

Winter 2020

Balancing Mickey Mouse and the Mutant Copyright: To Copyright a Trademark or to Trademark a Copyright, That is the Question

Follow this and additional works at: <https://scholarship.law.marquette.edu/iplr>



Part of the [Constitutional Law Commons](#), and the [Intellectual Property Law Commons](#)

Recommended Citation

Michael A. Forella III, *Balancing Mickey Mouse and the Mutant Copyright: To Copyright a Trademark or to Trademark a Copyright, That is the Question*, 24 Marq. Intellectual Property L. Rev. 1 (2020).

This Article is brought to you for free and open access by the Journals at Marquette Law Scholarly Commons. It has been accepted for inclusion in Marquette Intellectual Property Law Review by an authorized editor of Marquette Law Scholarly Commons. For more information, please contact megan.obrien@marquette.edu.

BALANCING MICKEY MOUSE AND THE MUTANT COPYRIGHT: TO COPYRIGHT A TRADEMARK OR TO TRADEMARK A COPYRIGHT, THAT IS THE QUESTION

MICHAEL A. FORELLA III

I. INTRODUCTION	77
II. THE DIFFERENCES BETWEEN TRADEMARKS AND COPYRIGHTS	78
III. THE RULES FOR COPYRIGHTING TRADEMARKS AND THE ARGUMENTS IN FAVOR THEREOF.....	79
IV. WHY ARGUING THAT TRADEMARKS FAIL THE COPYRIGHT REQUIREMENT BECAUSE THEY LACK CREATIVITY IS A PROBLEM.....	82
V. THE ARGUMENTS AGAINST COPYRIGHTING TRADEMARKS.....	84
VI. TO TRADEMARK A COPYRIGHT, NOT COPYRIGHT A TRADEMARK, THAT IS THE RULE.....	90

I. INTRODUCTION

“Wolde ye bothe eate your cake, and haue your cake?” This proverbial saying dates to mediaeval times, first appearing in 1546.¹ Despite the dramatic change in language and spelling, the meaning of this phrase was never lost in translation. One cannot simultaneously eat one’s cake and retain possession of one’s cake. Both trademark owners and the Copyright Office want to have their cake and eat it too. Trademark owners are trying to register their trademarks as copyrights. The Copyright Office wants to deny such marks, but under a weak lack of a creativity argument. Allowing trademarks to be registered as copyrightable works violates the clear doctrines of the boundaries of protection available in each area of intellectual property law.

There is no direct rule from Congress or the Supreme Court that a logo or slogan cannot also be a copyrightable work. However, the necessary intellectual property law boundaries are in place for good reason and support the argument presented herein that a clearly demarcated line between copyright and trademark protection must also be drawn. That clear demarcation should

1. Ben Zimmer, *‘Have Your Cake and Eat It Too’*, NEW YORK TIMES MAGAZINE, (Feb. 18, 2011), <https://www.nytimes.com/2011/02/20/magazine/20FOB-onlanguage-t.html>.

be that an image originally created, exploited, and that functioned as a copyright may later meet trademark's requirements and therefore be eligible for concurrent trademark and copyright protection. However, a mark originally created, exploited, and that functioned as a trademark cannot receive copyright protection, concurrent or sequential, regardless of creativity. This is determined by the applicant declaring during their copyright application that the work seeking registration is not a designator of a source of goods under penalty of fraud on the Copyright Office.²

In Section I, this comment discusses the differences between trademarks and copyrights. In Section II, this comment analyzes the rules for copyrighting trademarks and the arguments in favor of copyrighting trademarks. In Section III, this comment addresses the problems of arguing that trademarks fail copyright requirements for a lack of creativity. In Section IV, this comment weighs the arguments against copyrighting trademarks. Section V concludes by proposing a bright line rule for either Congress or the courts to adopt to provide guidance that copyrighting a trademark is prohibited.

II. THE DIFFERENCES BETWEEN TRADEMARKS AND COPYRIGHTS

A trademark is “any word, name, symbol, or device, or any combination thereof” that is registered with the United States Patent and Trademark Office and is used in commerce “to identify and distinguish” the source of goods and services.³ To be trademarked, the mark must either be distinctive or attain secondary meaning through public association.⁴ Therefore, trademark law protects the source identifying function of goods and services. Contrarily, a copyright is an original work of authorship, such as a literary, musical, audiovisual, or pictorial work, that is fixed in a tangible medium of expression.⁵ Therefore, copyright protects the expressive content of works.

Copyright protection is granted by the Constitution's Intellectual Property Clause which grants Congress the authority “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors ... the exclusive Right to their [] Writings and Discoveries.”⁶ Copyright protection is designed to incentivize authors to create creative works. In 1879, the Court distinguished copyright and trademark protection when the Supreme Court

2. 17 U.S.C. § 411(b)(1) (2008); 17 U.S.C. § 506(e) (2008).

