

# TAKING A MULLIGAN: MORAL RIGHTS AND THE ART OF GOLF COURSE DESIGN

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*I believe in reverencing anything in the life of man which has the testimony of the ages as being unexcelled, whether it be literature, paintings, poetry, tombs—even a golf hole.*

C.B. MACDONALD<sup>1</sup>

## INTRODUCTION

Recent surveys suggest that people from vastly different backgrounds and diverse cultures share a vision of what is considered a beautiful landscape.<sup>2</sup> The most common ideal is a view from a high lookout which overlooks open

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<sup>1</sup> GEOFF SHACKELFORD, *GROUNDS FOR GOLF: THE HISTORY AND FUNDAMENTALS OF GOLF COURSE DESIGN* xi (2003) [hereinafter SHACKELFORD, *GROUNDS FOR GOLF*] (quoting C.B. Macdonald). Golf historians consider Charles Blair Macdonald the "Father of American Golf Course Architecture." GEOFFREY S. CORNISH & RONALD E. WHITTEN, *THE ARCHITECTS OF GOLF: A SURVEY OF GOLF DESIGN FROM ITS BEGINNINGS TO THE PRESENT, WITH AN ENCYCLOPEDIA LISTING OF GOLF COURSE ARCHITECTS AND THEIR COURSES* 330 (1993). Macdonald is credited with building the first eighteen-hole golf course in the United States, coining the title "golf architect," and is a founder of the United States Golf Association. *Id.* at 330; see also GEOFF SHACKELFORD, *THE GOLDEN AGE OF GOLF DESIGN* 32–42 (Wiley, John & Sons, Inc. 2005) (1999) [hereinafter SHACKELFORD, *GOLDEN AGE OF GOLF DESIGN*] (discussing Macdonald's many accomplishments).

<sup>2</sup> John Tierney, Op-Ed., *The Golf Gene*, N.Y. TIMES, Aug. 20, 2005, at A13.

grassland, scattered trees, and a body of water, much like eighteenth-century English landscape art, or perhaps even more precise—the view from a golf tee.<sup>3</sup> In fact, some believe the golf course architect<sup>4</sup> is able to bring to life this primeval notion of a worldly paradise more than any other artist.<sup>5</sup> Ironically, in order to create such a natural looking and well-crafted design, top golf architects can spend well over \$10 million per course artificially constructing and shaping the earth.<sup>6</sup> In recent years, the publication of countless coffee-table books, calendars, and televised professional golf tours have begun to showcase the incredible artistry, creativity, and discipline involved in designing and constructing a golf course. This has had the effect of making household names out of not only living golf course architects, but even long-forgotten, early twentieth-century architects as well.<sup>7</sup> Some golf architecture enthusiasts are even so familiar with the styles of golf course designers that they can identify a course's designer from an airplane.<sup>8</sup> In fact, many top golf course architects use unique design characteristics and qualities to signal to the golfer the distinct process and artistic philosophy behind their work.<sup>9</sup> And now that magazine rankings and golf clubs prominently tout the club's architect as an indication of superior course design, the name or endorsement behind a golf course can significantly enhance the value of a particular course.<sup>10</sup> Consequently, an architect's rights of

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<sup>3</sup> Steve Sailer, *From Bauhaus to Golf Course: The Rise, Fall, and Revival of the Art of Golf Course Architecture*, THE AMERICAN CONSERVATIVE (Apr. 11, 2005), available at [http://www.isteve.com/golf\\_art.htm](http://www.isteve.com/golf_art.htm).

<sup>4</sup> For purposes of this article, the terms “architect” and “designer” are used interchangeably.

<sup>5</sup> See Sailer, *supra* note 3, at 1. (comparing golf course architects to artists).

<sup>6</sup> *Id.*

<sup>7</sup> Bill Pennington, *Forgotten Architects, Timeless Courses*, N.Y. TIMES, Aug. 4, 2008, at D5 (noting that Ross, Alister MacKenzie, and A.W. Tillinghast are a few of the golf course architects from the twentieth century that remain icons today).

<sup>8</sup> Sailer, *supra* note 3.

<sup>9</sup> *Compare Design Philosophy*, Dye Designs, <http://dyedesigns.com/golf/company/design-philosophy/> (last visited Oct. 14, 2010) (claiming that the philosophy behind Pete Dye's work is to accommodate a wide variety of golfers using a five-tee system to provide a variety of lengths on each hole, wider fairways, and generously sized greens), *with Design Philosophy*, Robert Trent Jones II Golf Course Architects, [http://www.rtj2.com/index.php?option=com\\_content&task=view &id=104&Itemid=57](http://www.rtj2.com/index.php?option=com_content&task=view&id=104&Itemid=57) (last visited Oct. 14, 2010) (claiming that the Robert Trent Jones's design philosophy is to make every project site specific so that each course is recognizable for its suitability to the original landscape and climate in which it is set).

<sup>10</sup> *E.g.*, *Nicklaus Design Overview*, Nicklaus Design, <http://www.nicklaus.com/design/overview.php> (last visited Oct. 14, 2010) (stating that in addition to impacting membership fees, annual dues, and greens fees, “communities that feature a Jack Nicklaus-designed golf course as an amenity have resulted in the highest real estate

integrity and attribution are directly at stake when a course claims to feature copies of a famous designer's work.

Despite widespread recognition of golf course design as innovative and creative work, current American intellectual property law offers weak protection to the golf course architect.<sup>11</sup> Unlike the works of traditional artists or architects, which are protected by the Copyright Act, a completed golf course is free to be replicated without the authorization of the designer.<sup>12</sup> Golf courses are not treated as “works of art” under traditional copyright law and are further excluded from the definition of “architectural works” within the Architectural Works Copyright Protection Act.<sup>13</sup> While some have argued that the Copyright Act should simply be modified to extend protection to course designers,<sup>14</sup> the real issue in protecting golf course design has more to do with promotion of the work to the public as a copy, rather than whether actual copying has occurred. This is because a potential developer would not undertake the considerable time and substantial expense in replicating the design of an esteemed golf course architect if he or she did not intend to promote the hole as a replica or pay homage to that designer. Nor would the average golfer be able to recognize a replica without a strong cue from the course developer. Thus, it appears that the key to stealing a golf course designer's original work actually lies in the promotion of the design as a replica or in purporting to feature copies of the work of a famous designer. Therefore, the remedy points away from copyright law and towards the unfair competition provisions of the Lanham Act and rights of publicity.

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value, the highest average home price, and the greatest velocity of home and lot sales”); *Ask the Architect*, Golf Course Home, <http://golfcoursehome.net/doc/communities/Community-architect.htm#Effect> (last visited Oct. 14, 2010) (stating that the name behind a golf course will inevitably enhance the value of a golf course development); see SHACKELFORD, *GROUNDS FOR GOLF*, *supra* note 1, at 145–46 (noting that it has become “a modern American pastime to tout” the name attached to a golf course regardless of how involved that architect actually was in the development of the course).

<sup>11</sup> Robert D. Howell, *Tee'd Off—Golf Course Designers Score Double Bogey in Search for Protection of Their Hole Designs*, 5 J. INTELL. PROP. L. 337, 343 (1997) (“The courses’ artistic nature is reflected in their beauty and design . . . . Classification as a form of ‘art’, however, does little to advance a golf hole’s chances of achieving copyrightability . . . .”).

<sup>12</sup> John S. Saroff, *Putting Intellectual Property Law on the Fairway: Toward an Expansion of Copyright Law to Golf Course Architecture*, 28 COLUM. J.L. & ARTS 379, 388 (2005) (“Under current regimes, golf course architects cannot seek protection for their designs under any section of the Copyright Act.”).

