

No. 14-36018

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

SLEP-TONE ENTERTAINMENT CORPORATION,
Plaintiff-Appellant,

v.

CANTON PHOENIX INCORPORATED, DBA CANTON PHOENIX
AND BING PAN ZHU,
Defendants-Appellees.

On Appeal from the United States District Court
for the District of Oregon
3:14-cv-00764-PK
Honorable J. Mosman

**BRIEF OF AMICI CURIAE INTELLECTUAL
PROPERTY LAW PROFESSORS IN SUPPORT OF
APPELLEES CANTON PHOENIX, INC.
AND BING PAN ZHU**

Of Counsel:

MARK P. MCKENNA
NOTRE DAME LAW SCHOOL
3120 Eck Hall of Law
Notre Dame, Indiana 46556
(574) 631-9258
markmckenna@nd.edu

JOSEPH C. GRATZ
DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111
(415) 362-6666
jgratz@durietangri.com

Counsel for Amici Curiae

CORPORATE DISCLOSURE STATEMENT

Pursuant to Federal Rule of Appellate Procedure 26.1, the undersigned states that none of the Amici is a corporation or has a parent corporation.

DATED: June 12, 2015

/s/ Joseph C. Gratz
Joseph C. Gratz
DURIE TANGRI LLP
Counsel for Amici Curiae

CERTIFICATE OF COMPLIANCE WITH RULE 29(C)(5)

Counsel for the parties did not author this brief in whole or in part. The parties have not contributed money intended to fund preparing or submitting the brief. No person other than Amici Curiae or their counsel contributed money to fund preparation or submission of this brief.

DATED: June 12, 2015

/s/ Joseph C. Gratz
Joseph C. Gratz
DURIE TANGRI LLP
Counsel for Amici Curiae

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IDENTITY AND INTEREST OF THE AMICI CURIAE

Amici are law professors who teach and have written extensively about trademark law and other intellectual property law subjects. Our sole interest in this case is in the orderly development of trademark law in a way that serves the public interest.*

Barton Beebe
New York University School of Law

William McGeeveran
University of Minnesota Law School

Stacey L. Dogan
Boston University School of Law

Mark P. McKenna
Notre Dame Law School

Deborah R. Gerhardt
University of North Carolina School of Law

Jessica Silbey
Northeastern University School of Law

Leah Chan Grinvald
Suffolk Law School

Christopher Jon Sprigman
New York University School of Law

Michael Grynberg
DePaul University College of Law

Rebecca Tushnet
Georgetown Law

* All signatories speak only on behalf of themselves. Institutional affiliations are listed for identification purposes only.

CONSENT OF THE PARTIES

Counsel for Appellees, Canton Phoenix, Inc. and Bing Pan Zhu, consented to the filing of this brief. Counsel for Appellant Slep-Tone Entertainment Corp. declined to consent. Amici's motion for leave to file this Amicus Brief is filed concurrently herewith.

I. SUMMARY OF ARGUMENT

The District Court correctly determined that Slep-Tone's trademark infringement and unfair competition claims are barred by *Dastar v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

Slep-Tone's fundamental complaint is about unauthorized use of its intangible content—karaoke tracks. Under *Dastar*, however, only confusion regarding the source of physical goods is actionable under the Lanham Act; confusion regarding the source of the karaoke tracks or their authorization is not actionable. Slep-Tone cannot avoid *Dastar* just because the karaoke tracks at issue are stored on a hard drive, as Canton Phoenix does not sell hard drives or any other physical product. Indeed, the only way consumers ever encounter the Slep-Tone marks is during playback of the karaoke tracks, so any “confusion” could only be the result of the content itself. *Dastar* clearly precludes such a claim.

Finally, Slep-Tone's marks cannot be separated from the content. Slep-Tone chose to embed its marks in creative works, and *Dastar* teaches that control over the creative works is the province of copyright law, not the Lanham Act.

II. ARGUMENT

A. Slep-Tone Fails to Allege Confusion Regarding the Source of Tangible Goods, as *Dastar* Requires

The gravamen of Slep-Tone's complaint is that, without Slep-Tone's authorization, Canton Phoenix allowed its customers to play

karaoke videos that included Slep-Tone's Sound Choice trademarks. Br. of Appellant at 10. The appearance of the Sound Choice marks during playback of the audiovisual karaoke tracks is, according to Slep-Tone, "likely to cause confusion, or to cause mistake, or to deceive customers and patrons into believing that the defendants' services were being provided with the authorization of the plaintiff and that the defendants' music libraries contain bona fides [sic] legal and licensed Sound Choice accompaniment tracks." Br. of Appellant at 14, 17.