3. 15 U.S.C. § 1127 (2006).

4. *Id.*

5. 17 U.S.C. § 102 (1990).

6. U.S. CONST. art. I, § 8, cl. 8.

ruled that the Commerce Clause does not give Congress any power to regulate trademarks not used in commerce.⁷

In contrast, Trademark protection is granted by the Constitution's Commerce Clause which grants Congress the power "[t]o regulate Commerce ... among the several States"⁸ Trademark protection is designed to ensure consumers are informed as to the source of the goods they purchase.⁹ Moreover, for famous trademarks, protection encompasses the likelihood of harm caused by the blurring or tarnishing caused by a knock-off mark regardless of "likely confusion, [] competition, or [] actual economic injury."¹⁰ Copyright and trademark protection were created for different purposes and therefore have different protections and limitations. Thus, it is no surprise that the boundaries between the two have blurred.

III. THE RULES FOR COPYRIGHTING TRADEMARKS AND THE ARGUMENTS IN FAVOR THEREOF

What is required for something to be creative? The Compendium, the Copyright Office's administrative manual, Section 913.1 states "[a] visual art work that is used as a trademark, logo, or label may be registered if it satisfies 'the requisite qualifications for copyright.'"¹¹ The Copyright Act's enumerated categories of works of authorships is broad enough to cover most trademarks. Also, fixation is not a barrier for trademarks seeking copyright protection so long as the trademark has been drawn, recorded, or computer generated. Therefore, to copyright a trademark, copyright's originality requirement is the last element. Copyright's originality standard requires a minimally creative work that is not copied. However, creativity is never defined in the Copyright Act.¹² Given the difficulty in defining and recognizing creativity, over a century ago, Justice Oliver Wendell Holmes warned that "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."¹³ Therefore, today, copyright's creativity requirements remain minimal.

In *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, the Court ruled that a work need only an "extremely low" amount of creativity.¹⁴ In fact, *Feist* held that

7. In re Trade-Mark Cases, 100 U.S. 82, 95-96 (1879).

8. U.S. CONST. art. I, § 8, cl. 3.

9. 17 U.S.C. § 102 (2019).

10. 15 U.S.C. § 1125(c)(1).

11. *U.S. Copyright Office, Compendium of U.S. Copyright Practices* § 913.1 (3d. ed. 2017).

12. 17 U.S.C. § 101 (2010).

13. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

14. *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345 (1991).

“[t]he vast majority of works make [copyright] grade quite easily.”¹⁵ Moreover, elements of a work that are not copyrightable in themselves, may be copyrightable if arranged in an original way.¹⁶ Therefore, copyright’s creativity requirements are generally not a barrier for marks seeking copyright registration.

However, an arrangement of individually, not copyrightable elements cannot be “so commonplace that it has come to be expected,” such as listing something in alphabetical order.¹⁷ Moreover, the Compendium Section 906.01 reads “a work that merely consists of common geometric shapes [is not registrable] unless the author’s use of those shapes results in a work that, as a whole, is sufficiently creative.”¹⁸ There are examples in Section 906.01 of common geometric shapes arranged in an insufficiently creative manner.¹⁹ However, these examples are not insightful as these are clearly uncreative marks.²⁰ Additionally, Section 913.1, which states that trademarks may be copyrighted, further states that the Copyright Office “typically refuses to register trademarks, logos, or labels that consist of only ... [w]ording ... [m]ere spatial placement or format of trademark, logo, or label elements; [or] [u]ncopyrightable use of color, frames, borders, or differently sized font ... either standing alone or in combination.”²¹

Therefore, given the Compendium’s language, the Compendium’s creativity standards for trademarks and logos, especially those consisting of geometric shapes, (geometric trademarks) are much more difficult than the standard proscribed in *Feist*. Despite this inconsistency between the federal courts and the Copyright Office, trademarks owners have still been trying to register their trademarks with the Copyright Office. In trademark owners’ view, trademarks are original works of authorship fixed in a tangible medium of expression. Thus, trademarks should be copyrightable, especially if the counterargument is a lack of an extremely low amount of creativity. Moreover, proponents of copyrighting trademarks will likely point to the current overlap between copyright and trademark protection.

In 1934, the court found that the Frank Merriwell character “[was] closely identified in the public mind with the work of a particular author, [and was protectable] . . . even after the expiration of the copyright, unless adequate

15. *Id.*

16. 17 U.S.C. § 101 (defining a compilation).

17. *Feist*, 499 U.S. at 363.

18. *U.S. Copyright Office, Compendium of U.S. Copyright Practices* § 906.1 (3d. ed. 2017).

