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Recent United States Copyright Reforms: Congress Catches the Spirit of Berne

Cover Page Footnote

James H. Carter, Jane C. Ginsburg

RECENT UNITED STATES COPYRIGHT REFORMS: CONGRESS CATCHES THE SPIRIT OF BERNE

*Graeme B. Dinwoodie**

At the turn of the year President Bush signed into law a series of miscellaneous but significant reforms of United States copyright law. They reflect a continuing attempt by Congress through piecemeal reform to fine-tune copyright law and bring about full compliance with the Berne Convention for the Protection of Literary and Artistic Works (Paris Text, 1971) (the "Berne Convention" or "Berne").

The latest measures are found in the Judicial Improvements Act¹ and the Copyright Remedy Clarification Act.² They (1) provide increased protection against the unauthorized copying of computer programs; (2) create copyright protection for the design of constructed works of architecture; (3) grant rights to protect the non-economic interests of certain visual artists; and (4) confirm that the states and their agencies can be held fully liable for copyright infringement. As a result of political maneuvering the "fair use" provisions of the legislation — which had been the subject of considerable debate last summer — were not adopted. A compromise bill containing similar fair use proposals has, however, been introduced in the new session of Congress.³

JUDICIAL IMPROVEMENTS ACT

The Judicial Improvements Act (the "JIA") includes titles affecting the scope of copyright protection granted to computer software, the design of works of architecture, and works of "visual art." These last two topics have been particularly prominent on the Congressional agenda since the United States accession to the Berne

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1. Judicial Improvements Act of 1990, Pub. L. No. 101-650, 104 Stat. 5089 (1990) (to be codified in scattered titles of U.S.C.) (pertinent parts codified in scattered sections of 17 U.S.C.A. (West Supp. 1991)) [hereinafter JIA].

2. Copyright Remedy Clarification Act, Pub. L. No. 101-553, 104 Stat. 2749 (1990) (to be codified at 17 U.S.C. §§ 501(a) & 511).

3. S. 1035, 102d Cong., 1st Sess. (1991); H.R. 2372, 102d Cong., 1st Sess. (1991).

Convention. For a variety of reasons, accession has been guided by a minimalist philosophy — "making only those changes to American copyright law that [were] clearly required under the treaty's provisions."⁴ Many commentators believed that, even under a minimalist approach, amendment of United States law was necessary in the areas of "moral rights" and works of architecture, but not sufficiently undertaken.⁵ Fortunately, accession has marked the beginning, not the end, of a renewed attempt to match United States law to the minimum standards of international copyright protection.⁶ The reforms relating to architectural works and works of visual art are small, but important, steps toward a more wholehearted United States adoption of the Berne Convention.⁷

4. H.R. REP. NO. 609, 100th Cong., 2d Sess. 7 (1988).

5. See, e.g., Jane C. Ginsburg & John M. Kernochan, *One Hundred and Two Years Later: The U.S. Joins the Berne Convention*, 13 COLUM.-VLA J.L. & ARTS 1, 24 (1988) [hereinafter Ginsburg & Kernochan].

6. See Ginsburg & Kernochan, *supra* note 5, at 6 ("In retrospect, and considering how close the whole effort came to being derailed in its closing stages, it would seem the proponents of this [minimalist] approach were right. The price paid was arguably a less than full embracing of the 'Spirit of Berne' in its broadest sense. But adherence, the principal goal, was in fact attained. New battles to move United States law further toward a fuller acceptance of Berne's wider implications will certainly be fought in the future."). Some expressed concern that the formal act of adherence would hinder the elevation of United States copyright protection to international standards by creating the illusion that those standards had already been attained. Edward J. Damich, *Moral Rights in the United States and Article 6bis of the Berne Convention: A Comment on the Preliminary Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, 10 COLUM.-VLA J.L. & ARTS 655, 663 (1986) ("From the point of view of a moral rights advocate, however, there is the danger that adherence will impede the full recognition of moral rights in the United States by providing confirmation that the existing paltry acceptance is equivalent to the meaningful protection embodied in Article 6bis.").

7. See Jane C. Ginsburg, *Copyright in the 101st Congress: Commentary on the Visual Artists Rights Act and the Architectural Works Copyright Protection Act of 1990*, 14 COLUM.-VLA J.L. & ARTS 477, 497 (1990) ("The 1990 Visual Artists Rights Act and the Architectural Works Copyright Protection Act enhance the U.S.' compliance with Berne Convention standards . . . Congress continued to adhere to its 'minimalist' approach to enlargement of copyright protections. This cautious, if not begrudging, strategy may provoke criticism that the U.S. remains reluctant to fulfill Berne mandates . . . Nonetheless, U.S. progress, albeit slow, is real.") (footnotes omitted). A continuation of this strategy has led to the introduction in the new session of Congress of a bill providing for the automatic renewal of copyright in pre-1978 works. See S. 756, 102d Cong., 1st Sess. (1991); H.R. 2372, 102d Cong., 1st Sess. (1991); see also Comments of Dorothy Schrader (Copyright Office) to the International Copyright Panel of the State Department's Advisory Committee on Intellectual Property, 41 Pat. Trademark & Copyright J. (BNA) 433 (1991); see also Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention, 10 COLUM.-VLA J.L. & ARTS 513, 581 (1986) ("The renewal registration requirement and duration of renewed copyrights under the U.S. Copyright Act with respect to works of foreign origin are incompatible with Berne because of the imposition of formalities and a shorter than required total term."); The Staff of the U.S. Copyright Office, *Implementing Legislation to Permit U.S. Adherence to the Berne*

Works of Architecture

The Berne Convention contemplates copyright protection for both architectural plans and completed structures. Article 2(1) (including separately within list of "literary and artistic works," "works . . . of architecture" and "plans . . . and three dimensional works relative to . . . architecture").⁸ At the time of accession, United States law was adequate with respect to the protection of plans (at least insofar as two-dimensional reproduction was concerned).⁹ However, the United States' reluctance to protect utilitarian aspects of works threatened to preclude protection of completed structures.¹⁰

Convention: A Draft Discussion Bill & Commentary, 10 COLUM.-VLA J.L. & ARTS 621, 634-36 (1986) (proposing automatic renewal of copyright in foreign works in order to comply with the provisions of the Berne Convention).

8. Cf. James Bingham Bucher, Comment, *Reinforcing the Foundation: The Case Against Copyright Protection For Works of Architecture*, 39 EMORY L.J. 1261, 1284-85 (1990) (arguing that since the World Intellectual Property Organization ("WIPO") permitted the United States to join the Berne Convention based on existing protection for "architectural works" there is no need to change existing United States law).

9. See generally Natalie Wargo, Note, *Copyright Protection for Architecture and the Berne Convention*, 65 N.Y.U. L. REV. 403 (1990) (evaluating the compatibility of American copyright protection for architecture and the corresponding obligations of the Berne Convention); David E. Shipley, *Copyright Protection for Architectural Works*, 37 S.C.L. REV. 393 (1986) (discussing the nature and scope of protection afforded to architectural works under U.S. Copyright Law); Elizabeth A. Brainard, Note, *Innovation and Imitation: Artistic Advance and the Legal Protection of Architectural Works*, 70 CORNELL L. REV. 81 (1984) (evaluating the appropriate level of protection of architectural works).

10. See 17 U.S.C. § 101 (1988) (design of a useful article only considered a pictorial, graphic or sculptural work to the extent that such features of the design can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article). Moreover, United States courts have not permitted copyright in two-dimensional plans to afford effective protection of the three-dimensional structure depicted therein; construction will only be enjoined if the second builder is using plans which are themselves infringing. *Robert R. Jones Assocs. v. Nino Homes*, 858 F.2d 274, 280 (6th Cir. 1988) ("[o]ne may construct a house which is identical to a house depicted in copyrighted architectural plans, but one may not directly copy those plans and then use the infringing copy to construct the house."); see also *Kunycia v. Melville Realty Co.*, 755 F. Supp. 566, 576 (S.D.N.Y. 1990); *Intown Enters. Inc. v. Barnes*, 721 F. Supp. 1263 (N.D. Ga. 1989); *Herman Frankel Org. v. Tegman*, 367 F. Supp. 1051, 1053 (E.D. Mich. 1973). Compare Copyright, Designs and Patents Act, 1988, ch. 48 (Eng.) § 17(3) [hereinafter CDPA] ("Copying" of an artistic work includes the making of a copy in three dimensions of a two-dimensional work.). In *Demetriades v. Kaufmann*, 680 F. Supp. 658, 664 (S.D.N.Y. 1988), even the use of infringing plans by the defendant did not convince the court that the second construction could be enjoined. The current U.K. legislation expressly includes within the definition of protectible artistic works "a work of architecture being a building or a model for a building." CDPA § 4(1)(b). Moreover, this is not a new development in U.K. law. See, e.g., *Meikle v. Maufe*, [1941] 3 All E.R. 144 (interpreting the Copyright Act of 1911, copyright subsisted in a building separate and distinct from the copyright in the plans from which it was built).

