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# Conflicts of Copyright Ownership Between Authors and Owners of Original Artworks: An Essay in Comparative and International Private Law

by Jane C. Ginsburg\*

## INTRODUCTION: PRINCIPLES AND PROBLEMS

Most, if not all, copyright laws distinguish between ownership of the incorporeal copyright, and ownership of chattels.<sup>1</sup> A generally-accepted corollary holds that alienation of the chattel that constitutes the material form of a copyrighted work does not carry the copyright with it.<sup>2</sup> Applying this principle to works of the visual arts, it should be clear that sale of a painting, even if it is the only "copy" of a work,<sup>3</sup> is not a transfer of the exclusive rights under copyright to reproduce the work or to create derivative works based on the painting. Similarly, ownership of the copyright confers no rights as to the material object. The artist (or her successor) owns the incorporeal exploitation rights; the purchaser of the painting is entitled to the quiet enjoyment of his chattel.

However, the distinction is not as impermeable as this exposition would suggest. On the one hand, the artist's rights, particularly her moral rights as enforced in some countries, limit the prerogatives of the owner of the art object.<sup>4</sup> On the other hand, the owner may impinge upon, or indeed fully displace, the author's pecuniary rights, in those

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1. See, e.g., 17 U.S.C. § 202 (1988) (ownership of copyright is distinct from ownership of "any material object in which the work is embodied"). CODE DE LA PROPRIÉTÉ INTELLECTUELLE (Fr.) [hereinafter C. PROP. INTELLECTUELLE], art L. 111-3 ("The incorporeal property right is independent of the property right in the material object.").

2. See, e.g., laws cited *supra*, note 1.

3. Cf. 17 U.S.C. § 101 (1988) ("Copies' are material objects . . . in which a work is fixed . . . . The term 'copies' includes the material object . . . in which the work is first fixed.").

4. Moreover, even when the chattel owner also owns the copyright, the artist's moral rights may in some countries constrain the exploitations the copyright owner may in fact make. See discussion *infra*.

copyright systems that presume a transfer of copyright ownership together with the alienation of the original object, or that attribute initial copyright ownership to the party that commissions the creation of the artwork.

The potential conflicts between artists and artwork owners have recently assumed an unprecedented importance. Until recently, the market for artworks was a market for originals. The value of the copyright rights of reproduction and adaptation was sufficiently negligible that artists directed most of their copyright-reforming efforts toward securing the "droit de suite," or artist's resale royalty on subsequent transfers of the chattel.<sup>5</sup> Now, by contrast, the market for art "merchandizing properties" -- reproduction or adaptation of art images on an ever-expanding variety of products, from paper goods, to clothing, to household items, to computer screen fillers, etc. -- affords a significant and growing source of income to copyright owners.<sup>6</sup> Thus, determining who is in fact the copyright owner, as between the artist and the purchaser of the art object acquires a practical urgency. But differences in national copyright laws, and in approaches to international conflicts of law, may make this determination complex if not elusive.

In this Article, I will first discuss the various points of contact, or conflict, between the rights of artists and of artwork owners in comparative law (primarily the U.S. and France). I will then consider how international private law rules applied in the U.S. and in Europe would (or perhaps should) designate the national law competent to resolve the conflict in copyright ownership between artists and purchasers.

To set the stage for much of the ensuing analysis, it may be helpful to design a problem that will bring many of the potentially conflicting interests into play. Suppose that the Museum Shop of the [fictitious] Museum of Moderately Modern Art (MOMMA), located in New York City, plans to purvey a line of goods, including post cards, wall calendars, plush toys, scarves, t-shirts, waste baskets, shower curtains, and refrigerator magnets, all incorporating full or partial reproductions or adaptations of the work of Pablita Métisse, a prolific and immensely popular artist, born in Spain in the late 19th-century, but resident for most of her career in France, where she died in 1973. The images that MOMMA wishes to use for its "Pablita" line of merchandizing properties are taken from paintings, some of which are in MOMMA's collection, and others of which are in museums in France, the U.K. and the Nether-

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5. See generally LILIANE DE PIERREDON-FAWCETT, *THE DROIT DE SUITE IN LITERARY AND ARTISTIC PROPERTY: A COMPARATIVE LAW STUDY* (Louise-Martin-Valiquette trans., John M. Kernochan gen. ed., 1991).

6. See, e.g., Marilyn Gardner, *The Fine Art of Merchandising Museums*, L.A. TIMES, Nov. 29, 1992, at E5.

lands. MOMMA has not obtained a license from Métisse's heirs, her daughters Columba and Claudia, authorizing the planned exploitation.

Moreover, neither MOMMA nor the other museums, nor purchasers that donated Pablita Métisse paintings to the museums, have any contracts signed by Pablita Métisse transferring copyright, or any rights under copyright, to the purchasers of the paintings. However, some of the paintings are portraits that were commissioned by the purchasers. Others of the paintings were sold, respectively, in France in 1905 and 1925, and in New York in 1960 and (posthumously) in 1980. To what extent, if any, do these factors form a basis for MOMMA to claim copyright ownership in the works in its collections, and for the European museums to claim copyright ownership in the works in theirs? Moreover, even if MOMMA might be considered a copyright holder in the U.S., would its ownership be recognized abroad? Would U.S. courts recognize the copyright ownership asserted by the European museums? Finally, even were the museums' copyright ownership upheld, to what extent would the artist's moral rights (asserted by Columba and Claudia) compromise MOMMA's planned exploitation at home or abroad?

## **I. CONFLICTS BETWEEN ARTISTS AND PURCHASERS IN COMPARATIVE LAW**

Despite the distinction between copyright and chattel ownership, there are several areas of potential conflict between the rights of artists and of owners of art objects. Some conflicts concern moral rights, others, pecuniary rights. In the realm of moral rights, the author's prerogatives may impinge upon the owner's enjoyment of the original object. They may also limit the owner's exercise of any copyright the owner has acquired.

With respect to pecuniary rights, conflicts may arise concerning both exercise and ownership of copyright. Two examples of interference in the exercise of chattel or copyright rights concern, on the one hand, the artist's access to a work in the purchaser's possession, and on the other, a selling-owner's unauthorized publication of a reproduction of the work in an auction catalogue. However, the most acute problems concern copyright ownership: who is the copyright owner if the artist has alienated the painting without reserving copyright ownership, or if the painting was created pursuant to a commission?