19. *Id.*

20. *Id.*

21. *Compendium* (Third) § 913.1.

explanation is given to guard against mistake.”²² In 1962, in *Planters Nut & Chocolate Co. v. Crown Nut Co.*, the Court of Customs and Patent Appeals declared that copyright and trademark protection is available for a fanciful picture of a humanized peanut used as a design mark to identify and distinguish the source of peanuts.²³

In *Frederick Warne & Co., Inc. v. Book Sales, Inc.*, the publisher of the “Peter Rabbit” books sued a competitor publishing versions of Peter Rabbit that were in the public domain, and thus, no longer protected by copyright law.²⁴ However, plaintiff brought trademark infringement claims for the cover illustrations and eight drawings of characters from the “Peter Rabbit” books.²⁵ Despite being sequential, rather than overlapping protection, the court held that “[t]he fact that a copyrightable character or design has fallen into the public domain should not preclude protection under the trademark laws so long as it is shown to have acquired independent trademark significance, identifying in some way the source or sponsorship of the goods.”²⁶

In *Lyons Partnership, L.P. v. Morris Costumes, Inc.*, the owners of the Barney character successfully brought copyright and trademark infringement claims against a costume rental company for renting “look-alike costumes that children allegedly believe are in fact Barney.”²⁷ Walt Disney is particularly aggressive in seeking concurrent copyright and trademark protection. For example, in *Walt Disney Co. v. Powell*, Disney brought copyright and trade dress claims against a vendor selling graphic depictions of Mickey Mouse.²⁸ In *Walt Disney Prods. v. Air Pirates*, regarding several Disney characters including Mickey Mouse, the court noted that Disney “devoted considerable effort and resources to developing a recognition of [Mickey Mouse], and exploiting its value in numerous ways.”²⁹

When Mickey Mouse was created as a cartoon and fixed in a tangible medium of expression, Mickey Mouse was copyrightable.³⁰ As time passed, Mickey Mouse became much more than a cartoon character. Mickey Mouse became a source identifying function. The public now associates Mickey Mouse’s likeness with Walt Disney, assuming his presence means Disney

22. *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196, 197 (S.D.N.Y. 1934).

23. *Planters Nut & Chocolate Company v. Crown Nut Company, Inc.*, 305 F.2d 916, (C.C.P.A 1962).

24. *Frederick Warne & Co., Inc. v. Book Sales Inc.*, 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979).

25. *Id.* at 1194.

26. *Id.* at 1196.

27. *Lyons Partnership, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 794 (4th Cir. 2001).

28. *Walt Disney Co. v. Powell*, 698 F. Supp. 10, 11 (D.D.C. 1988).

29. *Walt Disney Prods. v. Air Pirates*, 345 F. Supp. 108, 109 (N.D. Cal. 1972).

30. *Id.* at 113.

produced, sponsored, or approved any product Mickey Mouse appears on. Thus, Mickey Mouse earned trademark protection despite originally functioning as a copyright.³¹ Trademark owners, therefore, can argue that concurrent and sequential trademark and copyright protection exists. Further, the Copyright Office overstepped its authority by creating a more stringent creativity standard for geometric trademarks, violating the proscribed extremely low creativity threshold set forth in *Feist*.³²

IV. WHY ARGUING THAT TRADEMARKS FAIL THE COPYRIGHT REQUIREMENT BECAUSE THEY LACK CREATIVITY IS A PROBLEM

Another argument in favor of copyrighting trademarks is that the difference between the Copyright Office's creativity standard for geometric trademarks and *Feist's* extremely low standard has recently resulted in numerous controversial and inconsistent decisions by the Copyright Office. For example, the Copyright Office Review Board (CORB), the appellate body of the Copyright Office, denied copyright registration to the Union des Associations Européennes de Football's (UEFA) Starball logo for insufficient creativity.³³ The Starball is a two-dimensional artwork consisting of black curved stars and white polygons intended to appear as a three-dimensional soccer ball.³⁴

UEFA argued that while typical geometric shapes are not copyrightable, the stars and polygons used in their artwork were not typical because they are curved to appear as a soccer ball.³⁵ CORB cited Compendium Section 906.1, likening the Starball to white circles on a purple background.³⁶ CORB's higher creativity demands regarding trademarks and logos is clear in its refusal to register the UAC Triangle Design.³⁷ Here, the Copyright Office concluded that the selection and arrangement of geometric shapes lacked the sufficient creativity because they "[we]re not arranged in a way that creates a new, unfamiliar shape."³⁸ Surely, creating a new, unfamiliar shape would be creative, but is far from *Feist's* extremely low creativity threshold.

31. *Walt Disney Co.*, 698 F. Supp. at 12.

32. *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 363 (1991).

33. United States Copyright Office Review Board, Second Request for Reconsideration for Refusal to Register "The UEFA Champions League Starball Device"; Correspondence ID 1-2WP8WG4; SR 1-4149565625 (July 30, 2018).

34. *Id.* at 1.

35. *Id.* at 4.