The legislation which was enacted to effect United States compliance with its obligations under the Berne Convention expanded the definition of protected "pictorial, graphic or sculptural works" to expressly include architectural plans or models.¹¹ However, it did not address the protection of architectural structures themselves, which was where the deficiency appeared to lie. Following accession to Berne, at the request of a Congress unsure of the sufficiency of its amendments in this field,¹² the Register of Copyrights undertook a study to determine whether United States law afforded protection to works of architecture within the meaning of the Convention.¹³ The Register's report concluded that, despite the protection of architectural plans and models, some doubt remained as to whether United States copyright law unequivocally satisfied Berne Convention standards with respect to the constructed design of architectural structures.¹⁴ The Architectural Works Copyright Protection Act (Title VII of the JIA) removes that doubt.¹⁵

The 1990 amendments add a new section to the Copyright Act conferring copyright protection on "works of architecture." The scope of that protection extends to *the design* of constructed works, as is made clear in the definition of "architectural work":

An "architectural work" is 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.¹⁶

Protection as an "architectural work" is afforded to the design not only as contained in plans or drawings, but also as embodied in the completed structure. This dual protection of plans (they are also protected as pictorial or graphic works) for the period prior to erection of the building serves to prevent the creation of a window between planning and construction in which, under existing copyright law, the unauthorized use of the plans to construct a building would

11. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 4(a), 102 Stat. 2853 (1988). See David M. Larsen, Note, *The Effect of the Berne Implementation Act of 1988 on Copyright Protection for Architectural Structures*, 1990 U. ILL. L. REV. 151 (1990).

12. See S. REP. NO. 352, 100th Cong., 2d Sess. 9 (1988).

13. See *Copyright in Works of Architecture: A Report of the Register of Copyrights* (June 1989), reprinted in 38 Pat. Trademark & Copyright J. (BNA) 936 (1989) (Executive Summary).

14. *Id.* at 221.

15. Pub. L. No. 101-650, 104 Stat. 5133 (1990) (codified in scattered sections of 17 U.S.C.A.). Doubts have been expressed as to what constitutes a "building." See David Goldberg & Robert J. Bernstein, *Legislation by the 101st Congress*, N.Y. L.J. 3, 34 (1991). The U.K. Act defines a building as including "any fixed structure, and a part of a building or fixed structure." CDPA § 4(2).

16. 17 U.S.C.A. § 101 (West Supp. 1991).

not be prohibited.¹⁷

This copyright protection is subject to two limitations. It does not include "the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place."¹⁸ Nor does the amendment curtail the right of the owner of the building to make alterations of or destroy the building or to authorize these activities.¹⁹

Works of Visual Art

Article 6bis of the Berne Convention requires protection of two species of what are commonly called "moral rights." This phrase classically encompasses an author's rights of: (i) paternity or attribution (the right to have authorship recognized); (ii) integrity (the right to prevent distortion of the artist's work); (iii) disclosure (the right to control publication of the artist's work);²⁰ and (iv) withdrawal (the right to withdraw, modify or disavow a work after its publication).²¹ The Convention requires that member states recognize the rights of

17. See *supra* note 10. H.R. REP. NO. 735, 101st Cong., 2d Sess. 19 (1990).

18. 17 U.S.C.A. § 120(a) (West Supp. 1991); compare CDPA § 62 (copyright in (a) buildings, and (b) sculptures, models for buildings and works of artistic craftsmanship, if permanently situated in a public place or in premises open to the public, not infringed by making a graphic work representing, a photograph or film of, or broadcasting or including in a cable program service a visual image of, any such work). The U.K. provision — by treating buildings and publicly accessible sculptures alike — displays a consistency lacking in the United States provision. There is no logical basis to override the architect's copyright but not that of the sculptor in an equivalent situation. See Ginsburg, *supra* note 7, at 495 ("There is no apparent reason a Frank Lloyd Wright should not retain control over posters, post cards and T-shirts depicting the Guggenheim Museum, while an Alexander Calder may control, or receive compensation for, equivalent exploitations of his outdoor stables.").

19. 17 U.S.C.A. § 120(b) (West Supp. 1991). State and local landmark, historic preservation, zoning, or building codes relating to works of architecture are not preempted by this provision. 17 U.S.C.A. § 301(b)(4) (West Supp. 1991). Compare CDPA § 65 (Reconstruction of a building does not infringe the copyright in the building or the plans in accordance with which it was constructed.).

20. The restrictive application of the fair use doctrine to unpublished works contributes to providing a United States parallel to this component of moral rights. It is therefore somewhat ironic that, contemporaneous with the first recognition of moral rights by the federal legislature, Congress was considering broadening the permissible fair use of unpublished works. See *infra* notes 73-87 and accompanying text.

21. The United States right of termination is a weak equivalent of this right — although in one regard it is the most satisfactory equivalent, as it resides in the author and cannot be assigned. 17 U.S.C. § 203(a)(5) (1988). The predecessor of the termination right, the renewal right, can be assigned — but such assignment will only be effective if the author lives until the date of renewal. *Stewart v. Abend*, 495 U.S. 207, 217 (1990); *Marascalco v. Fantasy, Inc.*, 17 U.S.P.Q.2d (BNA) 1409 (C.D. Cal. 1990).

integrity and attribution.²²

Accession to Berne

When the United States acceded to the Berne Convention, and enacted amendments to the Copyright Act to implement it, Congress concluded that existing state and federal laws afforded sufficient protection to comply with Article 6*bis*:

According to the [majority] view, there is a composite of laws in this country that provides the kind of protection envisioned by Article 6*bis*. Federal laws include 17 U.S.C. § 106, relating to derivative works, 17 U.S.C. § 115(a)(2), relating to distortions of musical works used under the compulsory license respecting sound recordings; 17 U.S.C. § 203, relating to termination of transfers and licenses, and section 43(a) of the Lanham Act, relating to false designations of origin and false descriptions. State and local laws include those relating to publicity, contractual violations, fraud and misrepresentation, unfair competition, defamation, and invasion of privacy. In addition, eight states have recently enacted specific statutes protecting the rights of integrity and paternity in certain works of art. Finally, some courts have recognized the equivalent of such rights.²³

Accordingly, the United States acceded to the Berne Convention without any amendment of its law to accommodate moral rights. However, the various causes of action upon which claims of adequate moral rights protection were premised contain elements that limit their effectiveness.²⁴ Accession was completed relying more

22. 2 PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE § 15.23 (1989) [hereinafter GOLDSTEIN]; Roberta R. Kwall, *Copyright And The Moral Right: Is An American Marriage Possible?*, 38 VAND. L. REV. 1, 5 (1985); see generally Russell J. DaSilva, *Droit Moral and The Amoral Copyright: A Comparison of Artists' Rights in France and the U.S.*, 28 BULL. COPYRIGHT SOC'Y 1 (1980).

23. H.R. REP. NO. 609, 100th Cong., 2d Sess. 34 (1988) (footnotes omitted).

24. The conclusion that United States law was compatible with the moral rights requirements of Article 6*bis* was fiercely disputed by moral rights' advocates. See, e.g., Damich, *supra* note 6, at 661 ("When the language of Article 6*bis* is compared with the evidence that has been offered to suggest that moral rights are substantially protected in the U.S., it is clear that, aside from some recently-passed [state] statutes . . . , moral rights are not protected in any meaningful sense."); John M. Kernochan, *Comments of John M. Kernochan*, 10 COLUM.-VLA J.L. & ARTS 685, 686 (1986) ("The conclusion that the U.S. law is compatible with Berne here and recognizes moral rights in any sense comparable to that intended by most of the Berne signatories is tenuous indeed."); Deborah Ross, Comment, *The United States Joins the Berne Convention: New Obligations for Authors' Moral Rights?*, 68 N.C. L. REV. 363, 364 (1990) ("In reaching this conclusion, however, Congress failed to recognize the distinction between economic and moral rights; as a result, the United States claims full adherence to Berne but lacks the legal structure to support the full array of rights provided by the Convention."). See *contra* Letter from Dr. Arpad Bogsch, Director General of WIPO, to Irwin Karp, Esq. (June 16, 1987), reprinted in pertinent part in H.R. REP. NO. 609, 100th Cong., 2d Sess. 37 (1988).

upon the belief that United States protection was no more deficient than that of other signatories, than on the firm conviction that it met Berne standards.²⁵ Certainly, a panoply of United States legal doctrines offers protections analogous to those required by Article 6bis. For example, the federal law of unfair competition as set forth in the Lanham Act may allow an author to insist upon attribution of his work if failure to do so would amount to a misrepresentation. *Lamothe v. Atlantic Recording Corp.*²⁶ (cause of action is stated under § 43(a) of the Lanham Act where authorship of musical work is attributed to some, but not all, of the co-authors).²⁷ The same Act may provide the basis for an artist to prevent the distortion of his work. *Gilliam v. American Broadcasting Cos.*²⁸ ("an allegation that a defendant has presented to the public a 'garbled,' 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".) or at least to prevent the presentation of the distorted, garbled or mutilated work under his name.²⁹

If the distorted work reflects adversely upon the author's reputa-

("In my view, it is not necessary for the United States of America to enact statutory provisions on moral rights in order to comply with Article 6bis of the Berne Convention. The requirements under this Article can be fulfilled not only by statutory provisions in a copyright statute but also by common law and other statutes. I believe that in the United States the common law and such statutes (Section 43(a) of the Lanham Act) contain the necessary law to fulfill any obligation for the United States under Article 6bis.").