But even if Slep-Tone is right that consumers are likely to believe that the tracks Canton Phoenix allowed its customers to play are authorized, *Dastar* makes clear that any such confusion is irrelevant for Lanham Act purposes.

In that case, Dastar copied footage from the *Crusade in Europe* television series originally released by Twentieth Century Fox and re-used that footage in its own video series without attribution to Fox. According to Fox, this constituted reverse passing off. Dastar, Fox claimed, was passing off Fox's content as though it were Dastar's own, thereby falsely designating the origin of the video series in violation of § 43(a) of the Lanham Act. *Dastar*, 539 U.S. at 27. That section of the statute makes actionable use of:

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 . . . 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.

15 U.S.C. § 1125(a)(1)(A) (emphasis added).

According to the Supreme Court, as used in the statute, “origin of goods” refers only to the origin of physical goods. At its core, “origin” means the party that actually manufactured the goods at issue. But the concept of origin “might be stretched,” the Court allowed, to include the party “who commissioned or assumed responsibility for (‘stood behind’) production of the physical product.” *Dastar*, 539 U.S. at 31-32.

“Origin of goods,” however, is “incapable of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain.” *Id.* at 32. Whatever the range of relationships that might legitimately be regarded as those of legal “origin,” they must be tied to the physical goods and not merely the intangible content embodied therein.¹

¹ While the Court in *Dastar* was interpreting the language of § 43(a) specifically, 15 U.S.C. § 1125(a)(1)(A), the same rule applies in cases of infringement of registered marks under § 32 despite that section’s slightly less specific language. 15 U.S.C. § 1114. It is well established that the principles applicable to registered and unregistered marks are largely the same. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“[T]he general principles qualifying a mark for protection under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)”); *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1196 (9th Cir.

The Court's construction of the Lanham Act clearly was animated by its concern about a conflict between trademark and copyright law, and particularly its concern that Fox might use trademark law to gain control over content for which it no longer had copyright protection. *Dastar*, 539 U.S. at 33 (“The right to copy, and to copy without attribution, once a copyright has expired . . . passes to the public.”). But *Dastar*'s holding is not limited to cases involving formerly copyrighted works, or even cases in which a valid copyright exists.

Rather, the Court's interpretation of the phrase “origin of goods” to mean only the origin of physical goods applies generally, regardless of whether the content at issue in a particular case is or was protected by copyright. *See Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003). Under *Dastar*, only misrepresentations of the origin of physical goods are actionable under § 43(a); other sorts of misrepresentations, including but not limited to misrepresentations of the origin of creative content, are not actionable.²

2009) (“Federal trademark registration is not a prerequisite for protection under the Lanham Act, and for infringement claims . . . the same standard applies to both registered and unregistered trademarks.”) (internal quotation marks omitted). If anything, § 32 applies even more narrowly, as § 43(a) is widely acknowledged to extend to a broader range of conduct. *See Dastar*, 539 U.S. at 29 (“§43(a) is one of the few provisions [of the Lanham Act] that goes beyond trademark protection”).

²A broader range of misrepresentations (regarding the “the nature,

This construction of the Lanham Act was fatal to Fox’s claim because there was no doubt that Dastar (and not Fox) was the origin of the physical videotapes, even if Dastar was not the origin of the creative content embodied in those tapes. Thus, when it designated the tapes with its own name, Dastar was not falsely designating their origin—it was telling the truth. By contrast, Fox’s claim of reverse passing off “would undoubtedly [have been] sustained if Dastar had bought some of New Line’s Crusade videotapes and merely repackaged them as its own.” *Dastar*, 539 U.S. at 23–24. In that case, Dastar would have been misrepresenting the origin of the physical tapes.