### A. MORAL RIGHTS

The French copyright law declares the moral rights of attribution and of integrity to be "perpetual, not subject to statutes of limitations, and inalienable."<sup>7</sup> Because these moral rights are inalienable, the author retains the power to exercise them, even if she has transferred her pecuniary (exploitation) rights. As a result, the artist may object to reproductions or adaptations of her work that violate its integrity, for example by falsifying the original colors or distorting the image. The artist may also seek relief against alteration or destruction of the original copy.<sup>8</sup>

U.S. federal copyright law has, since 1990, incorporated a highly limited protection for visual artists' rights of attribution and integrity.<sup>9</sup> The 1990 provisions entitle the artist to seek relief against prejudicial alterations to or destruction of original copies of artworks (or of a limited, signed, numbered edition of no more than 200 copies). Under these provisions, the artist enjoys no protection against objectionable reproductions and adaptations of art images.<sup>10</sup> By contrast, artists' rights acts enacted by a variety of states, including New York and California, may extend protection against distorted reproductions of artworks.<sup>11</sup> In addition, § 43(a) of the Lanham Federal Trademarks Act may afford a basis of relief against distorted representations falsely attributed to the artist.<sup>12</sup> Finally, if the artist has retained rights under copyright, she may invoke the exclusive right to create or authorize derivative works against reproductions of artworks that significantly alter the image.<sup>13</sup>

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7. C. PROP. INTELLECTUELLE, *supra* note 1, art. L. 121-1.

8. See Judgment of May 30, 1962, Cour d'Appel, Paris, 1962 DALLOZ JURISPRUDENCE, at 570, note Henri Desbois (Fr.) (condemning owner/art dealer's dismemberment of a refrigerator painted by Buffet). For an English language commentary on this affair, see John Henry Merryman, *The Refrigerator of Bernard Buffet*, 27 HAST. L.J. 1023 (1976).

9. Visual Artists' Rights Act of 1990 [hereinafter VARA], incorporated at 17 U.S.C. §§ 106A, 113(d) (Supp. IV 1992).

10. For a fuller discussion of the scope of VARA, 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 (1990); Robert A. Gorman, *Visual Artists Rights Act of 1990*, 38 J. COPYRIGHT SOC'Y 233 (1991).

11. See, e.g., *Wojnarowicz v. American Family Association*, 745 F. Supp. 130 (S.D.N.Y. 1990) (applying the New York Artists Authorship Rights Act, N.Y. Arts & Cultural Affairs Law, § 14.03 (McKinney's Supp. 1990), against distorted representations of artist's work attributed to artist).

12. See, e.g., *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976) (false attribution of origin to British humor group Monty Python of heavily edited version of "Monty Python's Flying Circus").

13. *Cf. id.* (Monty Python had retained rights in the television scripts; unauthorized editing thus created an unauthorized derivative work, in violation of the group's rights under the U.S. copyright act).

Thus, under both French and U.S. law, the owner of a qualifying art object<sup>14</sup> does not enjoy complete discretion to dispose of the physical object as she wills. Where the owner of the artwork is also the owner of the copyright, her freedom to exploit the copyright through the commercialization of merchandizing properties incorporating the art image will vary depending on the differences in national copyright, and moral rights, regimes. We will return to the application of these rules, notably, with respect to MOMMA and its proposed "Pablita" line of merchandizing properties, after we have analyzed conflicts of ownership of pecuniary rights, and the problem of international private law.

## B. PECUNIARY RIGHTS

### 1. Exercise of Artists' and Owners' Property Rights

Although the copyright of artists and the chattel right of owners of art objects are distinct properties, it is not always possible to separate the incorporeal exploitation right from the property right in the object in which the copyrighted work is rendered concrete. For example, suppose the artist wishes to exercise her exclusive right of reproduction, but to do so, she requires access to the original copy of the work, now in the owner's hands. Must the owner's property right give way to the artist's? Put another way, may the owner exercise his property right in a way that frustrates the artist's realization of hers? Or suppose an owner wishes to exercise his right to dispose of his property by selling the painting, and, to promote the sale, wishes to reproduce and distribute advertisements depicting the painting. On the one hand, these acts of reproduction and distribution may be conceived as reasonable accessories to the owner's exercise of rights; on the other, they also are invasions of the artist's exclusive rights under copyright. Whose rights should yield? We will examine the responses of U.S. and continental copyright law to each of these examples.

#### a. *Right of Access to Original Copy*

The conflict in copyright and chattel rights here leads to an impasse. Some Continental copyright laws, notably those of Germany and Spain, provide explicitly for the artist's right of access, subject to compensating the owner for damage and inconvenience.<sup>15</sup> The French copyright law

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14. VARA does not apply to artworks sold before VARA's effective date, June 1, 1991. See Pub. L. No. 101-650, 104 Stat. 5128, Title VI, § 610(a) (effective date provision).

15. An Act dealing with Copyright and Related Rights, Sept. 9, 1965, art. 25 (German copyright law) *reprinted as amended in* 2 COPYRIGHT LAWS AND TREATIES OF THE WORLD (BNA), Item 1, at 4 (Supp. 1989-1990); Law on Intellectual Property, Nov. 11, 1987, art. 14(vii) (Spanish copyright law) *reprinted as amended in* 3 COPYRIGHT LAWS AND TREATIES

allows authors to seek judicial relief against "the owner's notorious abuse, preventing the exercise of the right of divulgation [public dissemination]."<sup>16</sup> Because the reproduction (at least the initial reproduction) entails the "divulgation" of the work, it is possible to conclude that the French law entitles the artist to request that the courts order access to the artworks in order to permit her to exercise the right of reproduction.<sup>17</sup> In the U.S., a few judicial decisions suggest that the artist might seek similar relief.<sup>18</sup>

*b. Reproduction as an Accessory to Chattel Right*

Does the art object owner's chattel right imply a right to reproduce the art image in furtherance of the exercise of the owner's right to sell the painting? France's highest private law court, the Cour de Cassation, in a controversy involving the unauthorized reproduction of a painting in an auction catalogue, recently answered "No."<sup>19</sup> French law lacks an open-ended exception akin to the U.S. fair use; were the unauthorized reproduction to be excused, the provisions of the exemption for "brief quotes"<sup>20</sup> would have to apply. The lower court had so held, deeming that the differences in dimension between the original painting and the auction catalogue's small-scale reproduction of the entire painting justified analogizing the reproduction to a "brief quote." The High Court abruptly declared that a complete reproduction, however small, simply could not be considered a "brief quote."

In the U.S., the fair use exception might prove more helpful to owners of art works. An unauthorized reproduction in a sales catalogue or in an advertisement might be considered an "incidental use," accessory to

OF THE WORLD (BNA), Item 1, at 5 (Supp. 1987-1988).

16. C. PROP. INTELLECTUELLE, *supra* note 1, art. L. 111-3.

17. See Claude Colombet, *Mécénat et Propriété Littéraire et Artistique*, in *MÉLANGES DÉDIÉS À DOMINIQUE HOLLEAUX*, at 61, 63 (1990).