<sup>13</sup> *See id.* at 387–88.

<sup>14</sup> *Id.* at 391 (arguing to expand the definition of “Architectural Work” in section 101 of the Copyright Act to specifically include golf courses).

This article will argue that from a practical standpoint, golf course designers are able to obtain protection for their work under classic Continental moral rights.<sup>15</sup> As the entire business value of an endorsed golf course design comes from controlling the moral right of attribution, false designation of origin in the design of a course by a third party is undoubtedly actionable under section 43(a) of the Lanham Act.<sup>16</sup> Part I will briefly explore the history of golf course design and the development of the profession known as the golf course architect. In particular, this section will illustrate the progression of golf course architecture from a profession guided primarily by utilitarian considerations and existing land features to one employing innovative skill driven predominantly by artistic considerations and framing. Part II will discuss the current U.S. law relevant to protecting golf course designers' original work. Specifically, this section will consider the lack of protection afforded to golf course architects by existing copyright law, trade dress law,<sup>17</sup> and the impact, if any, of *Pebble Beach Co. v. Tour 18 I, Ltd.*<sup>18</sup> Part III will propose the importation of moral rights into

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<sup>15</sup> Moral rights are “rights personal to authors, and as such viable separate and apart from the economic aspect of copyright.” 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8D.01 (2009). These include:

[T]he 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 prevent others from being named as the author of his work; 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. . . . [Additionally, the author has] the right to prevent others from making deforming changes in his work.

*Id.*

<sup>16</sup> See 15 U.S.C. § 1125(a)(1) (2006) (stating a cause of action arises when “[a]ny person who . . . uses in commerce any word . . . or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . of such person with another person, or as to the origin, sponsorship, or approval . . . by another person”).

<sup>17</sup> “Trade dress” is defined as “[t]he overall appearance and image in the marketplace of a product or a commercial enterprise. For a product, trade dress typically comprises packaging and labeling. For an enterprise, it typically comprises design and décor. If a trade dress is distinctive and nonfunctional, it may be protected under trademark law.” BLACK’S LAW DICTIONARY 1530 (8th ed. 2004).

<sup>18</sup> 942 F. Supp. 1513, 1561 (S.D. Tex. 1996) (holding that plaintiff’s golf hole design with a view of a lighthouse was entitled to trade dress protection because it had acquired secondary meaning and there was a likelihood of confusion arising from defendant’s use of said design), *aff’d*, 155 F.3d 526 (5th Cir. 1998).

section 43(a) as the appropriate and practical remedy for golf course designers seeking protection of their original designs that have been replicated without authorization. This section will first consider the application of the Visual Artists Rights Act of 1990 (“VARA”),<sup>19</sup> and will then explore the effect of *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>20</sup> on the right of integrity under section 43(a). Finally, Part IV will apply this proposal directly to golf course design by distinguishing the facts of *Dastar* and by discussing the use of the “false advertising” prong of section 43(a) as a means of protecting the rights of attribution and integrity.

## I. FROM UTILITY TO ARTISTRY: A BRIEF HISTORY OF GOLF COURSE DESIGN

There was a time when the only designer for the sport of golf was Mother Nature herself.<sup>21</sup> There was no innovative design plan, no engineering, and certainly no such profession as the golf course architect. In fact, the first authentic golf course, the Old Course at St. Andrews, was formed not by man, but by sheep that grazed and hollowed out bunkers to provide shelter from the wind.<sup>22</sup> Dutch sailors at that time used sticks to whack pebbles as they made their way into town, “counting their ‘strokes’ as they went.”<sup>23</sup> There were no formal tees or fairways, and some believe that the earliest golfers used rabbit holes as putting cups.<sup>24</sup> The land—or golf course—was considered unsuitable for cultivation and “evolved naturally over several hundred years with [limited]

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<sup>19</sup> 17 U.S.C. § 106A (2006). In passing VARA, Congress provided for protection of artists’ “moral rights” for the first time under the Copyright Act. See generally 3 NIMMER, *supra* note 15, § 8D.06.

<sup>20</sup> 539 U.S. 23, 38 (2003) (holding that a videotape producer’s unaccredited copying of material from a public domain television series did not violate the Lanham Act prohibition against “reverse passing off”).

<sup>21</sup> See, e.g., LOUIS THOMAS STANLEY, A HISTORY OF GOLF 1 (1991) (describing how the earliest golf courses were “moulded and shaped by natural forces”).

<sup>22</sup> Denys Lémery, *Golf Course Architect, Between Art and Industry*, EUR. INST. OF GOLF COURSE ARCHITECTS Y.B. (2002–03), available at <http://www.eigca.org/Article/EIGCA11170.ink>. “Records indicate that [the Old Course at St. Andrews] existed in a primitive form as early as 1414.” CORNISH & WHITTEN, *supra* note 1, at 4; see also STANLEY, *supra* note 21, at 6 (“A primitive lay-out must have been in existence before [St. Andrews] University was founded in 1413.”).

<sup>23</sup> SHACKELFORD, GROUND FOR GOLF, *supra* note 1, at 16.

<sup>24</sup> CORNISH & WHITTEN, *supra* note 1, at 4.

assistance from man.”<sup>25</sup> Grazing sheep kept the playing field well clipped and rain showers from the sea kept the turf healthy and in good shape.<sup>26</sup>

The driving force behind the earliest golf course designs was that of complete naturalness—where the existing land completely dictated the design of the course.<sup>27</sup> Designers “worked around what nature left behind” and did not make any “major changes to the ground in order to accommodate” the game.<sup>28</sup> The first golf course architects merely used existing topography and often laid out an entire course in a day by using the natural landscape features as green and tee locations and as hazards.<sup>29</sup> In fact, the Old Course at St. Andrews did not undergo any significant change until the work of greens keeper Allan Robertson in 1848.<sup>30</sup> By reducing the number of holes from twenty-two to eighteen, widening the fairways, and creating smoother putting surfaces, Robertson began laying the foundation of what would become a more strategic style of golf course design.<sup>31</sup>

At the turn of the nineteenth century, golf course designers began to manufacture the land in order to construct more aesthetically pleasing courses.<sup>32</sup> Unlike their predecessors who embraced the charm of the existing land, a new set of golf course architects “sought to influence the land,” leaving behind their distinct handprint on the landscape.<sup>33</sup> This marked the beginning of altering the natural terrain where the game of golf no longer had to be tailored to the existing land.<sup>34</sup> These designers considered themselves innovators and refused to incorporate naturally existing elements such as roads or fences and instead “sought to place hazards where they saw fit.”<sup>35</sup> “Inspired by the Victorian tastes

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<sup>25</sup> SHACKELFORD, *GROUNDS FOR GOLF*, *supra* note 1, at 16; *see* CORNISH & WHITTEN, *supra* note 1, at 4.

<sup>26</sup> CORNISH & WHITTEN, *supra* note 1, at 4.

<sup>27</sup> SHACKELFORD, *GROUNDS FOR GOLF*, *supra* note 1, at 31.

<sup>28</sup> *Id.* at 32.

<sup>29</sup> CORNISH & WHITTEN, *supra* note 1, at 15; Ross McMurray, *St. Andrews and the Development of Strategic Golf Course Design*, EUR. INST. OF GOLF COURSE ARCHITECTS Y.B. (2003–04), available at <http://www.eigca.org/Article/EIGCA11130.ink>.

<sup>30</sup> CORNISH & WHITTEN, *supra* note 1, at 15; McMurray, *supra* note 29.

