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Play It Again Samantha? Another Argument for U.S. Adherence to Article 6bis of the Berne Convention

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PLAY IT AGAIN SAMANTHA? Another Argument for U.S. Adherence to Article 6bis of The Berne Convention

> Ain't Singin' for Miller / Don't Sing For Bud / I won't sing for politicians / Ain't Singin' for Spuds. . .[1]

When Neil Young penned the above words to the song *This Note's For You*,[2] he was chastising artists for allowing their work to promote the advertising of such commercial products as beer, soft drinks, athletic shoes and raisins. Although the artistic integrity of such "selling out" of rock n' roll is questionable, no one would question an artist's legal right to exploit that work.[3] In fact, the recent trend in using new and classic tracks to promote products has led to a resurgence of many baby boomer songs, with a secondary effect of refurbishing many aging rockers' careers. Music marketing has become big business. Yet, such Madison Avenue tactics, unquestionably a highly debatable topic, is beyond the scope of this comment. Rather, the legalities of a copyright holder, one not the originating artist/author, who exploits that work for profit is the focus of debate here.

If one accepts the premise that an artist who retains his copyright has the legal right to exploit that work in any manner, then a corollary to that proposition would be that a copyright holder, who may not necessarily be the originating artist, also has the exclusive right to exploit that work. But what of the original artist who voluntarily (or involuntarily) surrenders some or all rights in the work? Does that artist retain a *moral right*[4] in the fruits of his labor to protect the integrity of the artist and the work? And what of a work that enters the public domain upon expiration of its copyright? What protection is afforded that work?

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1. N. Young, This Note's For You.
2. *Id.*
3. A copyright holder's exclusive right to exploitation of the copyright is found in § 106 of The Copyright Act of 1976, 17 U.S.C. § 106 (West 1977 & Supp. 1986).
4. The concept of moral rights comes from the french *le droit moral*, and enjoys its greatest acceptance in the European countries of France, Germany and Italy. *See infra* note 5.

The moral rights doctrine of copyright law encompasses personal rights of authors and artists, as opposed to their proprietary right in the copyright.[5] Generally speaking, it protects the integrity of the author *and* the work.[6] More specifically, moral rights include:

1) The right to be known as the author of the work;
2) The right to prevent others from being named the author of the work;
3) The right to prevent others from falsely attributing the authored work to one who did not create it;
4) The right to prevent others from making deforming changes in the work;
5) The right to withdraw the work from distribution if it no longer represents the views of the author; and
6) The right to prevent others from using the work or author's name in such a way as to reflect on the author professionally.[7]

United States copyright law[8] does not recognize moral rights.[9] As a result, American courts have been forced to fashion a remedy using a myriad of theories,[10] with the most noticeable and unique being the use of section 43(a) of the Lanham Act.[11] The most famous case in which section 43(a) of the Lanham Act was used as a "back door" to the assertion of moral rights is *Gilliam v. American Broadcasting Companies.*[12] In *Gilliam*, the Monty Python comedy troupe sought a preliminary injunction to restrain the American Broadcasting Company ("ABC") from airing certain *Monty Python* programs licensed to ABC by the British Broadcasting Company ("BBC").[13] Monty Python was under agreement to the BBC to write, deliver, and perform scripts as part of a comedy series entitled "Monty Python's Flying Circus." Monty Python retained all rights in the script and "optimum control" over any major

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5. 2 M. NIMMER, NIMMER ON COPYRIGHT § 8.21[A], 8-247 (1987) [hereinafter NIMMER].

6. *Id.* These are the concepts of paternity and integrity; paternity is the right to be known as the author of the work, while integrity encompasses the right to prevent distortion of the work. *Id.*

7. *Id.*

8. The Copyright Act of 1976, 17 U.S.C. §§ 101-914 (West 1977 & Supp. 1986).

9. *See* Gilliam v. American Broadcasting Cos., 538 F.2d 14, 24 (2d Cir. 1976)("American copyright law. . .does not recognize moral rights or provide a cause of action for their violation, since the law [copyright law] seeks to vindicate the economic, rather than the personal, rights of authors."). *See also* Vargas v. Esquire, Inc., 164 F.2d 522 (7th Cir. 1947).

10. Courts have used a variety of available legal theories to implicitly recognize the substance of moral rights, such as unfair competition, defamation, invasion of privacy, and breach of contract. *See* NIMMER, *supra* note 5, at § 8.21[E], 8-248. *See also Gilliam*, 538 F.2d at 24.

11. The Lanham Act § 43(a), 15 U.S.C.A. § 1125(a) (West 1982).

12. 538 F.2d 14 (2d Cir. 1976). *See also* Jaeger v. American Int'l Pictures, Inc., 330 F. Supp. 274 (S.D.N.Y. 1971); Smith v. Montoro, 648 F.2d 602 (9th Cir. 1981).

