringement suggests considerable solicitude for non-owners’ interests in stable meanings.<sup>336</sup>

But the relationship of trademark law to non-owners’ interests may not be as straightforward as this suggests. Trademark reasoning adheres to its historic concern that consumers’ beliefs are to be protected as to the “source” of products, as when “Quaker State” oils came from Oil City, Pennsylvania and Carr’s Biscuits came from Carr’s Bakery in Carlyle, England. But we live in a time when Quaker State--and its sister company \*997 Pennzoil--have both abandoned Pennsylvania in favor of Texas and some of Carr’s biscuit products, still by appointment to Her Britannic Majesty, are now made in Germany.<sup>337</sup> For a wide range of consumer goods, most consumers have incomplete knowledge of the physical “source” of authentic goods. For “source” to be anything but hopelessly anachronistic, it must be an abstract notion of a corporate identity that imposes uniform quality standards on the product.<sup>338</sup>

Trademark owners do and do not assert their interests when there is a disruption of the meaning consumers attach to a trademark. Consumers may believe that “General Electric” or “G.E.” signals a product made in the United States when, in fact, General Electric serves the United States market with appliances made in Mexico and lights bulbs manufactured in eastern Europe. No Pennzoil products come from Pennsylvania any longer; very few consumer products bearing the Texas Instruments mark are made in the States, let alone the Lone Star State. Beyond the implied geographic origin of many marks, the size of modern corporations has \*998 weakened any sense that the product is produced by the same team or group or family. All that consumers are left with is a general sense of the quality of a good attached to a particular mark--its color, texture, taste, nutritional value, safety, reliability, durability, and so on.

This suggests a small paradox. First, the likelihood of confusion as defined by the jurisprudence is arguably increased the more the infringing goods are of the same quality as the trademark owner’s goods: If the consumer not only buys the counterfeit product once, but uses it and then repeatedly buys the counterfeit product, then the “confusion” from the trademark owner’s

perspective is arguably worsened. But that is a situation of trademark infringement in which the “meaning” of the trademark for the consumer is least in jeopardy of being shifted. If the consumer is getting the same taste, texture, color, and nutritional value in his unauthentic “Kraft” macaroni and cheese, how is the meaning of “Kraft” being shifted by the unauthentic product? Thus the “confusion” being measured--attached neither to the geographic origin nor the quality of the goods--can be much more important to the trademark owner than to anyone else.

Whatever its shortcomings, the trademark likelihood of confusion doctrine contrasts with copyright cases in which courts could have discussed the value non-owners derive from stable meaning in cultural objects, but remained silent. For example, in *Walt Disney Productions v. Mature Pictures Corp.*,<sup>339</sup> the court granted a preliminary injunction against the use of the Mickey Mouse March and Mouseketeer ears in a pornographic movie.<sup>340</sup> This would have been an ideal occasion to discuss specifically consumers’ (or society’s) interest in a stable, wholesome Mickey Mouse. Instead, finding that there was a danger of irreparable harm to the copyrighted rodent, the opinion noted obliquely that the film’s “use of the copyrighted material in the setting provided is such as to immediately compromise the work.”<sup>341</sup>

Yet copyright infringement actions, like trademark cases, often confront courts with the need to compare the similarity of cultural objects; in such cases, audience response can be an important indicium of infringement:

If there are substantial similarities in ideas, the Court must then compare similarity of expression based on the response of the ordinary reasonable person. . . . [T]he issue then becomes whether the “ordinary observer, unless he set out to detect the disparities, \*999 would be disposed to overlook them and regard their aesthetic appeal as the same.”<sup>342</sup> This formula may be overbroad. Depending on how we define it, “aesthetic appeal” and an inability to detect “disparities” easily are not the same. Two paintings from the same school might have the same aesthetic appeal to a viewer who immediately sees important disparities between the two. Nonetheless, this “audience test”<sup>343</sup> remains an important element of infringement analysis. For example, it is used as the “intrinsic test,” the second prong of the analysis process used in the Ninth Circuit.<sup>344</sup> After a defendant’s work has been found to have “articulable similarities” with the plaintiff’s work (the “extrinsic test”), courts inquire “whether the ordinary, reasonable audience would recognize the defendant’s work as a ‘dramatization’ or ‘picturization’ of the plaintiff’s work.”<sup>345</sup> Whereas analytic dissection of the work and expert testimony are used in the extrinsic analysis to catalog “articulable similarities,” the intrinsic test asks only whether “‘an ordinary, reasonable observer’ would find a substantial similarity of expression of the shared idea.”<sup>346</sup>

The role of the reasonable person in copyright infringement analysis quickly leads to questions

over which reasonable person. Courts have focused on the putative audience; as in trademark actions, this gives deference to non-owners. For example, both video games and television commercials have been held to be “unlike an artist’s painting or even other audiovisual works” in that they “appeal to an audience that is fairly indiscriminating insofar as their concern about more subtle differences in artistic expression.”<sup>347</sup> If the audience is less discriminating, then of course they will more frequently mistake similar works as the same work.

This deference to the confusion of the actual audience touched its limits in *Warner Bros. v. American Broadcasting Cos.*,<sup>348</sup> in which Warner Brothers, as holder of the rights to “Superman,” claimed that \*1000 ABC’s television program *The Greatest American Hero* infringed its copyrights and trademarks.<sup>349</sup> Ralph Hinkley, the eponymous lead in *The Greatest American Hero*, received a caped suit of extraterrestrial origin which endowed him with great strength, the ability to fly, “holographic vision,” and general invulnerability.<sup>350</sup> But Hinkley was a reticent hero who had comic difficulty learning to use these powers. As the court said, “Hinkley display[ s] some Superman-like abilities in a decidedly un-Superman-like way.”<sup>351</sup> The show implicitly contrasted Hinkley to Superman; in the pilot episode, a seven-year-old boy, steeped in Superman lore, sees Hinkley trying to get airborne and “patiently explains that Hinkley must take three steps and jump vigorously into the air.”<sup>352</sup> Some of the promotional spots announced that Hinkley “may be unable to leap tall buildings in a single bound” and that he “may be slower than a speeding bullet.”<sup>353</sup>

On the issue of copyright infringement,<sup>354</sup> the plaintiff sought to introduce evidence that young viewers “would not perceive the negatives” and would believe that these were the same phrases as part of the copyrighted Superman programs.<sup>355</sup> The Court of Appeals agreed with the trial court that “the possible misperception of some young viewers” would not undermine the conclusion that the “average lay observer” would see ABC’s program “as poking fun at, rather than copying a copyrighted work.”<sup>356</sup> In other words, the question of the non-owners’ impressions was still central to the analysis, but the court--whatever the demographics of the television show--preferred a more familiar, more general, adult non-owner.

Do trademark and copyright cases bring non-owner interests into the analysis as a means or as an end? Copyright prevents copying of expression; but a copy is the same thing as the original--and sameness is a problem that has vexed philosophers since ancient times. The most obvious--and, from the plaintiff’s perspective, relevant--response is to rely \*1001 heavily on evidence of general perceptions of sameness or similarity. In short, this is use of consumers as a means. While trademark cases concern themselves with whether non-owners are confused, non-owners cannot themselves bring claims that they have been confused. In the case of trademarks, this creates a conceptual problem: There is an obvious dissonance between saying that trademark is intended to protect the public from confusion, but the public is not allowed to sue when it is confused.<sup>357</sup> Perhaps the cohabitation of these two principles can be defended on a cost-benefit analysis: trademark owners will presumably act in situations of widespread consumer confusion--because that confusion will mean lost business--but permitting non-owners

to file such cases might spawn too many nuisance suits. If non-owners could make claims of consumer confusion, what principle would prohibit such claims from being turned against the trademark owners themselves? Courts have implicitly repudiated any idea that the trademark owner's duty to control quality translates into any consumer right concerning the substantive level of quality. As the court wrote in *El Greco Leather Products Co. v. Shoe World, Inc.*,<sup>358</sup> "the actual quality of the goods is irrelevant; it is the control of quality that a trademark holder is entitled to maintain."<sup>359</sup> In other words, Honda may dramatically downgrade the quality of an "Acura" without worrying that a customer could bring a claim to stop it.

Although trademark and copyright doctrines both address the meaning of cultural objects, they do so in different--arguably, fundamentally different-- ways. First, traditional trademark doctrine<sup>360</sup> addresses confusion about whether two marks are the same mark or identify the same source, in other words, that the two marks, whether or not physically distinct, have the same meaning as to the designated physical object or \*1002 activity--a soap bar, a laundering service, a jet engine, an airline. Trademark "consumer confusion" doctrine is aimed at protecting consumers from confusion about physical objects or services to which a trademark is attached.<sup>361</sup> The doctrine is not intended to keep a cultural object stable for the sake of having a stable cultural object. On the other hand, copyright infringement is arguably about the cultural object's meaning as a cultural object.

As discussed above, the notion of source in trademark law has become so abstract that there can be trademark infringement without any shift in--or damage to--the meaning of the trademark: if the infringing, counterfeit goods are of the same general quality as the authentic goods and the consumer really has no other meaning attached to the trademark than this general qualitative indicator, then the meaning of the trademark remains stable despite the infringer's activities.<sup>362</sup> The parallel in copyright is that some infringements involve a shift in meaning and some may not. As with trademarks, confusion may still occur when the two objects--original and infringing--can still be perceived as different. As the court in *Country Kids 'N City Slicks, Inc. v. Sheen* wrote,

Nor is the sine qua non of substantial similarity whether an ordinary observer would "confuse" the two works in their entirety. Rather . . . the test is whether the accused work is sufficiently similar that an ordinary observer would conclude that the defendant unlawfully appropriated the plaintiff's protectable expression by taking material of substance and value.<sup>363</sup> In such cases, there may be a shift in meaning. But the most obvious form of copyright infringement--absolutely faithful copying-- need not endanger an existing meaning. When the consumer perceives no difference between the Donald Duck image in a pirate cartoon or video she bought and one that would have been made and sold under Disney's authority, a discussion about "substantive similarity" seems moot.

**\*1003** The distinction between tests for sameness and tests for similarity can not bear too much weight. As described in the beginning of this discussion of listener's interests, the meaning of a cultural object can be changed by altering the original object, by creating a derivative object which largely supplants the original object in the market of objects and ideas, or by creating a derivative object whose independent influence affects the meaning of the original object. The meaning of a cultural object protected by trademark law typically becomes unstable if consumers suffer from receiving different quality physical goods or services to which they believe the same trademark is attached or which they believe comes from the same source because of similar trademarks. The shift in meaning occurs through a connection to physical goods or services and the connection is provided by either an identical mark or a mark that is different but very similar.

To show that the meaning of a copyrighted cultural object was becoming unstable--in other words, to show that an infringer was blurring a cultural image--evidence might be presented through either sameness or similarity. One could argue in an infringement action that people thought the infringing work might be the same cultural image because they perceived both great similarities and important differences or that people believed it was the same cultural image, but that the image's meaning was being changed. An unauthorized, unmistakable Mickey Mouse in unquestionably Kama-Sutraesque positions with an unmistakable Minnie Mouse would be both infringement and recoding. In the Warner Bros. case, if there had been evidence that many viewers believed that Hinkley actually was "Superman," but a new, bumbling version, that would have been a strong showing of lay perceptions of "recoding."

### **C. The Anti-Dilution Doctrine and Protection of the Trademark as a Cultural Object Itself**

The "consumer confusion" doctrine in trademark law will probably lose some of its importance with the rise of "anti-dilution" doctrine.<sup>364</sup> Anti-dilution statutes permit a trademark owner to stop the "tarnishing" or "blurring" of her trademark even when no consumer confusion is involved.<sup>365</sup> Massachusetts enacted the first such statute in 1947;<sup>366</sup> New York followed suit in 1961.<sup>367</sup> In one classic formulation, the concept of "dilution" is understood to be the "gradual whittling away . . . **\*1004** of the identity and hold upon the public mind of . . . [a] mark or name by its use upon non-competing goods."<sup>368</sup>

Anti-dilution doctrine took a quantum leap with the enactment of the Federal Trademark Dilution Act of 1995.<sup>369</sup> Although not pre-empting state laws, the federal statute protects "famous" marks by granting injunctive relief against "another person's use in commerce of [the] mark or trade name" where such use "causes dilution of the distinctive quality of the mark."<sup>370</sup> Respecting First Amendment concerns, the law expressly exempts non-commercial uses, "all forms of news reporting and news commentary" and fair uses in "comparative commercial advertising."<sup>371</sup>

The line between consumer confusion and dilution can be subtle. Courts engaged in dilution analysis can be seen using the tools of consumer confusion. And vice versa. For example, long before dilution was codified in federal law, some federal courts applied reasoning that went beyond the confines of consumer confusion. For example, in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*,<sup>372</sup> the court moved from a standard trademark analysis-- consumer beliefs about source of a product--to a more interesting thought about “corrupting” an idea:

Defendants assert that the Lanham Act requires confusion as to the origin of the film . . . . Appellants read the confusion requirement too narrowly. In order to be confused, a consumer need not believe that the owner of the mark actually produced the item and placed it on the market. The public’s belief that the mark’s owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement. In the instant case, the uniform depicted in “Debbie Does Dallas” unquestionably brings to mind the Dallas Cowboys Cheerleaders. Indeed, it is hard to believe that anyone who had seen defendants’ sexually depraved film could ever thereafter disassociate it from plaintiff’s cheerleaders.<sup>373</sup> The next step is to conclude that a person who had seen the film would be unable to “disassociate” the idea of the Dallas Cowboys Cheerleaders from the film even without thinking that the Dallas Cowboys Cheerleaders \*1005 “sponsored or otherwise approved” the film’s use of the costume. This is very close to a dilution analysis, focusing on a recoding of the cultural object for the citizen.

In anti-dilution analysis, consumer confusion is not at issue; pure recoding is: “[I]njury to a recognized [trademark], rather than damage arising from confusion among consumers, lies at the heart of the wrong.”<sup>374</sup> A classic example of application of anti-dilution thinking is *Deere & Co. v. MTD Products, Inc.*,<sup>375</sup> in which a John Deere competitor ran afoul of the New York anti-dilution statute with ads which mischievously animated Deere’s logo. The ads showed the animated deer logo as smaller than--and running away from-- both a family dog and an MTD mower.<sup>376</sup> The court concluded that the ads raised the “possibility that consumers will come to attribute unfavorable characteristics to [the] mark and ultimately associate the mark with inferior goods and services.”<sup>377</sup>

The New York anti-dilution statute was applied in this case to prevent one non-owner (a competitor) from recoding Deere’s trademark without any showing that consumers were being confused. Similarly, in *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*,<sup>378</sup> the court found that the plaintiff had shown a likelihood of success of prevailing under Georgia’s anti-dilution statute because Topps’s “Garbage Pail Kids” chewing gum was an intentional “joke” on Cabbage Patch Kids and tended to “create[ ] an undesirable, unwholesome, or unsavory mental association with the plaintiff’s mark.”<sup>379</sup>

At the heart of an anti-dilution claim is the argument that the owner of a famous cultural object (the trademark)<sup>380</sup> has the right to keep the \*1006 meaning of that cultural object stable against a broader range of possible instability. Customer confusion as to the source of physical goods is no longer at issue; maintenance of the symbol's meaning qua symbol is at issue. In this sense, anti-dilution protection for a trademark can be likened to a corporate right of publicity.<sup>381</sup> The shift away from confusion about the goods or the source of goods makes anti-dilution claims closer to copyright infringement actions in which the plaintiff contends that the infringement adversely affects the meaning of her copyrighted work. The anti-dilution claim recognizes the trademark as an end in itself--a cultural object--that is contaminated or corrupted by the defendant's recoding.<sup>382</sup>

In a sense, this shift towards treating product identifiers as property is overdue. For the non-owner, the trademark is more than just a communication device about the quality of goods: the trademark is a good itself. For a lot of people, what matters is not the cut of the clothes, but the polo player or the alligator sewn on the breast.<sup>383</sup> For these people--all of us to some degree--the trademark is a social good that we purchase. Trademarks are an instrument of social self-definition, used by consumers to fit into a group, and often at the same time to draw attention to themselves as special and worthy. The trademark works "to express our sense of individuality and identity" while meeting our "yearning to belong, to be able to define [one]self as one of a group."<sup>384</sup> If consumer choices reflect social utility gained from this kind of identification, then we might be happy when a Pierre Cardin decides to saturate lower price ranges of the market--selling any and everything bearing his trademark.<sup>385</sup> Until the trademark loses its cachet, these activities will bring happiness--lots of designer utility--to people who might not otherwise be able to afford it.

This returns us to the difficult problem of measuring who benefits how much from what level of stability in the meaning of cultural objects. When \*1007 a Pierre Cardin decides to apply its mark to inferior products--and thereby knowingly to recode the mark's meaning--it may distress consumers who invested in old, expensive products and bring gleeful satisfaction to consumers now getting the mark on the cheap. Who gains how much from such changes? The difficulty of calculating social utility would inhibit protection of non-owner interests even if the clearer interests of trademark owners were not already on the table; those trademark owner interests may be best understood in a First Amendment context.

#### **D. Deeper Problems with "Listeners' Interests"**

The First Amendment argument against "listeners' rights" has two components: the first is the First Amendment interest of intellectual property owners; the second component is the First Amendment interest of the non-owners who want to "express" themselves by actions and objects which alter the meaning of the existing cultural object. The First Amendment interests of



owner-creators in expressing themselves through their creations is straightforward: freedom of expression is meaningful only when there is some mechanism to ensure that the speaker's expression remains his own expression.<sup>386</sup> Copyrights--as well as trademarks and rights of publicity--serve this purpose by allowing the author to patrol against words being put in her mouth.<sup>387</sup> The interest of non-owners against "listeners' rights" is both the deconstructionist argument to recognize more recoding freedom and the status quo, which permits considerable recoding. Even if one does not believe in the need for more recoding freedom, listeners' rights to hold a cultural object stable would disrupt the existing balance between property rights (which tend to hold a cultural object stable) and doctrines that limit control by owners in favor of new expressions (the idea-expression dichotomy, the fair use doctrines, the news reporting exceptions, and so on).

But aside from these "brute" personality arguments that move directly through the First Amendment, the personality justification provides other lines of reasoning that would undermine reliance interests for listeners.<sup>388</sup> Singer developed a proposal for a reliance interest in property using the example of plant closings. Singer argued that workers in a plant should **\*1008** have certain protections from plant closings,<sup>389</sup> including a mandatory right of first refusal to purchase a plant (instead of permitting a company to tear it down in favor of more efficient production elsewhere). Singer reasoned, "If the workers have a first right of refusal to purchase the plant--a legal power to compel a sale of the plant to them for its fair market value--the company may be harmed very little by this legal obligation; it can take the money and reinvest it elsewhere."<sup>390</sup>

However, that same reasoning may not hold true with intellectual property, particularly with "personas." Charlie Chaplin or Mary Pickford cannot hand over their images to faithful fans who want to ossify them into stereotypical roles.<sup>391</sup> To the degree that an artist has invested his or her own personality in the work, perhaps it cannot be sold for a market price that leaves the artist "harmed very little"; the very idea of personality interests is that they create value in property beyond what the market would charge for that particular commodity. The balance is no longer economic versus personality interests; it is personality interests versus personality interests.<sup>392</sup>

With competing personality interests, it is easy to return to an earlier point: that probably the most reasonable course of action on a cost-benefit analysis is for the disgruntled non-owners to shield themselves from the new meaning being imputed to the cultural object. People who do not like the idea of a *Gone with the Wind* sequel should not rent the *Scarlett* video. Hollywood may ruin a good number of books in rendering them into two-dimensional, big-screen stories, but no one is forced to the cinema any more than they are forced to the library. But this conclusion applies less the more the recoding "replaces" the meaning of the original. That is the difference between the relationship of the film *Scarlett* to the film *Gone with the Wind* **\*1009** and the relationship between the book *Gone with the Wind* and the film *Gone with the Wind*, in which the latter now overpowers all popular images of the story.