<sup>31</sup> CORNISH & WHITTEN, *supra* note 1, at 7, 13; McMurray, *supra* note 29.

<sup>32</sup> McMurray, *supra* note 29.

<sup>33</sup> SHACKELFORD, *GROUNDS FOR GOLF*, *supra* note 1, at 32.

<sup>34</sup> Lémery, *supra* note 22.

<sup>35</sup> SHACKELFORD, *GROUNDS FOR GOLF*, *supra* note 1, at 32. “Hazards” are any golf course features that may cause difficulty for the player, such as sand traps, water, trees, or boundaries. *Id.* at 12.

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of the era,” these architects would eliminate the natural and sometimes unpredictable elements out of golf for one of sheer geometric design.<sup>36</sup>

In the 1920s however, golfers became bored with the dull geometric style of golf courses that left the land with an artificial appearance.<sup>37</sup> Architects responded by altering their design objectives “to present options for the player to debate,” so that more daring play would be rewarded when executed skillfully.<sup>38</sup> Some golf historians consider this the most innovative period in American golf course architecture.<sup>39</sup> Aided by rapid economic expansion, this strategic golf course style thrived until the 1950s, when Robert Trent Jones<sup>40</sup> began to separate himself from the previous generation of architects by creating a distinctive “signature design.”<sup>41</sup> “Jones created the concept of the ‘heroic’ hole” that required players to make dramatic decisions with severe consequences for mistakes.<sup>42</sup> He employed large bunkers and created man-made lakes, something that had rarely been done before in golf course architecture.<sup>43</sup> Bulldozers invented for war now enabled golf course designers to “turn[] a piece of land upside down and create[] . . . cours[es] that [were absolutely] one of a kind.”<sup>44</sup> Barren agricultural land and rocky terrain that had rendered land unsuitable for a golf course was now easily “transformed into vast open green spaces.”<sup>45</sup>

Contemporary golf course architecture has taken more of a landscape-architecture approach, in which beauty and framing are given priority.<sup>46</sup> Designs today are influenced heavily by rankings in magazines, brand names, and the race to build the most expensive and lavish golf course.<sup>47</sup> Furthermore, tele-

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<sup>36</sup> See *id.* at 35.

<sup>37</sup> See *id.*

<sup>38</sup> See *id.* at 38.

<sup>39</sup> SHACKELFORD, *GOLDEN AGE OF GOLF DESIGN*, *supra* note 1, at 3.

<sup>40</sup> Robert Trent Jones was one of the most influential golf course architects in history. CORNISH & WHITTEN, *supra* note 1, at 113. “He was the first architect who expressly entered the field without having first trained in another profession . . .” *Id.* at 117. In fact, he “created his own major, golf architecture, while at Cornell University, taking classes he recognized would be imperative for [the] profession.” *Id.*

<sup>41</sup> SHACKELFORD, *GROUNDS FOR GOLF*, *supra* note 1, at 39.

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 41.

<sup>44</sup> Lémery, *supra* note 22.

<sup>45</sup> *Id.*

<sup>46</sup> SHACKELFORD, *GROUNDS FOR GOLF*, *supra* note 1, at 43.

<sup>47</sup> *Id.* at 55; see CORNISH & WHITTEN, *supra* note 1, at 162 (describing the attention Jack Nicklaus has received “because of his reported million-dollar-per-course design fee”).

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vision has greatly shaped the design and maintenance of golf courses.<sup>48</sup> The tremendous increase in the number of televised golf events has led to design features that are driven primarily by aesthetic considerations, such as adding color and beauty to the course, rather than functional ones.<sup>49</sup> Today's architects strive to create visually striking elements such as large, scenic, man-made lakes with contrasting white sand that will translate well onto television and color print.<sup>50</sup> Especially with the development of new technology and advanced machinery, architects have the ability and freedom to essentially build from scratch any golf course imaginable on any sort of geographical terrain.<sup>51</sup>

Unlike the "Golden Age" of golf course design, which was meant to test the mental strategy of a golfer's game, some believe today's courses are designed merely to serve as beautiful settings for golfers to play on soft, green turf.<sup>52</sup> Design choices appear to be made not because of any utilitarian functions of the game or for any strategic reason, but for sheer visual impact. For example, one of the most well-known contemporary designers, Jack Nicklaus,<sup>53</sup> is known "for the opulent look he demand[s] of all his courses," and for sparing no expense to achieve his ideal.<sup>54</sup> The designs of Tom Fazio,<sup>55</sup> which have been said to "capture[] the nation's imagination" are equally lavish.<sup>56</sup> In constructing Shadow Creek, an ultra-exclusive course that is said to have cost over \$37 mil-

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<sup>48</sup> SHACKELFORD, GROUND FOR GOLF, *supra* note 1, at 54.

<sup>49</sup> *Id.*

<sup>50</sup> *Id.*; see ROBERT MUIR GRAVES & GEOFFREY S. CORNISH, GOLF COURSE DESIGN 6 (1998) (discussing the creation of courses with "immense visual impact" during the modern era of course design).

<sup>51</sup> See CORNISH & WHITTEN, *supra* note 1, at 164 (describing how golf courses have been successfully integrated into hostile terrain such as an arid desert); Sailer, *supra* note 3 (discussing the ability of golf architects "to build from scratch any hole imaginable").

<sup>52</sup> SHACKELFORD, GOLDEN AGE OF GOLF DESIGN, *supra* note 1, at 3.

<sup>53</sup> Jack Nicklaus formed his own golf course architecture practice in 1974 and has since been known as a stickler for high design and maintenance standards. CORNISH & WHITTEN, *supra* note 1, at 350. His courses have received widespread attention and admiration, several of which are perennial sites on the PGA or Senior PGA Tours. *Id.*; see generally JACK NICKLAUS WITH CHRIS MILLARD, NICKLAUS BY DESIGN: GOLF COURSE STRATEGY AND ARCHITECTURE (2006).

<sup>54</sup> CORNISH & WHITTEN, *supra* note 1, at 164.

<sup>55</sup> Tom Fazio entered the business of golf course architecture as a teenager assisting his uncle, George Fazio. *Id.* at 255. He later became a full partner with his uncle, and their firm gradually became one of the nation's leading firms. *Id.* In the late 1980s, "Fazio was rated as the top golf architect in separate polls conducted by *Golf Course News* and *Golf Digest*." *Id.* at 256.

<sup>56</sup> *Id.* at 165.



lion, Fazio transplanted thousands of pine trees and sculpted the land down sixty feet in some areas and piled it up sixty feet in others.<sup>57</sup> The genius in the design, of course, is that while the course looks completely natural, “it [is] perhaps the least natural course ever created.”<sup>58</sup> The goal today appears to be more about building a course with eighteen holes that can each be the subject of spectacular photographs for a magazine advertisement or the front cover of a tournament program and much less about a strategic design that facilitates the sport of golf.<sup>59</sup>

## II. THE WEAK PROTECTION AFFORDED BY CURRENT U.S. INTELLECTUAL PROPERTY LAW

Despite the contemporary notion of golf course design as art, golf course architects are unable to seek protection for their innovative designs under current U.S. intellectual property regimes.<sup>60</sup> While the Copyright Act of 1976 purports to protect “original works of authorship fixed in any tangible medium of expression,” in order to qualify for protection the design aspects must not be characterized as utilitarian or useful.<sup>61</sup> This limitation on copyrightability by reason of utilitarian function is known as the “useful article” doctrine.<sup>62</sup> The Copyright Act defines useful articles as “having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>63</sup> A classic example of a court addressing the “useful article” doctrine is the case of *Brandir International, Inc. v. Cascade Pacific Lumber Co.*,<sup>64</sup> in which the manufacturer of a bicycle rack that was inspired by a sculpture brought copyright and trademark infringement actions against a competing manufacturer.<sup>65</sup> The court found that although the sculpture that inspired the bicycle rack was copyrightable, the rack itself was not copyrightable because it was “influenced in significant measure by utilitarian concerns and thus any aes-

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<sup>57</sup> CORNISH & WHITTEN, *supra* note 1, at 166.