25. "It is the lack of effective compliance among Berne countries, rather than the protection given moral rights in American law, that removes Article 6bis as an obstacle to U.S. adherence." Damich, *supra* note 6, at 655. Moral rights is an issue high on the agenda of the European Commission. The Commission recently proposed a Council Decision requiring all European Community countries by December 31, 1992, to comply with the Berne Convention and the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations ("Rome Convention"). See Follow-up to the Green Paper: Working Programme of the Commission in the Field of Copyright and Neighboring Rights, COM(90)584 final at Ch. 1.11.5 [hereinafter Working Programme]; see also *id.* at Ch. 8.3 (harmonization of moral rights). The United States has not acceded to the Rome Convention.

26. 847 F.2d 1403, 1407 (9th Cir. 1988).

27. See *Rosenfeld v. W.B. Saunders, Inc.*, 728 F. Supp. 236, 243 (S.D.N.Y. 1990) ("Any false attribution of principal authorship constitutes a section 43(a) violation if it misrepresents the contributions of the person designated as author. Thus, failure to attribute authorship to a co-author resulting in only a partially accurate designation of origin constitutes reverse palming off within the ambit of section 43(a).") (citations omitted), *aff'd mem.*, 923 F.2d 845 (2d Cir. 1990); see also *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981) (violation of § 43(a) of the Lanham Act where actor's name omitted from credits and replaced by another); *Dodd v. Fort Smith Special School Dist. No. 100*, 666 F. Supp. 1278 (W.D. Ark. 1987); *Marling v. Ellison*, 218 U.S.P.Q. (BNA) 702, 714 (S.D. Fla. 1982); *Follet v. New Am. Library*, 497 F. Supp. 304 (S.D.N.Y. 1980).

28. 538 F.2d 14, 24 (2d Cir. 1976) (citations omitted).

29. *Id.* at 25; *Benson v. Paul Winley Record Sales Corp.*, 452 F. Supp. 516

tion, its publication may constitute defamation.³⁰ If the distortion amounts to the creation of a "derivative work," the Copyright Act may provide a remedy.³¹ Contractual restrictions can effect the same rights as required by Article 6*bis*, although both the limited scope of contract — privity, for example — and the realities of artists' bargaining positions undermine this as a basis for effective protection.³²

These "equivalent" rights are, however, dependent upon exterior circumstances that should be of no relevance to the subsistence of

(S.D.N.Y. 1978); *CBS, Inc. v. Springboard Int'l Records*, 429 F. Supp. 563 (S.D.N.Y. 1976); *Jaeger v. American Int'l Pictures, Inc.* 330 F. Supp. 274 (S.D.N.Y. 1971).

30. *Clevenger v. Baker Voorhis & Co.*, 8 N.Y.2d 187, 192, 168 N.E.2d 643, 646, 203 N.Y.S.2d 812, 816 (1960) ("[T]he purchase of the copyright did not carry with it a license to defame by impliedly misrepresenting plaintiff as [the reviser of a subsequent edition of his work].").

31. *Gilliam*, 538 F.2d at 20. In addition to the general limitations inherent in pursuing the protection of moral rights through the Copyright Act, *see infra*, notes 37-38 and accompanying text, many modifications or mutilations will not possess sufficient originality to be a "derivative work" and thus will not infringe the copyright owner's rights. *See Paramount Pictures Corp. v. Video Broadcasting Sys.*, 724 F. Supp. 808, 820 (D. Kan. 1989) (Addition of commercial to beginning of video-cassette did not transform the motion picture in such a way as to constitute an unauthorized derivative work.). Additionally, Paul Goldstein has noted: "The paradox of relying on derivative rights to vindicate an author's interest in the integrity of her work is that the more extreme the defendant's distortion is, the less it can be said to be based on the original and thus to violate the derivative right in the original. If the distortion is so extreme that it takes only the original author's ideas but not her expression, the taking will not infringe the derivative right." 2 GOLDSTEIN § 15.24.1.2 (1989).

32. Even this intricate patchwork of remedies is unable to cover all aspects of the rights of attribution and integrity. For example, an author cannot insist upon attribution when the violative act is not false attribution, but complete non-attribution. *Vargas v. Esquire, Inc.*, 164 F.2d 522, 526 (7th Cir. 1947). The problem of complete non-attribution cannot be addressed under the Lanham Act because its remedies are dependent upon false attribution to another, or *misrepresentation* of the extent of an author's contribution. *But see* MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.21[E] (1991) (arguing that the language of *Smith v. Montoro* — in particular, the suggestion in dicta that "implied reverse palming off" is actionable under § 43(a) of the Lanham Act — contemplates an action based upon complete non-attribution); *cf. Boothroyd Dev., Inc. v. Poli*, No. 89-1650 (D. Mass. June 12, 1991), reported at News & Comment, *Reverse Palming Off Under Section 43(a) is not Actionable in First Circuit*, 42 Pat. Trademark & Copyright J. (BNA) 337 (Aug. 8, 1991) (*Montoro* presents facts which could not give rise to Section 43(a) claim in the First Circuit because that section does not extend to "reverse palming off."). Similarly, a work is granted minimal protection against its complete destruction, *Crimi v. Rutgers Presbyterian Church*, 194 Misc. 570, 576, 89 N.Y.S.2d 813, 818 (N.Y. Sup. Ct. 1949), although the Berne Convention does not require a right to prevent "destruction" of works. One of the changes made in the final version of the bill was to limit actionable "destructions" to acts committed intentionally or with gross negligence and only then in relation to "works of recognized stature." *See infra* notes 52-54 and accompanying text.

moral rights. Moral rights are clearly not protected as such.³³ Their vindication under existing United States law depended upon a fortuitous coincidence of the remedies sought by the artist with a remedy aimed at effectuating a different legal right. When the purposes underlying that right diverge — as they will — from those at the root of moral rights, the so-called “moral rights” evaporate.³⁴ For example, in the Ninth Circuit unfair competition law only affords a basis to correct false attribution of an author’s work if there is competition between plaintiff and defendant.³⁵ The protection of a work under the Lanham Act is dependent upon a misrepresentation and the likelihood of public confusion — in certain circumstances an appropriate acknowledgement that the work had been edited or revised, might defeat a Lanham Act claim.³⁶ Any deployment of the Copyright Act in support of moral rights will require that the author remains the owner (assuming that he ever was)³⁷ of the copyright because the Copyright Act vindicates only the economic interest un-

33. See *Gilliam*, 538 F.2d at 24; *Weinstein v. University of Ill.*, 811 F.2d 1091, 1095 n.3 (7th Cir. 1987); *Society of Survivors of the Riga Ghetto, Inc. v. Huttenbach*, 141 Misc. 2d 921, 926-7, 535 N.Y.S.2d 670, 673-4 (Sup. Ct. 1988); cf. *Edison v. Viva Int'l Ltd.*, 70 A.D.2d 379, 421 N.Y.S.2d 203 (App. Div. 1979).

34. See Ginsburg & Kernochan, *supra* note 5, at 35-6 nn.122, 124; Jane C. Ginsburg, *Moral Rights in a Common Law System*, 4 Ent. L.R. 121, 124 (1990).

35. *Halicki v. United Artists Communications, Inc.*, 812 F.2d 1213, 1214 (9th Cir. 1987). See also *Midler v. Ford Motor Co.*, 849 F.2d 460, 462-3 (9th Cir. 1988) (imitation of professional singer’s voice by “soundalike” in television commercial would not constitute unfair competition because plaintiff did not do television commercials and thus was not in competition with defendants; *Lamothe*, 847 F.2d at 1406; *Alflex Corp. v. Underwriters Labs., Inc.*, No. CV87-3344 JGD, 1989 WL 164359 (C.D. Cal. Mar. 21, 1989), *aff’d mem.*, 914 F.2d 261 (9th Cir. 1990), *cert. denied*, 112 S.Ct. 60 (1991)).

