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Real-Life Protection for Fictional Trademarks

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Real-Life Protection for Fictional Trademarks

Cover Page Footnote

Professor Jeanne C. Fromer, IPLA editors and staff, Ted Neustadt, and Victoria.

Real-Life Protection for Fictional Trademarks

Benjamin M. Arrow^{*}

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INTRODUCTION

A guy walks into a bar. It's a dingy neighborhood bar replete with a pool table, unattractive stained glass windows, aging barflies and a cranky bartender. "Hiya Homer," the bartender grumbles. This greeting is echoed by a corpulent, toad-like bar regular named Barney who punctuates it with a seismic belch. Welcome to Moe's Tavern. Location: Springfield, the fictional setting of the long-running television series, *The Simpsons*.

In between dispensing questionable advice, falling victim to a series of crank phone calls, pointing a shotgun at patrons and indulging in the occasional get-rich-quick scheme, Moe serves Duff, the local beer. Duff enjoys an enviable market position in Springfield, the apparent result of an aggressive marketing campaign. Duff's empire includes its several labels (Duff, Duff Dry, Duff Lite, Duff Dark, Raspberry Duff, Tartar Control Duff); Duff Gardens, a theme park; Duff Man, a flamboyant spokesman with a cape and a beer-toting belt and even a spokes-shark named Duff McShark. Duff advertises on television and in print (Moe's Tavern is positively plastered with advertising for the beer) and gives tours of its brewery. The beer sports a logo, instantly recognizable to fans of the show and to the residents of Springfield alike, featuring elongated black lettering against a red, white and tan background.

Duff's brand is characterized by crass marketing and less-than-stringent production standards.¹ Even the name connotes qualities few would seek out in a beer or with which they would wish to be associated.² Here in the real world, "most consumers know the fictional drink is a parody of the kind of mass-produced beer found

¹ In one episode of *The Simpsons*, "Duffless," Homer visits the Duff brewery where an inspector removes bottles of Duff from an assembly line containing a rat, a syringe and a human nose. On this trip, it is also revealed that Duff, Duff Dry and Duff Lite are all the same beer. *The Simpsons: Duffless* (Fox television broadcast Feb. 18, 1993).

² See *Twentieth Century Fox Film Corp. v S. Austl. Brewing Co.* [1996] 66 FCR 451, 465 (Austl.) ("The word [Duff] is used in relation to golf to refer to striking a ball clumsily or failing to play a shot. The word 'duffer,' which is perhaps more relevant, connotes a plodding, stupid or incompetent person."); see also THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 553 (4th ed. 2000) (noting that "duff" is a slang term for "buttocks"), available at <http://dictionary.reference.com/browse/duff>.

throughout the U.S.”³ Because of Duff’s fame on *The Simpsons*, however, those same qualities which suggest the shoddiness of the beer in the fictional world of Springfield have created a sizeable market for a Duff Beer here in the real world.

Enter Rodrigo Contreras. A “marketing man” who has “always had an eye for a gimmick,”⁴ Mr. Contreras is the owner of Simpson’s Brewing Company, a Tijuana-based brewery manufacturing his own Duff Beer⁵ whose label is “practically the same as the design on the cans in the cartoon.”⁶ Contreras stresses that the brewery’s name “is a coincidence.”⁷ Because he concedes that the idea to manufacture Duff Beer occurred to him while watching an episode of *The Simpsons* in 2002,⁸ however, that assertion may strike some as difficult to swallow. Contreras presently sells in Mexico and Europe but aims to expand into the United States as well.⁹ While Fox would not comment on any legal action it may or may not be contemplating against Simpson’s Brewing Company when interviewed about Contreras’ Duff Beer in December 2009, it simply stated that “*The Simpsons* is a Twentieth Century Fox property, and Fox owns the rights to *The Simpsons* universe. We intend to protect our rights.”¹⁰ This is almost certainly a credible threat. In 1996, Fox won a preliminary injunction against two Australian breweries for manufacturing a product called “Duff Beer”¹¹ and the company has initiated lawsuits against several other breweries around the world seeking to manufacture their very own Duff Beer without a license from Fox.¹² If Fox’s saber rattling is any indication, courts will likely

³ *Homer Simpson’s Beer Bubbles to Life*, FIN. TIMES, Dec. 3, 2009, <http://www.ft.com/cms/s/0/81d13ac8-e03e-11de-8494-00144feab49a.html?>

⁴ *Id.*

⁵ *Cerveza Duff de Mexico*, DUFF INC., <http://www.duffdemexico.com> (last visited May 20, 2010).

⁶ *Homer Simpson’s Beer Bubbles to Life*, *supra* note 3.

⁷ *Id.*

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.*

¹¹ *Twentieth Century Fox Film Corp. v S. Austl. Brewing Co.* [1996] 66 FCR 451, 452 (Austl.); *see infra* Part II.A.2.

¹² Eriq Gardner, *Why Hasn’t Fox Sued the Makers of Duff Beer?*, HOLLYWOOD REPORTER (Dec. 7, 2009, 2:06 AM), <http://thresq.hollywoodreporter.com/2009/12/fox->

soon have occasion to revisit the issue of real-life protection for fictional trademarks. But when they do, what harm could Fox allege?

Because Duff is a trademark, albeit a fictional one, a natural first impulse would be to look to trademark law. This body of law seeks to reward producers who, like the fictional Duff, make efforts to build a strong brand. Indeed, assuming that United States federal law applies in the fictional world of Springfield, Duff has an easy case against a rival fictional manufacturer calling itself Duff and manufacturing beer, or even shoes. But what happens when a real manufacturer attempts the same thing? Can trademark (or some other form of intellectual property protection) furnish a remedy for the creator of a fictional mark when a real-world user trades on the good will of the mark by recreating the fictional product in the real world? Or put another way, can a real-world producer get away with manufacturing Duff Beer?

This Note argues that it cannot. Two federal courts in the United States and Australia who have adjudged the issue agree, finding that such conduct constitutes a trademark injury. However, the appropriation of a fictional mark is no ordinary trademark injury. Because Duff is a creative aspect of a fictional work, the courts could have plausibly concluded that its appropriation is actually copyright infringement. Indeed, Fox appears to suffer two different injuries depending on one's perspective.

From inside Springfield (what this Note will call the "internal perspective"), when a second comer markets a beer called "Duff," we appear to have a classic trademark injury: a latter market entrant or "junior user" trading on the good will built up by the senior user of the mark.¹³ But things look very different outside

duff-beer-trademark.html; *see also* *S. Austl. Brewing Co.*, 66 FCR at 457 (noting that "Fox has consistently refused to grant licenses to parties who have sought to use 'The Simpsons' in connection with alcohol and tobacco products, or other substances considered detrimental to children").

¹³ 15 U.S.C. § 1114 (2006); *see also* *Lucent Info. Mgmt., Inc. v. Lucent Techs., Inc.*, 186 F.3d 311, 316 (3d Cir. 1999) (citing 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 26.01[1] (4th ed. 1996)) (defining senior user and junior user as the first and second seller, respectively, to adopt and use a trademark in the United States).

Springfield. From our perspective here in the real world (which this Note will call the “external perspective”), Duff Brewery does not exist at all. Instead, Duff Beer is part of a rich, fictional universe and preventing the unauthorized duplication of the expressive aspects of that world seems more properly to be the domain of copyright law. Both of these areas of intellectual property law have intuitive appeal but both pose doctrinal hurdles fictional marks may not be able to surmount. For a symbol to be a viable trademark it must be used in commerce to distinguish the seller’s goods from goods made by others, but to say that Duff Beer has been used in commerce is literally to indulge in fiction. Similarly, while copyright law protects original expression as soon as that expression is fixed in a tangible medium, under its *de minimis* doctrine, copyright does not protect “words and short phrases.”¹⁴ As Homer Simpson would say, “D’oh!”

The reasoning of the few courts to consider fictional trademark injuries is in many ways instructive in understanding the puzzle posed by fictional trademarks. But the courts ultimately paper over the tug between perspectives and doctrines, hinting at a role copyright might play while locating the injury under traditional trademark law. As a result, it remains unclear analytically, if not legally, what harm Fox suffers when Contreras sells his Duff Beer and whether existing trademark or copyright doctrine, standing alone, provides a remedy.

This Note proposes a doctrinal approach to cloaking deserving fictional trademarks with intellectual property protection. Part I describes the legal contours of relevant trademark and copyright law. Part II.A considers the fictional trademark problem as a trademark injury and presents two cases which have viewed it as such; Part II.B considers the possibility that a fictional trademark injury is actually a copyright injury in disguise and points to aspects of those two cases in which the courts appear to talk trademark but walk copyright. Part III locates the injury under traditional trademark law but adapts the trademark analysis to the particulars of the fictional trademark problem—in part, by incorporating relevant analytical principles from copyright. This

¹⁴ 37 C.F.R. § 202.1 (2010).

Note then discusses how the two cases would come out under this tailored trademark framework and analyzes a few other fictional trademark scenarios.

I. THE DOCTRINAL LANDSCAPE

A. Trademark

Trademarks are governed by both state common law and federal statutory law. The Lanham Act of 1946,¹⁵ a federal statute, affords qualifying marks nationwide protection upon registration.¹⁶ Unregistered marks are protected by state common law and are subject to more geographically limited protection.¹⁷

The term “trademark,” as defined in the Lanham Act, “includes any word, name, symbol or device or any combination thereof . . . used by a person, or . . . which a person has a bona fide intention to use in commerce and applies to register on the principal register established by [the Lanham] Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”¹⁸ As the Supreme Court has explained, the “requirements for qualification of a word or symbol as a trademark’ are that it be (1) a ‘symbol,’ (2) ‘use[d] . . . as a mark,’ (3) ‘to identify and distinguish the seller’s goods from goods made or sold by others,’ but that it not be ‘functional.’”¹⁹

Trademark law is bottomed on a consumer protection rationale. As the Supreme Court has explained,

¹⁵ Lanham Act of 1946, 15 U.S.C. §§ 1051–1129 (2006).

¹⁶ 15 U.S.C. § 1057(c).

¹⁷ See 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 19:1–9 (4th ed. 2010).

¹⁸ 15 U.S.C. § 1127. Courts and the Patent and Trademark Office, the federal registrar of trademarks, have construed the word “symbol” broadly and “authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC’s three chimes) and even a particular scent (of plumeria blossoms on sewing thread).” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

¹⁹ *Qualitex*, 514 U.S. at 166 (quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.01[1], at 3-2, § 7.26, at 7-113 (3d ed. 1994)).

In principle, trademark law, by preventing others from copying a source-identifying mark, reduces the customer's costs of shopping and making purchasing decisions for it quickly and easily assures a potential customer that *this* item—the item with the mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law thereby encourages the production of quality products and simultaneously discourages those who hope to sell inferior products by capitalizing on a consumer's inability quickly to evaluate the quality of an item offered for sale.²⁰

Thus, to the extent that trademark law seeks to disincentivize an “imitating competitor” from reaping “financial” and “reputation-related rewards associated with a desirable product,” this goal is subservient to the ultimate aim of protecting consumers by preventing confusion in the marketplace.²¹ Accordingly, trademark law looks favorably upon efforts such as those employed by the fictional Duff to create and promote a strong, distinctive mark and provides a relatively low threshold to establish rights in a mark.²² Section 43(a) of the Lanham Act provides a cause of action against the user of a mark in commerce whose use “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship or

²⁰ *Qualitex*, 514 U.S. at 163–64 (quoting 1 J. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.01[2], at 2–3 (3d ed. 1994)) (internal quotation marks omitted).

²¹ *Qualitex*, 514 U.S. at 163–64.

²² *See id.* at 162 (“The language of the Lanham Act describes [the universe of things that can qualify as a trademark] in the broadest of terms. It says that trademarks “includ[e] any word, name, symbol, or device or any combination thereof.”). Compare 15 U.S.C. § 1127, with 35 U.S.C. §§ 101–03 (requiring that a product be novel, useful, non-obvious and sufficiently described by the applicant in such a way as to enable others to make and use the invention to receive patent protection).

approval of his or her goods, services, or commercial activities by another person.”²³

Because of its focus on preventing marketplace confusion, trademark law favors marks which are distinctive and thus easily recognizable by consumers. In assessing distinctiveness “[c]ourts and commentators have traditionally divided potential trademarks into four categories. A potential trademark may be categorized as (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful.”²⁴ A generic term is “the name of a particular genus or class of which an individual article or service is but a member”²⁵ and “if at any time a mark becomes generic as to a particular product or service, the mark’s registration is subject to cancellation.”²⁶ Examples of marks which have become generic include Aspirin²⁷ and Murphy Bed.²⁸ A descriptive term “identifies a characteristic or quality of an article or service.”²⁹ Descriptive terms are not protectable as marks in their descriptive sense, that is, when they describe the products with which they are associated. They may, however, become distinctive “by acquiring a secondary meaning in the minds of the consuming public,”³⁰ that is, “when in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.”³¹ Chap Stick³² and Instant Messenger³³ are descriptive marks. A suggestive mark “suggests, rather than describes, some particular characteristic of the goods or services to which it applies and requires the consumer to exercise the

²³ Lanham Act of 1946 § 43(a), 15 U.S.C. § 1125(a)(1)(A).

²⁴ *Zatarain’s, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983).

²⁵ *Id.*

²⁶ *Id.*; *see also* 15 U.S.C. § 1064(3).

²⁷ *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

²⁸ *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95 (2d Cir. 1989).

²⁹ *Zatarain’s*, 698 F.2d at 790 (quoting *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 115 (5th Cir. 1979)).

³⁰ *Id.*; 15 U.S.C. § 1052(f).

³¹ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 (1982)).

³² *Morton Mfg. Corp. v. Delland Corp.*, 166 F.2d 191 (C.C.P.A. 1948).

³³ *In re Am. Online Inc.*, 77 U.S.P.Q.2d 1618 (T.T.A.B. 2006) (concluding that petitioner’s mark, “Instant Messenger,” was “registrable on the Principal Register because it has acquired distinctiveness under . . . the Trademark Act”).

imagination in order to draw a conclusion as to the nature of the goods and services.”³⁴ The term “Coppertone” as applied to sun-tanning products has been held to be suggestive.³⁵ Arbitrary or fanciful marks “bear no relationship to the products or services to which they are applied.”³⁶ Kodak³⁷ and Exxon³⁸ are fanciful marks. Suggestive marks and arbitrary or fanciful marks are considered to be inherently distinctive without proof of secondary meaning.³⁹

Trademark law requires not only that a mark be sufficiently distinctive, but that it have established priority in a given marketplace. This body of law thus follows the ancient maxim “first in time, first in right” with the first user of an inherently distinctive mark having priority over latter users and the first descriptive mark to acquire secondary meaning having priority over other such marks.⁴⁰ “Only active use” of a mark in commerce “allows consumers to associate a mark with particular goods and notifies other firms that the mark is so associated.”⁴¹ Judge Easterbrook of the Seventh Circuit explained that the purpose of the rule is to “reward[] those who act quickly in getting new products in the hands of consumers.”⁴² Indeed, as Professors Graeme Dinwoodie and Mark Janis note, “[a]bsent consumers coming to associate a mark with a particular source, there would be no reason to confer trademark rights on a particular trader.”⁴³ Thus, the use in commerce requirement, far from being a mere procedural formality, limits protection to marks which consumers have come to identify with a given source or producer.