<sup>58</sup> *Id.*

<sup>59</sup> See generally GEOFF SHACKELFORD, *THE FUTURE OF GOLF: HOW GOLF LOST ITS WAY AND HOW TO GET IT BACK* (Sasquatch Books 2005) (providing extensive discussion on the excessive commercialization of the sport of golf).

<sup>60</sup> Saroff, *supra* note 12, at 388–89.

<sup>61</sup> See Copyright Act of 1976, 17 U.S.C. § 102 (2006); *Baker v. Selden*, 101 U.S. 99, 105 (1879) (holding that if the purpose of the object is use, the appropriate mechanism to protect the creator’s interests is a patent).

<sup>62</sup> 1 NIMMER, *supra* note 15, § 2.18.

<sup>63</sup> 17 U.S.C. § 101 (2006).

<sup>64</sup> 834 F.2d 1142, 1145 (2d Cir. 1987).

<sup>65</sup> *Id.* at 1143.

thetic elements [could not] be said to be conceptually separable from [its] utilitarian elements.”<sup>66</sup> Thus, “[i]f design elements reflect a merger of aesthetic and functional considerations,” the work is not copyrightable.<sup>67</sup>

Similarly, because golf courses are created both for their aesthetic appearance and for facilitating the game of golf, golf courses are subject to the limitations imposed by the “useful article” doctrine. Like the bicycle rack in *Brandir*, it is nearly impossible to separate aspects of a course that were intended by the designer to be part of the strategic game design from those intended merely to enhance the aesthetics of the playing field.<sup>68</sup>

Golf courses are also unprotected as “architectural works” under the Architectural Works Copyright Protection Act (“AWCPA”).<sup>69</sup> An “architectural work” is defined as “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.”<sup>70</sup> The statutory reference to “building” includes non-habitable structures, such as churches, gazebos, and garden pavilions.<sup>71</sup> But protection for other three dimensional structures—such as creative works of landscape architecture—were deleted from the bill in order to preclude protection of highways, bridges, walkways, and other important elements of the transportation system.<sup>72</sup> Furthermore, protection has been limited to freestanding structures only, with courts finding the term “building” inapplicable to a structure-within-a-structure, such as a store within a mall.<sup>73</sup> As a result, unless a court was to contort the definition of “building” beyond its generally accepted limits, architects who

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<sup>66</sup> *Id.* at 1147.

<sup>67</sup> *Id.* at 1145.

<sup>68</sup> Saroff, *supra* note 12, at 387 (“Golf holes by their very definition, tradition and design are ‘useful articles,’ designed to facilitate the play of golf.”).

<sup>69</sup> Civil Justice Reform Act of 1990, Pub. L. No. 101-650, §§ 702–703, 104 Stat. 5089, 5133 (2000) (current version at 17 U.S.C. § 102(a)(8) (2006)).

<sup>70</sup> 17 U.S.C. § 101 (2006).

<sup>71</sup> 37 CFR § 202.11(b)(2) (2010).

<sup>72</sup> H.R. REP. NO. 101-735, at 18 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6950–51.

<sup>73</sup> *Yankee Candle Co. v. New England Candle Co.*, 14 F. Supp. 2d 154, 159–60 (D. Mass.) (holding that a store enclosed within a shopping mall was not an “architectural work” entitled to protection under Copyright Act because protection extends only to freestanding buildings), *vacated by settlement* 29 F. Supp. 2d 44 (D. Mass. 1998).

design golf courses and other three-dimensional structures that defy easy classification are unable to avail themselves of copyright protection.<sup>74</sup>

While it is true that the designer's architectural plans or models are protected under copyright law,<sup>75</sup> this protection affords no practical help when the copy of a course design is made relying on tools other than the protected plans or models.<sup>76</sup> The most notable replica course capitalizing off of famous golf course designs has been Tour 18, developed in Humble, Texas in 1994.<sup>77</sup> There, instead of designing a course that was site-specific, the designers of Tour 18 duplicated famous holes from historic American golf courses—such as Pebble Beach National Golf Links, Pinehurst, and Harbour Town Golf Links<sup>78</sup>—by using modern technology such as videotapes, overhead photographs, and public maps.<sup>79</sup> Subsequently, in *Pebble Beach Co. v. Tour 18 I, Ltd.*, the owners of three of the original golf courses that were copied brought suit under a variety of trade and unfair competition violations, including trade dress infringement.<sup>80</sup>

To determine trade dress infringement, the court considered whether the plaintiff's trade dress qualified for protection and whether a likelihood of confusion proved infringement of that trade dress.<sup>81</sup> The court employed a two-part analysis to determine “whether the plaintiff's trade dress qualified for protection,” considering whether each hole was (1) functional, and (2) inherently distinctive or had achieved secondary meaning.<sup>82</sup> One might have expected the court to find that a golf course is merely a playing surface to facilitate the game

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<sup>74</sup> Raphael Winick, *Copyright Protection for Architecture After the Architectural Works Copyright Protection Act of 1990*, 41 DUKE L.J. 1598, 1613 (1992) (“Golf courses, gardens, tunnels, bridges, overpasses, fences, and walls are only a few of the structures designed by architects that would not fit the common definition of ‘building.’”).

<sup>75</sup> 17 U.S.C. § 101 (2006) (defining “[p]ictorial, graphic, and sculptural works” to include “models, and technical drawings including architectural plans”).

<sup>76</sup> *Demetriades v. Kaufmann*, 680 F. Supp. 658, 664 (S.D.N.Y. 1988) (“[A]lthough an owner of the copyrighted architectural plans is granted the right to prevent the unauthorized copying of those plans, that individual, without benefit of a design patent, does not obtain a protectable interest in the useful article depicted by those plans.”).

<sup>77</sup> *Pebble Beach Co. v. Tour 18 I, Ltd.*, 942 F. Supp. 1513, 1532–33 (S.D. Tex. 1996); *About Us*, TOUR 18 HOUSTON, [http://www.tour18golf.com/tour18golf/club\\_info/aboutus.php](http://www.tour18golf.com/tour18golf/club_info/aboutus.php) (last visited Oct. 14, 2010) (claiming to replicate “holes from some of the greatest golf holes in America”).

<sup>78</sup> *Pebble Beach*, 942 F. Supp. at 1532.

<sup>79</sup> *See id.* at 1533.

<sup>80</sup> *Id.* at 1526.

<sup>81</sup> *Id.* at 1555.