36. *Id.*

37. United States Copyright Office Review Board, Second Request for Reconsideration for Refusal to Register UAC Triangle Design; 5 Correspondence ID: 1-25K4EEH; SR 1-3120971803 (Jan. 31, 2018).

38. *Id.* at 5.

Another clear example of the higher creativity demands regarding trademarks and logos is the Copyright Office's recent American Airlines rulings. American Airlines tried to register a red, white, and blue-colored logo that depicts the wings of an airplane and an eagle in flight.³⁹ American Airlines argued the logo was more than basic shapes because of its arrangement and abstraction of those shapes.⁴⁰ The Copyright Office ruled that the logo "falls below the threshold for creativity" because it is "comprised of basic geometric shapes."⁴¹ CORB characterized the logo as a "dual-colored, curved trapezoid with a bisecting, shaded and curved triangle" and that its "insignificant variations in shape [or] ... coloring... [do not] change [the work's] character; trapezoids, rectangles, and triangles are all basic geometric shapes."⁴² Based on CORB's own language, American Airline's logo combines creative, uncommon geometric shapes and certainly meets *Feist's* extremely low creativity thresholds.

After receiving "a higher-quality, larger-format image of the Work that depicted additional details," the Copyright Office reversed its decision and registered American Airline's logo.⁴³ In its decision, CORB stated that "[w]hen examining a work for copyrightable authorship, the Copyright Office evaluates only whether a work is sufficiently creative for copyright protection" and does "not consider the time and effort used in creating a design, its novelty, aesthetic appeal, or commercial value."⁴⁴ These are traditional factors in a trademark analysis. Ultimately, CORB granted American Airline's logo merely "thin" copyright protection "against only virtually identical copying" because the "quantum of originality is slight."⁴⁵

The problem with the Copyright Office's recent decisions is that these marks likely meet *Feist's* extremely low creativity threshold, thereby creating inconsistent rulings and tension with the federal courts. For example, cases before and after *Feist* have found that the combination of geometric shapes contain sufficient creativity and merit copyright protection.

In *Titlecraft Inc., v. NFL*, the court held that the National Football League's (NFL) trophy for its annual Super Bowl champion is copyrightable because

39. U.S. Copyright Office Review, Second Request for Reconsideration for Refusal to Register American Airlines Flight Symbol; Correspondence ID: 1-28H4ZFK; SR#: 1-3537494381 (Jan 8, 2018).

40. *Id.* at 4.

41. *Id.* at 4-5.

42. *Id.* at 4.

43. United States Copyright Office Review Board, Registration Decision Regarding American Airlines Flight Symbol; 5, 7, Correspondence ID 1-28H4ZFK; SR 1-3537494381 (Dec. 7, 2018).

44. *Id.* at 6.

45. *Id.* at 6 *citing* *Beaudin v. Ben and Jerry's Homemade, Inc.*, 95 F.3d 1, 2 (2d Cir. 1996).

“the combination of uncopyrightable elements in an original way renders the trophy appropriate for copyright protection.”⁴⁶ The court rejected the argument that the trophy was not copyrightable because it is merely a football on top of a base because “at some level of abstraction, all objects are combinations of geometric shapes; that does not mean they cannot be protected by copyright . . . it is the trophy’s *combination* of the base, with the football on top, at a certain angle, that is protectable. . . .”⁴⁷ The court likened the argument that the trophy consists only of common geometric shapes to the argument that “there can be no originality in a painting because all colors of paint have been used somewhere in the past.”⁴⁸ The different creativity standards applied by federal courts and the Copyright Office is problematic and must be realigned. Hopeful copyright registrants must be aware of the requirements of copyright and uniform decisions are vital to a fair copyright registration process.

V. THE ARGUMENTS AGAINST COPYRIGHTING TRADEMARKS

Although a geometric trademark may be sufficiently creative, this does not mean it should be copyrightable. The examples of concurrent or sequential copyright and trademark protection are limited to cartoon characters. As the court mentioned, “[d]ual protection under copyright and trademark laws is particularly appropriate for graphic representations of characters.”⁴⁹ The previously mentioned cartoon characters all met the copyright requirements—were originally created, were exploited, and functioned as copyrights—and then later met the trademark’s requirements. None of the previously mentioned cartoon characters were originally created, exploited, or functioned as trademarks that later sought copyright protection. As copyright and trademark protection overlap, they provide more protection than is necessary to satisfy the objectives of each protection.

Congress and the Supreme Court created boundaries for each form of intellectual property to limit overprotection. Providing more protection than is necessary harms the public, contrary to the purpose of intellectual property protection. For example, copyright protection is earned as soon as the creative, original mark is fixed in a tangible medium of expression, whereas a trademark must be used in interstate commerce.⁵⁰ Therefore, if a trademark owner can protect their mark under copyright law, they can warehouse the mark from the public, as copyright has no use in commerce requirement. Additionally, under

46. *Titlecraft, Inc. v. NFL*, 2010 U.S. Dist. LEXIS 134367, 1, 12-13 (2010).

