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The Tragedy of the Creative Commons: An Analysis of How Overlapping Intellectual Property Rights Undermine the Use of Permissive Licensing

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— Note —

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Introduction

Secure. Contain. Protect. These three words are one way to view the purpose of intellectual property—as a means for obtaining and maintaining exclusive rights over a creative work or invention. These three words are also the tagline of a vibrant internet community: the SCP Foundation.[1] The SCP Foundation is a "unique collective writing project," where individuals from around the world contribute stories

1. Homepage, SCP Found., http://www.scpwiki.com/ [https://perma.cc/C5BS-RD64] (May 24, 2022, 18:06).

that are published on the website.[2] The community maintains a fictional database written from the perspective of an organization whose purpose is to protect the public by discovering and housing strange, and sometimes dangerous, anomalies found in nature. These anomalies range from an "extremely hostile" cement statue[3] to a cardboard box that periodically opens and releases origami dragons.[4] Since the SCP Foundation is a creative-writing project, the authors who contribute to the website each obtain a copyright to their own work. However, the SCP Foundation utilizes a Creative Commons license to allow subsequent creators to develop works from the stories on the website with greater creativity and flexibility.[5] The SCP Foundation's Creative Commons license specifically allows for anyone to use the works found on the website to create derivative works, so long as attribution is given to the original author and the derivative work is also made available for reuse under the same Creative Commons license.[6] The subsequent creators can even profit from their derivative works under this license.[7] Derivative works can range from artbooks[8] to t-shirts[9] to video games.[10]

2. *Russia Licensing Statement*, 05 COMMAND, http://05command.wikidot.com/russia-licensing-statement [https://perma.cc/Z4N8-AZ7H] (last visited Oct. 27, 2021); *see also generally* Homepage, *supra* note 1.

3. *SCP-173*, SCP FOUND., http://www.scpwiki.com/scp-173 [https://perma.cc/VUD7-GXUY] (Oct. 9, 2021, 8:01 PM).

4. *SCP-1762*, SCP FOUND., http://www.scpwiki.com/scp-1762 [https://perma.cc/E4NJ-ZEEL] (Apr. 14, 2019, 1:28 AM).

5. *Russia Licensing Statement*, *supra* note 2*; see also Licensing Guide*, SCP FOUND., http://www.scpwiki.com/licensing-guide [https://perma.cc/H9Y6-385H] (Oct. 1, 2021, 2:38 AM).

6. The SCP Foundation utilizes the CC-BY-SA license. *Licensing Guide*, *supra* note 5; *see also Attribution-ShareAlike 3.0 Unported*, CREATIVE COMMONS, https://creativecommons.org/licenses/by-sa/3.0/legalcode [https://perma.cc/SC3W-JQ73] (last visited Oct. 27, 2021) (describing Creative Commons licenses). For a more in-depth discussion of Creative Commons licensing and the CC-BY-SA license, see *infra* Part I(B)(2).

7. *See Attribution-ShareAlike 3.0 Unported*, *supra* note 6; *Licensing Guide*, *supra* note 5.

8. *See, e.g.*, ARTSCP, https://artscp.com/en/ [https://perma.cc/C9VQ-75MV] (last visited Oct. 27, 2021).

9. *See, e.g.*, MagentaBlimp, *SCP Foundation (in White) Classic T-Shirt*, REDBUBBLE, https://www.redbubble.com/i/t-shirt/SCP-Foundation-in-White-by-MagentaBlimp/22312149.IJ6L0.XYZ [https://perma.cc/3W6F-KDCA] (last visited Oct. 27, 2021).

10. *See, e.g.*, Homepage, SCP CONTAINMENT BREACH, https://scpcbgame.com/ [https://perma.cc/9JJ8-YAN3] (last visited Oct. 27, 2021); *List of Notable SCP Games*, FANDOM: SCP-CONTAINMENT BREACH WIKI, https://containmentbreach.fandom.com/wiki/List_of_Notable_SCP_games [https://perma.cc/W3C4-5TDS] (last visited Oct. 27, 2021) (listing the notable video games that have been based off of the SCP Foundation website).

The SCP Foundation is considered unique because the community can continually grow the story and "anyone can develop it and benefit from it, given their adherence to the license."[11] As the SCP Foundation project shows, Creative Commons licenses, when used well, can increase creativity and innovation of intellectual property.[12]

Although the SCP Foundation is a great example of the benefits of using Creative Commons licenses, the SCP Foundation also illustrates the tension that can arise when different forms of intellectual-property protections conflict. Currently, the SCP Foundation is in litigation involving its copyright and Creative Commons license.[13] A man named Andrey Duksin successfully obtained a Russian trademark on the SCP Foundation logo.[14] He filed for the trademark after he used the logo in his own derivative work called ARTSCP.[15] In this derivative work, Duksin has created an art book that adds new art to accommodate the written entries on the SCP Foundation website.[16] He filed for the trademark because he felt that he had invested "a lot of money into promoting the universe and creating media content" and wanted to ensure that "no one shifty . . . jumps in and profits."[17] But Duksin has gone further than just protecting his own work—he has used his trademark to take down legal derivative works made under the SCP Foundation's Creative Commons license.[18] These are not derivative works of ARTSCP, but rather permissible uses of the SCP Foundation content.[19] Even if these were derivative works from ARTSCP, it would not make a difference given that ARTSCP should be subject to the same Creative

11. *Russia Licensing Statement*, *supra* note 2.

12. *Frequently Asked Question: What Is Creative Commons and What Do You Do?*, CREATIVE COMMONS (June 15, 2021, 17:59), https://creativecommons.org/faq/#what-is-creative-commons-and-what-do-you-do [https://perma.cc/PVX3-4292].

13. *See infra* Part II.

14. SCP FOUNDATION, Registration No. 661748 (Russ.) [hereinafter "SCP FOUNDATION" Trademark], https://new.fips.ru/publication-web/publications/document?type=doc&tab=UsrTM&id=A909F7E3-F580-4830-8731-9DABC47C1B88 [https://perma.cc/9K6R-8CFK] (last visited May 24, 2022).

15. *See Russia Licensing Statement*, *supra* note 2.

16. *See* ARTSCP, *supra* note 8.

17. *Russia Licensing Statement*, *supra* note 2 (quoting and providing a screenshot of a conversation on VK—a Russian social media website—between Duksin and the Russian branch of the SCP Foundation).

18. *Id.*

19. *See id.*

Commons license terms as the SCP Foundation's license.[20] Members of the SCP Foundation fear that Duksin could go so far as to take down the Russian branch of the SCP Foundation website because the website is using the logo for which he now has a "valid" trademark.[21]

The conflict playing out between Andrey Duksin and the SCP Foundation has implications outside of Russia. The conflict is reflective of one of the biggest debates in intellectual property: what is the purpose of intellectual-property rights?[22] Are intellectual property rights granted only to give a reward and provide a monopoly? Or are they granted to encourage disclosure and, therefore, more innovation and creativity? Further implicated by the Duksin–SCP Foundation conflict is a danger posed to permissive-licensing regimes, like the Creative Commons, that push against the idea of intellectual-property rights granting a monopoly—the danger that this type of licensing is legally inferior to more restrictive uses of intellectual property. This designation could make communities built around permissive licensing susceptible to strategic attacks by people claiming exclusive intellectual-property rights inconsistent with that community's goals.

As this Note argues, the purpose and values behind the use of a permissive license and a trademark are so completely at odds that there can be no compromise between them. Therefore, it should be impossible to obtain overlapping trademark rights to a creative work that is operating under a permissive license.

This Note aims to explain and address the problem of overlapping intellectual-property rights with a focus on permissive licensing. First, this Note provides an overview of copyright and trademark law and discusses the problem of overlapping copyright and trademark interests. Second, it introduces permissive licensing and provides some examples of different forms of permissive licensing. Third, it discusses the SCP Foundation and the problems that the SCP Foundation community has

20. *See Licensing Guide*, *supra* note 5. There is no indication on the ARTSCP website that Duksin is treating ARTSCP as a work licensed under the CC-BY-SA license. ARTSCP, *supra* note 8; *see also Russia Licensing Statement*, *supra* note 2.

21. Yossipossi, *The SCP Wiki Is Under Attack*, LIBREDDIT (Nov. 12, 2019), https://libredd.it/dvbds6 [https://perma.cc/P6Y4-L5KQ]; *see also Russia Licensing Statement*, *supra* note 2 ("[W]e expect attacks on our resources and ourselves."); *see also* "SCP FOUNDATION" Trademark, *supra* note 14.

22. This is a well discussed debate that spans all types of intellectual property from patents to trademarks. *See, e.g.*, Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 288 (1988) (describing the debate between utilitarian theory and personality theory); Adam D. Moore, *Intellectual Property and the Prisoner's Dilemma: A Game Theory Justification of Copyrights, Patents, and Trade Secrets*, 28 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 831, 834, 868–869 (2018) (arguing against the traditional theories for intellectual property and proposing an alternative "based on individual self-interest and prudence").

faced because of Andrey Duksin's trademark on the SCP Foundation's logo. This Note concludes with a discussion of how the SCP Foundation situation might resolve and proposes a broad solution for how intellectual property should address the problems created by overlapping trademarks with permissively licensed works.

I. AN OVERVIEW OF INTELLECTUAL PROPERTY AND PERMISSIVE LICENSING

Intellectual-property law has been developed and justified through many different theories. There are currently three main theories utilized to justify intellectual property law: personhood, natural rights, and utilitarianism.[23] The personhood theory argues that property rights embody a person's self-ownership.[24] "[T]angible and intangible items" are used to "define ourselves and obtain control over" our lives.[25] From this perspective, there are moral and ethical reasons to grant intellectual-property rights.[26] On the other hand, the natural-right theory argues that individuals are entitled to control over their own labor.[27] This theory advocates for individuals to own what they create. It is based in the philosophical theories of John Locke and Immanuel Kant.[28] Finally, the utilitarian theory argues that "[a]bsent certain guarantees, authors and inventors might not engage in producing intellectual property."[29] The utilitarian theory argues that intellectual-property rights incentivize the creation and distribution of a public good. It is the most common model of justification.[30] For example, the Intellectual Property

23. *See infra* notes 24–32 and accompanying text.

24. *See* G.W.F. HEGEL, ELEMENTS OF THE PHILOSOPHY OF RIGHT 75–77 (Allen W. Wood ed., H.B. Nisbet trans., 1991); Adam Moore & Ken Himma, *Intellectual Property*, THE STAN. ENCYC. OF PHIL. ARCHIVE, https://plato.stanford.edu/archives/win2018/entries/intellectual-property [https://perma.cc/9WKT-6ZXX] (Oct. 10, 2018) ("Personality theorists . . . maintain that individuals have moral claims to their own talents, feelings, character traits, and experiences . . . . Control over physical and intellectual objects is essential for self-actualization . . . .").