18. See *Baker v. Libbie*, 97 N.E. 109 (Mass. 1912) (ordering heir's access to manuscripts of Mary Baker Eddy's unpublished correspondence); *CCNV v. Reid*, 1992 COPYRIGHT L. DEC. (CCH), ¶ 26,860 (D.D.C. 1991) (settlement agreement that declared sculptor a co-owner of copyright in commissioned sculpture enforced by ordering recalcitrant owner of sculpture to permit artist's access to the work in order to exercise his reproduction right).

19. Judgment of November 5, 1993, Cour de Cassation, Assemblée Plénière, in 159 *REVUE INTERNATIONALE DU DROIT D'AUTEUR*, at 320 (Jan. 1994). Compare, Judgment of October 27, 1992, Cour de Cassation, Chambre Commerciale, Financière et Economique, in 156 *REVUE INTERNATIONALE DU DROIT D'AUTEUR*, at 190 (Apr. 1993) (rejecting infringement claim against unauthorized reproduction in a sales catalogue of t-shirts bearing copyrighted designs; the reproduction of the designs on the t-shirts had been licensed). In U.S. law, 17 U.S.C. § 113(c) (1988) leads to a similar result.

20. C. PROP. INTELLECTUELLE, *supra* note 1, art. L. 122-5, 3°(a).

exercise of a primary prerogative.<sup>21</sup> On the other hand, if the catalogue containing the unauthorized reproduction served not only to inform potential buyers, but was sold to a more general audience, the reproduction might be seen to invade the copyright owner's market for licensing reproductions in art books, and the fair use claim might therefore fail.<sup>22</sup>

## 2. Copyright Ownership

Up to now, we have assumed that the distinction in property rights between author and chattel owner has been maintained; that the artist has not in fact transferred the copyright to the purchaser of the painting. But what if such a transfer was presumed to have occurred, at least where the artist delivered the painting, and expressed no retention of copyright? Copyright laws in the U.S. and abroad have in the past, and to some extent continue to, impose a presumption that the artist granted the copyright where, either, the artist transferred the original artwork without restriction, or the artwork was a commissioned work, especially a portrait or a photograph.

### *a. Presumptions of Transfer of Copyright Together with the Original Artwork*

Today, both U.S. and French copyright law specify that sale of a copy of the work, including the original copy, does not, of itself, incorporate a transfer of the copyright.<sup>23</sup> Moreover, both laws today subject a transfer of copyright to the requirement of a writing signed by the author, and the French law further requires that each right granted be the "object of a distinct mention."<sup>24</sup> However, the distinction between sale of the chattel and sale of the incorporeal exploitation rights has not always been so clear. In France, the first law declaring the distinction was enacted in 1910. The High Court, in construing this law, has twice held that it derogated from the general civil law principle that transfer of ownership of the object conveyed full title, including to the copyright; the

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21. Cf. *Italian Book Corp. v. American Broadcasting Cos.*, 458 F. Supp. 65 (S.D.N.Y. 1978) (excusing television news program's dissemination, as part of coverage of Italian street festival, of a portion of a copyrighted song performed during the festival).

22. If, after *Campbell v. Acuff-Rose*, 114 S.Ct. 1164 (1994), the commercial purpose of the reproduction is no longer presumptively fatal to a fair use defense, the inquiry into potential market harm remains dominant. Moreover, in reversing the grant of summary judgment to the copyright owner, the Supreme Court gave special emphasis to the "transformative" character of defendant's parody. Reproduction of an entire artwork in a catalogue is unlikely to be deemed a "transformative" use. On the concept of "transformative" use in fair use, see generally, Pierre Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).

23. See 17 U.S.C. § 202 (1988); C. PROP. INTELLECTUELLE, *supra* note 1, art. L 111-3.

24. 17 U.S.C. § 204(a) (1988); C. PROP. INTELLECTUELLE, *supra* note 1, art. L. 131-3.



distinction therefore did not apply to unrestricted sales of paintings occurring before 1910.<sup>25</sup>

In the U.S., the 1909 Act also provided that sale of the chattel did not of itself entail alienation of the copyright.<sup>26</sup> However, the prior federal copyright law applied, in general, only to published works. The states regulated copyright in unpublished works; it is probably fair to assume that most artworks prior to their sale would have been considered unpublished.<sup>27</sup> Some state courts, most importantly, those of New York, had determined that a presumption of transfer of copyright accompanied unrestricted transfers of the original copy of a work (e.g., painting or manuscript).<sup>28</sup>

*i. Application, Over Time, of Legislative Reversals of the Presumption of Transfer*

While the New York legislature overturned the presumption of transfer in 1966,<sup>29</sup> it is not clear whether the presumption would continue to apply to sales occurring before 1966. For any states that had followed *Pushman* or adopted a similar result, but had not themselves abrogated the presumption, the 1976 Copyright Act displaces the local solution. But the 1976 Act's reversal of the presumption did not take effect until January 1, 1978. What of pre-1978 sales of artworks in these states? On the one hand, continued application of the presumption would mean that, for the duration of the copyright (50 years following the artist's death under U.S. copyright law; 70 years following the artist's death under the law of EC countries), the author would remain divested of the exploitation rights; the abrogated presumption thus would remain in force well into the twenty-first century, if not into the twenty-second.

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25. See Judgment of March 19, 1926, Cour de Cassation, Chambre Criminelle, 1927 DALLOZ PÉRIODIQUE ET CRITIQUE, Partie I, at 25 (Fr.) (works of, inter alia, Sisley and Courbet); Judgment of June 16, 1982, Cour de Cassation, Première Chambre Civile, 1982 Bull. Civ. I, No. 228, at 196 (Fr.) (works of Renoir); 1983 DALLOZ INFORMATIONS RAPIDES, at 96 (observations of Claude Colombet on Judgment of June 16, 1982).

26. 17 U.S.C. § 27 (1909) (*repealed*).

27. For the meaning of "publication" in U.S. copyright law, see, e.g., *Academy of Motion Picture Arts & Sciences v. Creative House Promotions*, 944 F.2d 1446 (9th Cir. 1991).

28. See, e.g. *Pushman v. New York Graphic Soc.*, 39 N.E.2d 249 (N.Y. Ct. App. 1942) (painting); *Chamberlain v. Feldman*, 89 N.E.2d 863 (N.Y. Ct. App. 1949) (manuscript). The number of States that have followed *Pushman*, or adopted a similar presumption, is uncertain. See MELVILLE B. NIMMER & DAVID NIMMER, 3 NIMMER ON COPYRIGHT, § 10.09[B] & n.16 (1993).

29. An Act to Amend the General Business Law, in Relation to the Right to Reproduce Works of Fine Art, 1966 Laws of N.Y., ch. 668 (amending N.Y. Gen. Bus. L. by adding art. 12-E, §§ 223-224).

