Cultural Heritage Tug of War: Balancing Preservation Interests and Commercial Rights

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CULTURAL HERITAGE TUG OF WAR:
BALANCING PRESERVATION INTERESTS
AND COMMERCIAL RIGHTS

He waka eke noa
A Maori proverb about common property meaning
"A canoe on which everyone may embark."

INTRODUCTION: EXPLORING RIGHTS TO CULTURAL HERITAGE

This Comment explores the clash between indigenous groups fighting to control their intangible cultural heritage\(^1\) and entities that use traditional knowledge for inspiration to create commercial works.\(^2\) The beauty and power of native language, legends, songs, folklore, and history motivates artists, authors, playwrights, and designers to incorporate aspects of native heritage into different pop culture mediums. Corporations also seek to incorporate indigenous imagery into their products, services, or marketing because they recognize the commercial value of doing so. Indigenous groups often resist these culture leaks and seek to control exclusively aspects of their cultural heritage\(^3\) that others believe are in the public domain, free for all to use.

First, Part II of this Comment attempts to define cultural heritage. This is not an easy task as the concept of cultural heritage varies between groups and encompasses both tangible and intangible aspects.\(^4\) This Comment focuses only on the intangible rights associated with cultural heritage, as opposed to rights in controlling a physical work.\(^5\) Part II then traces the development of statutory and case law applica-

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1. See Sarah Harding, *Value, Obligation and Cultural Heritage*, 31 *Ariz. St. L.J.* 291, 297-304 (1999). This Comment intends for the term “cultural heritage” to encompass several forms of traditional knowledge created by individuals, groups, or generations, which include stories, myths, folklore, and some art. See also Press Release, Estate of T’sunke Witko, One Brewing Company Settles Lawsuit with the Family of Crazy Horse and Rosebud Sioux Tribe [hereinafter Estate of T’sunke Witko], available at http://www.ableza.org/CHorse.html (last visited July 20, 2003).

2. For the purpose of this Comment, “commercial works” may include several types of expressions, including plays, books, advertisements, comic books, toys, games, and more.


ble to intangible cultural heritage disputes under the umbrella of intellectual property. The trademark, copyright, and right of publicity cases represented in this Comment are not necessarily landmark intellectual property decisions; still, all cases involve holdings and facts that may be applicable to cultural heritage appropriation suits.

To illustrate this complex cultural heritage tug of war, Part III uses the backdrop of an ongoing, real-life struggle between the Maori, indigenous tribes of New Zealand, and the...
LEGO\(^7\) Group (LEGO) a Danish toy maker. For the purpose of this Comment, one must hypothetically place this dispute within the jurisdiction of the United States.\(^8\) The Maori object to LEGO's use of Maori words and historical references\(^9\) in Bionicle,\(^10\) a hi-tech, interactive LEGO game,\(^11\) LEGO agreed to modify the game's second generation,\(^12\) yet the struggle continues as the two sides work together to draft "Guidelines for the Use of Traditional Knowledge."\(^13\) The guidelines would propose suggestions for all toy makers when incorporating indigenous cultural elements into their products. The Maori have used only the power of publicity thus far; no lawsuits have been filed.

Part III analyzes the Maori's possible legal claims against LEGO under established U.S. law and predicts the likelihood of success under trademark, copyright, and right of publicity regimes. Essen-

ARTICLE THE THIRD

In consideration thereof Her Majesty the Queen of England extends to the Natives of New Zealand Her royal protection and imparts to them all the Rights and Privileges of British Subjects.

[Signed] W Hobson Lieutenant Governor

Now therefore We the Chiefs of the Confederation of the United Tribes of New Zealand being assembled in Congress at Victoria in Waitangi and We the Separate and Independent Chiefs of New Zealand claiming authority over the Tribes and Territories which are specified after our respective names, having been made fully to understand the Provisions of the foregoing Treaty, accept and enter into the same in the full spirit and meaning thereof in witness of which we have attached our signatures or marks at the places and the dates respectively specified

Done at Waitangi this Sixth day of February in the year of Our Lord one thousand eight hundred and forty.

Id.

7. LEGO is a registered trademark.
8. Jurisdiction could be in either federal or state court, depending on how petitioners chose to pursue these actions. Federal copyright and trademark laws exist, yet right of publicity is a state action.
9. See infra text accompanying notes 206-322 (detailing a list of Maori complaints).
11. E-mail from Jette Orduna, LEGO, to Sarah La Voi, Student, DePaul University College of Law (Oct. 25, 2002, 12:09:38 CST) (on file with author). LEGO asserts that it studied a variety of cultures, not just Maori culture, to construct the Bionicle game. Id.
13. See id. "Traditional Knowledge" is analogous to cultural heritage. The Maori adopted the term traditional knowledge to refer to indigenous legends, stories, folklore, history, etc. that may be used by commercial entities to develop products. The "Guidelines for the Use of Traditional Knowledge" (Guidelines) that LEGO has pledged to draft with the Maori and other indigenous groups will not be legally binding, rather, they will comprise suggestions to manufacturers on how to preserve the integrity of traditional knowledge. The Guidelines have yet to be released and it is possible that they will never be completed as LEGO and all of the indigenous groups involved in the process struggle to agree on appropriate terms.
tially, this analysis concludes that the Maori claims would likely fail under U.S. standards, which generally do not protect facts, history, or language.\textsuperscript{14}

The dispute over the right to use indigenous cultural heritage extends far beyond this one example. Tracing the Maori/LEGO dispute sheds light on the greater question applicable in all cases of cultural heritage ownership: Can a group control the commercial use of its culture and its history? This Comment argues that, while valid claims of cultural heritage appropriation exist, the Maori, in this instance, may not lay claim to facts, language, and bits of history rightfully found in the public domain.\textsuperscript{15} Yet, this Comment also concludes that U.S. law is inadequate to safeguard cultural heritage as a whole and that lawmakers should explore alternative constructs for protection.

This Comment assumes that the Maori would instigate any legal action in the United States and that standing would not be an issue.\textsuperscript{16} This assumption allows an in-depth review of the U.S. legal regimes that could possibly protect different types of cultural heritage.

Part IV recognizes a future trend of valid cultural heritage disputes in the United States and suggests a possible compromise to resolve the debate: a legal structure of \textit{domaine public payant}.\textsuperscript{17} The progressive system of \textit{domaine public payant} permits the public to access valuable cultural heritage, yet allows for compensation to source indigenous groups. This system strikes a fair balance between access rights and rights to control the commercialization of cultural heritage.

\begin{footnotesize}
\begin{enumerate}
\item This is true unless the language was used in a unique signaling capacity. See \textit{infra} notes 23-89 and accompanying text.
\item This Comment concludes that the Maori, in this instance, would not receive intellectual property protection because their hypothetical claims are to language and history only, which rightfully belong in the public domain, free for all to use. Conversely, there could be other valid claims to cultural heritage, offered by the Maori or other indigenous groups, that current U.S. law does not protect, yet should.
\item In reality, the Maori would likely seek redress against LEGO in either New Zealand or Denmark; however, litigation in the United States is not improbable as the United States is likely one of LEGO’s prime markets. This Comment will not address the issue of standing in depth, still, it should be noted that the Maori could face a high hurdle when asserting collective rights in the United States.
\item For purposes of this Comment, consider a \textit{domaine public payant} structure as a type of middle or “gray domain” that houses cultural heritage elements that may not belong in either the private or the public domains.
\end{enumerate}
\end{footnotesize}
II. BACKGROUND: DEFINING CULTURAL HERITAGE AND THE EVOLUTION OF U.S. INTELLECTUAL PROPERTY REGIMES THAT COULD APPLY TO ITS PROTECTION

This section first explores the meaning of "cultural heritage." Next, it outlines the basic legal concepts of three U.S. intellectual property regimes: trademark, copyright, and the right of publicity. Following each outline is a series of relevant cases that could apply to cultural heritage disputes.

A. Cultural Intellectual Property v. Cultural Heritage

Indigenous groups often draw on their unique experiences, perspectives, and histories to develop stores of cultural art, music, and literature. Many indigenous and nonindigenous consumers are drawn to native style and technique. This creates a market for native-made goods; it also gives corporations the incentive to use indigenous elements in their products.18 This practice sparks questions over whether indigenous groups control the intellectual property rights to certain elements of their culture, and whether they have the right to keep such elements out of the public domain. Weighing in on the opposite side of this debate is the interest in unrestricted access to facts, history, and ideas.

The phrase "cultural intellectual property" connotes intangible ownership rights in cultural works that would likely meet the requirements of standard intellectual property laws.19 Alternatively, "cul-

18. See, e.g., Mattel, Inc., American Girl website, at http://www.americangirlstore.com/pls/ag/ag_agc_kaya?catid=375909 (last visited Nov. 15, 2003). In the United States, Native American culture has found its way into several consumer markets, including clothing, interior design, art, cinema, toys, and more. A popular Mattel line, the American Girl Series, offers a Native American doll, Kaya. Mattel describes Kaya on its website:

Kaya™ (KY-yaah) is an adventurous Nez Perce girl growing up in 1764. She's happiest when she's riding her beloved horse Steps High, playing with her tiny pup Tatlo, or sharing stories with her blind sister as they work. Kaya dreams of becoming a courageous leader for her people who is ready to meet whatever the future brings. She draws strength from her family, the legends her elders tell, and the bold warrior woman who is her hero.

Id. See also Wal-Mart's website, at http://www.walmart.com/catalog/product.gsp?product_id=882829&cat=5281&type=5&dept=4171&path=0%3A4171%3A4187%3A4177%3A5281 (last visited July 20, 2003). Wal-Mart carries another popular Mattel product that capitalizes on Native American culture, Northwest Native American Barbie. Id. The doll, which sells for $15, comes with a blue dress, white boots, and a "ceremonial blanket called a chilkat." Id.

19. An example might be an original fable recently written by a single, identifiable Native American author. Such work of cultural significance may qualify for copyright protection and, therefore, be considered "cultural intellectual property." This connotes clear intangible rights to the work under current U.S. intellectual property regimes.
tural heritage” encompasses a broader range, applying to history, language, art, traditions, oral compositions, written works, and more. Complicating any attempts to define this category is the fact that myriad elements qualify as cultural heritage. Further, cultural heritage works are often intergenerational, group efforts that do not fit neatly into trademark, copyright, or state intellectual property regimes.

A central inquiry to this discussion is the following: When does cultural heritage that is stored in the public domain cross the line to become cultural intellectual property, which enjoys exclusive ownership rights? Furthermore, when should this transformation occur; when do groups have rights to control works that simply do not meet the requirements for modern U.S. intellectual property protection? To form an opinion on this fundamental rights versus public access problem, one must understand the basic concepts of three intellectual property regimes: trademark, copyright, and the state law claim of right of publicity.

B. Trademark Law

Trademark law, unlike copyright law, has no clear constitutional authority. Therefore, Congress utilized the powers of the Commerce

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20. See Kristin Ann Mattiske, Note, Recognition of Indigenous Heritage in the Modern World: U.S. Legal Protection in Light of International Custom, 27 BROOK. J. INT'L L. 1105, 1111 (2002). While many believe that heritage and history belong to all people of the world to use and to learn from, Ms. Mattiske defines heritage as belonging to a people: “Heritage” is everything that belongs to the distinct identity of a people and which is theirs to share, if they wish, with other peoples. It includes all of those things that international law regards as the creative production of human thought and craftsmanship, such as songs, stories, scientific knowledge and artworks. It also includes inheritances from the past and from nature, such as human remains, the natural features of the landscape, and naturally occurring species of plants and animals with which a people has long been connected.

21. Indigenous works, such as folklore, often develop over time. Authors from each generation build on an old tale, keeping the core story and adding new elements. The story is like a living work, continually growing and changing.

22. Another intellectual property regime, patent law, also impacts claims to cultural heritage; however, patent law and related biopiracy issues exceed the scope of this Comment and thus will not be explored.

23. See U.S. CONST. art. I, § 8, cl. 8. This constitutional provision allows Congress to “Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” Id. This provision serves as the source for both copyright and patent protection; however, trademark law is not logically encompassed by Section 8.
Clause\textsuperscript{24} to justify trademark protection\textsuperscript{25} and adopted the Lanham Act in 1946,\textsuperscript{26} which codified a scheme of trademark protection.

Trademark law encompasses symbols, such as words, shapes, and colors,\textsuperscript{27} used in commerce that signal the source of a good.\textsuperscript{28} The Lanham Act defines a trademark as "any word, name, symbol, or device" used by a person to "identify and distinguish his or her goods... to indicate the source of the goods, even if that source is unknown."\textsuperscript{29} *Gilson on Trademark Protection and Practice* states that a trademark functions and receives legal protection because it:

(a) designates the source or origin of a particular product or service, even though the source is to the consumer anonymous; (b) denotes a particular standard of quality which is embodied in the product or service; (c) identifies a product or service and distinguishes it from the products or services of others; (d) symbolizes the good will of its owner and motivates consumers to purchase the trademarked product or service; (e) represents a substantial advertising investment and is treated as a species of property; or (f) protects the public from confusion and deception, insures that consumers are able to purchase the products and services they want, and enables the courts to fashion a standard of acceptable business conduct.\textsuperscript{30}

1. Basics of Trademark Law

To determine the degree of trademark protection received, marks are categorized according to a common-law hierarchy of descriptive-ness.\textsuperscript{31} The order is: (1) generic marks, which are never registrable; (2) descriptive marks, which are registrable upon proof of secondary meaning;\textsuperscript{32} (3) suggestive marks,\textsuperscript{33} which are registrable; and (4) arbitrary marks.

\textsuperscript{24} U.S. Const. art. I, § 8, cl. 8.
\textsuperscript{25} Rochelle Cooper Dreyfuss & Roberta Rosenthal Kwall, *Intellectual Property: Cases and Materials on Trademark, Copyright and Patent Law* 6-7 (1996) (relating that, although the Commerce Clause language denotes that it covers only trade between countries and states, now the law recognizes the power of the Commerce Clause over intrastate commerce as well).
\textsuperscript{27} Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995) (holding that a color is registrable if (1) it meets the ordinary requirements to register a trademark and (2) its use as a mark would not allow the owner to interfere with legitimate competition).
\textsuperscript{28} Service marks apply to services while trademarks refer to goods. An example of a fictional service mark would be MONEYZIP to signal a special wire transfer service offered by an investment bank.
\textsuperscript{29} 15 U.S.C. § 1127.
\textsuperscript{30} Jerome Gilson, *Gilson on Trademark Protection and Practice* § 1.03 (2002).
\textsuperscript{32} Id. at 9.
\textsuperscript{33} See Dreyfuss & Kwall, *supra* note 25, at 42-43. To be suggestive, a mark must require the consumer to use some imagination to connect it to the source of the good or service. *Id.* A common example of a suggestive mark would be SIZZLER for steakhouses.
trary or fanciful marks,\textsuperscript{34} which garner the highest trademark protection.

