ALIENABILITY RESTRICTIONS AND THE ENHANCEMENT OF AUTHOR AUTONOMY IN UNITED STATES AND CONTINENTAL COPYRIGHT LAW

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I. INTRODUCTION

A cardinal incident of what we commonly call ownership is the right to relinquish title to the object of ownership and to direct to whom, if anyone, that title is to be transferred.[1] The owner of a shoe or the holder of a right to receive the winnings of the New York State Lottery may freely sell, give away, or bequeath the shoe or right, or may abandon the shoe or waive the right to the lottery winnings.[2]

American law has traditionally treated authors' creations as objects of ownership. In enacting the Copyright Act of 1976, Congress declared its adherence to "the principle of unlimited alienability of copyright."[3] The Copyright Act accords authors a bundle of exclusive rights to exploit their work, including: the right to reproduce, publicly exhibit, distribute copies, and make adaptations.[4] The principle of unlimited alienability requires that an author be free to assign, license, and waive each of these exploitation rights, much like the owner of a shoe, car, or home. It also means that the author's assignee becomes the new sovereign owner of those rights. Thus, absent an express contractual obligation to the contrary, the assignee is entitled to exploit or dispense with the work as the assignee sees fit, without further need to obtain author consent.

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[1] A. M. Honore, *Ownership, in* OXFORD ESSAYS IN JURISPRUDENCE 107, 118-19 (A.G. Guest ed., 1st ser. 1961). *But see* Margaret J. Radin, *Market-Inalienability*, 100 HARV. L. REV. 1849, 1909-21 (1987) (arguing that where property is necessary for self-constitution and personal development, it should be subject to alienability restrictions).

[2] *See* N.Y. TAX LAW §§ 1600-16 (McKinney 1987). *But see* CAL. GOV'T CODE § 8880.32(g) (West 1992) (providing that the right of any person to a California State Lottery prize shall not be assignable, except to his estate or by appropriate judicial order).

[3] H.R. REP. NO. 1476, 94th Cong., 2d Sess. 21, 123 (1976) [hereinafter 1976 HOUSE REPORT].

[4] 17 U.S.C. § 106 (1988).

The application of traditional property concepts to copyright, as expressed in the Copyright Act's principle of unlimited alienability, contrasts with Continental European copyright doctrine.[5] Continental doctrine regards literary and artistic works as inalienable extensions of the author's personality. This view finds expression in restrictions on the market transfer and waiver of copyright. These restrictions are designed, in large part, to protect the author's personal interest in determining whether, when, by whom, and in what manner his work is presented to the public. The alienability restrictions under Continental doctrine include those arising from the author's so-called "moral right."[6] With certain limitations, the moral right entitles an author—even after granting to another the exclusive right to market his work—to block publication, determine how authorship is attributed, and prevent material changes in, or uses of, the work that are repugnant to the author's artistic conception. An author's control over the communication of his work is further enhanced under Continental doctrine through several additional barriers to copyright commodification, which operate in synergy with the moral right. These barriers include: unwaivable transferee obligations to disseminate the work, restrictions on retransfers, rules of contract interpretation that require authors' copyright grants to be narrowly construed, and limitations on author ability to convey rights in works not yet created. Finally, in some European countries copyright is simply non-assignable, although authors may grant licenses to exploit their work.

While essentially foreign to American jurisprudence, the Continental conception of creative works as inalienable extensions of personality has established a beachhead in this country. A number of U.S. courts have attempted to fashion analogues to certain Continental copyright inalienability restrictions out of American unfair competition, tort, and contract law.[7] The Supreme Court has noted that the U.S. Copyright Act's right of publication implicates authors' personal interest in creative control in addition to their

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[5] It is preferable to refer to Continental doctrine as "authors' rights," rather than "copyright," in order to translate Continental nomenclature more accurately and reflect Continental concerns for the interest of natural authors more precisely. Nevertheless, for the sake of stylistic simplicity, this Article generally refers to both Continental and United States doctrine as "copyright."

