

No. 18-615

In the Supreme Court of the United States

BRUCE MUNRO AND BRUCE MUNRO STUDIO,
Petitioners,

v.

LUCY ACTIVEWEAR, INC., LUCY APPAREL, LLC,
VF OUTDOOR, INC., AND VF CORPORATION,
Respondents.

On Petition For a Writ of Certiorari
To The United States Court of Appeals
For The Eighth Circuit

**RESPONDENTS' BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

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OPINION BELOW

The opinion of the court of appeals is not reported, but is reproduced at Pet. App. 1a-14a. The memorandum opinion and order of the district court also is not reported, but is reproduced at Pet. App. 15a-45a.

JURISDICTION

The court of appeals entered judgment on August 9, 2018. The petition for a writ of certiorari was filed on November 7, 2018. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

Petitioners Bruce Munro and Bruce Munro Studios create artistic light installations by placing lights on sticks outdoors. *See* Pet. App. 61a-62a (photos showing examples of Petitioners' light installations). Petitioners use the titles "field of light" and "forest of light" to identify their light installations.¹ *See, e.g.*, Pet. App. 2a. Each installation is different. *See* Pet. App. 61a-62a. According to Petitioners, they own protectable trade dress in light displays that contain the following features:

¹ Petitioners improperly use the ® registered trademark symbol with the name "Field of Light" in their petition (*see, e.g.*, Petition 1-2) because Petitioners do not have a U.S. federal trademark registration for "Field of Light."

- (1) an outdoor exhibit;
- (2) of large scale;
- (3) a light-based design;
- (4) thousands of short, end-lighted stems or stalks;
- (5) in an array;
- (6) arranged upon a predominately green space;
- (7) positioned off-kilter or splayed from the perpendicular; and
- (8) topped with variably lit bulbs.

See Pet. App. 62a, ¶ 22.

In 2013, Respondents hosted a free, one-time event promoting fitness and the Lucy® brand of women's athletic apparel. *See Pet. App. 74a-75a.* The event included lights on sticks along the Charles River in Boston. *See id.* Two years later, Petitioners filed a lawsuit against Respondents, alleging that the event infringed Petitioners' alleged trademarks and trade dress and usurped a prospective business opportunity. *See Pet. App. 3a.* Notably, Petitioners chose not to assert any copyright claims against Respondents. *See Petition 3.*

The district court granted Respondents' motion to dismiss and denied Petitioners' motion for leave to amend their complaint. *See Pet. App. 15a-*

45a. With respect to the trade dress claim at issue in the pending petition for writ of certiorari, the district court found that “to the extent Munro bases his claim on the similar style of exhibit,” his claim fails because “[t]he Lanham Act does not protect the content of a creative work of artistic expression.” Pet. App. 27a (internal quotations and citations omitted). The district court further held that Munro’s claims fail because “the light display is the good itself, rather than a mark on the good.” Pet. App. 29a. Finally, the district court explained that “when dealing with artistic works, courts have been wary to extend trademark protection over works properly the subject of copyright law,” and found that “extending trademark protection to a particular style of artistic expression would improperly extend trademark law into the area of copyright protection.” Pet. App. 28a-29a. The district court dismissed Petitioners’ trade dress claim with prejudice. *See* Pet. App. 44a.

The Eighth Circuit affirmed, holding that:

Munro asserts that Lucy created a “knockoff” light installation that basically plagiarized his creative designs. Copyright law, not trademark law, protects Munro’s creative works. As the district court found, Munro’s installation is not a “mark” that the Lanham Act was attempting to protect. Rather, the installation is the product itself. Because the light installation is the product, not a mark, and because

copyright, not trademark, protects artistic and creative ideas and concepts, *see Dastar*, 539 U.S. at 37, Munro's claim does not properly fall under the Lanham Act.

Pet. App. 7a.

REASONS FOR DENYING THE WRIT

Petitioners misconstrue the facts, procedural history, and relevant case law to argue that compelling reasons warrant a grant of their petition. To the contrary, there are several reasons to deny the petition.