25. Moore & Himma, *supra* note 24.

26. *See* Peter S. Menell, *Intellectual Property: General Theories*, *in* 2 ENCYCLOPEDIA OF LAW AND ECONOMICS: CIVIL LAW AND ECONOMICS 129, 158 (Boudewijn Bouckaert & Gerrit De Geest eds., 2000).

27. Moore & Himma, *supra* note 24; *see also* Hughes, *supra* note 22, at 296–97.

28. *See* Menell, *supra* note 26, at 157.

29. Moore & Himma, *supra* note 24.

30. *See* Mark S. Nadel, *How Current Copyright Law Discourages Creative Output: The Overlooked Impact of Marketing*, 19 BERKELEY TECH. L.J. 785, 787 (2004) ("[G]ranting the copyright holder a virtual monopoly by prohibiting the unauthorized copying and sales of copyrighted works is a

Clause of the Constitution states that Congress has the authority "[t]o 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."[31] This statement embodies the utilitarian ideal of promoting the creation of the arts while limiting exclusive ownership.[32] However, the means employed to achieve the utilitarian balance vary depending on the type of intellectual property involved.

The Duksin–SCP Foundation conflict implicates two major types of intellectual property law—copyright and trademark. Understanding how they are different will help clarify some of the issues found in the Duksin–SCP Foundation situation. Furthermore, overlapping intellectual-property rights appear to circumvent the delicate balance that intellectual-property law tries to create.[33] Many countries, including the United States, have not answered the question of whether different intellectual-property rights can be granted to the same work.[34] This lack of guidance can cause problems, especially when individuals disagree over the purpose of the intellectual property grant.

A. Copyright v. Trademark

1. Intellectual-Property Purposes

The United States government protects works under copyright law that are "original works" and are "fixed in any tangible medium of

necessary evil for attracting the financial investments needed to promote the creation and distribution of these creative works." (footnote omitted)); *see also* Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 TEX. L. REV. 989, 994–95 (1997) ("Information has the characteristics of what economists call a 'public good'—it may be 'consumed' by many people without depletion, and it is difficult to identify those who will not pay and prevent them from using the information." (citing Kenneth J. Arrow, *Economic Welfare and the Allocation of Resources for Invention*, *in* NAT'L BUREAU OF ECONOMIC RESEARCH, THE RATE AND DIRECTION OF INVENTIVE ACTIVITY: ECON. AND SOC. FACTORS 609, 614–16 (1962))).

31. U.S. CONST. art. I, § 8, cl. 8.

32. *See* Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1476–77 (2004).

33. *See infra* Part I(A).

34. Although the Duksin–SCP conflict involves mainly Russian law, in this Note, I focus on the intellectual-property law of the Unites States. This Note's purpose is not to resolve the Duksin–SCP conflict but to discuss the larger implications of the conflict—that overlapping property rights can harm certain works that function under permissive licensing. This issue is larger than Russian trademark law. I believe that the United States (and the rest of the world) needs to decide how to handle the conflicts caused by overlapping intellectual-property rights.

expression."[35] A work receives protection under copyright law at the point of its creation and, unlike other intellectual property, it does not require registration.[36] It "endures" from its creation to seventy years after the author's death.[37] Copyright law protects literary works, pictures, and sound recordings, as well as derivative works and compilations.[38] However, a copyright for a derivative work extends only to protect the new material and does not provide a copyright owner rights to the preexisting material.[39] Nor does the fact that a derivative work may receive copyright protection provide the creator with the right to make a derivative work without the original copyright owner's permission.[40]

The utilitarian goals of intellectual-property rights play out in copyright law differently than in patent and trademark law. Copyright law provides a longer period of exclusive ownership in exchange for granting greater benefits to the public.[41] The main benefit provided to the public is that after the copyright expires, it enters the public domain, and anyone can use the work.[42] Some of the other benefits are the fair-use defense and the independent-creation exception to copyright infringement.[43] These exceptions allow the public to create certain kinds of derivative works and allow for continued innovation of a copyrighted work.[44] However, copyright owners have a monopoly on the creation of innovations and improvements to their copyrighted work that are not fair use.[45] Derivative works of this kind are not permitted without the owner's consent. So, under copyright law, a copyright owner has the right to control the creation and dissemination of derivative works.[46]

35. 17 U.S.C. § 102.

36. *Id.* § 302; Moffat, *supra* note 32, at 1490–91. However, if the author wishes to litigate an alleged copyright violation, then the author is required to register the copyright with the Copyright Office before suing. 17 U.S.C. § 411. *But see* 2 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 7.16(B)(2)(b) (Matthew Bender ed., rev. ed. 2022) (cataloging exceptions to the registration requirement). The registration only protects the work against violations in the three years preceding registration because of the three-year statute of limitations. *Id.* § 507(b).

37. 17 U.S.C. § 302.

38. *Id.* §§ 102–103.

39. *Id.* § 103.

40. *Id.* § 103(b).

41. *Compare Id.* § 302, *with* 15 U.S.C. § 1058.

42. 17 U.S.C. § 302 (establishing the 70-year length of copyright protection).

43. *Id.* § 107.

44. *See id.*

45. *Id.* § 106.

46. *Id.* § 106(2).

Copyright protections have changed dramatically over the years. Initially, Congress set the copyright term at fourteen years with the possibility of renewal for another fourteen years.[47] In 1909, Congress changed the copyright term to twenty-eight years with the possibility of renewal for a like term.[48] The bargain of copyright law was then left mostly unchanged until 1976. In 1976, Congress changed the term to the life of the author plus fifty years.[49] The 1976 law also expanded what subject matter could be copyrighted to what is "fixed in any tangible medium of expression."[50] With the expansion of copyrights came the codification of the fair-use defense.[51] Recognition of the fair-use defense was seen as a way to rebalance the copyright bargain by providing additional rights to the public in exchange for the extension of the copyright term.[52] In 1998, Congress expanded the copyright length to where it now sits at life of the author plus seventy years.[53]

This evolution shows that a copyright is meant to provide an incentive for the creation of a new work and the dissemination of that work to the public. The goal of granting a copyright is to balance dissemination of works and competition to create with protection of exclusive rights.[54] Changes to the copyright term and fair use provide some rebalancing of those aims.

Trademark law, even more than other intellectual-property rights, is backed by utilitarian justifications; however, the policy goals that underlie trademark law are quite different than those of copyright law.[55] Trademark protection is used to designate a brand or product so a consumer can tell who made it; this is a functional purpose for consumerism rather than a reward for the creativity or innovative nature of the trademark or underlying product.[56] Also, trademarks may be renewed indefinitely.[57] Thus, trademark holders may enforce their trademarks continuously against the public.

47. Copyright Act of 1790, ch. 15, §1, 1 Stat. 124, 124.

48. Copyright Act of 1909, ch. 320, § 23, 35 Stat. 1075, 1080.

49. Copyright Act of 1976, Pub. L. No. 94–553, § 302, 90 Stat. 2541, 2572.

50. 17 U.S.C. § 102; Moffat, *supra* note 32, at 1493.

51. 17 U.S.C. § 107; Moffat, *supra* note 32, at 1493.

52. *See* Moffat, *supra* note 32, at 1485–88.

53. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, §102(b), 112 Stat. 2827, 2827 (1998) (amending 17 U.S.C. § 302).

54. *See supra* notes 30–32 and accompanying text.

55. Moffat, *supra* note 32, at 1488–89 ("Trademark law is . . . animated by very different policy goals than are patent and copyright law.").

56. Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687, 1694–97 (1999).

57. *See* 15 U.S.C. § 1058 (setting the initial trademark-registration term as ten years); *id.* § 1059 (allowing trademark registration to be renewed).

In 1946, the Lanham Act codified longstanding common-law principles and created the federal registration system for trademarks.[58] The Act has helped with the growth and development of U.S. Trademark law.[59] Trademarks normally need to be registered and renewed with the Patent and Trademark Office, but the Lanham Act protects unregistered trademarks as well.[60] Federal law currently provides that "any person who, on or in connection with any goods or services, . . . uses in commerce any word, term, name, symbol, or device . . . shall be liable in a civil action" if its use is "likely to cause confusion" or "misrepresents the nature, characteristics, qualities, or geographic origin" of the goods or services.[61] The law outlines the two main goals of trademark law: (1) "avoiding consumer confusion" and (2) "fostering desirable investment in quality products."[62]

Unlike copyright law, the purpose of trademark law is not to provide an incentive for the public to create but, instead, to protect the public from charlatans. This purpose is a utilitarian goal for the public good. Rather than encouraging creation, trademarks focus on economic efficiency: reducing social costs by ensuring consumers can reliably find goods and services from particular producers in the marketplace.[63]

Because copyright law and trademark law have different purposes, the rights they grant are different. A copyright has an end date,[64] while a trademark's life can be extended indefinitely to last as long as the trademark is in use.[65] This difference results from a difference in goals.

58. Margreth Barrett, *Finding Trademark Use: The Historical Foundation for Limiting Infringement Liability to Uses "in the Manner of a Mark,"* 43 WAKE FOREST L. REV. 893, 937–39 (2008); *see also* Lemley, *supra* note 56, at 1687 & n.2; Lanham Act, ch. 540, 60 Stat. 427 (codified as amended in scattered sections of 15 U.S.C.).

59. *See* Lemley, *supra* note 56, at 1687–88.

60. 15 U.S.C. § 1125(a); *see also* Wal-Mart Stores v. Samara Bros., Inc., 529 U.S. 205, 209–10 (2000) (explaining that an unregistered mark is "for the most part" entitled to protection if it would qualify under the Lanham Act for registration as a trademark) (quoting Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992)); Deyerle v. Wright Mfg. Co., 496 F.2d 45, 53–54 (6th Cir. 1974) (affirming the District Court's holding that the "unauthorized use" was "unfair competition" under § 1125 "even though the mark was not federally registered").

61. 15 U.S.C. § 1125(a)(1).

62. Vincent Chiappetta, *Trademarks: More Than Meets the Eye*, 2003 J.L. TECH. & POL'Y 35, 42.

63. *Id.*

64. A copyright lasts seventy years after the death of the creator. 17 U.S.C. § 302(a) (2018).

65. 15 U.S.C. § 1058(b)(1)(A) (providing that the trademark owner may apply for renewal of the ten-year trademark registration by submitting affidavits that meet certain requirements, including a showing of "current use of the mark in commerce").