[6] The term "moral right" is a translation of the French "*droit moral*." The German "Urheberpersönlichkeitsrecht," meaning "author's rights of personality," describes the nature of the rights more accurately, but the commonly-used terms "moral right" and "moral rights" will be employed here.

[7] *See infra* notes 203-10 and accompanying text.

proprietary interest in the work's exploitation.[8] In addition, several state legislatures and, most recently, Congress have accorded a measure of moral rights protection to creators of fine art.[9] Finally, numerous commentators have called for expanded recognition of authors' personal rights in their work.[10]

The United States' accession to the Berne Convention for the Protection of Literary and Artistic Works, effective March 1, 1989, has given considerable impetus to this tentative movement toward Europeanization. The Convention's provisions are largely reflective of Continental copyright doctrine and contain requirements concerning authors' moral right to be identified with and to prevent distortions of their works even after the right to exploit the work has been sold or licensed.[11] After years of debate over the extent to which these requirements would upset the equilibrium of U.S. copyright law and run counter to traditional property doctrine in this country,[12] Congress laid the groundwork for accession by enacting the Berne Convention Implementation Act of 1988.[13] The Implementation Act provided for the minimal amount of change in domestic law thought necessary to bring the United States into compliance with the Convention's provisions, and did not provide for explicit recognition of moral rights or any other

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8 Harper & Row v. Nation Enterprises, 471 U.S. 539, 555 (1984).

9 *See infra* note 227.

10 *See, e.g.*, Phyllis Amarnick, *American Recognition of the Moral Right: Issues and Options*, 29 COPYRIGHT L. SYMP. (ASCAP) 31 (1983); Edward J. Damich, *The Right of Personality: A Common-Law Basis for Protection of the Moral Rights of Authors*, 23 GA. L. REV. 1 (1988); Roberta R. Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1 (1985); John H. Merryman, *The Refrigerator of Bernard Buffet*, 27 HASTINGS L.J. 1023 (1976); Michael E. Horowitz, Note, *Artists' Rights in the United States: Toward Federal Legislation*, 25 HARV. J. ON LEGIS. 153 (1988).

11 The Berne Convention for the Protection of Literary and Artistic Works, art. 6bis, S. TREATY DOC. No. 27, 99th Cong., 2d Sess. 3706 (1986) [hereinafter Berne Convention].

12 *See* MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.21[2][a], at 8-279 to 8-280 (1993) (discussing the "avalanche of opposition to moral rights" in Congressional debates concerning adherence to the Berne Convention); *Berne Convention Implementation: Hearings on H.R. 4262 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary*, 100th Cong., 1st & 2d Sess. 345-48 (1987-88) [hereinafter *Berne Hearings*] (statement of the Coalition to Preserve the American Copyright Tradition) (arguing that the concept of the moral right is outside the U.S. Copyright tradition and purpose of providing an economic incentive for the creation and dissemination of works of authorship); Stephen L. Carter, *Owning What Doesn't Exist*, 13 HARV. J.L. & PUB. POL'Y 99, 101 (1991) (asserting that the moral right doctrine means that owners of paintings, films and other cultural works "should not have the right to do with their possessions as they wish"); Lawrence A. Beyer, *Intentionalism, Art and the Suppression of Innovation: Film Colorization and the Philosophy of Moral Rights*, 82 NW. U. L. REV. 1011, 1047, 1052-54 (1988) (arguing that the moral right of integrity runs counter to traditional notions of freedom of choice in market transactions).

13 Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended in scattered sections of 17 U.S.C.).

Continental restriction on copyright alienability.[14] Despite this ostensibly minimalist approach, in the view of many commentators adherence to Berne will work a gradual but appreciable change in the American copyright system by exposing it to the continuing influence of Continental copyright doctrine.