<sup>82</sup> *Id.*

of golf and therefore functional in the same way that it is a “useful article.”<sup>83</sup> However, the court noted that the limitation of protection to nonfunctional trade dress served the purpose of assuring that “competition [would] not be stifled by the exhaustion of a limited number of trade dresses.”<sup>84</sup> Then, in determining whether competition would be stifled, the court concluded that since there were essentially “an unlimited number of alternative designs” for a golf hole, the designs were not functional, and therefore satisfied the first element of the trade dress test.<sup>85</sup>

When considering the distinctiveness requirement, the court considered whether the designs were “inherently distinctive” or whether the plaintiff could prove distinctiveness through a finding of “secondary meaning.”<sup>86</sup> The court found that two of the holes failed to meet this prong because they were not arbitrary and distinctive “such that [they would] automatically serve as identifiers of source.”<sup>87</sup> Nor did the two holes achieve secondary meaning, because there was no evidence showing that customers connected the trade dress to only one source or were confused as to which source the holes were from.<sup>88</sup> The third hole succeeded in showing inherent distinctiveness because the hole contained an arbitrary source-identifying feature—namely, a recognizable lighthouse.<sup>89</sup> The court found that “the lighthouse [was] a strong, distinctive identifier of

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<sup>83</sup> There are a number of definitions of what is considered functional. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:69 (4th ed. 2009). Compare *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995) (stating that a feature is functional “if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage”), with *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 24 (2001) (stating the original engineering-driven definition that “‘a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article’”) (quoting *Inwood Labs., Inc. v. Ives Labs. Inc.*, 456 U.S. 844, 850 n.10 (1982)).

<sup>84</sup> *Two Pesos v. Taco Cabana*, 505 U.S. 763, 775 (1992).

<sup>85</sup> *Pebble Beach Co. v. Tour 18 I, Ltd.*, 942 F. Supp. 1513, 1556 (S.D. Tex. 1996).

<sup>86</sup> *Id.* at 1555. “The term ‘distinctive’ is a key term of art in trademark law.” 2 MCCARTHY, *supra* note 83, § 11:2. “The general rule . . . is clear: an identifying mark is distinctive and capable of being protected if it *either* (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning.” *Id.* “Generic terms can never be trademarks, descriptive terms are not inherently distinctive and suggestive, arbitrary and fanciful terms are regarded as being inherently distinctive.” *Id.*

<sup>87</sup> *Pebble Beach*, 942 F. Supp. at 1557.

<sup>88</sup> *Id.* at 1559. Trade dress can achieve secondary meaning when the primary significance of the dress in the minds of consumers is not the product, but the source of the product. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995); see 2 MCCARTHY, *supra* note 83, § 15:25.

<sup>89</sup> *Pebble Beach*, 942 F. Supp. at 1558–59.

source for Harbour Town Golf Links.”<sup>90</sup> The hole satisfied both the functional and distinctive elements of the test and was thus capable of trade dress protection and the court concluded that there was a likelihood of confusion between the replica and the original Harbour Town hole.<sup>91</sup> The court therefore granted an injunction that restricted defendants from using the lighthouse in its design or advertising, but allowed the hole itself to remain.<sup>92</sup>

As a practical matter, this case illustrates that golf course designers can satisfy the distinctiveness or secondary meaning requirements in order to use trade dress to protect their designs, but may run into problems relating to the confusion prong of the trade dress analysis. Very few holes are instantly recognizable as being from a particular course or designer, especially when taken out of the surrounding context of the original course. While the court suggested that the plaintiffs might have been eligible for trade dress protection because of their prominent advertising scheme, trade dress protection only protects the owner of the golf course from competitors who confuse customers, and not the architect from copycats stealing the creative aspects of the work.<sup>93</sup>

### III. CLASSIC CONTINENTAL MORAL RIGHTS AND THE LANHAM ACT

Other countries “have long recognized [the] rights personal to authors” independently “from the economic aspect[s] of copyright” law.<sup>94</sup> “These rights . . . known as *le droit moral*, or moral rights,” guarantee an ongoing relationship between the creative work and its author “separate and apart from the economic” issues at stake.<sup>95</sup> Their inalienability guarantees that even in a full transfer of copyright, there is “no impact on the assertion of [moral rights]

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<sup>90</sup> *Id.* at 1561.

<sup>91</sup> *Id.* The court analyzed seven factors to conclude that confusion existed between Tour 18’s copy and the original hole:

(1) the type or strength of plaintiff’s trade dress; (2) the degree of similarity between plaintiff’s and defendant’s trade dress; (3) the similarity between plaintiff’s and defendant’s goods or services; (4) the identity of plaintiff’s and defendant’s customers; (5) the similarity of plaintiff’s and defendant’s advertising; (6) the defendant’s intent; [and] (7) the existence of actual confusion.

*Id.*

<sup>92</sup> *Id.* at 1572.

<sup>93</sup> *Id.* (finding that Tour 18 could keep the hole in question but must take “corrective action to alter its confusingly similar replicas” of Harbour Town’s trade dress).

<sup>94</sup> NIMMER, *supra* note 15, § 8D.01.

<sup>95</sup> *Id.*

claims.<sup>96</sup> Two of these moral rights, the right of attribution and the right of integrity, are the core moral rights recognized in Article 6bis of the Berne Convention and figure largely in international law.<sup>97</sup> The right of attribution guarantees that the author's form of identification remains and conversely, includes a right against misattribution.<sup>98</sup> The right of integrity allows the artist to object to distortions or changes in the work that might damage the artist's reputation.<sup>99</sup> While the United States acceded to the Berne Convention in 1988, it did not include a provision providing the two 6bis moral rights.<sup>100</sup> Instead, Congress stated that existing state and federal law in the United States, such as section 43(a) of the Lanham Act, right of publicity laws, and unfair competition laws offer the protection envisioned by Article 6bis.<sup>101</sup>

The Visual Artists Rights Act of 1990, which extends the rights of integrity and attribution to unique works of fine art, represents the only express recognition of moral rights in the U.S. Code.<sup>102</sup> Legislative history suggests that courts "use common sense and generally accepted standards of the artistic community in determining whether a particular work falls within the scope of the definition."<sup>103</sup> However, protection is narrowly limited to works of visual art, which golf course design would fail to satisfy unless one was to sympathetically consider the golf course a "sculpture." But even then, it does not count as a "work of visual art" if it is not otherwise eligible for copyright protection—which as discussed above, a golf course is not.<sup>104</sup> Furthermore, courts have concluded that VARA does not apply to site-specific art—which a golf course un-

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<sup>96</sup> *Id.*

<sup>97</sup> Independently of the author's economic rights, and even after the transfer of said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

Berne Convention for the Protection of Literary and Artistic Works, art. 6bis, *amended* Sept. 28, 1979, 828 U.N.T.S. 221 [hereinafter Berne Convention].

<sup>98</sup> 3 NIMMER, *supra* note 15, § 8D.03.

<sup>99</sup> *Id.* at § 8D.04.

<sup>100</sup> Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 3, 102 Stat. 2853 (1988) (codified in various sections of 17 U.S.C. (2006)).

<sup>101</sup> H.R. REP. NO. 100-609, at 34 (1988).

<sup>102</sup> See 17 U.S.C. § 106A (2006) (providing, under limited circumstances, the rights of attribution and integrity to certain visual artists).

<sup>103</sup> H.R. REP. NO. 101-514, at 11 (1990).