Copyright protections exist to help grow the public domain, but a trademark in the public domain could lead to consumer confusion, which is counterproductive and undesirable. Furthermore, derivative uses of trademarks are not encouraged because this could also lead to customer confusion.

Trademarks and copyrights seem like night and day—copyright law incentivizes creation while trademark law attempts to reasonably constrain creation. These conflicts in motivation lead to problems when a person is granted both a copyright and trademark on the same work.

2. Overlapping Intellectual-Property Rights

Generally, it should be difficult for a trademark to receive copyright protection and vice versa. Copyright law does not protect "[w]ords and short phrases" or "familiar symbols or designs."[66] At the same time, most trademarks do not rise to the same level of originality and creativity as words or symbols that receive copyright protection.[67] However, pictures and characters have been found to be eligible for both copyright and trademark protection. Perhaps the most prominent example of an existing overlapping copyright and trademark is Mickey Mouse.[68] Walt Disney first registered a trademark for "Mickey Mouse" in 1928, which Disney Enterprises last renewed in 2018.[69] The trademark covered the words "Mickey Mouse."[70] However, like all works, the character of Mickey Mouse was copyrighted at the moment of its creation, so Mickey Mouse's copyright started in 1928—the same year the words "Mickey Mouse" were trademarked.[71]

Despite the existence of such a high-profile example of overlapping intellectual-property rights, courts have offered little guidance on how to address overlapping rights.[72] In *Frederick Warne & Co. v. Book Sales*

66. 37 C.F.R. § 202.1 (2020).

67. 17 U.S.C. § 102(b); *see also* Chiappetta, *supra* note 62, at 44–46.

68. *See* Walt Disney Co. v. Powell, 698 F. Supp. 10, 13 (D.D.C. 1988) (finding that a retail business violated Disney's trademark and copyright in Mickey Mouse), *aff'd in part and remanded in part*, 897 F.2d 565, 570 (D.C. Cir. 1990).

69. MICKEY MOUSE, Registration No. 0247156.

70. *Id.*

71. Kaitlyn Hennessey, *Intellectual Property—Mickey Mouse's Intellectual Property Adventure: What Disney's War on Copyrights Has to Do with Trademarks and Patents*, 42 W. NEW ENG. L. REV. 25, 27 (2020).

72. This is likely to change soon as Disney's copyright interest in Mickey Mouse is about to expire; this is expected to be followed by a large amount of litigation regarding the validity of the trademark. *See* Hennessey, *supra* note 71, at 27; Sarah Sue Landau, Note, *Of Mouse and Men: Will Mickey Mouse Live Forever?*, 9 N.Y.U. J. INTELL. PROP. & ENT. L. 249, 251, 268 (2020).

Inc.,[73] the District Court for the Southern District of New York held that the trademark holder for the character Peter Rabbit could maintain a trademark infringement action after its copyright had fallen into the public domain.[74] The court stated that "[d]ual protection under copyright and trademark laws is particularly appropriate for graphic representations of characters."[75] The court further explained that even if a "character or design has fallen into the public domain," its copyright status "should not preclude protection under the trademark laws so long as it is shown to have acquired independent trademark significance, identifying in some way the source or sponsorship of the goods."[76] In *Frederick Warne*, the trademark holder obtained the trademark while the copyright was still valid and then continued to assert the trademark rights after the copyright expired. The court implied that the picture of Peter Rabbit had risen to the status of a trademark.[77] However, Viva Moffat argues that it "is a stretch" to believe "that Peter Rabbit had risen to trademark status."[78]

> It is hard to believe . . . that there is really a significant risk of confusion in this instance. Indeed, it is only if the trademark rights are granted here that people will come to associate Peter Rabbit with a single source rather than believing that he is part of the public domain. [79]

Even so, "the court did not appear reluctant to confer trademark rights."[80]

When the Supreme Court addressed the question of overlapping copyright and trademark protection in *Dastar Corp. v. Twentieth Century Fox Film Corp.*,[81] it further muddied the waters on overlapping copyright and trademark interests. Although the Supreme Court addressed the importance of not disturbing the delicate balance of intellectual-property law, the Court did not address overlapping protection directly.[82] In *Dastar*, the Court addressed whether a plaintiff could

73. 481 F. Supp. 1191 (S.D.N.Y. 1979).

74. *Id.* at 1193, 1196, 1198 ("The fact that a copyrightable character or design has fallen into public domain should not preclude protection under trademark laws . . . .").

75. *Id.* at 1196.

76. *Id.*

77. *Id.* at 1196, 1198.

78. Moffat, *supra* note 32, at 1509.

79. *Id.*

80. *Id.*

81. 539 U.S. 23 (2003).

82. *Id.* at 33–34.

bring an infringement claim against a defendant for copying and editing the plaintiff's video series after the video series entered the public domain.[83] The plaintiff brought a claim for trademark infringement arguing that the defendant was trying to "reverse pass[] off" the video series, which would violate trademark law.[84] The Court explained that reverse passing off is when a "producer misrepresents someone else's goods or services as his own."[85] Framing the claim this way, the Court only needed to answer the question of whether the plaintiff was entitled to protect the video series under trademark law.[86] The Supreme Court held that the defendant had not violated trademark law with the creation of its edited video series because the defendant "was the 'origin'" of the videos.[87] The Court never reached the question of whether a work can be protected by both a copyright and a trademark.

The guidance offered by the Court in *Dastar* regarding overlapping protection was minimal. The Court explained that copyright law is a "carefully crafted bargain."[88] As such, when a "copyright . . . has expired, the public may use the . . . work at will and without attribution."[89] The Court "'caution[ed] against [the] misuse or over-extension' of trademark [law] . . . into areas traditionally occupied by patent or copyright."[90] However, this explanation fails to address several questions.

The Supreme Court in *Dastar* left open the question of concurrent copyright and trademark protection. Furthermore, it did not address what would happen after a period of concurrent protection when the copyright expires, such as in *Frederick Warne*. The Court also did not address whether the copyright holder and trademark holder could be separate entities. The Court appeared to put emphasis on the right to copy works in the public domain as an integral part of the copyright bargain;[91] this emphasis may indicate a preference for protecting the

83. *Id.* at 25–27.

84. *Id.* at 27 (citing Williams v. Curtiss-Wright Corp., 691 F.2d 168, 172 (3d Cir. 1982) (discussing plaintiff's claim that defendant had violated trademark law under the Lanham Act); *Williams*, 691 F.2d at 172 (discussing "reverse palming off" and "passing off").

85. *Id.* at 27 n.1 (citing *Williams*, 691 F.2d at 172). "Passing off," on the other hand, "occurs when a producer misrepresents his own goods or services as someone else's." *Id.*

86. *Id.* at 31.

87. *Id.* at 38 (quoting 15 U.S.C. § 1125 (a)(1)(A)).

88. *Id.* at 33–34 (quoting Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 150–51 (1989)); *see also supra* Part I(A)(1).

89. *Dastar*, 539 U.S. at 33–34.

90. *Id.* at 34 (quoting Trafix Devices, Inc. v. Mktg. Displays Inc., 532 U.S. 23, 29 (2001)).

91. *Id.* at 33–34.

copyright bargain above protecting against consumer confusion under trademark law. However, it may be "equally, if not more, problematic" to the public "to withdraw well established trademark rights" as it would be "to deny the right to copy."[92] By looking at only the copyright-bargain portion of overlapping protection, the Court did not provide any guidance on what courts should do when faced with overlapping copyright and trademark protection.

The court in *Frederick Warne* may be correct that pictures and characters can rise to the level of deserving both copyright and trademark protection. If so, then a "mutant copyright"—a work which has been granted "additional protection," often through the overlapping of copyright and trademark law[93]—would exist as a matter of law.[94]

The mutant copyright undermines the copyright bargain. When a person possesses a copyright and a trademark concurrently, the trademark allows the holder to prevent fair use of the copyright.[95] For example, a parody found to be fair use under copyright law could constitute infringement under trademark law.[96] Furthermore, the mutant copyright denies the right to copy, which is an integral part of the copyright bargain. A trademark can last indefinitely, as long as it is still in use. In this way, once a copyright expires, the trademark will still exist and

92. Moffat, *supra* note 32, at 1526.

93. *Id.* at 1522. Although *Dastar*, itself, only addressed the question of whether trademark protection can be granted after the expiration of a copyright, Viva Moffat argues that "claims for overlapping protection have arisen in a variety of circumstances that are not addressed by the Court's rulings in *Dastar* . . . . These situations, which also give rise to mutant copyrights . . . are problematic if we take seriously the Court's reasoning in *Dastar* and *Trafix* and intellectual property policy in general." *Id.* at 1525. In this way, "a mutant copyright emerges whenever overlapping protection is available." *Id.* at 1523.

94. *See Dastar*, 539 U.S. at 34 (asserting that had Congress wanted to create such a hybrid, it would have made its intent to do so clearer). The Court used the term "mutant copyright" to refer to a situation where a trademark holder attempts to expand its copyright protection in a work through trademark law. In *Dastar*, this was after the copyright was expired. But the potential existence of overlapping rights—that is, copyright and trademark protection at the same time—gives rise to the same concerns that the *Dastar* Court expressed in its opinion. *See supra* note 93 and accompanying text.

95. Moffat, *supra* note 32, at 1516.

96. *Id.* For example, a parody which constitutes fair use of a copyrighted work might infringe on the trademark of that same work. *Id.* Parodies in a commercial space are more likely to cause confusion, so courts have only permitted parodies that are not overtly tied to commercial use. *See, e.g.*, Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1405–06 (9th Cir. 1997) ("[T]he claim of parody is not really a separate 'defense' . . . but merely a way of phrasing the traditional response that customers are not likely to be confused as to the source, sponsorship, or approval.").

may be used to prevent the content from functionally entering the public domain.[97] Denying the public fair use and the right to copy goes against the utilitarian justification for copyrights.[98]

Overall, the mutant copyright denies the public the benefits of the copyright bargain and prioritizes trademark control. The *Dastar* Court acknowledged this problem but did not find it necessary to give courts any guidance on how to address it. This lack of guidance is even more problematic when considering a copyright that has been permissively licensed.

B. Copyright v. Copyleft

1. Permissive Licensing and Its Justifications

With the rise of technology and the internet, there has been a movement for people to license their copyrighted works to allow for greater freedom of use without losing copyright protection—this is called "permissive licensing." Proponents of permissive licensing believe it is an innovative way to strengthen the public domain using copyright law.[99]

The simplest way to make a copyrighted work free would be to put it in the public domain—abandoning one's copyright interest.[100] Doing so would add works to the public domain more quickly and would allow subsequent users to use the work any way they wish. However, people can also take works from the public domain and convert them into a proprietary product. There are several ways to do this. For example, a person can make changes to the public-domain work, which would give the new creator a copyright interest in her original portions of the work that she can assert against others. In this situation, the underlying work would remain in the public domain, but the derivative work's author could exclude the public from her original additions.[101]

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97. Moffat, *supra* note 32, at 1516.