The Visual Artists Rights Act of 1990 exemplifies this influence, as well as Congressional efforts to contain it.[15] According to the House Report, the Act is designed to bring "U.S. law into greater harmony with laws of other Berne countries."[16] The Act accords creators of original works of fine art certain narrowly circumscribed non-transferable and only partially waivable moral rights.[17] Unlike traditional American copyright, these newly enacted rights are non-transferable and only partially waivable.[18] Moreover, the Act requires that the Register of Copyrights conduct a study to determine whether the rights should be waivable at all.[19]

This Article examines the Continental copyright alienability limitations described above and the extent to which they may be compatible with American legal norms. Throughout this Article

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14 The House Committee report accompanying the Berne Convention Implementation Act bill noted that the proposed legislation adopted the "minimalist approach" of "amending the Copyright Act only where there is a clear conflict with the express provisions of the Berne Convention (Paris Act of 1971); and further, . . . only insofar as it is necessary to resolve the conflict in a manner compatible with the public interest, respecting the pre-existing balance of rights and limitations in the Copyright Act as a whole." H.R. REP. NO. 609, 100th Cong., 2d Sess. 20 (1988). With regard to moral rights, the Berne Convention Implementation Act provides:

> (b) CERTAIN RIGHTS NOT AFFECTED. The provisions of the Berne Convention, the adherence of the United States, thereto, and satisfaction of the United States obligations thereunder, do not expand or reduce any right of an author of a work—
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> (1) to claim authorship of the work; or (2) to object to any distortion, mutilation, or other modifications of, or other derogatory action in relation to, the work, that would prejudice the author's honor or reputation.

Berne Convention Implementation Act, *supra* note 13, § 3.

15 Visual Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5128 (codified as 17 U.S.C. § 106A (Supp. II 1990)). Ironically, the ultimate effect of the Visual Artists Rights Act may actually be to limit artists' moral rights by preempting state statutory provisions that accorded broader protection. *See* NIMMER & NIMMER, *supra* note 12, § 8.21 [B][2], at 8-282.6 to 8-292; *see infra* note 227. For a further discussion of the Visual Artists Rights Act see *infra* text accompanying notes 227-53.

16 H. REP. NO. 253, 101st Cong., 2nd Sess. 10 (1990) (quoting *The Visual Rights Act of 1989: Hearings on H.R. 2690 Before the Subcomm. on the Courts, Intellectual Property, and the Admin. of Justice*, 101st Cong., 1st Sess. 37 (1989) (statement of Ralph Oman, Register of Copyrights), reprinted in 1990 U.S.C.C.A.N. 6915, 6920 [hereinafter Visual Artists House Report].

17 *See infra* text accompanying notes 235-40.

18 Visual Rights Act of 1990, Pub. L. No. 101-650, §§ 603(e), 608(a), 104 Stat. 5128 (codified at 17 U.S.C. § 106A(e) (Supp. II 1990)). A waiver of the rights is effective only as to the works and the uses of such works that are specifically identified in a written instrument signed by the author. *Id.* § 603(e)(1). Moreover, the waiver is effective only as to the transferee to whom it is made. Visual Artists House Report, *supra* note 16, at 18-19.

19 *See infra* text accompanying notes 247-53.

the limitations are referred to as "autonomy inalienabilities": "inalienabilities" because they severely circumscribe author ability to alienate copyright entitlements by transfer or waiver, and "autonomy" because, although they limit authors' contractual freedom, they are designed ultimately to enhance authors' independent control of expression and communication *vis-à-vis* publishers, producers, and other persons who have obtained economic exploitation rights in creative works. In this Article the French and German copyright traditions will be exclusively relied on to represent Continental doctrine. These two traditions reflect, respectively, the Hegelian and Kantian schools of copyright thought, which have exerted a predominant influence on jurists and lawmakers throughout the civil law world.