Those non-owners who are disturbed because a recoding exists at all--even if they do not consume it--raise normative questions about their interests. One may regret a sequel or a book-to-film conversion because of the lost opportunity (“Now, they will never make a good version of X”) or because it will prevent other people from appreciating the original (“I’m just sorry all those people will never know how good the X book was”), but when non-owners take too much interest in the stability of a cultural image we may have doubts about the healthiness of their interest.

To use Professor Radin’s term, perhaps it is not human flourishing when a young executive daydreams of buying a Louis Vuitton handbag and wearing it down the street, when a fan group staunchly opposes a remake of *Gone with the Wind*, or when people dress up in twenty-fourth-century uniforms and attend Star Trek conventions. On the other hand, perhaps it is. This is a difficult question<sup>393</sup> because the handbag march, the ability to recite vast tracts of a movie script, and the clinging to a futuristic utopian adventure all seem to be forms, albeit limited forms, of self-expression. Society can recognize these as forms of self-expression without going out of its way to protect these forms of self-expression. There is a helpful correlation here: the more unusual the non-owner’s interests, the less those interests seem subject to familiar measures and indicia. Singer argues that with reliance interests, “[v]arious factors enter into the determination of the level of protection. First, the stronger and more established the relationship, the more it should be protected.”<sup>394</sup> It might be easy to measure how established a relationship is when we are speaking of employees of an industrial plant or the foundation of an old building that depends on not-too-much digging on the adjacent lot. But in the case of a person who “lives for *Gone with the Wind*,” who gets into heated arguments over Tin-Tin cartoons, or who says they will “die” if George Lucas releases any more Star Wars pre-quals, what exactly are we measuring and how?

## V. Conclusion

Those who write about property theory write--expressly or implicitly-- with an eye to how property laws can be changed to enhance society. For a good century, socialists and communists critiqued individual property in the name of a propertyless world--to be achieved, ironically, \*1010 through a regime of statist property. In the 1970s and 1980s property theory fell under the sway of the law and economics movement, devoted to the assumption that each legal status or transaction should be structured in the best economic interests of the parties. This “technological image of human behavior”<sup>395</sup> was met on the dialectic field by the loose confederation of critical legal studies scholars. But this limited humanist defense of property--like Radin’s personality theory--then generated a humanist critique, the deconstructionist view discussed in this Article.

The points made in this discussion are fairly straightforward. First, that the argument for more recoding freedom probably overstates the negative impact of existing intellectual property laws on the self-expression of non-owners. Second, that the argument for more recoding freedom

definitely understates the positive utility non-owners derive from stability in the meaning of propertized intellectual property--both those who recode and those who are passive listeners, who just “consume” the images and sounds of modern life. This discussion has explored how that stability is valuable to non-owners and how that stability depends on intellectual property laws. There is empirical work that could be done to try to measure those interests, but for the moment we should at least acknowledge that there are theoretical arguments--parallel to the deconstructionists’ approach in advocating recoding freedom--that support intellectual property laws.

Finally, this Article considers the improbable idea of “listeners’ rights,” noting both that the law gives only limited recognition to listeners’ interests and that there are profound reasons why we would not want laws to restrict the substantial recoding freedom of non-owners and the limitless recoding freedom of owners. Yet even here we cannot say for sure that a system of “locking in” the original meaning of cultural objects would lead to a slowing or qualitative worsening of culture. Suppressing Hollywood’s penchant for sequels might be a good thing.

Arguments about cutting back or reshaping intellectual property laws are usually at the margins--marginal, often unspecified changes in the law prescribed in law review articles that are themselves marginal to real policy debates about the future of intellectual property. But such “recodings” of the intellectual property system should be advocated and their assumptions tested-- when possible, in more than our thought experiments. When that is not possible, then alternative scenarios and divergent interests--like those of non-owners in intellectual property--should be developed as fully as possible in our scholarly discussions. That is the best hope for moving new ideas from the margin to the mainstream.

### Footnotes

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<sup>1</sup> U.S. Const. art. I, § 8, cl. 1. See, e.g., Yale Braunstein et al., *Economics of Property Rights As Applied to Computer Software and Databases* i (U.S. Department of Commerce, 1977) (“[I]f one wishes to encourage the private provision and use of scientific and artistic

works, the net value of output and goods services to the public ...can be increased by the broadest possible specification of property rights by means of copyright.”); Stanley M. Besen & Leo J. Raskind, *An Introduction to the Law and Economics of Intellectual Property*, 5 *J. Econ. Persp.* 3, 27 (1991) (encouraging economists to research intellectual property issues, which could play a key role in affecting America’s future competitiveness); William R. Johnson, *The Economics of Copying*, 93 *J. Pol. Econ.* 158, 172 (1985) (concluding that restrictions on copying may enhance social surplus under certain circumstances); William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 *J. Legal Stud.* 325, 326 (1989) (explaining that copyright law is in part designed to provide incentives to create a work subject to the law’s protection).

<sup>2</sup> See, e.g., Steven Chermansky, *Agreements, Property, and Personhood*, 81 *Cal. L. Rev.* 595, 646, 646-53 (1993) (suggesting that an inventor’s work is a “product of original thought,” and therefore inventors have a “personality stake in their inventions”); Edward J. Damich, *The Right of Personality: A Common Law Basis for the Protection of Moral Rights*, 23 *Ga. L. Rev.* 1, 4 (1988) (stressing that even though American courts have provided for some protection of personality rights through copyright, privacy, defamation, unfair competition, and contract laws, such protection lacks the substantial and coherent basis it has under French law); Justin Hughes, *The Personality Interest of Artists and Inventors*, 16 *Cardozo Arts & Ent. L.J.* 81 (1998) [hereinafter Hughes, *Personality*]; Justin Hughes, *The Philosophy of Intellectual Property*, 77 *Geo. L.J.* 287, 335 (1988) [hereinafter Hughes, *Philosophy*]; Margaret Jane Radin, *Property and Personhood*, 34 *Stan. L. Rev.* 957, 968 (1982) (suggesting that, because “property may have an important relationship to certain character traits that partly constitute a person,” the expectation of continuing control over such property should be protected); Vibeke Sorensen, *Thoughts of a Computer Artist*, 75 *Or. L. Rev.* 309, 315 (1996) (arguing that displaying artwork on the Internet involves “putting it in the electronic town square for everyone to view for free,” but reporting that she still provides a copyright notice to protect as much of her work as possible); Madhavi Sunder, *Note, Authorship and Autonomy as Rites of Exclusion: The Intellectual Propertization of Free Speech in Hurley v. Irish-American Gay, Lesbian, and Bisexual Group of Boston*, 49 *Stan. L. Rev.* 143, 157 (1996) (recognizing that “[a]lthough intellectual property rights are traditionally based on economic justifications, ... concern about identity and personhood are also implicated in the creation of intellectual property rights”). For a recent, insightful analysis of personality interests in the right of publicity, see Jeffrey Malkan, *Stolen Photographs: Personality, Publicity, and Privacy*, 75 *Texas L. Rev.* 779 (1997).

<sup>3</sup> See generally Damich, *supra* note 2, at 6 (supporting a common-law basis for the protection of a creator’s moral--or personal--rights, which are “rights deriving from the

work as an expression of the author’s personality”).

<sup>4</sup> For example, § 3344(a) of the California Civil Code treats injury to a celebrity’s peace of mind as equal to pecuniary injuries for purposes of triggering liability for appropriation of a celebrity’s name or likeness. Cal. Civ. Code § 3344(a) (West 1997); see also *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1103 (9th Cir. 1992) (affirming a multimillion dollar award to Tom Waits for use of a sound-alike in a Frito-Lay snack food advertisement); *Lugosi v. Universal Pictures*, 603 P.2d 425, 444 (Cal. 1979) (Bird, C.J., dissenting) (arguing for granting Lugosi a publicity right in his likeness in the Dracula role). See generally Sam Elliot, Note, Something’s Weird in the State of California: How the Right of Publicity Wronged Bettie Page, 72 Notre Dame L. Rev. 593, 596 (1997) (discussing the application of Cal. Civ. Code § 3344(a) to the commercial appropriation of celebrities’ likenesses). But see *infra* note 112 and accompanying text (discussing allowed uses of likenesses and other personal attributes under § 3344).

<sup>5</sup> Malkan, *supra* note 2, at 804.

<sup>6</sup> These scholars may not have congregated around any one moniker; “deconstructionist” is a term I have chosen to identify the general nature of the critique.

<sup>7</sup> Among the most interesting are Keith Aoki, (Intellectual) Property and Sovereignty: Notes Toward a Cultural Geography of Authorship, 48 Stan. L. Rev. 1293 (1996) [hereinafter Aoki, Sovereignty]; Keith Aoki, Adrift in the Intertext: Authorship and Audience “Recoding Rights,” 68 Chi-Kent L. Rev. 805 (1993) [hereinafter Aoki, Adrift]; James Boyle, A Theory of Law and Information: Copyright, Spleens, Blackmail, and Insider Trading, 80 Cal. L. Rev. 1413 (1992); Margaret Chon, New Wine Bursting from Old Bottles: Collaborative Internet Art, Joint Works, and Entrepreneurship, 75 Or. L. Rev. 257 (1996); Rosemary J. Coombe, Objects of Property and Subjects to Politics: Intellectual Property Laws and Democratic Dialogue, 69 Texas L. Rev. 1853 (1991); Peter Jaszi, On the Author Effect: Contemporary Copyright and Collective Creativity, 10 Cardozo Arts & Ent. L.J. 293 (1992) [hereinafter Jaszi, Author Effect]; Peter Jaszi, Toward a Theory of Copyright: The Metamorphoses of Authorship, 41 Duke L.J. 455 (1991) [hereinafter Jaszi, Theory of Copyright]; Jessica Litman, The Public Domain, 39 Emory L.J. 965 (1990); Andrea A. Lunsford & Lisa Ede, Collaborative Authorship and the Teaching of Writing, 10 Cardozo Arts & Ent. L.J. 681 (1992); Michael Madow, Private Ownership of the Public Image: Popular Culture and Publicity Rights, 81 Cal. L. Rev. 125 (1993); Martha Woodmansee, On the Author Effect: Recovering Collectivity, 10 Cardozo Arts & Ent. L.J. 279 (1992); and Sunder, *supra* note 2. For an early argument advocating an “expanded

First Amendment defense” for visual art works that incorporate others’ copyrighted images, see Patricia A. Krieg, Note, Copyright, Free Speech, and the Visual Arts, 93 Yale L.J. 1565, 1565 (1984).

<sup>8</sup> See Sunder, *supra* note 2, at 158 (arguing that “current identity politics increasingly makes property law its legal battleground--whether explicitly through intellectual property laws, or implicitly through a property tinged approach to developing First Amendment jurisprudence”).

<sup>9</sup> See, e.g., Sharon Bernstein, *City Grapples with Dilemma of Garage Units*, L.A. Times, Apr. 21, 1997, at A1 (calling the political interests and “power players” in a zoning dispute “stakeholders”); Yvonne Samuel, *Politicians, Religious Groups Help Families Leave Welfare*, St. Louis Post-Dispatch, Aug. 22, 1997, at 5C (referring to parents, elected officials, and organization leaders as “stakeholders” in the welfare system). The Small Business Administration’s website refers to people interested in the SBA’s programs as “stakeholders.” Aida Alvarez, *Message from the Administrator*, (last modified Nov. 19, 1998) < [http:// www.sbaonline.sba.gov/strategic/strat1.html](http://www.sbaonline.sba.gov/strategic/strat1.html)>.

<sup>10</sup> Dictionary of Quotations 771 (Bergan Evans ed., 1968) (quoting Michel de Montaigne, *Essais*, III, at xiii).

<sup>11</sup> This phrasing comes from Speech Act theory. See, e.g., J.L. Austin, *How to Do Things with Words* 8 (1975) (describing how “it is very commonly necessary that [the listener] should also perform certain other actions, whether ‘physical’ or ‘mental’ actions or even acts of uttering further words” (emphasis in original)); John R. Searle, *Speech Acts: An Essay in the Philosophy of Language* (1978); Justin Hughes, *Group Speech Acts*, 7 *Linguistics & Phil.* 379, 379 (1984) (defining group speech as utterances by more than one person or a group of persons speaking as a whole). Speech Act theory assumes that speaking a language is engaging in a rule-governed form of behavior and, more precisely, that speaking a language is performing speech acts, such as making statements, giving commands, asking questions, making promises and so on; and, more abstractly, acts such as referring and predicating; and secondly, that these acts are in general made possible by and are performed in accordance with certain rules for the use of linguistic elements. Searle, *supra*, at 16. Speech Act theory is built on the premises that the “basic or minimal units of linguistic communication” are the “production” or “issuance” of sentences under certain conditions so that there is, in the circumstances, a reference or a predication. *Id.* This distinguishes Speech Act theory from prior theories of language which have treated

the symbol, word, or sentence as the basic unit of language. See *id.*





<sup>12</sup> For example, in discussing moral rights, Keith Aoki observes that “the other side of such expanded legal protection is that one only benefits from such heightened protections if one is legally categorized as an author or an artist.” Aoki, *Adrift*, *supra* note 7, at 820.

<sup>13</sup> Non-owners can also be harmed by another’s misuse or abuse of their property. See Paul Schiff Berman, *An Anthropological Approach to Modern Forfeiture Law: The Symbolic Function of Legal Actions Against Objects*, 11 *Yale J.L. & Human.* (forthcoming 1999) (manuscript at 73) (describing the community acquittal of an arsonist who torched a “crack house” in an impoverished neighborhood of West Palm Beach). Berman writes:  
[The arsonist] took action against a symbol of society’s disorder instead of moving against the so-called perpetrators of neighborhood crime. He perceived that the prostitutes, drug dealers, and addicts who frequented the crack house were themselves victims of a larger societal problem and so destroyed the symbol of society’s crime rather than attacking the individuals.  
*Id.* (manuscript at 78) (emphasis in original).

<sup>14</sup> Throughout this discussion, I will use some shorthand terminology and some different terms with synonymous meaning. I will use “work” and “cultural object” interchangeably; images, written texts, personas, paintings, music, and audiovisual works all count as examples. A “stable” or “fixed” cultural object will be a shorthand way to say a cultural object with a widely, publicly understood meaning that remains comparatively stable over time. (The usage of the term “fixed”--when the meaning is fixed--is not to be confused with the meaning of “fixed” in copyright law. See 17 U.S.C. § 101 (1994) (referring to the moment a work is “‘fixed’ in a tangible medium of expression”).) I will use “owner” and “creator” interchangeably, although it is clear that often the owner of intellectual property is not the creator. In circumstances where the disconnection between creation and ownership would produce a substantial problem in the analysis, it is noted.

<sup>15</sup> Joseph William Singer, *The Reliance Interest in Property*, 40 *Stan. L. Rev.* 611, 611 (1988).

<sup>16</sup> These could also be called “secondary creators” following at least one commentator’s use of “secondary creativity” to describe “fan fiction.” Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction, and a New Common Law*, 17 *Loy. L.A. Ent. L.J.* 651, 652 (1997).

- <sup>17</sup> If the intellectual property owner is the creator of the expression, then it would be a prior restraint on the creator saying what they want to say with their own expression. But even when property rights to the expression have been transferred, this would run afoul of the principles embodied in  *Buckley v. Valeo*, 424 U.S. 1, 51-58 (1976) (holding unconstitutional on First Amendment grounds a restriction on a candidate’s personal and general campaign expenditures).
- <sup>18</sup> See Marci A. Hamilton, *Copyright, Capitalism, and the Constitution* 46 (1998) (unpublished manuscript, on file with the Texas Law Review) (describing the copyright system’s commitment to the commodification of intellectual works).
- <sup>19</sup> Pat Boone, *In a Metal Mood: No More Mr. Nice Guy* (Uni/Hip-O Records 1997); see also Pat Boone in *Hell*, *Economist*, Mar. 1, 1997, at 35 (“Mr. Boone’s own explanation has been somewhat lost in the din of debate. It was meant to be a joke.”).
- <sup>20</sup> See  *Estate of Hemingway v. Random House, Inc.*, 244 N.E.2d 250, 255 (N.Y. 1968) (finding that statements made by Ernest Hemingway to a biographer did not implicate Hemingway’s right to privacy because they were intended to be given to the biographer for the purposes of publication). Hemingway was quoted approvingly in  *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 559 (1985), which held that the defendant magazine publisher’s use of copyrighted excerpts from President Ford’s memoirs violated the copyright holder’s power to control the first publication of the material. See also Hughes, *Philosophy*, *supra* note 2, at 355-58 (discussing the notion that privacy rights can be used by public figures to hold back their privately held works or beliefs from dissemination).
- <sup>21</sup>  *Saturday Evening Post Co. v. Rumbleseat Press, Inc.*, 816 F.2d 1191, 1199 (7th Cir. 1987) (discussing the Post’s decision to cancel an agreement to produce porcelain dolls based on Norman Rockwell characters). The Seventh Circuit’s comment was an echo of two centuries of thought about American intellectual property law. To justify the Intellectual Property Clause, U.S. Const. art. I, § 8, James Madison argued, “The public good fully coincides in both cases with the claims of individuals.” *The Federalist* No. 43, at 272 (James Madison) (Clinton Rossiter ed., 1961). But Thomas Macaulay raised an early objection to copyrights in a 1841 speech to the British Parliament: “Copyright is monopoly, and produces all the effects which the general voice of mankind attributes to monopoly.” ’ Arnold Plant, *The Economic Aspect of Copyright in Books*, 1 *Economica* 167, 170-71 (1934) (quoting Thomas Babington Macaulay, *Speech Before House of Commons Regarding Sergeant Alfound’s Copyright Bill* (Feb. 5, 1841)).



<sup>22</sup> Although not of this school of scholarship, Mark Lemley makes the same point: “It is not enough to say that intellectual property law favors ‘creators’--for here we have creators on both sides of the equation, and the law must choose between them.” Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 *Texas L. Rev.* 989, 998 (1997).

<sup>23</sup> Aoki, *Adrift*, *supra* note 7, at 836.

<sup>24</sup> See Madow, *supra* note 7, at 125; Coombe, *supra* note 7, at 1853.