³⁴ *Zatarain’s*, 698 F.2d at 791 (internal citations omitted).

³⁵ *Id.*; see *Douglas Labs. Corp. v. Copper Tan, Inc.*, 210 F.2d 453 (2d Cir. 1954).

³⁶ *Zatarain’s*, 698 F.2d at 791.

³⁷ *Id.*; see *Eastman Kodak Co. v. Weil*, 243 N.Y.S. 319 (N.Y. Sup. Ct. 1930); see also *Eastman Kodak Co. v. Rakow*, 739 F. Supp. 116 (W.D.N.Y. 1989).

³⁸ *Exxon Corp. v. XOIL Energy Res., Inc.*, 552 F. Supp. 1008, 1014 (S.D.N.Y. 1981).

³⁹ *Zatarain’s*, 698 F.2d at 791.

⁴⁰ 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:1 (4th ed. 2010).

⁴¹ *Zazu Designs v. L’Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992).

⁴² *Id.* at 504.

⁴³ Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1612 (2007).

The issue of whether a use of a mark is sufficient to constitute a use in commerce is made “on a case by case basis” and turns on “the totality of the circumstances.”⁴⁴ Unsurprisingly then, it is not clear whether use in a work of fiction is sufficient to reserve priority rights in a mark here in the real world.

Many elements of fictional works are protectable under trademark law. For example, in *In re DC Comics*,⁴⁵ a seminal case on modern trademark interpretation, the court held that a graphic character can function as a protectable mark.⁴⁶ In that case, DC Comics appealed from a decision of the U.S. Patent and Trademark Office Trademark Trial and Appeal Board (“TTAB”) refusing trademark registration for drawings of three of DC’s comic book characters which appeared on the packaging for action figures of those characters.⁴⁷ TTAB reasoned that the drawings were “so descriptive” of the figures within that they were “not trademarks.”⁴⁸ The Court of Customs and Patent Appeals (now the Federal Circuit) reversed. That court reasoned that:

[w]hatever information a drawing of Superman or Batman or Joker might convey to the average prospective purchaser regarding a doll resembling one of the related fictional characters is wholly dependent on appellant’s efforts to associate each character in the public’s awareness with numerous attributes, including a single source of sponsorship.⁴⁹

The court thus concluded that the “information-conveying aspect of the drawing” did not “conclusively eliminate its possible trademark role” finding instead that DC’s efforts to link the characters and the brand in the public mind were the critical factor which enabled the fictional characters to serve as trademarks.⁵⁰

⁴⁴ *Johnny Blastoff, Inc., v. L.A. Rams Football Co.*, 188 F.3d 427, 433 (7th Cir. 1999); *see also New W. Corp. v. NYM Co. of Cal., Inc.*, 595 F.2d 1194, 1200 (9th Cir. 1979).

⁴⁵ 689 F.2d 1042 (C.C.P.A. 1982).

⁴⁶ *Id.* at 1045.

⁴⁷ *Id.* at 1043.

⁴⁸ *Id.*

⁴⁹ *Id.* at 1044.

⁵⁰ *Id.*

Similarly, other prominent elements of fictional works have been held to constitute independent trademarks. For example, in *DC Comics, Inc. v. Filmation Associates*,⁵¹ DC Comics, again in the role of plaintiff, sued an animation studio which created television shows for it and others. Proceeding on a trademark infringement theory, DC alleged that Filmation's series *Manta and Moray* and *Superstretch* infringed trademarks in the characters Aquaman and Plastic Man which starred in DC's cartoon series.⁵² The court found for DC, holding that:

[w]here the product sold by plaintiff is "entertainment" in one form or another, then not only the advertising of the product but also an ingredient of the product itself can amount to a trademark protectable under § 43(a) [of the Lanham Act] because the ingredient can come to symbolize the plaintiff or its product in the public mind.⁵³

The court noted that protectable ingredients included "the names and nicknames of entertainment characters, as well as their physical appearances and costumes" but did not include a fictional character's "physical abilities or personality traits" since these were capable of "an infinite number of possible visible and audible manifestations" and thus lacked the "consistency of representation" required for a mark to serve as a reliable indicator of source in the public mind.⁵⁴

Similarly, in *DC Comics v. Kryptonite Corp.*,⁵⁵ the court found the fictional element "Kryptonite" from DC's *Superman* series to be "an element associated with Superman entertainment products" and thus entitled to trademark protection.⁵⁶ Notably, in its defense, Kryptonite argued that DC Comics, by featuring Kryptonite in the *Superman* story "for narrative" and as a "fictitious substance to enhance the story" had "never used the mark in commerce . . . to

⁵¹ 486 F. Supp. 1273 (S.D.N.Y. 1980).

⁵² *Id.*

⁵³ *Id.* at 1277.

⁵⁴ *Id.* (internal citations omitted).

⁵⁵ 336 F. Supp. 2d 324 (S.D.N.Y. 2004).

⁵⁶ *Id.* at 332.

identify or designate the source of a real product or service.”⁵⁷ The court rejected this argument, finding that “[a]s a result of broad dissemination throughout all media, the fictional element Kryptonite, including its graphic depiction, has come to be recognized as a powerful symbol, and is immediately recognized or associated with the character Superman.”⁵⁸ The *Kryptonite* court thus seemed to hold that use of a fictional mark within a work of fiction, without more, may be sufficient to reserve priority in the mark. However, it is unclear if the court would have reached the same result without DC having also licensed Kryptonite to appear on merchandise.

Beyond whether or not the mark has been used in commerce, the principal constraint on the establishment of trademark rights is the extent to which such use has occurred. The extent of the use sufficient to reserve priority rights in a mark varies depending on whether or not the mark is registered.⁵⁹ While common law requires “substantial sales” to put other firms on notice that a given mark is already associated with a source of goods, “[r]egistration [of the mark with the United States Patent and Trademark Office] modifies this system slightly, allowing slight sales plus notice in the register to substitute for substantial sales without notice.”⁶⁰ In *Zazu Designs v. L’Oreal S.A.*,⁶¹ the Seventh Circuit explained that this system “prevents entrepreneurs from reserving brand names in order to make their rivals’ marketing more costly” and lets “others

⁵⁷ *Id.* at 331.

⁵⁸ *Id.* at 332.

⁵⁹ *Zazu Designs v. L’Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992).

⁶⁰ *Id.* (citing 15 U.S.C. § 1051(a) (2006)). The requirement that a mark be used in commerce before it can be registered was relaxed somewhat with the passage of the Trademark Law Revision Act of 1989 (“TLRA”) Pub. L. No. 100-667, 102 Stat. 3935, codified at 15 U.S.C. § 1051. Under the TLRA, the creator of a mark who has “a bona fide intention, under circumstances showing the good faith of such person, to use [the] trademark in commerce may request registration of its trademark on the principal register.” 15 U.S.C. § 1051(b)(1). This intent-to-use registration still requires that a bona fide use in commerce take place within six months (extendable up to three years for good cause shown) of the issuance of an approval (a “notice of allowance”) by the Patent and Trademark Office. 15 U.S.C. § 1051(d)(2). Failure to use the mark in commerce within this period results in abandonment of the application. 15 U.S.C. § 1051(d)(4).

⁶¹ 979 F.2d 499 (7th Cir. 1992).

know that they should not invest resources to develop a mark similar to one already used in the trade.”⁶²

In addition to serving as indicators of source, trademarks communicate the experiential and psychological qualities of a given product. Professor McCarthy states that “each product goes to market with a ‘psychic load’ of intangible and non-utilitarian psychological factors” and argues that the communication of such experiential information to consumers “must be recognized when considering the legal issues of ‘likelihood of confusion’ and ‘dilution’ of the effect of a given trademark.”⁶³ Thus, an important aspect of trademark law is its protection of the economic value of consumers’ positive psychological reaction to a firm and its trademark known as the firm’s “good will.”⁶⁴ Trademark law, then, protects not just the consumer, but “the businessman who has gained a strategic advantage through building up of good will, against unfair practices by competitors who desire to poach on this good will.”⁶⁵ With the advent of modern branding, trademarks have taken on lives of their own, becoming objects of consumer adoration even independent of any particular products with which they may be associated.⁶⁶ Good will has thus become a valuable intellectual property asset in its own right; the estimated value of Coca-Cola’s trademark, for example, independent of any of its tangible assets is estimated to be approximately \$24 billion.⁶⁷

⁶² *Id.* at 503.

⁶³ 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:37 (4th ed. 2010).

⁶⁴ *Id.* § 2:17.

⁶⁵ *Id.* § 2:17 (quoting *E. Wine Corp. v. Winslow-Warren, Ltd.*, 137 F.2d 955 (2d Cir. 1943)).

⁶⁶ See generally Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993).

⁶⁷ *Legislation: Industry Calls for Stiffer Enforcement of Anti-Counterfeiting Laws*, 44 PAT. TRADEMARK & COPYRIGHT J. (BNA) 585, 586 (1992); see also Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory L.J. 461, 461 (2005) (“Trademark merchandising is big business. One marketing consultant estimated the global market for licensing and marketing sports-related merchandise at \$17 billion in 2001. The college-logo retail market was estimated at \$3 billion in 2003. The 2002 Salt Lake Olympics generated \$500 million in gross sales—and \$34 million in licensing revenues—from sale of ‘Olympics’ attire.”) (internal citations omitted).

In addition to protecting trademarks which are inherently distinctive or which have acquired secondary meaning, the Lanham Act also protects a product's trade dress, that is, "the total image of a business."⁶⁸ Trade dress is protectable upon the same basis as trademarks; inherently distinctive trade dress is protectable absent a showing of secondary meaning.⁶⁹

In order to make out a cause of action for trademark infringement a plaintiff must establish that:

- It has a valid mark that is entitled to protection under the Lanham Act; and that
- The defendant used the mark,
- In commerce
- In connection with the sale . . . or advertising of goods or services
- Without the plaintiff's consent⁷⁰

and that such use "is likely to cause confusion . . . as to the affiliation, connection, or association of [the defendant] with [the plaintiff], or as to the origin, sponsorship, or approval of [the defendant's] goods, services, or commercial activities by [the plaintiff]."⁷¹

There are thus two discreet "use in commerce" analyses in trademark law: one for the senior user to determine if its use suffices to establish priority rights in a mark, and one for the junior user to determine if its use infringes. These are quite separate and distinct. While the priority analysis requires slight sales plus registration or more significant sales in the absence of registration, many significant uses by a junior user will be considered "fair uses" such that they employ the senior user's mark without infringing the senior user's trademark rights. Such fair uses

⁶⁸ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 n.1 (1992).

⁶⁹ *See id.* at 774 (noting that "[p]rotection of trade dress, no less than of trademarks, serves the Act's purpose to 'secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers'").

⁷⁰ *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400, 407 (2d Cir. 2005); *see also* 15 U.S.C. § 1114 (2006).

⁷¹ *1-800 Contacts*, 414 F.3d at 407 (citing 15 U.S.C. § 1125(a)(1)(A)).

include the senior user's mark having become generic,⁷² the senior user's abandonment of its mark,⁷³ and "nominative" fair uses such as descriptive use (including comparative advertising or news reporting), parody and free speech rights guaranteed by the First Amendment.⁷⁴ Indeed, as Professors Dinwoodie and Janis note, "a teleological analysis of trademark law would suggest that the concept of use sufficient to establish rights might differ radically from the type of use by a defendant that might give rise to infringement."⁷⁵ Thus, while courts and commentators differ as to what constitutes a "use in commerce" for infringement purposes,⁷⁶ section 45 of the Lanham Act makes clear that, for purposes of the priority analysis, "[t]he term 'use in commerce' means the bona

⁷² See, e.g., *The Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 97 (2d Cir. 1989) (holding that the term "Murphy bed" is "a generic term, having been appropriated by the public to designate generally a type of bed").

⁷³ See, e.g., *Major League Baseball Props., Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103 (S.D.N.Y. 1993) (holding that the baseball team "the Brooklyn Dodgers" had abandoned trademark rights in its name upon moving to Los Angeles such that a junior user's restaurant entitled "The Brooklyn Dodger" was a noninfringing use).

⁷⁴ See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (finding that the defendant's song "Barbie Girl" was a noninfringing parody of plaintiff Mattel's doll of the same name); see also *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987) ("Trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.").

⁷⁵ Dinwoodie & Janis, *supra* note 43, at 1613.

⁷⁶ Compare Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1673–74 (2007) (arguing that abolishing the requirement that a trademark be used "as a mark" in order to infringe would "severely limit a whole host of legitimate but unauthorized uses of [a trademark holder's mark] particularly (but not exclusively) in the online context") with Dinwoodie & Janis, *supra* note 43, at 1603 (arguing that "limiting liability to trademark use, as that term is understood by its proponents, will . . . result in insufficient marketplace regulation"). Similarly, courts are split with regard to the issue of whether use in public discourse to "sell" a political message constitutes a use in commerce under the infringement analysis. Compare *Lucasfilm v. High Frontier*, 622 F. Supp. 931 (D.D.C. 1985) (dismissing complaint of petitioner Lucasfilm alleging that public interest groups' use of the phrase "star wars" to persuade the public of their respective viewpoints of the Reagan Administration's strategic defense initiative through television messages constituted trademark infringement) with *United We Stand Am., Inc. v. United We Stand Am. N.Y., Inc.*, 128 F.3d 86, 92–93 (2d Cir. 1997) ("'use in commerce' denotes Congress's authority under the Commerce Clause rather than an intent to limit the Act's application to profitmaking activity.").

fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”⁷⁷

While the tests for likelihood of confusion employed by the different federal circuit courts of appeal vary, most circuits employ a non-exhaustive, multi-factor test with no one factor dispositive, such as that used by the Ninth Circuit.⁷⁸ Factors examined by the Ninth Circuit include:

- Strength of the mark;
- Proximity of the goods;
- Similarity of the marks;
- Evidence of actual confusion;
- Marketing channels used;
- Type of goods and the degree of care likely to be exercised by the purchaser;
- Defendant’s intent in selecting the mark; and
- Likelihood of expansion of the product lines⁷⁹

Trademarks enjoy even more robust protection under the Federal Trademark Dilution Act of 1998 (“FTDA”).⁸⁰ This statute protects “[t]he owner of a famous mark . . . against another person’s commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark.”⁸¹ As Judge Kozinski of the Ninth Circuit Court of Appeals explained, “[t]o be dilutive, use of the mark need not bring to mind the junior user alone. The distinctiveness of the mark is diminished if the mark no longer brings to mind the senior user alone.”⁸² Notably, when

⁷⁷ Lanham Act of 1946 § 43(a), 15 U.S.C. § 1127 (2006).

⁷⁸ See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), *rev’d in part* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

⁷⁹ *Sleekcraft Boats*, 599 F.2d at 348–49. The Second Circuit’s likelihood of confusion test, based on *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), is nearly identical. See *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009).

⁸⁰ 15 U.S.C. § 1125(c).

⁸¹ *Id.* § 1125(c)(1).