13. 538 F.2d at 18.

changes. Under the same agreement, the BBC acquired licensing rights, and subsequently licensed the rights to certain Monty Python segments to Time-Life Films.[14] The agreement with Time-Life permitted editing only "for insertion of commercials, applicable censorship or governmental . . . rules and regulations, and National Association of Broadcasters and time segment requirements."[15] ABC in turn was under agreement with Time-Life to air two ninety minute specials of Monty Python programs.[16]

The first ninety minute special was aired with twenty-four minutes of the original ninety minutes edited out. "Appalled" at the mutilation caused by the editing, Monty Python attempted to negotiate with ABC, and upon failure to reach an agreement, filed an action to enjoin the broadcast of the second ninety minute special, plus damages.[17] The trial judge, although finding that "the plaintiffs have established an impairment of the integrity of their work" and "the damage that has been caused to the plaintiffs is irreparable by its nature,"[18] nonetheless denied injunctive relief. The trial judge refused Monty Python's request for an injunction on the grounds that the defendant ABC would be financially harmed if enjoined from airing the program; that it was questionable who owned the copyright to the recorded programs; that it was unclear whether or not Time-Life and the BBC were indispensable parties; and that the plaintiff had not pursued the matter diligently.[19]

The Court of Appeals for the Second Circuit, in granting injunctive relief to the plaintiffs,[20] proceeded on two theories. First of all, the court held that unauthorized changes in an author's work which are so extensive as to impair the integrity of the original work constitute infringement.[21] Judge Lumbard concluded that there was a likelihood that ABC's actions constituted infringement, as the editing was substantial and unauthorized.[22] The court further found that absent an express authorization of the right to make changes, such right is reserved to the author. This applies

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14. *Id.* at 17.
15. *Id.* at 17-18.
16. *Id.* at 18.
17. *Id.*
18. *Id.*
19. *Id.*
20. *Id.* at 26.
21. *Id.* at 21.
22. *Id.* at 19. Judge Lumbard noted that "approximately 27 per cent of the original program was omitted, and the editing contravened contractual provisions that limited the right to edit Monty Python material." *Id.*

even if the assignment/license is silent with respect to the right to make changes.[23] Since Monty Python retained control over the script via the scriptwriters' agreement with the BBC, the group therefore retained control over editing of the script for the recorded programs. Thus, the BBC as grantor could convey to ABC only those rights that it retained through the scriptwriters' agreement.[24]

Although the court's copyright infringement theory implicitly recognized the moral right of an author to prevent distortion or mutilation of his work,[25] one must not forget that the Copyright Act affords no protection of moral rights. The court's second theory of recovery, section 43(a) of the Lanham Act,[26] is the more creative of the two. Although the *Gilliam* court conceded that the Copyright Act affords no protection of moral rights, the court fashioned a unique remedy by using section 43(a) to implicitly recognize the moral right of the author to have his work attributed to him in the form in which he created it.[27]

Section 43(a) of the Lanham Act, which is the federal counterpart to state unfair competition laws, states in part:

> Any person who shall affix, apply, or annex, or use in connection with any goods or services . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into

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23. *Id.* at 22.

> A reading of the contract [between Monty Python and the BBC] seems to indicate that Monty Python obtained control over editing the script only to ensure control over the program recorded from the script. Since the scriptwriters' agreement explicitly retains for the group all rights not granted by contract, omission of any terms concerning alterations in the program after recording must be read as reserving to appellants exclusive authority for such revisions.

Id. (footnotes omitted).

24. *Id.* at 21.

25. *Id.* at 23-24.

> [T]he copyright law should be used to recognize the important role of the artist in our society and the need to encourage production and dissemination of artistic works by providing adequate legal protection for one who submits his work to the public. . . .[T]he cuts made constituted an actionable mutilation of Monty Python's work.

Id. (citation omitted).

26. 15 U.S.C.A. § 1125(a) (West 1982).

27. 538 F.2d at 24. The *Gilliam* court rationalized that:

> [C]ourts have long granted relief for misrepresentation of an artist's work by relying on theories outside the statutory law of copyright. . . . Although such decisions are clothed in terms of proprietary right in one's creation, they also properly vindicate the author's *personal* right to prevent the presentation of his work to the public in a distorted form.

Id. (emphasis added).