98. *See id.* at 1516–17.

99. Niva Elkin-Koren, *Exploring Creative Commons: A Skeptical View of a Worthy Pursuit*, *in* The Future of the Public Domain 325 (P. Bernt Hugenholtz & Lucie Guibault eds., 2006). Creative Commons is a nonprofit organization that provides permissive licenses. Dave Fagundes & Aaron Perzanowski, *Abandoning Copyright*, 62 Wm. & Mary L. Rev. 487, 516 (2020).

100. In practice, however, abandoning one's copyright, at least in a legal sense, is very challenging. *See generally* Fagundes & Perzanowski, *supra* note 99, at 487, 490. Private organizations like Creative Commons offer some avenues similar to abandonment. *Id.* at 516 (discussing similarities and differences between permissive licensing and abandonment); *see also CC0 1.0 Universal (CC0 1.0) Public Domain Dedication*, Creative Commons, https://creativecommons.org/publicdomain/zero/1.0/ [https://perma.cc/L4CX-ZY4N] (last visited Oct. 16, 2021).

101. Elizabeth L. Rosenblatt, *The Adventure of the Shrinking Public Domain*, 86 U. Colo. L. Rev. 561, 585 (2015); *see* 17 U.S.C. §103 & note (2018).

Another example would be for a person to trademark a work in the public domain.[102] By attaching a good or service to a public domain image or character, a person creates a new proprietary interest in that image or character in connection with the product produced.[103] So, people can take public domain works and assert their own intellectual-property interest in it, making it their own. Therefore, placing a work in the public domain does not ensure that the work will stay wholly in the public domain. Also, placing a work in the public domain removes any ownership interest that the original creator had over the work.[104] Renouncing one's copyright interest is, thus, especially problematic if the original creator wanted the work to remain free and accessible to everyone. Put differently, if the creator wants the work to remain free for all, it is in the creator's best interest to retain a right to exclude others from excluding others. Because copyright abandonment would relinquish that right, it may not ensure that a work remains fully in the public domain indefinitely.

The main push for permissive licensing was the "copyleft" movement, which followed the application of copyright protection to computer software in 1976.[105] Copyleft licensing makes copyrighted works (usually software) free, and requires all derivative versions of the

102. *See* Rosenblatt, *supra* note 101, at 573 ("[C]opyright and trademark law are gradually encroaching upon the public domain as Congress and the courts have expanded them to last longer, protect more information, and prohibit more uses."); Jake Linford, *Trademark Owner as Adverse Possessor: Productive Use and Property Acquisition*, 63 CASE W. RSRV. L. REV. 703, 739 (2013) ("[T]he public domain of copyrighted works and patented inventions is a passive public domain, and works and inventions may enter and exit the public domain independent of public use."); *see also* Xavier Morales, *Can I Trademark Something in the Public Domain?*, SECURE YOUR TRADEMARK, https://secureyourtrademark.com/can-you-trademark/trademark-something-in-the-public-domain/#:~:text=Yes%2C%20you%20can%20trademark%20a,promote%20your%20products%20or%20services [https://perma.cc/L8H6-4N3G] (last visited Oct. 16, 2021) ("Yes, you can trademark a name, logo, or slogan from the public domain if you use that name, logo or slogan to sell or promote your products or services.").

103. For example, a person could use the public domain character Sherlock Holmes for a "Sherlock Holmes" brand barber shop, but a person would not be able to establish a trademark in "Sherlock Holmes" for the books since it describes a product available from other sources. Rosenblatt, *supra* note 101, at 587, 617–19. *Id.* By trademarking the character in one way, a person has prevented others from being able to use that character in that way. Thus, there has been a carve out from the public domain.

104. *See* Golan v. Holder, 565 U.S. 302, 331–32 (2012) ("Once the term of protection ends, the works do not revest in any rightholder. Instead, the works simply lapse into the public domain.").

105. Teresa Hill, Note, *Fragmenting the Copyleft Movement: The Public Will Not Prevail*, 1999 UTAH L. REV. 797, 797.

work to be free as well.[106] Richard Stallman started the copyleft movement to offer an alternative distribution method for software.[107] Under Stallman's model, software would be "release[d] with [its] source code" and would allow for others "to modify, copy, and even redistribute the software."[108] The copyleft opposed conventional copyright interests and the "proprietary software model," which allowed owners to keep the source code secret, which made it "impossible" for people to make changes, even for their own personal use.[109] Stallman explained that "the central idea of copyleft is to use copyright law, 'but flip[] it over to serve the opposite of its usual purpose: instead of a means of privatizing software, [copyright] becomes a means of keeping software free.'"[110] The copyleft movement stands on the opposite side of the copyright bargain from copyright law: where copyright law gives a monopoly to a creator to encourage creation, the copyleft movement believes that the monopoly grant is not necessary to incentivize creation and actually inhibits innovation.[111]

The copyleft movement's success has been hindered, in part, because it has "fragmented" into two groups: those who had "philosophical criticisms" of the intellectual property bargain, like Stallman, and those who believed that sharing source code was more "practical," and advocated open-source licensing.[112] Copyleft purists differ from proponents of open-source licensing, because the former argue that software

106. Free Software Foundation, *What Is Copyleft?*, GNU OPERATING SYS. (Dec. 15, 2018, 2:02 PM), https://www.gnu.org/licenses/copyleft.en.html#:~:text=Copyleft%20is%20a%20general%20method,in%20the%20public%20domain%2C%20uncopyrighted [https://perma.cc/T6BU-MD5Z]; Hill, *supra* note 105, at 797–98.

107. Hill, *supra* note 105, at 797. Copyright law as applied to computer software has been criticized by legal scholars and computer experts alike. *See* Larry N. Woodard, Comment, *The West German Smorgasbord Approach to Intellectual Property Protection of Computer Software*, 15 J. MARSHALL J. COMPUT. & INFO. L. 883, 883–84 (1997). Software does not easily fit into any of the current categories of intellectual property. Software has a "functional aspect" that makes it "act . . . more like hardware." *Id.* at 884. This causes software to "not fit into the subject matter domain of copyright law, nor . . . easily satisfy the 'usefulness' requirement of the Patent Act." *Id.* This incompatibility was the main motivation behind the copyleft movement. *See* Hill, *supra* note 105, at 797.

108. Hill, *supra* note 105, at 797.

109. *Id.*

110. *Id.* at 798 (alterations in original) (quoting RICHARD M. STALLMAN, *The GNU Project and Free Software*, *in* FREE SOFTWARE, FREE SOCIETY: SELECTED ESSAYS OF RICHARD M. STALLMAN 17, 22 (Joshua Gay ed., 2002)).

111. *See id.* at 798–99 (discussing factions of the copyleft movement, some of whom favor the approach for utilitarian reasons of "better designed software").

112. *Id.* at 798–99.

needs to stay free indefinitely for the public to continue innovating with that software.[113] Open-source licenses, however, do not ensure that software remains free indefinitely—they offer the software for free, but do not copyleft it.[114] Derivative software using open-source code may therefore be made proprietary.[115]

This fragmentation ultimately led to what has been called the "death" of open source.[116] Namely, the copyleft's fragmentation allowed "proprietary behemoths of the tech industry," like Microsoft and Google, to move in.[117] These companies originally viewed open source as dangerous but soon began to embrace it and use it for their own advantage.[118] Companies allow individuals to develop free software under open-source licenses. Then, when this software becomes valuable, these companies move in and turn it into proprietary software.[119] Today, Microsoft has publicly embraced open source and is a sponsor of the O'Reilly Open Source Conference.[120] "Open source today is no

113. *See id.* at 798.

114. *Categories of Free and Nonfree Software*, GNU OPERATING SYS. (Sept. 11, 2021, 9:37 AM), https://www.gnu.org/philosophy/categories.en.html [https://perma.cc/6EUX-Q9PD] (diagramming copylefted software as a subset of open-source software and both copylefted software and open-source software as subsets of free software).

115. *See id.*

116. *See* Tarus Balog, *Open Source Is Still Dead*, DZONE: OPEN SOURCE ZONE (Aug. 20, 2018), https://dzone.com/articles/open-source-is-still-dead [https://perma.cc/X8GA-L6C8]; Tarek Amr, *Free and Open Source Software Is Dead*, MEDIUM (Dec. 25, 2017), https://gr33ndata.medium.com/free-and-open-source-software-is-dead-8a95bac74716 [https://perma.cc/2LX7-A9FY]; Adrian Bridgwater, *Is Open Source Broken?*, FORBES (Nov. 11, 2019, 11:17 AM), https://www.forbes.com/sites/adrianbridgwater/2019/11/11/is-open-source-broken/?sh=18d57c84d560 [https://perma.cc/E6ZG-EBRH].

117. Bridgwater, *supra* note 116.

118. *Id.*

119. Balog, *supra* note 116.

120. *Id.*; Bridgwater, *supra* note 116. For another example of a tech company using open source for its benefit, but still trying to retain control, see Ron Amadeo, *Google's Iron Grip on Android: Controlling Open Source by Any Means Necessary*, ARS TECHNICA (Jul. 21, 2018, 9:56 AM), https://arstechnica.com/gadgets/2018/07/googles-iron-grip-on-android-controlling-open-source-by-any-means-necessary/ [https://perma.cc/SE4T-RMX3]. Google released Android for free through open source, but the company continues to try to exert leverage over Android. *Id.* It does this by releasing closed-source apps into Android that then are integrated into the phone system, causing any open-source version of the software to be abandoned. *Id.*

more than a development model used mostly to help create proprietary software . . . ."[121]

Free software under both open-source and copyleft licensing is still around. Developers can still use the copyleft license to block others from making their software proprietary while still allowing free use.[122] However, the open-source approach to free software has prevailed, resulting in large tech companies profiting from the developments in free software.[123] The fragmenting of the copyleft movement resulted in the stagnation of its aims to reform intellectual-property law.[124] So, does this failure to make software free have implications for all creative works?

2. The Creative Commons Licenses

An alternative permissive-licensing method to copyleft is Creative Commons. While copyleft licensing is mainly geared towards software, Creative Commons licenses look towards licensing everything else.[125] Creative Commons is a nonprofit organization with the purpose of helping individuals "overcome legal obstacles to the sharing of knowledge and creativity."[126] Basically, Creative Commons has the goal of strengthening the public domain by using individual copyright interests. This motivation is very similar to the goal of the copyleft movement, and it could be said that Creative Commons is carrying the torch for the copyleft movement by using copyright law to keep creative works free.