⁸² *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 904 (9th Cir. 2002).

proceeding under a dilution theory, a plaintiff need not prove likelihood of consumer confusion or mistake as to source.⁸³

B. Copyright

Unlike trademark, whose constitutional authorization is embedded in the Commerce Clause, copyright derives its authority from Article I, § 8, clause 8 of the Constitution, the Intellectual Property Clause, which states: “The Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁸⁴ In the modern seminal case interpreting this constitutional provision, *Feist Publications, Inc. v. Rural Telephone Services*,⁸⁵ the Supreme Court explained that “[t]he primary objective of copyright is not to reward the labor of authors, but ‘to promote the Progress of Science and useful Arts.’”⁸⁶

Copyright protects “original works of authorship” as soon as they are “fixed in any tangible medium of expression.”⁸⁷ Works of authorship include “literary” and “dramatic works,” as well as “motion pictures and other audiovisual works.”⁸⁸ The Supreme Court has explained that “[t]he *sine qua non* of copyright is originality”⁸⁹ and that “[o]riginal, as the term is used in copyright, means only that the work was independently created by the author . . . and that it possesses some minimal degree of creativity. . . .

⁸³ 15 U.S.C. § 1125(c)(1) (“Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, *regardless of the presence or absence of actual or likely confusion*, of competition, or of actual economic injury.”) (emphasis added).

⁸⁴ U.S. CONST., art. I, § 8, cl. 8.

⁸⁵ 499 U.S. 340 (1991).

⁸⁶ *Id.* at 349. In so holding, the court expressly rejected the theory that a telephone directory was entitled to copyright protection on the basis of the labor expended by the compiler of the directory. *Id.* at 362 (“[t]he selection, coordination, and arrangement of Rural’s white pages do not satisfy the minimum constitutional standards for copyright protection.”).

⁸⁷ 17 U.S.C. § 102(a).

⁸⁸ *Id.*

⁸⁹ *Feist Publ’ns, Inc. v. Rural Tel. Servs.*, 499 U.S. 340, 345 (1991).

[T]he requisite degree of creativity is extremely low; even a slight amount will suffice.”⁹⁰

Copyright thus protects minimally creative artistic expression, but it does not protect the underlying idea itself.⁹¹ Accordingly, where there is only one, or there are very few ways of expressing an idea, the idea and the expression are said to “merge” and the expression is rendered uncopyrightable.⁹² The Court of Appeals for the First Circuit explained that the rationale for the rule was to prevent the appropriation of the subject matter as a whole to the holder of the copyright in the form in which the idea is expressed.⁹³ For the same reason, the doctrine of *scenes-à-faire* prevents the copyrighting of the “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.”⁹⁴

As Leslie Kurtz notes, “Character is a part of a work that is protected by copyright, but is not itself the subject of copyright.”⁹⁵ Thus, a character can receive copyright protection if it is sufficiently well delineated in a larger literary or artistic work.⁹⁶

⁹⁰ *Id.*; see also Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 Nw. U. L. REV. (forthcoming 2010) (explaining that copyright’s low bar to protection for creative works aligns with the public’s psychological preference for an artistic marketplace featuring a large number of new works of moderate originality rather than a more limited marketplace of highly innovative works).

⁹¹ 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

⁹² See *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678 (1st Cir. 1967) (“When the uncopyrightable subject matter is very narrow, so that ‘the topic necessarily requires,’ if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance.”) (citations omitted).

⁹³ *Id.* at 679; see also *Baker v. Selden*, 101 U.S. 99, 107 (1879) (holding that “blank account-books are not the subject of copyright; and that the mere copyright . . . did not confer upon [the Plaintiff] the exclusive right to make and use account-books”).

⁹⁴ *Atari, Inc. v. N. Am. Phillips Consumer Elecs.*, 672 F.2d 607, 616 (7th Cir. 1982) (citing *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978)).

⁹⁵ Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 440.

⁹⁶ See *Anderson v. Stallone*, 11 U.S.P.Q.2d 1161, 1166 (C.D. Cal. 1989) (holding that as a matter of law, the characters at issue in the defendant’s movie “Rocky” were

Of course, the flip side of this doctrine is that “the less developed the characters, the less they can be copyrighted.”⁹⁷ In the landmark case of *Nichols v. Universal Pictures Corp.*,⁹⁸ Judge Learned Hand noted that copyright law cannot be limited to the text of a creative work, “else a plagiarist would escape by immaterial variations.”⁹⁹ Instead, Judge Hand proposed comparing the two works through a “series of abstractions.”¹⁰⁰ Later courts applying this language consider the work through such abstractions, filter out that expression which is unprotectable, and determine if a “reasonable observer could find [what remains] substantially similar beyond the level of generalized or otherwise nonprotectible ideas.”¹⁰¹ Substantial similarity is a necessarily amorphous concept. As Judge Hand explained in *Nichols*, themes and broad ideas in plays and literature are not protected by the copyright in the work as these are no more than the author’s ideas. In *Nichols*, for example, Judge Hand considered a claim that the defendant’s movie *The Cohens and The Kellys* infringed the plaintiffs play *Abie’s Irish Rose*.¹⁰² Among other things, Judge Hand found that one pair of the plaintiff’s characters were little more than “low comedy” “stock figures” and another were “so faintly indicated as to be no more than stage properties.”¹⁰³ Accordingly, the *Nichols* court held, the plaintiff’s copyright in *Abie’s Irish Rose* did not protect these characters and the defendant’s use of similar characters did not infringe the plaintiff’s copyright.¹⁰⁴

The Second Circuit uses a two-part test for copyright infringement: “(a) that the defendant copied from the plaintiff’s copyrighted work and (b) that the copying . . . went so far as to constitute improper appropriation.”¹⁰⁵ The court has held that the

“delineated so extensively that they [were] protected from bodily appropriation when taken as a group and transposed into a sequel by another author”).

⁹⁷ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

⁹⁸ 45 F.2d 119 (2d Cir. 1930).

⁹⁹ *Id.* at 121.

¹⁰⁰ *Id.*

¹⁰¹ *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 49 (2d Cir. 1986).

¹⁰² *Nichols*, 45 F.2d at 120.

¹⁰³ *Id.* at 122.

¹⁰⁴ *Id.*

¹⁰⁵ *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

evidence of copying could be proved either by “defendant’s admission” or “circumstantial evidence” of access.¹⁰⁶ “A party can establish access either by demonstrating that (1) the infringed work has been widely disseminated or (2) a particular chain of events exists by which the alleged infringer might have gained access to the copyrighted work.”¹⁰⁷ Where access to protectable expression is found, only substantial similarity between the original work and the allegedly copying work “will support a determination of infringement.”¹⁰⁸

Not every use of copyrighted material is an infringing use, however; fair use is an affirmative defense to copyright infringement.¹⁰⁹ This defense protects use of copyrighted material for purposes such as “criticism, comment, news reporting, teaching . . . scholarship, or research.”¹¹⁰ In analyzing whether a use is indeed fair, courts consider:

- the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- the nature of the copyrighted work;
- the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

¹⁰⁶ *Id.*

¹⁰⁷ *Repp v. Webber*, 947 F. Supp. 105, 114 (S.D.N.Y. 1996) (citation omitted).

¹⁰⁸ *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 913 (2d Cir. 1980); *see also* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A][2][a] (Matthew Bender rev. ed. 2010) (“The question in each case is whether the similarity relates to matter that constitutes a substantial portion of the plaintiff’s work—not whether such material constitutes a substantial portion of defendant’s work. . . . The quantitative relation of the similar material to the total material contained in plaintiff’s work is certainly of importance. However, even if the similar material is quantitatively small, if it is qualitatively important, the trier of fact may properly find substantial similarity. . . . [U]nder such circumstances the defendant may not claim immunity on the grounds the infringement ‘is such a little one.’ If, however, the similarity is only as to nonessential matters, then a finding of no substantial similarity should result.”).

¹⁰⁹ 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05 (Matthew Bender rev. ed. 2010).

¹¹⁰ 17 U.S.C. § 107 (2006).

- the effect of the use upon the potential market for or value of the copyrighted work.¹¹¹

The maxim *de minimis non curat lex*—the law does not concern itself with trivialities—“applies to copyright actions no less than to other branches of law.”¹¹² As used in copyright law, the doctrine means simply that “trivial copying is not an infringement.”¹¹³ As Judge Leval of the Second Circuit Court of Appeals explained:

The *de minimis* doctrine is rarely discussed in copyright opinions because suits are rarely brought over trivial instances of copying. Nonetheless, it is an important aspect of the law of copyright. Trivial copying is a significant part of modern life. . . . Parents in Central Park photograph their children perched on José de Creeft’s Alice in Wonderland sculpture. We record television programs aired while we are out, so as to watch them at a more convenient hour. Waiters at a restaurant sing “Happy Birthday” at a patron’s table. When we do such things, it is not that we are breaking the law but unlikely to be sued given the high cost of litigation. Because of the *de minimis* doctrine, in trivial instances of copying, we are in fact not breaking the law.¹¹⁴

However, while the doctrine permits “literal copying of a small and usually insignificant portion of the plaintiff’s work,”¹¹⁵ courts are careful to note that “even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity.”¹¹⁶ Unsurprisingly, then, when the subject of a copyright infringement

¹¹¹ *Id.* § 107(1)–(4).

¹¹² 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.01[G] (Matthew Bender rev. ed. 2010).

¹¹³ *Davis v. Gap, Inc.*, 246 F.3d 152, 173 (2d Cir. 2001).

¹¹⁴ *Id.*

¹¹⁵ *Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 242 (2d Cir. 1983).

¹¹⁶ *CyberMedia, Inc. v. Symantec Corp.*, 19 F. Supp. 2d 1070, 1077 (N.D. Cal. 1998) (quoting *Baxter v. MCA, Inc.*, 812 F.2d 421, 425 (9th Cir. 1987)).

action is a word or short phrase, this “qualitatively substantial” doctrine comes in conflict with the *de minimis* doctrine.

The regulations and policies promulgated by the United States Copyright Office particularly affect words and short phrases such as those embodied in fictional trademarks like “Duff Beer.” In 1958, the Copyright Office issued a circular stating:

To be entitled to copyright protection, a work must contain something capable of being copyrighted—that is, an appreciable amount of original text or pictorial material. . . . Brand names, trade names, slogans, and other short phrases or expressions cannot be copyrighted, even if they are distinctively arranged or printed.¹¹⁷

The circular suggests that such phrases are better addressed under the laws of trademark and unfair competition.¹¹⁸ The following year, the Copyright Office enacted 37 C.F.R. § 202.1, refusing registration, *inter alia*, for “[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents.”¹¹⁹ This regulatory bar against copyright protection for words and short phrases “has historically been justified with copyright’s ‘originality’ requirement: A small expression is deemed to lack sufficient originality.”¹²⁰

¹¹⁷ See *Southco, Inc. v. Kanebridge Corp.* 390 F.3d 276, 285 (3d Cir. 2004) (quoting U.S. COPYRIGHT OFFICE, CIRCULAR NO. 46, COPYRIGHT IN COMMERCIAL PRINTS AND LABELS (1958) [hereinafter COPYRIGHT IN COMMERCIAL PRINTS AND LABELS]). The current version of this circular is CIRCULAR NO. 34, COPYRIGHT PROTECTION NOT AVAILABLE FOR NAMES, TITLES, OR SHORT PHRASES (2009) [hereinafter COPYRIGHT PROTECTION NOT AVAILABLE FOR NAMES, TITLES OR SHORT PHRASES], available at <http://www.copyright.gov/circs/circ34.pdf>.

¹¹⁸ COPYRIGHT IN COMMERCIAL PRINTS AND LABELS, *supra* note 117. The current version of the Circular states, “Some brand names, trade names, slogans, and phrases may be entitled to protection under laws relating to unfair competition, or they may be entitled to protection and registration under the provisions of state or federal trademark laws. . . . The Copyright Office has no role in these matters.” See COPYRIGHT PROTECTION NOT AVAILABLE FOR NAMES, TITLES, OR SHORT PHRASES, *supra* note 117.

¹¹⁹ 37 C.F.R. § 202.1 (2010).

¹²⁰ Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 FORDHAM L. REV. 575, 578 (2005).

Because copyright protection attaches automatically to a work as soon as it is “fixed in a tangible medium of expression,”¹²¹ registration of the work with the Copyright Office is permissive and is not required for copyright protection to attach.¹²² However, because the copyright statute provides that “no civil action for infringement of the copyright in any United States work shall be instituted until registration of the copyright claim has been made”¹²³ with the Copyright Office, the filing of an application for registration is “a condition precedent for an infringement case to move forward in federal court.”¹²⁴ Importantly, however, the statute does not require the registration to have actually been approved for an infringement suit to proceed. The Copyright Act provides that

where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.¹²⁵

Therefore, while the registration requirement may erect a speed bump in the path of an impending copyright litigation, and may even involve the Copyright Office intervening in the litigation and arguing as to its merits, the Copyright Office’s refusal to register a work cannot prevent even an unmeritorious infringement action from going to trial.

¹²¹ 17 U.S.C. § 102 (2006).

¹²² *Id.* § 408(a).

¹²³ *Id.* § 411(a).

¹²⁴ MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][1][a] (Matthew Bender rev. ed. 2010). The Supreme Court recently classified 17 U.S.C. § 411(a)’s registration requirement as a “claim-processing” rule, i.e., “a precondition to filing a claim that does not restrict a federal court’s subject-matter jurisdiction.” *Reid Elsevier v. Muchnick*, 130 S. Ct. 1237, 1243 (2010). However, the Court declined to address whether “district courts may or should enforce [§ 411(a)’s registration requirement] *sua sponte* by dismissing copyright infringement claims involving unregistered works.” *Id.* at 1249.

¹²⁵ 17 U.S.C. § 411(a).

There is some disagreement among courts as to the role the *de minimis* doctrine and § 202.1 play in determining if a word or short phrase can ever be copyrightable. In *Alberto-Culver Co. v. Andrea Dumon, Inc.*,¹²⁶ the Seventh Circuit found that a phrase on the packaging of the plaintiff's product, "the most personal sort of deodorant," was not subject to copyright protection because it was "merely a short phrase or expression which hardly qualifies as an appreciable amount of original text."¹²⁷ The court further held that "to the extent that the phrase was connected with the artwork by different typography than the rest of the text, it is not protected because . . . mere distinctiveness in typographic ornamentation will not ordinarily qualify otherwise noncopyrightable material for copyright protection."¹²⁸ The Second Circuit took a similar approach in *Kitchens of Sara Lee, Inc. v. Nifty Foods Corp.*¹²⁹ in 1959, echoing the language of the 1958 Copyright Office circular: "[b]rand names, trade names, slogans, and other short phrases or expressions cannot be copyrighted, even if they are distinctively arranged or printed."¹³⁰ Taken together, these two cases appear to close the door to any copyright protection in a trademark.

By contrast, several more recent cases appear to re-open the possibility of copyright in a single word or a short phrase. For example, in *Narell v. Freeman*,¹³¹ Judge Farris characterized the title of a Frank Zappa song, "Weasels Ripped My Flesh" as an "original and hence protected phrase."¹³² Similarly in *Life Music, Inc. v. Wonderland Music Co.*,¹³³ the court stated in dicta that copyright protection might be available for the single invented word, "supercalifragilisticexpialidocious."¹³⁴ In *Bird v.*

¹²⁶ 466 F.2 705 (7th Cir. 1972).

¹²⁷ *Id.* at 711 (internal quotation marks omitted).

¹²⁸ *Id.*

¹²⁹ 266 F.2d 541 (2d Cir. 1959).