> commerce . . . shall be liable to a civil action by any person . . . who believes that he is or is likely to be damaged by the use of any such false description or representation.[28]

Under section 43(a), the *Gilliam* court held that presentation of a distorted work, if accompanied by the author's name, amounts to misrepresentation that could injure an author's business or personal reputation, and thus violate section 43(a), *even where no registered trademark is concerned.*[29] The court equated ABC's broadcast of the unauthorized edited version of the program as the presentation of a distorted work. Since Monty Python's name accompanied the program, that presentation amounted to an actionable misrepresentation which "impaired the integrity of appellants' work and represented to the public as a product of appellants that [which] was actually a mere caricature of their talents."[30] By leaving Monty Python's name "affixed" to the edited version of the program, ABC in fact created "a false designation of origin, or any false description or representation."[31] Under the *Gilliam* court's analysis, the above would hold true even in light of a notice disclaiming the author's approval of the edited version, as a disclaimer is not a defense to an action under section 43(a) of the Lanham Act.[32]

But the question still remains: Isn't the Lanham Act a *trademark* statute, not a *copyright* statute? How is it that the court uses a trademark statute to protect a common law copyright?[33] Also, since moral rights are generally recognizable through copyright law (outside the United States), how can it be that the court recognizes moral rights through trademark law? Such thought provoking questions were touched upon in Judge Gurfein's concurrence. Judge Gurfein posited that:

> So far as the Lanham Act is concerned, it is not a substitute for *droit moral* which authors in Europe enjoy. If the licensee may, by contract, distort the recorded work, the Lanham Act does not come into play. If the licensee has

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28. 15 U.S.C.A. § 1125(a) (West 1982).
29. 538 F.2d at 24.
30. *Id.* at 25.
31. Lanham Act § 43(a), *supra* note 28.
32. 538 F.2d at 25 n.13.
33. Since Monty Python's suit was to enjoin a *future* broadcast, its copyright in the unpublished script was a common law, rather than a statutory, copyright since statutory copyright can only exist after publication. *See id.* at 19-20 n.3. In his concurrence, Judge Gurfein "believe[d] that this is the first case in which a federal appellate court has held that there may be a violation of Section 43(a) of the Lanham Act with respect to a common-law copyright. The Lanham Act is a trademark statute, not a copyright statute." *Id.* at 26.

no such right by contract, there will be a violation in breach of contract.[34]

Judge Gurfein viewed section 43(a) of the Lanham Act as having limited applicability. Once the court determined that the unauthorized edited version of the program constituted an infringement of Monty Python's copyright, any additional theories of recovery beyond copyright infringement would be surplusage.[35] According to Judge Gurfein, an appropriate disclaimer would solve any problem of misdescription of origin to take the case out of the realm of the Lanham Act.[36]

Confused? Well, consider the case of *Smith v. Montoro*,[37] in which reverse passing off[38] was considered actionable under section 43(a) of the Lanham Act.[39] In *Smith*, actor Paul Smith contracted with an Italian film company to star in a film production. Smith was to receive star billing in both the film credits and advertisements promoting the film. The Italian film company licensed the United States distribution rights to the defendants, who subsequently removed Smith's name and substituted another actor's name in both the film credits and promotional advertisements.[40] Smith filed suit, and proceeded under several theories, including violation of section 43(a).[41] The court in *Smith* equated the unauthorized removal of Smith's name from the film credits and advertisements with an unauthorized removal or obliteration of an original trademark, thus constituting reverse passing off. This "reverse passing off" created a false designation of origin and false description violative of section 43(a) of the Lanham Act.[42]

Both *Gilliam* and *Smith* view the Lanham Act as remedial in nature, and give section 43(a) a very broad interpretation. By contrast, the district court in *Smith* adopted a narrower approach and

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34. *Id.* at 27 (emphasis in original). According to Judge Gurfein, the Lanham Act deals with misdescription of origin, not "artistic integrity." *Id.*

35. *Id.* at 26.

36. *Id.* at 27. Judge Gurfein's support for a disclaimer comports with District Judge Lasker's original grant of limited relief to Monty Python which required ABC to broadcast a disclaimer at the beginning of the program. *Id.* at 18.

37. 648 F.2d 602 (9th Cir. 1981).

38. The concept of "reverse passing off" concerns the unauthorized removal or obliteration of an original trademark on goods produced by another before resale of such goods. *See id.* at 605; *See also* NIMMER, *supra* note 5, at § 8.21[E], 8-270.2.

39. 648 F.2d at 607.

40. *Id.* at 603.