<sup>104</sup> 17 U.S.C. § 101 (2006) (defining "work of visual art"). The purpose of this provision is to avoid conferring any newly created artists' rights on works freely available in the copyright public domain. See H.R. REP. NO. 101-514, at 14 (1990).

doubtedly is—due to concerns of “dramatically affect[ing] real property interests.”<sup>105</sup>

The enactment of VARA, however, does not mean that Congress foreclosed all moral rights protections for expression that fails to satisfy the “fine art” category. As seen in the congressional record, VARA was intended to have no effect—positive or negative—on the ability of artists falling outside its scope to protect their moral rights.<sup>106</sup> An alternative vehicle affording protection of moral rights for those works that fall outside of “fine art” is section 43(a).<sup>107</sup> Placed in the chapter on trademarks in Title 15 of the U.S. Code rather than Title 17 on copyright, section 43(a) creates liability for those who use a false designation of origin or any false description or representation in connection with any goods or services that are likely to cause confusion.<sup>108</sup> For example, in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*,<sup>109</sup> the Second Circuit affirmed an injunction enjoining defendants from exhibiting or distributing a motion picture film featuring a uniform strikingly similar to the one worn by plaintiff’s cheerleading group because of a likelihood of confusion as to origin, sponsorship, or approval under section 43(a).<sup>110</sup> The court found it “hard to believe that anyone who had seen [the film] could ever thereafter disassociate it from plaintiff’s cheerleaders,” and that the resulting confusion would likely “impugn (plaintiff’s services) and injure plaintiff’s business reputation.”<sup>111</sup>

The Second Circuit’s 1976 decision in *Gilliam v. American Broadcasting Co.*<sup>112</sup> solidified the use of the Lanham Act to protect moral rights.<sup>113</sup> In *Gilliam*, the ABC television network heavily edited several episodes of the British program *Monty Python’s Flying Circus*, cutting out roughly twenty-seven per-

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<sup>105</sup> 3 NIMMER, *supra* note 15, § 8D.06 (citations omitted).

<sup>106</sup> 136 CONG. REC. E3,716-03 (daily ed. Oct. 27, 1990) (statement of Rep. Moorhead).

<sup>107</sup> 15 U.S.C. § 1125(a)(1)(A) (2006).

<sup>108</sup> *Id.* Section 43(a) provides a cause of action when:

[a]ny person who . . . uses in commerce any word . . . or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . of such person with another person, or as to the origin, sponsorship, or approval . . . by another person.

*Id.*

<sup>109</sup> 604 F.2d 200 (2d Cir. 1979).

<sup>110</sup> *Id.* at 207.

<sup>111</sup> *Id.* at 205 (citing *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1189 (E.D.N.Y. 1972)).

<sup>112</sup> 538 F.2d 14 (2d Cir. 1976).

<sup>113</sup> *See id.* at 24.

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cent of the original content.<sup>114</sup> The members of the Monty Python filed suit, seeking an injunction preventing ABC from airing the edited episodes because, inter alia, it “mutilated the original work” and, therefore, violated section 43(a).<sup>115</sup> The Second Circuit interpreted the false association prong of section 43(a) as follows:

American copyright law, as presently written, does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors. Nevertheless, the economic incentive cannot be reconciled with the inability of artists to obtain relief for mutilation or misrepresentation of their work to the public. . . . [C]ourts have long granted relief for misrepresentation of an artist’s work . . . [and] properly vindicate the author’s personal right to prevent the presentation of his work to the public in a distorted form. . . .

. . . .

. . . “To deform his work is to present him to the public as the creator of a work not his own, and thus makes him subject to criticism for work he has not done.” In such a case, it is the writer or performer . . . who suffers the consequences of the mutilation, for the public will have only the final product by which to evaluate the work. . . . [A]n allegation that a defendant has presented to the public a . . . distorted version of plaintiff’s work seeks to redress the very rights sought to be protected by the Lanham Act and should be recognized as stating a cause of action under that statute.<sup>116</sup>

In effect, the Second Circuit recognized that section 43(a) protects an author’s right of integrity to his or her work. The opinion stated that, while not explicitly mentioned in the Copyright Act, the rights of attribution and integrity are essential to the economic rights the Act protects, and must, therefore, be protected by means outside the statutory law of copyright.<sup>117</sup> ABC’s attributing the ninety-minute show to Monty Python was “a representation [that] . . . although technically true, creates a false impression of the product’s origin.”<sup>118</sup> The court further noted that the cuts made by ABC “impaired the integrity” of plaintiff’s work and presented to the public “a mere caricature of

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<sup>114</sup> *Id.* at 19.

<sup>115</sup> *Id.* at 24.

<sup>116</sup> *Id.* at 24–25 (citations omitted).

<sup>117</sup> *Id.* at 24.

<sup>118</sup> *Gilliam*, 538 F.2d at 24.



their talents.”<sup>119</sup> Consequently, the Second Circuit recognized that Monty Python could rely on section 43(a) to bring a misattribution claim.<sup>120</sup>

Five years later, the Ninth Circuit further expanded the reach of section 43(a) to encompass the right of attribution.<sup>121</sup> In *Smith v. Montoro*, an actor sued the U.S. distributor of a movie he appeared in for replacing his name in the credits and advertising materials with the name of another actor.<sup>122</sup> His section 43(a) claim stated that the distributor violated the prohibition against “false designation[s] of origin” by engaging in “reverse passing off,” which occurs when a person removes or obliterates [an] original trademark, without authorization, before reselling goods produced by someone else.”<sup>123</sup> The court found that in such situations, “the originator of the misidentified product is involuntarily deprived of the advertising value of its name and of the goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product.”<sup>124</sup> Further, the “purchaser (or viewer) is also deprived of knowing the true source of the product and may even be deceived into believing that it comes from a different source.”<sup>125</sup> Although the court never explicitly referenced moral rights, the mere recognition of the section 43(a) “reverse passing off” claim has opened the door for authors to assert their rights of attribution in the very same way.<sup>126</sup>

The Supreme Court, however, unquestionably changed the Lanham Act’s coverage of moral rights with its decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>127</sup> The case arose out of *Crusade in Europe*, a 1949 Fox television series based on Dwight D. Eisenhower’s memoir, which entered the public domain in 1977, when Fox failed to renew its copyright.<sup>128</sup> In 1995,

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<sup>119</sup> *Id.* at 25.

<sup>120</sup> *See id.* The Second Circuit confirmed this proposition in *King v. Innovation Books*, 976 F.2d 824 (2d Cir. 1992), where the court stated that “a false reference to the origin of a work, or a reference which, while not literally false, is misleading or likely to confuse” was grounds for a section 43(a) claim. *Id.* at 828.

<sup>121</sup> *See Smith v. Montoro*, 648 F.2d 602, 608 (9th Cir. 1981) (holding that an allegation of “reverse palming off” states a valid claim under section 43(a)).

<sup>122</sup> *Id.* at 603.

<sup>123</sup> *Id.* at 604–05.

<sup>124</sup> *Id.* at 607.

<sup>125</sup> *Id.*

<sup>126</sup> 3 NIMMER, *supra* note 15, § 8D.03(A)(2)(a) (stating that the rationales underlying *Smith v. Montoro* apply equally to authors “outside the motion picture context”).

<sup>127</sup> 539 U.S. 23 (2003).

<sup>128</sup> *Id.* at 25–26. Public domain is defined as:

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Dastar edited a copy of *Crusade in Europe*, adding a few original elements, and released it as part of a video set entitled *World War II Campaigns in Europe*.<sup>129</sup> Dastar claimed credit for the video set in advertising, on packaging, and on-screen, with no reference to the original television series.<sup>130</sup> Fox subsequently filed suit claiming, inter alia, that failing to credit the original series was in violation of section 43(a) because it was a false or misleading designation of origin likely to cause confusion as to the origin of the goods.<sup>131</sup>

The Court framed the issue as simply whether “origin” in section 43(a) refers to the manufacturer of the physical goods or to “the creator of the underlying work.”<sup>132</sup> In a unanimous decision, the Court determined that “the most natural understanding” of the word “origin” was that it 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.”<sup>133</sup> The Court explained:

The problem with this argument according special treatment to communicative products is that it causes the Lanham Act to conflict with the law of copyright, which addresses that subject specifically. . . . [I]n 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. . . . Assuming for the sake of argument that Dastar’s representation of itself as the “Producer” of its videos amounted to a representation that it originated the creative work conveyed by the videos, allowing a cause of action under § 43(a) for that representation would create a species of mutant copyright law that limits the public’s “federal right to copy and to use” expired copyrights.<sup>134</sup>

As a result, the Court explicitly limited the Lanham Act’s protections, thereby calling into question whether the right of integrity is still protected under section

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The universe of inventions and creative works that are not protected by intellectual-property rights and are therefore available for anyone to use without charge. When copyright, trademark, patent, or trade-secret rights are lost or expire, the intellectual property they had protected becomes part of the public domain and can be appropriated by anyone without liability for infringement.