47. *Id.*

48. *Id.* at 12-13 *citing* *Knitwaves, Inc. v. Lollytogs Ltd. Inc.*, 71 F.3d 996, 1003 (2d Cir. 1995).

49. *Frederick Warne & Co., Inc. v. Book Sales Inc.*, 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979).

50. 15 U.S.C. § 1127.

a copyright rather than trademark infringement claim, one need not prove likelihood of confusion, which is designed to protect the public.⁵¹

Also, any fair use defense typically available under copyright law would be eliminated as there is no fair use of another's trademark. Fair use is a foundational element of the societal bargain in copyright law that allows the public to make fair use of works for certain purposes despite being a copyrighted work.⁵² Moreover, copyrighting trademarks and thereby treating trademarks as expressive speech implicates significant First Amendment concerns. A trademark can prevent the speech of another if there is a likelihood of confusion. If one can trademark an expressive phrase that should be protected under copyright, one could prohibit another's speech through trademark law without any fair use defenses. As of 2017, it is more difficult to deny political, expressive phrases that are attempting to gain trademark protection, especially after the Court equivocated trademark and copyrights in the same case.⁵³

Furthermore, the expanded scope of what can be trademarked and copyright's expanded length of protection is concerning. In 1998, copyright protection was extended through the Copyright Term Extension Act (CTEA).⁵⁴ Under the CTEA, despite the constitutionality being challenged, Congress increased the length of copyright protection to the life of the author plus seventy years, and included a retroactive extension for all pre-existing copyrights.⁵⁵

In contrast, trademark protection always lasted, so long as the mark was used in interstate commerce or until the mark became generic.⁵⁶ Through Congress and various decisions by the federal courts, federal trademark protection has vastly expanded over the last several decades.⁵⁷ In 1946,

51. 15 U.S.C. § 1125(a).

52. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994); 17 U.S.C. § 107 (1992).

53. *See Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017) (ruling trademarks may not be denied for being immoral, disparaging, or scandalous and conflated trademarks and copyrights by stating "trademarks often have an expressive content ... powerful messages can sometimes be conveyed in just a few words.").

54. 17 U.S.C. § 304 (2002).

55. 17 U.S.C. § 302 (1998); *see Eldred v. Ashcroft*, 123 S.Ct. 769, 776 (2003); *see Symposium: Panel II: Mickey Mice? Potential Ramifications of Eldred v. Ashcroft*, 13 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 771, 781 (2003); Keith Gluck, *The Birth of a Mouse*, THE WALT DISNEY FAMILY MUSEUM BLOG (Nov. 18, 2012), <https://www.waltdisney.org/blog/birth-mouse> (arguing that Congress passed the CTEA to extend Mickey Mouse's copyright as without the CTEA, Mickey Mouse's copyright would have expired in 2003, but will now last until 2023 despite being created in 1928.).

56. *See* 15 U.S.C. § 1127 (defining abandonment); *see also* *Murphy Door Bed Co. v. Interior Sleep Systems, Inc.*, 874 F.2d 95, 101-02 (2d Cir. 1989) (holding generic marks are not eligible for trademark protection).

57. Mark A. Lemley, *Symposium: The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1688 (1999).

Congress expanded trademark law when it passed the Lanham Act, which provides protection for unregistered marks.⁵⁸ In 1955, Congress also passed the Federal Trademark Dilution Act, which provides a dilution claim despite no likelihood of confusion, even for non-competing and non-identical marks.⁵⁹ Today, under trademark protection, companies can protect a source-identifying color, source-identifying sounds, and even a restaurant's theme.⁶⁰

The Copyright Office should be more skeptical of not just geometric trademarks, but any trademark trying to gain copyright protection. However, the Copyright Office should not deny trademarks via an insufficient creativity argument, but rather, for illegitimate extension of trademark protection through copyright law and a necessary demarcation between the boundaries of copyright and trademark law. Without a division, companies can circumvent trademark protection's bounds through copyright law. The following cases illustrate the federal courts stance towards concurrent intellectual property protection overall.

In *Baker v. Selden*, the Court held that copyright protection does not extend to an idea itself, but only the expression of that idea.⁶¹ This core concept of copyright law is called the idea/expression dichotomy or merger problem. The plaintiff in *Baker* copyrighted his book describing his double-entry bookkeeping system.⁶² However, the illustrations to exemplify the system were not protectable under copyright law because they were ideas and examples of a system.⁶³ Despite the systems likely meeting copyright requirements, the Court correctly ruled that the following are patentable, not copyrightable: ideas, procedures, processes, systems, methods of operations, concepts, principles or discoveries embodied in a copyright work.⁶⁴

Despite not being copyrightable subject matter, these systems were ripe for protection under a different form of intellectual property, patent law.⁶⁵ Therefore, someone using the same system as Selden, even using the examples provided in his copyrighted book, would not be infringing on Selden's copyright because the examples are necessary to enact the system. Thus, to

58. Lanham Act, 15 U.S.C. § 1051-1126 (1946).

59. 15 U.S.C. § 1125(c) (1955).