Trademark law turns on consumer protection; the touchstone of trademark infringement is the likelihood of consumer confusion.\textsuperscript{35} To gain registration, a mark must not be likely to confuse the public as to its source or sponsorship.\textsuperscript{36} Further, a showing of likelihood of confusion is adequate to prove trademark infringement under the Lanham Act.\textsuperscript{37} It is important to note that preclusion from registration does not necessarily prohibit an applicant from using the mark.\textsuperscript{38} Outlined below is an example in which an indigenous group successfully employed trademark law to halt the registration of a mark in the name of cultural heritage protection. The legal victory was not complete, however, because the petitioners could not bar the respondent from using the mark, and stopping the respondent from using the marks was, ultimately, what the petitioners in this case wanted.\textsuperscript{39}

2. \textit{Harjo v. Pro-Football, Inc.}\textsuperscript{40}

In \textit{Harjo}, seven Native American petitioners succeeded in their move to cancel federal registrations\textsuperscript{41} with the United States Patent and Trademark Office (USPTO) for several service marks,\textsuperscript{42} including: THE WASHINGTON REDSKINS, REDSKINS,\textsuperscript{43} and RED-

\textsuperscript{34} See id.

\textsuperscript{35} Lanham Act, 15 U.S.C. § 1114(1)(a) (2000) (barring use of a registered mark that is "likely to cause confusion").

\textsuperscript{36} See id. § 1114.

\textsuperscript{37} Lois Sportswear U.S.A. v. Levi Strauss & Co., 799 F.2d 867, 873-76 (2d Cir. 1986) (listing eight factors relevant to the likelihood of infringement inquiry: (1) strength of plaintiff's mark, (2) the degree of similarity between the marks, (3) the proximity of the products, (4) likelihood that plaintiff will bridge the gap to encompass defendant's product line, (5) evidence of actual consumer confusion, (6) whether defendant acted in good faith, (7) the quality of the respective goods, and (8) the sophistication of relevant buyers).

\textsuperscript{38} Note, however, that unfair competition laws could possibly prohibit use of a confusing mark, registered or unregistered, that usurps a senior competitor's market.

\textsuperscript{39} Generally, indigenous groups involved in disputes over cultural heritage seek first to stop the use of the cultural heritage in question. Therefore, barring trademark applicants from receiving registration is a hollow victory if those applicants are still able to employ the mark in question.

\textsuperscript{40} 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999).

\textsuperscript{41} See id. at 1705-06. Cancellation No. 21,069 to Registration Nos. 1,606,810; 1,085,092; 987,127; 986,668; 978,824; 836,122.

\textsuperscript{42} See supra note 28 and accompanying text.

\textsuperscript{43} See Harjo, 50 U.S.P.Q.2d (BNA) at 1707. THE WASHINGTON REDSKINS and REDSKINS were registered for "entertainment services—namely, presentations of professional football contests." Id.
SKINNETTES,\textsuperscript{44} which all refer to the Washington Redskins football franchise. The corporate owner of these marks, Pro-Football, Inc. (Pro-Football), vigorously challenged this action.\textsuperscript{45} Pro-Football claimed that REDSKINS had acquired a secondary meaning,\textsuperscript{46} representing the Washington football team only, not Native Americans.

The issue before the Trademark Trial and Appeal Board (TTAB) concerned only the registrability of the marks, not whether Pro-Football, or any other entity, could use the marks.\textsuperscript{47} Petitioners sought to cancel the marks under § 2(a) of the Lanham Act, which prohibits the registration of marks that are “immoral, deceptive, or scandalous,” or that “may disparage or falsely suggest a connection” with people, “institutions, beliefs, or national symbols, or bring them into contempt or disrepute.”\textsuperscript{48} The exact language of § 2(a) was key to the petitioners’ courtroom victory. The TTAB noted that the statute prohibited regis-

\begin{footnotesize}
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\item \textsuperscript{44} See Harjo, 50 U.S.P.Q.2d (BNA) at 1707. REDSKINETTES was registered for “entertainment services, namely, cheerleaders who perform dance routines at professional football games.” \textit{Id.}
\item \textsuperscript{45} Pro-Football had a strong motive to fight the cancellation of all marks related to the Washington Redskins team. Sports teams regularly strike licensing deals with manufacturers of apparel, mugs, school supplies, cereal, and more. Upon cancellation of the trademarks, Pro-Football would lose control of the marks’ use, resulting in the loss of some licensing revenues. This relates only to the REDSKINS mark and other trademarks in question. Pro-Football may still control any logos that were not deemed unregistrable by § 2(a) of the Lanham Act. Yet, overall, losing control of the team’s name probably had a negative financial impact on the team.
\item \textsuperscript{46} See Dreyfuss & Kwall, supra note 25, at 44. A mark acquires secondary meaning when the service or good it signifies becomes the primary meaning in the mind of the consumer. \textit{Id.} For example, a person’s or character’s name is a descriptive term that describes that specific person or character. Yet a name could acquire secondary meaning. Harry Potter is the name of the lead character in the wildly popular children’s book series by J.K. Rowling. Time Warner, Inc. (Time Warner) owns the HARRY POTTER trademark. If another entity were to employ the name HARRY POTTER to identify a boy wizard in a television series, Time Warner could institute a Lanham Act trademark infringement claim. The opponent would likely argue that a name is merely descriptive and unworthy of protection. Time Warner could counter by claiming that HARRY POTTER had acquired secondary meaning in the public mind because HARRY POTTER had become synonymous with the young wizard found in J.K. Rowling’s books. Market saturation of the book had resulted in the boy wizard transforming into the primary definition of HARRY POTTER. This acquisition of secondary meaning converts a merely descriptive mark into protectable intellectual property.
\item \textsuperscript{47} Harjo, 50 U.S.P.Q.2d (BNA) at 1740.
\item \textsuperscript{48} Lanham Act, 15 U.S.C. § 1052(a) (2000). The relevant portions of § 2 of the Lanham Act provide:
\begin{itemize}
\item No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
\item (a) Consists of or compromises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute
\end{itemize}
\textit{Id.}
\end{itemize}
\end{footnotesize}
tration of marks that are immoral, deceptive, or scandalous; however, lowering the threshold, it barred all marks that may disparage people or bring them into disrepute.49 Ultimately, the TTAB held that all of Pro-Football's registrations may disparage Native Americans, which justified cancellation.50 The TTAB did not, however, officially label the marks immoral, deceptive, or scandalous.51

To reach this partial pro-cultural heritage protection conclusion, the TTAB heard testimony from the petitioners' and respondent's experts in the fields of history, linguistics, and social science.52 Generally, the petitioners demonstrated that the term "Redskins" in any form was deeply offensive to Native Americans53 and was so at the time of registration in the 1960s.54 Pro-Football responded with expert testimony that "Redskins" was an innocuous term akin to "Native American" or "American Indian."55 The TTAB found the petitioners' evidence more convincing and canceled the respondent's marks; however, note that the Washington Redskins football team still exists today, despite its trademark cancellation. Use was not at issue; only the registrability of REDSKINS as a protectable mark was before the TTAB. Further, petitioners gained no rights to the marks themselves.

3. **Hornell Brewing Co. v. Rosebud Sioux Tribal Court**56

Not all marks canceled under § 2(a) survive in the marketplace, as did REDSKINS. The Lakota Sioux succeeded in a cancellation petition against the Hornell Brewing Company, which placed renowned Native American Crazy Horse's image on a malt liquor product.57 The Lakota Sioux also pursued action in a tribal court58 to enjoin Hornell's production of Crazy Horse Malt Liquor.59 The petitioners

49. Harjo, 50 U.S.P.Q.2d (BNA) at 1748.
50. Id. at 1749.
51. Id.
52. Id. at 1723-34.
53. Id. at 1720. Petitioners argued that the term "Redskins" reflected a patronizing, demeaning attitude towards Native Americans, which promulgated views of Native Americans as "simple 'savages' whose culture was treated mainly as a source of amusement for white culture." Id.
54. Harjo, 50 U.S.P.Q.2d (BNA) at 1719. In a § 2(a) cancellation action, the Board considers the status of the marks from the time of registration to the present. Id. at 1735.
55. Id. at 1720.
56. 133 F.3d 1087 (8th Cir. 1998).
59. Hornell Brewing Co. v. Rosebud Sioux Tribal Court, 133 F.3d 1087 (8th Cir. 1998).
claimed that Hornell's use of Crazy Horse's name and image resulted in defamation, a violation of Crazy Horse's estate's right of publicity, negligent and intentional infliction of emotional distress, violation of the Indian Arts and Crafts Act, and trademark violations.


Id. at 715.

61. See Indian Arts and Crafts Act, 25 U.S.C. § 305a-305e (1990). The language of the Indian Arts and Crafts Act refers to intellectual property as well as real property. This Act may be a useful tool for some groups in their fight to protect cultural heritage; however, the Indian Arts and Crafts Act would not benefit the Maori. The relevant section of the Indian Arts and Crafts Act reads:

§ 305a. Promotion of economic welfare through development of arts and crafts; powers of Board

It shall be the function and the duty of the Secretary of the Interior through the Board to promote the economic welfare of the Indian tribes and the Indian individuals through the development of Indian arts and crafts and the expansion of the market for the products of Indian art and craftsmanship. In the execution of this function the Board shall have the following powers: (a) To undertake market research to determine the best opportunity for the sale of various products; (b) to engage in technical research and give technical advice and assistance; (c) to engage in experimentation directly or through selected agencies; (d) to correlate and encourage the activities of the various governmental and private agencies in the field; (e) to offer assistance in the management of operating groups for the furtherance of specific projects; (f) to make recommendations to appropriate agencies for loans in furtherance of the production and sale of Indian products; (g)(1) to create for the Board, or for an individual Indian or Indian tribe or Indian arts and crafts organization, trademarks of genuineness and quality for Indian products and the products of an individual Indian or particular Indian tribe or Indian arts and crafts organization; (2) to establish standards and regulations for the use of Government-owned trademarks by corporations, associations, or individuals, and to charge for such use under such licenses; (3) to register any such trademark owned by the Government in the United States Patent and Trademark Office without charge and assign it and the goodwill associated with it to an individual Indian or Indian tribe without charge; and (4) to pursue or defend in the courts any appeal or proceeding with respect to any final determination of that office; (h) to employ executive officers, including a general manager, and such other permanent and temporary personnel as may be found necessary, and prescribe the authorities, duties, responsibilities, and tenure and fix the compensation of such officers and other employees: Provided, That the Classification Act of 1923, as amended, shall be applicable to all permanent employees [except executive officers,] and that all employees [other than executive officers] shall be appointed in accordance with the civil-service laws from lists of eligibles to be supplied by the Civil Service Commission; (i) as a Government agency to negotiate and execute in its own name contracts with operating groups to supply management, personnel, and supervision at cost, and to negotiate and execute in its own name such other contracts and to carry on such other business as may be necessary.
under the Lanham Act.\textsuperscript{62} The tribal court found for the Lakota Sioux.\textsuperscript{63} On appeal, the United States Court of Appeals for the Eighth Circuit dismissed this action, claiming that the tribal court had no jurisdiction over this matter.\textsuperscript{64} The court, however, did not criticize the tribal court's ruling on the merits.\textsuperscript{65}

Despite this favorable ruling, Stroh Brewing Company, owner of G. Heileman Brewing Company and a defendant in the Crazy Horse Malt Liquor case, chose to settle with the Estate of Crazy Horse and the Rosebud Sioux Tribe.\textsuperscript{66} The settlement agreement provided for "a public apology and acknowledgment of the Estate's right to protect the name of Crazy Horse, and for delivery of culturally appropriate damages—seven race horses and thirty-two Pendleton blankets, braids of tobacco and sweet grass."\textsuperscript{67}

A press release from the Estate of T'sunke Witko\textsuperscript{68} claims the Stroh's settlement was a landmark event in the movement to protect cultural heritage:

This is a historic victory in the battle to protect the name of Crazy Horse and the cultural property of all tribes. This settlement recognizes the important role of Tribal Customary Law in protecting indigenous Intellectual Property and sends a strong message that people cannot just take Indian Cultural Property and use it without permission.\textsuperscript{69}

Crazy Horse Malt Liquor has since disappeared from the market.

Native Americans claim the above two cases as successes in the struggle for the protection of native cultural heritage. In reality, however, the two cases discussed above represent mixed victories. In Harjo, petitioners succeeded in halting registration only, not use. Hornell culminated with cessation of use and a public apology, however, this action was not legally mandated. Stroh chose to concede.\textsuperscript{70}

\textbf{Footnotes:}

\begin{itemize}
  \item[62.] Rosebud Sioux Tribal Court, 133 F.3d at 1087.
  \item[63.] See id. at 1093.
  \item[64.] See id.
  \item[65.] Id.
  \item[66.] Estate of T'sunke Witko, supra note 1.
  \item[67.] Id. The date set for delivery of these items was April 26, 2001. Id.
  \item[68.] Id. T'sunke Witko is the Sioux name for Crazy Horse. See Crazy Horse defense website, at http://www.crazyhorsedefense.org (last visited Nov. 15, 2003).
  \item[69.] Estate of T'sunke Witko, supra note 1.
  \item[70.] See supra text accompanying note 63.
\end{itemize}
Again, in neither case did indigenous petitioners gain cultural intellectual property rights to the marks.

Both Harjo and Hornell dealt with clearly offensive use of Native American symbolism. Many disputes over commercial use of cultural heritage are not so clear, including the Maori/LEGO issue to be analyzed in Part III of this Comment. Listed below are general U.S. trademark decisions that could hinder a group's fight for control of items it has identified as indigenous cultural heritage.