BLACK’S LAW DICTIONARY 1265 (8th ed. 2004).

<sup>129</sup> *Dastar Corp.*, 539 U.S. at 26–27.

<sup>130</sup> *Id.* at 27.

<sup>131</sup> *Id.*; see *Smith v. Montoro*, 648 F.2d 602, 605–06, 608 (9th Cir. 1981) (stating that “reverse passing off” is a “false designation of origin”).

<sup>132</sup> *Dastar Corp.*, 539 U.S. at 31.

<sup>133</sup> *Id.* at 31, 37.

<sup>134</sup> *Id.* at 33–34 (citations omitted) (internal quotation marks omitted).

43(a) because of the perception that such protection would bring the Lanham Act into conflict with the Copyright Act.<sup>135</sup>

The Court's decision, however, has been criticized for the overly broad rule it created and for its failure to consider section 43(a)'s role in ensuring U.S. compliance with the Berne Convention.<sup>136</sup> Furthermore, the facts of *Dastar* rendered it a poor test case for a discussion of moral rights. First, Fox was not an entity that had any claim to moral rights because it was not the author, or even the statutory author, of the work. The original *Crusade in Europe* was produced by Time, Inc., who subsequently assigned the copyright to Fox.<sup>137</sup> Second, failing to renew its copyright in the series made Fox a less-than-sympathetic plaintiff because the work was now in the public domain where, even under the Berne Convention, moral rights no longer apply.<sup>138</sup> Given these facts, it is not surprising that moral rights and U.S. obligations under the Berne Convention received little discussion by the Court.

#### IV. APPLICATION TO THE ART OF GOLF COURSE ARCHITECTURE

Because golf course architecture is uniquely suited to local terrain and surroundings, the ability to copy plans for multiple courses is generally not of major economic significance in the industry of golf course design.<sup>139</sup> In fact, no golf course operator would want to commission an exact copy of a golf course over an original design suited for a specific location unless the actual purpose was to use the name of the original designer in promoting the course. This is because the average casual golfer would be unlikely to ever recognize a copy without a strong cue—especially when transplanted to a different location than

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<sup>135</sup> *Id.* at 34–35.

<sup>136</sup> See, e.g., *Family Movie Act of 2004: Hearing on H.R. 4586 Before the Subcomm. on Courts, the Internet and Intellectual Prop. of the H. Comm. on the Judiciary*, 108th Cong. 10, n.2 (2004) (statement of Marybeth Peters, Register of Copyrights, U.S. Copyright Office) (stating that the “ill-considered [*Dastar*] decision . . . has weakened the protection for moral rights that our laws offer” and that “the subcommittee should examine whether section 43(a) . . . is an important means for protecting the moral rights of attribution and integrity”).

<sup>137</sup> *Dastar Corp.*, 539 U.S. at 25–26.

<sup>138</sup> *Id.* at 33 (internal quotation marks omitted) (“The right to copy, and to copy without attribution, once a copyright has expired . . . passes to the public.”); see Berne Convention, *supra* note 97 (stating that an author’s rights of attribution and integrity “shall, after his death, be maintained, at least until the expiry of the economic rights”).

<sup>139</sup> James H. Schnare II, Senior Vice President and General Counsel, Nicklaus Companies, LLC, Address at New York Law School’s Institute for Information Law & Policy Symposium: Intellectual Property from Tee to Green: Applying the Art of Law to the Business of Golf (Mar. 10, 2008) (on file with author).

the context of the original.<sup>140</sup> Thus, as a practical matter, golf course architects are more likely to confront a situation involving misattribution or mutilation of their original work, rather than a situation where a designer wished to add or substitute his or her name on a work. This difference is paramount because as *Gilliam* and *Dastar* illustrate, an artist wishing to remove his name from a work due to misattribution or mutilation—like in *Gilliam*—has a better chance of success than an artist wishing to add his or her name to a work—like in *Dastar*.<sup>141</sup>

In fact, the court in *Gilliam* issued an explicit endorsement of moral rights, which it described as including “the right of the artist to have his work attributed to him in the form in which he created it.”<sup>142</sup> As previously stated, the members of Monty Python were granted an injunction that prevented ABC from airing edited episodes because the edited versions “mutilated” the original work and presented to the public a distorted version of the work.<sup>143</sup> And while attribution of the episodes to Monty Python was technically correct, the court found that ABC had nonetheless created a false impression of the product’s origin by presenting only a “caricature” of the group’s talents.<sup>144</sup> Similarly, a copycat golf course presents a mere “caricature” of the original designer’s talent because it lacks the authenticity and site-specificity intended in the original design. By taking the golf course out of its intended context, it presents the work in a distorted form and subjects the architect to criticism for work that he has not done. After all, a course designed with the natural features of the ocean and other site-specific characteristics does not translate well when transplanted into the middle of Texas. The copycat inevitably cheapens the distinctive design philosophy of the original and misrepresents the integrity of the designer’s work. Thus, golf course architects are able to rely on the factual similarities of misattribution laid out in *Gilliam* in order to protect their work from copycat designers.

But even the unlikely situation where a golf course designer wishes to add his name to a course is significantly distinguishable from the unfavorable facts of *Dastar*. *Dastar* involved a situation where a work entered into the public domain because a copyright owner failed to renew a lapsed copyright regis-

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<sup>140</sup> *Id.*

<sup>141</sup> *But see* *Lamothe v. Atl. Recording Corp.*, 847 F.2d 1403, 1405–06 (9th Cir. 1988) (holding that allegations of defendants unilaterally deciding to attribute authorship of musical compositions to less than all of joint authors stated a cause of action under the Lanham Act for express “reverse passing off”); *Smith v. Montoro*, 648 F.2d 602, 603 (9th Cir. 1981).

<sup>142</sup> *Gilliam v. Am. Broad. Cos.*, 538 F.2d 14, 24 (2d Cir. 1976).

<sup>143</sup> *Id.* at 24–25.

<sup>144</sup> *Id.* at 25.

tration.<sup>145</sup> This played a large role in the Court's decision, and, at the very least, made Fox a less-than-sympathetic plaintiff. In contrast, golf course architecture is not protected under the Copyright Act and so the grave concerns the *Dastar* Court expressed about section 43(a) overlapping with the protections of the Copyright Act are not at issue.<sup>146</sup> Further, the *Dastar* Court expressed concerns because "[r]ecognizing in [section] 43(a) a cause of action for misrepresentation of authorship of noncopyrighted works (visual or otherwise) would render these limitations [in VARA] superfluous."<sup>147</sup> However, as discussed above, VARA provides limited rights of attribution and integrity for a narrowly defined class of visual art that does not include golf course design. Finally, the plaintiff in *Dastar* was not the author of the work but was rather assigned the copyright in *Crusade in Europe*.<sup>148</sup> Because moral rights are not assignable with the transfer of copyright, Fox had no claim to moral rights in the work.<sup>149</sup> This would not be the case with respect to a golf course architect bringing a claim under section 43(a) because the golf course designer is clearly the author of the work.<sup>150</sup> Consequently, the *Dastar* Court's reasoning in denying protection under section 43(a) is significantly distinguishable from, and should not apply to, golf course design.