Creative Commons created six licenses that can be chosen based on four different conditions.[127] These licenses allow for broader use of copyrighted works—from releasing the work into the public domain to permitting only redistribution.[128] These are standardized licenses that have

121. Balog, *supra* note 116.

122. Free Software Foundation, *supra* note 106.

123. *See supra* notes 118–21 and accompanying text.

124. Hill, *supra* note 105, at 822 ("[W]ith this division in the copyleft movement, the public will not prevail.").

125. Kincaid C. Brown, *Creative Commons: An Explainer*, 97 MICH. BAR J., Sept. 2018, at 52 ("Creative Commons licenses are designed for any copyrightable material with the exception of computer software . . . .").

126. *What We Do*, CREATIVE COMMONS, https://creativecommons.org/about/#:~:text=Creative%20Commons%20is%20a%20nonprofit,address%20the%20world's%20pressing%20challenges. [https://perma.cc/2DP3-3LXE] (last visited May 25, 2022).

127. *See infra* Figure 1. *See also About CC Licenses*, CREATIVE COMMONS, https://creativecommons.org/about/cclicenses/ [https://perma.cc/4N8E-JJVX] (last visited Feb. 11, 2021).

128. *See About CC Licenses*, *supra* note 127.

full legal force all around the world.[129] The licenses allow users to contract around copyright law without needing to contract individually with each person who wants to use their works. This consistency, flexibility, and internationality is especially helpful for images and content released on the internet because individuals in any country may be able to find and use the work. Since Creative Commons licenses operate as world licenses, drafters write them to be enforceable in every country, which allows for notice in each jurisdiction without confusion about whether the license applies.[130] Creative Commons has summarized the cases in which courts have discussed the license not only in the United States but also in Israel, Spain, and Germany.[131] Litigation of Creative Commons licenses is rare, but there have been a few important cases in the United States in recent years regarding Creative Commons licenses.[132] In these cases, the courts have recognized the Creative Commons licenses as valid public licenses and have interpreted them in line with how Creative Commons expected.[133]

129. Frequently Asked Questions: Are Creative Commons Licenses Enforceable in a Court of Law?, CREATIVE COMMONS (Aug. 28, 2020, 8:11 PM), https://creativecommons.org/faq/#are-creative-commons-licenses-enforceable-in-a-court-of-law [https://perma.cc/R6VF-REYH].

130. *Id.*

131. *See Case Law*, CC WIKI, https://wiki.creativecommons.org/wiki/Case_Law [https://perma.cc/R5GE-A5VW] (Aug. 9, 2017, 3:10 PM).

132. *Id.*; Diane Peters, *Recent U.S. Legal Decision Reinforces Strength of CC Licenses*, CREATIVE COMMONS (Apr. 2, 2018) https://creativecommons.org/2018/04/02/recent-u-s-legal-decision-reinforces-strength-cc-licenses/ [https://perma.cc/K2AN-WKX8]; *see also* Philpot v. WOS, Inc., No. 1:18-CV-339-RP, 2019 WL 1767208, at *2, *10–11 (W.D. Tex. Apr. 22, 2019) (finding that improper attribution under a Creative Commons license would be a violation of the copyright law); Great Minds v. FedEx Off. & Print Servs., Inc. 886 F.3d 91, 92–94 (2d Cir. 2018) (holding that nothing in the license "prohibit[ed] licensees' use of third-party services in furtherance of their authorized purposes").

133. *See* Peters, *supra* note 132 ("The decision [of the Second Circuit] aligns squarely with the arguments make by Creative Commons in an amicus brief submitted to the court." (referring to Great Minds v. FedEx Off. & Print Servs., Inc. 886 F.3d 91 (2d Cir. 2018))).

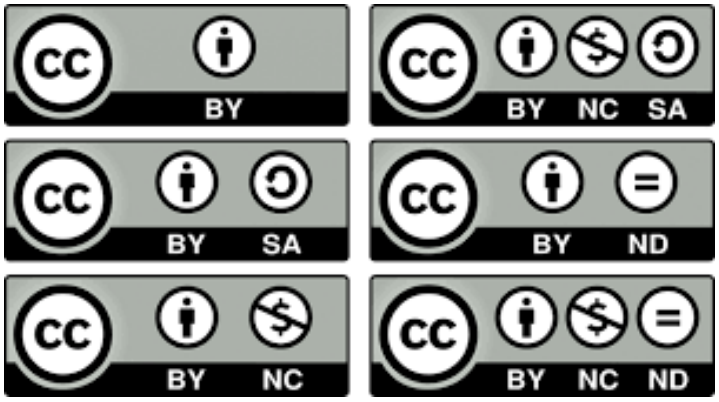

Figure 1: Creative Commons Licenses[134]

Figure 1 shows the six different Creative Commons licenses and the four conditions that define the scope of each license, those conditions being Attribution (abbreviated as BY), ShareAlike (SA), NonCommercial (NC), and NoDerivatives (ND).[135] Attribution requires that the user give credit to the original creator.[136] Attribution is the most important feature of the licenses and is required by nearly every Creative Commons license.[137] ShareAlike requires that adaptations and derivatives be distributed under the same license as the original work.[138] NonCommercial requires that distribution and derivative works not be commercialized or monetized.[139] Finally, NoDerivatives means that no derivative works or adaptations of the original work are permitted.[140]

As an example of how these conditions work, consider the CC-BY-SA license. This license allows anyone to use the works covered by the license as long as 1) attribution is given to the original creator (the "BY" part), and 2) as long as any derivative works are also licensed

134. Illustration of the Creative Commons Licenses, *in What is Creative Commons*, UNIV. OF WIS. LA CROSSE: MURPHY LIBR., https://libguides.uwlax.edu/c.php?g=274222&p=3962182 [https://perma.cc/XE38-B5YN] (Dec. 13, 2017, 1:05 PM); *see About CC Licenses*, *supra* note 127.

135. *About CC Licenses*, *supra* note 127; *About the Licenses*, CREATIVE COMMONS, https://creativecommons.org/licenses/ [https://perma.cc/4KNC-F5B7] (last visited Oct. 14, 2021).

136. *About CC Licenses*, *supra* note 127.

137. *Id.* Attribution is required on every license but the CC0 license. CC0 is not really a license, but rather a way for creators to indicate that they wish to give up their copyright and place their work in the public domain. *Id.*

138. *Id.*

139. *Id.*

140. *Id.*

under the same license terms (the "SA" part).[141] Any derivative use of the works under the CC-BY-SA license is allowed, including any adaptation, collection, or reproduction.[142] Furthermore, under the CC-BY-SA license, anyone can profit off the work, so long as they adhere to the license requirements.[143]

The CC-BY-SA license is one of the most permissive Creative Commons licenses and possibly the most like copyleft licenses.[144] By requiring all derivative works to be a Creative Commons SA-type license, the public continues to have public access and free use of the creative work. However, Creative Commons also offers licenses that do not have the ShareAlike condition. The existence of multiple licenses appears to mirror the fragmentation of the copyleft movement. Unfortunately, this similarity may mean that Creative Commons will be unable to effectuate a change in the copyright system. It has been argued that "[t]he lack of a clear alternative [to copyright] may simply strengthen the proprietary regime in creative works."[145] With no alternative, it may be challenging to have "enforceable legal measures" to constrain copyright holders to keeping their creative works free.[146] So scholars argue that the solution to making copyright more flexible (with an aim toward innovation) is not in licensing, as argued by Stallman and Creative Commons, but rather in copyright reform.[147] Nevertheless, it appears that large companies have not yet been able to co-opt Creative Commons licenses for their own profit.

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141. *Id.*

142. *Id.* ("If you remix, adapt, or build upon the material, you must license the modified material under identical terms.").

143. *Id.* ("The license allows for commercial use.").

144. *See id.*; *see also About the Licenses*, *supra* note 135 ("[The CC-BY-SA] license is often compared to 'copyleft' free and open source software licenses."). There are only two limits on the CC-BY-SA license: (1) the ShareAlike feature, which requires derivative works to be Creative Commons as well; and (2) the attribution requirement. *Id.* The only license more permissive than the CC-BY-SA license is the CC-BY license which "allows reusers to distribute, remix, adapt, and build upon the material in any medium or format, so long as attribution is given to the creator." *Id.*

145. Elkin-Koren, *supra* note 99, at 345.

146. *Id.*

147. *Id.* at 345; *see also* Christopher S. Brown, *Copyleft, the Disguised Copyright: Why Legislative Copyright Reform is Superior to Copyleft Licenses*, 78 UMKC L. REV. 749, 782–83 ("[P]roponents of the copyleft movement can probably achieve their goals relatively quickly if they pursue legislative reform. The outcome of such amendments, creating a large database of limited copyright works free to use and modify, is a drastic change in philosophy. However, the amendments themselves are not that drastic.").

3. Overlapping Intellectual Property and Permissive Licensing

The problem with overlapping copyright and trademark ownership does not end with the standard copyright—permissive licensing is swept into this conflict, creating the "mutant copyleft."[148] Permissive licensing values accessibility to the public and the ability to make derivative use of a creative work.[149] By modifying the copyright bargain, permissive licensing puts more control in the hands of the public than a standard copyright. When an individual obtains a trademark on a permissively licensed work, it strips away that control.

Many creators license their images under Creative Commons.[150] And, as the court in *Frederick Warne* explained, characters and pictures can gain trademark status if they "come[] to symbolize [a brand] in the public mind."[151] Furthermore, a trademark can be obtained on images in the public domain and on permissively licensed works[152] because the permissive license is on the copyright interest, not the trademark interest. If a person were to obtain a trademark on a work licensed under Creative Commons, there would be additional constraints added to reproducing or creating derivatives of the work, which may frustrate the permissive license's purpose. Creative Commons itself cautions against using a Creative Commons license to share a logo or trademark.[153] From a policy perspective, it does not make sense to permit parties to obtain a trademark on a permissively licensed work. The

148. The Court in *Dastar* used the term "mutant copyright" to refer to a work which has received an expanded scope of exclusion due to the work receiving both copyright and trademark protection. Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34 (2003). The mutant copyright gives the copyright holder additional power to exclude, which Congress had not contemplated. This Note uses the term "mutant copyleft" to refer to trademark protection being applied to a permissively licensed copyright. But mutant copyleft could arise in other situations. Like the mutant copyright, which gives the copyright holder powers not contemplated by law, the mutant copyleft gives a non-copyright holder power to exclude the public that neither Congress nor the copyright holder contemplated, and in fact abridges the copyright holder's right to permissively license a work.

149. *See* Part I(B)(1).