On the other hand, usual principles of interpretation of legislative changes hold that, in the absence of specific legislative direction, laws that alter property rights are not applied retroactively so as to divest the owner.<sup>30</sup>

However, Nimmer has suggested that, at least where the purchaser did not, before abrogation of the presumption, rely on the presumption by exercising rights under copyright, the legislative reversal of the presumption should take effect.<sup>31</sup> Where the art object owner demonstrated no expectations of copyright ownership that application of the subsequent legislation would unsettle, it is appropriate to give the fullest effect possible to the intervening enactment.

The problem of persistence of a parallel, contrary, rule of copyright ownership is also present in the French copyright system, as a result of the two High Court decisions mentioned above. But French commentators criticizing these decisions have not generally advocated a similar approach to resolving the problem. Rather, many insist that the 1910 law did not change the distribution of property between artists and purchasers; that the distinction between copyright and chattel had *always* been present in French law, and that the 1910 law simply reaffirmed the distinction.<sup>32</sup> However, one French author, granting *arguendo* that the 1910 law did reverse the distribution of copyright, has contended that while the reversal might not have had an "*immediate*" impact, the effects of the presumption should not linger on.<sup>33</sup>

#### *b. Commissioned Artworks*

For many commissioned artworks, the presumption of transfer, if applicable at the time the commission was executed, would convey the copyright to the commissioning party upon the artist's delivery of the commissioned work. Independently of this presumption, the commissioning party might also be deemed the copyright owner by virtue of having commissioned the work's creation.

While French copyright law has not conferred copyright on commissioning parties, other European copyright laws have, at least to some extent. For example, the U.K. copyright law, until its 1988 general revision, named as copyright owner (absent agreement to the contrary)

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30. See, e.g., *Roth v. Pritikin*, 710 F.2d 934 (2d Cir. 1983) (declining to apply 1976 copyright act's work for hire provisions to a work commissioned before the act's effective date; retroactive application would have divested the commissioning party of copyright ownership).

31. See NIMMER, *supra* note 28 (discussing the New York law).

32. See HENRI DESBOIS, *LE DROIT D'AUTEUR EN FRANCE*, ch. V, § 312, at p. 403 (3d ed. 1978); Colombet, observations in DALLOZ INFORMATIONS RAPIDES, *supra* note 25.

33. Pierre-Yves Gautier, *Le Contrat Bouleversé: de l'Imprévisibilité en Droit des Propriétés Artistiques*, 1990 DALLOZ CHRONIQUE XXIV, at 131.

the party commissioning the creation of a "photograph, portrait or engraving."<sup>34</sup> Note that the commissioning party is the copyright owner even if she is not the subject of the portrait or photograph.<sup>35</sup> On the Continent, the Dutch and Belgian copyright laws confer copyright ownership on the party commissioning the creation of a portrait.<sup>36</sup>

In the U.S. the 1976 copyright act, as interpreted by the Supreme Court in *Community for Creative Non Violence v. Reid*,<sup>37</sup> excludes most commissioned artworks from works made for hire status. First, works of fine art are not included in the limited list of categories of commissioned works subject to work for hire status. Second, most fine artists do not work under conditions giving rise to an "employment relationship" under the criteria set forth in *CCNV* and elaborated in subsequent lower court decisions.<sup>38</sup>

What of artworks commissioned in the U.S. before the effective date of the 1976 copyright act? Would these have been considered works made for hire, and therefore subject to the commissioning party's copyright ownership? In *CCNV* the Supreme Court stated that prior to the 1976 act's legislative compromise on copyright ownership, worked out among interested groups by 1965, there was no general rule that commissioned works were works made for hire.<sup>39</sup> Between 1965 and 1978 some decisions, particularly in the Second Circuit, did develop a broad application of the works made for hire doctrine to commissioned works.<sup>40</sup> Does it follow that artworks commissioned in New York, Connecticut and Vermont between 1965 and 1978 are subject to work

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34. Copyright Act of 1956, 4-5 Eliz. 2, ch.74, art. 4(3) (Eng.). See also An Act Respecting Copyright, 1985 Revised Statutes of Canada, ch. C-42, § 13(2).

35. See, e.g., *Apple Corps Ltd. v. Cooper*, [1993] Fleet St. Rep. 286 (Ch. div. 1992) (Eng.) (copyright ownership of photographs taken for the album jacket of "Sergeant Pepper's Lonely Hearts Club Band" held to belong to the record producer that commissioned the photographs); *Planet Earth Prods. v. Rowlands*, 69 Dominion L. Rep. 4th 715 (Ontario Sup. Ct. 1990) (Can.) (same result with respect of other photographs commissioned for album jackets).

36. Law Concerning the New Regulation of Copyright, September 23, 1912, arts. 19, 20 (Dutch copyright act) reprinted as amended in II COPYRIGHT LAWS AND TREATIES OF THE WORLD (BNA), Item 1, at 7; Law on Copyright, March 22, 1886, art. 20 (Belgian copyright act) reprinted as amended in I COPYRIGHT LAWS AND TREATIES OF THE WORLD (BNA), Item 1, at 3. See generally Jean-Louis Bismuth, *General Report*, in 3 LE COMMERCE INTERNATIONAL DE L'ART ET LE DROIT [hereinafter COM. INT'L], 193, at 194-5; Philippe Coppens & Alain Strowel, *Belgian Report*, in 3 COM. INT'L, 227, at 242; Anton Quaadvlieg, *Dutch Report*, in 3 COM. INT'L, 277, at 287 (1991).

37. 490 U.S. 730 (1989).

38. See *id.* at 751; see also *Marco v. Accent Publishing Co.*, 969 F.2d 1547 (3d Cir. 1992); *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410 (7th Cir. 1992); *Playboy Enterprises v. Dumas*, 831 F. Supp. 295 (1993).

39. *CCNV*, *supra* note 37, at 744.

40. *Id.*, at 748; *Brattleboro Publishing Co. v. Winmill Publishing Co.*, 369 F.2d 565 (2d Cir. 1966); *Roth v. Pritikin*, *supra* note 30.

made for hire status, while works commissioned elsewhere are not? Or should one simply conclude that the Second Circuit cases were wrongly decided, and that at no point were artworks commissioned from independent artists works made for hire? Even if one gives credence to the Second Circuit's arguably aberrant decisions, one might, adapting Nimmer's suggestion regarding the effect of the abrogation of the New York State presumption of transfer, accord work for hire status only to those commissioned works whose commissioning parties relied on their copyright ownership before the effective date of the 1976 federal copyright act.

At this point, we have identified many of the variables in determining who is the copyright owner of a work of art. But so far the discussion has addressed U.S. and foreign laws, without determining which law will govern when the problem of copyright ownership and exploitation presents an international (or multinational) aspect. The problem of Pablita Mézisse and MOMMA's merchandizing properties, set forth at the beginning of this article, is replete with such aspects, and therefore will permit us to focus the ensuing discussion of international conflicts of law.