Slep-Tone’s claim here differs from Fox’s in that Slep-Tone is complaining about the *use* of its Sound Choice marks, as opposed to the *absence* of attribution at issue in *Dastar*. But that difference is immaterial under *Dastar* because Slep-Tone still does not allege confusion about the source of any *physical goods*, only confusion about the source of the creative content displayed on Canton Phoenix’s machines.³

characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities”) are actionable as false advertising under § 43(a)(1)(B). 15 U.S.C. § 1125(a)(1)(B). There is no false advertising claim in this case.

³ For this reason, though it is not clear that *Nintendo of America, Inc. v. Dragon Pacific International*, 40 F.3d 1007 (9th Cir. 1994), is otherwise consistent with *Dastar*, the case is distinguishable because *Nintendo*

1. Canton Phoenix’s Digital Files and Hard Drive are not Relevant Goods

Slep-Tone attempts to avoid the *Dastar* problem by arguing that its mark does designate the source of a physical good—the compact discs on which it sells karaoke tracks (and, apparently, the digital files contained on those discs). From there, it contends that because Canton Phoenix played unauthorized copies of those tracks from a hard drive, this is a dispute about consumer confusion regarding the source of tangible goods. *See* Br. of Appellant at 18–19. Later Slep-Tone claims that the duplicate tracks themselves are distinct goods. *Id.* at 29.

But Canton Phoenix does not sell copies of the karaoke videos to its customers, so it makes no representation to consumers, correct or incorrect, about the source of the physical medium containing those videos. (Indeed, it is unlikely that any customer gave any thought to whether Canton Phoenix was playing the videos from discs or from a hard drive.) All that Canton Phoenix provides to its customers is playback of the karaoke videos while they perform. There is therefore no meaningful sense in which Canton Phoenix uses the Sound Choice marks “in connection with the sale, offering for sale, distribution, or advertising” of its hard drive, as the statute requires. 15 U.S.C. § 1114(1)(a); *see also id.* at § 1125(a)(1) (requiring that the allegedly

involved the sale of physical cartridges that bore the Nintendo mark. *Id.* at 1009.

infringing mark be used “in connection with” goods or services); *N.A.A.C.P. v. Radiance Foundation, Inc.*, _ F.3d _, No. 14-1568, 2015 WL 2372675, at *5 (4th Cir. May 19, 2015) (explaining that “in connection with” requires a nexus between the use and a commercial transaction, not just the presence of a mark).

Indeed, Slep-Tone essentially acknowledges the irrelevance of the digital files (and, by extension, the hard drive), as it candidly admits that its real complaint is that Canton Phoenix misrepresented the source of the intangible content of those tracks. *See* Br. of Appellant at 20 (complaining about “defendants’ presentation of counterfeit copyrightable content, with trademarks that attribute such [content] to Slep-Tone”); *id.* at 21 (arguing that “Canton also included Slep-Tone’s registered marks and presented those marks in association with the ‘intangible expression’ . . .”). Had Canton Phoenix streamed the files from YouTube, the gravamen of Slep-Tone’s complaint would have been exactly the same.⁴

Moreover, the only possible representation of source encountered by Canton Phoenix’s consumers was the video content itself—through the appearance of the Sound Choice mark on the screen. *Dastar*,

⁴ Slep-Tone’s compact discs are obviously irrelevant, since the issue is whether Canton Phoenix falsely designates the source of its own physical goods.

properly understood, bars any Lanham Act claim in which the plaintiff claims that consumers are confused about whether the defendant was authorized to reproduce, display, or perform the plaintiff's expressive material. *See Dastar*, 539 U.S. at 33 (rejecting an interpretation of "origin of goods" that would include "not merely the producer of the physical item . . . but also the creator of the content that the physical item conveys"); *cf. Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000) (rejecting plaintiff's contention that the content of a video clip can falsely indicate origin).