<sup>25</sup> Madow, *supra* note 7, at 134 (emphasis in original).

<sup>26</sup> *Id.*

<sup>27</sup> Coombe, *supra* note 7, at 1855. Coombe continues her critique noting that: [t]he political implications of cultural commodification (and the legal regimes supporting it) are largely unexplored. When the ramifications for the political ideal of democratic dialogic practice are addressed, it is generally in terms of the material limitations of access to dialogue caused by concentrations of capital and mass media monopolies. *Id.* at 1866 (emphasis in original). She sees the problem as residing at the broadest level: What I’m suggesting here is that intellectual property laws may deprive us of the optimal cultural conditions for dialogic practice. By objectifying and reifying cultural forms--freezing the connotations of signs and symbols and fencing off fields of cultural meaning with “no trespassing” signs-- intellectual property laws may enable certain forms of political practice and constrain others. *Id.* (emphasis in original). More recently, Coombe has suggested that Native Americans should be given a “cultural property right” in Native American stories. See Rosemary J. Coombe, *The Properties of Culture and the Politics of Possessing Identity: Native Claims on the Cultural Appropriation Controversy*, 6 *Can. J.L. & Juris.* 249, 283-85 (1993). But then what happens to Latinos and lesbians who want to use Native American stories to express their subordination?

<sup>28</sup> Tushnet, however, presents a more individual-focused perspective in her article on people who write “fan fiction” on the Internet. See generally Tushnet, *supra* note 16, at 657

(describing the manner in which fan fiction authors feel that they are making significant life changes when they share their creative works in the community).

<sup>29</sup> Madow, *supra* note 7, at 145-46.

<sup>30</sup> Aoki, *Adrift*, *supra* note 7, at 836.

<sup>31</sup> Rosemary J. Coombe, *The Cultural Life of Intellectual Properties: Authorship, Appropriation and the Law* 23 (1998).

<sup>32</sup> Sunder, *supra* note 2, at 171.


<sup>33</sup> *Id.* at 168.

<sup>34</sup> Aoki, *Sovereignty*, *supra* note 7, at 1310. Aoki argues that “increasingly intellectual properties underwrite the ‘private’ sovereignties of multinational companies.” *Id.* at 1305; see also Jessica Litman, *The Exclusive Right to Read*, 13 *Cardozo Arts & Ent. L.J.* 29, 53 (1994) (“The only way that copyright laws get passed in this country is for all the lawyers who represent the current stakeholders to get together .... [T]his process has produced laws that are unworkable from the vantage point of people who were not among the negotiating parties ....”).






<sup>35</sup> Tushnet, *supra* note 16, at 685.


<sup>36</sup> Aoki, *Sovereignty*, *supra* note 7, at 1347 (quoting Herbert I. Schiller, *The Global Information Highway: Project for an Ungovernable World*, in *Resisting the Virtual Life: The Culture and Politics of Information* 17, 22 (James Brock & Iain A. Boal eds., 1995)).



<sup>37</sup> See, e.g., Margaret Jane Radin, *Reinterpreting Property* 12 (1993) (questioning the ideology of individual ownership of property when applied broadly to a society in which “the largest proportion of holdings are owned by institutions or entities other than persons”).




- <sup>38</sup> For a thoughtful survey of how large corporations shifted U.S. trade policy to focus on intellectual property, see generally Michael P. Ryan, *Knowledge Diplomacy: Global Competition and the Politics of Intellectual Property* 67-89 (1997).
- <sup>39</sup> See, e.g., Aoki, *Adrift*, *supra* note 7, at 829-30 (noting the strong interest that copyright-based industries have in retaining the exclusivity provided by current intellectual property laws); Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutionary Impulse*, 78 *Va. L. Rev.* 149, 151-54 (1992) (describing how since the 1970s “the judicial tide [has] begun to turn in a clearly propertarian direction”); Marci A. Hamilton, *Appropriation Art and the Imminent Decline in Authorial Control over Copyrighted Works*, 42 *J. Copyright Soc’y USA* 102, 105-07 (1994) (discussing the work-made-for-hire doctrine and its advantages to copyright-based industries); Richard A. Epstein, *Congress’s Copyright Giveaway*, *Wall St. J.*, Dec. 21, 1998, at A19 (describing the recent extension of copyright terms as “a huge uncompensated wealth transfer from ordinary citizens to Disney, Time Warner and other holders, corporate and individual, of preexisting copyrighted material”).
- <sup>40</sup> See, e.g.,  *Forward v. Thorogood*, 985 F.2d 604, 606 (1st Cir. 1993) (holding that Thorogood’s music recordings were not works for hire because the financial backer came into the project long after the songs were written).
- <sup>41</sup> I am appreciative for long conversations with independent filmmakers like Joe Convery (writer/director, *Skippy* (Planet Earth Productions 1997)), Aaron Reid (writer/producer, *The Next Step* (Wavelength Productions 1993)), and Dino D’Annabele (boxing films) who completely self-finance their own projects and, if they are lucky, then get distributed, often through a patchwork of right grants. For example, with the independent film *The Next Step*, Phaedra Cinema bought the North American distribution rights, released the film theatrically in ten markets, and sold the cable television rights to the Sundance Channel; Vanguard Video domestically released the film on video; and Curb Entertainment purchased the right to distribute the film outside North America. See *Interview with Aron Reed* (Nov. 27, 1998). In the case of *Skippy*, which has not been distributed at the time of writing, the producers were looking into a variety of distribution channels. See *Interview with Joe Convery* (Dec. 7, 1998). It is difficult to imagine how people like these filmmakers would have any chance at all without intellectual property rights to sell to distribution entities.
- <sup>42</sup> See Eugene Volokh, *Cheap Speech and What It Will Do*, 104 *Yale L.J.* 1805, 1806-07 (1995).



- <sup>43</sup> See, e.g., Byron F. Marchant, *On-Line on the Internet: First Amendment and Intellectual Property Uncertainties in the On-Line World*, 39 *How. L.J.* 477, 489 (1996) (noting that “the ease of transmitting electronically on the Internet has increased the need for vigilance to protect intellectual property rights in an electronic global village”); Henry H. Perritt, Jr., *Property and Innovation in the Global Information Infrastructure*, 1996 *U. Chi. Legal F.* 261, 313 (noting that “[a] healthy information infrastructure undoubtedly requires adequate legal protection for the intellectual property of content creators”).
- <sup>44</sup> The movie studios may take this problem more seriously in the wake of Art Buchwald’s suit against Paramount over his movie treatment “King for a Day” and the Eddie Murphy film *Coming to America* (Paramount 1988). See *Buchwald v. Paramount Pictures Corp.*, 13 *U.S.P.Q.2d* (BNA) 1497 (Cal. Super. Ct. 1990). Other individuals have been less successful in pressing these claims against studios. See, e.g., *Walker v. Time Life Films, Inc.*, 784 *F.2d* 44, 50 (2d Cir. 1986) (finding that the creators of the film *Fort Apache: The Bronx* did not infringe on the copyright of the book *Fort Apache* because the two works were not substantially similar); *Chase-Riboud v. Dreamworks, Inc.*, 987 *F. Supp.* 1222, 1232-33 (C.D. Cal. 1997) (denying a preliminary injunction based on a claim against the producers of the film *Amistad* (Dreamworks SKG 1997), though noting that the author supported her claim by pointing out significant similarities between her novel and the film); *Weygand v. CBS, Inc.*, 43 *U.S.P.Q.2d* (BNA) 1120, 1128 (C.D. Cal. 1997) (finding that a studio’s film scripts of a white child’s adoption by a poor black farmer in the Depression South did not infringe a script that had previously been submitted to CBS). Recently, screenwriters Jeffrey Howard, Chris Beutler, and Jay Schlossberg-Cohen filed a lawsuit against the makers of the James Bond movie *Tomorrow Never Dies* (United Artists 1997). See *Déjà Vu*, *L.A. Times*, Dec. 24, 1997, at F2.
- <sup>45</sup> *The Happy Hooker* (Cannon 1975); see *Walt Disney Prods. v. Mature Pictures Corp.*, 389 *F. Supp.* 1397, 1398 (S.D.N.Y. 1975) (finding that the use of the Mickey Mouse March as background music for a scene in which a hooker gratifies three young male actors did not constitute fair use of the copyrighted song as a parody).
- <sup>46</sup> See *MCA, Inc. v. Wilson*, 425 *F. Supp.* 443, 445 (S.D.N.Y. 1976) (concerning a musical, *Let My People Come--A Sexual Musical*, which included the song *Cunnilingus Champion of Co. C* using the music of the song *The Boogie-Woogie Bugle Boy*), modified and aff’d, 677 *F.2d* 180 (2d Cir. 1981).

- 47 See, e.g.,  *Playboy Enters., Inc. v. Frena*, 839 F. Supp. 1552, 1554 (M.D. Fla. 1993) (detailing suit against an operator of a subscription computer bulletin board service for copyright and trademark infringement);  *Sega Enters. Ltd. v. MAPHIA*, 857 F. Supp. 679, 682 (N.D. Cal. 1994) (seeking a preliminary injunction enjoining defendant's use of the SEGA trademark).
- 48 See Samuel Freedman, "Endgame" Opens in Wake of Pact, *N.Y. Times*, Dec. 13, 1984, at C14 (discussing a settlement that Beckett and the American Repertory Theater reached over a production that was set in subway ruins); Justin Hughes, *Between Art and Law*, *Harv. Crimson*, Jan. 21, 1985, at 3 (discussing Beckett's agents' efforts to stop a production set in subway ruins).
- 49 See *Lindon c. La Compagnie Brut de Buton*, 155 *Revue Int'l du Droit D'Auteur* 225 (T.G.I. Paris, 3e ch., Oct. 15, 1992) (granting Beckett an injunction against an all-female production of *Waiting for Godot*); *Stick to the Script*, *N.Y. Times*, Aug. 5, 1984, at D7 (describing Albee's threat to stop a Texas theater company's all-male version of *Who's Afraid of Virginia Woolf*); Emily Yellin, *Male Actor Seeks a Female Role, But the Playwright Says No*, *N.Y. Times*, Sept. 22, 1996, at 30 (discussing Harling's refusal to permit a male "Truvy" in a Memphis production of *Steel Magnolias* and Williams's estate's ban on cross-gender casting).
- 50 See William H. Honan, *Artists, Newly Militant, Fight for Their Rights*, *N.Y. Times*, Mar. 3, 1988, at C29. This struggle comes after decades of individual film directors, stars, and producers using various devices, including the Lanham Act, to stop studios and distribution systems from recoding their works through editing. See  *Gilliam v. American Broad. Cos.*, 538 F.2d 14, 17 (2d Cir. 1976) (granting a preliminary injunction preventing the broadcast of edited Monty Python programs); *Autry v. Republic Prods., Inc.*, 213 F.2d 667, 669 (9th Cir. 1954) (finding that severe editing can "emasculate" the "dynamic and dramatic" quality of an artist's work); *Carroll v. Paramount Pictures*, 3 F.R.D. 95, 96 (S.D.N.Y. 1942) (holding that a producer's claim of libel from a major studio's production of inferior work was sufficiently pleaded to survive a Rule 12 motion for dismissal); *Stevens v. National Broad. Co.*, 148 U.S.P.Q. (BNA) 755, 758 (Cal. Super. Ct. 1966) (enjoining the broadcast of an edited version of *A Place in the Sun*).
- 51 See  *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1096 (9th Cir. 1992) (affirming a multimillion dollar award to Waits because Frito-Lay used a sound-alike in ads);  *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (establishing liability for appropriating a celebrity's voice by using a sound-alike in a commercial). A slightly

different case of recoding is  *Schott Musik Int'l GmbH & Co. v. Colossal Records of Austl. Pty. Ltd.* (1997) 145 ALR 483 (finding that a techno version of Carl Orff's *Carmina Burana* recorded under a mandatory licensing scheme did not "debase" the classical recordings).

<sup>52</sup> See *McFarland v. Miller*, 14 F.3d 912, 921 (3d Cir. 1994) (holding that the actor may have become so inextricably identified with his Our Gang "Spanky" character as to have a cognizable claim against those using the character name and image);  *Douglass v. Hustler Magazine, Inc.*, 769 F.2d 1128, 1146 (7th Cir. 1985) (allowing a model who agreed to pose for Playboy to prevent Hustler from using the photos); *Kyser-Smith v. Upscale Communications, Inc.*, 873 F. Supp. 1519, 1527 (M.D. Ala. 1995) (denying summary judgment to a company that used, without her permission, the image of a scantily-clad model to promote "Hot Six Oil" for body massages);  *Russell v. Marlboro Books*, 183 N.Y.S.2d 8, 35 (Sup. Ct. 1959) (stopping a company from using a fashion model's image in a provocative scene without her permission). An individual unsuccessfully sued an Internet service provider in *Stern v. Delphi Internet Servs. Corp.*, 626 N.Y.S.2d 694, 700 (Sup. Ct. 1995) (granting summary judgment because the use of Stern's picture fell under the incidental use exception of a publicity rights statute).

<sup>53</sup> In sampling cases, for example, music is "recontextualized" with potentially different meanings. Often small music companies (usually close corporations owned by musicians) bring such suits against corporate giants. See, e.g.,  *Tin Pan Apple Inc. v. Miller Brewing Co.*, 30 U.S.P.Q.2d (BNA) 1791, 1795 (S.D.N.Y. 1994) (denying the defendant brewery's motion for summary judgment in a copyright infringement action involving the alleged use of lyrics from the musical group the Fat Boys in a televised beer commercial);  *Jarvis v. A & M Records*, 827 F. Supp. 282, 289 (D.N.J. 1993) (denying a record company's motion for summary judgment on a suit brought by a songwriter for copyright infringement by sampling);  *Grand Upright Music Ltd. v. Warner Bros. Records*, 780 F. Supp. 182, 185 (S.D.N.Y. 1991) (holding that a record company's use of lyrics without the permission of the original songwriter violated the rights of the original artist).

<sup>54</sup> See  *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 110 (2d Cir. 1998) (holding that a promotional poster for the film *Naked Gun 33 1/3* that superimposed Leslie Nielsen's head onto a pregnant model's naked body was a permissive parody of the famous Annie Leibovitz photo of Demi Moore that appeared on the cover of *Vanity Fair*);  *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974) (allowing the owner of a famous racing car to prevent the use of the image of the car); Barbara Hoffman, *From Virtual Gallery to the Legal Web*, N.Y.L.J., Mar. 15, 1996, at 5, 5

(recounting a New York newspaper's agreement to pay a photographer \$20,000 for digitally altering her photograph without permission); see also *infra* note 61 and accompanying text (discussing cases involving artist Jeff Koons). For an example of a small corporation's recoding another small corporation's website for commercial advantage, see *Futureodontics Inc. v. Applied Anagramics Inc.*, 45 U.S.P.Q.2d (BNA) 2005, 2010 (C.D. Cal.) (denying a preliminary injunction against the defendant's web site that reproduced a page from the plaintiff's web site in a "framed link," but refusing to dismiss the case because the defendant did not foreclose the possibility that the link constituted a derivative work of the original web site), *aff'd*, 152 F.3d 925 (9th Cir. 1998).

<sup>55</sup> Brooke A. Masters, *Sculptor, Cathedral Sue over Movie's Art*, *Wash. Post*, Dec. 6, 1997, at B1.

<sup>56</sup> *Id.*



<sup>57</sup> See Brooke A. Masters, *Judge Tells Filmmaker to Settle Suit or Halt Video*, *Wash. Post*, Feb. 11, 1998, at B2.

<sup>58</sup> Even if corporate plaintiffs outnumbered individual plaintiffs in reported cases or vice versa, this would not tell us much. The enforcement of intellectual property rights by both individuals and corporations may be more "underneath the radar." See also *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 524 (1994) (noting that in copyright cases plaintiffs and defendants "run the gamut from corporate behemoths to starving artists" (quoting *Cohen v. Virginia Elec. & Power Co.*, 617 F. Supp. 619, 622-23 (E.D. Va. 1985))).



<sup>59</sup> Coombe, *supra* note 7, at 1863.

<sup>60</sup> See, e.g., *Milpurrurru v. Indofurn Pty. Ltd.* (1994) 54 F.C.R. 240, 283 (holding a business liable for importing carpets bearing infringing images of Australian Aboriginal sacred images). In *Milpurrurru*, not only were the images reproduced inaccurately, they were sacred images put in a format where they could be walked on--definitely a recoding of the Aboriginal images. Cf. *Chanel Destroys Offensive Dress*, *Wash. Post*, Jan. 21, 1994, at G3 (reporting the consequences of designer Karl Lagerfeld's accidental embroidery of Koranic calligraphy on the bodice of a low-cut evening dress); Christine Steiner, Getty Trust General Counsel, *Remarks at Conference on Intellectual Property and Human Rights*, Geneva (Nov. 9, 1998) (describing "protests against fashion uses of cultural


symbols that represent certain traditional ceremonies and spiritual endeavors”).

<sup>61</sup> See  *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992); *Campbell v. Koons*, 1993 U.S. Dist. LEXIS 3957 (S.D.N.Y. 1993);  *United Feature Syndicate, Inc. v. Koons*, 817 F. Supp. 370 (S.D.N.Y. 1993).

<sup>62</sup> This apt description comes from Raphael Winick, *Intellectual Property, Defamation, and the Digital Alteration of Visual Images*, 21 *Colum.-VLA J.L. & Arts* 143, 159-60 (1997).


<sup>63</sup> See  *Rogers v. Koons*, 751 F. Supp. 474, 480 (S.D.N.Y. 1990) (granting an injunction against Koons’s unauthorized use of artist Rogers’s photograph), amended on other grounds by 777 F. Supp. 1 (S.D.N.Y. 1991), *aff’d*,  960 F.2d 301 (2d Cir. 1992).



<sup>64</sup>  *United Feature*, 817 F. Supp. at 372.

<sup>65</sup>  *Id.* at 373 (describing the creation of Wild Boy and Puppy).

<sup>66</sup> See *id.*


<sup>67</sup> *Id.* (describing the creation of Wild Boy and Puppy). For a picture of the Koons sculpture, see *id.* at 385.

<sup>68</sup>  *Rogers*, 960 F.2d at 305.

<sup>69</sup> Is *String of Puppies* a parody or is it merely satirical? The Second Circuit grappled with this issue: “The problem ... is that even given ‘String of Puppies’ is a satirical critique of our materialistic society, it is difficult to discern any parody of the photograph ‘Puppies’ itself.”  *Id.* at 309-10. In *United Feature*, Koons initially admitted “that the Wild Boy and Puppy sculpture was not intended to be parody or a satire of the comic strip character ‘Odie,’” instead arguing that “[i]t is the use of the comic strip character as a social comment in the sculpture that brings the Koons use within the same line of reasoning or approach as the parody cases.”  *United Feature*, 817 F. Supp. at 384. After the court granted Art Rogers summary judgment against Koons in the Rogers case, Koons’s lawyers




realized the deficiency of this argument and did a volte-face, arguing that the Odie sculpture was a “parody of the ‘Odie’ figure itself.” *Id.* The court found this “position [to be] in complete contradiction to the undisputed evidence in the case.” *Id.*

70  *United Feature*, 817 F. Supp. at 383.