Prior comparative scholarship in this area has suffered from three principal shortcomings, which this Article seeks to address. First, the commentary has centered on the moral right to the exclusion of other Continental copyright alienability restrictions. This narrow focus takes the moral right out of its context in Continental doctrine and fails to account for the synergistic effects of its operation with other autonomy inalienabilites.

Second, only passing consideration has been given to the troublesome question of the extent to which the moral right is actually inalienable, as Continental doctrine purports it to be. Commentators seeking to minimize the inconsistencies between United States and Continental doctrine have argued that the moral right is inalienable only in theory. This position confuses statutory limitations on the scope and exercise of the moral right with the author's waiver of the right. This Article examines the moral right alienability question in some detail and concludes that the moral right, together with other Continental doctrine, constitutes a significant restraint on copyright alienability.

Third, in assessing the extent to which the moral right finds American law parallels, the commentary tends to concentrate on statutory provisions and individual case holdings without considering their rhetorical underpinnings or practical effect. In failing to consider the rhetorical foundations, some commentators have exaggerated the extent to which American and Continental law converge. To the extent that American law contains approximate parallels to Continental autonomy inalienabilities, the parallels result from a patchwork of rules and policies designed to protect a variety of economic, public, and personal interests. But as this Article will show, Continental moral rights, together with other autonomy inalienabilities, form a cohesive legal doctrine, backed by a

longstanding theoretical tradition that espouses an inseverable personal connection between authors and their creations. It is a thesis of this Article that the theoretical and doctrinal rationales for legal rules make a difference in their import. The rhetoric of Continental commentators, together with the matrix of rules that are seen to act in concert to protect author autonomy, promote a very different conception of creative expression than does American law. As we shall see, Continental authors' rights ideology has supported judicial applications of autonomy inalienability rules that far exceed the scope of American analogues. In addition, one must presume that the ideology informs the attitudes and practices of Continental authors and publishers even beyond its expression in case law.

At the same time, and somewhat contradictorily, some commentators have overestimated the significance of the moral right by giving undue weight to black letter law and insufficient consideration to industry practice.[20] The exigencies of the market may vitiate Continental law protection of author autonomy in some sectors. For example, independent scriptwriters and directors, who generaly rely on an ongoing relationship with producers for their livelihood, may be reluctant to exert their autonomy rights in the face of producer opposition. To the extent that autonomy alienability rules are ignored in practice, their import on the Continent and their divergence from American law may be reduced. On the other hand, Continental case law evinces considerable author willingness to counter egregious violations of their autonomy rights in most areas, including television and film production. This suggests that, even if moral rights and other autonomy inalienability rules do not fully inform industry practice, they do afford authors with additional leverage in determining the manner in which authors' works are disseminated.

With these points in mind, Part I of this Article examines the theoretical bases for the divergent treatment of copyright and alienability in American and Continental doctrine. Part II discusses the substantive similarities and differences between the Continental moral rights doctrine and its American analogues. Part III examines the inalienability of the moral right. Part IV discusses and compares the lesser known, but equally important, Continental autonomy inalienabilities and their American counterparts. Together with the moral right, these alienability restrictions provide

[20] The author is indebted to Paul Goldstein for raising this issue and for the insights gained from discussions with him concerning it.

for a measure of continuing author sovereignty over creative works, and a correlative restriction on transferees' free exploitation and disposition of such work that is unknown in the United States.

II. Comparative Copyright Theory

United States copyright law differs fundamentally from its Continental counterpart. U.S. copyright doctrine applies traditional property principles to the field of copyright, and treats authors' works as the subject of proprietary, quasi-ownership rights.[21] In contrast, Continental copyright law and doctrine focuses on the author and his personal relationship to his work.[22] Continental doctrine views copyright essentially as the protection of the author's individual character and spirit as expressed in his literary or artistic creation.[23] Although a work may be commercially exploited, it is not simply a commodity—and many commentators would say that it is not a commodity at all.[24] Instead, the work is seen, partially or wholly, as an extension of the author's personality, the means by which he seeks to communicate to the public. "When an artist creates, . . . he does more than bring into the world a unique object having only exploitive possibilities; he projects into the world part of his personality and subjects it to the ravages of public use."[25]

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21 *See generally* Wendy J. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent and Encouragement Theory*, 41 Stan. L. Rev. 1343 (1989).