36. *Rosenfeld v. W.B. Saunders, Inc.*, 728 F. Supp. 236, 243-4 (S.D.N.Y.) (disclaimer adequate to prevent confusion, thus defeating § 43(a) claim), *aff’d mem.*, 923 F.2d 845 (2d Cir. 1990). The burden of demonstrating the sufficiency of the disclaimer lies with the defendant. 728 F. Supp. at 243; *Home Box Office, Inc. v. Showtime/The Movie Channel, Inc.*, 832 F.2d 1311, 1315-6 (2d Cir. 1987); see also *Charles of the Ritz Group, Ltd. v. Quality King Distributors, Inc.*, 832 F.2d 1317, 1324 (2d Cir. 1987). Indeed, the remedy for violation of § 43(a) of the Lanham Act may often simply be to require an appropriate acknowledgement of the artist’s role by means of disclaimer. See, e.g., *CBS, Inc. v. Springboard Int’l Servs.*, 429 F. Supp. at 569. In the circumstances presented in *Gilliam*, the majority did not believe that the disclaimer proposed by the district court offered sufficient relief. Compare *Gilliam*, 538 F.2d at 25 n.13; cf. CDPA § 103(2) (Court may remedy infringement of right of integrity by requiring disclaimer disassociating author from treatment of the work.).

37. The assumption that the author was the owner cannot readily be made in the United States, in particular as a result of the “work for hire doctrine.” See 17 U.S.C. § 101 (1988). The large gap that this effectively creates in moral rights protection probably does not affect United States compliance with its Berne obligations. Ginsburg & Kernochan, *supra* note 5, at 34. Indeed, the size of that gap may have been reduced by the decision of the Court in *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989).

derlying the grant of copyright.³⁸

State Protection of Moral Rights

There has been express recognition of moral rights by various state legislatures.³⁹ Within the limited spheres of operation of state statutes — in terms of geography, activities prohibited, and types of works covered — they achieve a measure of protection. Such protection exists only in a small minority of states, however, and the level of protection varies.⁴⁰ The circumscribed ambit of such state protection can be seen by comparing two of the most prominent examples. New York's Artists' Authorship Rights Act⁴¹ concentrates on protecting the artist's reputation by prohibiting the public display or publication of works of fine art or limited editions, or reproduc-

38. *Gilliam*, 538 F.2d at 24 ("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."). Article 6bis requires that moral rights be granted to the artist "independent of the economic interest." On this most fundamental point, the Copyright Act's protection of moral rights is exposed as ephemeral. Only the legal or beneficial owner of the copyright can institute an infringement action. 17 U.S.C. § 501(b) (1988). Thus, once the copyright is transferred the purported moral right is lost because the original author can no longer bring an action to enforce the copyright. As a result of the divergence in the policies underlying copyright and moral rights, privacy protections — which have their basis in the artist's personality — may provide a vehicle for the development of moral rights which is less dependent upon happenstance.

39. See, e.g., CAL. CIV. CODE §§ 980-990 (West 1982 & Supp. 1990); CONN. GEN. STAT. ANN. §§ 42-116s — 42-116t (West Supp. 1991); ILL. REV. STAT. ch. 121½ para. 1401-1408 (1989); LA. REV. STAT. ANN. § 51:2151—51:2156 (West 1987); ME. REV. STAT. ANN. tit. 27, § 303 (West 1988); MASS. ANN. LAWS ch. 231, § 85S (Law. Co-op. 1986); NEV. REV. STAT. ANN. §§ 598.970 - 598.978 (Michie 1989); N.J. STAT. ANN. §§ 2A:24A-1 — 2A:24A-8 (West 1987); N.M. STAT. ANN. § 13-4B-3 (Michie Supp. 1988) and §§ 56-11-1 to 56-11-3 (Michie Supp. 1986); N.Y. ARTS & CULT. AFF. LAW §§ 11.01—16.01 (McKinney 1984 & Supp. 1991); PA. STAT. ANN. tit. 73 §§ 2101-2110 (Supp. 1990); R.I. GEN. LAWS §§ 5-62-2 to 5-62-6 (1987).

40. See Paul Geller, *Comments on Possible U.S. Compliance with Article 6bis of the Berne Convention*, 10 COLUM.-VLA J.L. & ARTS 665, 668 (1986) (noting that the existence of such statutes in some states serves only to expose the lack of protection in others). The objectives of moral rights laws are also incidentally promoted by other state enactments such as anti-piracy statutes. See, e.g., California Record Piracy Law, CAL. PENAL CODE § 653w (West 1988 & Supp. 1991) (criminalizing failure of those who commercially market audio or audiovisual works to clearly identify the actual manufacturer, author, artist, performer, producer, programmer, or group on the outside cover box or jacket); the disclosure requirement of § 653w is neither violative of the First Amendment nor pre-empted by the Copyright Act. *People v. Anderson*, 286 Cal. Rptr. 734 (Ct. App. 1991).

41. N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney 1984); see Edward J. Damich, *The New York Artists' Authorship Rights Act: A Comparative Critique*, 84 COLUM. L. REV. 1733 (1984); Sarah Ann Smith, Note, *The New York Artists' Authorship Rights Act: Increased Protection and Enhanced Status for Visual Artists*, 70 CORNELL L. REV. 158 (1984).

tions thereof, in altered or mutilated form if the work is displayed, published or reproduced as being the work of the artist (or under circumstances in which it would reasonably be regarded as being the work of the artist) "and damage to the artist's reputation is reasonably likely to result therefrom."⁴² California's Art Preservation Act⁴³ attempts directly to prevent the loss or physical alteration of works of fine art, declaring that "the physical alteration or destruction of fine art, which is an expression of the artist's personality, is detrimental to the artist's reputation"⁴⁴

Visual Artists Rights Act of 1990

Congress continued to pursue establishment of a uniform national system of moral rights, claiming that its position "reflected neutrality, not antipathy."⁴⁵ During congressional consideration of proposed legislation designed to create such a system, it became clear that the ease with which these rights would coexist with the eco-

42. N.Y. ARTS & CULT. AFF. LAW § 14.03(1); see *Wojnarowicz v. American Family Ass'n*, 745 F. Supp. 130, 136-38 (S.D.N.Y. 1990) (Distribution of fragmented reproductions of an artist's work with attribution to the artist violated New York's Artists' Authorship Rights Act.). But see *Morita v. Omni Publications Int'l, Ltd.*, 741 F. Supp. 1107, 1114-15 (S.D.N.Y. 1990) (Juxtaposition of a poster created solely to depict anti-nuclear message together with a pro-nuclear text so as to place the work in a context unauthorized, and opposed, by the artist did not constitute a "mutilation" such as to violate the New York statute.) vacated as moot, 760 F. Supp. 45 (S.D.N.Y. 1991).

43. CAL. CIV. CODE § 987 (West 1982 & Supp. 1991).

44. CAL. CIV. CODE § 987(a) (West 1982 & Supp. 1991).

45. H.R. REP. NO. 609, 100th Cong., 2d Sess. 40 (1988). Indeed, even after this most recent enactment, Congress continues to contemplate additional artists' rights. As mandated by the Act, IIA § 608(b), on February 1, 1991 the Register of Copyrights requested comments on the feasibility of granting royalties to artists on resales of their works — although this is more truly an economic, rather than a moral, right. The right of *droit de suite* — the artist's right to receive a part of any profit made on a resale of his painting or sculpture — was rejected by the U.K. government in the White Paper that led to the CDPA. See INTELLECTUAL PROPERTY AND INNOVATION, 1986, CMND 9712, at ¶¶ 19.13-16 [hereinafter the White Paper]. The European Commission is continuing to examine the advisability of a Community initiative on the question of resale rights. Working Programme, Ch. 8.5. These rights will not be covered by the proposed council decision requiring compliance with the Berne Convention, see *supra*, note 25, as the Berne Convention permits, but does not require, member countries to extend *droit de suite*. Article 14*ter*. See generally Monroe E. Price, *Government Policy and Economic Security for Artists: The Case of the Droit de Suite*, 77 YALE L.J. 1333 (1968); see also William A. Carleton III, Note, *Copyright Protection for Visual Artists: A Display-Based Alternative to the Droit de Suite*, 76 CORNELL L. REV. 510 (1991); Marshall A. Leaffer, *Of Moral Rights and Resale Royalties: The Kennedy Bill*, 7 CARDOZO ARTS & ENT. L.J. 234 (1989); Gilbert S. Edelson, *The Case Against an American Droit de Suite*, 7 CARDOZO ARTS & ENT. L.J. 260 (1989). California is the only state in the United States that has enacted any such provision. See Artists' Resale Royalty Act, CAL. CIV. CODE § 986 (West 1982 & Supp. 1991), offering qualifying artists economic rights comparable to those given in some civil law jurisdictions under the *droit de suite*.

conomic exploitation of copyrights differed significantly from one type of copyrighted work to another. In particular, in order to secure the passage of generally applicable moral rights legislation, influential groups of copyright owners (such as motion picture producers and periodical publishers) would need to be placated. Accordingly, Congress decided to consider the claims of different types of authors separately,⁴⁶ and its first legislation in this area, the Visual Artists Rights Act of 1990 (Title VI of the JIA), is limited to a narrow range of copyrighted works.⁴⁷

The new law accords rights of "attribution" and "integrity" to authors of a "work of visual art,"⁴⁸ which is essentially limited to works that are single copies or limited editions.⁴⁹ While this limitation (in

46. While the considerable disagreement as to the moral rights that should be granted with respect to motion pictures caused Congress to hesitate in extending moral rights to such works, it has addressed the immediate concerns of artists regarding the colorization of motion pictures through the enactment of the National Film Preservation Act of 1988, Pub. L. No. 100-446, 102 Stat. 1782 (1988), which prevents the material alteration (including the colorization) of designated films unless the film is conspicuously labelled to indicate the alteration or colorization. *Id.* at § 4. See Anna S. White, Comment, *The Colorization Dispute: Moral Rights Theory As a Means of Judicial and Legislative Reform*, 38 EMORY L.J. 237, 267-276 (1989). This Act is scheduled to expire on September 27, 1991, and its proposed successor, H.R. 2372, 102d Cong., 1st Sess. (1991), omits the "conspicuous labelling" requirement. In light of this development, the author of the film preservation legislation, Rep. Robert J. Mrazek (D-N.Y.), has introduced a "Film Disclosure Bill," H.R. 3051, 102d Cong., 1st Sess. (1991), that would declare breaches of labelling requirements to be violations of an amended Section 43 of the Lanham Act.