¹³⁰ *Id.* at 544.

¹³¹ 872 F.2d 907 (9th Cir. 1989).

¹³² *Id.* at 911.

¹³³ 241 F. Supp. 653 (S.D.N.Y. 1965).

¹³⁴ *Id.* at 656 ("[E]ven if defendants copied only 'the word' [supercalifragilisticexpialidocious], they conceivably might still be liable for infringement."); *see also* Tree Publ'g Co. v. Warner Bros. Records, 785 F. Supp. 1272, 1275 (M.D. Tenn. 1991) (citing *Life Music* approvingly and characterizing the word "supercalifragilisticexpialidocious" as "capriciously fanciful").

Parsons,¹³⁵ the Sixth Circuit noted that “copyright *ordinarily* does not subsist in a single word”¹³⁶ and that in the case of “financia,” the plaintiff’s “claim that the word derives from another language suggests a lack of originality and creativity.”¹³⁷ The court held that the “defendants’ alleged use of the word ‘efinancia’ [in its domain name] simply does not reproduce any of the creativity that entitles Bird to a copyright in the computer program titled Financia.”¹³⁸ Instead, the court held that because “the word derives from another language” it lacked “originality and creativity.”¹³⁹

In *Cook v. Robbins*,¹⁴⁰ an unpublished opinion from the Ninth Circuit, the court went even further. In that case, plaintiff Cook had written a book entitled “Wall Street Money Machine,” which shared strategies for investing in stocks which Cook had distilled from his experience as a cab driver. Two of the book’s prominent themes were the idea of a “meter drop,” that is, Cook’s experience that “he could make more money taking numerous short trips than by waiting for higher fares,” and the concept of a “rolling stock”: a stock that “tends to consistently roll up to a specific price point and then drop down to a specific price point in an obvious pattern of repeated waves.”¹⁴¹ When Robbins used Cook’s phrases in his Financial Power seminar manual, Cook sued for copyright infringement. At trial, the jury found for Cook and awarded \$655,900 in damages but the district court granted judgment as a matter of law for the defendant because it found that “Cook failed to prove that any of [Robbins’] profits were attributable to phrases from [Cook’s] book.”¹⁴² Citing *Feist*, the Ninth Circuit reinstated the award holding that “Cook’s complete expressions in conveying the meaning of ‘meter drop’ and ‘rolling stock’ are creative, even

¹³⁵ 289 F.3d 865 (6th Cir. 2002).

¹³⁶ *Id.* at 881 (emphasis added).

¹³⁷ *Id.* at 882; *cf.* *Santrayll v. Burrell* 39 U.S.P.Q.2d 1052, 1054 (S.D.N.Y. 1996) (finding that “the repetition of the non-protectible word ‘uh-oh’ in a distinctive rhythm comprises a sufficiently original composition to render it protectible by the copyright laws”).

¹³⁸ *Parsons*, 289 F.3d at 881.

¹³⁹ *Id.* at 882.

¹⁴⁰ Nos. 98-36242, 99-35141, 14695 (9th Cir. filed Nov. 6, 2000), *available at* http://www.american-justice.org/upload/page/108/65/cook_v_robbins.pdf.

¹⁴¹ *Id.* at 14700.

¹⁴² *Id.* at 14699.

if only minimally so, and are protected by his copyright in Wall Street Money Machine.”¹⁴³ The parties eventually settled, but not before the Copyright Office “proposed that the U.S. intervene to request rehearing en banc” out of concern that the holding “would undermine Rule 202.1.”¹⁴⁴ The Ninth Circuit subsequently ordered the opinion unpublished.¹⁴⁵ Unsurprisingly, Justin Hughes remarks that “it is hard to think of a better example of the qualitatively substantial doctrine than *Cook v. Robbins*.”¹⁴⁶

More recently, in *Southco, Inc. v. Kanebridge Corp.*,¹⁴⁷ the Third Circuit, sitting en banc, held that a system of part numbers used by a manufacturer of screw fasteners was excluded from copyright protection because it was “not original”¹⁴⁸ and for the independent reason that the numbers themselves were “analogous to short phrases or the titles of works.”¹⁴⁹ Acting as amicus curiae, the United States submitted that the Register of Copyrights, relying on § 202.1, “routinely and categorically denies protection to all part numbers, no matter how creative.”¹⁵⁰ Citing § 202.1 and the 1958 Copyright Office circular, the majority held that “the Copyright Office’s longstanding practice of denying registration to short phrases merits deference.”¹⁵¹

Judge Roth, joined by Judge Chertoff dissented, challenging the majority’s view of the conclusiveness of the *de minimis* doctrine and the regulation: “even if Southco’s part numbers were properly considered ‘short phrases,’ § 202.1 is best understood as a rough starting point for an originality analysis, not a shortcut for avoiding this analysis.”¹⁵² Noting that “[s]hort phrases are typically unprotectable because they are either insufficiently independent or insufficiently creative or both,” Judge Roth argued that “it does not make sense to state categorically that no

¹⁴³ *Id.* at 14711.

¹⁴⁴ Hughes, *supra* note 120, at 591.

¹⁴⁵ *Cook v. Robbins*, 232 F.3d 736 (9th Cir. 2001).

¹⁴⁶ Hughes, *supra* note 120, at 589.

¹⁴⁷ 390 F.3d 276 (3d Cir. 2004) (en banc).

¹⁴⁸ *Id.* at 282.

¹⁴⁹ *Id.* at 285.

¹⁵⁰ *Id.* at 297 (internal quotation marks omitted).

¹⁵¹ *Id.* at 286.

¹⁵² *Id.* at 298 (Roth, J., dissenting).

combination of numbers or words short enough to be deemed a ‘phrase’ can possess ‘at least some minimal degree of creativity’” as required by the Supreme Court under *Feist*.¹⁵³ Therefore, she argued, “it would seem (notwithstanding [§ 202.1]) that even a short phrase may command copyright protection if it exhibits sufficient creativity.”¹⁵⁴ This analysis was cited with approval by Judge Kane of the United States District Court for the District of Colorado in 2009.¹⁵⁵

The next Part applies the two doctrines outlined above to the fictional trademark problem and highlights the strengths and weaknesses of proceeding under either doctrine.

II. A TRADEMARK OR A COPYRIGHT INJURY?

Fox and *The Simpsons*’ creator, Matt Groening, developed the idea for the fictional brand, Duff. Therefore, when a real-world manufacturer puts out a product by the same name, one might think that it has stolen Fox’s idea and that, as a matter of equity, intellectual property law ought to furnish a remedy. But intellectual property law does not protect ideas in the abstract.¹⁵⁶ While a real-world Duff manufacturer may have taken more than just an idea, it is difficult to articulate how much more. Part of the reason it is so difficult to conceptualize the injury Fox suffers when another producer introduces a Duff Beer to the marketplace stems from the fact that Duff Beer is a fictional product sold in a fictional universe under a fictional brand name. Fox’s injury looks very different when we suspend our disbelief and plunge into the

¹⁵³ *Id.*

¹⁵⁴ *Id.* (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01[B] (3d ed. 1994)).

¹⁵⁵ See *Health Grades, Inc. v. Robert Wood Johnson Univ. Hosp., Inc.*, 634 F. Supp. 2d 1226, 1238 (D. Colo. 2009) (“I am persuaded by Judge Roth that the Copyright Office’s regulation does not strip copyright protection from . . . original expressions [which are manifested in short phrases].”).

¹⁵⁶ Compare 17 U.S.C. § 101 (2006) (providing copyright protection for creative expression, but not the idea underlying that expression, as soon as the expression is fixed “in a tangible medium”), with 35 U.S.C. § 101 (providing protection for functional matter which meets the requirements of novelty, utility, non-obviousness and other statutory criteria), and 15 U.S.C. § 1052 (providing protection for symbols used as designations of source in commerce).

fictional world of Springfield, accepting the fictional reality as our own and when we pull back, remind ourselves that *The Simpsons* is nothing more than a cartoon and view Duff Beer as one element of a vividly imagined work of animated fiction. As a consequence of this puzzle of perspective, Fox suffers a different intellectual property injury depending on our vantage point.

An analogy to Internet law helps explicate the puzzle. Writing on the problem of perspective in this area of the law, Professor Orin Kerr posits that “whenever we apply law to the Internet, we must first decide whether to apply the law to the facts as seen from the viewpoint of physical reality or virtual reality.”¹⁵⁷ Kerr terms the perspective from inside virtual reality the “‘internal perspective’ of the Internet” and the point of view of an “outsider concerned with the functioning of the network in the physical world rather than the perceptions of a user” the “external perspective.”¹⁵⁸ In attempting to apply law to the Internet, our perception of who is doing what to whom is not a mere cognitive tool for conceptualizing difficult problems, Kerr contends. Instead, our selection of perspective is itself outcome determinative, because “[b]y choosing the perspective, we choose the reality; by choosing the reality, we choose the facts; and by choosing the facts, we choose the law.”¹⁵⁹ While Kerr suggests that courts may dismiss this problem of perspective as “a minor skirmish in the ‘battle of analogies,’” he notes that courts “*already* choose perspectives when they apply law to the Internet” without realizing it.¹⁶⁰

The analogy to Internet law is not a perfect fit. For one thing, while the Internet is interactive, such that users can participate in the virtual world, even creating and trading on their own marks within that world,¹⁶¹ Springfield is a closed universe: we can enjoy it only as it is presented to us by Fox. Nevertheless, the fictional world of Springfield is, like the Internet, a vast virtual world. We

¹⁵⁷ Orin Kerr, *The Problem of Perspective in Internet Law*, 91 GEO. L.J. 357, 357 (2003).

¹⁵⁸ *Id.* at 359–60.

¹⁵⁹ *Id.* at 361.

¹⁶⁰ *Id.* at 381.

¹⁶¹ *See infra* Part III.

can understand it, as we can the Internet, from an internal perspective, wherein Duff Beer is real and dominates the marketplace or from the external perspective in which we are aware that Duff is a parody: a farcical wink at popular culture embedded in a work of pure fiction. Kerr's methodology is thus a good fit for the problem of fictional trademarks as well, because it provides an analytical framework for exploring how the ontology of a fictional mark, like our understanding of the "facts" of the Internet, changes depending on our perspective. As with Internet law, by choosing the perspective, we choose to view Duff either as a real beer which has really been used in commerce, or as a colorful aspect of a fictional work which is used to entertain. By choosing between these versions of reality, we choose the legal remedies available. Thus, Kerr's lens of perspective helps us identify two different versions of a story Fox can tell in court, and in turn, suggests the law to be applied.

Viewing this problem from the internal perspective, that is, from the vantage point of a resident of Springfield, Fox can claim a trademark injury. Having already used Duff Beer as a mark, it will argue, the breweries' latter use of the mark as an indicator of source for beer is likely to lead to consumer confusion as to the origin of the beer.¹⁶² Fox can also bring an action for dilution, alleging that the breweries' use of the name "Duff" weakens the distinctiveness of its famous mark even if it is not being used on beer.¹⁶³ Proceeding under a dilution theory, Duff would not even have to make out a showing of a likelihood of consumer confusion.

Fox could also view the situation from the external perspective. Seen this way, Duff Beer is a significant element of its literary property, *The Simpsons*. Because the expression of a parodic beer with an unflattering name is minimally creative artistic expression fixed in the tangible medium of film, the breweries' appropriation of Fox's original expression might constitute a copyright injury.¹⁶⁴

Both of these theories accurately provide a way of conceptualizing the injury Fox suffers from the breweries' actions,

¹⁶² See *infra* Part III.

¹⁶³ See 15 U.S.C. § 1125(c)(1) (2006).

¹⁶⁴ See 17 U.S.C. § 102(a).

yet both are doctrinally problematic. While Duff Beer is itself a brand name (albeit a fictional one) Duff would have had to have used the mark in commerce to reserve rights in the mark.¹⁶⁵ That being so, the court would have to find that Fox and Groening's use of "Duff" within the fictional world of Springfield is sufficient to establish priority in the mark such that another's use of that mark would constitute trademark infringement. The copyright theory is troublesome as well. While it is perhaps more intellectually honest to say that the only way Fox has really *used* the mark has been as part of the texture of its literary property, *The Simpsons*, copyright law's *de minimis* doctrine may permit the use of the word "Duff" on beer and declines independent protection for words and short phrases such as "Duff Beer." Thus, if a copyist took Duff Beer and all of Homer Simpson with it, Fox could easily establish copyright infringement. But if a copyist takes no more than the words "Duff Beer" and even the Duff label, it is difficult to argue that this expression is substantial enough to be protected by Fox's copyright in *The Simpsons*. This Part explores whether either doctrine can or should furnish fictional trademarks with real-life protection.

A. *The Trademark Theory of Fictional Trademarks*

Taking the internal perspective and assuming a traditional trademark infringement scenario, i.e., that Duff's competitor is a junior user making a product called "Duff Beer" in Springfield, trademark law endows Duff with a full doctrinal arsenal.

If Springfield were within the jurisdiction of American federal law, and a competitor of Duff manufactured and sold a rival product, also called Duff Beer, the original Duff would have an easy case. The original Duff—the senior user—would merely have to prove that it had made bona fide use of the mark in commerce in connection with the sale of goods, and that "the defendant's use of that mark is likely to cause [consumer]

¹⁶⁵ See 15 U.S.C. § 1051(a); see also *Zazu Designs v. L'Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992).

confusion as to the affiliation, connection, or association of the defendant with the plaintiff” as a result.¹⁶⁶

Within the fictional world of Springfield, Duff has a strong, distinctive mark.¹⁶⁷ It would be an understatement to say that Duff Brewery has used the mark in commerce as a designation of source in connection with the sale of beer. Advancing to the likelihood of confusion analysis, a court would likely emphasize the strength of the mark (in the case of Duff, a strong, distinctive mark, made more so by Duff’s extensive advertising), proximity of the goods (both are beers) the similarity of the marks (the marks are identical) and perhaps most significantly, the defendant’s intent in selecting the mark (a court will almost certainly infer that the junior user’s use of “Duff” as a trademark for beer strongly indicates its intent to divert business from the senior user). In this scenario, Duff would win handily.

Even if a new market entrant were to manufacture Duff shoes, or Duff automobile parts, Duff would have an easy dilution case. Given its extensive market penetration, Duff would easily establish its fame and would be virtually certain to succeed on its claim that the junior user’s use of the mark would dilute Duff’s mark by blurring: that is, by weakening the mark’s uniqueness in the public’s eyes.¹⁶⁸

But take the junior user out of Springfield, into the real world, and all bets are off. The major hurdle for Duff is priority. Within Springfield, Duff easily meets this requirement by means of its use

¹⁶⁶ 1-800 Contacts, Inc. v. WhenU.com, 414 F.3d 400 (2d Cir. 2005) (alteration in original) (citation omitted).

¹⁶⁷ A court would almost certainly find the mark to be a suggestive mark (i.e., suggesting either that in sufficient quantities, it transforms the consumer into a lumbering clod or causes him to spend a significant amount of time on his rear end). See *Twentieth Century Fox Film Corp. v S. Austl. Brewing Co.* [1996] 66 FCR 451, 455 (Austl.) (“It is fair to say that the beer and its consumption are not shown in a favourable light.”).