150. *CC Search*, CREATIVE COMMONS, https://search.creativecommons.org/ [https://perma.cc/KR59-NREG] (last visited Oct. 14, 2021); *see also, e.g.*, *A Cute Dog*, CREATIVE COMMONS, https://search.creativecommons.org/photos/7992f788-c8f6-459c-8186-b87edfb6bebe [https://perma.cc/8K6W-TX4Y] (last visited Oct. 14, 2021).

151. Frederick Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191, 1196–97 (S.D.N.Y. 1979).

152. *See supra* notes 101–03 and accompanying text.

153. *See* Frequently Asked Questions: Could I Use a CC License to Share My Logo or Trademark?, CREATIVE COMMONS (Nov. 22, 2021, 10:24 PM), https://creativecommons.org/faq/#could-i-use-a-cc-license-to-share-my-

trademark will prevent uses that the work's author intended to allow under the permissive license.

The ambivalence of the Supreme Court on what to do regarding overlapping trademark and copyright interests leaves questions and considerations open for someone with a permissive license. Consider the following illustrative example of how this issue might arise. An artist, A, draws an image and licenses that image under the most permissive Creative Commons license, the CC-BY license. A subsequent user, B, could take that image and begin using it as a company logo, so long as B provides proper attribution to A. The company could then get recognition and use the logo on its website and documents. At that point, the image would reasonably become the trademark for that company, but the image is still licensed by A under the Creative Commons license. Then another person, C, could come along and start using the image. Now, what happens if C places the image on a t-shirt and begins selling it? Could B sue C for trademark infringement? Which interest is more important: A's copyright interest in permissively licensing the image to the public or B's interest in avoiding public confusion between C and B's company? Can A and B, two different parties, reasonably have separate copyright and trademark interests in the same intellectual property? What if A and B live in different countries? Can B remove A's copyright interest through his trademark? Is C responsible for trademark infringement when C believed that the image was free to use under the Creative Commons license?

These are serious questions that will continue to have serious consequences as access to permissive licensing becomes more and more common through the internet. The conflict between Andrey Duksin and the SCP Foundation brings some of these problems to the forefront.

logo-or-trademark [https://perma.cc/R6VF-REYH] ("While a logo or trademark can be covered by copyright laws in addition to trademark laws, the special purposes of trademarks make CC licenses an unsuitable mechanism for sharing them in most cases.").

II. Secure, Contain, Protect the SCP Foundation.

Figure 2: SCP Foundation Logo[154]

A. History of the SCP Foundation

In 2007, on the imageboard 4chan, a person known only by the username "Moto42" posted a picture and some text.[155] Although unnamed, this picture grew in popularity and quickly took on the name SCP-173.[156] SCP-173 was described as an extremely dangerous cement statue that would move when a person blinked.[157] A community grew around this work and people began writing their own stories of other "SCPs." In July 2008, SCP-173, along with its derivative works, were transferred to a Wikidot wiki, which became the English branch of the SCP Foundation website.[158] The SCP Foundation website was not created by Moto42, but Moto42 "released SCP-173" and other SCP content under a Creative Commons license "and entrusted its management to the staff" of the English branch of the SCP Foundation.[159] Since then, the SCP Foundation has continued to grow. The SCP Foundation has become a "unique collective writing project," where individuals from all over the world contribute stories that are published on the website.[160] The community continues to write about "SCPs" but now from the perspective of a secret organization whose purpose is to protect the public from the threat of anomalies found in nature.[161] Today, there

154. Illustration of the SCP Foundation Logo, *in* SCP Foundation (Nov. 9, 2020, 2:04 AM), http://www.scpwiki.com/ [https://perma.cc/C5BS-RD64]. This is the logo on which Duksin has obtained a trademark. *See* "SCP FOUNDATION" Trademark, *supra* note 14.

155. *Russia Licensing Statement*, *supra* note 2. Although the original post on the 4chan anonymous board is no longer accessible, it remains substantially unchanged on the SCP Foundation website. *Id. See also SCP-173*, *supra* note 3.

156. *Russia Licensing Statement*, *supra* note 2.

157. *See SCP-173*, *supra* note 3.

158. *Russia Licensing Statement*, *supra* note 2.

159. *Id.*

160. *Id.*

161. *About the SCP Foundation*, SCP Found., https://scp-wiki.wikidot.com/about-the-scp-foundation [https://perma.cc/5A6Q-MEDJ] (Sept. 9, 2021, 15:38).

are fifteen official branches of the SCP Foundation and five unofficial branches.[162] In 2010, the Russian branch was founded, and, in 2015, an entrepreneurial man joined that branch—his name was Andrey Duksin.[163]

After contacting the SCP Foundation, Duksin began to create his own derivative work called "ARTSCP."[164] ARTSCP is a collection of artbooks that contain the stories published on the SCP Foundation website but with art drawn by his team to accompany the stories.[165] He sells these books on his website for his own profit.[166] The SCP Foundation was initially enthusiastic about the project and members of the community even posted about ARTSCP on social media.[167] Duksin promoted the SCP Foundation through networking with other creators and purchasing advertisements for the SCP Foundation, which benefited both the SCP Foundation and ARTSCP.[168]

In 2017, Duksin was in contact with a major film company about creating a series based on the SCP Foundation.[169] According to the Foundation, Duksin offered to be the "sole point of contact" between the film company as well as to construct a "uniform canon" for the SCP Foundation story.[170] He stated that being the sole point of contact would leave "no 'possibility of fraud.'"[171] The Foundation alleges that Duksin suggested that he should keep "half of the monetary reward" and then the rest could be distributed to "those who would be doing

162. *International Translation Archive of the SCP Foundation*, SCP FOUND., http://scp-int.wikidot.com/ [https://perma.cc/M9HD-5N25] (Nov. 29, 2020, 13:43).

163. *Russia Licensing Statement*, *supra* note 2.

164. *Id.* The *Russia Licensing Statement* was prepared by the Russian branch of the SCP Foundation to explain its legal dispute with Duksin. The statement is therefore written from the Foundation's point of view, though it supports portions of its statement with screen captures of conversations with Duksin.

165. ARTSCP, *supra* note 8. *See, e.g.*, *SCP Foundation (EN), (RED)*, ARTSCP, https://artscp.com/en/goods/en-2019 [https://perma.cc/N4TD-EADT] (last visited Oct. 14. 2021).

166. ARTSCP, *supra* note 8; *About Us*, ARTSCP, https://artscp.com/en/about/ [https://perma.cc/6NL7-3RNP] (last visited Oct. 14, 2021).

167. *Russia Licensing Statement*, *supra* note 2. Members posted on the SCP Foundation social media only after Duksin requested that they do so. *Id.*

168. *Id.* The most notable effect happened in 2019 when the advertisements purchased from Duksin resulted in a short period of time where the daily number of website visits doubled. *Id.*

169. *Id.*

170. *Id.*

171. *Id.* (internal quotation marks omitted).

the actual work."[172] However, nothing appeared to come of Duksin's filmmaking desires, and the SCP Foundation put talks of movies to rest until 2018.

In 2018, the SCP Foundation stated that it received an email from an online store called GeekFunCo. GeekFunCo sold SCP-branded merchandise and had begun to receive demand letters from "an unknown 'trademark holder.'"[173]

Unbeknownst to any branch of the SCP Foundation, Andrey Duksin applied for two trademarks through the Russian Federal Service for Intellectual Property—one for ARTSCP and one for the SCP Foundation logo.[174] As a result, Duksin began to request that Russian groups using the SCP Foundation logo take down their websites and merchandise.[175] Along with GeekFunCo, Duksin targeted several other profitable businesses, like SCP Fandom Box and Extradimensional Russian SCP Foundation Fandom, which sold boxes filled with a variety of different SCP-branded merchandise.[176] Although these boxes originated in Russia, the products were sold and shipped all over the world. According to the sellers, Duksin gave these websites draconian ultimatums that involved requesting more money than the boxes could profit.[177] When asked about these actions, Duksin said that he needed to "secure [him]self from the competition" and that people could still "develop the Foundation" but now they "must have [Duksin's] approval."[178]

Although Duksin has been acting only within Russia, he believes that his trademark gives him the ability to control SCP Foundation merchandise created all over the world.[179] After all, he argues that he can already prevent the sale of products out of Russia into other

172. *Id.*

173. *Id.* (internal quotation marks omitted).

174. "SCP FOUNDATION" Trademark, *supra* note 14; ARTSCP, Registration No. 810171 (Russ.), https://new.fips.ru/iiss/document.xhtml?faces-redirect=true&id=c39b487b54a3af1b91e5b5846103f2f0 [https://perma.cc/SFE9-A9YS] (last visited Oct. 15, 2021); *see also Russia Licensing Statement*, *supra* note 2. For a suggestion as to how Duksin could get a trademark on the SCP Foundation logo even though he did not create the logo or have any legal claim to the logo, see The Game Theorists, *Game Theory: The Horror That Threatens SCP*, YOUTUBE (Mar. 3, 2020), https://www.youtube.com/watch?v=T6P9TCdWE64 [https://perma.cc/NT9V-2LRV] (noting that Duksin is "not breaking trademark laws" but "breaking copyright laws").

175. *Russia Licensing Statement*, *supra* note 2.

176. *Id.*

177. *Id.* (providing screenshots and translated transcripts of several conversations between Duksin and vendors).

178. *Id.* (quoting a conversation between Duksin and someone, Nikita Kulik, attempting to give away merchandise with the SCP Foundation logo).

179. *Id.*

countries. Duksin justifies this belief by stating that in countries including Russia and the Commonwealth of Independent States, trademark law has "precedence."[180] Duksin has offered competitors three options: (1) "be a friend of [Duksin's]"; (2) do "not sell fanboxes or other Foundation-related stuff"; or else (3) "try and break the rules" and "get to know the law enforcement."[181] Duksin's actions seem like nothing less than a hostile takeover of all commercialization around the SCP Foundation. The question then becomes whether he has any legal basis for his assertion that his trademark is valid and can be asserted above the rights of the other members of the SCP Foundation.[182]

B. SCP Trademark v. the Creative Commons License

At the time that Duksin joined the SCP Foundation, and to this day, the SCP Foundation has been operating under the use of a Creative Commons license[183]—specifically, the Creative Commons Attribution-ShareAlike license (CC-BY-SA license).[184] This license allows anyone to reproduce or repurpose the works on the SCP Foundation website as long as attribution is given to the SCP Foundation and any derivative works are distributed under the same CC-BY-SA license.[185]

As explained by the Dmitry Zelten, the Site Administrator for the Russian Branch, the "SCP Foundation is a unique collective writing project. The fact that anyone can develop it and benefit from it, given their adherence to the license, gives it an immense advantage over other similar projects."[186] Derivative users can create and expand the SCP Foundation without fear of violating another SCP Foundation member's copyright interest. Under the license, the only way to violate a contributor's copyright would be through violating the license.[187]

180. *Id.*

181. *Id.* (quoting the conversation between Duksin and Kulik, referenced in note 178).