71 *Id.*


72 *Id.* at 372.

73 If it was Koons’s lawyers who suggested the term “producer,” then they may not be the most clear-minded litigators: Producers are not commonly considered the artistic center of a project, at least not in the post-Samuel Goldwyn film industry. See, e.g., Jean-Loup Tournie, *Author’s Rights and New Modes of Exploitation*, 16 *Colum.-VLA J.L. & Arts* 427, 456 (1992) (noting that the view that producers are authors “has never prevailed, especially since today’s producers are essentially financiers who assemble the capital needed to invest in a product which the director ... is in charge of making”); see also  *Geshwind v. Garrick*, 734 F. Supp. 644, 650-51 (S.D.N.Y. 1990) (finding that, absent written agreements to the contrary, the films’ animators, not the films’ producer, were its authors, despite the producer’s claim of authorship based on his supervision), vacated in part, 738 F. Supp. 792 (S.D.N.Y. 1990), *aff’d*, 927 F.2d 594 (2d Cir. 1991). Academy Awards are given to screenwriters, directors, and actors, but there is no “Best Producer” category; the award for “Best Picture” is received by the producers of a film, but the award goes to the film, not the individuals.





74 By analogy, in some sense, architects “sculpt” buildings in the way Koons may have created sculptures--having concepts, doing sketches, designating materials, and overseeing both model makers and actual building constructors. We still credit architects with a great deal of creativity and artistry. See Hughes, *Personality*, *supra* note 2, at 93-94.

75 A *Details* magazine editorial noted, “Today you can make music without playing an instrument (hello, Tricky) or be an artist without wielding a paintbrush (hello, Jeff Koons).” Joe Dolce, *Editor’s Letter*, *Details*, June 1997, at 24.

76  *Rogers*, 960 F.2d at 312. Writing about *Wild Boy and Puppy*, the district court found

that “[t]he fact that the infringing copy can be classified as ‘art’ or as being part of an ‘artistic tradition’” did not save  Koons from liability. United Feature, 817 F. Supp. at 379. Art market observer Richard Polsky noted that by 1997 Koons’s work had “begun to look like the kitsch it once parodied. There is nothing even thought-provoking, let alone aesthetically sublime, about a life-size Disneyesque bear talking to a goofy-looking London bobby.” Richard Polsky, *Modern Art: The Bottom Line*, Harper’s Mag., Nov. 1997, at 38, 39.

<sup>77</sup> See, e.g., William L. Posser, *Privacy*, 48 Cal. L. Rev. 383, 398-401 (1960).

<sup>78</sup> See, e.g.,  *Gilliam v. American Broad. Cos.*, 538 F.2d 14, 21 (2d Cir. 1976) (enjoining the broadcast of Monty Python skits that had been edited without authorization);  *Granz v. Harris*, 198 F.2d 585, 588 (2d Cir. 1952) (finding that putting the author’s name on a distorted version of a work is a basis for an unfair competition claim);  *Benson v. Paul Winley Record Sales Corp.*, 452 F. Supp. 516, 518 (S.D.N.Y. 1978) (holding that the defendants’ overdubbing of sexually suggestive sounds on Benson’s recording “threat[ened] his professional standing and personal stature”);  *Prouty v. National Broad. Co.*, 26 F. Supp. 265, 265-66 (D. Mass. 1939) (enjoining, under unfair competition law, the broadcast of a “degrad[ed]” version of a novel).

<sup>79</sup> Writers of many ideological viewpoints have embraced the view that property enhances personhood or self-actualization. See, e.g., *supra* note 2; see also James V. DeLong, *Property Matters* 335-36 (1997). DeLong writes:  
[I]ncluded on the list of community values is a dedication to nurturing individual development and autonomy. “Community” is not synonymous with “anthill.” We want people to be able to act freely and creatively, inventing themselves and defining their own personhood, if you will. Control over property, whether it takes the form of land, computer hardware, or electric guitars, is a crucial part of this.  
Id.

<sup>80</sup> See Hughes, *Philosophy*, *supra* note 2, at 359, 358-65 (responding to the First Amendment attacks on copyright protection by arguing that “freedom of expression is meaningless without assurances that the expression will remain unadulterated” (emphasis in original)).

<sup>81</sup> Boyle, for example, writes,  
We are driven to confer property rights in information on those who come closest to the image of the romantic author .... It leads us to have too many intellectual property rights,

to confer them on the wrong people, and dramatically to undervalue the interests of both the sources of and the audiences for the information we commodify.

James Boyle, *Shamans, Software, and Spleens: Law and the Construction of the Information Society* x-xi (1996) (emphasis in original).

<sup>82</sup> For a wide-ranging discussion of the externalities--negative and positive--caused by media products, see generally C. Edwin Baker, *Giving the Audience What It Wants*, 58 *Ohio St. L.J.* 311, 346-85 (1997). Baker's focus is on externalities from the content of cultural objects, i.e. increased violence on the streets because of increased violence on the television. See *id.* at 373. His interesting discussion is not directed toward the point made here: that there are positive externalities from a certain level of stability of cultural objects.

<sup>83</sup> Edward Gibbon, *The History of the Decline and Fall of the Roman Empire* 235 (Womersley ed. 1994).

<sup>84</sup> John Fiske, *Understanding Popular Culture* 174 (1989); see also Madow, *supra* note 7, at 143.

<sup>85</sup> Madow, *supra* note 7, at 194. Coombe similarly sees Judy Garland used by "pre-Stonewall era gay men ... to identify themselves to each other and to comment upon the relation between nature and artifice in the presentation of the gendered self." Coombe, *supra* note 7, at 1876-77.

<sup>86</sup> Madow, *supra* note 7, at 194.

<sup>87</sup> *Id.* ("Dyer shows, however, that after Garland's firing by MGM and her suicide attempt, urban gay men found in Garland's image, particularly her androgyny and her fragile facade of normality, a powerful means of 'speaking to each other about themselves.'" (quoting Richard Dyer, *Heavenly Bodies: Film Stars and Society* x (1986))).

<sup>88</sup> *In the Good Old Summertime* (MGM 1949); see also Melinda Corey & George Ochoa, *The Dictionary of Film Quotations* 176 (1995).

<sup>89</sup> See Jeanine Bassinger, *A Women's View* 140-42 (1993) (discussing the women who

starred in the various film versions of *A Star Is Born* and *What Price Hollywood?*).

<sup>90</sup> Ephraim Katz, *The Film Encyclopedia* 509 (1994).

<sup>91</sup> To be sure, Madow might note that during the 1940s and 1950s the right of publicity was weaker and more inchoate. He might also argue that present publicity rights are too strong because the evolution of the Garland image could not occur in the same way today. But there is good reason to think that in the 1940s and 1950s nonlegal circumstances made it easier to control a celebrity's image, particularly because paparazzi, tabloids, and communication channels (i.e., the Internet) were not as intrusive and did not exert as much pressure on the celebrity's image.

<sup>92</sup> Although their individual styles are very different, each of these artists uses stylized people, animals, and creatures in their art--the kind of genre that could easily integrate the "Odie" image. See Gary Alexander, *New Art International* (1996).

<sup>93</sup> Madow, *supra* note 7, at 145.

<sup>94</sup> *Id.*

<sup>95</sup> These Rambo-like characters are both appealing, absurd, and traditional. As James Salter writes, "There were officers in the First [World] War who strolled out calmly under fire in an advance, walking to death as though it were to lunch or adjutant's call. It was thrilling to see men with disdain like that." James Salter, *Burning the Days* 72 (1997).

<sup>96</sup> "John Wayneing it" may have had its heyday in the years following the movie *The Green Berets* (Warner Brothers 1968). I am indebted to U.S. Army Captain John Dundas, Marine Colonel George J. Flynn, and former officer Michael P. Peters for background on these thoughts. Interview with John Dundas, U.S. Army Captain, in Washington, D.C. (June 6, 1995); Interview with George J. Flynn, U.S. Marine Corps Colonel, in Washington, D.C. (Sept. 29, 1997); Interview with Michael P. Peters, former U.S. Army Colonel, in Washington, D.C. (Sept. 29, 1997).

<sup>97</sup> Coombe, *supra* note 7, at 1877; see also Coombe, *supra* note 31, at 117-23 (discussing

heterosexual women and gay fan groups developing alternative Star Trek stories).

<sup>98</sup> See generally Camille Bacon-Smith, *Enterprising Women: Television Fandom and the Creation of Popular Myth* 93-113 (1992).

<sup>99</sup> Coombe, *supra* note 31, at 118.

<sup>100</sup> *Id.* at 119.

<sup>101</sup> *Id.* at 121, 120-21.

<sup>102</sup> *Id.* at 121.



<sup>103</sup> The term refers to gay and lesbian Star Trek fans. See Interview with Henry Jenkins, in *Enterprise Zones: Critical Positions on Star Trek* app. at 260-63 (Taylor Harrison et al. eds., 1996).

<sup>104</sup> See also *infra* note 173 and accompanying text.

<sup>105</sup> But see Tushnet, *supra* note 16, at 676. Tushnet argues that “fan fiction” should be freely permitted because it is not for profit; “[i]f a line is not drawn at noncommerciality when it comes to creative re-use of characters, then a fan’s daydream is theoretically as illegitimate as the story she posts on the Web.” *Id.* (emphasis in original). Not so. This overlooks the issue of changing the social meaning of the character; the proper line should be drawn between the unregulated private use (the daydream) and the public uses, many of which are permitted, some of which are not.

<sup>106</sup> Rosemary J. Coombe, *Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders*, 10 *Cardozo Arts & Ent. L.J.* 365, 371 (1992).

<sup>107</sup> Sunder, *supra* note 2, at 168.

- <sup>108</sup> Aoki, *Sovereignty*, supra note 7, at 1337; see also *id.* at 1322. Coombe makes the more expansive argument that intellectual property laws not only throttle creators in our own society, but also “reinforce tendencies towards American cultural hegemony.” Rosemary J. Coombe, *Left Out on the Information Highway*, 75 *Or. L. Rev.* 237, 240 (1996). Aoki also argues that authors are not only given the ability to tax the future social product via copyright law but also receive a generous subsidy to the extent that they do not have to pay compensation to all of the sources from which they have drawn or by which they have been influenced, only some of which may be in the public domain. Aoki, *Sovereignty*, supra note 7, at 1337. Perhaps Aoki overstates his point: where is the harm, if future generations of authors will also be able to draw on current influences cost-free (because they are public domain, are under the fair use doctrine, or are *de minimis*)?
- <sup>109</sup> Boyle, supra note 81, at 196.
- <sup>110</sup> Sunder, supra note 2, at 168.
- <sup>111</sup>  720 F.2d 231 (2d Cir. 1983).
- <sup>112</sup>  *Id.* at 242. Mark Lemley makes the same observation in his discussion of the “romantic author” argument. See Mark A. Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 *Texas L. Rev.* 873, 885 (1997) (reviewing Boyle, supra note 81) (arguing that “taken to an extreme, [[[strong intellectual property] protection can make the creation of new works virtually impossible by locking up all of the possible sources from which a new author can work”)).
- <sup>113</sup> Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 *Ohio St. L.J.* 517, 556 (1990) (recognizing that a “complete author’s rights” regime does not exist and, if it did, it would create innumerable difficulties for the development of new intellectual works).
- <sup>114</sup> See *infra* notes 121-28 and accompanying text.
- <sup>115</sup> See, e.g., *Mattel Inc. v. MCA Records Inc.*, 46 *U.S.P.Q.2d* (BNA) 1407, 1420 (C.D. Cal.







1998) (holding that the song Barbie Girl, on Aqua, Aquarium (UNI/MCA 1997), is a permitted parody of the Barbie doll). Lyrics include:

Life in plastic, it's fantastic

You can brush my hair, undress me everywhere ...

Dress me up, make it tight, I'm your dolly









<<http://www.aqua.dk/aqua/aqua.htm>> (visited Feb. 1, 1999).

- 116 Some First Amendment cases have expressly relied on “artistic freedom.” See, e.g.,  *Rogers v. Grimaldi*, 875 F.2d 994, 1001-02 (2d Cir. 1989) (permitting, on grounds of artistic freedom, Federico Fellini to use Ginger Rogers’s name and likeness in the film *Ginger e Fred* (PEA 1986), about two Italian cabaret dancers who imitated Ginger Rogers and Fred Astaire).
- 117 See, e.g.,  *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148, 1152-53 (9th Cir. 1986) (upholding televangelist Jerry Falwell’s fair use defense for copying a Hustler Magazine parody cartoon of him, when the copy was used in Falwell’s fundraising materials).
- 118 See, e.g.,  *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991). In *Feist*, the Supreme Court held that creativity is a requirement for copyright protection and that copyright only extends to the original elements of a work. The Court based the creativity requirement both on the statutory grounds that the Copyright Act only protects “original works of authorship,” 17 U.S.C. § 102 (1994), and on constitutional grounds, see *id.* at 345, 355, 363-64, although the latter was not required for the decision and does not directly follow from the language of Article I, Section 8 of the Constitution, see *Hughes*, *Personality*, *supra* note 2, at 99.
- 119 For example, the California publicity rights statute expressly provides that the “use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required...”  *Cal. Civ. Code* § 3344(d) (West 1997); see also   *Hicks v. Casablanca Records*, 464 F. Supp. 426, 433 (S.D.N.Y. 1978) (approving a book and movie containing a fictionalized account of Agatha Christie’s mysterious 11-day disappearance); James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 *Texas L. Rev.* 637, 660 (1973) (observing the courts’ tendency to give the press a lot of room to use celebrities’ likenesses in reporting); Robert W. Clarinda, *Lewinsky: Testing the Limits of Copyright*, *N.Y.L.J.*, Aug. 14, 1998, at 5 (concluding that Monica Lewinsky would have trouble asserting a claim under

California's § 3344 because of the First Amendment exceptions).


- <sup>120</sup> For example, the Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (codified as amended at 15 U.S.C. §§ 1051, 1125, and 1127 (Supp. II 1996)), amended the Lanham Act, 15 U.S.C. §§ 1051-1127 (Supp. II 1996), to provide federal remedies--in place of the patchwork of state remedies--for uses of a trademark that "dilute" the trademark without causing consumer confusion. This extension of trademark protection does not apply to noncommercial uses of marks, fair uses, or news reporting or commentary. 15 U.S.C. § 1125(c)(4) (Supp. II 1996). The new law applies only to commercial speech, which the Supreme Court defined as "expression related solely to the economic interests of the speaker and its audience." *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557, 561 (1980). This standard is widely understood to mean speech that proposes a commercial transaction. See Madrid Protocol Implementation Act and Federal Trademark Dilution Act of 1995: Hearings on H.R. 1270 and H.R. 1295 Before the House Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary, 104th Cong. 72-74 (1995) (statement of Mary A. Alford).
- <sup>121</sup> *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985) (comparing two works that dealt with a young professional who investigates and exposes a conspiracy to murder healthy young people and harvest their vital organs).
- <sup>122</sup> See *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1329 (9th Cir. 1983) (holding that there existed a genuine issue of material fact regarding whether "only the Star Wars idea or the expression of that idea was copied" such that summary judgment for the defendants was inappropriate); see also *Williams v. Crichton*, 84 F.3d 581, 589 (2d Cir. 1996) (finding that the common features of the plaintiff's Dinosaur World books and Jurassic Park-- including "placing dinosaurs on a prehistoric island far from the mainland"-- were scenes à faire in "dinosaur adventure stor[ies]"); *Litchfield v. Spielberg*, 736 F.2d 1352, 1358 (9th Cir. 1984) (finding that E.T. the Extra-Terrestrial (Universal Pictures 1982) was not substantially similar to the plaintiff's musical about visiting extraterrestrials); *Weygand v. CBS, Inc.*, 43 U.S.P.Q.2d (BNA) 1120, 1127 (C.D. Cal. 1997) (finding no infringement between two scripts about the story of a poor white child adopted by poor black farmers in the Depression South). A new scene à faire in science fiction is the use of a computer virus to disable the enemy, as in *Independence Day* (20th Century Fox 1996) and *Arthur C. Clarke, 3001: The Final Odyssey* (1997). Noting the similarity, Clarke jokingly queried whether he could accuse the *Independence Day* creators "of the trans-temporal crime of precognitive plagiarism." Clarke, *supra*, at 190.



- <sup>123</sup> Dutch still life paintings of the period are rife with stock elements. See, e.g., Abraham van Beyeren, *Breakfast Piece* (1666) (Kunsthistorisches Museum, Vienna); Pieter Claesz, *Still Life with a Turkey Pie* (1627) (Rijksmuseum, Amsterdam); Pieter Claesz, *Still Life with Musical Instruments* (1623) (Louvre, Paris); Willem Claesz Heda, *Still Life* (1634) (Rijksmuseum, Amsterdam); Jan Davidsz de Heem, *Breakfast Piece* (undated) (Kunsthistorisches Museum, Vienna). These paintings are collected in *The World's Master Paintings: From the Early Renaissance to the Present Day* 303, 311, 312, 329, 331 (Christopher Wright ed. 1992), respectively.
- <sup>124</sup> See, e.g.,  *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986) (determining that “drunks, prostitutes, vermin ... derelict cars” are realistic portrayals of police work in the South Bronx and that “[f]oot chases and the morale problems of policemen, not to mention the familiar figure of the Irish cop, are venerable and often-recurring themes of police fiction”);   *Weygand*, 43 U.S.P.Q.2d (BNA) at 1125-27 (comparing two film scripts in which a white child is adopted by poor black farmers in the Depression South and finding no infringement for similar issues and scenes).
- <sup>125</sup> For example, *Titanic* director James Cameron told Walter Lord, author of *A Night to Remember*, “You’re the one who really wrote this” movie. John Seabrook, *You’re the One Who Really Wrote This*, *Sky Mag.*, Apr. 1998, at 21.
- <sup>126</sup> See  *Smith v. Jackson*, 84 F.3d 1213, 1217 (9th Cir. 1996) (finding no similarity between the plaintiffs’ and Michael Jackson’s songs).
- <sup>127</sup>  See *Country Kids ‘N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1286 n.7 (10th Cir. 1996) (applying the scenes à faire doctrine to wooden dolls);  *Mattel, Inc. v. Azrak-Hamway Int’l, Inc.*, 724 F.2d 357, 360 (2d Cir. 1983) (holding that the defendant’s “Warlord” doll did not infringe the “Masters of the Universe” dolls);  *FASA Corp. v. Playmates Toys, Inc.*, 869 F. Supp. 1334, 1352 (N.D. Ill. 1994) (finding no infringement of the plaintiff’s “BattleTech” toys because the defendant merely used the same general concepts of a futuristic, war-dominated universe, interstellar battle machines, and genetically engineered warriors).
- <sup>128</sup> See  *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1376 (10th Cir. 1997) (concluding that the plaintiff’s command code values were “unprotectable as scenes a faire because they were

dictated by external functionality and compatibility requirements of the computer and telecommunications industries”).