41. *Id.* Plaintiff also proceeded on theories of breach of contract, false light publicity, and violation of CAL. CIV. CODE § 3344 (West 1982), concerning appropriation of a persons likeness. *Id.*

42. *Id.* at 607.

concluded "that the Lanham Act is limited in its scope and intent to merchandising practices in the nature of, or *economically equivalent* to, palming off one's goods as those of a competitor, and•or misuse of trademarks and trade names."[43]

Although the *Gilliam* and *Smith* courts' use of the Lanham Act to protect moral rights is rather inventive, perhaps they are giving too broad an interpretation to the statute, an interpretation not originally contemplated by the framers of section 43(a). Nowhere in the legislative history of section 43(a) is there any indication that Congress intended the protection afforded both the *Gilliam* and *Smith* plaintiffs.[44] The reader should be reminded that the Lanham Act is a trademark statute, used to protect trademarks and trade names. Where are the trademarks in these cases? And remember, as Judge Gurfein stated in his concurrence in *Gilliam*, the Lanham Act is not a substitute for moral rights.[45]

Although use of the Lanham Act might be viewed as the most creative and inventive method of protecting moral rights under American law, it is by no means the sole theory courts have used to implicitly recognize moral rights in this country. In *Geisel v. Poynter Products, Incorporated*,[46] the United States District Court for the Southern District of New York recognized that moral rights could be asserted through contract law.[47] The court went on to state that although the civil law doctrine of moral right is not recognized by American law, parts of the doctrine exist as specific rights, such as copyright, libel, privacy and unfair competition.[48] In *Edison v. Viva International Limited*,[49] the New York Supreme Court, Appellate Division stated that an action for libel may exist where an author's name is retained on a work in which the changes

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43. *Id.* at 603 (emphasis in orginal).

44. S. REP. No. 1333, 79th Cong., 2d Sess., *reprinted in* 1946 U.S. CODE CONG. SERV. 1274 (1946). The senate report cites Justice Holmes in Prestonettes v. Coty, 264 U.S. 359 (1923):

> It [a trademark] does not confer a right to prohibit the use of the word or words. *It is not a copyright.* . . . A trademark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his.

U.S. CODE CONG. SERV. at 1275 (emphasis added). The basic purpose of trademark legislation, according to the senate report, is to protect both the consumer and the trademark owner. *Id.* at 1274.

45. 538 F.2d at 27.

46. 295 F. Supp. 331 (S.D.N.Y. 1968).

47. *Id. See also* Edison v. Viva Int'l, Ltd., 70 A.D.2d 379, 421 N.Y.S.2d 203 (1979)(moral rights subsumed by contract law); Granz v. Harris, 198 F.2d 585 (2d Cir. 1952).

48. 295 F. Supp. at 339-40 n.5.

49. 70 A.D.2d 379, 421 N.Y.S.2d 203 (1979).

made are such as to reflect adversely upon the author's reputation.[50] The Fifth Circuit, in *Zim v. Western Publishing Company*,[51] recognized that it is an invasion of privacy to use an author's name on a revised version of a previously published work by such author, if publication of the revision is unauthorized.[52] And finally, an action may lie for unfair competition whereby one passes off the work of another as the author's own work.[53] Most actions under section 43(a) of the Lanham Act also contain an unfair competition claim, as section 43(a) is considered the statutory counterpart to the common law claim of unfair competition.[54]

As might be evident from the above case law, the courts are silently screaming out for the recognition of moral rights and are haphazardly manipulating long recognized theories of law in an attempt to fit this foreign right into the jigsaw puzzle. Unfortunately, the piece just does not quite fit. There does not seem to be an adequate remedy at law for the protection of moral rights, at least not in this country. Perhaps due in part to this realization, two states have adopted their own version of 'moral rights' legislation. The California Art Preservation Act[55] is one such state statute. The Act provides that "[n]o person, except an artist who owns and possesses a work of fine art which the artist has created, shall intentionally commit, or authorize the intentional commission of, any physical defacement, mutilation, alteration, or destruction of a work of fine art."[56] Unfortunately, the California Act is applicable only to works of fine art,[57] and does not include works for hire.[58]

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50. *Id.* at 207.

51. 573 F.2d 1318 (5th Cir. 1978).

52. *Id.* at 1326-27.

53. This is known as the concept of false attribution. *See generally* Granz v. Harris, 198 F.2d 585 (2d Cir. 1952); Shaw v. Time-Life Records, 38 N.Y.2d 201, 379 N.Y.S.2d 390 (1975).

54. *See* Gilliam v. American Broadcasting Cos., Inc., 538 F.2d 14 (2d Cir. 1976); Jaeger v. American Int'l Pictures, Inc., 330 F. Supp. 274 (S.D.N.Y. 1971); Geisel v. Poynter Prods., Inc., 283 F. Supp. 261 (S.D.N.Y. 1968).

55. CAL. CIV. CODE § 987 (West 1982). Section 987(a) states:

> The Legislature hereby finds and declares that the physical alteration or destruction of fine art, which is an expression of an artist's personality, is detrimental to the artist's reputation, and artists therefore have an interest in protecting their works of fine art against such alteration or destruction; and that there is also a public interest in preserving the integrity of cultural and artistic creations.

Id.

56. *Id.* at § 987(c)(1).