60. *Qualitex Co. v. Jacobsen Products Co., Inc.*, 514 U.S. 158, 172 (1995) (protecting color); see generally UNITED STATES PATENT AND TRADEMARK OFFICE, *Trademark "Sound Mark" Examples*, <https://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples>; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (1992) (protecting a restaurant's theme).

61. *Baker v. Selden*, 101 U.S. 99, 104 (1879).

62. *Id.* at 101.

63. *Id.* at 103.

64. See 17 U.S.C. § 102(b).

65. *Baker*, 101 U.S. at 104.

protect these examples under copyright law would be a backend route to protect a system, which is the subject of patent, not copyright law.⁶⁶ Essentially, the ideas for how to carry out the system cannot be copyrightable. Moreover, the underlying system in the work is not copyrightable subject matter and there is a limited number of ways to express this creative and original idea. Therefore, even if identically expressed, such expression does not warrant copyright infringement because the expression of the idea is merged with the non-copyrightable idea, making the expression of that idea non-copyrightable as well. Simply put, ideas and systems are patentable, not copyrightable.⁶⁷

Additionally, in *TrafFix Devices, Inc. v. Mktg. Displays*, the Court faced the problem of sequential protection between a patent and trademark.⁶⁸ When Marketing Display's patent expired, Traffix reverse engineered it and sold a very similar product.⁶⁹ Marketing Display sought trademark infringement, but the Court ruled against Marketing Display's plea for sequential protection.⁷⁰ The Court considered public policy regarding creative, inventive works and referred specifically to the right to copy.⁷¹ The Court stressed the non-functionality requirement for trademark protection and found that the distinction between trademark's non-functionality and patent's utility requirement must remain clearly demarcated.⁷² After making that distinction, the Court rejected Marketing Display's attempt to extend an expired patent's protection using trademark law⁷³

Federal courts have directly expressed concerns with copyrighting trademarks.⁷⁴ For example, the Second Circuit stated the “[o]verextension of trade dress protection can undermine restrictions in copyright and patent law that are designed to avoid monopolization of products and ideas. Consequently, courts should proceed with caution in assessing claims to unregistered trade dress protection so as not to undermine the objectives of these other laws.”⁷⁵ In *Galerie v. Coffaro*, the court dismissed the plaintiff's trademark claim because the plaintiff should have “brought [the claim] under the federal copyright, not

66. *Id.*

67. *Id.* at 105.

68. *Traffix Devices, Inc., v. Marketing Displays, Inc.*, 532 U.S. 23, 26 (2001).

69. *Id.*

70. *Id.* at 35.

71. *Id.* at 29.

72. *Id.* at 32-33.

73. *Id.* at 34-35.

74. *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 32 (2d Cir. 1995).

75. *Id.*

trademark, statute.”⁷⁶ The Ninth Circuit addressed concurrent trademark and copyright holding:

This [movie] clip is [not] a trademark ... the [movie clip] ... was clearly covered by the Copyright Act ... and the Lanham Act cannot be used to circumvent copyright law. If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity.⁷⁷

Likewise, in *Murray Hill Publ'ns, Inc. v. ABC Communs., Inc.*, the court rejected a trademark claim where copyright properly applied because otherwise it “would simply transform every copyright action into a Lanham Act action....”⁷⁸ In *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopulos, Inc.*, the court held that a song cannot be a trademark for itself as that “would allow any copyright claim for infringement ... to be converted [] into a Lanham Act cause of action ... [and] stretch the definition of trademark ... too far [by] ... protecting the very essence of the song, an unwarranted extension into an area already protected by copyright law.”⁷⁹

In *Dastar Corp. v. Twentieth Century Fox Film Corp.*, the Supreme Court was again directly faced with the issue of sequential protection, denying an attempt to extend copyright protection through trademark law.⁸⁰ The plaintiff, Twentieth Century Fox (Fox), alleged trademark infringement in a previously copyrighted work that expired when Fox failed to renew its registration.⁸¹ Dastar edited Fox's work and sold it at a lesser cost.⁸² The court rejected Fox's attempt to protect its work with trademark law after its copyright protection expired.⁸³ The Court defined a “mutant copyright,” as when a copyright owner

76. *Galerie Furstenberg v. Coffaro*, 697 F. Supp. 1282, 1290 (S.D.N.Y. 1988).