<sup>129</sup> See  Cal. Civ. Code § 3344(d) (West 1997).

<sup>130</sup> See, e.g., *Winters v. D.C. Comics*, No. BC-145670 (Cal. Super. Ct. Dec. 11, 1997) (issuing summary judgment order and allowing the comic book publisher to use Winters’s likeness); see also  *Guglielmi v. Spelling-Goldberg*, 25 Cal.3d 860 (1979) (Bird, C.J., concurring) (permitting the use of Rudolf Valentino’s image under California common law in a fictional account of a Hollywood “ladies’ man”).





<sup>131</sup> Steve Martin, *Picasso at the Lapin Agile*, in *Picasso at the Lapin Agile and Other Plays* 1, 63-77 (1996).

<sup>132</sup> But was there really any recoding going on here? The play’s Elvis character said things that were predictably Elvis-like; nothing pejorative or distasteful was done with the image; the only recoding was that the Elvis character was inserted into an already-absurd early-twentieth-century Paris setting. For another unauthorized Elvis Presley presence in pop culture, there are songs by “El Vez.” See (or hear) *El Vez, Christmas Wish*, on *High-Fidelity Holiday* (EMI Music 1998). For an example of an assertion of a publicity right that increased rather than decreased recoding, see *Sagan v. Apple Computer, Inc.*, 874 F. Supp. 1072 (C.D. Cal. 1994). Apple had given a development project the internal name “Carl Sagan”; when Sagan learned about this, he demanded that his name not be used. After Apple technicians changed the project’s code name to “Butt-Head Astronomer,” Sagan sued for defamation; the court denied the claim, concluding that the code name did not assert facts about Sagan. *Id.* at 1074-76.

<sup>133</sup> See Alex Kozinski, *Mickey & Me*, 11 *U. Miami Ent. & Sports L. Rev.* 465, 469 (1994) (arguing that “if we open up the field and allow ... characters to be portrayed by someone other than the company that created them, they will become different characters”).

<sup>134</sup> Madow, *supra* note 7, at 233 (emphasis in original).

<sup>135</sup> See *id.*

- <sup>136</sup> Id. at 237.
- <sup>137</sup> Id. at 238 (noting that cigarettes and alcohol are the most obvious and important examples of dangerous products that celebrities have routinely endorsed). Worse still are cases such as Michael Jackson’s doing Pepsi-Cola ads but refusing to drink it. Deyan Sudjic, *Cult Heroes* 11 (1989).
- <sup>138</sup> Bette Midler, for example, refuses to do commercials. See Charles-Edward Anderson, *Soundalike Suit*, *A.B.A. J.*, Jan. 1990, at 24. As does Dustin Hoffman. See Howard Kurtz, *Dustin Hoffman Wins Suit*, *Wash. Post*, Jan. 23, 1999, at C2.
- <sup>139</sup> He also was offered eight “infomercial” opportunities, but accepted only one--for a product he had used and believed in. Interview with Casey Kasem, in Los Angeles, Cal. (Sept. 23, 1994).
- <sup>140</sup> See Sudjic, *supra* note 137, at 31. And many celebrities have refused to do cigarette advertisements. See Interview with Nicholas Coster, in Los Angeles, Cal. (Jan. 5, 1999) (stating that Mr. Coster, a veteran star of several soap operas, like many of his colleagues consistently refused to do cigarette ads).
- <sup>141</sup> Madow, *supra* note 7, at 236.
- <sup>142</sup> Some evidence that corporations would be in the vanguard of those appropriating unprotected celebrity images are those cases in which corporations sought the same thing: to get the celebrity’s image through a look-alike or, in more recent cases, a sound-alike. See  *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1111-12 (9th Cir. 1992) (affirming a multi-million dollar award for using a sound-alike in ads);  *Midler v. Ford Motor Co.*, 849 F.2d 460, 464 (9th Cir. 1988) (establishing liability for the unauthorized use of a sound-alike of a distinctive celebrity voice in a commercial).
- <sup>143</sup>  183 N.Y.S.2d 8 (Sup. Ct. 1959).
- <sup>144</sup>  *Id.* at 16.

<sup>145</sup>  *Id.* at 17.

<sup>146</sup> For an interesting analysis of how the court reached this conclusion, see Malkan, *supra* note 2, at 823, 821-24 (suggesting that the court’s holding was based not so much on the fact that the photo in the two “ads had been physically altered, but [was] because they conveyed two different and inconsistent meanings”). Models are still at risk. See *Kyser-Smith v. Upscale Communications, Inc.*, 873 F. Supp. 1519, 1523 (M.D. Ala. 1995) (protecting a model (who did not sign a release) from a company that wanted to use her scantily clad image to advertise “Hot Six Oil” for body massages).

<sup>147</sup> Evelyn Virshup, Jackson Pollock: Art vs. Alcohol, in *Creativity and Madness: Psychological Studies in Art and Artists* 17, 19 (Barry Panter et al. eds., 1995) (“Artwork, like a Rorschach inkblot, is a projective screen where we all bring our own feelings, thoughts and experiences to focus. What we see and interpret from our own and others’ art comes from our personal life experience.”).

<sup>148</sup> Nelson Algren, *Chicago: City on the Make* 32-33 (Contact Editions 1961) (1951). The phenomenon is not new: The passive use of cultural objects for identification is centuries old and occurs across human societies. After Ming China had lost its northern capital to invaders, the Imperial court moved to Hangchow. There the Emperor discovered a cook who could recreate one of the soups he had enjoyed in the North. A poet of the time captured the soup’s aura of status and social identity:

A bowl of fish soup isn’t worth more than a few cents. Yet, made as in the days of former capital, it brings smiles to the imperial face. So people come in droves to buy it at twice the price; In part, they are buying the imperial gesture, and in part they buy the soup.

Meng-Lung Feng, *Ku-chin hsiao-shuo* 195, 239 (Frederick W. Mote trans., 1947); see also Frederick W. Mote, *Yüan and Ming, in Food in Chinese Culture: Anthropological and Historical Perspectives* 239 (K.C. Chang ed. 1977) (also containing the poem).

<sup>149</sup> Sudjic, *supra* note 137, at 12; see also Werner Meunsterberger, *Collecting: An Unruly Passion* 199 (1994). Sudjic observes that:

Trends always involve competition and imitation because they are a vehicle of self-definition. There is both a desire for some form of expression of an individual kind and at the same time there is a propensity for sharing in a current drift and identification with others. Such movements are always part of fashion and trendiness.

Sudjic, *supra* note 137, at 12.

- <sup>150</sup> Judith Martin, a.k.a. Miss Manners, writes:  
Our prop is the book. In a public place, such as an airplane or a museum, an open book being intently read means “I am not available.” An open book on the lap, when the head is tilted up and there is a dreamy expression in the eyes, means “I am willing to listen to what you have to offer before I make up my mind whether I want to know you.”  
If the hands are folded over the exposed pages, so that the subject of the book cannot be seen, an interested party may open with, “What are you reading?” Allowing the title or a representative page to be seen saves misunderstandings because the nature of the book carries a message, too.
- Literary classic or scholarly work: “Don’t bother me unless you have an education.”
  - Current world affairs: “You must be someone who is concerned about serious matters.”
  - Current fiction: “You must be au courant but soulful.”
  - ....
  - Psychology or self-improvement book: “One kind word and I’m yours.”
  - Erotic literature: “Kind words are not necessary.”
- Judith Martin, *Miss Manners’ Guide for the Turn-of-the-Millennium* 543 (1989).
- <sup>151</sup> See Verne Gay, *All About Ellen*, *Newsday*, Apr. 24, 1997, at B8 (noting that the Rev. Jerry Falwell and groups such as the Liberty Federation and the American Family Association have attacked Ellen and threatened boycotts of the show’s advertisers).
- <sup>152</sup> See Editorial, *Redskins and Soreheads*, *Wash. Times*, June 10, 1998, at A20.
- <sup>153</sup> See Laura Miller, *www.claptrap.com*, *N.Y. Times*, Mar. 15, 1998, § 7 (Book Review), at 43 (describing readers’ stubborn resistance to “hyperfiction’s efforts to free them from ... ‘domination by the author’”).
- <sup>154</sup> *Id.* (quoting George P. Landow, *Hypertext: The Convergence of Contemporary Critical Theory and Technology* 34 (1992)).
- <sup>155</sup> See *id.* (describing how even the most adventurous readers “shudder at the thought” of reading hypertext novels).
- <sup>156</sup> See *id.* (explaining that readers enjoy reading stories, not plotting the stories themselves, as hypertext novels require). Hypertext novels may yet catch on. Cf. Anne H. Soukhanov, *Word Watch*, *Atlantic Monthly*, Aug. 1998, at 112 (explaining that “lexia,” meaning a

“freestanding block of fiction linked electronically to one or more others in a digital environment,” although “well known among devotees of hypertext fiction ... has to date appeared only infrequently in the general press; however, citations seem to be on the rise”).

<sup>157</sup> See, e.g., David Bowie, *Space Oddity*, on *Best of David Bowie 1969-74* (Emd/Virgin 1990); Malcolm McLaren, *Paris* (BMG/Gee Street 1995); Alanis Morissette, *Untitled* [13th track], on *Jagged Little Pill* (WEA/Warner Brothers 1995); M.C. Solaar, *Paradisique* (Polygram 1997); M.C. Solaar, *Prose Combat* (PGD/Cohiba 1994).

<sup>158</sup> Edmund Kitch has similarly noted that those of us who write articles on intellectual property tend to be “more sympathetic to copyrights than patents or trademarks” perhaps because “people who write books about the subject could bring themselves to do away with patents and trademarks but never could quite bring themselves to argue against their own copyrights.” Edmund W. Kitch, *Property Rights in Inventions, Writings, and Marks*, 13 *Harv. J.L. & Pub. Pol’y* 119, 123 (1990).

<sup>159</sup> Coombe, *supra* note 106, at 376.

<sup>160</sup> For real-world examples of non-owners’ struggling to prevent real property from being recoded from farmland into suburbs, see Sven-Marie Green, *Letter to the Editor: Precious Evans Farm*, *Wash. Post*, July 31, 1998, at A24 (characterizing a northern Virginia farm as a “precious commodity” for local children); Lindsey Layton, *Making a Bid for a Rural Way of Life: Group Sets Up Land Trust to Save Calvert Farm*, *Wash. Post*, Aug. 19, 1998, at A1 (describing a Maryland town “struggling to balance property rights against public cries to control growth”); and Michael D. Shear, *Evans Farm May Be Ripe for Developers*, *Wash. Post*, July 21, 1998, at A1 (detailing local residents’ opposition to the development of the same farm because it serves as open space for the community). See also Sasha Abramsky, *Manhattan: The Suburb*, *New York*, Feb. 1, 1999, at 22 (describing urban residents’ efforts to stop developers from changing the character of neighborhoods).

<sup>161</sup> A small piece of evidence of consumer reliance on image stability is the idea that as images “destabilize,” people will look for substitute indicators of meaning. Winick, for example, suggests that “[o]ne result of the proliferation of altered images is that the public will tend to make value judgments about the source of an image.... Identifying the source of an image, and whether that source is trustworthy, will become more important in the collective psyche.” Winick, *supra* note 62, at 149.

- <sup>162</sup> See supra notes 130-32 and accompanying text.
- <sup>163</sup> Max Frankel, *The Facts of Media Life*, N.Y. Times Mag., Sept. 27, 1998, at 32.
- <sup>164</sup> See John J. Fialka, *Songwriters' Heirs Mourn Copyright Loss*, Wall St. J., Oct. 30, 1997, at B1 (describing United Airlines's use of the famous Gershwin tune).
- <sup>165</sup> See *id.* (describing how Cole Porter's estate mistakenly licensed the use of *I've Got You Under My Skin* to the manufacturers of Vanish toilet bowl cleaner). But see Frank Sinatra & Bono, *I've Got You Under My Skin*, on Duets (Capitol Records 1993).
- <sup>166</sup> See, e.g., Philip Kotler, *Marketing Management* 646 (9th ed. 1997).
- <sup>167</sup> See, e.g., David I. Kertzer, *Ritual, Politics, and Power* 9-10 (1988) David I. Kertzer, *Ritual, Politics, and Power* 9-10 (1988) (suggesting that people develop rituals in part to create stability and continuity between past and present); Lawrence Lessig, *The Regulation of Social Meaning*, 62 U. Chi. L. Rev. 943 (1995) (discussing the importance of social meanings and arguing that courts should take them into consideration when deciding free speech cases).
- <sup>168</sup> This argument against expanded rights for secondary users may be contrasted with an argument I have made elsewhere for an implicit "moral shop right" to give original creators special leeway vis-a-vis the expressions embodied in their creations. See Hughes, *Personality*, supra note 2, at 131-38. Arguably, there is some inconsistency: it can be said that the moral shop right is really a recoding right for artists who have alienated the copyright to their works. The difference between recoding freedom for an original creator and recoding freedom for a secondary user stems from assumptions about the original relationship between person and object. I assume that created objects are, on the whole, significant events in the lives of their original creators. I also assume that creators believe more often than not that their creations convey some aspect of their own personalities: if we removed the created object from the creator's life--if we could surgically pluck the object and the act of creating the object from the creator's life--we would significantly disrupt the trajectory of that life. The likely disruption for a secondary user seems very different. There are occasions when a secondary user may come in contact with a created

object and suddenly feel that object manifests--or could, on recoding, manifest--much of their view of the world: a kind of “love at first sight.” But even in these extreme cases, if exposure to the cultural object had been denied, how readily could the secondary user find an alternative conduit for expression? The difference between the recoding freedom given to original creators versus secondary users may depend on some intuitive judgment about the degree to which each group relies on the created object for expression and the legitimacy of that reliance. Wendy Gordon has made a parallel observation, arguing that original creators’ comparatively greater economic investment justifies giving them stronger rights than secondary users:

To the extent a creator labors toward a goal, she has foregone alternative investments of effort and reduced her available avenues of action. Thus, the particular avenue remaining has great importance for her, and interfering with it may render purposeless many of the prior choices she has made. For the copyist, however, closing this particular avenue arguably will mean comparatively little, for he has little prior investment in its pursuit. Although both may value equally the profits at issue, only for the creator does the creation embody a host of prior sacrifices and the implementation of her distinct and general goals. Gordon, *supra* note 39, at 217.

The difference also depends on the subject area we have just considered: the general need for a stable image. Creating a moral shop right empowers one identifiable individual or small group with some recoding rights. In contrast, the deconstructionist prescription for recoding would permit everyone to use the image. The two prospects for recoding offer vastly different prospects for image stability.

<sup>169</sup> See *supra* notes 61-76 and accompanying text.


<sup>170</sup> In the 1950s comedian Jack Benny did a famous television parody of the film, which became the subject of what was called the Gaslight case, but was actually *Loew’s Inc. v. Columbia Broad. Sys., Inc.*, 131 F. Supp. 165 (S.D. Cal. 1955), *aff’d sub nom. Benny v. Loew’s, Inc.*, 239 F.2d 532 (9th Cir. 1956), *aff’d* by an equally divided court, 356 U.S. 43 (1958) (*per curiam*).

<sup>171</sup> See Brunson, *Dracula Turns 100*, *GeneratioNext*, June/July 1997, at 16. Brunson remarks that:

It was 1931’s mellower “Dracula” that really launched the character as a viable movie icon.... This is certainly the film that stamped the definitive image of Dracula in our minds--probably for all time--and that’s because of Bela Lugosi. He had those peculiar penetrating eyes, that marvelously resonant voice that suggested an ancient European wisdom, and an aura of suppressed exoticism.

*Id.* California Chief Justice Bird also noted that Dracula and Lugosi had become largely





synonymous. See  *Lugosi v. Universal Pictures*, 603 P.2d 425, 445 (Cal. 1979) (Bird, C.J., dissenting). For a semi-fictionalized look at Bela Lugosi's own awareness of his connection to the Dracula character, see Tim Burton's film *Ed Wood* (Touchstone Pictures 1994).

<sup>172</sup> “The meaning of Dracula changes with the times. The character is no longer a figure of horror; instead, he's now a misunderstood romantic hero.... Dracula is no longer a scary figure; he's now a Sesame Street character who teaches kids how to count.” Brunson, *supra* note 171, at 15.

<sup>173</sup> Kenneth Anderson, *Where No Man Has Gone Before*, *Times Literary Supplement*, Jan. 3, 1997, at 1849.

<sup>174</sup> The most clear case in which recoding completely replaces the original work is with architectural additions--hence the great debate in the past few years over additions to the Salk Institute in San Diego, the Guggenheim Museum in New York, and the Kimbell Museum in Fort Worth. See generally Thomas Fisher, *Lessons for the Salk*, *Progressive Architecture*, Oct. 1993, at 7 (arguing that an inability to communicate the benefits of architectural design inhibited meaningful discussions concerning additions to the Salk Institute); Joseph Giovanni, *The Salk Addition*, *Architecture*, Mar. 1996, at 75 (describing how heavy criticism caused the architects to scale down their plans for additions to the Salk Institute); Cathleen McGuigan, *Do the Wright Thing*, *Newsweek*, June 29, 1992, at 58 (discussing the debate over the merits of the Guggenheim Museum addition); Witold Rybczynski, *In Montreal, the New Makes Way for the Old*, *N.Y. Times*, Dec. 8, 1991, § 2 (Arts & Leisure), at 34 (exploring the difficulties involved in building a modern addition to a historic museum building). For example, Michael Graves's 1985 proposal to expand the Whitney Museum of American Art was criticized: “[w]hatever the design's undeniable merits, there is no doubt that it cannibalized the Breuer building, reducing it to a subsidiary element in a totally new statement.” Victoria Newhouse, *Towards a New Museum* (1998), quoted in Herbert Muschamp, *Designing Museums: Often Not a Lively Art*, *N.Y. Times*, June 28, 1998, § 2 (Arts & Leisure), at 32.

<sup>175</sup> *Cinderella* (Walt Disney Pictures 1950); *Snow White and the Seven Dwarfs* (Walt Disney Pictures 1937). True, there have been other *Cinderella* derivative works--Rodgers and Hammerstein's 1964 musical version, *Cinderella* (CBS 1957; also CBS television broadcast, Feb. 22, 1965 and ABC television broadcast, Nov. 2 1997), and Jerry Lewis's 1960 spoof, *Cinderfella* (Paramount Pictures 1960)-- but it still appears that Disney's *Cinderella* character has largely displaced the public domain *Cinderella*.