57. *Id.* at § 987(b)(2). " 'Fine art' means an original painting, sculpture, or drawing, or an original work of art in glass, of recognized quality, but shall not include work prepared under contract for commercial use by its purchaser." *Id.*

58. *Id.* at § 987(b)(2) & (7). Section 987(b)(7) states: " 'Commercial use' means fine art

Also, in most cases there must be an *intentional* act of defacement, mutilation, alteration or destruction for the Act to apply.[59]

The other state statute, The New York Artists' Authorship Rights Act,[60] is similar in scope to the California Act. The New York Act provides that:

> [N]o person other than the artist or a person acting with the artists consent shall knowingly display in a place accessible to the public or publish a work of fine art or a limited edition multiple of not more than three hundred copies by that artist or a reproduction thereof in an altered, defaced, mutilated or modified form if the work is displayed, published or reproduced as being the work of the artist, or under circumstances under 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, except that this section shall not apply to sequential imagery such as that in motion pictures.[61]

Like the California Act, the New York statute is applicable to works of fine art.[62] In addition to works of fine art, the New York Act also protects limited edition multiples,[63] but does not apply to works for hire.[64] Equally important is the fact that the altered work must be attributed to the author for an action to lie under the New York Act.[65]

Despite the obvious shortcomings of both state statutes, such legislation is a step in the right direction to recognizing moral rights under American law. Unfortunately, there exists the possibility of federal preemption: the Copyright Act will preempt a state statute if: (1) the rights created under state law are

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created under a *work-for-hire* arrangement for use in advertising, magazines, newspapers, or other print and electronic media." *Id.* (emphasis added).

59. The Act also provides that "no person who frames, conserves, or restores a work of fine art shall commit, or authorize the commission of, any physical defacement, mutilation, alteration or destruction of a work of fine art by any act constituting *gross negligence*." *Id.* at § 987(c)(2) (emphasis added).

60. N.Y. ARTS & CULT. AFF. § 14.03 (McKinney 1984 & Supp. 1988).

61. *Id.* at § 14.03(1).

62. *Id.* at § 11.01. "Fine art" means a painting, sculpture, drawing, or work of graghic art and paint, but not multiples. *Id.*

63. *Id.* at § 11.01(10). "Limited edition" means works of fine art produced from a master, all of which are the same image and bear numbers or other markings to denote the limited production thereof to a stated maximum number of multiples, or are otherwise held out as limited to a maximum number of multiples. *Id.* The New York Act protects limited edition multiples "of not more than three hundred copies." *Id.* at § 14.03(1).

64. *Id.* at § 14.03(3)(d). Section 14.03(3)(d) provides: "This section shall not apply to work prepared under contract for advertising or trade use unless the contract so provides." *Id.*

65. *Id.* at § 14.03(1).

equivalent to rights under federal law, and (2) the rights under state law are applicable to 'works of authorship' within the subject matter of the Copyright Act.[66] In regard to the latter element, clearly, "works of fine art" can be considered "works of authorship" under the Copyright Act. Not so clear is whether or not the first element applies to preempt the state statutes. Are the "moral rights" created under the state acts "equivalent" to any rights created under federal law? It is precisely this element on which reasonable men could, and have, differed.

So where does all this leave us? We have a myriad of case law in which the courts have uniquely, albeit haphazardly, attempted to fashion a remedy to implicitly recognize an author's moral rights using theories of law outside the realm of copyright. Yet, the underlying theme is that if the United States and its judicial system are to recognize moral rights, such moral rights should be recognized through copyright law. It is ultimately up to the Congress to lead the way in providing the necessary continuity and leadership in the area of moral rights by passing adequate legislation. Three avenues are open to the Congress to achieve this goal: (1) amend the Copyright Act to provide for the protection of moral rights; (2) adopt limited moral rights legislation; or (3) become a Berne Convention member and adhere to Article 6bis.

Amend the Copyright Act

Although arguably the most desirable course of action, amending the Copyright Act to provide for protection of moral rights is perhaps the most radical of the proposed solutions. One such amendment, H.R. 288,[67] was proposed by Congressman Drinan to amend the copyright law to secure the rights of authors of pictorial, graphic, or sculptural works to prevent the distortion, mutilation, or other alteration of such works.[68] Unfortunately, such legislation standing on its own has not met with much success. As will be seen in the third proposed solution, amending the Copyright Act would be much more successful if Congress was presented with the proper vehicle, such as the Berne Convention, to facilitate and legitimize the process.

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66. *See* Nimmer, *supra* note 5, at § 8.21[C], 8-260.