This is true even though much expressive material is conveyed in physical form, and so strategic plaintiffs might often claim that their case is about the source of irrelevant physical goods. If it were otherwise, Disney could prevent others from selling copies of *Steamboat Willie* even after its copyright expired by arguing that, because Mickey Mouse is in the movie and is Disney's trademark, consumers will be confused about the source of physical copies of the movie. Under Slep-Tone's interpretation, that claim would technically survive *Dastar* because it is nominally focused on the source of physical goods, even though in truth it hinges on an assertion that consumers will think Disney authorized the reproduction of the content. *Dastar* would be a dead letter, since it would allow any plaintiff to plead around the

holding, creating precisely the sort of “mutant copyright law” the Supreme Court rejected. *Dastar*, 539 U.S. at 34.⁵

2. Confusion Regarding “Authorization” is Not Actionable

Slep-Tone also cannot avoid *Dastar* by claiming confusion about whether the tracks are “authorized.” As this Court recognized in *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d 1137 (9th Cir. 2008), the legitimacy of a party’s use of content is an issue for copyright law, not the Lanham Act. *Id.* at 1144.⁶ If Slep-Tone owns the copyright in

⁵ For the same reason, *Dastar* bars claims of confusion regarding the source of services to the extent the alleged confusion could only be caused by the content of the creative work. Though there may be other contexts in which use of Slep-Tone’s marks would cause actionable confusion regarding the source of services, such claims cannot be based solely on allegedly unauthorized use of content. The movie theater that shows *Steamboat Willie* after it falls into the public domain cannot be subject to an infringement claim if Disney simply claims that use of Mickey Mouse within the content causes confusion about source or sponsorship of the theater’s entertainment services.

⁶ *Sybersound* is a false advertising case, but its logic applies to false designation of origin cases as well; indeed, even more strongly given *Dastar*’s recognition that false advertising is a broader cause of action than false designation of origin. *See Dastar*, 539 U.S. at 38 (suggesting that the producer of a video that substantially copied the Crusade series but which, in advertising or promotion, gave purchasers the impression that the video was quite different from the series might have a false advertising claim); *A.H. Lundberg Associates, Inc. v. TSI, Inc.*, No. C14–1160, 2014 WL 5365514 (W.D. Wash. Oct. 21, 2014) (origin of intangible elements of goods cannot be proper subject of false designation of origin claim under *Dastar*).

its tracks, it can bring a copyright infringement claim; otherwise Canton Phoenix does not need Slep-Tone's authorization to show the videos. Fox could not have succeeded in *Dastar* simply by claiming that Dastar's use of the Fox content falsely implied that Dastar had the right to use that material—that is the same thing, in Lanham Act terms, as saying that the content falsely implied source. *See Smith v. BarnesandNoble.com, LLC*, No. 1:12-cv-04374, 2014 WL 263099 (S.D.N.Y. Sept. 23, 2014) (barring claims of false representation of affiliation between an author and a distributor based merely on sale of copies of author's book, even if the distributor was distributing unauthorized copies); *Antidote Int'l Films, Inc. v. Bloomsbury Publ'g, PLC*, 467 F. Supp. 2d 394, 399 (S.D.N.Y. 2006) (holding that *Dastar* bars a false affiliation claim where "one person is the publisher of a novel and the other is the author of the novel, because the holding of *Dastar* would be meaningless if a false authorship claim could be recast in this manner").⁷

⁷ The District Court was wrong to suggest that Slep-Tone would have had a claim if it had alleged that copying had degraded the quality of the audio recording or of the visual presentation of the accompanying lyrics. *See* ER 9. The Lanham Act only provides a claim for confusion regarding the source of physical goods. Thus, allegations about degradation of quality would only be relevant if they were focused on the quality of physical goods and consumers believed Slep-Tone was the source of those physical goods and was therefore responsible for their poor quality. The District Court's hypothetical claim would still be

B. Slep-Tone’s Marks Cannot Be Separated From the Content

Slep-Tone misunderstands *Dastar* when it argues that its claim is not barred because “the creative and original audio tracks that are subject to copyright protection are generally distinct from the presentation of Sound Choice marks.” Br. of Appellant at 23. First, this argument ignores the fundamental statutory interpretation issue: the Sound Choice mark still does not designate the origin of a physical good, and that is the only designation that matters under *Dastar*. Thus, even if Slep-Tone were right that its mark were somehow separable from the content in which it is embedded, its claim still would be barred.

Second, separability is not even possible here: Slep-Tone has claimed trade dress rights in the graphical displays of its karaoke tracks, “including the typeface, style, and visual arrangement of lyrics, the use of particular color-coding to display lyrics and other information, and the use of particular graphics to display cues for the convenience of users of Slep-Tone’s products.” See ER 17-18. That trade dress obviously cannot be disentangled from the audiovisual work—it *is* the audiovisual work. Thus, accepting Slep-Tone’s claim would conflict

barred under *Dastar* because it focuses on the quality of intangible content and is unconnected to any confusion about the source of physical goods.

directly with *Dastar*'s holding that copyright law, not trademark law, governs copying of expressive content.