182. Duksin likely has no legitimate basis for asserting his trademark outside of Russia. Trademark law is not international. For example, nothing in the U.S. trademark statute extends the rights a trademark holder has under U.S. law to another country. *See* 15 U.S.C. §§ 1051–1172. However, Duksin would likely still have control of his trademark for goods coming in and out of Russia.

183. *Russia Licensing Statement*, *supra* note 2.

184. *Licensing Guide*, *supra* note 5.

185. *About CC Licenses*, *supra* note 127; *see also Attribution-ShareAlike 3.0 Unported*, *supra* note 6.

186. *Russia Licensing Statement*, *supra* note 2.

187. *Id.*

Furthermore, the license ensures that anyone, including Andrey Duksin, can make money from the SCP Foundation content.[188]

Although Duksin has been able to create and profit from ARTSCP because of the Creative Commons license, he has repeatedly clashed with it. The first notable conflict occurred in the summer of 2017 when Duksin was in contact with a filmmaking company. The Foundation was skeptical of the prospect of a film because any movie that would be made would still need to adhere to the Creative Commons license. The SCP Foundation did not believe that the filmmakers would react positively to the idea of their movie "being distributed for free on a legal basis."[189]

When the SCP Foundation discovered Duksin's trademark, its initial belief was that Duksin obtained the trademark to control any movie made.[190] After all, he applied for the trademark around the same time he engaged in filmmaking discussions.[191] Further, the classifications of goods and services that are covered by Duksin's trademark include computer software, computer games, electronic releases, marketing and online advertisements, book publishing, video files, and films.[192] The fact that films and videos are included suggested that Duksin was trying to circumvent the Creative Commons license and make a movie more likely to be produced.[193] However, more concerning to the SCP Foundation was the inclusion of electronic releases. This classification could allow Duksin to perform a "hostile takeover" of the SCP Foundation website, which itself is an electronic release.[194] Although Duksin has told the SCP Foundation that he would never assert the trademark against the SCP Foundation website, his words are not enough to assuage its fears.

Duksin told the Foundation that he obtained the trademark only to protect himself, not to hurt the community. He explained that he put "a lot of money into promoting the universe and creating media content," so he had "to make sure no one shifty enough jumps in and profits on the PR [he was] making."[195] Duksin said the trademark would not matter "for the community" because he had "always supported the

188. *Id.*

189. *Id.*

190. *Id.*

191. *Id.*

192. *Id.*

193. *Id.*

194. *Id.*

195. *Id.* (quoting the conversation between Duksin and SCP Foundation staff, referenced in note 17).

community's decisions."[196] However, a trademark has legal force and, "[e]ven today his words that the trademark is not detrimental to the site in any way are only valid until and unless any business operations are conducted on the site."[197] Duksin has indicated that he is interested in being the only person to profit from the SCP Foundation content. So, the SCP Foundation website is only safe so long as it does not try to profit.

If anyone in the SCP Foundation does try to profit, Duksin has shown that he is willing to threaten to enforce his trademark against those people.[198] In light of the Creative Commons license, Duksin does not have a valid copyright-infringement claim against other users of the license. However, to the objections by users that they are conducting business in compliance with the Creative Commons license, Duksin responds that the license does not matter in Russia and that he will send them to jail.[199]

Duksin has defended his position by arguing that he "put a lot of money into promoting the universe . . ." and that he wants "to get [his] own investment back."[200] He registered the trademark to fight competition and stop competitors from making profit without his permission. This sort of reasoning seems to be completely in line with the reasoning for obtaining a trademark—to protect profits and avoid customer confusion.[201] However, Duksin's actions go against everything that the SCP Foundation and its Creative Commons license stand for. There is no "symbiosis" between Duksin and the SCP Foundation.[202]

Although Andrey Duksin's actions are not in line with the Creative Commons ethos, his arguments about the value of his trademark still align with the justifications for trademark law. The SCP Foundation is still in litigation with Duksin over his trademark.[203] The Duksin–SCP Foundation conflict will resolve, but it poses important questions: is a trademark somehow more important than a permissive copyright? And, if so, is a trademark more important than a copyright? Or is the

196. *Id.* (quoting the conversation between Duksin and SCP Foundation staff, referenced in note 17).

197. *Id.*

198. *See id.*

199. *Id.* (quoting a conversation between Duksin and a VK vendor name "Fear Phantom").

200. *Id.*

201. *See* Chiappetta, *supra* note 62, at 42.

202. *Russia Licensing Statement*, *supra* note 2.

203. *SCP Legal Funds*, GOFUNDME (Nov. 23, 2020), https://www.gofundme.com/f/scp-legal-funds [https://perma.cc/8SHE-ZM3V]. According to the SCP Foundation, as of November 2020, the Foundation won its initial challenge against Duksin. *Id.* However, the SCP Foundation is continuing in its lawsuit against Duksin to sue him for copyright violation. *Id.*

"copyleftness" what makes a Creative Commons license inferior to a trademark?

III. Setting Right the Problem of Overlapping Intellectual Property

A. Resolving the Duksin–SCP Foundation Conflict

The SCP Foundation, on its own, is a prime example of how a permissive license can contribute to the utilitarian goals of copyright. The SCP Foundation has been able to grow and inspire continuous creation by using the CC-BY-SA license. The success of the SCP Foundation may even illustrate that the monopoly grant to original creators under copyright law privatizes too much and hurts the goal of incentivizing individuals to bring new works to the public.[204] However, by permissively licensing the works, the SCP Foundation has opened itself up to the dangers of overlapping intellectual-property rights and the mutant copyleft.

The Duksin–SCP Foundation conflict is a great illustration of the problems that overlapping copyright and trademark interests can cause for a permissively licensed work. But that tension is not limited to just this situation. The arguments of each party reflect the natural tension between copyright and trademark. Duksin and trademark law argue for continuous and complete control over intellectual property to increase profits and avoid customer confusion.[205] The SCP Foundation and copyright law argue for public innovation and creation.[206] Although people are rewarded under copyright law with the monopoly grant, this is not the main goal of copyright law under the utilitarian theory, and copyright law cares little if the work created is profitable.[207] This tension is further accentuated when the copyrighted work is permissively licensed. Permissive licensing limits the scope of the monopoly grant and encourages broader innovation rights. With this tension running into the heart of intellectual-property theory, will permissively licensed works be able to overcome the hurdles created by the intellectual property regime?

Regarding the Duksin–SCP Foundation conflict, first, it is likely that Duksin has violated copyright law by not adhering to the Creative Commons license requirements with his own derivative work, ARTSCP. Under the license, Duksin would not be permitted to prevent derivative

204. Resolving this question is outside the scope of this Note. For more discussion on the copyright bargain and whether it is currently balanced, see generally, Eric E. Johnson, *The Economics and Sociality of Sharing Intellectual Property Rights*, 94 B.U. L. Rev. 1935 (2014) and Nadel, *supra* note 30, at 788, 790–93.

205. *See supra* notes 55–63, 171, 195–97.

206. *See supra* notes 1–12, 41–46.

207. *See supra* notes 29–32, 45.

uses of ARTSCP, so long as those derivative works provided proper attribution and use the CC-BY-SA license.[208] So, his desire to protect his return-on-investment in ARTSCP is not feasible under that license (at least not to the extent that he wants).

As of November 2021, according to the SCP Foundation, the Russian Federal Antimonopoly Service found that Duksin's actions "violated Fair Competition laws by using the trademark against Russian social media groups and content creators" and the decision was upheld on appeal.[209] The committee also stated that the SCP Foundation logo was not created by Duksin and could lead to an "illegitimate monopoly."[210] However, the committee did not hold that the trademark was illegal and has allowed Duksin to retain his trademark rights.[211] Russia has a long history of indulging trademark and patent "trolls" and has been resistant to removing existing trademark registration, even in the face of apparent illegitimacy.[212] Companies with significantly more money than the SCP Foundation have faced years of litigation to retrieve their intellectual-property rights from illegitimate trademark holders.[213] This history might mean that the SCP Foundation will encounter a war of attrition to reclaim its logo; the SCP Foundation may lose because it does not have the funds to continue litigating. Fortunately, the SCP Foundation has the support of a large community, which has been willing to donate to help the SCP Foundation continue its litigation efforts.[214] Other permissively licensed works are not as fortunate. In this regard, the prospect of litigation can deter or undermine the whole idea of Creative Commons.

208. *Russia Licensing Statement*, *supra* note 2; *see also Licensing Guide*, *supra* note 5.

209. *SCP Legal Funds*, *supra* note 203.

210. *Id.*

211. *Id.*

212. There are dozens of individuals and companies that are "active in hoarding brand names and patents in Russia" despite having no legitimate intellectual property interest. Andrew Kramer, *He Doesn't Make Coffee, but He Controls 'Starbucks' in Russia*, N.Y. TIMES (Oct. 12, 2005), https://www.nytimes.com/2005/10/12/business/worldbusiness/he-doesnt-make-coffee-but-he-controls-starbucks-in.html [https://perma.cc/ YK5K-EMC8]. As stated, although the Russian Federal Antimonopoly Service determined Duksin's trademark "a violation of Fair Competition law," the Service has "left Duksin's trademark intact, and they have chosen not to address" the illegitimacy of Duksin's trademark. *Id.* This behavior allows Duksin to join the ranks of other trademark trolls.

213. For example, Starbucks was in litigation for three years trying to get its trademark back from a Russian trademark "squatter." Andrew E. Kramer, *After Long Dispute, a Russian Starbucks*, N.Y. TIMES (Sept. 7, 2007), https://www.nytimes.com/2007/09/07/business/worldbusiness/07sbux.html [https://perma.cc/4V8Y-L74H].

214. *See SCP Legal Funds*, *supra* note 203.

Ultimately, a win for Duksin could signal the potential "death of Creative Commons" in a similar fashion to that of the "death of open source." Opportunists, like Duksin, could descend on a permissively licensed work that shows profit potential and file a trademark on it. This would be similar to how tech companies are able to utilize open-source software and turn it proprietary once it is developed enough.[215] At a minimum, the consequence of allowing subsequent users to obtain trademarks on a work licensed under Creative Commons would be to render the ShareAlike condition of Creative Commons meaningless because someone could use a trademark to control derivative works.