67. H.R. 288, 96th Cong., 1st Sess., 125 Cong. Rec. 440 (daily ed. Jan. 18, 1979).

68. *Id.*

ADOPT LIMITED MORAL RIGHTS LEGISLATION

A second course of action available to Congress would be to adopt limited moral rights legislation. One such 'moral rights' bill, The Film Integrity Act of 1987,[69] was introduced by Congressman Richard A. Gephardt of Missouri on May 13, 1987. This bill "gives the screenwriter and director of a film the right of consent for any alteration of their work."[70] The bill was Gephardt's reaction to the recent colorization of many American Film Classics,[71] and perhaps, was foresight to the subsequent actions of the Copyright Office in granting copyright protection for colorized versions of black and white motion pictures.[72] On June 22, 1987, the Copyright Office of the Library of Congress issued a notice of registration decision which granted derivative[73] protection to "those color versions that reveal a certain minimum amount of individual creative human authorship."[74] The Copyright Office made this decision disregarding any "aesthetic or moral arguments."[75]

Whether or not a colorized version of a black and white film should receive copyright protection as a derivative work is beyond the scope of this comment. Suffice it to say that regardless of the Copyright Office's decision, many proponents of the Gephardt Bill and like legislation[76] view the colorization process as the 'bastardi-

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69. H.R. 2400, 100th Cong., 1st Sess., 133 Cong. Rec. E1922-23 (daily ed. May 13, 1987).

70. *Id.* at E1922.

71. *Id.*

72. Copyright Registration For Colorized Version of Black and White Motion Pictures, 52 Fed. Reg. 23443-46 (1987).

73. Section 101 of The Copyright Act of 1976 defines derivative work as:

> [A] work based upon one or more pre-existing works such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship. . . .

17 U.S.C. § 101 (1977 & Supp. 1986). Section 103(b) of the Copyright Act of 1976 outlines the scope of derivative protection:

> [Copyright protection in a derivative work] extends only to the material contributed by the author of such work, as distinguished from the pre-existing material employed in the work, and does not imply any exclusive right in the pre-existing material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the pre-existing material.

Id. at § 103(b).

74. 52 Fed. Reg. at 23445.

75. *Id.* at 23444 n.2.

76. People the likes of Martin Scorsese, George Lucas, Stephen Speilberg and Arthur

zation' of American Film Classics and the rape and plunder of a very important part of our heritage.[77]

The Gephardt Bill, as a limited moral rights bill in direct response to the colorization of black and white films, is understandably limited to the protection of one artistic medium—film; therefore, it falls short of being a broad sweeping piece of moral rights legislation. If Congress where to adopt this course of action, it might find itself considering a huge volume of legislation each time a specific work or artistic medium is threatened. Different bills would have to be tailor made to fit the specific fact, work and medium in question.

Become a Berne Member and Adhere to Article 6bis

While Congress has recently passed Berne Convention[78] implementing legislation,[79] it has done so in complete disregard of Arti-

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Hiller have spoken out publicly and at congressional hearings against the colorization of black and white films.

77. According to Representative Gephardt, "[f]ilm is a uniquely American art form: we brought it to life, we made it talk, we used it to address our deepest social concerns. Classic Feature Films are a vital part of America's living heritage." 133 Cong. Rec. at E1923 (daily ed. May 13, 1987).

78. International Union for the Protection of Literary and Artistic Works, signed at Berne, September 9, 1886; Additional Act and Declaration signed at Paris, May 4, 1896; revised at Berlin, November 13, 1908; additional protocol signed at Berne, March 20, 1914; revised at Rome, June 2, 1928; revised at Brussels, June 26, 1948; revised at Stockholm, July 14, 1967 (but not ratified by a sufficient number of member states to bring the Stockholm Act into force); revised at Paris, July 24, 1971. For text of the most recent Paris Act, *see* 4 M. Nimmer, Nimmer on Copyright, Appendix 27 (1987) [hereinafter The Berne Convention].

79. The Berne Convention Implementation Act of 1987, H.R. 1623, 100th Cong., 1st Sess., 133 Cong. Rec. H1293 (daily ed. March 16, 1987), was first introduced in the House by Congressman Kastenmeier of Wisconsin on March 16, 1987. *Id.* Mr. Kastenmeier's bill originally contained a moral rights provision which called for adding a new section to the Copyright Act, § 106a, the "moral rights of the author" section. *Id.* at H1295. After much debate in committee hearings between directors and screenwriters on the one hand, and the various copyright industries on the other, the House opted to pass an amended version of H.R. 1623 (now referred to as H.R. 4262, The Berne Implementation Act of 1988) without the moral rights provision. 134 Cong. Rec. at H3103 (1988). The amended House Bill passed by a 420-0 margin. *Id.* In the debate preceding the vote, Congressman Kastenmeier stated:

> After hearing from all these parties, I came to respect the view that the best course was to avoid statutory treatment of moral rights in the context of Berne. This conclusion rested in part on the political reality that legislation with a moral rights provision simply would not pass. Furthermore, amendments to the Copyright Act are not required in order to secure U.S. adherence to Berne. Most observers agree that current law, including the Lanham Act and laws relating to defamation, privacy and publicity, and unfair competition, contains the basic element of moral rights sufficient to comply with Berne.