4. Mohegan Tribe of Indians of Connecticut v. Mohegan Tribe and Nation, Inc.72

In this Lanham Act litigation, a federally recognized Native American tribe challenged another group of similar ancestry for rights to the MOHEGAN and MOHEGAN TRIBE marks.73 The plaintiffs claimed that the defendant nation's use of these marks harmed the Mohegan people and injured the plaintiff as well.74 Plaintiff owned and operated the Mohegan Sun Casino and related facilities while the defendant traded only in arts and crafts.75 To receive protection under the Lanham Act, one must (1) possess a valid, protectable trademark and (2) establish that the defendant's use of the mark is likely to cause confusion as to the origin of the goods at issue.76 The Supreme Court of Connecticut held that the plaintiffs failed to establish these requirements; Mohegan was a generic term, ineligible for Lanham Act protection and the plaintiff did not establish a likelihood of confusion.77

The court also noted that this trademark dispute was unique: "On appeal, the parties have failed to identify any case under the Lanham Act, and we have found none, in which the word or term for which

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71. See Estate of T'sunke Witko, supra note 1. It is safe to say that many, even if not a majority, of Americans could agree that the term "Redskins" is pejorative and that labeling a malt liquor with Crazy Horse's image would offend Native Americans. The press release quotes one outraged tribal member:

"They have taken his name and slapped it on a cheap beer for a quick buck," said Seth H. Big Crow, Sr., administrator for the Estate of T'Sunke Witko, a.k.a. Crazy Horse, who hailed the long awaited decision as a major victory in the protection of cultural rights. "Crazy Horse fought and died protecting Indian people from things like alcohol. His spirit and reputation deserve greater respect," said Big Crow from his home on the Rosebud Reservation in South Dakota.

Id.

72. 769 A.2d 34 (Conn. 2001).
73. Id. at 34.
74. Id.
75. Id. at 36.
76. Lane Capital Mgmt., Inc. v. Lane Capital Mgmt, Inc., 192 F.3d 337, 344 (2d Cir. 1999).
77. Mohegan Tribe of Indians of Conn., 769 A.2d at 48.
trademark protection was sought is, as in this case, a term used by a defendant to identify its nationality, ethnicity or ancestry." This case sets a precedent that tribal names are generic, which narrows the availability for trademark protection in similar cultural heritage disputes.

The following cases do not have indigenous plaintiffs. Instead, they deal with marks that revolve around nationality and foreign language words. These cases could be helpful while reviewing the hypothetical legal actions arising from the Maori/LEGO dispute.

5. Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.\(^7\)\(^9\)

This case dealt with genericness under the Lanham Act. In this dispute, a telephone directory distributor claimed that a competitor's use of the mark FILIPINO YELLOW PAGES infringed his trademarks for a line of local and international Filipino telephone directories.\(^8\)\(^0\)

The United States Court of Appeals for the Ninth Circuit rejected the plaintiff's claim and held that FILIPINO YELLOW PAGES was generic, or at best merely descriptive,\(^8\)\(^1\) and not worthy of trademark protection.\(^8\)\(^2\)

6. Otokoyama Co., v. Wine of Japan Import, Inc.\(^8\)\(^3\)

In this trademark dispute, both the plaintiff and the defendant imported Japanese sake\(^8\)\(^4\) for distribution in the United States under similar trademarks.\(^8\)\(^5\) The plaintiff sold sake under the OTOKOYAMA brand since 1984 and held four registered trademarks incorporating that mark.\(^8\)\(^6\) The defendant entered the U.S. market in 1997 with its "Mutsu Otokoyama."\(^8\)\(^7\)

The defendant contended that the plaintiff's OTOKOYAMA mark translated to "sake" in Japanese, the generic name for this fermented rice wine.\(^8\)\(^8\) The United States Court of Appeals for the Second Circuit vacated the preliminary injunction granted by the lower court and held the defendant's evidence of genericness, even of a foreign word,

\(^7\) Id. at 42 n.20.
\(^9\) 198 F.3d 1143 (9th Cir. 1999).
\(^8\) Id. at 1145.
\(^1\) Id. at 1151.
\(^2\) Id.
\(^3\) 175 F.3d 266 (2d Cir. 1999).
\(^4\) Sake is a type of strong Japanese rice wine. Id. at 268.
\(^5\) Otokoyama Co., 175 F.3d at 268.
\(^6\) Id.
\(^7\) Id.
\(^8\) Id.
cast serious doubt on the plaintiff’s trademark rights to OTOKOYAMA.\textsuperscript{89}

As these cases demonstrate, current trademark jurisprudence provides no clear path in determining cultural heritage rights. When cultural heritage is appropriated egregiously, trademark law may be able to bar registration or even use in rare situations. Other types of claims, including the hypothetical Maori claims, struggle to find full protection under U.S. trademark laws.

C. Copyright Law

Copyright law has clear roots in the United States Constitution Article I, Section 8, Clause 8. This clause allows Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”\textsuperscript{90} Congress codified these protections in the Copyright Act of 1976 (Copyright Act),\textsuperscript{91} ensuring authors finite control over their works. The fundamentals of copyright law consist of three requirements; protected works must be: (1) original; (2) works of authorship; and (3) fixed in a tangible medium of expression.\textsuperscript{92}

Even though the Copyright Act attempts to define clearly the requirements for protection, the parameters are often ambiguous. For

\textsuperscript{89} See id. at 273. The court only vacated the preliminary injunction; it did not officially hold that plaintiff’s trademark was generic. Id.

\textsuperscript{90} See infra note 91 and accompanying text.

\textsuperscript{91} See Copyright Act, 17 U.S.C. § 102 (1978). The Copyright Act defines subject matter in § 102, which provides:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphic, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.

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

\textsuperscript{92} See id. § 102.
example, the three basic requirements of originality, authorship, and fixation conflict fundamentally with products of cultural heritage.

1. Originality and Authorship

The first two requirements for copyright protection are tied closely together. Section 101 of the Copyright Act does not define “original” or “author” explicitly. However, review of case law reveals that complete novelty is not required to meet the originality requirement for copyrighted works.93 Originality exists in “substantial and sufficient degree, in the conception, organization and presentation of material whether new or old. As to what is old, only the common source, not the copyrighted work, except as to fair use, may be resorted to by all, for only the old lies in the public domain.”94

A landmark United States Supreme Court case, Feist Publications, Inc. v. Rural Telephone Services Co., further defines “original.”95 In copyright law, “original” requires that the work was created independently by an author, not copied from other works, and that it possess “at least some minimal degree of creativity.”96 Work may be original even though it closely resembles other works, so long as “similarity is fortuitous, not the result of copying.”97 This definition reinforces the concept that novelty is not requisite to originality.

The concept of “author” may seem clear; however, the term has given rise to confusion. In 1884, the Supreme Court attempted to define authorship in Burrow-Giles Lithographic Co. v. Sarony.98 It concluded that “author,” in a constitutional sense, meant “he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.”99

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94. Id. at 224.
95. Feist Pub’l’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) (reversing a judgment in favor of respondent because the selection, coordination, and arrangement of respondent’s white pages telephone book contained only uncopyrightable facts, which did not satisfy the minimum constitutional requirements for copyright protection; the arrangement was not sufficiently original).
96. See id. at 345.
97. Id.
98. 111 U.S. 53, 58 (1884).
99. Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884) (upholding a finding of infringement against defendant lithographic company regarding a photograph of Oscar Wilde, by which authorship rights could be conferred). The Court noted:

These findings, we think, show this photograph to be an original work of art, the product of plaintiff’s intellectual invention, of which plaintiff is the author, and of a class of inventions for which the Constitution intended that Congress should secure to him the exclusive right to use, publish and sell . . . .

Id. at 60.
Recent case law builds on this nineteenth century definition to clarify and expand the concept of authorship. In *Lindsay v. Titanic*, the United States District Court for the Southern District of New York granted authorship status to a documentary producer even though he did not physically procure the photos and footage used in the film.

The plaintiff and the defendant had agreed to coproduce a documentary detailing underwater explorations of the sunken *Titanic* yet the defendant backed out of the plan. In litigation, the defendant claimed that the plaintiff could not be considered an author under the Copyright Act because he did not dive to the ship and actually take the photographs. The court rejected that argument and held:

> [W]here a plaintiff alleges that he exercised such a high degree of control over a film operation—including the type and amount of lighting used, the specific camera angles to be employed, and other detail-intensive artistic elements of a film—such that the final product duplicates his conceptions and visions of what the film should look like, the plaintiff may be said to be an “author” within the meaning of the Copyright Act.

This holding reinterprets the authorship requirements of the Copyright Act that the author of a work is the person “who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression . . . .” The court viewed authorship requirements in

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100. 52 U.S.P.Q.2d (BNA) 1609 (S.D.N.Y. 1999).
101. See id. at 1612-13.
102. The *Titanic* was a luxury cruise liner billed as “unsinkable.” Tragically, the *Titanic* struck an iceberg on its maiden voyage to New York in 1912, killing several passengers. The infamous *Titanic* tragedy has inspired several films, books, songs, plays, poems, and more. Id. at 1611.
103. Id.
104. See id. at 1613. The defendant and his crew were part of a professional salvage crew. The plaintiff was not a direct part of the salvage and exploration effort; instead, he was a creative director and contributor. The court said the following about the plaintiff’s role:

> The fact that Lindsay did not literally perform the filming, i.e. by diving to the wreck and operating the cameras, will not defeat his claims of having “authored” the illuminated footage. The plaintiff alleges that as part of his pre-production efforts, he created so-called "storyboards," a series of drawings which incorporated images of the Titanic by identifying specific camera angles and shooting sequences. During the expedition itself, Lindsay claims to have been “the director, producer and cinematographer” of the underwater footage. As part of this role, Lindsay alleges that he directed daily planning sessions with the film crew to provide them with “detailed instructions for positioning and utilizing the light towers.” Moreover, the plaintiff actually “directed the filming” of the Titanic from on board the Ocean Voyager, the salvage vessel that held the crew and equipment. Finally, Lindsay screened the footage at the end of each day to “confirm that he had obtained the images he wanted.”

Id.
106. Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737 (1989) (citing 17 U.S.C. § 102 (1978)) (holding that a sculpture was not a work-made-for-hire because the artist retained control and independence over the project and therefore held the copyright to the piece).
the context of film footage and photography to expand the definition.\textsuperscript{107} This holding demonstrates that courts are willing to mold copyright definitions to fit changing needs, which could certainly impact cultural heritage litigation.

2. \textit{Joint Authorship}

In the cultural heritage context, works are often intergenerational, the product of several authors over a series of decades, even centuries,\textsuperscript{108} which conflicts with the defined notions of originality and authorship. The traditional notion of authorship is singular;\textsuperscript{109} yet courts have established a history of accepting joint authorship in certain cases. The Copyright Act defines joint authorship as a work “prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”\textsuperscript{110} The key to joint authorship is joint labor; to share a copyright all authors must intend to be joint authors and intend the final

\begin{enumerate}
\item\textsuperscript{107} Reid, the author of a three-dimensional sculpture depicting homelessness won authorship rights while the Community for Creative Non-Violence received property rights in the physical sculpture itself. \textit{Id.} at 753. It is important to note the Court entertained the idea that the Community for Creative Non-Violence may be a joint-author due to its significant contributions. \textit{Id.}
\item\textsuperscript{108} Lindsay, 52 U.S.P.Q.2d at 1609. The court performed a concise, comprehensive review of the evolution of the definition of authorship:
\begin{quote}
For over 100 years, the Supreme Court has recognized that photographs may receive copyright protection in “so far as they are representatives of original intellectual conceptions of the author.” Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58, 28 L. Ed. 349, 4 S. Ct. 279 (1884). An individual claiming to be an author for copyright purposes must show “the existence of those facts of originality, of intellectual production, of thought, and conception.” Feist Publications, Inc. v. Rural Telephone Service Company, Inc., 499 U.S. 340, 346-347, 113 L. Ed. 2d 358, 111 S. Ct. 1282 (1991) (citing Burrow-Giles, 111 U.S. at 59-60). Some elements of originality in a photograph include “posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any variant involved.” Rogers v. Koons, 960 F.2d 301, 307 (2d Cir.), cert. denied, 506 U.S. 934, 121 L. Ed. 2d 278, 113 S. Ct. 365 (1992). Taken as true, the plaintiff’s allegations meet this standard. Lindsay’s alleged storyboards and the specific directions he provided to the film crew regarding the use of the lightowers and the angles from which to shoot the wreck all indicate that the final footage would indeed be the product of Lindsay’s “original intellectual conceptions.”
\end{quote}
\item\textsuperscript{109} \textit{Id.}
\item\textsuperscript{108} E-mail from Maui Solomon, Maori Attorney, to Sarah La Voi, Student, DePaul University College of Law (Nov. 11, 2002, 10:59:13 CST) (on file with author). Mr. Solomon points out that the Intellectual Property system is inadequate to protect “traditional knowledge in the public domain” because it protects only private property rights and not “collective/intergenerational rights and obligations.” \textit{Id.}
\item\textsuperscript{109} \textit{See generally} Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884).
\item\textsuperscript{110} Copyright Act, 17 U.S.C. § 101 (1978).
\end{enumerate}
product to be an inseparable melting pot of joint expression.\footnote{111} However, joint authors need not work together in concert; they need only have the intention to create a joint work at the outset.\footnote{112} The availability of non-linear joint authorship could pertain to cultural heritage such as folklore or native songs passed from generation to generation.