¹⁶⁸ Because of trademark law’s balancing act vis-à-vis the First Amendment, however, a book or educational video about Duff Beer would be a permissible use of the mark. Similarly, Fudd, Duff’s rival from the fictional town of Shelbyville, is free to run an ad contending that “Fudd tastes better than Duff.” See *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 904 (9th Cir. 2002) (“These are uses that, though potentially dilutive, are nevertheless permitted: comparative advertising; news reporting and commentary; and noncommercial use.”) (quoting 15 U.S.C. § 1125(c)(4)(B)).

of the mark on its beer as well as on Duff Gardens and in associated advertising. Here in the real world, however, it is much harder to establish that Duff and its creators Groening and Fox have actually *used* the mark in commerce such as to establish priority in the mark. Indeed, as “[t]he use requirement rewards those who act quickly in getting new products in the hands of consumers,”¹⁶⁹ courts may be more sympathetic to the Rodrigo Contrerases of the world who make diligent efforts to speed new products to market—particularly those for which there is ample demand.

Courts considering these issues in two prominent fictional trademark cases found a real-life trademark injury for the appropriation of fictional trademarks. This Note now considers both in turn.

1. *DC Comics, Inc. v. Powers*

In *DC Comics, Inc. v. Powers*,¹⁷⁰ DC Comics sued Jerry Powers, the publisher of an “alternate culture” publication calling itself *The Daily Planet*—the same name as “the fictional Metropolis newspaper which employs Superman’s alter ego”¹⁷¹—from DC’s *Superman* comic book series. DC Comics sued Powers in the U.S. District Court for the Southern District of New York under section 43(a) of the Lanham Act.¹⁷² Powers moved for a preliminary injunction “to preclude [DC Comics] from any use of the name Daily Planet” and DC Comics cross-moved for injunctive relief “seeking to preclude [Powers] from any use of the Daily Planet.”¹⁷³ While Powers had at one point registered the name *The Daily Planet* as a trademark for his newspaper, the newspaper folded in 1973 and the mark was cancelled by the United States Patent and Trademark Office in 1976.¹⁷⁴ Both DC Comics and Powers claimed exclusive rights to use of *The Daily Planet*, based

¹⁶⁹ *Zazu Designs v. L’Oreal, S.A.*, 979 F.2d 499, 504 (7th Cir. 1992).

¹⁷⁰ 465 F. Supp. 843 (S.D.N.Y. 1978).

¹⁷¹ *Id.* at 845.

¹⁷² *Id.*; see Lanham Act of 1946 § 43(a), 15 U.S.C. § 1125(a) (“[F]alse designation of origin”).

¹⁷³ *Powers*, 465 F. Supp. at 845–46.

¹⁷⁴ *Id.* at 847.

on their prior use of the name. As the court noted, however, what was “really at issue” was whether either party would be “entitled to exclusive exploitation of the name Daily Planet based on the expected wave of public interest in the Superman character calculated to result from the release of the Superman movie” that year.¹⁷⁵

The court began by analyzing the comparative use of the mark by both DC Comics and Powers. Noting that *The Daily Planet* first appeared in the Superman story in 1940, the court emphasized that since that time, the fictional newspaper had “played a key role, not only in the development of the Superman story, but also in the development of the Superman character.”¹⁷⁶ The court emphasized that DC had “gone to great effort and expense throughout the long history of Superman to utilize the Superman character in connection with a myriad of products born of the Superman story.”¹⁷⁷ While the fictional paper “was never singled out” in any of DC’s many licensing agreements for use of the *Superman* characters, the court noted that it was “part and parcel of the typical licensing agreement” and that the fictional newspaper had been “prominently featured on many products emanating from these licensing agreements.”¹⁷⁸ The court contrasted DC’s use of *The Daily Planet* with Powers’ use of the mark, which it characterized as “brief and, at best, sporadic.”¹⁷⁹ Accordingly, the court found that “only [DC Comics] has demonstrated an association of such duration and consistency with the Daily Planet sufficient to establish a common law trademark therein” and noted that “the Daily Planet has over the years become inextricably woven into the fabric of the Superman story.”¹⁸⁰

In holding that plaintiff DC Comics had “demonstrated a probability of success on the merits sufficient to warrant” the grant of an injunction against Powers’ use of *The Daily Planet*, the court

¹⁷⁵ *Id.* at 846.

¹⁷⁶ *Id.* at 847.

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

suggested two rationales underpinning its decision.¹⁸¹ It emphasized that “plaintiff has . . . engaged in extensive licensing of the Superman character as well as the Superman story covering a myriad of products” and “the Daily Planet has played a key role in many of these licensing agreements.”¹⁸² It also noted that “the Daily Planet has become so closely associated with the presentation of the Superman *story* that any use thereof by defendants would create a substantial likelihood of confusion at the consumer level.”¹⁸³ The court concluded that it was thus “quite apparent that defendants, both in adopting the Daily Planet as the title of their newspaper and in its publication, intended to at least confuse, if not to deceive the public as to the origin of the publication.”¹⁸⁴

The licensing agreements certainly represent real-world uses in commerce and appear to have been central to the court’s finding that DC Comics possessed a common law trademark in *The Daily Planet*. Further, while the court leans heavily on DC’s use of the fictional paper to advance the *Superman* story, it is unclear if it would have concluded that use of *The Daily Planet* in the story, without more, was sufficient to support a finding of the existence of a trademark.

2. *Twentieth Century Fox Film Corp. v South Australian Brewing Co.*

In a 1996 Australian case, *Twentieth Century Fox Film Corp. v South Australian Brewing Co.*,¹⁸⁵ Fox and *The Simpsons*’ creator, Matt Groening (“the producers”), brought suit against South Australian Brewing Co. and Lion Nathan Australia (“the breweries”) seeking to enjoin them “from promoting or dealing with any product in the form of a can . . . with the wording, get-up¹⁸⁶ and name” of the fictional Duff Beer.¹⁸⁷ The plaintiffs

¹⁸¹ *Id.* at 848.

¹⁸² *Id.*

¹⁸³ *Id.* at 848–49 (emphasis added).

¹⁸⁴ *Id.* at 849.

¹⁸⁵ [1996] 66 FCR 451 (Austl.).

¹⁸⁶ Also known as trade dress.

¹⁸⁷ *Twentieth Century Fox Film Corp. v S. Austl. Brewing Co.* [1996] 66 FCR 451, 453 (Austl.).

proceeded on two causes of action. The first alleged breach of section 52 of the Trade Practices Act of 1974 under Australian law.¹⁸⁸ While the Act does not mention the use of marks or symbols at all, its language and policy rationale (i.e., consumer protection) suggest that it is best construed as the Australian analogue of section 43(a) of the Lanham Act.¹⁸⁹ The producers also brought a cause of action for “passing off”¹⁹⁰—that is, for attempting to pass off the breweries’ goods as originating with the producers—a common law tort in Australia, which is also subsumed under section 43(a) of the Lanham Act in American law.¹⁹¹

¹⁸⁸ *Trade Practices Act 1974* (Cth) s 52 (Austl.). Entitled “Misleading or deceptive conduct,” this provision states that “a corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.” The provision is located under “Part V—Consumer Protection.”

¹⁸⁹ Compare *Trade Practices Act 1974* (Cth) s 52 (Austl.) (“[A] corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive”) with Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2006):

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

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

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

¹⁹⁰ *S. Austl. Brewing Co.*, 66 FCR at 452.

¹⁹¹ *Id.* at 472 (“[F]ive characteristics . . . must be present . . . to create a valid cause of action for passing off: (1) a misrepresentation (2) made by a trader in the course of trade, (3) to respective customers . . . or ultimate consumers of goods supplied by him, (4) which is calculated to injure the business or goodwill of another trader . . . and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought . . .”); see also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28 n.1 (2003) (“Passing off (or palming off as it is sometimes called) occurs when a producer misrepresents his own goods or services as someone else’s. ‘Reverse passing off,’ as its name implies, is the opposite: The producer misrepresents someone else’s goods or services as his own.”). The Court noted that this conduct violates § 43 of the Lanham Act. *Id.* at 30.

The court began by noting that the name “Duff” was conceived by Groening “as the name of an imaginary beer which would be associated particularly with ‘Homer’ and also with his ‘bar-fly’ friends and associates” and that the beer “is assigned an important role in the series viewed as a whole.”¹⁹² The court noted that Fox had licensed clothing manufacturers in Australia to produce caps and T-shirts¹⁹³ and had also released comic books featuring the fictional beer¹⁹⁴ but has “consistently refused to grant licenses to parties who have sought to use ‘The Simpsons’ in connection with alcohol and tobacco products, or other substances considered detrimental to children.”¹⁹⁵ The court also noted that “[t]he evidence clearly establishes that throughout the series there is a clear and pervasive association of ‘Duff Beer’ with ‘Homer’ and other characters such as ‘Barney,’ his friend”¹⁹⁶ and emphasized the show’s “wide coverage, deep market penetration, and broad recognition”¹⁹⁷ resulting in “substantial goodwill and reputation in Australia in relation to the characters, names and images appearing in ‘The Simpsons’ including the name ‘Duff Beer.’”¹⁹⁸

The court found that the name “Duff” had “acquired a powerful secondary meaning” when used in relation to the fictional beer.¹⁹⁹ Indeed, in its view, “it would be artificial in the extreme to suggest that consumers would be attracted by the concept of ‘Duff’ on the basis of its dictionary meaning . . . [the] key attractive features arise from the association with ‘The Simpsons’ and not from any literal dictionary meaning of the word ‘duff.’”²⁰⁰

Importantly, the court noted:

¹⁹² *S. Austl. Brewing Co.*, 66 FCR at 455 (“There is one whole episode substantially devoted to the theme of ‘Duff Beer’ (Duffless) and the name ‘Duff’ features prominently and repeatedly in another 22-minute episode, ‘Selma’s Choice’”).

¹⁹³ *Id.* at 455–56.

¹⁹⁴ *Id.* at 456 (noting that “[t]he merchandise contains references to copyright and to the reserved rights of Groening or Twentieth Century Fox”).

¹⁹⁵ *Id.* at 457.

¹⁹⁶ *Id.* at 458.

¹⁹⁷ *Id.* at 455.

¹⁹⁸ *Id.* at 456.

¹⁹⁹ *Id.* at 465.

²⁰⁰ *Id.*

An unusual aspect of this case, is that it concerns not a fictional ‘character’ as such, but a ‘make-believe’ product, namely the fictional ‘Duff Beer’ which is coupled with a character, a background institution, (Duff Brewery), and also with the associated advertising signs, posters and images of the beer, which play an important role in the series. These features form part of the fictional ‘environment’ in which the stories are played out. It plays a background role as part of the fictional world which the characters inhabit.²⁰¹

The court concluded that “the principles which apply to character image or title association are equally applicable to the name of a product which features in the program, in this instance, ‘Duff Beer.’”²⁰² That being so, the court held that “the deliberate creation by the breweries of an association by use of the name ‘Duff’ between the breweries’ beer can with ‘The Simpsons’ program, in circumstances where there is no association and indeed, where such association is contrary to the express policy of the producers, amounts to misleading and deceptive conduct.”²⁰³ The court found that the producers had successfully made out the elements of passing off as well.²⁰⁴

In both *Powers* and *South Australian*, the courts seem to embrace the principle articulated in *DC Comics, Inc. v. Filmation*

²⁰¹ *Id.* at 465–66.

²⁰² *Id.* at 466.

²⁰³ *Id.* at 470. Although letters from the breweries to vendors made a “tongue-in-cheek” attempt at disassociation from *The Simpsons* (“Oh and (to be serious for a moment) yes we’re aware of the fact that another ‘Duff Beer’ features in ‘The Simpson’s’ [*sic*] TV show. Please note Homer’s favourite drop is a completely separate, fictitious product. We would encourage you *not* to use ‘Simpson’s’ [*sic*] imagery or logos in supporting ‘Duff Beer’ as these are *not* owned by us and in doing so you may run the risk of infringing legal copyright.”), the court found “a notable lack of any attempt to drive this message home to the ‘consuming public.’” *Id.* at 471.

²⁰⁴ *Id.* at 472 (“There has been a misrepresentation as to the association of the goods with ‘The Simpsons,’ made by [the] breweries in the course of trade, to prospective customers or ultimate consumers. It is reasonably foreseeable that the business or goodwill of ‘The Simpsons’ and their licensing and merchandising rights could be adversely affected, particularly in the light of the policy in relation to alcohol promotion.”).

Associates that a significant ingredient of an entertainment work can come to stand for the work in the public mind, and in so doing, becomes a trademark.²⁰⁵ In *Powers*, the court emphasized the role *The Daily Planet* played “not only in the Superman story, but also in the development of the Superman character.”²⁰⁶ Indeed, the court held that any use of the mark by the defendants would “create a substantial likelihood of confusion at the consumer level,”²⁰⁷ precisely “because the Daily Planet has become so closely associated with the presentation of the Superman story.”²⁰⁸ Similarly, in *South Australian*, the court employed *Filmation*-type reasoning in emphasizing the “important role” the “‘make-believe’ product” Duff Beer plays on *The Simpsons*.²⁰⁹

Indeed, the courts in *Powers* and *South Australian* note the efforts of the plaintiffs in those cases to actively forge an association between the fictional mark and the entertainment franchise. The *Powers* court does this in two oblique ways. First, it states that the “plaintiff has gone to great effort and expense throughout the long history of Superman to utilize the Superman character in connection with a myriad of products born of the Superman story.”²¹⁰ It then describes DC’s efforts to license and merchandise Superman and notes that the “typical licensing agreement would permit use not only of Superman, but of all the Superman characters” and that *The Daily Planet* “has been prominently featured on many products emanating from these licensing agreements.”²¹¹ Without expressly so stating, the court essentially reasoned that DC’s licensing of *The Daily Planet* on merchandise represented its attempts to forge a link in the public

²⁰⁵ 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980); see *supra* notes 51–53 and accompanying text.

²⁰⁶ DC Comics, Inc. v. Powers, 465 F. Supp. 843, 847 (S.D.N.Y. 1978).

²⁰⁷ *Id.* at 848–49.

²⁰⁸ *Id.* at 848 (emphasis added).

²⁰⁹ *S. Austl. Brewing Co.*, 66 FCR at 465–66. The court’s conclusion that consumers would actually be turned off by a product called “Duff” but for its association with *The Simpsons* further strengthens the inference that a *Filmation*-type rationale undergirds the reasoning in *South Australian Brewing Co. Id.*

²¹⁰ *Powers*, 465 F. Supp. at 847.

²¹¹ *Id.*

mind between the fictional trademark, *The Daily Planet* and DC's entertainment product, *Superman*.