47. See Pub. L. No. 101-650, 104 Stat. 5128 (1990) (codified in scattered sections of 17 U.S.C.A.); H.R. REP. NO. 514, 101st Cong., 2d Sess. 9 (1990). Existing state and federal laws may still protect the moral rights of authors of works not covered by this Act; rights under the common law or statutes of any state are preempted only with respect to works of visual art to which the rights conferred by the Visual Artists Rights Act apply. 17 U.S.C.A. § 301(f)(1) (West Supp. 1991).

48. Although the Act purports to apply to "works," it protects particular copies rather than the incorporeal "work" as copyright law would regard that term. See Ginsburg, *supra* note 7, at 481-84 (explaining the consequences of the Act protecting copies, not the image depicted therein). For example, mass produced copies of a work initially produced in a limited edition will not be protected notwithstanding that they embody the same image as the initial edition.

49. The new law defines a "work of visual art" as:

- (1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or
- (2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

17 U.S.C.A. § 101 (West Supp. 1991). Specifically excluded from the definition are works for hire, works not the subject of copyright protection, and any poster,

effect, to works of "fine art" rather than those of mass production) appears to flout the basic copyright principle of aesthetic neutrality, it succeeds in targeting for protection works which are commonly seen as the most appropriate recipients of moral rights.⁵⁰

The right of attribution permits artists to claim and disclaim authorship. The artist has the right to be identified with works which are his or hers, and to prevent any identification with works that are not. Similarly, the artist has the right to prevent identification with any of his or her works which have been distorted, mutilated or otherwise modified in a manner that would be prejudicial to the artist's honor or reputation.⁵¹ The right of integrity gives visual artists the right to prevent (i) any "intentional distortion, mutilation, or other modification of [a] work [of visual art] which would be prejudicial to his or her honor or reputation,"⁵² or (ii) "any [intentional or grossly negligent] destruction of a work of recognized stature."⁵³ The term "work of recognized stature" is not elaborated upon in the Act or legislative history. In an earlier version of the bill (H.R. 2690), Congress deleted the concept of a "work of recognized stature," commenting that such language would not only increase litigation by creating "a battle of the expert witnesses" on the issue of

map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, database, electronic information service, electronic publication, or similar publication, or any merchandising item or advertising, promotional, descriptive, covering or packaging material or container. See *id.*

50. See Ginsburg, *supra* note 7, at 479 (arguing that the unique importance of the physical object in the case of "works of visual art" sets moral rights in such works apart from others).

51. 17 U.S.C.A. § 106A(a)(1)-(2) (West Supp. 1991).

52. The "honor" or "reputation" to be considered is the "artistic or professional honor or reputation of the individual as embodied in the [protected] work. . . . [A]ny evidence [of the general character of the plaintiff] is irrelevant." H.R. REP. NO. 514, 101st Cong., 2d Sess. 15 (1990). Modifications which are the result of the passage of time or the inherent nature of the materials used by the artist do not constitute "distortion[s], mutilation[s], or other modification[s]" within the meaning of the Act. 17 U.S.C.A. § 106A(c)(1) (West Supp. 1991). Similarly, modifications which are the result of conservation efforts or the public presentation of the work are not actionable as "destruction[s], distortion[s], mutilation[s] or other modification[s]" unless they are caused by gross negligence. 17 U.S.C.A. § 106A(c)(2) (West Supp. 1991). Accordingly, galleries and museums retain discretion as to lighting, placement or framing of a work. Special rules and procedures are laid down with respect to the removal of works of visual art incorporated into buildings. 17 U.S.C.A. § 113(d)(1) (West Supp. 1991); see generally Katherine Marik, *The Visual Artists Rights Act of 1990: The United States Recognizes Artists and Their Rights*, 8 ENT. & SPORTS L. 7, 9-10 (1991). On August 13, 1991, the Copyright Office issued a final regulation establishing a Visual Arts Registry for the filing of statements and documentation relating to works of visual art incorporated in buildings. Copyright Office Final Rule Establishing a Visual Arts Registry, 56 Fed. Reg. 38,340 (1991) (to be codified at 37 C.F.R. § 201.25).

53. 17 U.S.C.A. § 106A(a)(3) (West Supp. 1991).

"recognized stature," but also might exclude from protection "less well-known or appreciated artists [who] also have honor and reputation worthy of protection."⁵⁴ Its reintroduction in the final version of the legislation — calling for judicial critique of the stature of art — is unfortunate. All civil remedies available for copyright infringement⁵⁵ are available for any breach of these moral rights,⁵⁶ although infringement is not subject to criminal penalty.⁵⁷

These rights are granted to the author of the work of visual art and are independent of ownership of the copyright. The transfer of a physical object embodying the work or the transfer of the copyright in the work does not affect the ownership of the moral rights. Conversely, the waiver (to the extent permitted) of moral rights does not operate to transfer, or in any way affect, the ownership of the physical object or the copyright in the work.⁵⁸

The moral rights granted by this Act endure for the life of the author,⁵⁹ although state laws extending protection beyond the life of the author are not preempted by this limitation.⁶⁰ The rights are

54. H.R. REP. NO. 514, 101st Cong., 2d Sess. 15 (1990).

55. Registration of authorship is not a prerequisite to the institution of a suit for violation of moral rights or the availability of remedies. Registration does, however, remain a prerequisite for most copyright infringement actions, 17 U.S.C.A. § 411(a) (West Supp. 1991), and even in those for which it is not (e.g., actions for infringement of copyright in a "Berne Convention work"), failure to register may limit the range of remedies at an owner's disposal. 17 U.S.C.A. § 412 (West Supp. 1991).

56. 17 U.S.C.A. § 501(a) (West Supp. 1991). Although the Act extends the copyright defense of fair use to actions for infringement of moral rights, JIA § 607, Congress "recognize[d] that it is unlikely that such claims will be appropriate given the limited number of works covered by the Act, and given that the modification of a single copy or limited edition of a work of visual art has different implications for the fair use doctrine than does an act involving a work reproduced in potentially unlimited copies." H.R. REP. NO. 514, 101st Cong., 2d Sess. 22 (1990).

57. 17 U.S.C.A. § 506(f) (West Supp. 1991).

58. 17 U.S.C.A. § 106A(e)(2) (West Supp. 1991).

59. 17 U.S.C.A. § 106A(d)(1) (West Supp. 1991). *But see infra* note 60 (rights with respect to works protected under JIA § 610(b)(1) endure for period co-extensive with copyright). The term of protection for joint works extends for the life of the last surviving author. 17 U.S.C.A. § 106A(d)(3) (West Supp. 1991). "All terms run . . . to the end of the calendar year in which they . . . expire [as in copyright]." 17 U.S.C.A. § 106A(d)(4) (West Supp. 1991). Compare CDPA § 86 (moral rights endure for period co-extensive with copyright, except right to prevent "false attribution" which subsists until twenty years after author's death).

60. 17 U.S.C.A. § 301(f)(2)(C) (West Supp. 1991). When, in the final version of the bill, the duration of the rights granted was limited to the life of the author, this provision became necessary in order to ensure compatibility with the Berne Convention. H.R. 5316, 101st Cong., 2d Sess., Cong. Rec. 13314 (1990); *Cf. Ginsburg, supra* note 7, at 484-85 (questioning United States compliance, on the national level, with duration requirements of Article 6bis of Berne Convention). The Act applies only to acts committed, and works created, after its effective date, although it will give coverage (against acts committed after that date) to works created before then but in which the author still holds title. JIA § 610(b). The rights in this

personal to the author and thus cannot be transferred.⁶¹ However, the rights can be waived, permitting activities that otherwise would be actionable.⁶² In order to be effective the waiver instrument must (a) be in writing, (b) be signed by the author, and (c) specifically identify the work, and the uses of the work, to which the waiver applies.⁶³ Moreover, any waiver that is obtained is personal to the recipient; it cannot be transferred to a third party. A third party must obtain a further waiver directly from the author.⁶⁴

Finally, in light of the current debate upon government censorship of art, the Act provides that "this title does not authorize any governmental entity to take any action or enforce restrictions prohibited by the First Amendment to the United States Constitution."⁶⁵ This supererogatory acknowledgment of the limits of Congressional authority effects nothing; it is a political symbol and no more. With or without such a declaration, Congress cannot authorize the violation of the United States Constitution.⁶⁶

latter category endure for a period co-extensive with the copyright. 17 U.S.C. § 106A(d)(2) (West Supp. 1991). The effective date of the Act is six months after its enactment. JIA § 610(a).