3. Indigenous Oral Cultures

Further, concepts of originality and authorship do not conform to indigenous oral cultures. An example of an oral culture is ancient India, where history and tradition was viewed in a collective sense of "peoples" rather than "individuals."\footnote{113} In ancient India’s oral culture, the people placed more weight on “what was said” as opposed to “who said what.”\footnote{114} Bali exemplifies a more recent oral culture, where the personal possession of artistic property was a foreign concept.\footnote{115} Balinese people subscribed to the belief that the production of culture was a collective, anonymous effort that could not be held by one particular class.\footnote{116}

4. Fixation

The third requirement for copyright protection, fixation, also fails to conform to elements of cultural heritage, especially oral cultures. Unlike the first two requirements, the Copyright Act does define fixation:\footnote{117}

A work is “fixed” in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is “fixed” for purposes of this

\footnotesize{111. \textit{Melville B. Nimmer \\ \\ & David Nimmer}, \textit{Nimmer on Copyright Law} § 6.03 (2003).}
\footnotesize{Without such a preconcerted common design the resulting combination should not be regarded as a joint work. This does not mean, however, that the several authors must necessarily work in physical propinquity, or in concert, nor that the respective contributions made by each joint author must be equal either in quantity or quality. Neither is an express “collaboration agreement” necessary to create a joint-author relationship. \textit{Id.} at 6-7.}
\footnotesize{112. \textit{See id}. Indeed, joint authors, given that they each had the clear intent at the outset to be joint authors, need not even know one another personally nor do their contributions need to be simultaneous. \textit{Id.} at 6-7.}
\footnotesize{114. \textit{Id.} at 12.}
\footnotesize{115. \textit{Id.} at 13.}
\footnotesize{116. \textit{Id.}}
As noted above, indigenous cultures often rely on oral traditions and works. Consequently, this fixation requirement is nearly impossible to meet. Stories and songs are often never transferred to paper, yet exist only in the mind of the storyteller. Therefore, "fixation" in the teller's mind, or even in the listeners' minds, falls short of U.S. copyright requirements because no "tangible medium of expression" results.

Having established the basic framework for U.S. copyright protection and its conflicts with cultural heritage, this section now examines copyright case law with potential to shape future holdings in cultural heritage litigation.

5. Fendler v. Morosco

In 1930, the Court of Appeals of New York reiterated the theme "ideas . . . are as free as air." In Fendler v. Morosco, an author and producer sought review of a trial court decision, which granted an injunction and more than $780,000 to plaintiff playwright. The plaintiff wrote In Hawaii, a play that told the story of a young American doctor who traveled to Hawaii, discovered the germ of leprosy, and fell in love with a beautiful, proud Hawaiian princess. In the defendant author's play, Bird of Paradise, a young American college graduate went to Hawaii to work among the lepers of Molokai, where he fell in love with the daughter of a Hawaiian priest. Both plays included elements of native Hawaiian culture, including customs, hula dances, songs, myths, and religion.

The court held that the defendants, even if they did have access to the plaintiff's script, did not copy material elements. Despite the similarity of the plays, they differed substantially; the overall themes

118. Id. § 101.
119. BETTIG, supra note 113, at 13-14 (noting that Medieval Europe was also a primarily oral culture where the medieval listener respected the actual form of the communication over authorship).
120. 171 N.E. 56 (N.Y. 1930).
121. Id. at 58.
122. Id. at 56.
123. Id. at 59.
124. Id.
125. Id.
126. Fendler, 171 N.E. at 60. (“The literary larcenist must do more than filch ideas, imitate mannerisms, repeat information, borrow phrases, utilize quotations; you must be able to attribute to him the felonious intention of appropriating without independent labour a material part of a protected work.”).
of an American traveling to Hawaii to study leprosy and finding love are simply ideas. Ideas are not copyrightable; therefore, the court reversed the judgment and dismissed the complaint.

6. Malkin v. Dubinsky

Thirty years after the Hawaiian theme dispute, another playwright petitioned a New York court to protect the copyright in his play. This author also lost.

Malkin wrote, but had not yet published, a play entitled The Battle Goes On, a melodrama that portrayed a strike in the textile industry and highlighted the personal life of Harry Silverstein, one of the workers. Harry led the strike, but his son opposed it and worked against his father. Harry’s daughter sympathized with the strikers and was in love with the boss’s son. At the close of The Battle Goes On, Harry was fatally shot.

The plaintiff contended that he sent the play to the defendant union to solicit production, but the union representatives turned down the manuscript and, instead, produced their own similar play, With These Hands. The defendants’ play incorporated themes used in the plaintiff’s work, such as strikes, pickets, bad blood between the union and employers, and family money troubles.

After noting substantial differences between the two plays, the New York Supreme Court went on to reiterate that any similar borrowed ideas from the plaintiff’s play were not original and, therefore, not worthy of copyright protection. Citing to Fendler, this court stated:

127. Id.
128. Id. at 58 (citing Augustine Birrell, Seven Lectures on the Law and History of Copyright in Books 167 (1899)). "Ideas... are as free as air. If you happen to have any, you fling them into the common stock, and ought to be well content to see your poorer brethren thriving upon them." Id.
129. Fendler, 171 N.E. at 61.
131. See id.
132. Id. at 511.
133. Id. at 503.
134. Id.
135. Id.
136. Malkin, 203 N.Y.S.2d at 504.
137. Id.
138. Id.
139. Id. at 506 (citing Becker v. Loew’s, Inc., 133 F.2d 889, 891 (7th Cir. 1943)). "A copyright extends only to the arrangement of the words. A copyright does not give a monopoly in any incident in a play. Other authors have a right to exploit the facts, experiences, fields of thought, and general ideas, provided they do not substantially copy a concrete form..." Id.
140. Id.
"Plots and incidents taken out of the public domain are not susceptible of copyright and are not protectable." Consequently, the court awarded judgment in favor of the defendants and dismissed the plaintiff's complaint on the merits.

7. Gilliam v. ABC, Inc.

In 1976, the authors of the popular Monty Python's Flying Circus television series sought copyright protection in the New York courts when American Broadcasting Company (ABC) edited the programs for rebroadcast in the United States. The plaintiffs, the Monty Python author/performer group, created the series for broadcast by the British Broadcasting Corporation (BBC) and retained strict creative controls.

ABC licensed three ninety-minute Monty Python episodes from BBC in 1973 and planned to broadcast them "back-to-back." To make room for commercials, ABC edited out approximately twenty-four minutes of each ninety-minute episode; ABC also omitted content because the original programs contained "offensive or obscene matter."

The United States Court of Appeals for the Second Circuit barred the broadcast, granting the plaintiffs a preliminary injunction on the theory that the defendant's severe edits were a mutilation of the plaintiffs' copyrighted work that constituted copyright infringement.

141. Malkin, 203 N.Y.S.2d at 506. The court went on to say it would be "ridiculous" to state that President Franklin D. Roosevelt's election would be subject to copyright simply by "incorporating that event into a play." Id.

142. Id. at 510-11. The court stated:

After reading the play, viewing the motion picture, examining the alleged similarities, appraising and evaluating all the evidence, and in the light of all of the surrounding circumstances, I am satisfied that there is no warrant for this litigation. I find and conclude from the credible evidence and the inferences logically flowing therefrom, that the critical changes and appendage in plaintiff's manuscript were not written in 1947, but after the summer of 1950. I also find and conclude that there is no satisfactory showing of access to plaintiff's manuscript by defendants. I further find and conclude that there has been no appropriation by defendants of plaintiff's property, and that the few similarities that exist are both trivial and insignificant or in the public domain.

Consequently, judgment is awarded in favor of the defendants, dismissing the complaint on the merits.

143. 538 F.2d 14 (2d Cir. 1976).
144. Id. at 14.
145. Id. Monty Python wanted to ensure that the final production comported with their original vision and was not tainted by interference. Id.
146. Id. at 18.
147. Id.
148. Gilliam, 538 F.2d at 21. The court explained:
When considered in a cultural heritage context, this case law could provide protection for copyrighted stories that are reworked and retold in a commercial setting. Altering the cultural heritage work to suit commercial tastes could mislead the public into believing the source indigenous group sponsored the new, edited final form, when in fact the group may object to the changes.

8. *Hogan v. DC Comics*\(^{150}\)

In 1999, the plaintiff comic book authors claimed that the defendant's painted novel infringed their work.\(^{151}\) Again, the New York District Court held that the ideas used in both works were rightfully found in the public domain and that no one author could gain exclusive control over them.\(^{152}\)

The plaintiff's futuristic work, *Matchsticks*, was an episodical, violent comic book with gothic themes that centered on a half-vampire, half-human character named Nicholas Gaunt.\(^{153}\) The story incorporated the themes of (1) seeking out one's identity and past and (2) facing the internal conflict between good and evil.\(^{154}\)

The plaintiff, a graphic novelist, claimed that the defendant had access to his work because he sent samples to DC Comics while pursuing publication and work as an "inker."\(^{155}\) DC Comics later released a book entitled *Dhampire* that also featured a half-vampire, half-human named Nicholas Gaunt.\(^{156}\) The two works had several similarities: both were gothic and macabre; both used religious symbolism and bib-

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\(^{149}\) See *id.* at 26. The plaintiffs also brought a trademark infringement action under the Lanham Act. *Id.*


\(^{151}\) *Id.* at 299.

\(^{152}\) *Id.* at 310.

\(^{153}\) *Id.* at 300.

\(^{154}\) *Id.*

\(^{155}\) *Id.* at 305. The defendant asserted that he had no recollection of this encounter with the plaintiff or of reviewing the plaintiff's work, *Matchsticks*. *Hogan*, 48 F. Supp. 2d at 306.

\(^{156}\) *Id.* at 310.
lical allusions; both characters were involved in new romances; both characters sought the truth of their past; and both characters killed.\footnote{157} Despite the similarities, the court held that these mirror elements were merely "unprotectable ideas" and "\textit{scenes a faire}"\footnote{158} and, consequently, granted the defendant summary judgment.\footnote{159}

This final case would also likely hinder an indigenous group's quest for copyright protection of its ancient legends and stories, many of which incorporate the traditional struggles between good and evil. However, indigenous groups suing in the United States may have a final intellectual property route. They could attempt to use state law claims, such as right of publicity, to protect the persona of current or deceased tribal members.

\textbf{D. Right of Publicity}

Beyond federal trademark and copyright laws lies a legal regime that may apply to disputes over the ownership of cultural heritage—right of publicity. Unlike trademark and copyright law, the right of publicity is not necessarily an intellectual property right. Instead, it is defined as a "commercial tort which protects against the (mis)appropriation of the commercial value of another's identity."\footnote{160} Thus, right of publicity laws protect one's right to exploit his or her own public image commercially by barring others from doing so.

Right of publicity protection is a rapidly evolving common law right derived from the right to privacy and unfair competition laws.\footnote{161} Because the right of publicity is a descendent of right to privacy laws, it has inherited the confusing history attached to the development of privacy rights.\footnote{162} Scope of protection varies from state to state, according to individual statutes.

\footnote{157} Id.
\footnote{158} Copyright Law: A Practitioner's Guide § 2:2.2 (Practicing Law Inst. ed., 2001). Copyright protects expression, not ideas. This dichotomy between idea and expression is central to the understanding of copyright law. It ensures that only the author's concrete contributions will be protected. The raw pool of material from which to draw will not be depleted. \textit{Scenes a faire} are standard themes found in theatrical works and literature and belong to this pool of ideas free for all to use. Basic examples of \textit{scenes a faire} include star-crossed lovers, unrequited love, the battle between good and evil, and a struggle to find one's real identity. More specific plot lines also qualify as \textit{scenes a faire}. Examples include friendly aliens (the film \textit{E.T.}), the theft of nuclear weapons from a dilapidated Russian arsenal, the tale of a woman rejecting a man's dominance, and the stock character of a sleazy music producer.
\footnote{159} Gilliam v. ABC, Inc., 538 F.2d 14 (2d Cir. 1976).
\footnote{160} \textsc{Julius C. S. Pinckaers, From Privacy Toward A New Intellectual Property Right in Persona} 14-15 (1996).

\footnote{161} See Gilson, supra note 30, § 1.03.
\footnote{162} Id.
The right of publicity protects people's investment in the development of their personas, allowing them to exclude others from the use of their name, likeness, and other recognizable attributes in commercial contexts.\textsuperscript{163} Usually, the right of publicity vests with celebrities; however, anyone who attains fame or prominence through advertising or news coverage may enjoy the right of publicity.\textsuperscript{164} Upon the death of one who enjoys right of publicity protection, that right could pass on to his or her estate.\textsuperscript{165}

According to one intellectual property expert, the right of publicity is akin to trademark laws because both depend "to a great degree on public recognition, perception, and association."\textsuperscript{166} Both trademarks and rights of publicity warrant similar remedies as well, giving rise to injunctive relief and possible compensatory damages upon violation.\textsuperscript{167}

Below is a framework of right of publicity cases that sets the stage for actions by both private individuals and public figures. This line of cases establishes law that could work for either side in a cultural heritage dispute. The first two cases could assist groups seeking right of publicity protection for cultural heritage and the final two cases may work against indigenous groups.\textsuperscript{168}

1. **Haelan Laboratories v. Topps Chewing Gum**\textsuperscript{169}

In *Haelan Laboratories v. Topps Chewing Gum*, the United States Court of Appeals for the Second Circuit recognized that the right of publicity does not only pertain to privacy; it ties to one's financial interest in the control of his persona.\textsuperscript{170} The plaintiff contracted with famous baseball players to use their likenesses to promote sales of its chewing gum.\textsuperscript{171} The ball players agreed not to enter into any similar agreements with advertisers; later, however, the defendant induced the ball players' permission to use their photographs to sell Topps' competing brand of chewing gum.\textsuperscript{172} As its defense, Topps applied the traditional theory that only players, not the plaintiff, had standing
to sue because the baseball players' privacy rights were personal, and could not be assigned to someone else.\footnote{173
}{See id. at 867. The defendant argued that plaintiffs' claim had no merit: The contract with plaintiff was no more than a release by the ball-player to plaintiff of the liability which, absent the release, plaintiff would have incurred in using the ball-player's photograph, because such a use, without his consent, would be an invasion of his right of privacy under Section 50 and Section 51 of the New York Civil Rights Law; this statutory right of privacy is personal, not assignable; therefore, plaintiff's contract vested in plaintiff no 'property' right or other legal interest which defendant's conduct invaded.
}{Id. The court rejected this contention. Id.
}{174
}{Haelan Laboratories, 202 F.2d at 868. The court stated: “We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture.” Id.
}{Id.
}{175
}{See also Pinckaers, supra note 160, at 14. “The Second Circuit Court of Appeals recognized the ‘right of publicity’ which not only consisted of the (negative) right to prohibit unauthorized commercial use of identity, but also of the (positive) right to grant exclusive rights to third parties to exploit the licensor’s identity.” Id. (emphasis in original).
}{Id.
}{176
}{177
}{Id. at 563.
}{178
}{Id.
}{179
}{See id. at 564.
}{180
}{Id. The Commentary actually urged viewers to see the show in person, but this did not bolster respondent's case.
}{Id.
After winding its way through the Ohio court system, Zacchini landed in the Supreme Court. After weighing the First Amendment right to free speech of the media against a performer’s "commercial stake in his act," the Court held that neither the First Amendment nor the Fourteenth Amendment to the United States Constitution grants the media privilege to appropriate a performer’s entire act, damaging his commercial interests. The Court clarified this holding:

It is important to note that neither the public nor respondent will be deprived of the benefit of petitioner’s performance as long as his commercial stake in his act is appropriately recognized. Petitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it.