In the alternative, many of the major treatises suggest the possibility that section 43(a)(1)(B)—the "false advertising" prong of section 43(a)—remains unaffected by *Dastar*.<sup>151</sup> Courts have not addressed this issue because

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<sup>145</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 26 (2003).

<sup>146</sup> *Id.* at 28 n.2.

<sup>147</sup> *Id.* at 35.

<sup>148</sup> *Id.* at 26.

<sup>149</sup> 3 NIMMER, *supra* note 15, § 8D.06[D] (stating that moral rights can be waived but are not transferable).

<sup>150</sup> The golf course operator is considered the owner of the product.

<sup>151</sup> See, e.g., 5 MCCARTHY, *supra* note 83, § 27:77.50 (stating that well-known cases such as *Gilliam* "and the false actor's credit case of *Smith v. Montoro* will be in violation of . . . [section] 43(a) only if they fit within the . . . 'false advertising' prong of . . . [section] 43(a)(1)(B)"); 3 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT §§ 17.14.3 (3d ed. 2005 & Supp. 2010) (acknowledging that "[b]ecause the Court's opinion addressed only section 43(a)(1)(A), it left open the possibility for relief against reverse passing off of literary and artistic works under section 43(a)(1)(B)"); 2-7 ANNE GILSON LALONDE ET AL., GILSON ON TRADEMARKS § 7.02(6)(d)(ii) (2010) (stating that a plaintiff may still have a cause of action after *Dastar* under section 43(a)(1)(B)). The false advertising prong of section 43(a) states that "[a]ny person who . . . uses in commerce any . . . name . . . which . . . in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action." 15 U.S.C. § 1125(a)(1) (2010).

authors' "claims under Section 43(a) have . . . relied [solely] on the false association prong to protect their rights of attribution and integrity."<sup>152</sup> However, in the context of using a famous golf course designer's name as an endorsement promoting a replica or homage course, this theory seems particularly appropriate.<sup>153</sup> This is because misattribution of authorship can be actionable under the false advertising prong of section 43(a) if it is a false or misleading representation of fact that misrepresents the "nature, characteristics, [or] qualities" of the goods.<sup>154</sup> Because the unique characteristics and qualities of a famous golf course are inherently site specific, using the name of the designer on a copycat course in another location—even if a respectable copy—misrepresents the quality of the goods because it lacks the surrounding features that were part of the original design.<sup>155</sup> After all, representing a copy of a Pebble Beach hole without the Pacific Ocean and surrounding mature cypress trees is clearly an inaccurate representation of the work of the designer whose course was designed with these natural existing land features in mind.<sup>156</sup> Inaccurate credit attributed to a designer in this way is likely to severely impair his ability to sell his services if copycat courses misrepresent the original design philosophy behind a course. This will inevitably affect consumers' desire to play on the original course after experiencing a poorly designed copy lacking the natural land features meant to

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<sup>152</sup> Clint A. Carpenter, *Stepmother, May I?: Moral Rights, Dastar, and the False Advertising Prong of Lanham Act Section 43(a)*, 63 WASH. & LEE L. REV. 1601, 1630 (2006).

<sup>153</sup> The plaintiffs in *Pebble Beach* actually did bring a false advertising claim under section 43(a)(1)(B), however, it was not asserted as a moral rights argument. There, the golf course operators (not the architects) alleged that the word "copy," used in advertisements to describe the holes, misled consumers into believing the holes were exact copies, which they were not. *Pebble Beach Co. v. Tour 18 I, Ltd.*, 942 F. Supp. 1513, 1526–27, 1562 (S.D. Tex. 1996). The district court quickly disposed of this claim because the plaintiffs failed to provide any extrinsic evidence. *Id.* at 1563. In contrast with the argument asserted by the plaintiffs in *Pebble Beach*, this Note is suggesting action under section 43(a)(1)(B) by the architects as a moral rights claim. Such a claim would assert that the use of a designer's name misrepresents the nature and quality of the goods because golf course architects design courses to be site specific and, therefore, the copy inherently misrepresents the work of the designer.

<sup>154</sup> 5 MCCARTHY, *supra* note 83, §§ 27:55, 27:85 (describing the two alternative types of false advertising).

<sup>155</sup> An example of a golf course architect considering the surrounding features of a specific site during the design process is the creation of Harbour Town Golf Links. There, evidence demonstrated "that the placement and design of the course" was specifically constructed "to create [a] relationship between the course and the [existing] lighthouse." *Pebble Beach Co. v. Tour 18 I, Ltd.*, 155 F.3d 526, 542 (5th Cir. 1998).

<sup>156</sup> *Id.*

be included in the design.<sup>157</sup> Misattribution of this kind subjects the golf course architect to criticism for work that he has not actually done. As a result, a golf course architect should be able to rely on the false advertising prong of section 43(a) in order to protect his rights of attribution and integrity, which are inherent in the “nature, characteristics, [or] qualities” of the goods.<sup>158</sup>

Thus, in order to constitute infringement of a golf course architect’s rights of attribution and integrity, a copycat or homage course must expressly use the name of the designer in promoting its course. For example, any hole or course that purports to feature the design of a famous golf course architect, or even one that claims to have been inspired by the architect, would constitute infringement. In these situations, the golf course architect has a right to prevent the presentation of his work to the public in a distorted form. The entire value of creating a copy of a famous designer’s work, and the harm from the designer’s perspective, lies in the promotion of that work using the famous golf course designer’s name. In contrast, in the unlikely situation where a golf course operator commissioned an exact copy of a famous golf course architect’s work and left the designer’s name off of the work, there would be no infringement of the architect’s rights of attribution and integrity under this theory. This is because even though an exact copy of the design has been made, it is highly implausible that anyone would recognize it as a copy without a strong cue. Without such a cue, there is no damage to the original designer’s reputation and thus, no need to prevent the presentation of his work to the public in the distorted copycat form.

## V. CONCLUSION

Golf course design and the profession of the golf course architect have dramatically changed over time. Initially, golf course design was driven predominantly by the utilitarian concerns of facilitating the sport of golf by using the existing land features as natural hazards. Today, however—thanks to technology and machinery—the natural existing land serves merely as a blank canvas, which innovative architects use to sculpt breathtaking masterpieces. The focus appears to be less about utility and more about lavish, artistic grandeur and the creation of visually striking elements that will translate well onto television and color print. Furthermore, now that magazine rankings and golf clubs prominent-

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<sup>157</sup> This is analogous to the argument Carpenter makes with respect to the misattribution of a screenplay writer. He states that this kind of misattribution is material because “potential employers who chose not to hire” a screenwriter to write their screenplays “may have chosen differently had [the screenwriter] been accurately credited.” Carpenter, *supra* note 152, at 1644.

<sup>158</sup> 5 MCCARTHY, *supra* note 83, § 27:85.

ly tout the club's architect as an indication of innovative and superior course design, the name or endorsement behind a golf course has taken on considerable significance, either enhancing or reducing the value of a particular course.<sup>159</sup> Thus, when a course claims to feature copies of the work of a famous designer, the architect's right of integrity and attribution are directly at stake. In the absence of traditional intellectual property protection, famous golf course architects must rely on classic moral rights in order to control their reputations and to build a strong brand. Without such protection, shoddy knockoffs that use golf course designers' names will inevitably cheapen the value of their brand and impair the integrity of their work, by presenting to the public a mere caricature of their talents.

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<sup>159</sup> See, e.g., *Nicklaus Design Overview*, *supra* note 10.