Third, separability is not a workable standard. Creative works routinely contain recognizable trademarks. The owners of those marks could argue that background uses, such as uses of Coca-Cola cans as props, should be edited out, or that characters should be morphed to make them look different from trademarked characters, while leaving the sequence of events the same. Given the existence of powerful digital editing tools that can now be used to replace individual elements in a work, these demands could be endless.

Similarly, prominent recording artists often include their names or nicknames in their songs.⁸ Their names may be valid trademarks. Because of statutory copyright licenses, those artists do not have the power under copyright law to control all uses of their songs.⁹ Under Slep-Tone's novel separability theory, however, they could assert trademark claims where copyright law is not available to them,

⁸ See, e.g., EMINEM, *The Real Slim Shady*, on THE MARSHALL MATHERS LP (Interscope Records 2000) (using both "Eminem" and "Slim Shady"); DESTINY'S CHILD, *Dot*, on THIS IS THE REMIX (Columbia Records 2002) ("If something's wrong blame it on me/B-E-Y-O-N-C-E").

⁹ See, e.g., 17 U.S.C. §§ 110 (exempting various performances of musical works), 114(d) (providing for statutory licenses for non-interactive uses of sound recordings); 115 (providing for compulsory licenses to make and distribute phonorecords of musical works).

demanding that songs be altered to remove allegedly source-identifying information.¹⁰

Contrary to its suggestion, Slep-Tone's claim is not different just because "the Sound Choice marks are presented prior to and separate from the audio track and contain no copyrightable or creative content." Br. of Appellant at 23.¹¹ The title of a work alone is uncopyrightable and could be changed, and it is often presented "prior to and separate from" the rest of an expressive work. But that does not mean that Disney could require a copier of *Steamboat Willie* to use a different title for the movie once it enters the public domain. If the use is lawful under copyright law, no one should have to hesitate and engage in a detailed separability analysis before copying an expressive work.

¹⁰ Indeed, artists whose names are in their works, or who claim trademark rights in song titles or phrases, *see, e.g.*, Kory Grow, *Taylor Swift Trademarks 'This Sick Beat' and Other '1989' Phrases*, ROLLING STONE, Jan. 28, 2015, available at <http://www.rollingstone.com/music/news/taylor-swift-trademarks-this-sick-beat-and-other-1989-phrases-20150128>, could create exactly the Scylla and Charybdis problem identified in *Dastar*: the statutory license for musical works does not allow a licensee to make fundamental changes to the work. 17 U.S.C. § 115(a)(2). Complying with the copyright law would force a statutory licensee to risk a trademark claim under Slep-Tone's theory.

¹¹ Of course, Slep-Tone does not even maintain this distinction, as it also asserted claims based on its alleged trade dress in the visual presentation of the tracks.

Nor does it matter that Slep-Tone’s claims are based on embedded registered trademarks, rather than other source-identifying matter within the expressive works. *See id.* at 20–21. The Lanham Act requires some false indication of “origin.” If we accept Slep-Tone’s theory that matter contained in expressive content can falsely designate “origin,” then the ontological status of that matter is irrelevant. *See Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162 (1995) (holding that any symbol that is capable of designating source can qualify as a mark); *cf. Comedy III Prods.*, 200 F.3d at 595 (rejecting Comedy III’s argument that “the [video] clip at issue falls under the protection of the Lanham Act because it contains elements that in other contexts might serve as trademarks”). *Comedy III* was decided before *Dastar*, but its instincts were sound: any alleged secondary meaning of the components of an expressive work is irrelevant.¹²

Indeed, the Supreme Court anticipated—and rejected—precisely the distinction Slep-Tone urges here. Describing the double bind in

¹² Several recent cases have understood that, if the plaintiff’s *only* claim of confusion comes from the reproduction of the expressive content of a work, then *Dastar* ought to apply, because origin cannot be inferred from the content. *See, e.g., Pulse Entertainment Corp. v. David*, No. CV 14-4732 (C.D. Cal. Sept. 17, 2014) (*Dastar* barred false designation of origin claim based on explicit misattribution of hologram to wrong creator; hologram was creative work like a cartoon); *Masck v. Sports Illustrated*, 5 F. Supp. 3d. 881 (E.D. Mich. 2014) (*Dastar* barred false designation of origin claim based on copying of photos).