Second, the *Powers* court notes that “the Daily Planet has become so closely associated with the presentation of the Superman story that any use thereof by defendants would create a substantial likelihood of confusion”²¹² Though buried in the passive voice, the *Powers* court seems to be saying that any use of *The Daily Planet* by the defendants would create a substantial likelihood of confusion because DC Comics had already succeeded in linking that name to the *Superman* franchise. By contrast, the court in *South Australian* appears implicitly to accept that the producers of *The Simpsons* had made efforts to link Duff Beer to the show when it notes with disapproval that “there is no disclaimer to consumers on the [breweries’ Duff Beer] can, or in the retail advertising or promotional material, to the effect that the beer is *not* that referred to in ‘The Simpsons’ program.”²¹³

B. The Copyright Theory of Fictional Trademarks

Although decided under trademark law, much of the reasoning of the courts in *Powers* and *South Australian* seems to sound in copyright rather than trademark. Indeed, because of the facts of those two cases, Fox and DC Comics could have brought supplemental copyright claims as well (although neither did).²¹⁴

In *Powers*, the court found “substantial evidence indicating that the adoption by defendants of the name Daily Planet in 1969 was merely an attempt to cash in on the Superman story and its notoriety.”²¹⁵ The court noted “numerous references in the paper not only to the Superman character, but also to the Superman story,” including “[a] lead article entitled ‘Superman smokes super dope,’” “[u]se of the phrase ‘Watchdog of Metropolis’ as its slogan,” “[n]umerous drawings of the Superman character,” and the “[u]se of a masthead which was an exact replica of the Daily

²¹² *Id.* at 848.

²¹³ *S. Austl. Brewing Co.*, 66 FCR at 470–71 (emphasis added).

²¹⁴ *See, e.g.*, *DC Comics, Inc. v. Unlimited Monkey Bus., Inc.*, 598 F. Supp. 110 (N.D. Ga. 1984) (noting that defendant’s infringing use of the “Superman” character was significant enough that plaintiff could bring viable trademark and copyright claims).

²¹⁵ *Powers*, 465 F. Supp. at 849.

Planet insignia appearing in numerous Superman comic books.”²¹⁶ Here, the court appears troubled by Powers’ unauthorized use of DC’s artistic expression in its own right. This aspect of the court’s reasoning sounds overwhelmingly in copyright, and indeed, may have been enough to support an independent copyright action.

Similarly in *South Australian*, the court notes that “‘Duff Beer’ appears in nearly all episodes of [*The Simpsons*] broadcast in Australia . . . with varying degrees of prominence” including “one whole episode substantially devoted to the theme of ‘Duff Beer’ (Duffless) . . . and . . . another 22-minute episode, ‘Selma’s Choice.’”²¹⁷ Here, the Court’s language suggests that it sees Duff Beer functioning like a fictional character which is sufficiently well delineated to receive copyright protection, or is, at a minimum, a substantial enough expressive element of the *Simpsons* story that it would not be filtered away during an abstraction-filtration-comparison analysis.²¹⁸ Moreover, the *South Australian* court noted that Duff’s strong identity, its extensive fictional marketing, and its tether to Homer Simpson “form part of the fictional ‘environment’ in which the stories are played out. It plays a background role as part of the fictional world which the characters inhabit.”²¹⁹ Here, the court appears to view Duff as a protectable element of Fox’s literary property and a defining feature of a fictional world. This reasoning, too, sounds strongly in copyright.

In some fictional trademark cases, such as *Powers*, the defendant will have taken enough of the plaintiff’s protectable expression that the plaintiff can bring a traditional copyright claim. In such a case, the fictional mark will likely get swept up in the court’s larger infringement analysis, receiving at most a passing mention. When such an appreciable amount of original expression is at issue, a court need not reach the issue of the copyrightability

²¹⁶ *Id.*

²¹⁷ *S. Austl. Brewing Co.*, 66 FCR at 455.

²¹⁸ *See id.* at 466 (“No doubt, the assignation of the name ‘Duff’ to the product was designed to achieve a more believable specific fictional effect than to have an anonymous generic ‘beer’ can and it serves to endow the characters with more focused identifiable ‘human’ traits.”).

²¹⁹ *Id.* at 466.

of the name and appearance of the fictional trademark itself; it need only determine whether the copyright in the larger entertainment work in which the mark is embedded has been infringed. But the smaller the quantity of expression in dispute, the more qualitative weight the fictional mark itself must bear and the dicier the copyright analysis becomes.

For example, it is not at all clear what an American court would do with the facts of the *South Australian* case had the plaintiffs proceeded on a copyright infringement theory (and brought the case in a United States district court). Determining whether the breweries' use of Duff Beer infringes Fox's copyright in *The Simpsons* or is a mere *de minimis* use requires the court to analyze the role played by Duff Beer on *The Simpsons*. Because no court has ever passed on a fictional trademark case brought on a copyright infringement theory, it is difficult to know how a court would rule. Nevertheless, certain dicta in the opinion of the *South Australian* court's opinion offer some clues. The *South Australian* court found that the fictional beer plays "an important role in the series" and "form[s] part of the fictional 'environment'" of Springfield.²²⁰ Seen this way, Fox's copyright in *The Simpsons* extends to "Duff Beer" because the fictional product is a significant and well-defined creative element of the plot of *The Simpsons* just as Homer, Moe and Barney are. The breweries' use of the name "Duff Beer" thus constitutes copyright infringement (just as a drawing of Homer on the can surely would). Treating well-defined fictional trademarks as something akin to protectable fictional characters is easily justified under the minimal creativity standard of *Feist* as well as the federal courts' filtration test jurisprudence.²²¹ Moreover, the fact that the breweries' use was commercial strongly cuts against a finding of fair use.²²²

²²⁰ *Id.* at 465–66.

²²¹ *See, e.g., Anderson v. Stallone*, 11 U.S.P.Q.2d 1161, 1166 (C.D. Cal. 1989) (finding that the characters in defendant Stallone's "Rocky" films were "so highly delineated that they warrant copyright protection as a matter of law").

²²² *See Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539, 562 (1985) ("The fact that a publication was commercial as opposed to nonprofit is a separate factor that tends to weigh against a finding of fair use. Every commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to

Although copyright doctrine easily accommodates the above approach, a court may nevertheless view the fictional Duff as mere *scenes-à-faire*. On this reading, Duff Beer is a generic low-comedy trope—the cheap beer—akin to the unprotectable characters in *Abie's Irish Rose*²²³ and accordingly unprotected by Fox's copyright in *The Simpsons*. Alternatively, the court could find that while Duff Beer is sufficiently creative to be protected by Fox's copyright in *The Simpsons*, the breweries' use of the name "Duff Beer" alone constitutes *de minimis* copying, particularly in light of their alteration of the appearance of the fictional can.²²⁴ In fact, courts may have an incentive to view the problem this way. It is the stated policy of the Copyright Office to direct those seeking protection for "words, phrases, symbols or designs that distinguish the goods or services of one party from those of another" to the U.S. Patent and Trademark Office, and by implication, to trademark law.²²⁵ This policy is likely to exert subtle pressure on courts to find the breweries' use of the Duff Beer name to be a *de minimis* use of copyrighted material, but potentially cognizable trademark infringement, and to channel the problem to trademark law.

To proceed on its copyright infringement theory, Fox would then have to argue that the two words "Duff Beer" are themselves sufficiently creative that they should be entitled to independent copyright protection. Forced to fend for itself as an independent res, Duff Beer almost certainly loses on § 202.1 grounds. While the imprimatur of the Copyright Office is not required for a copyright action to proceed, it is clear that the agency's views on copyrightability hold sway with the federal courts. Indeed, while the *Southco* majority noted a split of opinion among the federal

the owner of the copyright." (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984) (internal quotation marks omitted)).

²²³ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930).

²²⁴ *S. Austl. Brewing Co.*, 66 FCR at 471 ("The steps which are said to have been taken to disassociate [the breweries' beer from the Duff Beer on] 'The Simpsons' . . . include ensuring that the words 'The Simpsons' were not referred to on the can and the design, colour and get-up of the yellow can was said to be quite different from that featured in 'The Simpsons.' Nor did the image of any 'Simpsons' character appear on the can.").

²²⁵ See COPYRIGHT PROTECTION NOT AVAILABLE FOR NAMES, TITLES, OR SHORT PHRASES, *supra* note 117.

courts regarding the level of deference owed to the Copyright Office as a matter of administrative law, it reasoned that “[a]t a minimum, the practice of the Copyright Office reflects a body of experience and informed judgment to which courts and litigants may properly resort for guidance.”²²⁶ Moreover, as Professor Hughes notes, “[a]lthough the [§ 202.1] bar exists only in the regulations of the Copyright Office, courts have applied this rule against claims of copyright” consisting of names and titles of various creative works.²²⁷

In justifying the denial of copyright for Duff, however, the court may go one step too far and turn back the claim of copyright in “Duff Beer” on the reasoning that the fictional mark does not manifest the minimum creativity required by *Feist*. Indeed, as Justin Hughes points out, the *de minimis* doctrine is classically justified by copyright’s originality doctrine.²²⁸ On this theory, “too short equals not creative equals not copyrightable.”²²⁹ Such reasoning is specious on its face. Judge Roth pointedly observed that “it does not make sense to state categorically that no combination of numbers or words short enough to be deemed a ‘phrase’ can possess ‘at least some minimal degree of creativity.’”²³⁰ Professor Hughes is even more direct: “it is fundamentally disingenuous to use the originality requirement as the doctrinal bar against copyright protection of titles, names and short phrases” because “[m]any very small expressions positively leap over the low threshold of originality we have established in copyright law.”²³¹ Indeed, in *Southco*, the government essentially conceded as much in its brief: “we note that the Copyright Office will not register even a *creative* short phrase.”²³² The troubling

²²⁶ *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 286 n.5 (3d Cir. 2004) (en banc) (internal quotation marks omitted).

²²⁷ Hughes, *supra* note 120, at 581.

²²⁸ *Id.* at 578.

²²⁹ *Id.* at 605.

²³⁰ *Southco*, 390 F.3d at 286 (Roth, J., dissenting) (quoting *Feist Publ’ns, Inc. v. Rural Tel. Servs.*, 499 U.S. 340, 345 (1991)).

²³¹ Hughes, *supra* note 120, at 578.

²³² Brief for United States as Amicus Curiae Supporting Appellee at 15 *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276 (3d Cir. 2004) (No. 02-1243) (emphasis added), available at <http://www.usdoj.gov/atr/cases/f201000/201034.pdf>.

tendency of courts to press *Feist* into service to justify the *de minimis* bar calls into question the rationale for denying independent copyright protection to words, symbols and short phrases.

If lack of creativity is a spurious justification for the *de minimis* doctrine, might there still be a workable policy justification for a *de minimis* doctrine in copyright law? Hughes himself poses the best justification for the *de minimis* doctrine, arguing for a minimum-size requirement in copyright on the basis of preserving the balance of the overall doctrinal and statutory scheme of copyright.²³³ For example, Hughes notes, the third factor in the statutory fair use defense, “the amount and substantiality of the portion used in relation to the copyrighted work as a whole” is of course “directly sensitive to the size of the work.”²³⁴ Further, because courts often favor a finding of fair use where the second use is “transformative,” that is, a use which recontextualizes the borrowed material rather than merely appropriating it, Hughes argues that the smaller the work, the less likely a second use is to be transformative.²³⁵ There is, thus, a legitimate concern that a proliferation of such “microworks” would swallow the fair use defense.²³⁶ Further, Hughes points out, copyright law is intended to protect literary “compositions.”²³⁷ On this rationale, American and English courts have rejected protection for the label on a bottle of scotch²³⁸ and in the invented word “Exxon,”²³⁹ among other things.

²³³ Hughes, *supra* note 120, at 578 (“The real issue is not lack of originality; the real issue is size.”).

²³⁴ *Id.* at 629 (quoting 17 U.S.C. § 107 (2006)).

²³⁵ *Id.* at 629.

²³⁶ *Id.* at 578, 619.

²³⁷ *Id.* at 628–33.

²³⁸ *Higgins v. Keuffel*, 140 U.S. 428, 431 (1891) (concluding that “[t]o be entitled to a copyright the article must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached”).

²³⁹ *Exxon Corp. v. Exxon Ins. Consultants Int’l, Ltd.*, [1981] 2 All E.R. 495, *aff’d* [1982] Ch. 119 (A.C.) (Eng.) (“I would have thought . . . that unless there is something in the context of the [copyright] Act which forbids it, a literary work would be something which was intended to afford either information and instruction, or pleasure in the form

Finally, there is the concern for what Hughes calls the “Oscar Wilde Principle”: a concern with removing “[m]uch of the world of witticisms, pithy observations, and insightful judgments” from the public domain.²⁴⁰ As Judge Roth conceded in her *Southco* dissent, “[i]t may well be that short expressions must hurdle a slightly higher creativity bar than longer works” so that “mundane phrases or slight variations on common expressions” will not be “taken out of the public domain.”²⁴¹ This concern overlaps with the merger doctrine’s directive not to permit a party to appropriate a given body of subject matter by copyrighting the few forms that that subject matter might take.²⁴² But it goes further and implicates the constitutional balance between the First Amendment and the Intellectual Property Clause. While the latter secures “for limited Times to Authors . . . the exclusive Right to their respective Writings,”²⁴³ the length of that limited time has grown considerably: from twenty-eight years, (renewable for another twenty-eight years) under the 1909 act, to forty-seven years (renewable for another twenty years) under the 1976 act, to a total of ninety-five years under the Sonny Bono Copyright Term Extension Act.²⁴⁴ For works created after 1976, copyright protection lasts even longer.²⁴⁵ With “limited times” becoming substantially less so, a court should indeed be particularly circumspect before removing a quip or other short phrase from the public domain for what is likely to be a century or more.

Thus, whether “Duff Beer” is sufficiently creative to warrant independent copyright protection is probably the wrong question; Duff almost certainly is. But at bottom, the question of whether or

of literary entertainment. . . . I am not sure whether [Exxon] can be said to be a ‘work’ at all; I am clearly of the opinion that it cannot be said to be a ‘literary work.’”).

²⁴⁰ Hughes, *supra* note 120, at 612.

²⁴¹ *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 300 (3d Cir. 2004) (en banc) (Roth, J., dissenting).

²⁴² *Id.* at 293 n.11.

²⁴³ U.S. CONST. art. 1, § 8, cl. 8.

²⁴⁴ MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT*, § 9:08 (Matthew Bender rev. ed. 2010).

²⁴⁵ Under the Sonny Bono Copyright Term Extension Act, copyright protection “endures for a term consisting of the life of the author and 70 years after the author’s death,” or for posthumous works, 95 years from the year of first publication or 120 years from the year of its creation, whichever expires first. 17 U.S.C. § 302 (2006).

not independent copyright protection should attach to a fictional trademark such as Duff has more to do with copyright's overall doctrinal scheme and purpose than with the level of creativity of the fictional brand. Particularly in a case like *South Australian*, then, where the defendant did not take any of the artwork associated with the fictional can, it may be correct to say that the plaintiff has not suffered a copyright injury. Copyright protection is doubtless appropriate in cases such as *Powers* where significant visual or literary expression has been appropriated together with a fictional mark. But to extend copyright protection to a logo, standing alone, no matter how creative, may simply place too much of a strain on copyright's purpose and throw off the delicate balance struck by this body of intellectual property law.

III. DOCTRINAL SOLUTION: TAILORING THE TRADEMARK ANALYSIS TO THE FICTIONAL TRADEMARK PROBLEM

A real-life logo which may fall short of the originality required for copyright—some colors and a word or two, for instance—will often possess the requisite distinctiveness for trademark protection to attach, and will certainly do so where the name bears a non-descriptive relationship to the product. As a legal matter, then, trademark law is better equipped than copyright to provide protection for such logos. But, this Note argues, trademark law is also superior to copyright law for the protection of fictional trademarks as an analytical matter.