## **II. INTERNATIONAL LEGISLATIVE COMPETENCE: WHAT LAW APPLIES TO EXERCISE AND OWNERSHIP OF COPYRIGHT IN ARTWORKS?**

The Berne Convention and recent French case law supply clear answers to some of the transnational issues posed here, and we will address these questions first. The basic issues, however, concerning ownership of pecuniary rights, currently lack certain resolution; they will form the bulk of the following discussion.

### **A. QUESTIONS WITH ANSWERS**

#### **1. Law Applicable to Exercise of Rights**

The Berne Convention designates "the law of the country where protection is claimed" to govern the "exercise and enjoyment" of rights under copyright.<sup>41</sup> As a result, this law (often the law of the forum) will determine the content and scope of moral and pecuniary rights in artworks (and other works of authorship). The Berne Convention thus establishes the rule of national treatment, under which a foreign Berne

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41. Berne Convention for the Protection of Literary and Artistic Works, art. 5.2. Unless otherwise noted, all references are to the 1971 Paris Text of the Berne Convention, S. TREATY DOC. No. 27, 99th Cong., 2d Sess. 37 (1986) [hereinafter Berne or Berne Convention].

Union author receives the same treatment as local authors in the country in which the Unionist author claims protection. It follows that, for example, the French authorities having recognized the artist's right to oppose the art object owner's reproduction of the painting in a catalogue, an American artist whose work is sold at the Hôtel Drouot auction house in Paris may also prevent the unlicensed reproduction of her work in the catalogue. By the same token, a French artist whose 1992 canvas is mutilated that year in Missouri would be entitled to the full extent of integrity rights granted U.S. artists by the 1990 Visual Artists' Rights Act of 1990.<sup>42</sup>

## 2. French Law Enforcement of Foreign Creators' Moral Rights

While the Berne Convention assimilates foreign authors to nationals with respect to the exercise of rights under copyright, it does not clearly set forth who has standing to invoke those rights. Nonetheless, with respect to the moral rights of attribution and integrity, the French High Court has answered that question for claims seeking to enforce those rights in France. In *Huston v. La Cinq*, the Court applied French law in order to attribute authorship status and the right to sue in France to defend the moral rights of attribution and integrity to all creators, whatever their employment status or enjoyment of copyright in the work's country of origin or in the country of which the creator is a national or domiciliary.<sup>43</sup>

It follows that, according to French conflict of laws rules, a foreign author, even if she is not a copyright owner, always maintains the right to ensure that exploitations made of her work in France respect her rights of attribution and integrity. For example, returning to MOMMA

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42. Because VARA does not protect against distorted reproductions of artworks, the artist, whether American or foreign, would have no claim under the federal copyright act unless she were also the owner of the derivative works right, in which case she could bring a copyright infringement claim. For artists who are no longer copyright owners, state laws, such as the New York Artists Authorship Act, *supra* note 11, would, where applicable, assist foreign authors as well as locals. However, the state right might conflict with the federal copyright law where the artist is seeking to prevent exercise of a copyright grantee's derivative works right. Under these circumstances, the state law might be preempted. See, e.g., Edward J. Damich, *The New York Artists' Authorship Rights Act: A Comparative Critique*, 84 COLUM. L. REV. 1733 (1984). On the related area of invocation of state protection of the *droit de suite* by foreign artists, and possible preemption of the state law, see Lee D. Neumann, *The Berne Convention and the Droit de Suite Legislation in the United States: Domestic and International Consequences of Federal Incorporation of State Law for Treaty Implementation*, 16 COLUM.-VLA J. L. & ARTS 157 (1992).

43. Decision of May 28, 1991, Cour de Cassation, Première Chambre Civile, 1991 JURIS CLASSEUR PÉRIODIQUE II 21731, note André Françon. For an English-language commentary on this decision, see Jane Ginsburg & Pierre Sirinelli, *Authors and Exploitations in International Private Law: The French Supreme Court and the Huston Film Colorization Controversy*, 15 COLUM.-VLA J. L. & ARTS 135 (1991).

and its proposed "Pablita" line of merchandizing properties, Columba and Claudia would have a claim against French exploiters of the Pablita properties if the items deformed the originals, such as by presenting a complete line of scarves in every possible color combination, depicting an image originally rendered by Pablita Métisse in monochrome. As a result of the *Huston* decision, it seems clear that Columba and Claudia would maintain the right to advance their claim even if, for example, the French exploiter was MOMMA's licensee, and MOMMA had acquired the work from a donor who claimed title to the copyright through a pre-1910 purchase of one of Pablita's early, "Purple Period," works.

## B. QUESTIONS WITHOUT CLEAR ANSWERS: WHAT LAW DETERMINES WHO OWNS THE PECUNIARY RIGHTS IN WORKS OF ART?

In the absence of Berne Convention direction, many questions arise concerning international legislative competence to determine ownership of pecuniary rights under copyright. One series of questions addresses the law normally competent to determine ownership; another inquires whether local public policy ("*ordre public*") imperatives require rejection of the normally competent law in favor of application of local rules. The first series of questions requires treatment of the problems of presumption of transfer on the one hand, and commissioned artworks on the other.

### 1. The Normally Applicable Law

The transaction between the artist and the purchaser is contractual, and contract choice of law rules would therefore apply. However, the potential subject matter of the contract -- transfer of copyright as well as of the corporeal object -- complicates the selection of the choice of law rule. Both U.S. and foreign authorities agree that the law of the country of protection (i.e., each country where the copyright is exploited) defines the nature and scope of what rights under copyright may be granted for that territory.<sup>44</sup> On the other hand, most of these authorities would not

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44. See, e.g., *Rules Proposed in Relation to Intellectual Property Rights, for Inclusion in a Convention on Private International Law in the Member States of the European Economic Community*, art. F(1)(a) in EUGEN ULMER, *INTELLECTUAL PROPERTY RIGHTS AND THE CONFLICT OF LAWS* [hereinafter ULMER], at 99; ULMER § 68, at 46; Henri Desbois, observations on the Decision May 16, 1972, Tribunal de Grande Instance, Bayonne, 25 *REVUE TRIMESTRIELLE DE DROIT COMMERCIAL* 624 (1972); see also MELVILLE B. NIMMER & PAUL E. GELLER, *INTERNATIONAL COPYRIGHT LAW AND PRACTICE*, § 3[1] (1991); *Campbell Connelly & Co. v. Noble*, [1963] 1 All Eng. L. Rep. 237 (Ch. div. 1962) (in English law contract, American law governs question of whether second term of U.S. copyright is assignable); *Corcovado Music Corp. v. Hollis Music*, 981 F.2d 679 (2d Cir. 1993) (same, with respect to Brazilian law contract).

subject the form or procedure of the transfer to the law governing protection of the copyright.<sup>45</sup> In other words, the author, even in an international contract, may not grant rights that are unavailable or inalienable in the country of protection; but if the rights are available for transfer, then the law of the contract determines whether, and by what means, the transfer has occurred.