3. **Molony v. Boy Comics Publisher**

This 1950 New York case presents a barrier to groups utilizing the right of publicity as a means to protect the use of indigenous public figures. In *Molony*, a seventeen-year-old man serving in the United States Coast Guard rushed to the rescue of several people when a U.S. Army plane struck the Empire State Building. The plaintiff “displayed exceptional presence of mind in quickly procuring medical equipment, and in evacuating a large number of victims, to many of whom he administered first aid.”

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182. *Zacchini*, 433 U.S. at 573. The Court differentiates between the two torts in question here, the right to privacy and the right of publicity:

“The interest protected” in permitting recovery for placing the plaintiff in a false light “is clearly that of reputation, with the same overtones of mental distress as in defamation.” By contrast, the State’s interest in permitting a “right of publicity” is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment. As we later note, the State’s interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation. Second, the two torts differ in the degree to which they intrude on dissemination of information to the public. In “false light” cases the only way to protect the interests involved is to attempt to minimize publication of the damaging matter, while in “right of publicity” cases the only question is who gets to do the publishing. An entertainer such as petitioner usually has no objection to the widespread publication of his act as long as he gets the commercial benefit of such publication. Indeed, in the present case petitioner did not seek to enjoin the broadcast of his act; he simply sought compensation for the broadcast in the form of damages.

183. *Id.* at 575.
184. *Id.* at 578.
186. *Id.* at 121.
187. *Id.*
The event captured America's attention, making Americans wonder what could happen if our cities were subject to attacks from the air.\textsuperscript{188} Several media covered the plaintiff's role in the rescue, launching him into the spotlight.\textsuperscript{189} Six months later, the defendant published \textit{Boy Comics}, which depicted the Empire State Building accident, labeling the plaintiff "Real Hero."\textsuperscript{190} Depictions of the plaintiff showed him procuring first aid supplies from a drugstore, aiding an elevator operator with severe burns, climbing to the seventy-ninth floor, and carrying out victims to safety.\textsuperscript{191}

The soldier objected to the unauthorized commercialization of his likeness and filed suit under the New York Civil Rights Law sections 50 and 51,\textsuperscript{192} which forbade the use of one's name, portrait, or picture without his consent for advertising purposes or use in trade.\textsuperscript{193} While the court held that the pictorial depiction was essentially accurate, the defendant's account did not constitute advertising or use in trade.\textsuperscript{194} The court held for the defendant publisher, dismissing the plaintiff's

\begin{footnotesize}
\begin{enumerate}
\item[188.] \textit{Id.} at 120-21.
\item[189.] \textit{Id.} at 121.
\item[190.] \textit{Id.}
\item[191.] \textit{Molony,} 98 N.Y.S.2d at 121. The court described defendant's publication in detail: This action springs from an account of this incident with accompanying drawings, which appeared some six months later in a magazine published by defendant, entitled "Boy Comics." It occupies five pages of an issue containing various series of pictures, and is headed "The True Story of the Empire State Building," beneath which are the capitalized words "REAL HERO." The script is taken almost verbatim from the news account as it appeared in the \textit{New York Journal-American}. The pictures are not actual photographs, but the usual type of drawings or symbolic sketches which are found in such publications. The first pictures are of a four-motored bombing plane crashing into the Empire State Building, followed by an illustrated narrative of plaintiff's deeds. He is shown procuring morphine, hypodermics, and first-aid kits from a drugstore, giving first aid to an elevator girl who sustained severe burns and had descended rapidly from the 79th floor, then shown climbing the stairs to the 79th floor while the elevators were disabled, and then carrying out survivors and again administering first aid. The narrative culminates in plaintiff's being congratulated by survivors and photographed and interviewed by newsmen and, finally, in his being recommended by the Coast Guard for a decoration. \textit{Id.}
\item[192.] See \textit{N.Y. Civ. Rights Law} §§ 50, 51 (McKinney 1950). The relevant portion of the statute states:

\begin{quote}
§ 50. Right of privacy
A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.
\end{quote}
\textit{Id.}
\item[193.] New York had no common-law right to privacy. \textit{Molony,} 98 N.Y.S.2d at 121.
\item[194.] \textit{Id.} at 124-26.
\end{enumerate}
\end{footnotesize}
If a defendant were, however, using the disputed likeness in a plainly commercial context, a plaintiff may have a better case.

4. Landham v. Lewis Galoob Toys

In this case, the plaintiff lost his right of publicity claim against a defendant toy maker. The plaintiff was a "fringe actor" who played supporting roles in several motion pictures, including the 1987 film Predator, in which he played Billy, the Native American Tracker. The defendant toy maker contracted in 1995 to market a line of toys based on Predator, including a Billy toy. The plaintiff objected to the Billy toy, claiming the toy violated his right of publicity under Kentucky law.

The United States Court of Appeals for the Sixth Circuit explored the question of when the character's identity fuses with the actor's identity, vesting the right of publicity with the individual actor. The court held that "if the use of a fictional character also evokes the identity of the actor who played the character, he may challenge that use," even if that actor gained fame only through his performance of that role. However, in applying this rule to the case, the court held that the actor's identity and the character's identity were separate and distinct. The court reached this pro-defendant decision even though the use in question was clearly commercial and, consequently, subject to a higher level of scrutiny.

195. Id. at 126.
196. The principles of this case could work for the Maori if a U.S. court were to deem the Bionicle game mainly commercial. In Molony, the comic book coverage arguably had some newsworthiness.
197. 227 F.3d 619 (6th Cir. 2000).
198. Id. at 621.
199. Id. at 622.
200. Id. Plaintiff also claimed the doll violated the Lanham Act's prohibition of false endorsements.
201. Id. at 625.
202. Landham, 227 F.3d at 625.
203. Id.
204. Id. at 626. The court rejected the plaintiff's argument:

In sum, Landham has not demonstrated—either through direct evidence or by virtue of Galoob's use of the "Billy" character—that his persona has "significant commercial value" or that the "Billy" toy invokes his own persona, as distinct from that of the fictional character. For these reasons, we affirm the district court's grant of summary judgment to Defendants on this claim.

205. LEGO's use of Maori elements in the Bionicle game could likely be deemed commercial as well. However, this case evidences that commercial use will not always result in a finding for the plaintiff.
Both *Haelan Laboratories* and *Zacchini* strengthen the right of publicity regime by first recognizing a right to one's persona and then recognizing the right to license that right of publicity. However, *Molony* shrinks the rights of public figures by allowing depictions of actual events, and *Landham* refuses an actor rights to his character's persona. These right of publicity cases exemplify the fractured nature of the law in this area. This common law action, although tenuous, could provide ammunition to indigenous groups in a battle over cultural heritage if the element in controversy is a persona.

III. **Analysis: Squaring U.S. Trademark, Copyright, and Right of Publicity Laws with the Protection of Cultural Heritage**

The outline of U.S. case law above provides the framework for analyzing the Maori's potential legal claims against LEGO. This groundwork provides some understanding of U.S. practice regarding the protection of intangible cultural property and allows one to gauge future legal trends in the cultural heritage area. This section will first detail the dispute between New Zealand's indigenous tribes and the Danish toy maker. Next, it will set out some possible Maori legal claims under trademark, copyright, and right of publicity regimes, analyzing each one's likelihood of success based on U.S. case law and trends.

A. **LEGO's Bionicle Game and the Maori Objections**

The hi-tech Bionicle line combines toys, online games, and comics to create an interactive game for children. LEGO researched several cultures and their histories, including Polynesian culture, to create the rich background for this complex game. Bionicle games center around an island, Mata Nui, that was once a beautiful paradise, but is now a "place of darkness and fear ruled by the deadly Makuta." Six heroes, the Toa, have joined forces to fight the Makuta and free the Matoran, the inhabitants of Mata Nui.

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207. See infra note 10 and accompanying text.

208. See LEGO website, at http://www.lego.com/eng/bionicle/games.asp (last visited Nov. 15, 2003). The LEGO website has an extensive lexicon to define each character, name, place, and object in the Bionicle line. LEGO continues to develop the game, adding new story lines and products.

209. Id.
The Matoran did not always go by that name. According to LEGO's online lexicon, these Mata Nui inhabitants were previously called the "Tohunga."\footnote{Tohunga} Tohunga is a sacred Maori word that loosely translates to "priest."\footnote{The first generation of the Bionicle game employed other words found in the Maori language as well: \textit{Pohatu} (stone), \textit{Kanohi} (mask), and \textit{Whenua} (earth).\footnote{This Bionicle backdrop arguably incorporates elements of Polynesian legend and history.\footnote{Specifically, LEGO focused on the struggle surrounding Easter Island, \textit{Rapa Nui} in Maori,\footnote{whose name resembles "Mata Nui," LEGO's name for the island paradise at the center of the Bionicle game. According to one news article: "The vowel-laden names of the Bionicle characters are clearly reminiscent of Polynesian names and the elemental (earth, fire, water, stone, air) nature of the characters also relates to the spiritual beliefs of Pacific islanders."\footnote{See Lego to Change Bionicle Names: Cultural Exploitation?, supra note 205.\footnote{Id. The definitions in the LEGO lexicon match the Maori meanings for these words: "Kanohi: The masks worn by the inhabitants of Mata Nui; Whenua: Turaga of Onu-Koro; Pohatu: The Toa of Stone." Id.}}}}

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\footnote{See LEGO website, at http://www.lego.com/eng/bionicle/lexicon.asp?contid=sz (last visited Nov. 15, 2003) (LEGO's online lexicon defines “Tohunga” as the villagers of the island of Mata Nui, who now call themselves Matoran.).} 

\footnote{Lego to Change Bionicle Names: Cultural Exploitation?, supra note 205.} 

\footnote{Id. The definitions in the LEGO lexicon match the Maori meanings for these words: "Kanohi: The masks worn by the inhabitants of Mata Nui; Whenua: Turaga of Onu-Koro; Pohatu: The Toa of Stone." Id.} 

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Islanders.”215 LEGO admits to studying Polynesian culture while developing the game, and to being inspired by it.216 However, LEGO asserts that its historians explored the history and lore of several cultures to create the Bionicle line:

LEGO Company’s new product Bionicle (a contraction of the words ‘Biology’ + ‘Chronicle’) has evolved through inspiration from many different cultures and places around the world. In the Bionicle universe there are words with specific meaning to Maori, Koreans, Rotuman Islanders, Moroccans, Chinese, Japanese and even speakers of ancient Cornish in Great Britain. Other words are purely fictional simply chosen for their feel. The Bionicle story and characters have been created to represent heroism, bravery and inspiration for children in their play with and enjoyment of the products.217

The New Zealand-based barrister on the frontline of this debate, Maui Solomon, states that the Maori object to LEGO’s misuse of both Polynesian language and culture.218 Specifically, the Maori challenge the use of Maori and other Polynesian names on plastic LEGO toys, the use of sacred Maori words, such as Tohunga (priest), and the Maori names being used “outside their cultural context.”219 Maui Solomon drafted a letter of complaint to LEGO in May 2001,220 asking for the suspension of the Bionicle line because it infringed the Polynesian peoples’ intellectual property rights to their language and culture.221

After receiving the letter, LEGO reconsidered its game; however, it did not suspend sales or recall any Bionicle merchandise.222 Instead, LEGO agreed not to use any Maori words in later Bionicle generations.223 Considering that LEGO believed the Maori claims had no legal merit, agreeing to this revision, was a major concession, albeit far less expensive than a product recall.

216. E-mail from Jette Orduna, LEGO, to Sarah La Voi, Student, DePaul University College of Law (Oct. 25, 2002, 12:09:38 CST) (on file with author).
217. See id.
218. E-mail from Maui Solomon, New Zealand Barrister, to Sarah La Voi, Student, DePaul University College of Law (Nov. 11, 2002, 10:59:13 CST) (on file with author).
219. Id.
221. CNN, supra note 213.
222. E-mail from Jette Orduna, LEGO, to Sarah La Voi, Student, DePaul University College of Law (Nov. 8, 2002, 09:03:21 CST) (on file with author). LEGO stated that it was “too late and impossible to recall all the products and marketing materials, which had been distributed worldwide.” Id. Further, LEGO claims not to view this matter as a legal one; instead it sees it as a sentimental issue only. Id.
223. Id.
Below, the next section analyzes the Maori’s possible intellectual property claims against LEGO in U.S. courts, if indeed the Maori chose to sue. By looking through the narrow lens created by the Maori challenges to LEGO’s Bionicle line, we can explore the broader issues of all cultural heritage disputes and how they might fare under U.S. law.

B. Possible Trademark Claims

When seeking protection for cultural heritage, specifically for the Maori words incorporated into Bionicle, the Maori may turn to the Lanham Act.224 It is important to note that LEGO has not attempted to trademark any word or symbol in the Bionicle line, except for the “Bionicle” name itself.225 Bionicle, as noted above, combines the words “biology” and “chronicle” to form a new word,226 which would likely qualify as either “suggestive” or “arbitrary” on the accepted U.S. scale of trademark eligibility.227

In their hypothetical lawsuit against LEGO, the Maori have two high hurdles to clear before gaining trademark protection for words in the Maori language. They must (1) establish that common words in their language are eligible for trademark protection,228 and (2) prove that LEGO’s use of Maori words is likely to cause consumer confusion.229

1. Generic Names are Not Subject to Trademark Protection

Random words in any language, which do not signal the specific source of a product or service, do not meet the threshold for trademark protection, according to the basic principles of trademark law.230 A word must “designate the source or origin of a particular product or

224. Lanham Act, 15 U.S.C. §§ 1051-1127 (2000). The Lanham Act protects marks used in trade or commerce. The Maori may have to first establish that they had been trading on the names themselves to establish a valid trademark claim.

225. E-mail from Jette Orduna, LEGO, to Sarah La Voi, Student, DePaul University College of Law (Oct. 25, 2002, 12:09:38 CST) (on file with author).