Id. at H3083. In its place, the amended House Bill substituted § 4(b)(1)(2) which promised

cle 6bis,[80] the moral rights provision of Berne, thus making United States adherence to Berne "moral rights neutral."[81] The Berne Convention is the first international treaty governing the protection of intellectual property. The crux of the Berne Convention is two-fold:

(1) National Treatment - agreement to protect foreign copyrighted works at no less a level than one's own; and
(2) Minimum Mandatory Rights - foreign copyright owners must receive a minimum level of protection in each Berne country regardless of the protection afforded one's own nationals.[82]

Prior to Congress' enactment of the Berne Implementation Act, the United States was signatory to the Universal Copyright Convention ("UCC")[83] but was not a member of Berne.[84] Notwithstanding the United States, seventy-six countries are Berne members, as opposed to seventy-nine UCC members. Fifty-two countries are members of both conventions, while twenty-four

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not to "expand or reduce" existing moral rights protection. *Id.* at H3080. On October 5, 1988, the Senate, by a 90-0 margin, passed an amended version of H.R. 4262, which contained minor technical changes. S. 1301 (as amended), 100th Cong., 2d Sess., 134 Cong. Rec. S14549, S14566 (daily ed. Oct. 5, 1988). The Senate Bill also deleted the original moral rights provision and in its place retained § 4(b)(1)(2) (numbered 3(b)(1)(2)) which also promised not to "expand or reduce" existing moral rights protection. *Id.* at S14549. The House concurred in the Senate amendment on October 12, 1988. 134 Cong. Rec. at H10098 (daily ed. Oct. 12, 1988). Senate ratification of the treaty occurred on Thursday, October 20, 1988, 134 Cong. Rec. at S16939 (daily ed. Oct. 20, 1988), with the bill being sent to the President for his approval and signature the very next day. 134 Cong. Rec. at H11275 (daily ed. Oct. 21, 1988).

80. Berne Convention, Art. 6bis (Paris Act) states in part:

(1) Independently of the author's economic 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.

Id. See 4 M. NIMMER, NIMMER ON COPYRIGHT, Appendix 27-5, 6 (1987).

81. Senator Hatch of Utah, conferring on the provision of the Senate Bill which would neither "expand or reduce" existing copyright protection of moral rights, stated in debate that "U.S. implementing legislation should be neutral on the issue of moral rights," and "it is my belief that Berne under our bill will be moral rights neutral." 134 Cong. Rec. at S14558 (daily ed. Oct. 5, 1988).

82. Smith, *Should the Motion Picture Industry Support or Oppose U.S. Adherence to the Berne Convention?*, 6 THE ENT. AND SPORTS LAW. 1, 10 (Fall 1987) [hereinafter Smith].

83. Uniform Copyright Convention, signed at Geneva, September 6, 1952; revised at Paris, July 24, 1971. For text of the Paris Act, *see* 4 M. NIMMER, NIMMER ON COPYRIGHT, Appendix 25 (1988) (hereinafter the UCC).

84. The other noticeable exception to Berne membership is the Soviet Union, which, like the United States, is a UCC member. The Peoples Republic of China is neither a Berne nor a UCC member.

countries are Berne signatories but not UCC members.[85] This last fact is significant because works first published in the United States by an American author were not protected in those twenty-four countries who are Berne members but not UCC signatories.

The significance of United States adherence to Berne should not be understated. In the first place, adherence to Berne will allow the United States to dispense with the device of simultaneous publication. The only way that the United States or any other non-Berne country could gain Berne protection for a copyright was to either first publish that work in a Berne country, or publish the work in a Berne country *simultaneously* with publishing the work in the non-Berne country, such as the United States.[86] This will result in a significant savings in both cost and time, not to mention litigation for infringement. Secondly, United States adherence to Berne will afford protection against works frequently pirated in those twenty-four countries who are Berne members but not UCC members.[87] Third, Berne membership will provide the United States with greater market access and better trade relations in the intellectual property arena, specifically in those twenty-four Berne member countries who are not UCC members.[88] Fourth, United States adherence might result in retroactive protection of certain United States works created prior to United States adherence.[89] Lastly, Berne membership will elevate the United States to the forefront of the International Copyright Community as a leader in the protection of intellectual property.[90]

Purposely left out as a distinct benefit of Berne membership is the protection of moral rights. Article 6bis of the Berne Convention states that: "Independently of the author's economic 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."[91] Yet, Congress has opted to forgo a golden opportunity to once and for all settle the moral rights debate in this country by passing Berne implementing

85. *See* Smith, *supra* note 82, at 10.