- <sup>176</sup> Throughout this century, Barrie’s Peter Pan has been almost continuously in theatrical performances in this country. See, e.g., Russ Mussara, Mary Martin Gave Wings to “Peter Pan,” *Akron Beacon J.*, Jan. 22, 1998, at F15; Janet I-Chin-Chuu, Still Flying Through Air, *Seattle Times*, Nov. 20, 1997, at H30.
- <sup>177</sup> Mary Shelley’s *Frankenstein* (TriStar 1994).
- <sup>178</sup> *An American Werewolf in London* (Werewolf 1981).
- <sup>179</sup> Bram Stoker’s *Dracula* (Columbia 1992).
- <sup>180</sup> *Hercules* (Walt Disney Pictures 1997).
- <sup>181</sup> See Hughes, *Philosophy*, *supra* note 2, at 364.
- <sup>182</sup> See *id.*
- <sup>183</sup> See *supra* note 49 and accompanying text.
- <sup>184</sup>  538 F.2d 14 (2d Cir. 1976).
- <sup>185</sup>  *Id.* at 23-24.
- <sup>186</sup> *Kreig*, *supra* note 7, at 1583.
- <sup>187</sup> See Carla Hesse, *Publishing and Cultural Politics in Revolutionary Paris, 1789-1810*, at 3-4, 98, 125-27 (1991). As a result of piracy during this period, twenty-one major Paris publishers and booksellers were forced to declare bankruptcy. See *id.* at 73-76, 98-99. Copyright was duly restored in 1793. See *id.* at 120, 119-20 (describing the enactment of the “declaration of the rights of genius”).

<sup>188</sup> Charles C. Mann, *Who Will Own Your Next Good Idea?*, *Atlantic Monthly*, Sept. 1998, at 57, 76.

<sup>189</sup> *Id.* at 76.

<sup>190</sup> A mix that, in C. Edwin Baker's view, neither accounts for the externalities produced nor reflects the true preferences of consumers. See Baker, *supra* note 82, at 411-13.

<sup>191</sup> See, e.g., *Practice Management Info. Corp. v. American Med. Ass'n*, 121 F.3d 516, 520 (9th Cir. 1997) (holding that the American Medical Association can enforce its copyright in the Current Procedural Terminology codes despite their use in Medicare and Medicaid forms); *Building Officials & Code Admin. v. Code Tech., Inc.*, 628 F.2d 730, 734-35 (1st Cir. 1980) (noting that, for due process and public policy reasons, BOCA may have lost its copyright when it permitted model codes to be included in Massachusetts building regulations). For example, Practice Management concerned the licensing of the American Medical Association's ("AMA") Current Procedural Terminology ("CPT") to the government for use with Medicare and Medicaid. The AMA published the first edition of the CPT in 1966; it was not licensed to the government until 1983. One of the questions raised in the case was whether the Government's action in "integrating" the CPT into the legal regime of Medicare and Medicaid had destroyed the AMA's copyright. The Ninth Circuit ultimately concluded that the copyright was still intact. Because the AMA had started its medical code system to assist physicians, it might be said that the government may have recoded the meaning of the CPT (albeit with the AMA's consent) when it made the CPT the standard device for Medicare and Medicaid.

<sup>192</sup> Madonna volunteered her services for a voter registration campaign sponsored by MTV. See David Brinn, *Taking a Peek at Madonna's "Girlie Show,"* *Jerusalem Post*, Oct. 1, 1993, at 2 (describing an ad in which Madonna "wrapped her naked self in an American flag while telling fans that she [would] personally spank them if they [didn't] register to vote"). It is only a small step to imagine a government using popular public figures' images to promote, say, the buying of war bonds or abstinence until marriage, despite the fact that the public figure in question might believe in pacifism and free love.

<sup>193</sup> See Daniel J. Boorstin, *Hidden History* 135 (1987).

- <sup>194</sup> Id. at 135-37.
- <sup>195</sup> John Locke, *Two Treatises of Government* 288, 287-91 (Peter Laslett ed., Cambridge Univ. Press 1988) (1690).
- <sup>196</sup> See C.B. MacPherson, *The Political Theory of Possessive Individualism: Hobbes to Locke* 201 (1962) (“First, a man may appropriate only as much as leaves ‘enough and as good’ for others; this limit, explicitly stated by Locke, is clearly required by the justification, for each man has a right to his preservation and hence to appropriating the necessities of his life.”); Geraint Parry, *John Locke* 53 (1978) (noting that Locke’s principle of “enough and as good” limits “the amount [of property] which may be legitimately acquired”).
- <sup>197</sup> James Tully, *A Discourse on Property: John Locke and His Adversaries* 47 (1980); see also Ruth W. Grant, *John Locke’s Liberalism* 67-71, 91 (1987) (explaining Locke’s theory of natural rights as including both the right to self-preservation and the duty to respect the rights of one’s equals).
- <sup>198</sup> See Grant, *supra* note 197, at 111; Tully, *supra* note 197, at 125-27.
- <sup>199</sup> For example, Robert Nozick has brought the Lockean proviso from the state of nature into modern society, by interpreting the “enough and as good” requirement as a principle meant “to ensure that the situation of others is not worsened” by the appropriation of property from the commons. Robert Nozick, *Anarchy, State and Utopia* 175, 175-76 (1974). Thomas Pogge has described the problem and (one kind of) response for modern application of the Lockean proviso:  
Junior must have an initial liberty to appropriate stuff that is equivalent to the stuff Senior had the initial liberty to appropriate .... But libertarians typically want to justify a world in which everything is owned and in which new subjects (some of them owning nothing) will find no use for their initial liberty to appropriate. So they favor another intermediate formulation of the equality constraint. Junior must have initial established rights and liberties that are at least equivalent to the initial established rights and liberties of Senior.  
Thomas W. Pogge, *Realizing Rawls* 57-58 (1989); see also Lawrence C. Becker, *Property Rights: Philosophic Foundations* 42-43 (1977) (criticizing the idea that property rights gained through labor do not cause losses to others).
- <sup>200</sup> See Coombe, *supra* note 106, at 373.




201 Id.



202 First, there is no consensus on whether Locke intended his description of the justification for propertization in the presociety state of nature to have any normative power in the circumstances of a full-blown society--in which consent, express or implied, becomes the final justifier of property distributions. Second, the condition makes an act of propertization illegitimate if, afterwards, there is not enough and as good to become the private property of others, while Coombe's example is that of a government entity acting on the interests of community self-actualization. But most importantly, Locke attached the enough and as good condition to there being property for other people's survival, but the intuitive appeal of the condition as a principle of just distribution attracts modern writers like Coombe (and me) to apply the condition to opportunities for economic well-being, personal growth, and self-actualization.


203 My goal is not to muddle the discussion with just compensation issues, although it does raise some interesting problems. Should Memphis be able to conduct condemnation proceedings against Elvis's right of publicity as long as it gave the estate just compensation?

204 Contrast this situation with one area of law that expressly recognizes the enough and as good condition: the "essential facilities" doctrine of antitrust law. Under the essential facilities doctrine, if a private party controls the only practical facilities for some type of commerce in a given location, that party can be forced to open the facility to the use of others on equitable terms. The doctrine originated in [United States v. Terminal R.R. Ass'n](#), 224 U.S. 383 (1912). There is general agreement that the doctrine has the following four elements: (a) control of the facility by a monopolist; (b) a competitor's inability to duplicate the facility; (c) denial of use of the facility to the competitor; and (d) the feasibility of giving the competitor access to the facility. See [MCI Communications v. AT&T](#), 708 F.2d 1081, 1133 (7th Cir. 1983); see also [Aspen Highlands Skiing Corp. v. Aspen Skiing Co.](#), 738 F.2d 1509, 1520-21 (10th Cir. 1984) (finding that a multiday, multitarea ski-lift pass was an essential facility and thus there was a duty to continue the joint marketing arrangement) (citing [MCI](#), 708 F.2d at 1132-33), *aff'd*, [472 U.S. 585](#) (1985).

205 See [Monster Communications, Inc. v. Turner Broad. Sys., Inc.](#), 935 F. Supp. 490, 494 (S.D.N.Y. 1996) (describing the balance between the protection accorded photographic

images and the “demands” of history which can “strengthen somewhat the hand of a fair use defendant”);  *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 643 (Ct. App. 1995) (holding that a professional football player could not prevent his image from being used in posters reporting a contemporaneous, newsworthy event--a Super Bowl victory);  *Dora v. Frontline Video, Inc.*, 18 Cal. Rptr. 2d 790, 792 (Ct. App. 1993) (holding that a surfer could not prevent the use of his likeness or name in a documentary on surfing because “[p]ublic interest attaches to people who by their accomplishments or mode of living create a bona fide attention to their activities”);  *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 350 (Ct. App. 1983) (noting that free speech requires that celebrities “relinquish[ ]” some of their privacy). See generally Robert M. Jarvis, *Babe Ruth as Legal Hero*, 22 Fla. St. U. L. Rev. 885, 887-89 (1995) (discussing cases in which Babe Ruth or his heirs were unable to prevent uses of the baseball star’s image); *supra* notes 119, 130.

206 219 U.S.P.Q. (BNA) 982 (N.D. Cal. 1982), *aff’d*,  781 F.2d 733 (9th Cir.), *reh’g denied* and opinion amended, 789 F.2d 1319 (9th Cir. 1986), *aff’d sub nom.*  *San Francisco Arts and Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987).

207 *Id.* at 987-88. On appeal of the district court decision, the Ninth Circuit panel ordered the gay organization to pay the Committee’s attorneys fees. See  *Olympic Comm.*, 781 F.2d at 738.



208 See, e.g., *The Pink Panther* (United Artists 1964); *The Pink Panther Strikes Again* (United Artists 1976); *The Curse of the Pink Panther* (United Artists 1983).

209 See Constance L. Hays, *Gay Patrol and MGM in a Battle over Name*, N.Y. Times, May 27, 1991, at L21.

210 Much has been written about the case. See, e.g., *Sunder*, *supra* note 2, at 158-60. The discussion here is strictly about how the facts of the case relate to the enough and as good condition.

211 36 U.S.C. § 308 (1994).

212 *Id.*

- <sup>213</sup> See  *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 568 n.32 (1987) (Brennan, J., dissenting).
- <sup>214</sup> See Coombe, *supra* note 7, at 1876 (highlighting the irony of an exclusive all-male club's use of the name "Olympic").
- <sup>215</sup> See, e.g., A Super, Special Volunteer Has Healthy Outlook on Life, *Times-Picayune* (New Orleans), Aug. 10, 1997, at E8 (discussing the Special Olympics in New Orleans schools). Before assuming that the U.S. Olympic Committee accepts these usages and objected--perhaps for prejudicial reasons-- against gays and lesbians using the word, it should be remembered that many uses of the word were grandfathered by the legislation and that the U.S. Olympic Committee has also moved against non-controversial, commercial uses of the word. See *O-M Bread, Inc. v. United States Olympic Comm.*, 65 F.3d 933, 935 (Fed. Cir. 1995) (preventing "Olympic" brand breads--grandfathered under the Amateur Sports Act--from expanding into "Olympic Kids" bakery products).
- <sup>216</sup> See Frank Morgan, Math Chat: Ping-Pong Balls and President's Names, *Christian Sci. Monitor*, Aug. 8, 1997, at 15 (discussing the 1997 Math Olympiads in Argentina); With Flying Colours, *Straits Times* (Singapore), Aug. 6, 1997, available in 1997 WL 12141155; 1997 WL 12141155 (discussing the 1997 Physics and Chemistry Olympiads in Sudbury and Montreal, Canada, respectively).
- <sup>217</sup> See, e.g., Hong Kong to Host Computer Olympiad in August, *Xinhua English Newswire*, July 30, 1997, available in 1997 WL 11190644; Hong Kong to Host Computer Olympiad in August, *Xinhua English Newswire*, July 30, 1997, available in 1997 WL 11190644 (discussing China's National Olympiad in Informatics); Local Milestones, *Virginian-Pilot* (Norfolk), Aug. 1, 1997, at B2, available in 1997 WL 1245086; 1997 WL 1245086 (discussing Pittsburgh's 1997 "National Afro-Academic, Cultural, Technological, and Scientific Olympics" for high school students).
- <sup>218</sup> If "Olympics" had been a trademark instead of property created by a private law, the name "Olympics" might have fallen prey to the doctrine of "genericness." Trademark law distinguishes between words in trademarks which cannot be protected because they are only descriptive and words in names which cannot be protected because they are generic. See, e.g.,  *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59

F.3d 902, 909-10 (9th Cir. 1995) (finding “self-realization” to be too generic to trademark).

<sup>219</sup> Joann Loviglio, *Cambodian Teen Trains in R.I., Away from Country’s Chaos*, Assoc. Press, Aug. 4, 1997.


<sup>220</sup> 144 Cong. Rec. S12,800-01, (daily ed. Oct. 21, 1998) (statement of Sen. Gorton) (noting that “[v]ital geographic features that dominate and define the State of Washington, Mount Olympus in the Olympic Mountain range, within the Olympic National Forest on the massive Olympic Peninsula, were named long before Congress chartered the USOC” and chastising the USOC for an “attitude” toward small Washington businesses using the name “Olympic” that “demand[ed] correction”).


<sup>221</sup> See *supra* notes 208-09 and accompanying text.

<sup>222</sup> There is another, subtle difference between the two examples. The organizers of the Gay Games wanted to use “Olympics” for the meaning and references which were the core purpose of Congress granting a property right to one group. The organizers of the gay civic patrol probably wanted to use “Pink Panther” not only because of its reference to the Inspector Clouseau movies-- which suggests crime-stopping, but not great seriousness--but also for the referential cocktail of “Black Panthers” and “Gray Panthers” (civic activist groups) with the gay and lesbian associations of the color pink. In other words, “Pink Panthers” might have been a desirable choice even if the films had never existed.


<sup>223</sup>  515 U.S. 557 (1995).

<sup>224</sup>  491 U.S. 397 (1989).

<sup>225</sup>  *Hurley*, 515 U.S. at 566 (holding that requiring the admittance of a parade group “expressing a message not of the organizers’ own choosing” would violate the First Amendment).

<sup>226</sup>  *Johnson*, 491 U.S. at 420 (holding that a state’s interest in “preserving the flag as a symbol of nationhood and national unity [does not] justify ... [a] criminal conviction”).



227  Hurley, 515 U.S. at 563.

228 Id.

229 Id. at 568.

230 Id. at 572-73 (citations omitted).


231 Id. at 573.

232 Sunder, supra note 2, at 149-51.


233 Id. at 149.

234 Id. at 150.

235 Id. at 151.

236 In years past, the KKK, along with an anti-busing group, had also been refused access to the Boston St. Patrick's Day Parade.  Hurley, 515 U.S. at 562.

237 Sunder, supra note 2, at 171; see also Wendy Bounds, Can Aging Playboy Bunny Lure Women?, Wall St. J., Nov. 10, 1998, at B1 (reporting that Gloria Steinem worked as a Playboy bunny in a nightclub to gather information on working conditions).

238 At the same time, the person willing to exclude GLIB from the Boston parade may have to distinguish why they would permit Nazis to march in Skokie, Illinois. See  Collin v. Smith, 578 F.2d 1197 (7th Cir. 1978) (invalidating ordinances enacted to prevent a Nazi rally in Skokie, a predominantly Jewish suburb of Chicago); Rob Warden, Nazi Wins, May Cancel Skokie March, Wash. Post, June 21, 1978, at A3. The distinction most readily


available is that the parade is a form of speech, while the streets of Skokie are a receptacle--a forum--for speech. As with any distinction, we can find intermediary cases. A “jazz festival” may be more like a thematic parade; a “state fair” may be more like a public street.

239 Sunder, *supra* note 2, at 171.

240 See, e.g., Austin, *supra* note 11, at 8; Searle, *supra* note 11, at 16. Similarly, Sunder writes that “[a] property-like conception of the First Amendment ... does not allow for th[e] evolution of ideas,” Sunder, *supra* note 2, at 168, and that “a property conception of speech condones removing ideas from dialogue,” *id.* at 169. This conflates ideas and expressions, destroying a useful distinction, not just in intellectual property law, but also in linguistics and philosophy. A property conception does not “condone [ ] removing” expressions from the social dialogue, it condones making expressions the basic unit of the social dialogue.

241 Sunder, *supra* note 2, at 149.

242 See *id.* at 151-53.

243  Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, 515 U.S. 557, 577-78 (1995).

244 See Matthew Brelis, Coalition Pushes Right on Left Bank of Charles, *Boston Globe*, Dec. 5, 1995, at 25 (observing that Cambridge “held a St. Patrick’s Day Parade that welcomed members of the gay community”); Robin Vaughan, The Doyenne of Drag, *Boston Herald*, Mar. 1, 1996, at S14 (linking the organization of the Cambridge parade to the South Boston parade’s ban on gays).

245 See Joseph Mallia, Cambridge Kicks Off St. Pat’s Fun, *Boston Herald*, Mar. 17, 1996, at 22 (praising the peaceful nature of the Cambridge parade compared to the violent South Boston parades of recent years, and noting the Mayor’s decision not to participate in the South Boston function); Carolyn Ryan, Irish Eyes on Southie, *Patriot-Ledger* (Quincy, Mass.), Mar. 16, 1996, at 1 (citing the lack of participation by any statewide elected officials in the 1996 South Boston parade as evidence that the recent controversy will have

lasting effects on the near-century-old event).

246 🚩 Texas v. Johnson, 491 U.S. 397, 402 (1989).

247 🚩 Id. at 417.

248 Perhaps Justice Brennan was not thinking of intellectual property law when he penned this line; even considering those laws, one may still believe that the wide variety of First Amendment exemptions from intellectual property protection endorse this comment. See *supra* notes 114-32 and accompanying text.

249 🚩 Johnson, 491 U.S. at 410.

250 🚩 Id. at 413 (emphasis in original).

251 But for First Amendment jurisprudence, the other critical distinction between the two cases remains that *Hurley* involved a cultural object--a parade--deemed to be under private control, while *Johnson* involved a cultural object--the flag--under no one's control except the government's. *Hurley* might have produced a different result if the parade had been, as it was until 1947, a civic event run by the city government. See 🚩 *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, 515 U.S. 557, 560 (1995).

252 🚩 Johnson, 491 U.S. at 405.


253 🚩 Id. at 421 (Kennedy, J., concurring).

254 🚩 Id. at 405 (quoting 🚩 *Smith v. Goguen*, 415 U.S. 566, 604 (1974) (Rehnquist, J., dissenting)).

255 Id. at 429 (Rehnquist, J., dissenting).

256 Id. at 416 n.11.

257 See supra notes 169-80 and accompanying text.


258  Johnson, 491 U.S. at 418-19.

259 These are “cultural objects,” but it should also be remembered that intellectual property law puts words and phrases--which might be too ubiquitous to count as single cultural artifacts--beyond propertization. For example, trademark registration is regularly denied to phrases like “Handkerchiefs of the Year” or “BEST BEER IN AMERICA” because “such phrases or terms cannot be exclusively appropriated by a single manufacturer of those goods.” In re Boston Beer Co., 47 U.S.P.Q.2d (BNA) 1914, 1920 (T.T.A.B. 1998); see also Paul Farhi, Court Opens Up Use of “You Have Mail,” Wash. Post, Jan. 5, 1999, at C1 (describing how a court allowed AT&T to use the phrase “you got mail” in its email program over the objections of AOL who has used the phrase for over ten years).