226. Id.

227. See supra text accompanying notes 28-34. BIONICLE is a strong candidate for trademark protection in the United States. First, it is clearly not the generic term for a specific service object. Next, it does not simply describe the characteristics or attributes of the game. The term may be considered suggestive; one could argue that it connotes the game’s epic, historical nature. More likely, however, BIONICLE would be deemed arbitrary and worthy of the highest level of trademark protection because BIONICLE is a novel term created by combining two separate words, biology and chronicle.


229. Id. § 1051(b)(3)(D).

service” before it will be considered for trademark protection. The words employed by LEGO in developing the Bionicle line, Pohatu, Kanohi, and Whenua translate to the generic words, “stone,” “mask,” and “earth” respectively. According to one trademark expert, a generic name is:

The name of a particular genus or class of things or a member of such a class. It is denominative in character, is ordinarily a noun, and answers the questions “What is it?” or “What do you call it?” Thus, “piano” is the generic name for one member of a class of keyboard instruments.

The Maori words above meet this definition of “generic names.”

Generic names are essential to communication and, therefore, must be free for all to use. No one person or group may rightfully corner a generic name as an exclusive trademark. Usually, generic names, such as the Maori words embedded in LEGO’s Bionicle game, are not eligible for trademark protection.

Yet, it is important to note that generic terms are not eligible for trademark protection only when they are designed to signal the corresponding generic term. ORANGE, for example, would be ineligible for trademark protection to signal the actual fruit because it is the widely accepted generic term for that item. If the ORANGE mark signifies a mobile phone company; however, it could be registrable.

This indicates that LEGO could succeed in registering some Maori words if it chose to pursue that route. For example, the WHENUA mark may be registrable if it signaled something other than earth in the Bionicle universe, such as a warrior princess. If LEGO did register a Maori term for an element of the Bionicle game, LEGO would not control every use of the Maori word. It would own rights to the Maori word only in the context of the Bionicle game.

231. GILSON, supra note 30, § 2.02.
233. See id.
234. GILSON, supra note 30, § 2.02, at 13-14.
235. Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111 (1938) (holding that “shredded wheat” was a generic, descriptive term to which plaintiff cereal producer held no exclusive rights).
236. GILSON, supra note 30, § 2.02.
238. GILSON, supra note 30, § 2.02.
239. Id.
2. Generic Terms in a Foreign Language May Still Be Deemed Generic

The trademark inquiry goes even one step further in this case because the words that are generic in the Maori language are novel to most American consumers, who are not familiar with Polynesian languages. Nonetheless, trademark law does not afford foreign generic words greater protection. United States law equates the foreign word with its English translation and inquires "whether it would be generic to members of the American public familiar with the foreign language." In this case, the words "stone," "mask," and "earth" are clearly generic names, yet they are not necessarily used to signal the corresponding object. Therefore, the Maori words found in Bionicle may be eligible for trademark protection under the Lanham Act.

Even though the trademark case law outlined above dictates that generic words are not eligible for protection, this does not preclude LEGO from gaining trademark rights to some Maori words used in the Bionicle game. When the courts refused protection above, it was because the marks signaled their generic counterparts. For example, in Mohegan Tribe of Indians of Connecticut v. Mohegan Tribe and Nation, Inc. the court refused to protect the MOHEGAN mark because it was a generic term used to describe a people of certain ancestry. Both the plaintiffs and the defendants were utilizing a word outside of the English language to signal a source, their tribes, and their associated business endeavors.

In both Filipino Yellow Pages and the dispute regarding OTOKOYAMA sake, the courts supported the rule that foreign generic or descriptive words did not warrant trademark protection when used to signal the corresponding generic goods or services. In the hypothetical Maori v. LEGO dispute, however, the Maori words

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240. Duncan, Inc. v. Royal Tops Mfg. Co., 343 F.2d 655 (7th Cir. 1965) (refusing to grant exclusive rights to the generic names of foreign games or to the games themselves in a dispute revolving around the "Yo-Yo").

241. GILSON, supra note 30, § 2.02[4]. Gilson highlights other cases in which foreign generic terms were not protected under U.S. law, such as KABA for "coffee" to those familiar with Ukrainian and the Cyrillic alphabet, or LECHE DE MAGNESIA, which translates to "milk of magnesia" in Spanish. Id.

242. 769 A.2d 34 (Conn. 2001).

243. Id. at 42.

244. See Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns, Inc., 198 F.3d 1143 (9th Cir. 1999).

245. See Otokoyama Co. v. Wine of Japan Import, Inc., 175 F.3d 266 (2d Cir. 1999).

246. Id. at 271.
employed are names of the game pieces. They could be considered descriptive, yet they are certainly not generic.

3. **LEGO's Use of Generic Maori Terms is Unlikely to Cause Consumer Confusion**

Trademark law focuses on consumers' perceptions. If a mark is likely to confuse the public as to the source or the origin of a good or service, a merchant may not register that trademark. The test for consumer confusion is defined in the Lanham Act. It is unlawful to use any trademark that "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . ."249

In this case, LEGO claims to have employed Maori words, along with other fictional words, because their look and "feel" comport with the epic style of the Bionicle game. A thorough exploration of the Bionicle website reveals no direct connection to the Maori or to any Polynesian people beyond the use of some words that have specific meaning in the Maori language. The majority of LEGO consumers are not familiar with Polynesian languages and would likely not be able to pinpoint the origin of the vowel-laden words. Consequently, consumers are unlikely to connect the Maori to the Bionicle game at all. This lack of association in the minds of consumers rules out a likelihood of consumer confusion.

4. **Maori Claims Under § 2(a) of the Lanham Act: Immoral, Deceptive, or Scandalous Marks**

To reiterate, LEGO has not attempted to register any words in the Bionicle universe beyond the game's name, nor does LEGO plan to

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247. For example, if "Pohatu" signaled a Bionicle character with a stone body, it should be deemed descriptive and granted a very narrow scope of protection.
248. See supra note 36 and accompanying text. Lack of registrability does not necessarily preclude the use of a mark.
250. E-mail from Jette Orduna, LEGO, to Sarah La Voi, Student, DePaul University College of Law (Oct. 25, 2002, 12:09:38 CST) (on file with author).
251. LEGO website, at http://www.lego.com/eng/bionicle/default.asp (last visited Nov. 15, 2003). The LEGO website makes no mention of the Maori people or the Polynesian history or culture.
252. Both sophisticated parents and unsophisticated children comprise LEGO's target consumer group. However, LEGO sells its products throughout the world. It is unreasonable to assume that the majority of its consumers would be familiar with the Maori language.
pursue trademark protection for game words in any country. However, if LEGO did attempt to trademark a toy's name, such as the “Tohunga” toy from the first generation of the Bionicle line, the Maori may be able to bar registration under § 2(a) of the Lanham Act, which prohibits immoral, deceptive, or scandalous marks.

Harjo v. Pro-Football, Inc. acts as a guide to a § 2(a) objection. Again, in that case, American Indians successfully enjoined the registration of any form of REDSKIN due to its disparaging nature. In this present debate, the Maori are particularly upset by LEGO’s use of the term Tohunga for a plastic toy. The Maori attorney, Maui Solomon, said that his clients specifically objected to the offensive use of this sacred term, which means “priest.”

To establish a § 2(a) claim, the Maori must lay the groundwork for how LEGO’s use of Tohunga is immoral, deceptive, or scandalous, or could disparage a people. In Maori culture, language is central to the Maori way and to preserving one’s tribal identity, known as the Māoritanga. One Maori artist explains the role language plays in the Maori world:

First, in understanding that language is the key to understanding any culture, I make sure that I speak my language in as many places as possible and pass this on to my children. I want them to learn their language and to know who their ancestors are, their tribal histories, as well as the customs and traditions we have. Knowledge of my language enables me to move comfortably amidst my people and to participate more fully... The Maori language is the lifeblood of our culture.

Second, the Maori must establish the sacred place of Tohunga in their culture, which is exemplified by a Maori fable. The birth of life, according to Maori culture, began with Ranginui, the Sky Father, and Papatuanuku, the Earth Mother, clinging together in a tight embrace. Their many children were crushed between the two bodies, yearning for freedom and struggling to break loose. Many children-

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253. E-mail from Jette Orduna, LEGO, to Sarah La Voi, Student, DePaul University College of Law (Oct. 25, 2002, 12:09:38 CST) (on file with author).
254. 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999). See supra notes 40-55. See also addendum as Harjo was recently reversed.
255. Id. at 1749.
256. E-mail from Maui Solomon, Maori Attorney, to Sarah La Voi, Student, DePaul University College of Law (Nov. 11, 2002, 10:59:13 + 1300) (on file with author).
257. See id.
258. See supra note 48 and the accompanying text.
260. Id. at 56.
261. Id. at 26.
262. Id.
gods used their powers and strength in desperate attempts to separate their parents and liberate their siblings. All failed, save one, Tāne Mahuta, the god of the forests. He "set his sturdy feet upon his father’s chest, and braced his upper back and shoulders against the bosom of his mother. He pushed and they parted." His siblings tumbled forth and so the world began.

This story illustrates the Maori ties to nature and the divine. The Maori spiritual beliefs are elemental, savoring earth, wind, fire, and water. The bridge between the divine and the human is paramount and the Tohunga, (priests), facilitate this sacred synapse by managing tapu (under religious restriction, sacred) and mana (power, prestige, authority).

LEGO used the term “Tohunga” to refer to general island inhabitants in the first release of the Bionicle game. In light of the pivotal and sacred role of the Tohunga in Maori religion and culture, creating a plastic children’s toy with this name “may disparage” the Maori people, as REDSKIN was held to be possibly disparaging to Native Americans in Harjo. Therefore, the Maori may be able to block LEGO under § 2(a) of the Lanham Act if the toy maker had attempted to register TOHUNGA as a trademark for its Bionicle pieces. This conclusion loses its punch, however, because LEGO has never attempted to register any words in the game and has stated that it will never do so. Further, cancellation of a trademark registration, as established in Part II of this Comment, prohibits only exclusive rights to that word; one may still use the term freely. The Washington Redskins football team still exists today. The team owners have lost only the right to license and control the mark. Therefore, LEGO would still be free to use the Tohunga toy, rendering any Maori § 2(a) efforts moot.

263. Id.
264. Id.
266. Id.
267. See id. at 162.
268. Id. at 26, 161-62.
269. See supra note 208 and accompanying text.
270. E-mail from Jette Orduna, LEGO, to Sarah La Voi, Student, DePaul University College of Law (Oct. 25, 2002, 12:09:38 CST) (on file with author).
271. Losing the right to license the REDSKINS mark likely resulted in a substantial loss of potential revenue for the team owners.
272. Further, other entities could also freely use the term “Tohunga” to market goods and services. No one entity, including the Maori, would own exclusive rights to the term. This result would invert the essential Maori purpose.
Finally, it is key to note that LEGO has attempted to lessen injury and insult to the Maori by changing the name of the island inhabitants from the Tohunga to the Matoran, a name with no specific meaning in the Maori language.  

This analysis of the theoretical legal battle between the Maori and LEGO reveals that U.S. trademark law is unlikely to provide the Maori with effective legal ammunition. Another possible route lies in the copyright regime.

C. Possible Maori Copyright Action: Unlikely to Succeed

The Maori have objected most fervently to LEGO's inappropriate use of specific words from the Maori language in the Bionicle line; however, these theoretical plaintiffs are also upset that the Bionicle story line resembles Maori history and lore. Maui Solomon, the Maori attorney leading this opposition, alleges that the Bionicle "storyline [sic] bore 'a remarkable resemblance' to traditional yarns from Easter Island." Consequently, the Maori might raise copyright claims in this hypothetical legal action for protection of their cultural heritage.

First, it is not clear that LEGO based the epic Bionicle game on the evocative, war-torn Maori history or legends. To facilitate this portion of the analysis, however, we will assume Bionicle draws heavily from Maori past and legend, specifically the battle over Rapa Nui, or Easter Island.

1. Maori History and Legends Do Not Qualify for Copyright Protection

As established in Part II, the three fundamental requirements for U.S. copyright protection: (1) originality; (2) authorship; and (3) fixation, clash with the oral cultures of indigenous tribes. Therefore, it may be difficult for the Maori to succeed in copyright claims against LEGO for the use of Maori language, history, or legend in the Bionicle game.

275. See id. (quoting Maui Solomon).
276. See supra note 213 and accompanying text (outlining some of the Maori history, past leaders, and wars.).
Originality and authorship are high hurdles for the Maori in this instance. There is no one “author” of Maori legends detailing the epic battles to protect *Rapa Nui*, just as in Western culture, where there is no identifiable author to the legends of Santa Claus or the Easter Bunny. These stories are often based on a kernel of truth and evolve over time. This intergenerational evolution weakens claims of originality, often making copyright protection unattainable. Further, these stories have been passed down orally, without fixation in a “tangible medium of expression,” as required by the Copyright Act.

Even if these Maori stories were fixed in a tangible medium of expression and the group could establish authorship and originality, their protection would have expired. Copyright protection is finite. After the adoption of the Sonny Bono Copyright Term Extension Act, works are protected for only seventy years after the death of the author before they enter the public domain. The last Maori War ended in 1872, 131 years ago. This time frame suggests that fictional accounts of the wars would not be subject to current copyright protection, unless they were created within seventy years and met the rigorous copyright standards laid out above.

One renowned expert in the field of copyright, David Nimmer, expounds on the issue of copyrighting historical accounts: “One cannot build a story around a historical incident and then claim exclusive right in the use of the incident.” Allowing exclusive rights to historical events would rob the public domain of vital information, excluding later authors from retelling an event in a different manner.

Nimmer also explains why courts deny protection to such facts: “Facts may be discovered, but they are not created by an act of authorship. One who discovers an otherwise unknown fact may well have performed a socially useful function, but the discovery as such does not render him an ‘author’ in either the constitutional or statutory sense.”

This refusal to grant copyrights in facts, however, does not leave all factual works vulnerable to blatant copying. Copyright laws do protect the original expression, the manner in which the facts are related, if they are not functional (i.e., a graph or a table). Therefore, if

278. Id.
280. 3 NIMMER & NIMMER, supra note 111, § 9.01.
281. See supra note 206 and accompanying text.
282. 1 NIMMER & NIMMER, supra note 111, § 2.11.
283. See id. To summarize, finders are not keepers in the realm of copyright law.
LEGO had appropriated a Maori storyteller's expression of a legend, including his original contributions, the Maori may have a valid copyright action. Note that, even if LEGO did base Bionicle loosely on Maori legend or factual history, it would not rise to this level of copying.