61. 17 U.S.C.A. § 106A(e)(1) (West Supp. 1991). The final version of the Visual Artists Rights Act reduced the term of protection included in earlier versions of the bill such that the rights of attribution and integrity generally do not endure beyond the death of the author. Accordingly, it deleted a section that had provided that upon the author's death the rights of attribution and integrity, and the authority to waive them, vested according to state laws of testacy or intestacy. *See, e.g.,* H.R. 2690, 101st Cong., 1st Sess. (1989); H.R. Rep. No. 514, 101st Cong., 2d Sess. 19 (1990). However, this deletion also excised any provision for the post-mortem ownership of rights with respect to works referred to in JIA § 610(b)(1), which may endure beyond the death of the author. *See supra* note 60. There is no indication that Congress intended to alter the earlier provision that state laws of testacy and intestacy govern such ownership.

62. 17 U.S.C.A. § 106A(e)(1) (West Supp. 1991). While conceding that the availability of waivers may operate to circumvent the effectiveness of these new rights, Congress accepted that "the artist is better protected under a regime requiring specificity of waivers than under one where an ideologically pure no-waiver law is rarely in fact observed." *The Visual Artists Rights Act of 1989: Hearings on H.R. 2690 Before the Subcomm. on Courts, Intellectual Property, and the Administration of Justice of the House Comm. on the Judiciary*, 101st Cong., 1st Sess. 13 (1989) (statement of Prof. Jane C. Ginsburg). In the U.K., where similar reforms were recently enacted, the availability of waivers, CDPA § 87, has led to claims that writers' moral rights are being "trampled on." Simon Tait, *Writers See Moral Rights Lost Through Act Waiver*, *THE TIMES*, April 21, 1990. As a result of similar concerns, the Act requires the Register of Copyrights to study and to report to Congress on the extent that artists' rights have been waived. JIA § 608(a)(1).

63. 17 U.S.C.A. § 106A(e)(1) (West Supp. 1991). Blanket waivers for any purpose will not be effective. H.R. Rep. No. 514, 101st Cong., 2d Sess. 19 (1990).

64. H.R. Rep. No. 514, 101st Cong., 2d Sess. 18-19 (1990). In the case of a joint work, the waiver of rights by one author will bind his joint authors. 17 U.S.C.A. § 106A(e)(1) (West Supp. 1991).

65. JIA § 609.

66. One author has noted (and rejected) the comparison drawn by critics of the

Computer Software Rental

The Computer Software Rental Amendments Act of 1990, (Title VIII of the JIA), makes it an infringement of copyright to rent a computer program for commercial purposes unless authorized by the copyright owner.⁶⁷ This Act extends to computer software the protections previously granted to phonorecords under United States copyright law,⁶⁸ by creating an exception to the "first sale doctrine."

The first sale doctrine, now contained in § 109(a) of the Copyright Act,⁶⁹ permits the owner of a lawfully made copy of a copyrighted work to sell, otherwise dispose of, or use *that copy* without the copyright owner's permission. The 1984 Act restricted the first sale doctrine out of concern that the record rental business facilitated illicit reproduction of copyrighted works. The recent amendments arise out of a similar concern — what Congress perceived as the "embryo of a business of rental of software for the purpose of copying."⁷⁰

The prohibition on rental of computer software is subject to three important exceptions. First, it does not apply to rentals for nonprofit purposes by nonprofit libraries (provided that all copies of software lent by such institutions bear a warning notice in the form prescribed by the Register of Copyrights) or nonprofit educational institutions. Second, if a program is embodied in a machine or product and that program cannot be copied during the ordinary operation of the machine or product, the rental of that machine or product will not be actionable. This exception ensures that the distribution of many consumer products which contain computer programs (e.g., automobiles, calculators) will not be affected by the amendment. Finally, the prohibition does not extend to the rental of programs embodied in, or used in conjunction with, "limited purpose computers" (such as those designed for playing video games). The legislative rationale for the last exception is the lack of evidence that the rental market for electronic audiovisual games played on limited purpose computers results in the copying of the programs that generate the

Act between the provisions of the flag desecration statute struck down by the United States Supreme Court, *Texas v. Johnson*, 491 U.S. 397 (1989) (Act of burning American flag was expressive conduct protected by First Amendment.), and the similar prohibition imposed by the Visual Artists Rights Act with respect to works of visual art. Marik, *supra* note 52, at 10-11.

67. Pub. L. No. 101-650, 104 Stat. 5134 (1990) (codified in scattered sections of 17 U.S.C.A.). The infringer in this situation is subject to civil but not criminal sanctions. For a more detailed discussion of the Computer Software Rental Amendments Act of 1990 see Richard Raysman & Peter Brown, *The Computer Software Rental Bill*, N.Y. L.J. 3 (1990).

68. See Record Rental Amendment Act of 1984, Pub. L. No. 98-450, 98 Stat. 1727 (1984) (codified in scattered sections of 17 U.S.C.) [hereinafter 1984 Act].

69. 17 U.S.C. § 109 (1988).

70. S. REP. NO. 265, 101st Cong., 2d Sess. 5 (1990).

game.⁷¹

This restriction of the owner's rights under the first sale doctrine affects the creation for the copyright owner of the so-called "rental right." Such a right was introduced into United Kingdom law by Section 18(2) of the CDPA, and applies in the United Kingdom to films in addition to sound recordings and computer programs. This concept is affirmatively cast by the United Kingdom Act as the copyright owner's exclusive right to rent copies to the public, whereas United States law frames the issue negatively as a limitation upon the rights afforded by the first sale doctrine. Additionally, although under both United States and United Kingdom law the copyright owner can refuse to permit rental, the United Kingdom government — fearing resultant anti-competitive effects — has expressly reserved the power to introduce compulsory licensing.⁷²

Fair Use

Earlier versions of this legislation contained provisions aimed at permitting more extensive quotation from unpublished works. These provisions were intended to assimilate the defense of "fair use,"⁷³ which allows the use of copyrighted material in a reasonable

71. H.R. REP. NO. 735, 101st Cong., 2d Sess. 8-9 (1990). Unsuccessful attempts were made in the last session of Congress to impose a limited prohibition against the commercial rental, without the copyright owner's permission, of programs embodied in electronic circuitry which is contained in, or used in conjunction with, limited purpose computers designed primarily to play home video games, for the period of one year from the date of their first commercial retail sale from inventory in the United States. See H.R. 5297, 101st Cong., 2d Sess. (1990), reprinted in 40 Pat. Trademark & Copyright J. (BNA) 276 (1990).

72. See CDPA § 66; see also White Paper, ¶ 19.12. The issue has also been considered at the European Community level. See Green Paper on Copyright and The Challenge of Technology, COM(88)172 final at ch. 4.6-4.12; Working Programme, ch. 4.3; *Proposal For A Council Directive on Rental Right, Lending, and Certain Rights Related to Copyright*, Ch. 1, adopted by the European Commission on December 5, 1990.

73. See 17 U.S.C. § 107 (1988); see generally WILLIAM F. PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW* (1985). The defense of "fair use" approximates to that of "fair dealing" in United Kingdom law. Cf. CDPA §§ 29-30. Early case law suggested that unpublished works were to be given absolute protection from unauthorized publication, *Prince Albert v. Strange*, [1849] 64 Eng. Rep. 293, 2 De G. & Sm. 652, on appeal [1849] 41 Eng. Rep. 1171, 1 Mac. & G. 25, and that, accordingly, the defense of fair dealing was inapplicable to such works. *British Oxygen Co., Ltd. v. Liquid Air, Ltd.*, [1925] Ch. 383, 393. However, while the unpublished nature of the work remains a factor to be considered, *Beloff v. Pressdram, Ltd.*, [1973] 1 All E.R. 241, 263, it is probably no longer an absolute bar to the defense of fair dealing. *Id.* See also *Hubbard v. Vosper*, [1972] 2 Q.B. 84, 94-95 (Fair dealing can be defense to unauthorized publication of a work which, although not published to the world at large, was widely circulated.); *Distillers Co. (Biochemicals) Ltd. v. Times Newspapers, Ltd.*, [1975] 1 Q.B. 613, 625 (unpublished materials produced during discovery not so widely circulated that their unauthorized publication by a newspaper could constitute fair dealing). Cf. *Higgins v. Hindley*, Ct. App.,

manner without the copyright owner's consent, with respect to both published and unpublished material. In *Harper & Row, Publishers, Inc. v. Nation Enters.*,⁷⁴ the United States Supreme Court, in rejecting a fair use defense, commented that "the unpublished nature of a work is '[a] key, though not necessarily determinative factor' " and that "[t]he scope of fair use is narrower with respect to unpublished works."⁷⁵ The proposed reforms were sought by publishers, particularly of biographies, in the wake of subsequent Second Circuit decisions in *Salinger v. Random House, Inc.*⁷⁶ and *New Era Publications Int'l, ApS v. Henry Holt & Co. (New Era I)*,⁷⁷ which, in purporting to follow *Harper & Row*, severely restricted the use of unpublished materials.