In the context of presumptions of transfers of copyright ownership of works of art, the question that primarily concerns us is not whether the reproduction and adaptation rights in works of art are assignable, but whether the author should be deemed to have assigned them. Hence the contract choice of law qualification. The problem of the domain of the law of the country of protection is reduced because the rights that would be transferred are generally available for transfer in most copyright systems (subject to the reserve of moral rights). However, local law may limit the scope of the transfer of these rights to, for example, means of exploitation known at the time of the transfer. Thus, for example, a pre-1910 transfer might not, in France or Germany, be deemed to cover reproductions of the art work on computer screens.<sup>46</sup>

Turning, therefore, to applicable contract choice of law rules, we will assume that the contract between the artist and the purchaser (if, indeed, there was a written contract) did not specify a national, or state, law applicable to their transaction. The U.S. conflicts approach, expressed in the Restatement, Second, of Conflict of Laws, directs the court, in the absence of a law chosen by the parties, to apply the law of the "most significant relationship."<sup>47</sup> Factors to consider include: "the place of contracting; the place of negotiation of the contract; the place of performance; the location of the subject matter of the contract; and the domicile, residency, nationality, place of incorporation and place of business of the parties."<sup>48</sup> In the context of sales of artworks, the country of sale and the nationality, domicile or residence of the parties, appear to be the most important considerations.

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45. See authorities cited *supra* note 44. But compare *Campbell Connelly*, *supra* note 44, with *Corcovado*, *supra* note 44: in controversies determining whether a contract purporting to grant full-term worldwide rights granted the renewal term of U.S. copyright under the 1909 Act, the English court held U.S. law governed the question of whether the second term was assignable, but English law governed whether the contract's language was effective to grant the second term; by contrast, the U.S. court held U.S. law not only governed whether the renewal term was assignable at all, but also whether the contract's language was effective.

46. See, e.g., *ULMER*, *supra* note 44, § 70 (discussing German copyright law of 1965, art 31.4). The French copyright law, C. PROP. INTELLECTUELLE, *supra* note 1, art. L. 1-131-6, permits transfer of rights to exploit the work through means unknown or unanticipated at the time of contracting, but requires that such a grant be explicit.

47. RESTATEMENT (SECOND) OF CONFLICT OF LAWS, §§ 6, 188 (1988).

48. *Id.*, § 188(2).

European Community countries might apply the choice of law rules set forth in the 1980 Rome Convention on the law applicable to contractual obligations.<sup>49</sup> It provides that, in the absence of a law chosen by the parties to the contract, the applicable law is the one that has the closest ties to the contract: the Convention presumes that "the contract is most closely connected with the country where the party who is to effect the performance which is characteristic of the contract has, at the time of conclusion of the contract, his habitual residence . . . ."<sup>50</sup> In our case, the party owing the characteristic performance is the artist.<sup>51</sup> The law of the artist's residence at the time of the sale of the painting is therefore competent.

*a. Presumption of Transfer of Copyright with the Sale of the Original Copy*

Let us apply the Restatement and Rome Convention rules to the Pablita Métisse merchandising properties. Suppose that in 1905 Pablita, then resident in France, had sold a "Purple Period" painting through a New York gallery to a New York buyer. Under the Restatement approach, New York law would probably apply, because the greatest number of contacts are grouped in New York. Under New York law at the time, the buyer would own the copyright, absent a reservation of rights by the artist.<sup>52</sup> Under the Rome Convention, New York might also be considered to have the closest relationship to the contract. Even if the law of Pablita's then-residence were to apply, the result would be

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49. Rome Convention on the Law Applicable to Contractual Obligations, *opened for signature* June 19, 1980, 23 O.J. No. L. 266/1 (1980).

50. *Id.*, arts 4.1, 4.2. The Rome Convention provides that it does not apply to contracts entered into before the Act's effective date, *see id.*, art. 17, but courts might nonetheless apply the choice of rule it sets forth, notably because it corresponds to the choice of law rule propounded by other international private law conventions in the contracts field. *See, e.g.*, Hague Convention on the Law Applicable to the International Sale of Goods, June 15, 1955, 510 U.N.T.S. 149 (1964) [hereinafter 1955 Hague Convention] and Hague Draft Convention on the Law Applicable to Contracts for the International Sale of Goods, Oct. 30, 1985, 24 I.L.M. 1573 [hereinafter 1985 Hague Draft Convention]. The former convention designates the internal law of the country where the seller has its habitual residence, *see* 1955 Hague Convention, art. 3. The latter designates the law of the seller's principal place of business, 1985 Hague Draft Convention, art. 8.1, or the law having the closest relationship to the parties and their transaction, *see* 1985 Hague Draft Convention, art. 8.3. Neither of these conventions applies directly to the problem discussed in this article, because both concern only the sale of corporeal goods, and because both exclude transfers of property rights, *see* 1955 Hague Convention, art. 5.3; 1985 Hague Draft Convention, art. 5c.

51. *See* ULMER, *supra* note 44, Rule F(2).

52. Although the New York Court of Appeals did not announce the presumption of transfer of a copyright until 1942, it derived the presumption from an 1872 decision, *Parton v. Prang*, 18 F.Cas. 1273 (C.C.D. Mass. 1872).



the same, because in France, pre-1910 sales of artworks were presumed to transfer the copyright as well.<sup>53</sup>

If, on the other hand, the facts remained the same, except that the sale occurred in New York in 1960, Pablita would retain the copyright if French law applied, while under New York law, she would still be presumed to have alienated it. As to which of these laws applies, U.S. courts, applying the Restatement, would most likely designate New York law, EC country courts applying the Rome Convention might select New York law, as the law of the most significant relationship, or might designate French law, as the law of the residence of the party owing the "characteristic performance." Choice of forum (U.S. or E.C.), therefore, could determine the identity of the copyright owner.

Suppose instead that the sale, to a New York buyer, occurred in France in 1925. Here, both the Restatement and the Rome Convention would most likely designate French law, which by 1925 no longer presumptively divested the artist of her copyright.

Finally, suppose that Pablita had resided in New York from 1960 to 1970, and that she had sold works in New York to New York and to French buyers. Suppose also that some of her works were sold posthumously in New York in 1980. With respect to the posthumous sales, because they occur after the effective date of the 1976 Copyright Act, there would no longer be a presumption of transfer under U.S. law, nor would there be such a presumption under French law. Whatever the applicable law, therefore, the result is the same: the copyright remains with the artist, or her heirs.