B. Resolving the Mutant Copyleft

The use of trademark law on copyrighted material is problematic on both sides of the copyright bargain, but it inherently infringes on the purpose motivating permissive licenses: free use of a creative work.[216] By valuing accessibility to the public, permissively licensed works are placed closer to the public domain. This access opens these works up to the possibility of a subsequent user obtaining a trademark on the permissively licensed work.

Obtaining an exclusive intellectual-property interest in a work in the public domain causes a clear problem that hits at the heart of trademark law—it causes public confusion.[217] The current trend is to allow a trademark to be obtained on images, characters, and logos in the public domain.[218] However, this causes confusion over who actually owns the work. Consider the outcome of *Frederick Warne*.[219] By recognizing that the story and pictures of Peter Rabbit were in the public domain, but that the character of Peter Rabbit had potentially risen to the status of being trademarkable,[220] the court provided an outcome based in public confusion over its intellectual-property rights in Peter Rabbit.[221] The public would have a difficult time differentiating the trademark of Peter Rabbit and the public-domain portion of Peter Rabbit.[222] As a result, the public would likely not make any use of Peter Rabbit, either because the public would believe that Peter Rabbit was still exclusively owned

215. *See supra* notes 117–21.

216. *See supra* Part I(B)(1).

217. *See supra* notes 61–62.

218. *See supra* Part I(A)(2).

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

220. *Id.* at 1198.

221. Moffat, *supra* note 32, at 1508–09.

222. Rosenblatt, *supra* note 101, at 609 & n. 232 (explaining the relationship between legal uncertainly and privatization of the public domain).

and, therefore, not in the public domain or out of fear of litigation.[223] There are significant transaction costs to public use if a trademark is obtained on a work in the public domain. The overlap and public confusion create opportunities for trademark holders to overreach, which ultimately "shrinks the public domain."[224]

Obtaining a trademark on a permissively licensed work causes related problems. Consider the Duksin–SCP Foundation situation again. Currently, the law allows for overlapping copyright and trademark interests in a work.[225] So, without prohibiting overlapping copyright and trademark protections, there are two main solutions that a court could provide while still upholding both the trademark and copyright: either the trademark can circumvent the copyright, or the trademark is not enforceable. Neither of these outcomes is good.

First, removing a copyright interest in a creator's own work is inherently wrong. This removal deprives the creator of the property right and control that the creator was promised as a reward for creating the work,[226] going against both the moral and utilitarian justifications for intellectual property rights.[227] Removing a permissively licensed copyright is even more problematic because it denies the public access and use that the creator promised to them. This may hurt the utilitarian goal of encouraging creation and innovation because people may not want to share their creative works if they are fearful that they may be deprived of their intellectual property rights for doing so. Accordingly, allowing a party to obtain a trademark to stop innovation and creation is not really a solution.

Alternatively, denying enforcement of a trademark may also be a problem. If a party has come to rely on its logo in association with a product or company, then there is a risk to the public when the trademark is not enforceable. Either there will be public confusion over what products are associated with the company, or "shifty" individuals could move in and trick the public by using the goodwill that backs the trademarked image. The trademark likely would be enforceable but limited to the specific product or service for which it is currently being used. This narrowing of the trademark scope could be a useful solution; this would involve treating all works in the public domain as "generic" since

223. *Id.* at 608. *See also The Curious Case of Old Mr. Bunny*, TIMWARNES (Feb. 28, 2020), https://www.timwarnes.com/blog/2020/2/27/the-curious-case-of-old-mr-bunny [https://perma.cc/3PVW-3QL2] (trying to determine who has a copyright interest in Peter Rabbit and concluding that it belongs to the publishing company Frederick Warne & Co).

224. Rosenblatt, *supra* note 101, at 622.

225. *See supra* notes 66–72 and accompanying text.

226. *See* 17 U.S.C. § 106.

227. *See supra* notes 24–32.

generic works cannot be trademarked.[228] Although permissively licensed works are not in the public domain, permissive licenses provide the public access similar to the public's access to public-domain works. It might violate a permissive license to treat a work as generic since that may result in lack of attribution or other limitations that the license assures.

Because the courts and Congress have provided little guidance on how to handle overlapping trademark and copyright interests, it is a challenge to predict how the tension between the two protections will resolve. This problem is complicated further by the internet and the possibility that a trademark may be obtained in a different country than that of the original creator. Trademark registration is not international,[229] which provides an additional issue where only some of the public would be denied use. This mixture of conflicting international policies would be complicated further if certain countries strike a balance favoring copyright law, while others resolve this problem in favor of trademark law. Disparate international regimes would make it even harder for the public to tell when they might be violating someone's trademark.

Ultimately, it seems that, if legislators and courts allow the overlap of permissively licensed copyrights and trademarks, the public will always lose. But the solution is simple: it should be impossible to obtain trademark rights on a work that is operating under a permissive license. Although the solution seems straight forward, achieving it is challenging.

C. The Solution

A clear solution to avoiding the problems caused by the mutant copyleft is to simply prevent the overlap from happening. However, to achieve this solution, there would likely need to be copyright reform. Ideally, Congress should explicitly recognize permissive licensing and deny overlap with trademark law. To achieve this end, Congress would need to implement a few specific protections.

First, copyright holders should be allowed to "relinquish all or some of their rights" under the Copyright Act.[230] Second, the Copyright Office should update its database to disclose what rights have been relinquished by copyright holders.[231] Since the database suggestion is relatively simple and cheap, it should be possible to seamlessly integrate this feature.[232] Currently, Creative Commons utilizes a database to

228. Rosenblatt, *supra* note 101, at 625.

229. Nothing in the U.S. trademark statute extends the rights a trademark holder has under U.S. law to another country. *See* 15 U.S.C. §§ 1051–1172.

230. Brown, *supra* note 147, at 778.

231. *Id.*

232. *Id.* at 783.

allow individuals to access permissively licensed works and differentiate between license restrictions on those works.[233] The Copyright Office should not have a problem doing the same. Codifying permissive licensing would make it easier for the public to access permissively licensed works and for individuals to protect permissively licensed works from misuse.

Next, Congress should reject overlapping copyright and trademark rights. Overlapping protection is likely "an unintended consequence of a complex and evolving intellectual property system."[234] Because it is an unexpected consequence, Congress has been silent on whether overlapping protection should be maintained or is beneficial. Due to this congressional silence, the courts have not had any guidance in addressing the problems caused by overlapping intellectual-property interests. Although the Supreme Court in *Dastar* recognized the dangers that overlapping copyright and trademark protection can cause, the Court did not reject the possibility of overlap.[235] If Congress were to speak on the issue, then the courts would have more direction in addressing the problems. This guidance would give the courts some indication of what types of overlap may be desirable, if any.

At a minimum, overlapping intellectual-property rights should be rejected when there are multiple parties with different intellectual-property interests in the same work. For example, one party has the copyright interest in an image and a different person has a trademark for the same image. This prohibition would not affect single parties, like Disney, that possess both a copyright and trademark interest in the same work. Also, this situation would exclude multiple parties with the same kind of intellectual-property interest in a similar work, such as multiple parties using a generic term as a trademark for different products or services.[236] Rather, this minimum requirement would only implicate the situation where two parties may have conflicting desires on how the underlying work should be used and both have different types of control over that use. Without the recommended changes, this conflict can cause public confusion over how the work should be used and who actually owns the work. This situation is likely to occur when the copyright interest is permissively licensed, so rejecting overlapping protection when there is a permissively licensed copyright makes the most sense as to where the minimum line should be drawn in determining impermissible, overlapping intellectual-property rights.

233. *CC Search*, *supra* note 150.

234. Samuel Oddi, *The Tragicomedy of the Public Domain in Intellectual Property Law*, 25 Hastings Commc'ns & Ent. L.J. 1, 43 (2002).

235. Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 33–34 (2003).

236. *See supra* note 102 and accompanying text.

This solution of preventing overlapping trademark and permissive licensing helps avoid public confusion when there are multiple people using the same permissively licensed image. It allows for reduced transaction costs for the public in understanding what uses are permissible. Furthermore, it will help avoid situations, like the Duksin–SCP Foundation conflict, where parties will try to interfere with the permissive licensing from the perceived belief that a trademark is more meaningful. Finally, this solution will encourage the public to continue innovating and creating.

Conclusion

The conflict unfolding between Andrey Duksin and the SCP Foundation presents serious problems that occur when a party obtains a trademark on a permissively licensed copyright. If the courts or Congress do not address the problem of the mutant copyleft, then permissively licensed copyright holders, like the members of the SCP Foundation, will be faced with the challenges and the costs of competing with trademark holders for how their works should be used. If courts protect the copyright interest over the trademark interest, they run the risk of public confusion. This also presents the risk of permissively licensed copyright holders still needing to litigate to protect their work. Most people who utilize permissive licensing do not make money from their works, so funding litigation may be difficult.[237] The SCP Foundation was fortunate to have a community that was able to bring awareness to the problem and help the SCP Foundation raise money to fight back against Duksin. Without the ability to litigate, it would not matter whether the court is willing to hold the trademark unenforceable. On the other hand, if the courts hold that the trademark is enforceable against derivative works operating legally under a permissive license, then trademark law may become a new way for opportunistic individuals to capture valuable copyrights and make them proprietary.

Too many transaction costs hurt the public. Permissive licensing, like the Creative Commons license, tries to remove transaction costs by using a standardized license to allow creators to provide the public with certain uses to their work, without needing to contract with everyone in the public.[238] However, overlapping copyright and trademark interests create new and more complicated transaction costs.[239] That causes public confusion about how other parties can use the work.[240] Furthermore, it opens potential users up to the prospect of litigation if they do

237. Over half of the Creative Commons licenses prevent commercial uses of the work. *About CC Licenses*, *supra* note 127.

238. *See supra* Part I(B).

239. *See supra* Part I(A)(2).

240. *See* Rosenblatt, *supra* note 101, at 608.

use a work that is permissively licensed.[241] Regardless of a trademark's attempt to reduce confusion over the identity of a good or service, a trademark on a work that is in the public's possession (either through a permissive license or the public domain) goes against the ideals of trademark law because it necessarily causes confusion to the public. The purpose and values behind permissive licensing and trademarks are so completely at odds that there can be no compromise between them. Therefore, the best solution would be to avoid the mutant copyleft completely by making it impossible to obtain overlapping trademark rights on a work operating under a permissive license. Intellectual property is for the promotion of arts and creativity;[242] although trademark law is justified under different reasons, it should not interfere with individual copyright holders trying to achieve this goal.

Reagan Joy[†]

241. *See id.*

242. *See supra* Parts I(A)(1) & I(B)(1); *see also* U.S. CONST. art. I, § 8, cl. 8.

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