260 A new lawsuit raises this issue regarding the phrase “Arbor Day”: the holiday is widely celebrated but the phrase itself is trademarked to the National Arbor Day Foundation, which has tried to prevent at least one ecology group from using the phrase. See Matt Kelley, Morton Offspring Files Petition Against Arbor Day Foundation, Omaha World-Herald, Oct. 1, 1997, at 2. Elsewhere, I have argued that this might be what happens when a trademarked work loses its protection through the doctrine of “genericness.” If there is no other word for an insulated, sealed, portable container for hot liquids, then perhaps “Thermos” should not be propertized. See Hughes, Philosophy, supra note 2, at 322; see also supra note 218.

261 See, e.g., Barton Gellman, “This Experience Changed my Life”: At Maccabiah Games, U.S. Athletes Expand Field of Vision, Wash. Post, July 28, 1997, at D1 (reporting how, since 1932, Jewish teams from around the world have gathered in Tel Aviv to compete in games to commemorate a band of second-century B.C.E. Jews who fought the Syrians).




262 See Tushnet, supra note 16, at 684-85 (explaining that proponents of “fan fiction” become frustrated when copyright law is used to suppress their form of creativity).


263  49 F.3d 807 (1st Cir. 1995), aff’d, 516 U.S. 233 (1996).


264  *Id.* at 819 (Boudin, J., concurring).

265 See Sunder, *supra* note 2, at 143-48.


266 “A satire is an original work, the essential feature of which is the use of humor to point out the weaknesses of or otherwise comment upon an identifiable, previously created work.” Michael C. Albin, Comment, Beyond Fair Use: Putting Satire in Its Proper Place, 33 *UCLA L. Rev.* 518, 544 (1985) (emphasis in original); see also Lemley, *supra* note 22, at 1037 (noting that a parody must build upon a prior work). Perhaps only literary criticism has an equally fundamental need to make express references to pre-existing works.

267  *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 544 (2d Cir. 1964) (quoting  *Columbia Pictures Corp. v. National Broad. Co.*, 137 F. Supp. 348, 354 (S.D. Cal. 1955)). The Ninth Circuit first adopted this standard in  *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 757 (9th Cir. 1978). For other cases developing this standard, see *infra* note 278.

268  623 F.2d 252 (2d Cir. 1980).








269  *Id.* at 253 n.1.

270 *Id.*

271  *Fisher v. Dees*, 794 F.2d 432, 439 (9th Cir. 1986); see also 4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.05[C][1], at 13-213 (1998) (concluding that the Fisher standard “brings the Ninth Circuit roughly in conformity with the Second Circuit, extend[ing] the ‘conjure up’ test to embrace, at least in an appropriate case, a high degree of similarity, that nonetheless falls short of wholesale appropriation”).

272 See Randall B. Hicks, *Requiem for a Parody*, 8 *Hastings J. Comm. & Ent. L.* 55, 57 (1985).

- 273 389 F. Supp. 1397 (S.D.N.Y. 1975).
- 274 ☐ 425 F. Supp. 443 (S.D.N.Y. 1976).
- 275 ☐ 600 F.2d 1184 (5th Cir. 1979).
- 276 ☐ 623 F.2d 252 (2d Cir. 1980).
- 277 ☐ 720 F.2d 231 (2d Cir. 1983).
- 278 ☐ 329 F.2d 541 (2d Cir. 1964). This case involved a parody by Mad Magazine of songs by Irving Berlin. The court denied relief on the grounds that Mad’s use differed significantly from the original in “theme, content and style.” ☐ Id. at 545. A similar descriptive dichotomy occurs with the parody exception in trademark infringement cases. Compare ☐ Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 506 (2d Cir. 1996) (permitting a “SPA’AM King of the Wild Boars” Muppet as parody of SPAM meat products), with ☐ Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 1032, 1041 (N.D. Ga. 1986) (granting the “Cabbage Patch Kids” mark owner a preliminary injunction against a use of the mark “Garbage Pail Kids,” which “derisively depict[s] dolls with features similar to Cabbage Patch Kids dolls in rude, violent and noxious settings”), and ☐ Pillsbury Co. v. Milky Way Prods., Inc., 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (finding that the use of the Pillsbury Doughboy in lewd poses violated Georgia’s antidilution statute).
- 279 This distinction in the caselaw probably shadows an immeasurable distinction: what kinds of parodies and satires give rise to litigation and what kinds do not. We could conjecture that parodies that are more offensive to the original work owner or creator tend to give rise to litigation more often than less offensive parodies. But other factors also affect a copyright owner’s decision to sue a parodist, including how widely the parody has been disseminated and whether the parodist is susceptible to threats of litigation. But some decisions to sue parodists do not seem to fit any of these criteria. See e.g., Greg Burk, *Space Suit: Star Trek: Parody or Galactic Menace?*, L.A. Weekly, June 7, 1996, at 33 (discussing Paramount Studios’s surprising decision to sue a small theatrical Star Trek parody despite having ignored parodies in Mad magazine and on Saturday Night Live and In Living Color).


- 280 See supra notes 45-46 and accompanying text.
- 281 See  *Walt Disney v. Air Pirates*, 581 F.2d 751, 757-58 (9th Cir. 1978); *Walt Disney Prods. v. Mature Pictures Corp.*, 389 F. Supp. 1397, 1398 (S.D.N.Y. 1975).
- 282 Subeil Joseph Totah, Comment, In Defense of Parody, 17 *Golden Gate U. L. Rev.* 57, 74 (1987); see also 4 Nimmer & Nimmer, supra note 271, § 13.05[C][[1], at 13-208 (1998) (“[T]he function of the copyrighted work is not undermined by parody, as the owner will typically not exploit the potential market for skewering his own property.”).
- 283 “In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include ... (4) the effect of the use upon the potential market for value of the copyrighted work.” 17 U.S.C. § 107(4) (1994).
- 284 See  *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1188 (5th Cir. 1979).
- 285 Hicks, supra note 272, at 73; see also Note, The Parody Defense to Copyright Infringement: Productive Fair Use After *Betamax*, 97 *Harv. L. Rev.* 1395, 1411 (1984) (writing that parodies play an important artistic function and deserve protection even though they do economic damage to the original work).
- 286  *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992). Similarly, in  *United Features Syndicate, Inc. v. Koons*, 817 F. Supp. 370 (S.D.N.Y. 1993), Koons testified that he was not even conscious of the source of the Odie image,  *id.* at 384, sealing shut the possibility that he was making a parody of the Odie character and its social meaning. See also  *MCA, Inc. v. Wilson*, 677 F.2d 180, 185 (2d Cir. 1981) (stressing the importance of at least a relationship between the parody and the copyrighted work).
- 287  *Elsmere Music Inc. v. National Broad. Co.*, 482 F. Supp. 741, 747 (1980).
- 288 This issue--how small a group will count for our social planning-- is a common problem in theories about “just” distribution of social goods like education or health care. For example, John Rawls’s seminal *A Theory of Justice* argues that these social goods must be

distributed with the interests of the “worst off” or “least advantaged” group in mind, that is, the poorest class in the society. But the question is, how large a “worst-off” group counts for our social planning? A million people? Ten thousand people? See Pogge, *supra* note 199, at 203-05 (exploring the issue of the minimum theoretical size of the “least advantaged” group); John Rawls, *A Theory of Justice* 98 (1971) (“The serious difficulty is how to define the least fortunate group.”).

So, too, policies adopted to preserve the enough and as good condition will depend on how large a group must be to be deprived of enough and as good to trigger the curtailing of property rights. The group could be defined to be as large as half the society or as small as a particular social position. See Rawls, *supra*, at 98; see also Pogge, *supra* note 199, at 204, 203-07 (noting that “[t]here is surely some arbitrariness in stipulating the size of [the] least advantaged group in advance” and suggesting that one seek out a “reasonably homogenous” least advantaged group under different social arrangements); Robert Paul Wolff, *Understanding Rawls* 27 (1977) (questioning whether focus on the least advantaged group would be on “the working class as a whole, or on unskilled workers, or on black, unskilled women, or whatever”).

289  425 U.S. 748 (1976).

290  *Id.* at 763.

291  274 U.S. 357, 372 (1927) (Brandeis, J., concurring).

292 Robert H. Bork, *Neutral Principles and Some First Amendment Problems*, 47 *Ind. L.J.* 1, 25 (1971) (recounting Brandeis’s assertion that free speech is necessary for the “spread of political truth,” for avoiding repression and instability, and for promoting happiness in society).

293 Sadjic, *supra* note 137, at 20.

294 Milan Kundera, *Slowness* 51 (Linda Asher trans., Harper Collins Publishers 1996) (1995).

295 Margaret Mitchell, *Gone with the Wind* (1936); *Gone with the Wind* (Metro-Goldwyn-Mayer 1939).



- <sup>296</sup> Alexandra Ripley, *Scarlett: The Sequel to Margaret Mitchell's Gone with the Wind* (1992); *Scarlett* (Hallmark Home Entertainment 1994). One critic noted that “[c]ompared with the movie classic ‘Gone With the Wind,’ to which it is nominally a sequel, ‘Scarlett’ is a pitiful joke ....” Tom Shales, “‘Scarlett’: Can CBS Sweep Up?”, *Wash. Post*, Nov. 13, 1994, at G1.
- <sup>297</sup> Frank Herbert, *Dune* (1965).
- <sup>298</sup> *Dune* (Universal Pictures 1984).
- <sup>299</sup> As Judge Kozinski noted, “Batman and Superman ... have changed: they’re not the same Batman and Superman I was reading about in 1964. I’m kind of sorry, because I liked the old Batman ....” Kozinski, *supra* note 133, at 469.
- <sup>300</sup> This may even describe baseball fans’ asserting rights in the name “Yankees” in order to stop the team from leaving the Bronx. See *Eternal Vigilance Soc’y v. Steinbrenner*, 45 U.S.P.Q.2d (BNA) 1637, 1638 (S.D.N.Y. 1997).
- <sup>301</sup> Tushnet, *supra* note 16, at 657. Tushnet, however, was discussing “fan fiction,” which may either stabilize or destabilize a cultural object’s meaning.
- <sup>302</sup> Objects include celebrity images and architectural landmarks, see *supra* note 174 (discussing controversial additions to famous art museums).
- <sup>303</sup> For example, although the original black-and-white version of *Casablanca* is still available, broadcasts generally use the colorized version.
- <sup>304</sup> See, e.g., Richard Cohen, *His Reputation Lives On: How Can We Say that Someone Like Tom Dewey Is Dead?*, *Wash. Post*, Oct. 16, 1997, at A19 (debating whether the film *Hoodlum*’s fictional version of Dewey caused harm to his relatives and fans). An example of this reliance is the controversy that surrounded Disney’s movie *Rudyard Kipling’s Jungle Book*, which added a variety of characters and plotlines absent from the original Kipling work. See David Armstrong, *Kipling? Get Me Rewrite*, *S.F. Examiner*, Dec. 23, 1994, at D3 (judging the film to be “absolutely faithful” to the original “[o]ther than

changing just about everything”); Robert F. Moss, *Mowgli We Know, But Who Are Major Boone and Kitty?*, N.Y. Times, Dec. 25, 1994, at B28 (advising that “Kipling purists should note the caveat in the opening credits of the new film: ‘Based on characters created by Rudyard Kipling’ ”); Robert F. Moss, *New “Jungle Book” Leaves Kipling Behind*, Int’l Herald Trib., Dec. 23, 1994, at 20 (discussing the “liberties” taken in the film that merely “incorporated some of the original into [its] script”); Henry Sheehan, “Jungle Book” Not Faithful, but Fun, Orange County Reg., Dec. 23, 1994, at 22 (“Kipling’s imperialism has been excised from the movie, which is a bit akin to shaving Santa Claus’ beard; at the very least it makes him awfully hard to recognize and may destroy his personality entirely.”); Ron Weiskind, *Bungle in the “Jungle,”* Pittsburgh Post-Gazette, Dec. 23, 1994, at 8 (Weekend Magazine) (questioning why, if the director believed that film makers “were free to invent some entirely new directions,” the movie should still be called “Rudyard Kipling’s The Jungle Book”).

305 See generally Singer, *supra* note 15.

306 No. C-89-0873-WDK (C.D. Cal. 1989) (granting order for preliminary injunction).






307 See Don J. DeBenedictis, *Photo Realism: Judge Requires Truth in Labeling for Ansel Adams Copies*, A.B.A. J., Oct. 1989, at 37.

308 See *id.*






309 *Id.*

310 See, e.g., Peter Marsh & Peter Collett, *Driving Passion*, Psychol. Today, June 1987, at 21-22 (discussing how drivers use bug deflectors, vanity plates, car phones, and other accessories to individualize their cars); Editorial, ... *Smart Road in the Future*, Wash. Post, July 28, 1997, at A18 (observing that driving “is a part of people’s personality .... The current automotive trend-- immense truck/sport/utility vehicles whose power, size and rock-climbing capabilities have no relation whatever to the needs of the urban families inside them--testify to the continuing role of cars as vehicles of self-expression, not to mention self-aggrandizement”).








311 For a description of dilution, see *infra* subpart IV(C).









- 312  Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368, 387 (5th Cir. 1977).
- 313  Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 157 (1989) (emphasis in original). The Bonito Court held that patent law preempted a state design-protection law that impeded copying of nonpatented inventions. See  id. at 168.
- 314 Id.; see also  Stanfield v. Osborne Indus., Inc., 52 F.3d 867, 873 (10th Cir. 1995) (finding that the plaintiff abandoned its mark by granting a “naked” license that lacked quality controls).
- 315 These are “certification marks” which are “indications of regional origin.” 15 U.S.C. § 1054 (1994).
- 316 See  Idaho Potato Comm’n v. Russet Valley Produce, Inc. (In re Russet Valley Produce, Inc.), 904 P.2d 566, 567 (Idaho 1995) (punishing a licensee for improperly shipping “non-Russet Burbank potatoes” with the “Idaho” label). This case concerns a certification mark, which is, in many respects, the U.S. analog to an appellation contrôlée--a word used to guarantee origin from a particular geographic area. See Peter Brownlow, Cadbury Barred from Using ‘Swiss Chalet’ For Chocolate, 11 World Intell. Prop. Rep. 408, 408-09 (1997) (describing the English case Chocosuisse Union des Fabricants Suisses de Chocolat v. Cadbury Ltd., [1998] R.P.C. 117 (ch. 1997), which barred Cadbury from marketing a “Swiss Chalet” chocolate bar because Cadbury may not pass off its chocolate under the Swiss appellation contrôlée). But in the Idaho Potato case, the plaintiff used survey evidence to establish that the name has a widely-known meaning which is contrary to the common geographic meaning. See Idaho Potato, 904 P.2d at 367.
- 317 Leventhal v. Ollie Morris Equip. Corp., 7 Cal. Rptr. 911, 914 (Dist. Ct. App. 1960).
- 318 Id. at 559.
- 319 Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, § 2, art. 21, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 33

I.L.M. 1197 (1994).

- 320 According to Landes and Posner, “trademark law...can best be explained on the hypothesis that the law is trying to promote economic efficiency.” William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 *Trademark Rep.* 267, 267 (1988).
- 321 See Siegrun D. Kane, *Trademark Law: A Practitioner’s Guide* § 7, at 7-1 (3d ed. 1997) (“Likelihood of confusion is the central inquiry in a trademark infringement case under the Lanham Act or common law.”); 1 Jerome Gilson, *Trademark Protection and Practice* § 103[8][a], at 1-39 (1998) (noting that “[m]odern consumer-minded courts have gone to great lengths to base their decisions in part on the ground that the public has a right to be free from confusion” and that this interest is “coextensive” with the trademark owner’s private right to enforce his or her mark).
- 322  *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 275 (7th Cir. 1976); see also 3 Rudolph Callmann, *The Law of Unfair Competition, Trademarks and Monopolies* § 17:13, at 57 (4th ed. 1983) (describing how a trademark infringement involves equally the interests of the parties and the consuming public).
- 323 The costs of enforcing the trademark’s meaning may be borne entirely by the “users” of the trademark (as production costs), except that some corporations may use revenues from some products to support other products, e.g., Proctor & Gamble may use profits from Crest toothpaste to enforce the meaning of a weaker trademark in its stable of household products. The author thanks Eleanor Meltzer for this thought.
- 324  *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978); accord  *Universal Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 115 (2d Cir. 1984); *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 36 U.S.P.Q.2d (BNA) 1812, 1816 (S.D.N.Y. 1995), *aff’d*, 73 F.3d 947 (2d Cir. 1996).
- 325 See  *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 382 (7th Cir. 1976). One treatise puts the test: “A consumer ordinarily is not able to compare trademarks side-by-side. Instead, he is apt to compare the defendant’s mark on a product on the supermarket shelf with ‘a not very definite or clear recollection as to the real [or plaintiff’s] trade-mark.’” ’ 2 Gilson, *supra* note 321, § 5.01[3], at 5-33 (quoting  *Northam-Warren Corp. v. Universal Cosmetic Co.*, 18 F.2d 774, 775 (7th Cir. 1927)

(emphasis and alteration in original)).

- 326  *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 75 (2d Cir. 1910). Trademark doctrine also bars “initial interest” confusion that lures consumers with a similar-looking trademark, even if the confusion is dispelled by the time the consumer actually purchases the good.  See *Rust Env’t & Infrastructure, Inc. v. Teunissen*, 131 F.3d 1210, 1215 (7th Cir. 1997) (noting that if a confusingly similar trademark is used, the user of the new mark may be required to take reasonable steps to prevent confusion of the two marks). It is interesting to consider whether this element of the doctrine principally protects consumers--by suppressing attempts to confuse initially--or trademark holders--because, if at the time of purchase, the consumer is no longer confused, the consumer is purchasing someone else’s goods willingly. On the other hand, at the point where the consumer is no longer confused, she may already have invested time and energy in the “wrong” choice.
- 327 *Pikle-Rite Co. v. Chicago Pickle Co.*, 171 F. Supp. 671, 676 (N.D. Ill. 1959).
- 328 See, e.g.,  *Toys “R” Us Inc. v. Abir*, 45 U.S.P.Q.2d (BNA) 1944, 1948 (S.D.N.Y. 1997) (enjoining a “TOYSAREUS.COM” site because “it is doubtful that children or parents shopping the Internet for toys are sophisticated buyers”);  *In re Digirad Corp.*, 45 U.S.P.Q.2d (BNA) 1841, 1845 (T.T.A.B. 1998) (finding that the gamma radiation sensors used for a medical isotope tracing were not similar enough to an electronic digital x-ray system to bar the registration of a trademark because of the difference in producers of these products and the sophistication of purchasers when buying such products). This aspect of the likelihood of confusion test creates problems when the specific consumers are young children. See *Lyon Partnership L.P. v. Giannoulas*, 48 U.S.P.Q.2d (BNA) 1759, 1764 (N.D. Tex. 1998) (finding that a “Barney” parody at a sporting event was not confusing because “the fact that small children, incapable of reasoning, may have been confused by the...act, does not amount to actual confusion”); Brooke A. Masters, *Protecting Barney’s Image from Bogus Beasts*, *Wash. Post*, Mar. 25, 1998, at B1 (recognizing that the important legal inquiry is not whether the parody was intended to represent Barney, but rather whether the public will be confused by the costume).
- 329 See, e.g.,  *Morgenstern Chem. Co. v. G.D. Searle & Co.*, 253 F.2d 390, 394 (3d Cir. 1958) (finding that the name “Mictine” for diuretic tablets is likely to be confused with the name “Micturin” for a urinary tract infection treatment);  *McNeilab, Inc. v. American Home Prods. Corp.*, 675 F. Supp. 819, 826 (S.D.N.Y. 1987), *aff’d*,  848 F.2d 34 (2d Cir. 1988) (explaining that irreparable harm is presumed if misleading advertising claims create a danger to public health).