I. Petitioners misconstrue the lower courts' decisions.

Contrary to Petitioners' argument, the lower courts applied the unremarkable and non-controversial principle that the Lanham Act does not protect ideas or works of art. The lower courts did not, as Petitioners imply, find that federal copyright law preempts federal trademark law. Instead, the lower courts found that Petitioners' alleged trade dress does not serve as a source-identifier for any good or service and, accordingly, is not protected by the Lanham Act. *See* Pet. App. 1a-45a. The lower courts did not base their decisions on a finding of preemption. *See id.*

Petitioners' other arguments regarding purported errors in the lower courts' decisions also fail. First, the lower courts' alleged failure to

separately address Petitioners' trade dress dilution claim is not a sufficient reason to review this case. Because the lower courts determined that Petitioners' alleged trade dress was not protected by the Lanham Act, all of Petitioners' claims under that statute necessarily fail, including their dilution claim. Second, Petitioners' argument that the lower courts misapplied this Court's holding in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) lacks merit. Finally, the lower courts' decisions that Petitioners could not obtain trade dress protection for a product itself are well-supported. Petitioners are incorrect in their assertion that this Court's decision in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000) requires a contrary result. *Wal-Mart* considered trade dress protection for the design of clothing, not the article of clothing itself. Here, as discussed below, Petitioners seek trade dress protection for the idea of a light installation using lights on sticks, not the design of any underlying product.

II. Petitioners are attempting to obtain trade dress protection for an artistic work, not the design of a product.

Petitioners frame the question presented as one concerning the boundaries of trademark and copyright protection for "product design trade dress." *See Petition.* However, Petitioners are not claiming trade dress protection over a distinctive design of a product, but rather a genre of art. Indeed, Petitioners' self-defined "trade dress" broadly covers

outdoor light displays that incorporate lights on sticks regardless of size, shape, color, height, brightness or placement of the lights. *See* Pet. App. 62a, ¶ 22 (Petitioners defining their alleged trade dress as “(1) an outdoor exhibit; (2) of large scale; (3) a light-based design; (4) thousands of short, end-lighted stems or ‘stalks’; (5) in an array; (6) arranged upon a predominately green space; (7) positioned off-kilter or splayed from the perpendicular; and (8) topped with variably lit bulbs.”).

Granting protection for this alleged trade dress would allow Petitioners to monopolize the artistic idea of displaying lights on sticks outdoors. This is not the intent of the Lanham Act, which is meant to prevent consumer confusion regarding the source of products or services. *See, e.g., EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopoulos, Inc.*, 228 F.3d 56, 63 (2d Cir. 2000) (“Trademark law is concerned with protection of the symbols, elements or devices used to identify a product in the marketplace and to prevent confusion as to source.”)

Furthermore, Petitioners’ light installations vary from display to display and therefore are not a uniform, consistent “product design” capable of obtaining secondary meaning.

The cases Petitioners cite do not support their argument. In every case cited by Petitioners, the alleged trade dress was distinct from the product itself and therefore had the ability to identify the source of the product. *See, e.g., Ashley Furniture*

Indus., Inc. v. Sangiacomo N.A., Ltd., 187 F.3d 363 (4th Cir. 1999) (trade dress protection for a neo-Roman design of bedroom furniture); *Gurglepot, Inc. v. New Shreve, Crump & Low LLC*, 153 F. Supp. 3d 441 (D. Mass. 2015) (trade dress protection for fish design of pitcher); *Mercado Latino, Inc. v. Indio Prods., Inc.*, 649 Fed. Appx. 633 (9th Cir. 2016) (trade dress protection for design of candles consisting of religious images). In sharp contrast to the cases they rely on, Petitioners cannot identify any product that their purported trade dress identifies. To the contrary, as the lower courts pointed out, Petitioners' alleged trade dress is the product itself, not a unique, uniform, and consistent symbol that identifies Petitioners as the source of a product.

Petitioners' light installations are artistic works protected, if at all, under copyright law, not the Lanham Act.

III. The Lanham Act should not be used to create a species of perpetual copyright protection.

Courts have long held that trademark law should not be used to provide perpetual protection for artistic works.