77. See *Comedy III Productions, Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000); see also *Shaw v. Lindheim*, 919 F.2d 1353, 1364-1365 (9th Cir. 1990) (rejecting a concurrent copyright and trademark protection attempt for a pilot script. The court heard the copyright claim, but not the trademark claim because doing so would expand trademark protection in a way “[in]consistent with the Lanham Act's purpose of preventing individuals from misleading the public by placing their competitors' work forward as their own.” The court specifically referred to the concurrent protection problem by refusing “to expand the scope of the Lanham Act to cover cases in which the Federal Copyright Act provides an adequate remedy.”).

78. *Murray Hill Publications, Inc., v. ABC Communications, Inc.*, 67 F. Supp. 2d 754, 761 (E.D. Mic. 1999).

79. *EMI Catalogue Pshp. v. Hill, Holiday, Connors, Cosmopulos Inc.*, 2000 U.S. App. Lexis 30761 18,19 (2d Cir. 2000).

80. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 25 (2003).

81. *Id.* at 26-27.

82. *Id.*

83. *Id.* at 34-35.

attempts to use trademark law to protect the previously copyrighted work.⁸⁴ While *Dastar* overruled sequential protection for an expired copyright via trademark law, it did not directly address concurrent protection.

While rare, there are marks that are concurrently copyrights and trademarks, such as Mickey Mouse. Under *Dastar*, once Mickey Mouse's copyright expires, the right to copy him should pass in to the public domain. Trademark protection after Mickey Mouse's copyright expiration would create a "mutant copyright." In *Dastar*, Fox's trademark claims were easy to reject relative to Disney's trademark rights in Mickey Mouse. Mickey Mouse entering the public domain would create mass consumer confusion as any company would be free to copy Mickey Mouse. This contradicts trademark's purpose of avoiding consumer confusion and free-riding another company's good will.

Dastar looks to balance the right to copy after a copyright's expiration against trademark's perpetual protection so long as the mark is continually used in interstate commerce and avoids becoming generic. *Dastar* finds that the harm to the public and mark owners denied sequential protection are outweighed by the public benefit received from the right to copy the work.⁸⁵ Public policy supports the right to copy, but also supports protecting Mickey Mouse as a trademark because his passing into the public domain would cause consumer confusion and free-riding off Disney's good will. However, protecting Mickey Mouse as a trademark is contrary to *Dastar*'s holding against sequential trademark protection after a copyright's expiration. Therefore, while *Dastar* resolved the issue of sequential protection, marks such as Mickey Mouse that have concurrent trademark and copyright protection are left stranded.

Dastar and these other cases look to maintain clear demarcations between the scopes of intellectual property protection, and copyright and trademark protection specifically. Otherwise, trademark protection can form into a mutant copyright and eliminate the public's right to copy, which is crucial to the societal bargain, advancement of new creative works, and overall access to knowledge. While *Dastar* resolved the issue of extending copyright protection via trademark law, the reverse of *Dastar*, using copyright law to extend trademark protection, must be regulated for the same policy concerns of *Dastar*. Clear demarcations between other areas of intellectual property law exist for good reason and for these same reasons a clear line between copyright and trademark law is necessary. Without clear demarcations between copyright and trademark law, the protection for creative works, whether trademark or

84. *Id.*

85. *Id.* at 35-36.

copyright, may extend into absolute rights. For example, in *Video Pipeline Inc., v. Buena Vista Home Entm't, Inc.*, a federal district court held that copying previews of Disney's movies was copyright and trademark infringement because Disney's characters were both copyrights and trademarks.⁸⁶ However, the court enjoined not only showing the parts of the previews with the trademarked characters, but the entire preview.⁸⁷ This protected the entire work through trademark law, despite trademarks appearing in only parts of the work. Had the plaintiffs been required to use copyright protection, they would have been required to show unauthorized use of their creative works that was substantially similar to the original and that no infringement defenses were available. A copyright infringement claim is far more difficult to prove than the trademark claim that was used. Further, defendants are harmed if they unnecessarily settle, enter licensing agreements, or stop using the work thereby robbing the public, due to uncertain litigation concerns.

VI. TO TRADEMARK A COPYRIGHT, NOT COPYRIGHT A TRADEMARK, THAT IS THE RULE

Trademark owners and the Copyright Office cannot have their cake and eat it too. Trademark owners cannot also have copyright protection. The Copyright Office cannot have an extremely low standard and then deny marks that clearly meet this low standard. Cases that did not overrule overlapping intellectual property protection deal with an overlap where different areas of intellectual property protect different aspects. The cases not overruling concurrent trademark and copyright protection deal with trademark protection for a mark originally created, exploited, and that functioned as a copyright that later functioned as a trademark. Therefore, it is necessary to draw a line that an image originally created, exploited, and that functioned as a copyright may later meet trademark's requirements and therefore be eligible for concurrent trademark and copyright protection. However, a mark originally created, exploited, and that functioned as a trademark cannot also later receive copyright protection.