If instead of brewing Duff Beer, for example, Rodrigo Contreras were preparing derivative works—that is, producing new *Simpsons* episodes and selling those—Fox's injury would indeed sound predominantly in copyright (although Fox almost certainly has trademarks in Homer, Moe and company). In this scenario, Fox is really complaining of the appropriation of its literary property and its creative visual art. However, the injury Fox suffers when another company manufactures the fictional beer from its show is that people think *The Simpsons* has something to do with the beer. The breweries' actions thus "cause confusion," "mistake," or "deceive as to the affiliation, connection or association . . . or as to the origin, sponsorship, or approval" of the

beer.²⁴⁶ They create confusion in the marketplace. The breweries use the wealth of brand information packed into a symbol to deceive and they trade on the good will accumulated by another producer of a very different product. Duff Beer, then, acts as a very distinctive trademark, but not a trademark for beer. In appropriating the Duff Beer mark, the breweries trade on the good will *The Simpsons* has carefully built up in its *entertainment* franchise and signal to consumers that the beer contains the same experiential qualities as or bears the endorsement of that entertainment product.²⁴⁷ In so doing, the breweries “reap the financial, reputation-related rewards associated with a desirable product.”²⁴⁸ Just not their product. In this way, the appropriation of a fictional trademark leads to a real-world trademark injury.

Nevertheless, there remains the problem of determining how (or if) Fox has reserved priority in the Duff Beer mark. Here, this Note endorses an approach similar to that of the court in *Filmation*, which found that the prominent use of an ingredient of a fictional work (in that case, a fictional character) led to that ingredient’s coming to “symbolize the plaintiff in the public mind” here in the real world.²⁴⁹ The courts in both *Powers* and *South Australian* likewise appear to hold that at some point, a use in fiction rises to the level of a real-world use in commerce. But at what point is a use in fiction sufficient to break the fictional mark through the fourth wall and into our world?

In answering this question, an analogy to virtual worlds is instructive. In online games such as *Second Life*, players experience a virtual community through their avatars.²⁵⁰ They can purchase any number of goods in this community with virtual “Linden Dollars,” which can be purchased with real dollars. A number of goods which can be purchased in *Second Life* are simply virtual versions of real-world goods: Nike sneakers and the

²⁴⁶ Lanham Act of 1946 § 43(a), 15 U.S.C. § 1125(a) (2006).

²⁴⁷ See, e.g., *DC Comics v. Kryptonite Corp.*, 336 F. Supp. 2d 324, 332 (S.D.N.Y. 2004) (“Kryptonite . . . serves to identify the *entertainment* and other goods and services created, distributed and/or licensed by or on behalf of DC Comics.”) (emphasis added).

²⁴⁸ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

²⁴⁹ *DC Comics, Inc. v. Filmation Assocs.*, 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980).

²⁵⁰ *SECOND LIFE*, <http://secondlife.com> (last visited Aug. 16, 2010).

like. But some goods are created expressly for Second Life and sold only in the game. The appropriation of such goods by other virtual vendors has led to real-life litigation resulting in several cases of real-life protection for these virtual trademarks.²⁵¹

Writing on the use of trademarks in these virtual worlds, Professors Candidus Dougherty and Greg Lastowka analyze the issue of whether a use in this world is a use in ours.²⁵² Because “[m]any Second Life users are playing for real money profit,”²⁵³ they argue, “a Second Life user who regularly conducts in-world sales under a recognized brand should meet the use threshold required to establish trademark rights.”²⁵⁴ However, they exclude “a hobby-use, a de minimis use . . . a handful of sales or an internal business use” from the list of uses sufficient to establish trademark rights.²⁵⁵

Fictional trademarks are a closer case. Like a virtual trademark in Second Life, Duff Beer is a fictional mark being used in a virtual world. Unlike the virtual world of Second Life, however, Springfield is non-interactive and the individual elements of that world are not separately monetized. Thus, unlike in Second Life, where the number of sales generated and the revenue earned by the creator of a virtual trademark are easily calculated, it is unclear to what extent the creators of *The Simpsons* owe their financial success to Duff. Thus, the conventional use in commerce analysis—scrutinizing *The Simpsons*’ overall sales or ratings—does not provide the full picture of Fox’s use of Duff, specifically.

²⁵¹ See, e.g., *Eros LLC v. Leatherwood*, No. 8:07-CV-01158-SCB-TEW (M.D. Fla. filed July 3, 2007), available at <http://www.citmedialaw.org/sites/citmedialaw.org/files/2008-03-20-Order%20for%20Judgment%20by%20Consent.pdf> (enjoining defendant from selling unauthorized copies of “sex bed” for use in Second Life); *Eros LLC v. Simon*, No. 1:07-cv-04447-SLT-JMA (E.D.N.Y. filed Dec. 3, 2007), available at <http://www.citmedialaw.org/sites/citmedialaw.org/files/2008-01-03-Judgment%20by%20Consent%20as%20to%20Simon.pdf> (settlement for unauthorized copying of virtual sex toys for use in Second Life).

²⁵² Candidus Dougherty & Greg Lastowka, *Virtual Trademarks*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 749 (2008).

²⁵³ *Id.* at 779.

²⁵⁴ *Id.* at 782.

²⁵⁵ *Id.*

In the fictional trademark context, then, this Note proposes that courts more broadly analyze the efforts expended by the creator of a fictional mark to link the mark and the associated entertainment product in the public mind.²⁵⁶ Certainly the market penetration and popularity of the larger entertainment work—elements measured by the conventional use in commerce analysis—provide circumstantial evidence of the efforts of the mark’s creator to forge an association. Indeed, these indicia constitute essential factors in calculating use and represent an important limiting principle. This is so because the author of a fictional work will seldom register a fictional mark, and indeed, will likely not be permitted to do so by the United States Patent and Trademark Office absent immediate plans to use the mark in commerce, such as by licensing it.²⁵⁷ Accordingly, to function as a real-world mark, a fictional trademark must be associated with an entertainment work which has achieved “substantial sales.”²⁵⁸ The *Kryptonite* court seems to have assumed this when it noted with approval that the fictional element Kryptonite had “come to be recognized as a powerful symbol” for the *Superman* franchise, “[a]s a result of broad dissemination throughout all media.”²⁵⁹ Conversely, minimal distribution of the entertainment work in which the fictional mark is embedded (what this Note will call the “container entertainment work”) might implicate the *Zazu* court’s concern that rival firms

²⁵⁶ Importantly, the fictional trademark plaintiff’s efforts in this regard operate in precisely the same way as do those of a conventional trademark plaintiff seeking to forge an association between her product and her trade symbol. Indeed, the conventional use in commerce analysis is essentially a proxy for the more difficult task of assaying consumers’ associations. *See supra* note 41 and accompanying text. Thus, calculating use in commerce by measuring the fictional trademark proprietor’s attempts to link the mark and the associated entertainment work poses a new analytical model, but breaks no legal ground. *See DC Comics v. Kryptonite Corp.*, 336 F. Supp. 2d 324, 335 (S.D.N.Y. 2004) (rejecting defendant’s argument that plaintiff DC Comics’ use of the prominent fictional element “Kryptonite” in DC’s *Superman* comic books, motion pictures and television programs amounted to use only as a story element or character and not as a “trademark use” protectable under the Lanham Act).

²⁵⁷ *See supra* note 60 and accompanying text.

²⁵⁸ *Zazu Designs v. L’Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992).

²⁵⁹ *Kryptonite*, 336 F. Supp. 2d at 332.

receive fair notice that a mark is already associated with a competitor's brand.²⁶⁰

To complete the picture of whether a plaintiff has made substantial efforts to link the fictional mark and the container entertainment work in the public mind, the prominence of the fictional mark within the work must also be measured. Here, courts should apply *copyright's* filtration test to determine if the mark is a sufficiently prominent and well-defined element of the fictional atmosphere, or mere *scenes-à-faire*. The proposed trademark priority analysis is thus both quantitative and qualitative. A mark must be sufficiently pervasive throughout the container entertainment work that it could reasonably come to stand for the work in the public mind. By measuring sales of the container entertainment work and the pervasiveness of the mark within that work together, this quantitative analysis serves as a proxy for the quantitative "active use" in commerce inquiry performed at the priority step under the conventional trademark analysis.²⁶¹ Unlike in the conventional use in commerce inquiry, however, a fictional mark must also have achieved some minimal level of literary distinctiveness (the "slight amount" of creativity required by the Supreme Court in *Feist*) as to be capable of becoming uniquely associated with the container entertainment work. The distinctiveness inquiry at the priority step is not a substitute for the more fine-grained analysis the court will perform at the likelihood of confusion stage; at the priority step, the court does not evaluate the strength of the mark and does not assess actual confusion. Rather, by examining whether the fictional mark is *potentially* memorable enough to serve as shorthand for the entertainment work, this prong of the test simply ensures that the fictional trademark proprietor was the first to use the mark *as a mark*.

Courts should also note whether the mark appears in licensing agreements: either as a real-world manifestation of its fictional

²⁶⁰ *Zazu*, 979 F.2d at 503 ("By insisting that firms use marks to obtain rights in them, the law prevents entrepreneurs from reserving brand names in order to make their rivals' marketing more costly. Public sales let others know that they should not invest resources to develop a mark similar to one already used in the trade.").

²⁶¹ See *supra* note 41 and accompanying text.

existence or simply depicted on T-shirts, etc. While licensing agreements were present in both *Powers* and *South Australian*, their existence should function as a one-way ratchet. That is, the presence of a licensing agreement involving the fictional mark should be strong prima facie evidence of a plaintiff's efforts to reserve priority in the mark, but the absence of such an agreement, standing alone, should not be viewed as outcome determinative. Additionally, courts should determine whether the fictional mark appears in any advertising such as promotions for the entertainment work on television or movie posters or in derivative works such as *The Simpsons* comic book series.

The court should then proceed to the traditional multi-factor "likelihood of confusion" analysis. Most courts' first factor, strength of the mark, poses difficulties in the fictional trademark context because while "Bass" is distinctive on shoes, for example, but "leather" is not, nearly anything will seem fanciful when used on an entertainment product. Courts should thus evaluate the distinctiveness of a fictional mark by again using copyright's filtration test because this test roughly maps onto the traditional distinctiveness framework for conventional trademarks. That is, while conventional trademarks are arrayed on a spectrum from unprotectable and generic to fanciful and distinctive, fictional marks derive their distinctiveness not by their relationship to the products to which they are affixed but from the level of creativity invested in them by their authors—a metric the filtration test was designed to measure. The proposed strength of the mark analysis should be a thorough, probing inquiry into the degree of creativity invested in the fictional mark by its author. At this stage, courts should note the degree to which the plot of the fictional work features the mark, the detail with which the mark is rendered and the *actual* memorability of the mark. To the extent that there is any ambiguity in whether consumers have actually come to associate the mark with the entertainment work, courts should consider circumstantial evidence and, where available, empirical evidence of actual confusion in the form of consumer surveys, just

as they do under the conventional likelihood of confusion analysis.²⁶²

Courts should understand the proximity of the goods factor as how closely the real-world product mimics the fictional one. The goods will never be proximate in the conventional sense because the junior user is not selling entertainment, but rather, a tangible product. This requirement should thus be understood not as whether the products are the same, but as whether the defendant's product blurs the perspective between fantasy and reality, internal and external, as Duff Beer and *The Daily Planet* do.

One last factor bears mentioning: the defendant's intent in selecting the mark. Courts should more readily infer bad faith on the part of a defendant in this context than in the traditional trademark framework. Here, the specter of trading on the fame which is peculiarly associated with entertainment products hangs over every case. Courts should have license to infer such bad faith from circumstantial evidence. When, as in *South Australian*, the senior user has "wide distribution" and "deep market penetration," this information should weigh heavily towards a finding of malicious intent by a junior user just as copyright more readily infers access when the original work is famous.²⁶³

This Note now analyzes *Powers* and *South Australian* under the proposed framework and then considers other factual scenarios involving fictional trademarks.

²⁶² See, e.g., *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025 (9th Cir. 2010) (noting that "[s]urvey evidence may establish actual confusion" and that "evidence of actual confusion can . . . support a finding of likelihood of confusion" (quoting *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 353 (9th Cir. 1979))); *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 638–39 (6th Cir. 2002) ("If a party chooses a mark with the intention of creating confusion between its products and those of another company, that fact alone may be sufficient to justify an inference of confusing similarity. Circumstantial evidence of copying, particularly the use of a contested mark with knowledge of the protected mark at issue, is sufficient to support an inference of intentional infringement where direct evidence is not available.") (internal citations omitted).

²⁶³ See *supra* note 107 and accompanying text.

A. *Rethinking Powers and South Australian Brewing Co.*

Powers and *South Australian* were well reasoned and rightly decided. However, the courts in those cases viewed an unusual trademark problem through the lens of conventional trademark reasoning and in so doing, were hamstrung in their attempts to really explain the injury and why the remedy imposed was the correct one. Under the tailored trademark analysis, *Powers* and *South Australian* would come out the same way, but this framework permits a court presented with those cases to address the priority issue head-on, to articulate those factors going to the distinctiveness of a fictional mark, and to more realistically assess the likelihood of confusion when a fictional trademark is appropriated.

1. *South Australian Brewing Co.*

Applying the fictional trademark framework to *South Australian Brewing Company*, a court would begin with the priority analysis. At this stage, it would proceed as the *South Australian* court did. It would emphasize Fox and Groening's many attempts to link Duff Beer and *The Simpsons* in the public imagination, such as "[l]icensed merchandise relating specifically to 'Duff Beer,'"²⁶⁴ and the evidence that Duff "appears in nearly all episodes of the series"²⁶⁵ including two episodes "substantially devoted" to the fictional beer: "Selma's Choice" and "Duffless."²⁶⁶ The court would explain that Duff Beer's originality and prominence on the show prevent it from being filtered away as mere *scenes-à-faire*. It would also note at this stage *The Simpsons* comic books, which feature Duff, as evidence of the fictional mark's presence across various media. These factors all point to Fox and Groening's having established priority in Duff. The *South Australian* court reasoned by analogy to fictional characters to make this point, citing an earlier case involving Mickey and Minnie Mouse²⁶⁷ which held that these names were "so closely

²⁶⁴ See *Twentieth Century Fox Film Corp. v S. Austl. Brewing Co.* [1996] 66 FCR 451, 456 (Austl.).

²⁶⁵ *Id.* at 455.

²⁶⁶ *Id.*

²⁶⁷ *Id.* at 463 (quoting *Radio Corp. Pty. v Disney* [1937] 57 CLR 448, 453 (Austl.)).

associated in the public mind, with . . . [Walt] Disney and his activities” that the use of either the characters’ names or likenesses in connection with goods would suggest that the goods were “connected with . . . Disney.”²⁶⁸ Proceeding under this Note’s approach, the court could instead simply hold that under the totality of the circumstances, Fox and Groening’s efforts to forge the link between its fictional mark, Duff, and its entertainment property, *The Simpsons* in the public mind were substantial and numerous. Accordingly, Duff Beer is a trademark for *The Simpsons* and the plaintiffs had established priority in the mark.