2. Comparing Hypothetical Maori Claims to Established Copyright Case Law

This conclusion that the Maori have little hope to succeed in a copyright action follows the case law highlighted in Part II. In Fendler v. Morosco, the court refused to protect general "ideas" common to two separate plays. Just like in Fendler, the "ideas" that comprise Maori legends are not protected by copyright.

In Malkin v. Dubinsky, another playwright lost the battle to protect his play, which was based on family drama within the context of a union strike. The court recognized similarities, as well as differences, between the two plays, concluding that incidents extracted from the public domain are not copyrightable. The themes running through Maori legends, which include a battle to protect one's homeland, war, complicated love, and pride, are also basic ideas in the public domain. These scenes a faire do not warrant protection. In Hogan v. DC Comics, the court found no copyright infringement where two similar comic books contained central half-vampire, half-human characters of the same name.

Finally, in the realm of copyright, the Maori could claim that LEGO's portrayal of Polynesian history perverts the real story and, therefore, constitutes copyright infringement. In Gilliam v. ABC, Inc., the authors of the Monty Python series succeeded on copyright grounds because ABC edited the Monty Python programs inappropriately, mutilating the plaintiff's copyrighted work. In the instant case, however, the Maori do not hold copyrights to the legends and

286. See id.
288. Id.
289. Id. at 507. "In the case at bar, plaintiff's claims involve, at best, some similar material which belongs to the public domain and some details which in the total context are trivial." Id. at 506.
292. Id. at 313.
294. See id.
history that may have inspired the Bionicle backdrop. This lack of copyright precludes this course of action.

After exhausting the copyright route, the Maori could next seek redress under right of publicity laws.

D. Possible Strategies Based on Right of Publicity Laws

Beyond naming the cowed inhabitants of Mata Nui the "Tohunga" in the first version of the Bionicle game, LEGO referenced no actual Maori historical figures. If LEGO had built its Bionicle story around a revered Maori warrior, the Maori may have had a strong right of publicity claim, provided LEGO's use detracted from Maori plans to capitalize on that warrior persona. LEGO did not pursue this avenue, and therefore, a right of publicity exploration will be brief. For the purposes of legal analysis that could aid the debate over control of cultural heritage, we will assume that LEGO did incorporate the story of "Mana King," a purely fictional Maori warrior figure created for this Comment only, into the Bionicle story line through the LEGO website, comics, and plastic toys. Using this assumption, one can analyze the Maori's theoretical claims against the right of publicity case law set forth in Part II.

1. General Right of Publicity Analysis

If Mana King had died, the rights in his persona might have passed down to his heirs through his estate, as right of publicity laws can be descendible. SUPRA note 30, § 1.03. His estate may then have standing to sue LEGO in the U.S. court system if LEGO consumers would be likely to incorrectly believe that Mana King or his estate somehow supported or endorsed LEGO's Bionicle product line. SUPRA note 30, § 1.03. Before winning a right of publicity claim, the Maori would have to establish a connection in the consumer mind between the LEGO game and their revered warrior, Mana King.

When analyzing right of publicity cases, courts might first look back to the landmark case, New York Times Co. v. Sullivan, which dealt with right of privacy as opposed to right of publicity, yet still provides guidance. This libel case restricted privacy rights for public figures by requiring that plaintiffs establish that false statements or misuse of
their persona resulted from the defendant’s actual malice. Right of publicity analysis parallels this idea that even though public figures have vested rights in their persona, they must endure certain invasions due to their elevated societal status.

When analyzing a right of publicity claim, the courts ask first whether the medium in which the reference to the public figure appeared is commercial or noncommercial. Purely commercial speech is afforded less protection because it is assumed to be less worthy to the public discourse. Next, a court determines whether the publication at issue intended to create a false impression in the minds of the audience. The question of actual malice, as presented in Sullivan, rarely arises in right of publicity claims because defendants often have attempted only to imply sponsorship and have not made express statements about the public figure. The concept of actual malice is better suited to right to privacy issues.

In the situation of Mana King’s appearance in LEGO’s Bionicle line, courts likely would hold that the game was not purely commercial speech. Mana King’s fictional presence in the game as a character adds depth and value to the story. The fact that the game is a commercial work for sale in the marketplace, as opposed to a nonprofit historical commentary, does not strip it of all free speech rights. Courts are aware of the careful balance between the right of publicity, the First Amendment, and intellectual property laws.

The next step in a right of publicity analysis is to ask whether consumers are likely to incorrectly assume Mana King or his estate endorsed the Bionicle game. The question mirrors trademark notions of

299. See id. Specifically, this case centered on libel—damaging false statements against a person. Id. The court defined actual malice as knowledge that the statement made was false or that it was made with reckless disregard for the truth. Id. at 280.

300. While right of publicity laws are linked to right to privacy laws, and similar reasoning is employed to comprehend both, the two realms are opposite. In right to privacy cases, people are fighting to preserve their privacy and to keep their actions out of the public eye. In right of publicity cases, plaintiffs court publicity, yet they are seeking to exclude others from also exploiting their persona in a commercial context. Right of publicity plaintiffs want to be the only entity controlling the commercial aspects of their persona.

301. Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1184-85 (9th Cir. 2001) (denying well-known actor Dustin Hoffman’s assertions to his right of publicity when a magazine used an altered photograph of him in women’s clothing during a commentary on female clothing and style).

302. Sullivan, 376 U.S. at 266.

303. Hoffman, 255 F.3d at 1186.

304. Id.

305. See id. at 1184.
likelihood of confusion.\textsuperscript{306} If Mana King was the hub of the Bionicle game, consumers may very likely be confused and believe that his estate endorsed the game, which would buttress the Maori's right of publicity claims under a sponsorship confusion theory.\textsuperscript{307} However, if Mana King was only one of many characters, confusion as to Mana King's or Maori sponsorship would be less likely. Below is a case-by-case analysis of how Maori right of publicity claims might fare in light of the case law outlined in Part II.

2. Case Law Application to the Hypothetical Situation of Mana King

The early right of publicity case mentioned previously, \textit{Haelan Laboratories v. Topps Chewing Gum},\textsuperscript{308} reinforces the rights of Mana King's estate to bring action against LEGO. According to the Second Circuit, people have the right to grant the use of their persona to others,\textsuperscript{309} which implies that one may bar others from using that persona without permission. This holding bolsters the claims of Mana King's estate, assuming LEGO idolized this warrior without permission.

The landmark \textit{Zacchini v. Scripps}\textsuperscript{310} right of publicity decision held that people have the right to profit from use of their persona.\textsuperscript{311} This Supreme Court ruling aids Mana King's estate. The estate could ar-

\textsuperscript{306} See Gilson, \textit{supra} note 30, § 5.05. Gilson demonstrates how courts review likelihood of confusion when the plaintiff's and the defendant's goods do not necessarily compete in the same market. This trademark analysis sheds light on the issues of source confusion and helps to explain how a court may embark on this complicated analysis in a right of publicity context:

§ 5.05 Noncompeting Products

Direct product competition is an important factor in assessing public confusion, but a trademark owner may prevail by showing that the respective products are so related that the public believes they come from a single source. In analyzing noncompeting goods trademark cases, courts often consider a list of factors developed from prior case law. Important factors in the determination of whether to extend protection are: (1) the fame of the owner's trademark; (2) the strength of the mark; (3) whether the respective products are of the same genus; and (4) whether the owner is likely to expand his business to produce the noncompeting product. Consumer confusion may also be associated with tarnishment of the trademark owner's product, by derogatory use of the mark, or by association with inferior products.

\textit{Id.}

\textsuperscript{307} To illustrate, an actor would have a strong sponsorship confusion claim if a vitamin manufacturer were to place the actor's image on vitamin bottles or in the advertisements without permission. Consumers would naturally (and mistakenly) draw a connection between the actor and the product, concluding that the actor endorsed the product when in fact he did not.

\textsuperscript{308} 202 F.2d 866 (2d Cir. 1953).

\textsuperscript{309} \textit{Id.} at 869.

\textsuperscript{310} 433 U.S. 562 (1977).

\textsuperscript{311} \textit{Id.} at 578.
gue, for example, that it deserves compensation, under Zacchini, for use of the warrior's image in the Bionicle game. To justify compensation, the estate could argue that LEGO's use of Mana King's persona in their game appropriated the rights of the estate to use the warrior's image in its own line of toys to teach children Maori history, losing the ability to profit from Mana King's performance in this commercial context.

The other right of publicity cases found in Part II may also work for the estate of Mana King. In Molony v. Boy Comics Publisher, the court refused to protect a hero's right of publicity. This young coast guard officer could not enjoin the defendant publisher from depicting his heroics following a plane crash at the Empire State Building because the Real Hero comic book depicted real life events and was not used in advertising or trade, even though the comic book was sold. In the present hypothetical dispute, Mana King's estate would have an easier time proving that the warrior's image was used in trade, but this finding is not certain. This factual question would depend on a deeper inquiry into the exact manner and use of Mana King's image in the LEGO game and the advertising.

Finally, Landham v. Lewis Galoob Toys appears to parallel the hypothetical dispute between Mana King's estate and LEGO. In Landham, the defendant produced an action toy based on a character from the film Predator. The actor who played "Billy the Native American Tracker" character sued, claiming the toy violated his right of publicity. The court held that the actor's identity was sufficiently separate from the identity of "Billy the Native American Tracker." Therefore, the plaintiff actor's right of publicity remained intact.

In the situation of Mana King, alternatively, there is no line of demarcation between the man and the character. Mana King was not playing a role. Therefore, Landham may bolster the estate's case. Another case also lends support to Mana King's estate's fight to maintain control of his persona: Hornell Brewing Co. v. Rosebud Sioux Tribal Court. In this dispute, discussed in detail in Part II, the estate of

313. See id. at 124.
314. 277 F.3d 619 (6th Cir. 2000).
315. Id. at 621.
316. See id.
317. See id. at 626.
318. See id.
319. 133 F.3d 1087 (8th Cir. 1998).
Crazy Horse won a battle against Hornell Brewing Company in tribal court on right of publicity grounds.\textsuperscript{320}

Again, Hornell Brewing Company used the image of the Sioux leader Crazy Horse on its malt liquor beverage.\textsuperscript{321} The tribal court, even though later reversed due to jurisdictional issues, found that Hornell Brewing Company had appropriated Crazy Horse's image, violating his estate's right of publicity.\textsuperscript{322} This line of reasoning extends naturally to the fictional instance of using Mana King to sell LEGO games and toys.

Of the three intellectual property regimes discussed in this Comment, indigenous groups may find the most protection under right of publicity laws. This option is narrow, however, and restricted to specific commercial uses of indigenous personas. Of course, in the real dispute between the Maori and LEGO, LEGO did not cross into this right of publicity territory.

IV. IMPACT: STRIKING A BALANCE THROUGH A SYSTEM OF \textit{DOMAINE PUBLIC PAYANT}

Controversies surrounding use of cultural heritage elements in commercial contexts is on the rise, as evidenced by the debate between LEGO and the Maori. If this trend continues, U.S. courts will be faced with the impossible task of applying current intellectual property law to claims of cultural heritage appropriation. This Comment demonstrates that current U.S. intellectual property regimes are inadequate to fairly and efficiently deal with valid claims of cultural misappropriation.\textsuperscript{323} The relevant tension is: How do we safeguard cultural heritage that is worthy of protection while simultaneously preserving a rich pool of common ideas? It is a challenge to avoid an over-protectionist system\textsuperscript{324} that stifles creativity and tramples First Amendment rights of free speech. Yet, it is important to recognize that some cultural heritage slipping through the cracks of the intellectual property

\textsuperscript{320} Id. at 1093.
\textsuperscript{321} See supra text accompanying note 57.
\textsuperscript{322} Rosebud Sioux Tribal Court, 133 F.3d at 1087.
\textsuperscript{323} After reviewing the regimes of trademark, copyright, and right of publicity law, it is clear that cultural heritage claims do not fit neatly into any of these categories. This does not suggest that all claims of cultural appropriation are deserving of legal accommodation; however, valid claims could exist that have insufficient legal recourse. For example, if a recording company were to record songs performed in an indigenous ceremony, incorporate them into a popular culture song and profit from their use, the indigenous singers may have a difficult time mounting a successful legal battle. The proposed system of \textit{doma\i ne public payant} may step in to protect works that have slipped into this gray area that lies between the public and private domains.
\textsuperscript{324} If legislators were to develop an overbroad scheme to protect cultural heritage it would drain the public domain, robbing creators of useful ideas and inspiration.
system\textsuperscript{325} is vulnerable to misuse and deserves protection.\textsuperscript{326} Therefore, a novel compromise\textsuperscript{327} is necessary to accommodate this unique sector of cultural heritage.

A. Domaine Public Payant Defined

A system of \textit{domaine public payant}\textsuperscript{328} may be the answer to cultural heritage tug of wars. In this system, the state is the guardian of its own cultural heritage.\textsuperscript{329} It acts as the liaison between indigenous groups that supply the cultural heritage and the end-users of that knowledge.\textsuperscript{330} One author defines \textit{domaine public payant} as:

\begin{quote}
[A] legislative scheme that imposes a fee for the use or economic exploitation of works in the public domain. Funds received are funneled into societies that provide for the welfare of creative workers and their families or into state administrative agencies for the promotion of cultural activities and exchange.\textsuperscript{331}
\end{quote}

\textsuperscript{325} Defining which types of works would be eligible for inclusion into a \textit{domaine public payant} system must be left to each state to determine. One route is to include only works that once had copyright protection, but which has now expired. If the work could be deemed cultural heritage, it would be eligible for inclusion. However, this avenue would exclude much of the work highlighted in this Comment, such as folklore. While developing standards for inclusion into a \textit{domaine public payant} system, the state must assess its own goals and identify how best to preserve its own cultural heritage.