To determine if a mark was originally created, exploited, and functioned as a trademark or a copyright, the applicant must declare as part of the copyright application process under 17 U.S.C. § 409 that the work seeking registration is not a designator of a source of goods under penalty of fraud on the Copyright Office. A knowingly fraudulent representation would lead to invalidation of the copyright application if it is material—meaning of such a nature that it

86. *Video Pipeline v. Buena Vista Home Entertainment*, 275 F. Supp. 2d 543, 564, 577 (D.N.J. 2003).

87. *Id.* at 564, 577.

would have caused the Copyright Office to refuse registration.⁸⁸ Failing to notify the Copyright Office that the mark seeking registration is a trademark would surely qualify as a material fraudulent representation that would invalidate the copyright application because under the rule proposed herein a mark that functions as a source identifier would never be granted copyright protection.

This declaration removes the burden from the Copyright Office and any third parties. Also, while this may result in concurrent copyright and then trademark protection, this puts the burden on the applicant to use the work seeking copyright registration as a copyrightable work, typically before any trademark protection would be available. If said work meets copyright's minimal requirements and then later functions as a trademark, this is acceptable so long as the work originally functioned as a copyright typically does—such as expression aesthetic or artistic meaning. The mark functioning as a copyright typically does benefit and enrich the public as copyright law intended. If a mark is used or intended to be used as a source identifier without first functioning as a copyrighted work, the mark was created, exploited, and functions as a trademark. For such a mark, trademark protection alone should apply without the potential for concurrent or sequential copyright protection. However, a work originally created, exploited, or that functioned as a copyright is one that is used or intended to be used to express some aesthetic, expressive, or artistic meaning. For such a mark, copyright and then trademark protection, even concurrent, is available.

Mickey Mouse, for example, would comport with this rule because Mickey Mouse was originally created, exploited, and functioned as a copyright. Then, only after time, Mickey Mouse functioned as a trademark and satisfied trademark's requirements. Mickey Mouse thus should be eligible for concurrent copyright and trademark protection. Moreover, this rule comports with *Dastar* in that it only allows for concurrent protection and disallows sequential protection if the copyright does not seek trademark registration prior to the copyright's expiration or alleged trademark infringement. Therefore, the copyright must seek trademark protection while the copyright protection is valid. Such a mark cannot seek trademark registration after the copyright's expiration or after the alleged copyright infringement.

This rule demarcates clear boundaries between copyright and trademark law and closes a circumvention of trademark law's bounds through copyright law, while not contradicting trademark's purpose of avoiding consumer confusion. No test is foolproof and the same holds true for this rule. Specifically, a mark owner could originally create, exploit, and function a mark

88. 17 U.S.C. § 411(b)(1).

as a copyright to gain copyright protection all along, knowing the mark's true purpose is to serve as a trademark. If the mark meets copyright's requirements and then later meets trademark's requirements, the mark would gain concurrent copyright and trademark protection. However, defrauding the Copyright Office is illegal and the minimum examinations by the Copyright Office will snuff out bad faith registrations. Moreover, and most importantly, if the work's creator exploits the work as a copyright typically does, this inherently benefits and enriches the public and comports with copyright law's purpose.

The loss of a few images from the public domain—because such images can comport with this rule and therefore be eligible for concurrent copyright and trademark protection—is outweighed by the mass consumer confusion and illegitimate free-riding that would result from longstanding trademarks such as Mickey Mouse falling into the public domain due to Disney's copyright expiration. In fact, this exception to this proposed rule that allows concurrent protection is not contrary to the purpose of the rule. The purpose of this rule is to protect against copyrighting a trademark, not against granting trademark protection to a copyright. This rule is designed to either prevent a trademark originally created, exploited, and functioned as a trademark from also receiving copyright protection, or to make such work also function and be exploited as a copyright prior to being eligible for trademark protection.

The rule does not resolve the right to copy concerns of *Dastar*. Such concerns are unavoidable without rendering Mickey Mouse into the public domain, and further contradict trademark's purpose of making the marketplace fair, avoiding consumer confusion, and eliminating illegitimate free-riding. Therefore, this rule balances over-extending trademark protection by prohibiting copyrighting a trademark against trademark's purposes, and legitimate concurrent trademark and copyright protections for copyrights that now serve a source identifying function.

If a work is originally created, exploited, and functioned simultaneously as a copyright and a trademark, then copyright registration would be possible with potential concurrent future trademark protection. For example, if a company creates a character for an advertisement, so long as the character has some expressive use, copyright protection is available. If this character later becomes a source identifying function, the character can also be trademarked. A clear, systematic approach is necessary. This rule allows for the enhancement of the public domain, the maintenance of the incentive to create works that progress the science and arts against marketplace fairness, and the avoidance of mass consumer confusion and free-riding. The Supreme Court or Congress should adopt the proposed rule herein to provide guidance to an unclear area of law that, if left unattended, allows mark owners to undermine, circumvent, and extend the boundaries of trademark law through copyright.