In determining the likelihood of confusion, the court would begin by focusing on the strength of the mark, applying copyright’s abstraction test. Indeed, the *South Australian* court essentially did so, without saying as much, and its approach is instructive on this point. It emphasized the way the “‘make-believe’ product” is “coupled with a character [Homer Simpson], a background institution, (Duff Brewery), and also with the associated advertising signs, posters and images of the beer, which play an important role in the series.”²⁶⁹ The court noted Duff’s role in the “fictional world which the characters inhabit”²⁷⁰ and reasoned that, “[n]o doubt, the assignation of the name ‘Duff’ to the product was likely designed to achieve a more believable specific fictional effect than to have an anonymous generic ‘beer.’”²⁷¹ In so doing, the *South Australian* court implied that Duff’s distinctiveness owes to the literary definition given to the fictional beer and the artistic originality it embodies, but proposes no test for measuring such distinctiveness.²⁷² An “anonymous generic ‘beer’” could not realistically come to stand for the show in the public mind. Accordingly, copyright’s filtration test would render it unprotectable *scenes-à-faire*. But a court would almost certainly find that because Duff embodies a high degree of original

²⁶⁸ *Id.*

²⁶⁹ *Id.* at 465–66.

²⁷⁰ *Id.* at 466.

²⁷¹ *Id.*

²⁷² Interestingly, the *South Australian* court also performed a traditional distinctiveness analysis. Concluding that “‘Duff’ cannot be said to be descriptive of the beer’s qualities” *id.* at 463 it nevertheless determined that Duff had “acquired a powerful secondary meaning.” *Id.* at 465.

expression, it is indeed a memorable and distinct aspect of *The Simpsons* and therefore functions as a highly distinctive trademark for the show.

Under proximity of the goods, courts compare the fictional product to its real-world counterpart. In *South Australian*, the trade dress of the real-world beer was “said to be quite different from that featured [on] ‘The Simpsons.’”²⁷³ Nevertheless, South Australian Brewing Company’s product was a beer bearing the name “Duff.” Thus, while South Australian Brewing Company’s “Duff” is not a real-world replica of *The Simpsons*’ Duff, the beer does blur the perspective between fiction and reality to some degree. The goods are therefore somewhat related under this factor.

Finally, the *South Australian* court notes *The Simpsons*’ “wide coverage, deep market penetration and broad recognition”²⁷⁴ to suggest that Fox and Groening had established substantial good will in *The Simpsons* and in the fictional mark.²⁷⁵ The proposed framework, however, permits a double inference from *The Simpsons*’ market position: the existence of good will built up in the mark by Fox and an intent to trade on that good will by the breweries. This factor, too, strongly suggests infringement.

2. *DC Comics, Inc. v. Powers*

Similarly, in *DC Comics, Inc. v. Powers*, the court began by shoehorning the fictional newspaper in with the *Superman* characters. The court pointed to the existence of licensing agreements for “all the Superman characters” which led to the creation of merchandise featuring the fictional newspaper.²⁷⁶ The *Powers* court essentially reasoned that *The Daily Planet* functioned as a protectable character just as Superman did, and was licensed and promoted accordingly. Under the proposed approach, however, the court would not have had to reason by analogy or bootstrap the fictional newspaper to the *Superman* characters. It

²⁷³ *Id.* at 471.

²⁷⁴ *Id.* at 455.

²⁷⁵ *Id.* at 456.

²⁷⁶ *DC Comics, Inc. v. Powers*, 465 F. Supp. 843, 847 (S.D.N.Y. 1978).

could simply state that *The Daily Planet* is a prominent and well-delineated ingredient of DC's protectable entertainment work, *Superman*, and DC has made substantial efforts to link the fictional newspaper and the *Superman* franchise in the public mind. It would then marshal the evidence of the licensing agreements and would note that *The Daily Planet* is a well-defined newspaper, playing a central role in the series. Not only does the paper have a recognizable title, masthead, and office building, but it employs nearly all the characters in the series, including the Man of Steel himself (incognito as his handsome, but bumbling alter ego, Clark Kent), Superman's love interest Lois Lane, and a photographer named Jimmy Olsen whose interest in Lane forms a love triangle in the series.²⁷⁷ Based on its dramatic role in the *Superman* series, *The Daily Planet* thus survives even a very stringent filtration analysis. The court would then conclude that based on the totality of the circumstances, DC Comics had established *The Daily Planet* as a protectable trademark and having used the mark in commerce, had reserved priority rights in it.

The court would then proceed to the likelihood of confusion analysis. Under strength of the mark, a court would likely find that the level of distinctiveness of *The Daily Planet* is high, owing not to the uniqueness of the name as applied to a newspaper (which under the conventional trademark analysis would likely be found to be on the borderline between a descriptive and a suggestive mark, and thus possibly unprotectable absent secondary meaning) but rather, to the fictional newspaper's dramatic role in the series. Indeed, it is precisely because *The Daily Planet* calls to mind the *Superman* characters and story, and not that it is a particularly unusual name for a newspaper, that it serves as a potent trademark for the series.

Under proximity of the goods, the court would note that Powers' *Daily Planet* employed "a masthead which was an exact replica of the Daily Planet insignia appearing in numerous

²⁷⁷ See generally *Superman Episode Guide (1968)*, THE BIG CARTOON DATABASE, http://www.bcdb.com/cartoons/Filmation_Associates/A-G/Batman_Superman_Hour/Superman (last visited Jan. 4, 2011).

Superman comic books.”²⁷⁸ This factor cuts strongly in favor of a finding of infringement.

When discussing the defendant’s intent in selecting the mark, the *Powers* court’s reasoning is instructive. Noting the appearance of drawings of Superman and the use of the Superman character in its articles, including one titled “Superman smokes super dope”²⁷⁹ the court found *Powers*’ adoption of the name *The Daily Planet* to be “merely an attempt to cash in on the Superman story and its notoriety.”²⁸⁰ Indeed, as *Powers* himself admitted in his affidavit “that he was aware of the relationship between the *Daily Planet* and the Superman story when he first decided to use the name,” the *Powers* court rightly identified the link between bad faith in selecting the name *The Daily Planet* and the fame of the *Superman* story.²⁸¹ A court applying the proposed framework would proceed in the same manner at this step.

B. Notes on Tailored Trademark from Other Factual Scenarios

This Note now briefly considers a few other fictional trademark scenarios which illustrate the proposed framework applied in practice.

Perhaps the best weapon in the war against fictional trademark infringement is the licensing agreement. In the race to bring fictional products to real-world markets, no licensing company rivals Omni Consumer Products Corporation.²⁸² Named for the “fictional megacorporation” from the film, “*Robocop*,”²⁸³ this “defictionalizing company” enjoys licenses to produce real-world versions of *Tru Blood*, the fictional blood substitute for vampires from the HBO television series of the same name;²⁸⁴ *Sex Panther*, the fictional cologne from the 2004 Will Ferrell film, *Anchorman: the Legend of Ron Burgundy*; and Stay Puft marshmallows, whose

²⁷⁸ *Powers*, 465 F. Supp. at 849.

²⁷⁹ *Id.*

²⁸⁰ *Id.*

²⁸¹ *Id.*

²⁸² OMNI CONSUMER PRODS. CORP., <http://www.omniconsumerproductscorporation.com> (last visited Oct. 5, 2010).

²⁸³ Rob Walker, *This Joke’s for You*, N.Y. TIMES, May 4, 2008, <http://www.nytimes.com/2008/05/04/magazine/04wwln-consumed-t.html>.

²⁸⁴ Mercifully, the real-world version is a blood orange soda.

fictional spokesman, the Stay Puft Marshmallow Man, famously wreaks havoc in midtown Manhattan in the climax of the 1984 film, *Ghostbusters*.²⁸⁵ Each of these products is, of course, perfectly legal and produced pursuant to a licensing agreement. But assuming for a moment that such products were produced without a license, an analysis of the fictional trademarks upon which they are based illuminates how a court might apply the tailored trademark framework proposed in this Note under related, but distinct factual scenarios.

Firstly, it would be hard to imagine a more successful effort to reserve priority in a fictional mark than that made by HBO in its use of *Tru Blood*. In addition to being the title of the container entertainment work, *True Blood*, the fictional product *Tru Blood* plays a pervasive dramatic role in the series; indeed, in the series, it represents a technological breakthrough which permits vampires to live in (tenuous) harmony with the living. Vampires are depicted chugging this fictional product out of a stout glass bottle with a recognizable red and yellow logo in nearly every episode of the show.²⁸⁶ Accordingly, *Tru Blood* sails through the priority analysis because of the creativity invested in it by the show's creators (it is the lynchpin of the plot of the entire series) and its pervasiveness on the series. However, both factors do not necessarily need to be present in equal amounts for a fictional trademark proprietor to succeed in linking its fictional mark and the entertainment work in which it is embedded.

In *Anchorman: The Legend of Ron Burgundy*,²⁸⁷ Paul Rudd's caddish, mustachioed television reporter, Brian Fantana, hatches a scheme to woo a female television anchor with the help of a fictional cologne called "Sex Panther."²⁸⁸ In the movie, the fictional cologne is "illegal in nine countries," (presumably because it is "made with bits of real panther") and has been subjected to studies which indicate that "60% of the time, it works

²⁸⁵ OMNI CONSUMER PRODS. CORP., *supra* note 282.

²⁸⁶ See generally HBO, TRUE BLOOD, <http://www.hbo.com/true-blood/index.html> (last visited Jan. 4, 2010).

²⁸⁷ ANCHORMAN: THE LEGEND OF RON BURGUNDY (Dreamworks Pictures 2004).

²⁸⁸ *Id.*

every time.”²⁸⁹ The absurdity of the fictional cologne, as well as the scene in which Fantana’s scheme predictably flops, manifests a high degree of creativity and causes Sex Panther to serve as a potent trademark for *Anchorman* despite its only appearing in a few brief minutes of the film. The success of the licensed, real-world version of Sex Panther provides strong circumstantial evidence that consumers do, in fact, associate Sex Panther with *Anchorman* and that its caché among consumers is predicated almost entirely upon this association. Indeed, as the *South Australian* court noted with regard to the fictional Duff, “it would be artificial in the extreme to suggest that consumers would be attracted by the concept of [Sex Panther] on the basis of its dictionary meaning” alone.²⁹⁰ Accordingly, at the priority step, pervasiveness and distinctiveness should be understood to exist on a sliding scale, such that a plaintiff could succeed in establishing priority with a high degree of either or a modest amount of both.

Finally, while Stay Puft marshmallows have yet to be released, their success in the marketplace would give courts another metric by which to evaluate a fictional trademark proprietor’s success in transforming a fictional product into a real-world trademark: duration of the association. It has been twenty-six years since the Ghostbusters’ showdown with the Stay Puft Marshmallow Man.²⁹¹ The success of defictionalized Stay Puft marshmallows a quarter century later would represent strong circumstantial evidence of the strength of the mark.

Yet another instructive example of a fictional trademark creator’s efforts to encourage the public to associate a fictional mark with a real-world entertainment product is Dunder Mifflin, the fictional paper company of NBC’s television show *The Office*. The fictional Dunder Mifflin maintains a real-world Internet presence²⁹² with an elaborate website announcing fictional

²⁸⁹ *Id.*

²⁹⁰ See *Twentieth Century Fox Film Corp. v S. Austl. Brewing Co.* [1996] 66 FCR 451, 465 (Austl.).

²⁹¹ GHOSTBUSTERS (Columbia Pictures 1984).

²⁹² DUNDER MIFFLIN, A MICRO-CAP REGIONAL PAPER AND OFFICE SUPPLY DISTRIBUTOR, <http://www.dundermifflin.com> (last visited May 28, 2010).

corporate environmental initiatives,²⁹³ and the company's fictional acquisition by another fictional company, Sabre Corp.²⁹⁴ The site also features a complete archive of (hilarious) fictional company newsletters.²⁹⁵ The site is so richly detailed that one could spend hours on it before getting linked back into its web host, nbc.com. In this way, the website stealthily advertises for the show while masquerading as the public profile of Dunder Mifflin. In other words, it pulls the user into the internal perspective of *The Office* where Dunder Mifflin is real and marvelously mediocre. NBC thus uses Dunder Mifflin in at least two ways to reserve priority in the mark: as the fictional workplace around which the plot of *The Office* centers—much like the way *The Daily Planet* functions in Superman—and in real-world, on-line advertising for the show.²⁹⁶ Its perspective-warping website would also weigh heavily in NBC's favor in an infringement suit under the “proximity of the goods” factor because the more a company pulls us into its fictional world with a fictional trademark, the more likely any second-comer's goods are to create marketplace confusion.

Another interesting “proximity” issue is raised by use of a fictional trademark on real-world goods which are not exact analogues of their fictional counterparts. In *DC Comics v. Kryptonite Corp.*, DC Comics sued defendant Kryptonite Corp., a manufacturer of bicycle locks which had licensed the name of the fictional element from DC, when Kryptonite went beyond the bounds of the licensing agreement.²⁹⁷ Kryptonite was, of course, not manufacturing a green, glowing space mineral, but earthly security devices. While this fact cuts in favor of Kryptonite under the “proximity of the goods factor,” it is important to recognize that, in fictional trademark cases, the goods are almost never

²⁹³ *Id.* (“Dunder Mifflin is committed to improving the environment. That's why we plant a tree for each and every metric ton of paper that we ship.”).

²⁹⁴ SABRE CORP., <http://www.sabre-corp.com/news-012010.shtml> (last visited May 28, 2010).

²⁹⁵ *Contact*, DUNDER MIFFLIN, A MICRO-CAP REGIONAL PAPER AND OFFICE SUPPLY DISTRIBUTOR, <http://www.dundermifflin.com/contact> (last visited May 28, 2010).

²⁹⁶ That the site also sells licensed *Office* merchandise further strengthens NBC's claim of priority under the framework proposed in this Note.

²⁹⁷ *See DC Comics v. Kryptonite Corp.*, 336 F. Supp. 2d 324 (S.D.N.Y. 2004).

proximate in the traditional trademark sense.²⁹⁸ Thus, the kind of “nonparallel” use at issue in *Kryptonite* represents merely a difference of degree, but not of kind, from the more typical real-product-that-appears-to-be-the-fictional-product injury.

CONCLUSION

Homer Simpson is not just a guy and Moe’s Tavern is not just a bar. These represent valuable intellectual property assets which in many ways serve as conventional trademarks. A fictional trademark functions no differently than a fictional character in terms of its ability to designate the source of an entertainment product, but because it appears to be a trademark for a fictional good, rather than the entertainment work in which it is embedded, it blurs our perspective and our ability to understand its ontological function.

This Note locates fictional trademark injuries under trademark law but proposes adapting the trademark framework to the particulars of the fictional trademark problem. This tailored trademark framework borrows analytical principles from copyright to determine what a use in commerce sufficient to reserve priority in a mark might look like for a fictional trademark, and to determine if a fictional trademark has been infringed. Conceiving of fictional trademarks as real-world trademarks for their associated entertainment products and modifying the trademark analysis to evaluate the strength of those trademarks will help protect valuable intellectual property rights in these entertainment products.

²⁹⁸ *Filmation* proved the rare exception. There, DC Comics used its characters as trademarks for its entertainment products: the shows *Aquaman* and *Plastic Man*, which defendant Filmation’s entertainment products, the shows *Manta and Moray* and *Superstretch*, were found to infringe. *DC Comics, Inc., v. Filmation Assocs.*, 486 F. Supp. 1273 (S.D.N.Y. 1980). *See infra* Part I.A.