However, concerns were expressed by the computer industry that the proposal would lessen the protection afforded computer programs (which are, in the main, technically unpublished), and these concerns ultimately resulted in the exclusion of the fair use amendments from the final package of reforms.⁷⁸ In presenting the final version of the bill to Congress, Rep. Kastenmeier (D-Wis.), chairperson of the House sub-committee that deals with copyright, expressed his regret that an agreement could not be reached between publishers and the computer industry but noted that "this remains an important policy issue for Congress."⁷⁹ The continuing importance of the issue was emphasized when a similar fair use reform bill was immediately introduced in the new session of Congress.⁸⁰

Civ. Div. (Aug. 24, 1983), *esp. per Kerr, L.J.* (There would be no arguable defense of fair dealing were it not for the previous publication of the work.). Although the defense of fair dealing was broadened by the CDPA, *British Broadcasting Corp. v. British Satellite Broadcasting Ltd.*, [1991] 3 W.L.R. 174, 177, that change did not purport to alter the relevance of the unpublished nature of a work to the scope of the defense. That the permissible unauthorized use of unpublished works would be lesser in the United Kingdom is to be expected because of a less developed right to privacy, which could operate to prevent intrusion into private affairs, than there is in the United States. Pierre N. Leval, *Towards A Fair Use Standard*, 103 HARV. L. REV. 1105, 1129 (1990).

74. 471 U.S. 539 (1985).

75. *Id.* at 554.

76. 650 F. Supp. 413 (S.D.N.Y. 1986), *rev'd*, 811 F.2d 90 (2d Cir.), *reh'g denied*, 818 F.2d 252 (2d Cir.), *cert. denied*, 484 U.S. 890 (1987).

77. 684 F. Supp. 808 (S.D.N.Y.), 695 F. Supp. 1493 (S.D.N.Y. 1988), *aff'd on other grounds*, 873 F.2d 576 (2d Cir.), *reh'g en banc denied*, 884 F.2d 659 (2d Cir. 1989), *cert. denied*, 493 U.S. 1094 (1990).

78. See Roger Cohen, *Software Issue Kills Liberal Amendment to Copyright Laws*, N.Y. TIMES, Oct. 13, 1990, at A1; H.R. 5498, 101st Cong., 2d Sess., (1990).

79. H.R. 5498, 101st Cong., 2d Sess. Cong. Rec. 8270 (1990). It also remains an important issue for writers. The Authors Guild, a writers' organization, has recently formed the Committee to Preserve Fair Use to press for legislation that would define writers' right to make fair use of unpublished materials. See Roger Cohen, *Writers Mobilizing Against Restrictions on Using Quotations*, N.Y. TIMES, Feb. 20, 1991, at C11.

80. See S. 1035, 102d Cong., 1st Sess. (1991) (proposing addition to the fair

Arguably, the concerns provoked among publishers by the above decisions should have been somewhat alleviated by the subsequent decisions of the Second Circuit in *New Era Publications Int'l, ApS v. Carol Publishing Group (New Era II)*⁸¹ and *Wright v. Warner Books, Inc.*⁸²

In *Wright*, both Judge Walker, in the District Court, and the Court of Appeals expressly rejected the proposition — which publishers feared followed from the *Salinger* and *New Era I* decisions — that there is a *per se* rule against copying unpublished expressive material.⁸³ Although *New Era II* dealt specifically with the permissible use of *published* material, the court accepted the principle that expressive material can be used to convey facts, and thus can be permissibly quoted under the doctrine of fair use.⁸⁴ The rejection of this argument by the majority in *New Era I*⁸⁵ was perceived as a central prop of the barrier erected by the *New Era I* court against the copying of unpublished material.⁸⁶

use section of the Act providing that "the fact that a work is unpublished is an important element which tends to weigh against a finding of fair use, but shall not diminish the importance traditionally accorded to any other consideration under this section, and shall not bar a finding of fair use, if such finding is made upon full consideration of all [other] factors"; H.R. 2372, 102d Cong., 1st Sess. (1991).

81. 729 F. Supp. 992 (S.D.N.Y.), *rev'd*, 904 F.2d 152 (2d Cir.), *cert. denied*, 111 S.Ct. 297 (1990).

82. 748 F. Supp. 105 (S.D.N.Y. 1990), *aff'd*, No. 90-9054 (2d Cir. Nov. 21, 1991) (A biographer's minimal use of quotations from, and paraphrasing of, the unpublished writing of a deceased author constituted fair use.).

83. *Wright*, 748 F. Supp. at 111; No. 90-9054, slip op. at 19 (2d Cir. Nov. 21, 1991) (although concluding, contrary to District Court, that "nature of copyrighted work," in fair use analysis favored plaintiff, affirming that "[n]either *Salinger*, *Harper & Row*, nor any other case . . . erected a *per se* rule regarding unpublished works.").

84. *New Era II*, 904 F.2d at 156.

85. *New Era I*, 873 F.2d at 583, 884 F.2d at 660-61.

86. Judges in the Second Circuit have elaborated upon their views in *Salinger* and *New Era I* not only in subsequent decisions, but also in testimony to Congress on the proposed legislation and in various legal publications and lectures. See, e.g., *Hearings on H.R. 4263 and S. 2370, Unpublished Works and Fair Use, Before the Subcommittee on Courts, Intellectual Property, and the Administration of Justice of the House Committee on the Judiciary*, 101st Cong., 2d Sess. (1990) (Statements of Chief Judge Oakes and Judges Leval and Miner); Jon O. Newman, *Not the End of History: The Second Circuit Struggles with Fair Use*, 37 J. COPYRIGHT Soc'y 12 (1989); Jon O. Newman, *Copyright Law and the Protection of Privacy*, 12 COLUM.-VLA J.L. & ARTS 459 (1988); Pierre N. Leval, *Fair Use or Foul?: The Nineteenth Donald C. Brace Memorial Lecture*, 36 J. COPYRIGHT Soc'y 167 (1989); Pierre N. Leval, Comment, *Towards a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990); Roger J. Miner, *Exploiting Stolen Text: Fair Use or Foul Play*, 37 J. COPYRIGHT Soc'y 1 (1989); James L. Oakes, *Copyrights and Copyremedies: Unfair Use and Injunctions*, 18 HOFSTRA L. REV. 983 (1990); see also Mary Sarah Bilder, *The Shrinking Back: The Law of Biography*, 43 STAN. L. REV. 299, 312-33 (1991); Lloyd L. Weinreb, Comment, *Fair's Fair: A Comment on the Fair Use Doctrine*, 103 HARV. L. REV. 1137 (1990); Vincent H. Peppe, Note, *Fair Use of Unpublished Materials in*

The reversal of these apparently prevailing principles suggests that the Second Circuit is, from within the confines imposed by the Supreme Court in *Harper & Row*, attempting to articulate an approach that permits a degree of access to unpublished material that exceeds the restrictive edict of *Salinger*.⁸⁷ If that is the case, the problems experienced by Congress in balancing competing interests may warrant that the issue be left to the courts to resolve in conformity with existing principles.

COPYRIGHT REMEDY CLARIFICATION ACT

The Copyright Remedy Clarification Act makes clear that states, their instrumentalities, and officers and employees of states acting in their official capacities, are liable for infringement of copyright and that the remedies available for such infringement are the same as in any suit against a private person.⁸⁸ The need for such a clarification stems from the decision of the United States Supreme Court in *Atascadero State Hosp. v. Scanlon*.⁸⁹ In *Atascadero*, the Court held that Congress can only abrogate the Eleventh Amendment, which provides states with immunity from suits in federal court⁹⁰ for

the Second Circuit: The Letters of the Law, 54 BROOKLYN L. REV. 417 (1988); Christopher A. Murphy, Note, *Salinger v. Random House: The Author's Interests in Unpublished Materials*, 12 COLUM.-VLA J.L. & ARTS 103 (1987).

87. See David Goldberg and Robert J. Bernstein, *An Update on Fair Use*, N.Y. L.J., Oct. 19, 1990, at 3, (concluding that "future Second Circuit panels will be more receptive to the fair use defense in the context of biographical works quoting from unpublished materials."); see also Melvin L. Wulff, *The Fair Use Doctrine After 'New Era'*, N.Y. L.J., Dec. 7, 1990, at 1.