which would-be users of creative content might find themselves if the Lanham Act were interpreted to allow claims of false designation of the origin of content, the Court noted that if “Dastar had simply copied the television series as Crusade in Europe and sold it as Crusade in Europe, without changing the title or packaging (including the original credits to Fox),” Fox still would not have been satisfied and likely would have brought a passing off claim. *Dastar*, 539 U.S. at 36. That claim, of course, would have been the same one Slep-Tone is making here: it would have alleged confusion based on the credits to Fox, just as Slep-Tone alleges confusion based on the inclusion of the Sound Choice marks within the content.

Far from endorsing such a claim, as Slep-Tone implies, *see* Br. of Appellant at 21, the Court invoked this hypothetical claim to demonstrate why “origin” must be understood to refer only to the origin of tangible goods. *See Dastar*, 539 U.S. at 36 (noting that “adopting a special definition of ‘origin for communicative products,’ one that would include the origin of the creative content, would place “manufacturers of those products in a difficult position”). As the full context of the Court’s discussion makes clear, its interpretation of “origin” ruled out not only claims for failing to credit the creator of a work, but also claims for crediting the creator, “if that [crediting] should be regarded as implying the creator’s ‘sponsorship or approval’ of the copy.” *Id.*

Slep-Tone chose to embed its claimed marks in expressive works in order to bootstrap a claim to control goods into a claim to control content. If there is confusion, it is not the kind of confusion trademark law aims to stop, and it is confusion of Slep-Tone's own deliberate creation. Its attempt to circumvent copyright's limitations—given Slep-Tone's apparent lack of a copyright interest in the music tracks at issue—should not succeed. As the Magistrate Judge reasoned:

[B]ecause the 1925 silent film *The Phantom of the Opera* is in the public domain, it is uncontroversial that it may be performed publicly, including for the purpose of commercial gain, and that copies of the 1925 public-domain version of the film (as opposed to more recent re-edits which may be subject to copyright as derivative works) may be (and routinely are) packaged under a new label and sold to the public for commercial benefit. The fact that the public-domain film opens and closes with Universal Studios' registered and still-enforceable trademarks is no obstacle to either public performance or sale of the public-domain film, so long as the packaging or labeling of the medium in which the copy is fixed does not bear the Universal Studios trademark or any information likely to confuse consumers as to whether the repackaged copy is a Universal Studios product.

ER 32.

In fact, even assuming that consumers expected to get karaoke tracks arranged by Slep-Tone, that is exactly what they got.

Trademark law gives Coca-Cola the right to police the authenticity of its tangible goods, because a soda that is not made by Coca-Cola is not Coca-Cola. But Slep-Tone does not have the right to police the

authenticity of its creative works under the Lanham Act. For that it must rely on copyright law.

III. CONCLUSION

For the foregoing reasons, the judgment of the District Court should be affirmed.

DATED: June 12, 2015

Respectfully submitted,

Of Counsel:

/s/ Joseph C. Gratz

MARK P. MCKENNA
NOTRE DAME LAW SCHOOL
3120 Eck Hall of Law
Notre Dame, Indiana 46556
(574) 631-9258
markmckenna@nd.edu

JOSEPH C. GRATZ
DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111
(415) 362-6666
jgratz@durietangri.com

Counsel for Amici Curiae

CERTIFICATE OF COMPLIANCE

I hereby certify that pursuant to Fed. R. App. P. 32(a)(7)(C) and Ninth Circuit Rule 32-1 this brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and (6), because it is written in 14-pt Century Schoolbook font, and with the type-volume limitations of Fed. R. App. P. 29(d) and Ninth Circuit Rule 29-2(c), because it contains 4,227 words, excluding the portions excluded under Fed. R. App. P. 32(a)(7)(B)(iii). This count is based on the word count feature of Microsoft Word.

DATED: June 12, 2015

/s/ Joseph C. Gratz
Joseph C. Gratz
DURIE TANGRI LLP
Counsel for Amici Curiae

9th Circuit Case Number(s) 14-36018

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