With respect to the inter vivos 1960-1970 sales, these should be divided between pre-1966 and 1966-1970 sales. The latter group, occurring subsequent to New York's abrogation of the presumption of transfer, produces the same result as the posthumous sales. Analysis of the former group may yield different results under the Restatement and the Rome Convention. For pre-1966 sales to New Yorkers, both the Restatement and the Rome Convention point to application of New York law, and its presumption of transfer: most contacts are to New York, and Pablita was at the time a New York resident. By contrast, for pre-1966 sales in New York to French buyers, while Pablita's then-New York residence might lead, under Rome Convention criteria, to application of New York law, under the Restatement, which takes into account both parties' nationality (as well as residence), French law might well apply.

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53. See *supra* note 25 and accompanying discussion.

*b. Copyright Ownership of Commissioned Artworks*

If the work at issue was the object of a commission, and, under some countries' copyright laws, the copyright would belong to the commissioning party,<sup>54</sup> one question is whether title to the copyright is considered to vest initially in the commissioning party, or whether the copyright vests (fleetingly) in the author, but is presumptively transferred to the co-contractant. In the latter case, one would continue to apply the contracts choice of law rules already discussed, although the conflicts analysis under the Restatement would look to factors additional to those reviewed above. Here, the place not only of sale, but of performance, that is, of execution of the artwork (for example of a portrait), may affect the determination of the applicable law. The Restatement, in addition to setting forth the factors listed above, further states: "if the place of negotiating the contract and the place of performance are in the same state, the local law of the state will usually be applied."<sup>55</sup>

However, if the commissioning party (or employer) is the initial copyright owner, as in the U.S. regime of works made for hire, another choice of law approach is warranted. I have elsewhere recommended application of the law of the work's country of origin to determine initial title to copyright when the work is for hire (or its foreign equivalent).<sup>56</sup> The recommendation contemplated works destined for broad international dissemination; in seemed undesirable to subject the exploitation of these works to the uncertainty that would result from imposition of different national laws regarding copyright ownership. It should be possible to grant reproduction, derivative work, and public performance rights in a work for exploitation in many countries without subjecting the title of the licensee to local challenge. In the context of commissioned artworks, it seems unlikely that, at the time of the commission, the parties contemplated this kind of exploitation of, for example, a portrait. Nonetheless, even if the initial rationale does not apply to commissioned artworks, there may still be good reasons to apply the law of the country of the work's origin. In fact, as we will see, this law will generally coincide with the law designated by the contracts conflicts rule already discussed.

According to the Berne Convention, a work's country of origin is the country of first publication; for unpublished works, it is the country of

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54. See *supra* notes 34-36 for countries and conditions under which commissioning parties may own the copyright in the resulting artworks.

55. RESTATEMENT (SECOND) OF CONFLICT OF LAWS, § 118(3) (1988).

56. See Jane C. Ginsburg, *Note on the Decision of March 14, 1991 of the Cour d'Appel de Paris*, 1992 JURIS CLASSEUR PERIODIQUE II 21780; Jane C. Ginsburg, *Les Conflits de Lois Relatifs au Titulaire Initial du Droit d'Auteur*, CAHIERS DU DROIT D'AUTEUR, No. 18, at 1 (July-August 1989); Jane C. Ginsburg, *Colors in Conflicts: Moral Rights and the Foreign Exploitation of Colorized U.S. Motion Pictures*, 36 J. COPYRIGHT SOC'Y 81, 98 (1988).

which the author is a national or domiciliary.<sup>57</sup> Because the dispute concerns ownership of pecuniary exploitation rights, unpublished works will generally be at issue; the dispute arises when the author or commissioning party seeks for the first time to exercise reproduction or derivative works rights. Moreover, even if the commissioning party has already undertaken to exploit the copyright, these acts do not constitute a "publication" if the commissioning party was not in fact the copyright owner. A publication that the copyright owner has not authorized is not a valid "first publication;" despite the work's dissemination, the work remains formally "unpublished."<sup>58</sup>

As a result, the law of the artist's nationality or domicile will determine copyright ownership. However, the artist's nationality may not always be the same as her domicile. For example, if Pablita Métisse, albeit a Spanish national, lived in England from 1950-1960, and there painted a portrait on commission, the law of her British domicile would confer the copyright on the commissioning party, while the law of her nationality (which, for present purposes we will assume to be very similar to French law), would maintain the artist's ownership of the copyright. Because the general trend in international choice of law conventions designates the law of the parties' "habitual residence" rather than of their nationality,<sup>59</sup> we will consider that the country of origin of an unpublished work is the country of the author's domicile.

Designating the competence of the law of the author's domicile to determine initial title to copyright, however, may occasionally produce arbitrary results. For example, suppose that Pablita Métisse, then residing in England, returned temporarily to France to paint a commissioned portrait of a French national and domiciliary. She executed and sold the painting in France, where it remained. Despite Pablita's British domicile (under whose law copyright ownership would pass to the commissioning party), the country with the "most significant relationship" to the transaction is clearly France, under whose law copyright would remain with the artist. It therefore seems appropriate to introduce the same flexibility into the choice of law rule for determining initial title to copyright as the Rome Convention extends to determining the law applicable to contractual obligations: while the applicable law is presumptively that of the artist's residence, if the "closest ties" are to another country's law, the latter will apply.

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57. Berne Convention, *supra* note 41, art. 5(4).

58. *See id.*, art. 3.3 ("The expression 'published works' means works published with the consent of their authors."); accord American Academy of Motion Picture Arts & Sciences v. Creative House Promotions, *supra* note 27.

59. *See, e.g.*, 1955 Hague Convention and 1986 Hague Draft Convention, *supra* note 50; Rome Convention, *supra* note 49. Moreover, most common law and Latin American countries apply the law of the parties' domicile rather than of their nationality. *See Y. LOUSSOUARN & P. BOUREL, DROIT INTERNATIONAL PRIVÉ*, 149 (4th Ed. 1993).

Applying these choice of law rules to another example of a work commissioned from Pablita Métisse (here a French resident), suppose a Dutch national engaged Métisse to paint a portrait of her husband, also a Dutch national, with sittings and delivery of the portrait to occur in the Netherlands. Under the analysis here proposed, it does not matter whether, under Dutch law, copyright ownership of a commissioned portrait vests initially in the commissioning party, or is presumed to be transferred from the artist. Under the country of origin (modified by the most significant relationship test) approach, as well as under Rome Convention (and, for that matter, under the Restatement), Dutch law has the "closest ties" to the transaction, and would therefore apply, despite Pablita's French residence, and the party commissioning the portrait would be deemed the copyright holder. Suppose instead that the sittings and delivery occurred in Pablita's studio in Paris. In that case, all the rules rehearsed above would point toward French law, and Métisse would retain the copyright.