86. 3 M. NIMMER, NIMMER ON COPYRIGHT § 17.04[D], 17-13 (1988).

87. Pirating of United States works has been most prevalent in Turkey and Thailand, both of which are Berne members but not UCC members. *See* Smith, *supra* note 81, at 11-12.

88. *Id.* at 12-13.

89. *Id.*

90. *Id.*

91. Berne Convention, Art. 6bis (Paris Act).

legislation without the appropriate moral rights legislation needed to adhere to Article 6bis. Since Congress first determined that Berne was not a self-executing treaty,[92] appropriate implementing legislation was necessary. Congress then determined that amending the Copyright Act to provide for Berne adherence would be the best course of action to pursue in accomplishing this goal.[93] Thus, Congress had before it the perfect vehicle, the Berne Convention, to use in amending the Copyright Act to provide for the recognition of moral rights in compliance with Article 6bis. Instead, Congress decided to forgo the moral rights issue for another day.[94]

It is interesting to note that for years the courts have been saying that United States law does not recognize the concept of *droit moral*. Opponents of Berne in the past (most noticeably Congress and the copyright community) have previously defeated prior Berne implementing legislation in part on the premise that United States law is incompatible with Article 6bis of Berne.[95] Now, within the span of approximately eighteen months, Congress has decided to ignore years of settled law and scholarly opinion by stating that United States law adequately protects and recognizes moral rights, and is therefore not incompatible with Article 6bis.[96] It is rather evident the influence big business and the copyright industries have had on Congress to block the moral rights legislation needed to adhere to Article 6bis. In fact, Senator Hatch is on record as stating the influence this lobby had on the final outcome

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92. Congressman Kastenmeier, introducing the Berne Convention Implementation Act of 1987, stated that "[t]he proposed legislation clearly proceeds upon the presumption that the Berne Convention is *not self-executing* and requires implementing legislation." 133 Cong. Rec. at H1294 (daily ed. March 16, 1987) (emphasis added). The bill's co-sponsor, Congressman Moorhead stated that "[w]ith regard to moral rights, the subcommittee has received testimony from many experts including representatives of 11 countries who are members of Berne and their opinions are almost unanimous, in th[at] Berne is *not self-executing*. . . ." 134 Cong. Rec. at H3083 (daily ed. May 10, 1988)(emphasis added).

93. 133 Cong. Rec. H1293 (daily ed. March 16, 1987).

94. The congressional attitude towards the protection of moral rights can be summed up neatly in the words of Congressman Moorhead: "The Congress can adopt legislation changing the law regarding moral rights, but it can do that at any time, regardless of whether or not the United States adheres to Berne." 134 Cong. Rec. at H3083 (daily ed. May 10, 1988). This statement begs the question; if Congress was truly serious about moral rights legislation, it would recognize that Article 6bis is the appropriate vehicle for that legislation.

95. 133 Cong. Rec. at H1293 (daily ed. March 16, 1987).

96. The conflict between settled case law and Congress' new found view on moral rights is best exemplified by Senator Hatch's statement that "while existing U.S. law satisfies U.S. obligations under Article 6bis of Berne, our judicial system has consistently rejected causes of action denominated as 'moral rights' or arising under the moral rights doctrine." 134 Cong. Rec. at S14558 (daily ed. Oct. 5, 1988).

of the bill.

> The Coalition to Preserve the American Copyright Tradition and the Magazine Publishers Association, which originally opposed Berne due to a concern over moral rights, helped craft the compromise [making Berne moral rights neutral] and now feel comfortable enough about United States adherence to Berne to no longer oppose S. 1301 [the Senate amendment to H.R. 4262].[97]

In order to rush through a compromise bill,[98] Congress has bowed to the pressures of special interests and has effectively painted a coat of grey on the moral rights of artists and authors in this country. In the words of Senator Hatch, "[m]oral rights will not come in, if you will, the back door by virtue of our adherence to Berne." Congress has not only closed the back door to moral rights, it has chained and bolted that very same door.

For the time being, we will have to settle for piecemeal legislation such as the Film Integrity Act of 1987 in the area of moral rights. It is now up to the courts to take charge of the moral rights debate and hold that United States law is incompatible with Article 6bis of Berne, forcing a showdown in the moral rights arena. As Representative Gephardt stated in the introduction to the Film Integrity Act of 1987, it is time to "hold[] those who would tamper with our American heritage to a higher standard than a mere dollar sign. We must insist on nothing less."[99]

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97. 134 Cong. Rec. at S14558 (daily ed. Oct. 5, 1988).

98. Senator Hatch stated: "Thus, to maintain th[e] status quo on moral rights, the compromise [bill]" made changes to assure that Berne adherence would be moral rights neutral. *Id.*

99. 133 Cong. Rec. at E1922-23 (daily ed. May 13, 1987).