88. Copyright Remedy Clarification Act § 2(a), 17 U.S.C.A. §§ 501(a), 511 (West Supp. 1991). The Semiconductor Chip Protection Act of 1984, Pub. L. No. 98-620, 98 Stat. 3347 (1990) (codified at 17 U.S.C. §§ 901-914 (1988)), is also amended similarly to abrogate states' immunity. Copyright Remedy Clarification Act, § 2(b), 17 U.S.C.A. §§ 910(a), 911(g) (West Supp. 1991). In *Chew v. California*, 893 F.2d 331 (Fed. Cir.), cert. denied, 111 S.Ct. 44 (1990), the Court of Appeals for the Federal Circuit held that states are immune from liability for damages in patent infringement suits. See also *Kersavage v. University of Tenn.*, 731 F. Supp. 1327 (E.D. Tenn. 1989) (state university was absolutely immune under Eleventh Amendment from all claims for damages or injunctive relief sought in patent infringement suit brought in federal court). This prompted the introduction of a parallel bill in the field of patents which would have eliminated the immunity, the Patent Remedy Clarification Bill, H.R. 3886, 101st Cong., 2d Sess. (1990); H.R. 5598, 101st Cong., 2d Sess. (1990). This bill made no progress during the last session of Congress. Since the demise of the bill, the courts have refused to limit the holding of *Chew*. See *Jacobs Wind Elec. Co. v. Florida Dep't of Transp.*, 919 F.2d 726 (Fed. Cir. 1990), leading to the prompt reintroduction of the Patent and Plant Variety Protection Remedy Clarification Bill, S. 578, 102d Cong., 1st Sess. (1991), in the new session of Congress, on March 21, 1991. On the same day, the Trademark Remedy Clarification Bill, S. 579, 102d Cong., 1st Sess. (1991), which would similarly amend the Lanham Act, was also introduced.

89. 473 U.S. 234 (1985).

90. As a result of exclusive federal jurisdiction over copyright claims under 17

money damages,⁹¹ by "making its intention unmistakably clear in the language of the statute."⁹²

Prior to *Atascadero*, some courts had concluded that the language of the Copyright Act sufficiently evinced a Congressional intent to abrogate the states' eleventh amendment immunity.⁹³ However, *Atascadero*, in the opinion of one court, "wiped the slate clean,"⁹⁴ and the increased stringency of its test was the basis for a series of appellate decisions refusing to hold state entities⁹⁵ liable for copyright infringement because the Copyright Act did not demonstrate unequivocal congressional intent to do so.⁹⁶ The courts that ren-

U.S.C. § 301 (1988) and 28 U.S.C. § 1338 (1988), state claims are unavailable to redress copyright infringement. Accordingly, the restrictions of the Eleventh Amendment operate in this context to determine not *where* a claim may be pursued, but *whether* a claim may be pursued. Courts deciding this issue noted the concern evoked by exclusivity of jurisdiction, but felt constrained by *Atascadero* to decide as they did. *Lane v. First Nat'l Bank of Boston*, 871 F.2d 166, 173-74 (1st Cir. 1989); *BV Engineering v. University of Cal., Los Angeles*, 858 F.2d 1394, 1400 (9th Cir. 1988), *cert. denied*, 489 U.S. 1090 (1989). However, support for a distinction based upon exclusive federal jurisdiction can be found in the language of *Atascadero* itself. See *Atascadero*, 473 U.S. at 240 n.2.

91. Some of the cases declining to permit money damages have, however, suggested that prospective injunctive relief may be available against the states. See *Lane*, 871 F.2d at 174.

92. *Atascadero*, 473 U.S. at 242. See also *Welch v. Texas Dep't of Highways and Public Transp.*, 483 U.S. 468 (1987); Jeffrey S. Schira, Note, *Sovereign Immunity to Copyright Infringement Actions After Atascadero*, 50 OHIO ST. L.J. 197 (1989).

93. See, e.g., *Mills Music, Inc. v. State of Arizona*, 591 F.2d 1278, 1284-86 (9th Cir. 1979); *Johnson v. University of Virginia*, 606 F. Supp. 321, 324 (W.D. Va. 1985); see also Susan Shoenfeld, *The Applicability of Eleventh Amendment Immunity Under the Copyright Acts of 1909 and 1976*, 36 AM. U.L. REV. 163 (1986); see generally John C. Beiter, Note, *Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?*, 40 VAND. L. REV. 225 (1987).

94. *Lane*, 871 F.2d at 169.

95. Damages may be available against the infringing individuals in their personal capacity. See e.g., *Richard Anderson Photography v. Brown*, 852 F.2d 114, 122 (4th Cir. 1988) ("The mere fact that [the official's] conduct was undertaken in the course of her state employment does not of course relieve her of individual liability, even if her employer could not be sued for it. A state may no more than an individual principal give its agent authority to commit torts without civil recourse."), *cert. denied*, 489 U.S. 1033 (1989). See also *Lane*, 871 F.2d at 174 ("[plaintiff] may . . . sue the responsible officials in their individual capacities for money damages"). Additionally, one court, while declining to permit suit against the state, noted that private parties may be sued for abetting the wrongful acts. *Id.*

96. See, e.g., *Richard Anderson Photography*, 852 F.2d 114 (state university immune from damages suit for copyright infringement stemming from unauthorized use of plaintiff's photographs); *BV Engineering*, 858 F.2d 1394 (state university immune from liability for infringement of copyright in computer programs and accompanying user manuals); *Lane*, 871 F.2d 166 (Commonwealth of Massachusetts immune from liability for infringement of copyright in compilations of financial data); see also *Woelffer v. Happy States of America, Inc.*, 626 F. Supp. 499, 504 (N.D. Ill. 1985) ("The sweeping language employed by Congress arguably in-

dered these decisions were aware of the consequences. However, the responsibility for meeting the *Atascadero* standard lay with Congress.⁹⁷

In 1990, Congress took up the challenge and passed the Copyright Remedy Clarification Act.⁹⁸ This statute confirms that Congress does intend, and did originally intend,⁹⁹ to abrogate the states' immunity for copyright infringement. The Act should resolve problems that had occurred particularly in the market for educational materials. Testimony before the House sub-committee in connection with earlier versions of the bill revealed that two public universities had withdrawn from negotiations with the Copyright Clearance Center for a photocopying license because they believed they were immune from liability.¹⁰⁰ Such potential disregard of copyrights existed not only in universities, and not only with respect to photocopying; in theory, any state institution previously could have decided to ignore the copyright law with apparent impunity. As a result, lucrative markets, such as educational computer software, would have been affected. The Copyright Remedy Clarifi-

cludes states within the class of copyright . . . infringers. Under *Atascadero*, however, this is not enough to abrogate sovereign immunity.").

97. See, e.g., *BV Engineering*, 858 F.2d at 1400 ("We recognize that our holding will allow states to violate the federal copyright laws with virtual impunity. It is for Congress, however, to remedy this problem."). See also *Lane*, where the Court observed that:

We are not without sympathy for [plaintiff's] plight. It can persuasively be argued that our holding today, rather than furthering Congress' encouragement of creative endeavor, undermines it — and does so without a correspondingly beneficial tradeoff. If the objectives of the Copyright Act and the purposes of the Eleventh Amendment are weighed with no thumb on the scale, the societal balance likely tips in favor of abrogation. Yet courts are not free in instances like this to impose their value judgements on the community; policy choices of this kind are for the legislative, not the judicial branch.

871 F.2d at 175.

98. It has long been settled that Congress could legislate to remove states' immunity when acting to enforce the substantive provisions of the fourteenth amendment. *Fitzpatrick v. Bitzer*, 427 U.S. 445, 456 (1976). However, at the time of *Atascadero* it remained an open question whether it could do so when legislating pursuant to a provision enacted anterior to the Eleventh Amendment. The Supreme Court has since determined, in *Pennsylvania v. Union Gas Co.*, 491 U.S. 1 (1989), that Congress can, and it is submitted that there is no basis upon which to distinguish between its authority to do so under the Commerce Clause and its authority pursuant to the Copyright Clause.

99. The amendments made by this Act, however, shall only affect violations that occur on or after the enactment of the Act. See Copyright Remedy Clarification Act § 3.

100. *Copyright Remedy Clarification Act: Hearings on H.R. 1131 Before the House Subcomm. on Courts, Intellectual Property and the Administration of Justice*, 101st Cong., 1st Sess. (1989) (Statement of Myer Kutz, John Wiley & Sons Inc.), quoted in 38 Pat. Trademark & Copyright J. (BNA) 291 (1989).

cation Act should make investment in markets such as educational materials more secure.

CONCLUSION

These reforms not only introduce substantive rights for visual artists and architects and close loopholes in existing copyright protection. They also provide welcome evidence that, rather than inducing complacency, United States accession to the Berne Convention has provided the impetus for further critical assessment by Congress of the adequacy of intellectual property protection in the United States.