In *Dastar*, this Court explained that "in construing the Lanham Act, we have been careful to caution against misuse or over-extension of trademark and related protections into areas traditionally occupied by patent or copyright." 539 U.S. at 34 (internal quotations and citation omitted). This Court went on to state that "reading § 43(a) of

the Lanham Act as creating a cause of action for, in effect plagiarism – the use of otherwise unprotected works and inventions without attribution – would be hard to reconcile with our previous decisions.” *Id.* at 36.

Likewise, in *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001), this Court explained that “[t]rade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.” Furthermore, the Court noted that “[t]he Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.” *Id.* at 34.

Lower court decisions are consistent. *See, e.g., Kehoe Component Sales Inc. v. Beast Lighting Prods., Inc.*, 796 F.3d 576, 586-87 (6th Cir. 2015) (explaining that “the Lanham Act protects the ability to control one’s brand; it does not protect the ability to control one’s inventions or innovations”); *Stolle Mach. Co., LLC v. RAM Precision Indus.*, 605 Fed. Appx. 473, 482 (6th Cir. 2015) (“Taking tangible goods and reselling them as your own constitutes a Lanham Act violation; taking the intellectual property contained in those goods and incorporating it into your own goods does not.”); *EMI*, 228 F.3d at 63 (“Trademark law … does not protect the content of a creative work of artistic expression as a trademark for itself. Copyright law protects the

artist's right in an abstract design or other creative work.") (citations omitted).

Petitioners are attempting to do precisely what is prohibited by these cases – obtain through trade dress protection a perpetual copyright in the artistic concept of displaying lights on sticks outdoors. This Court should not allow Petitioners to do so.

IV. The Court's prior cases are not in conflict.

Petitioners incorrectly imply that this Court's decisions in *Dastar* and *Traffix* conflict. In *Dastar*, the petitioner "took a creative work in the public domain – the Crusade television series – copied it, made modifications (arguably minor), and produced its very own series of videotapes." 539 U.S. at 31. This Court construed the phrase "origin of the goods" in the Lanham Act and explained that

reading the phrase ... in accordance with the Act's common-law foundations (which were *not* designed to protect originality or creativity), and in light of the copyright and patent laws (which *were*), we conclude that the phrase refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods.

Id. at 37 (emphasis in original). Thus, the Lanham Act did not prevent the petitioner from unaccredited

copying of an uncopyrighted work. *See id.* According to this Court, “[t]o hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do.” *Id.* (citation omitted).

In *Traffix*, this Court considered whether a party can be liable for trade dress infringement for copying aspects of a product that had been patented after the patent expired. *See* 532 U.S. 23. The Court held that the claimed trade dress – a dual-spring design – was functional and therefore could not serve as a trademark. *See id.* at 32-33.

Dastar and *Traffix* considered two distinct issues. Even so, both cases recognize the danger in extending trademark law in a manner that would provide perpetual copyright or patent protection for artistic works or inventions. Furthermore, nothing in *Dastar* or the lower courts’ application of its holding in this dispute suggests, as Petitioners argue, that trade dress that qualifies for protection under the Lanham Act would be denied such protection if it was also protected by copyright. To the contrary, as discussed above, the lower courts simply found that Petitioners’ claimed trade dress does not serve a source-identifying function as is required for protection under the Lanham Act.

V. This is not the case in which to resolve any alleged conflicts in federal court decisions.

The Court should also deny certiorari because this case is not the appropriate vehicle to resolve any perceived conflict among the Circuits regarding

product design trade dress and the intersection of copyright and trademark law relating thereto. As explained above, Petitioners are not attempting to obtain trade dress protection over a “product design” capable of obtaining secondary meaning. Instead, Petitioners are seeking trade dress protection for works of artistic expression. It is well-established that such works are protected, if at all, under copyright law, not trademark law. Thus, to the extent there is a conflict regarding the scope of protection for product design trade dress, this is not the appropriate case to resolve it.

CONCLUSION

The petition for writ of certiorari should be denied.

RESPECTFULLY SUBMITTED,

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December 12, 2018