## 2. Eviction of the Normally Competent Law by the Forum's "*Ordre Public*"

The courts of France and of other continental countries that follow traditional conflicts analysis sometimes palliate the designation of a foreign law that would result in application of a rule the forum finds extremely unappealing, by holding that the result violates the forum's "*ordre public*" (weakly translated as "public policy"), and therefore applying the forum's substantive rule instead.<sup>60</sup> The Rome Convention allows limited leeway for signatories to decline to apply the law whose competence the Convention designates. The Convention states that "[t]he application of a rule of the law of any country . . . may be refused only if such application is manifestly incompatible with the public policy (*ordre public*) of the forum."<sup>61</sup>

Therefore, in order to determine whether a European, and particularly a French court, would reject a foreign law designated by the law of the work's country of origin or by the Rome Convention, whose application would confer copyright on the purchaser or commissioning party rather than on the author, it is necessary to determine whether vesting copyright in a person other than the author is "manifestly incompatible" with local public policy. For example, if MOMMA sought to license a French entity to exploit merchandising properties based on the works of Pablita Métisse sold in New York to New York buyers during the 1950s, or based on portraits commissioned by English and Dutch residents and

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60. See generally HENRI BATIFFOL & PAUL LAGARDE, *DROIT INTERNATIONAL PRIVÉ*, Tome 1, 409-428 (7th ed. 1981).

61. Rome Convention, *supra* note 49, art. 16.

executed by Pablita in those countries, could Pablita's heirs successfully invoke French "*ordre public*" to challenge the copyright title MOMMA acquired from the purchasers of the works at issue?

While French courts have invoked local "*ordre public*" to invalidate transfers of moral rights, they have not found an international contract's disposition of pecuniary rights to violate local public policy, even though the arrangement would not have been permissible in a contract governed by French law.<sup>62</sup> It would therefore seem that application of New York, English, or Dutch law to the Pablita Métisse works in question, thus depriving the author of pecuniary rights in these works, would not run afoul French conflicts doctrine.

However, one might contend that it is one thing when an author enters into an international contract and knowingly conveys rights under terms inconsistent with French law, but permissible under the law of the contract; it is another when the author never explicitly conferred any rights under copyright, rather the copyright was simply presumed to be granted along with the primary object of the transaction, the corporeal work of art. Arguably, French public policy would be more offended at the latter outcome than the former. This argument would be more convincing if French authorities had demonstrated, as a matter of domestic law, that presumptions of transfer of copyright in artworks violate local public policy. But the High Court's decisions, including one of fairly recent date, continuing to enforce the effects of the pre-1910 presumptions of transfer, undercut the strength of the "*ordre public*" contention.

Finally, one could contend that the rights at issue are not purely pecuniary. Rather, since they include the right to publicly disseminate, perhaps for the first time, images of the work, the moral right of divulgation is also implicated. If French courts are more solicitous to preserve French law protection of moral than pecuniary rights in international contracts, perhaps "*ordre public*" would come into play were the "moral" aspect of the contract highlighted. There are at least two

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62. See, e.g., Decision of February 1, 1989, Cour d'Appel, Paris, Première Chambre, 142 REVUE INTERNATIONALE DU DROIT D'AUTEUR 301 (1989), note Pierre Sirinelli. In this case, in a contract governed by New York law, a French author agreed to be a ghost writer, thus transferring her moral right of attribution to a credited co-writer (a French national resident in New York), and also agreed to accept a lump sum payment, instead of proportional remuneration, as would have been required under French law. The court held the contract to violate French "*ordre public*" insofar as it alienated the moral right of attribution. By contrast, the court also held that the contract's arrangements for pecuniary compensation, albeit at variance with French law, did not violate "*ordre public*." See also, Decision of March 14, 1991, 1992 JURIS CLASSEUR PÉRIODIQUE II 21780, note Jane Ginsburg, where the court held that the Italian copyright law's work made for hire provision, conferring on an employer initial title to pecuniary rights in employee-created designs, is "in no way contrary to '*ordre public*' as understood in French private international law."

problems with this argument. First, the moral rights to which French courts have given international precedence are the rights of attribution and integrity. These are the only moral rights mentioned in the 1964 law, cited by the *Huston* court, which sets forth the terms under which foreign works will be protected.<sup>63</sup> The other moral rights, of divulgation and "repentance,"<sup>64</sup> appear to be of less moment for international private law. Second, the moral right of divulgation is not absolute. Although the law provides that "only the author has the right to divulge the work,"<sup>65</sup> it also states that in the event of "notorious abuse in the use or nonuse" of the right of divulgation by the author's heirs, a court may order the work to be divulged.<sup>66</sup> When a right is qualified as a matter of domestic law, it is less likely that it will be deemed to express the kind of exceptionally strong public policy that warrants displacing an otherwise competent, albeit contrary, foreign law.<sup>67</sup>

### CONCLUSION

Once the forum applies its conflicts rules to designate a law competent to determine copyright ownership of pecuniary rights, it appears that the forum will not unsettle this designation through imposition of the "*ordre public*" exception. The law that EC member countries' courts would deem normally competent to determine whether the purchaser of the original artwork also owns the pecuniary rights should be the law of the artist's residence at the time of the sale, or the national (or state) law with the most significant relationship to the artist, the purchaser, and the transaction. U.S. courts would probably also apply the most significant relationship test to determine whether there has been a transfer of copyright with the canvas. Where the artist has created the work on commission, the forum (whether U.S. or E.C.) should apply the law of the work's country of origin -- the artist's then-residence -- or, if that law's relationship to the transaction seems too slim, then the law of the most significant relationship, to determine initial title to the copyright.

Thus, if a French or European court applies the law of the contract or of the country of origin to deem MOMMA (or its predecessors) the copyright owner of the Pablita Mëtisse works at issue, it seems likely that the designation will not be disturbed. However, it is important to

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63. C. PROP. INTELLECTUELLE, *supra* note 1, art. L-111-4. The second paragraph of this provision states, "In any event there may be no violation of the integrity or paternity of these [foreign] works."

64. *See id.*, arts. L-121-2 (divulgation), L-121-4 (repentance).

65. *Id.*, art. L-121-2.

66. *Id.*, art. L-121-3.

67. On the "attenuated effect" ["*effet atténué*"] of the forum's "*ordre public*" on a transaction to which a foreign law normally applies, *see generally* BATIFFOL & LAGARDE, *supra* note 59, at 424-426.

recall that the law of the country of protection determines which, and to what extent, rights may be granted. Thus, even a foreign court, applying its choice of law rules, identifies MOMMA as the copyright owner by presumption of transfer, the *scope* of the rights MOMMA owns will nonetheless be defined by the domestic copyright law of the country where protection is sought. That law may exclude means of exploitation unknown at the time of the transfer. As a result, despite recognition of its title to pecuniary rights, MOMMA's ability to license certain forms of exploitation, notably those involving technologies unknown at the time of acquisition of the copyright, may be more limited in some fora than in others. Moreover, before the courts of France and many other European countries, Pablita Métisse, and now her heirs, Columba and Claudia, will always retain the moral rights of attribution and integrity, and may invoke these against MOMMA's French and other European exploitations.