\textsuperscript{326} The cultural heritage that would be eligible for inclusion in the \textit{domaine public payant} system would not be eligible for protection under other U.S. intellectual property regimes. If it were, there would be no logical need of this new form of protection. Examples of eligible works might include folklore, the performance of sacred ceremonies, and ancient tribal chants. As discussed in this Comment, these elements of indigenous oral cultures often fail to meet standards for protection under traditional intellectual property laws; therefore, they would benefit from another form of compromised protection.

\textsuperscript{327} It is necessary to note that this proposed system of \textit{domaine public payant} is a true compromise in the sense that neither side will be completely content with the result. Successful compromises give each side in a debate something of what they ask for, but also refuses something else. In this instance, indigenous groups may desire, foremost, to completely exclude their cultural heritage from the commercial realm. Compensation may not even be an issue. On the other hand, commercial users want unfettered access to this cultural heritage. The compromise of \textit{domaine public payant} offers indigenous groups the promise of only partial control over their cultural heritage and minimal compensation (even if compensation was not their main objective). In turn, it offers commercial users limited access to the cultural heritage, yet requires them to pay a fee they would like to avoid.

\textsuperscript{328} See Cathryn A. Berryman, \textit{Toward More Universal Protection of Intangible Cultural Property}, 1 J. INTEL. PROP. L. 293, 307-08 (1994). The author proposes a system to protect works of cultural heritage based on the legal rubric of \textit{domaine public payant} in which the state acts as the guardian of its own cultural heritage.

\textsuperscript{329} Perhaps the state could inherit these works after copyright protection expires.

\textsuperscript{330} See Berryman, \textit{supra} note 328 and accompanying text. Internationally, some states have introduced this system to monitor the movement and use of physical cultural property. This notion, the author argues, could protect the integrity of intangible cultural property as well.

\textsuperscript{331} See \textit{id.} at 307-08. This author was forward thinking in her solutions for claims of cultural heritage appropriation. Note that this article was published in 1994, well before the widely publicized debate over the REDSKINS trademark or the Maori/LEGO dispute at issue.
This system protects cultural heritage while simultaneously allowing controlled access to valuable cultural works and knowledge.

*Domaine public payant* is analogous to a library in which cultural heritage is shelved. Patrons may browse indefinitely, looking through all of the information stored there. If one chooses to "borrow" a specific work he must: (1) pay a reasonable fee; (2) keep it in good condition; and (3) return it for others to use after him. Described below is a detailed discussion developing the benefits of each of these three elements of the system and how *domaine public payant* could have been utilized in the Maori/LEGO debate.

1. **Fee Schemes**

A system of set, compulsory fees provides valuable funding to indigenous communities and cultural organizations. This ensures that the cycle of creativity continues. It also establishes fair practice in which all who wish to use the cultural heritage have equal access to it.\(^3^3^2\)

The typical fee structures available under a *domaine public payant* system vary. Charges may (1) be either perpetual or limited in duration; (2) vary depending on the type of work; and (3) apply to foreign works housed in a state's public domain.\(^3^3^3\) This flexibility in fee structures allows a state to tailor its own scheme to best serve its unique needs and preference.

In the case of the Maori/LEGO dispute, a fee structure would have benefited both groups. Currently, the Maori have not been monetarily compensated for LEGO's use of the Maori elements in the Bionicle game. A mandatory fee structure would have ensured that the Maori community receive some funding when LEGO "borrowed" elements of their culture, provided the language would even be eligible for inclusion into a *domaine public payant* system.\(^3^3^6\)

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332. Granted, it is usually less of a burden for a corporation to dole out payment than it is for the struggling artist. Perhaps the fee structure could reflect this inequity in wealth of the applicants. Or, it could base fees on a royalty basis, charging those who make money off of the work a higher price.

333. See id. at 308.

334. In this Comment, "state" refers to a body and can include a nation, a group of United Nations, or singular territories.

335. It is important to note that the Maori cannot be classified simply as a homogenous group. Different tribes exist under the Maori umbrella and all represent different interests. The Maori often disagree among themselves, placing importance on different issues. Perhaps, this division of interests is what has hampered the drafting of the Guidelines for the Use of Traditional Knowledge proposed by LEGO.

336. See Christine Haight Farley, *Protecting Folklore of Indigenous Peoples: Is Intellectual Property the Answer?*, 30 CONN. L. REV. 1, 49-50 (1997). Farley explains the difference between public domain systems, which only protect works that would have been eligible for copyright
2. Preservation of the Work's Integrity

Beyond a desire for compensation, guardians and creators of traditional knowledge probably fear that unchecked use may result in its mutilation or alteration. This is at the heart of many debates over the use (or misuse) of traditional knowledge. A domaine public payant system contains safeguards against this by instituting guidelines for use. Returning to the library analogy, patrons cannot deface, alter, or damage a book and expect to return it to the library with no consequence. To protect against such violations, domaine public payant systems impose sanctions when necessary.\(^{337}\) Cathryn Berryman deftly illustrates the purpose and effectiveness of sanctions:

To avoid stifling any creativity or distribution, public domain legislation strikes a balance between freedom of use and preservation of integrity. Sanctions are imposed only on those uses that violate the work's essence, cultural value, or reputation. Thus, modern adaptations, translations, or republications are allowed as long as the work's character is maintained.\(^{338}\)

This type of perpetual protection for a work's integrity reflects a system of moral rights,\(^{339}\) which protect creators' rights of paternity

\(^{337}\) See Berryman, supra note 328, at 304.

\(^{338}\) See id. at 304-05.

\(^{339}\) Dreyfuss & Kwall, supra note 25 (laying out an in-depth discussion of the history, development, and benefits of a moral rights system). See also Roberta Rosenthal Kwall, Preserving Personality and Reputational Interests of Constructed Personas Through Moral Rights: A
and integrity even after the tangible or intangible rights to the work have been assigned. In the United States, moral rights protection has been extended to creators of visual art only; other artists do not enjoy this reputational control.


§ 106A. Rights of certain authors to attribution and integrity

(a) Rights of attribution and integrity. Subject to section 107 and independent of the exclusive rights provided in section 106, the author of a work of visual art—

(1) shall have the right—

(A) to claim authorship of that work, and

(B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create;

(2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and

(3) subject to the limitations set forth in section 113(d), shall have the right—

(A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and

(B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.

(b) Scope and exercise of rights. Only the author of a work of visual art has the rights conferred by subsection (a) in that work, whether or not the author is the copyright owner. The authors of a joint work of visual art are coowners of the rights conferred by subsection (a) in that work.

(e) Transfer and waiver.

(1) The rights conferred by subsection (a) may not be transferred, but those rights may be waived if the author expressly agrees to such waiver in a written instrument signed by the author. Such instrument shall specifically identify the work, and uses of that work, to which the waiver applies, and the waiver shall apply only to the work and uses so identified. In the case of a joint work prepared by two or more authors, a waiver of rights under this paragraph made by one such author waives such rights for all such authors.

(2) Ownership of the rights conferred by subsection (a) with respect to a work of visual art is distinct from ownership of any copy of that work, or of a copyright or any exclusive right under a copyright in that work. Transfer of ownership of any copy of a work of visual art, or of a copyright or any exclusive right under a copyright, shall not constitute a waiver of the rights conferred by subsection (a). Except as may otherwise be agreed by the author in a written instrument signed by the author, a waiver of the rights conferred by subsection (a) with respect to a work of visual art shall not constitute a transfer of ownership of any copy of that work, or of ownership of a copyright or of any exclusive right under a copyright in that work.

Id.

341. 3 Nimmer & Nimmer, supra note 111, §8D.01. Nimmer outlines the basics of moral rights and the doctrine's French origins succinctly in his treatise:

§ 8D.01 Introduction

A—Types of Moral Rights
The United States has very limited moral rights protection for creators because the American construction of intellectual property is still too narrowly tied to the notion of physical property law. Ownership and disposition are fundamental to tangible property. Once you sell property you lose all rights to it. A system of moral rights allows a creator to dispose of the intellectual property through a license or a transfer, yet he maintains assurances that his work cannot be altered inappropriately. Necessarily, a transferee's rights are limited within a system of moral rights. This element of the domaine public payant system could make this option unattractive to legislators intent on fit-

Certain countries of the world have long recognized rights personal to authors, and as such viable separate and apart from the economic aspect of copyright. Their separate viability is such that a full transfer of copyright may suffice for all economic purposes, but may exert no impact on the assertion of these claims. In France, home country to the doctrine, these rights are known as le droit moral, or moral rights. "The adjective 'moral' has no precise English equivalent, although 'spiritual', 'non-economic' and 'personal'convey something of the intended meaning."

It is beyond the scope of this treatise to treat moral rights under the laws of their European homelands. Some may overlap others, and perhaps no country affords every conceivable species of moral right. In brief, the following summary encompasses the various rights that can be grouped together under this rubric. First, there are numerous variations on the attribution right (droit au respect du nom; also, droit a la paternite):

- the right to be known as the author of his work;
- the right to prevent others from falsely attributing to him the authorship of a work that he has not in fact written;
- the right to publish a work anonymously or pseudonymously, as well as the right to change his mind at a later date and claim authorship under his own name;
- the right to prevent others from using the work or the author's name in such a way as to reflect adversely on his professional standing.

In addition, there are several distinct categories that comprise the classic droit moral:

- the right to prevent others from making deforming changes in his work (droit au respect de l'oeuvre);
- the right to publish a work, or to withhold it from dissemination (droit de divulgation); and
- the right to withdraw a published work from distribution if it no longer represents the views of the author (droit de retrait; also, droit de repentir).

Under French law, the moral right is conceived as perpetual, inalienable, and impre-scribable. In theory, therefore, even today in France, an outrageous stage or film version of Le Medecin Malgre Lui could be challenged and subjected to the full range of sanctions for violation of the moral right. Moreover, even if Moliere's line has long since expired in the three centuries since that play was penned, the French state might still be able to protect the integrity right under a parens patriae (emphasis in original) theory.

Id.
ting the square peg of intellectual property into the round hole of real property law.

Nevertheless, if the United States employed this system, the Maori could be certain that any traditional knowledge within the domaine public payant would preserve its integrity. Perhaps LEGO would have been precluded from using the sacred Tohunga name to signify a plastic toy that the Maori found offensive.342

3. Nonexclusive Rights to the Cultural Heritage

Again returning to our library analogy, a user must return the book so others may borrow it after him. In the realm of intellectual property, it is impossible to steal away a nonphysical work, however, this "return" concept translates to intangible property because domaine public payant structures require that all potential users have access to the work. No one user may exclude others from also using the work.343 Anyone has access to the traditional knowledge, subject to a fee and controls.

B. Domaine Public Payant as a Compromise

These three elements of a domaine public payant system, a fee structure, preservation of integrity, and open access to all, combine to create a reasonable, workable solution to disputes over cultural heritage. Through state control, both creators of intangible works of cultural value and their consumers can be assured of getting some of what they want. Creators, as a group, benefit by an injection of funding into local cultural programs and individual and group creators are assured the integrity of their work will be preserved. On the other side of the transaction, users gain access to valuable cultural works for a nominal price. This system does not foster a hyper-protective intellectual property environment, nor does it allow commercial users free reign to manipulate a state's precious cultural heritage. Domaine public payant is an intelligent compromise.


343. See Berryman, supra note 328, at 309. Berryman states that a copyright holder's rights effectively transfer to the state upon expiration. The scope of those rights changes, however. The guardian of the domaine public payant system allows non-exclusive rights to everyone who wishes to use the work and agrees to the regulations. In copyright law, an owner's rights include the ability to exclude others from infringing his work. Copyright Act, 17 U.S.C. § 106 (2000).
V. Conclusion

This Comment highlights a current trend in which indigenous groups challenge commercial users of cultural heritage. This form of dispute is exemplified by the Maori demands that LEGO purge its Bionicle game of Maori language and history. Review of the current U.S. intellectual property regimes of trademark, copyright, and right of publicity reveals that the Maori's claims would likely fail because language and bits of history are not protectable intellectual property. Currently, they belong in the public domain, free for all to use.

Yet, legitimate disputes surrounding cultural heritage do exist. Indigenous groups with valid claims are handicapped by an inflexible system of U.S. intellectual property laws that cannot accommodate the unique nature of traditional knowledge. In disputes that include relevant claims of cultural heritage appropriation, such as the theft of sacred chants or folklore or the manipulation of sacred imagery, U.S. law is inadequate. States have a vested interest in protecting their cultural heritage and should legislate to provide a system to do so.

_Domaine public payant_, a system in which the state regulates the transactions of traditional knowledge between creators and users, facilitates the needs of all interested parties. Creators receive limited control over how the cultural heritage is used and indirect funding while users have access to a vast pool of inspiration. _Domaine public payant_ simultaneously protects cultural integrity while fueling creation. The United States should adopt this legal structure.

VI. Addendum: Harjo v. Pro-Football, Inc. Reversed

This Comment refers throughout to the TTAB's 1999 decision in _Harjo_, which led to the cancellation of several trademarks owned by Pro-Football, Inc. In September 2003, the United States District Court for the District of Columbia reversed _Harjo_. The district court reviewed whether the trademarks at issue, when used in the con-

344. See Press Release, New Zealand's Intellectual Property Concerns (May 1, 2003), available at http://www.scoop.co.nz/mason/stories/po0305/500012.htm (last visited Nov. 15, 2003). This release announces Maori opposition to Sony's use of Maori imagery, names, and sacred tools in its ultra-violent video game, "The Mark of the Kri." The press release quotes the Maori man behind this new cultural heritage protection campaign: "Sony have 'hitched a ride' on New Zealand's heritage with absolutely no concern or respect for New Zealand Maori ...." _Id_. This Maori opposition to Sony's use of cultural heritage in a violent video game differs from Maori complaints against LEGO; indeed the facts are different and raise varying issues. This is evidence that the trend towards litigation in the cultural heritage arena continues to gain momentum.


text of Pro-Football's services, "may disparage a substantial composite of Native Americans." According to the court, the marks must have been found to be offensive when they were registered in 1967.

The court held that the TTAB's evidentiary findings did not constitute the "substantial evidence" necessary to support its decision that the REDSKINS trademarks "were disparaging to a substantial composite of Native Americans." In its opinion, the court reiterates that its findings are based solely on a lack of evidence and that the decision should not be considered a comment on the issue of using Native American imagery for sports teams. The defendants, led by Suzan Shown Harjo, have filed an appeal.

Sarah La Voi*

347. Id. at 139.
348. Id.
349. Id.
350. Id.

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