- 330 See, e.g.,  *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992). Note, however, that context is important: “International Business Machines” as a trademark for brassieres might be viewed as an “arbitrary” mark with, perhaps, an element of double entendre. The author thanks Eleanor Meltzer for this example.
- 331  *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 851 n.11 (1982). As one commentator has noted, “[t]he prime element of secondary meaning is a mental association in buyers’ minds between the alleged mark and a single source of the product.” 2 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 15.02[1] (3d ed. 1992) (emphasis in original).
- 332 See, e.g.,  *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246, 253 (5th Cir. 1997), cert. denied, 118 S. Ct. 1795 (1998); see also  *Two Pesos*, 505 U.S. at 770; *Walt Disney Prods. v. Mature Pictures Corp.*, 389 F. Supp. 1397, 1398 (S.D.N.Y. 1975).
- 333 See 3 Gilson, *supra* note 321, § 8.11, at 8-210 to-211. It can be argued, however, that the use of survey data tends to set a higher bar than “likelihood” of confusion, forcing the trademark owner to show some degree of actual confusion--even if only actual confusion engendered by the survey itself.
- 334 Surveys must be done with generally accepted sampling and polling methods. See *id.* at 8-219 to-235 (discussing the factors that courts consider in determining the weight to attribute to a survey); see also  *Berkshire Fashions, Inc. v. Sara Lee Corp.*, 725 F. Supp. 790, 797 (S.D.N.Y. 1989), *aff’d*, 904 F.2d 33 (2d Cir. 1990) (accepting the “classic ‘mall intercept’ technique” as sound survey methodology).
- 335 See, e.g.,  *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 400-01 (8th Cir. 1987) (finding likelihood of confusion based on a survey showing that when shown the “Mutant of Omaha” T-shirt, 42% of respondents were reminded of the trademark, and 25% of those (10.5% of the original sample) assumed that the trademark owner went along with the infringing T-shirt);  *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980) (“In an opinion survey, a response by approximately 25% of the panel that two products were made by the same company was sufficient to support an inference of likelihood of confusion.”);  *RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1061 (2d Cir. 1979) (holding that a 15% to 20% rate of confusion supported a finding of infringement);


James Burrough Ltd. v. Sign of the Beefeater, Inc., 540 F.2d 266, 278 (7th Cir. 1976) (finding infringement based on survey results showing confusion among 15% to 22.5% of consumers); Berkshire Fashions, 725 F. Supp. at 798 (finding infringement based on a showing that 28% of respondents were confused); James Burrough Ltd. v. Leshner, 309 F. Supp. 1154, 1159 (S.D. Ind. 1969) (accepting a showing of confusion among 12% of shoppers as proof of infringement); Humble Oil & Ref. Co. v. American Oil Co., 259 F. Supp. 559, 564 (E.D. Mo. 1966) (noting, in response to four surveys showing confusion among 18% to 44.9% of consumers, that “[w]hatever the precise percentage of confusion ... there is still too much”), *aff’d*, 405 F.2d 803 (8th Cir. 1969); Seven-Up Co. v. Green Mill Beverage Co., 191 F. Supp. 32, 36 (N.D. Ill. 1961) (basing infringement on a showing of 25% confusion).


On the other hand, once the survey evidence shows confusion dipping into single digits, courts tend to hold that this evidence weighs against a finding of confusion. See *Henri’s Food Prods. Co. v. Kraft, Inc.*, 717 F.2d 352, 358 (7th Cir. 1983) (treating a survey finding confusion among 7.6% consumers as evidence against finding infringement); *S.S. Kresge Co. v. United Factory Outlet, Inc.*, 598 F.2d 694, 697 (1st Cir. 1979) (finding unconvincing a showing that 7.2% of consumers were confused); *Wuv’s Int’l, Inc. v. Love’s Enters., Inc.*, 208 U.S.P.Q. (BNA) 736, 756 (D. Colo. 1980) (holding that 9% confusion among consumers is a “questionable amount of confusion”).

336 In some cases, the percentage of survey confusion used to support an infringement finding has dipped even lower. In *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 365 F. Supp. 707 (S.D.N.Y. 1973), modified, 523 F.2d 1331 (2d Cir. 1975), the fact that 8.5% of the people surveyed confused “Steinway” and “Grotrian-Steinweg” was held as strong evidence of confusion, although this result was probably colored by the fact that an additional 7.7% perceived a business connection between the two companies. *Id.* at 716. When such evidence is not available, courts have relied on evidence that retail salespersons have been confused by similarity in two marks, on the rationale that such salespeople have greater knowledge about the products and are less likely to be confused than consumers. See 2 Gilson, *supra* note 321, § 5.01[3], at 5-34 to-35.

337 Among Carr’s products in the United States, their “Table Water Biscuits” and “Scottish All Butter Shortbread Biscuits” are both made in Great Britain, but Carr’s “Butter Cookies Topped with Dark Chocolate” are manufactured in Germany.

338 This is arguably the interpretation given the consumer confusion test in *Lever Bros. v. United States*, 981 F.2d 1330, 1338 (D.C. Cir. 1993) (noting that the affiliation of the

producers of foreign and domestic products does nothing to lessen consumer confusion when consumers are faced with physically different goods sold under the same trademark). Subsequent proposed Customs rules on grey market imports also seem to follow this interpretation. Grey market imports occur when a (1) trademark owner manufactures and markets-- or licenses to manufacture and market--her products in a foreign country, and (2) products made for that foreign market are imported back into the U.S., where they compete with the owner's domestically manufactured wares. See  *Quality King Distribs., Inc. v. L'Anza Research Int'l, Inc.*, 118 S. Ct. 1125, 1134 (1998). This occurs when the products manufactured abroad have a significantly lower price than the domestic goods. Domestic corporations try to use intellectual property laws as a means to ward off such "parallel" imports. See *id.* (holding that copyright protection of labels on hair care products could not be used to stop parallel imports).

In *Lever Bros.*, "Shield" deodorant soap and "Sunlight" dishwashing products legitimately manufactured by Lever U.K. were finding their way into the United States. Customs declined to restrict these imports because they were genuine goods manufactured by a company with the same owner as the United States trademark owner. Lever U.S. brought suit to compel Customs to deny entry to these goods on the grounds that differences between the foreign products and their domestic counterparts resulted in consumer confusion and deception about the origin and nature of the products. Both the trial court and appellate court ordered Customs to bar these imports because of the material differences. See  *Lever Bros.*, 981 F.2d at 1331.












In response, the Customs Service issued proposed rules that would allow the grey market imports when a label is applied to the product packaging near the trademark at issue: "This product is not the product authorized by the United States trademark owner for importation and is physically and materially different." *Importations Bearing Recorded Trademarks or Tradenames*, 63 Fed. Reg. 14663 (1998) (to be codified at 19 C.F.R. § 133.23(b)) (proposed Mar. 26, 1998). Customs believed that such a label would "qualify [ [ [ ] possible erroneous inferences regarding characteristics of the article that might be drawn by the consumer from the trademark alone," and that imports would be permitted "[w]here such a label is present to modify the message regarding product characteristics that ordinarily may be communicated by the trademark standing alone, so as to eliminate the likelihood of consumer confusion." *Id.* at 14667 (emphasis added).

339 389 F. Supp. 1397 (S.D.N.Y. 1975).


340 *Id.* at 398.

341 *Id.*





- 342  Chuck Blore & Don Richman, Inc. v. 20/20 Adver. Inc., 674 F. Supp. 671, 679 (D. Minn. 1987) (quoting  Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960) (Hand, J.)).
- 343 See Leon R. Yankwich, Originality in the Law of Intellectual Property, 11 F.R.D. 457, 468 (1951) (describing the “audience test” as “an ability to view the claims as to the conflicting works through the eyes of the average person”).
- 344 Berkic v. Crichton, 761 F.2d 1289, 1292 (9th Cir. 1985); see also  Kouf v. Walt Disney Pictures & Television, Inc., 16 F.3d 1042, 1045 (9th Cir. 1994) (citing Berkic for the proposition that the intrinsic text examines the beliefs of a reasonable audience).
- 345 Berkic, 761 F.2d at 1292.
- 346  Smith v. Jackson, 84 F.3d 1213, 1218 (9th Cir. 1996) (finding no similarity between the plaintiff’s songs and Michael Jackson’s songs).
- 347  Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 619 (7th Cir. 1982) (distinguishing video games from other types of artistic works); see also  20/20 Adver. Inc., 674 F. Supp. at 680 (distinguishing television commercials from various types of artistic works).
- 348  720 F.2d 231 (2d Cir. 1983).
- 349  Id. at 235.
- 350  Id. at 236-37.
- 351  Id. at 238.
- 352  Id. at 236.


353  Id. at 244.


354 In a mixed trademark and copyright case, introducing the issue of consumer confusion as an element of the trademark case is common. See, e.g.,  Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 1038 (N.D. Ga. 1986) (accepting survey evidence as proof of consumer association, especially among children, to show trademark infringement of the plaintiff’s “Cabbage Patch Kids” dolls by the defendant’s “Garbage Pail Kids” products).



355  Warner Bros., 720 F.2d at 244.

356 Id. The Court of Appeals also agreed that once the trial court had found that there was no substantial similarity between Hinkley and Superman as a matter of law, it was unnecessary to admit survey evidence showing that many lay observers thought Hinkley was similar to Superman.  Id. at 245.

357 The law adopts a cleaner position with respect to copyright and the right of publicity. For publicity rights, American courts have consistently found that the only person who can assert a claim that a living person’s name has been appropriated is that living person. See *Capetola v. Orlando*, 426 F. Supp. 616, 617-18 (E.D. Pa. 1977) (rejecting a claim to cancel the trademark “The Dawn” on the grounds that Dawn Robertson had not given her permission because the evidence showed that Dawn was actually allied with the trademark holder);  *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 U.S.P.Q.2d (BNA) 1192, 1194 (T.T.A.B. 1994) (refusing to allow a rival clothing manufacturer or anyone other than the Duca D’Aosta himself to seek cancellation of the “Duca D’Aosta” clothing label on the grounds that the Duca is a living person). Likewise, an entrepreneur who markets goods under the label “Uma Thurman” can only be challenged by Thurman herself, not by any of her fans.

The offered rationale is that the law tries to protect only “the privacy and property interests of persons whom the public will associate with a mark,”  *Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc.*, 989 F.2d 985, 990 (8th Cir. 1993), not any interests pertaining to non-owners.

358  806 F.2d 392 (2d Cir. 1986).




359  Id. at 395; see also  *Societe des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d


633, 640-41 (1st Cir. 1992) (explaining that the required showing is not that the product suffers in quality, but merely that there is a material difference likely to cause consumer confusion).

360 The newer, anti-dilution standard is discussed below. See *infra* subpart IV(C).

361 There is no question that we have other laws besides trademark which protect consumers' interests in stable messages about physical objects and services. These include laws which limit use of descriptive words to those fulfilling a particular certification--for example, "attorney-at-law." The purpose of these laws is to impose particular limits on the use of words in order to help people quickly sort out information. See, e.g., *Kathy McCabe, Many Are Cold, But Some Are Frozen*, *Boston Globe*, Nov. 24, 1998, at C1 (describing new United States Department of Agriculture regulations on the use of the word "fresh" on turkeys).










362 See *supra* notes 337-38 and accompanying text.

363  *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1288 (10th Cir. 1996); see also  *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 607 (1st Cir. 1988) (applying the "ordinary observer" standard by looking at the overall similarities rather than the minute differences);  *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982) (applying the "ordinary observer" and "taking material of substance and value" standards).

364 See, e.g.,  *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 624-25 (2d Cir. 1983) (holding that consumer confusion and direct competition are not necessary elements of an anti-dilution action); see also 3 *Callmann*, *supra* note 322, § 21.11, at 68 (applauding the increasing judicial application of dilution doctrine in a manner that is "not related to or limited to the test for confusion").

365 See  *Sally Gee*, 699 F.2d at 624-25.

366 1947 Mass. Acts 307 (codified at  *Mass. Gen. Laws ch. 110B, § 12* (1990)).

- 367 1961 N.Y. Laws 1813 (codified at  N.Y. Gen. Bus. Law § 368-d (McKinney 1996)).
- 368 Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 *Harv. L. Rev.* 813, 825 (1927).
- 369 Pub. L. No. 104-98, 109 Stat. 985, 986 (codified as amended at  15 U.S.C. §§ 1125, 1127 (Supp. II 1996)). Parties familiar with state anti-dilution statutes have been quick to use the new federal anti-dilution statute. See, e.g., *Polo Ralph Lauren L.P. v. Schuman*, 46 U.S.P.Q.2d (BNA) 1046 (S.D. Tex. 1998). For a thoughtful discussion of the need for careful application of the new law, see  *Viacom Inc. v. Ingram Enterprises, Inc.*, 141 F.3d 886, 891-92 (8th Cir. 1998) (cautioning that excessive use of the anti-dilution law could harm competition).
- 370 15 U.S.C. § 1127(c)(1) (Supp. II 1996).
- 371 *Id.* § 1127(c)(4).
- 372  604 F.2d 200 (2d Cir. 1979).
- 373  *Id.* at 204-05 (citations omitted).
- 374  *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 49 (2d Cir. 1978); see also  *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*, 369 N.E.2d 1162, 1165 (N.Y. 1977) (observing that anti-dilution laws were not designed to prevent consumer confusion, but were made to preserve the business reputation of the trademark holder).
- 375 860 F. Supp. 113 (S.D.N.Y.), *aff'd*,  41 F.3d 39 (2d Cir. 1994); see also *Deere & Co. v. MTD Prods., Inc.*, 34 U.S.P.Q.2d (BNA) 1706, 1711 (S.D.N.Y. 1995) (making the preliminary injunction permanent).
- 376 See  *Deere*, 41 F.3d at 41.

377 ☐ Deere, 41 F.3d at 45.

378 ☐ 642 F. Supp. 1031 (N.D. Ga. 1986).

379 ☐ Id. at 1039-40. While anti-dilution theoretically moves away from “consumer confusion,” it should be noted that confusion subtests have--not surprisingly--lurked back into the anti-dilution analysis. Thus, in concluding that the mark “Sally Lee” would not “blur” the “Sally Gee” women’s clothing mark, the court reasoned that “[s]ophisticated retailers and discerning consumers of women’s apparel are unlikely to have blurred vision causing them to see ‘Sally Gee’ upon viewing a ☐ Sally Lee label.” Sally Gee, Inc. v. Myra Hogan, Inc., 699 F.2d 621, 626 (2d Cir. 1983).

380 The requirement of anti-dilution statutes that the mark involved must be “famous” is generally understood to mean that the mark has acquired a heightened level of “secondary meaning” for the public. Thus, in ☐ Allied Maintenance Corp. v. Allied Mechanical Trades, Inc., 369 N.E.2d 1162 (N.Y. 1977), the mark “allied” was found not to have a strong secondary meaning for the public because there was widespread use of the mark, including 300 companies in the New York City directory alone. ☐ Id. at 1166.

381 See Kristine Boylan, *The Corporate Right of Publicity in Federal Trademark Dilution Legislation*, 88 Trademark Rep. 349 (1998) (arguing that “dilution is more like the right of publicity, in corporate form, than it is like traditional trademark infringement”).

382 The physical objects are still relevant to anti-dilution analysis. A trademark may be tarnished when it is “linked to products of shoddy quality” or where “the public will associate the lack of quality or lack of prestige in the defendant’s goods with the plaintiff’s unrelated goods,” ☐ Deere, 41 F.3d at 43, although it is not clear how this will happen unless the consumer is confused about where the defendant’s goods came from.

383 There is a vast literature on what kind of meaning or “signification” fashion produces, one of the points being that fashion has only nonrepresentational meaning. See, e.g., Jonathan Culler, *Barthes* 77, 76-77 (1983).

384 Sudjic, *supra* note 137, at 12.

- 385 In the meantime, designers may be vigilant in preventing lesser-priced lines from imitating their look. See, e.g., *Ralph Lauren Is Ordered to Pay Yves Saint Laurent*, *Wall St. J.*, May 19, 1994, at B2 (reporting a judgment against Lauren for marketing a \$1000 knock-off of Saint Laurent's \$25,000 black tuxedo dress designed in 1970).
- 386 See Hughes, *Personality*, *supra* note 2, at 81, 106-08 (concluding that there is an undeniable link "between creativity and personal experience"); Hughes, *Philosophy*, *supra* note 2, at 358-59 (asserting that property rights can protect the self-expression of individuals).
- 387 See Chon, *supra* note 7, at 271 (noting that copyright law recognizes a joint work only when each author intends that her "flame of genius" merge with others').
- 388 In addition to the reason sketched out above, one obvious problem is how and who would decide what the "original" meaning of a work was. This might not be a great concern if all derivative works were prohibited, but once any derivative works are permitted, there would have to be a mechanism to determine whether a derivative work was "faithful" to the original.
- 389 See Singer, *supra* note 15, at 743. "In Professor Radin's terms, the workers' interest is personal in the sense that their lives and identities may be bound up with the plant's continued operation. The workers have a far stronger moral claim to purchase the plant ... over a stranger." *Id.*
- 390 *Id.* at 725.
- 391 For an exploration of a contrary view, see Malkan, *supra* note 2, at 781-83. Malkan explores the possibility that the distinction between "privacy" and "publicity" rights may reflect a contrast between a modernist "essentialist view that personality is innate and immutable" and a postmodernist view that personality is "constructed" consisting in "impersonation, masquerade, and pastiche." *Id.* On the latter theory, Malkan proposes, "[i]f we bargain away one personality, there is nothing to stop us from generating a new one." *Id.* at 783.
- 392 This may not, however, be true of a case like *Eternal Vigilance Soc'y v. Steinbrenner*, 45

U.S.P.Q.2d (BNA) 1637 (S.D.N.Y. 1997), in which baseball fans sought a declaratory judgment that “the trademark, logo, style, accoutrements, of YANKEES equally belong to Bronx County and the City of New York” as a means of preventing the Yankees from “moving ... anywhere out of Bronx County.” Id. at 1638. This case looks much more like the plant closing cases, in which an entity that has demonstrated itself as concerned principally with profit would be required, under Singer’s proposal, to sell its interest to citizens who have a reliance interest in the property.

<sup>393</sup> Difficult because to some extent “personhood theories of property may legitimate the propertization of nothing more valuable to society than settled expectations .” Sunder, *supra* note 2, at 160.

<sup>394</sup> Singer, *supra* note 15, at 739.

<sup>395</sup> Patrick Baude, *High Technology, the Human Image, and Constitutional Value*, 18 *Ind. L. Rev.* 643, 652 (1985).

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