The non-recognition of any inherent, personal connection between the author and his work has also been suggested by the formal requirements and work-for-hire provisions of the U.S. Copyright Act. Under the Act, an author's work is protected only when and if it is "fixed in any tangible medium of expression." 17 U.S.C. § 102(a) (1988). In addition, until recent amendments designed in large part to bring the U.S. into compliance with the Berne Convention, protection has been conditional compliance with statutory requirements of notice and registration. For a thorough discussion of the statutory formalities and their gradual and incomplete elimination under the Copyright Act of 1909, the Copyright Act of 1976, and the Berne Convention Implementation Act, see Nimmer & Nimmer, *supra* note 12, ch. 7.

Under the work-for-hire provisions, when an employee creates a work in the course of employment, the employer—and not the employee—is deemed to be the "author" of the work for purposes of the Copyright Act. The employer is also the first copyright owner, unless the parties have agreed otherwise. 17 U.S.C. § 201(b) (1988).

22 For example, the German Copyright Statute provides: "Copyright shall protect the author with respect to his intellectual and personal relations to the work, and also with respect to the utilization of the work." Gesetz über Urheberrecht und verwandte Schutz rechte, 1965 Bundesgesetzblatt [BGBl.] I art. II (F.R.G.) [hereinafter German Act] (translated in UNESCO, 2 Copyright Laws and Treaties of the World art. II (1987)).

23 *See* Stig Strömholm, *Droit Moral—The International and Comparative Scene from a Scandinavian Viewpoint*, 14 Int'l Rev. Indus. Prop. & Copyright L. [I.I.C.] 1, 13 (1983) ("'The expression of individuality' has in fact become the central formula around which all Continental European copyright law . . . is organized.").

24 *Id.*

25 Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 Harv. L. Rev. 554, 557 (1940) (summarizing the Continental perspective on

The contrasting approaches of United States and Continental copyright laws are reflected in the treatment of the alienability of authors' rights in each system. In the United States, copyright inalienabilities are an anomaly. Until the recent enactment of the Visual Artists Rights Act of 1990, the single substantive alienability restriction found in the Copyright Act—the right of authors and their heirs to terminate copyright grants after thirty-five years—served solely to improve the bargaining position of the author so that he could achieve a greater return on the exploitation of his work.[26] Continental copyright law, on the other hand, has long contained pervasive restrictions on alienability. In essence, these restrictions reflect the idea that the author's transfer of his exploitation rights does not disengage him from his work.

The fundamental differences between United States and Continental copyright law originate in the divergent influences of Anglo-American and Continental liberalism, particularly, in the varying classification and treatment of authors' works within these traditions as subject or object, person or property. United States copyright law has been molded principally by classical utilitarianism and, to a lesser extent, by Lockean natural right theory.[27] Con-

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moral rights). Continental copyright provides for "patrimonial" or "pecuniary" rights, similar to those in the United States, that enable the author to commercially exploit his work. As in the United States, the author in France or Germany has the exclusive right for a limited number of years to reproduce, distribute, exhibit and publicly communicate his work and to exploit adaptations of his work. GERMAN ACT, *supra* note 22, arts. 15-22; Loi du 11 mars 1957 Sur la Propriete Litteraire et Artistique, arts. 26-28, 1957 J.O. 2733, 1957 D.L. 102 (Fr.) [hereinafter FRENCH ACT] (translated in UNESCO, 1 COPYRIGHT LAWS AND TREATIES OF THE WORLD (1987)). But in contrast to U.S. law, the exploitation rights are vested only in the natural person who created the work (except rights in computer software under the French Act). André Lucas & Robert Plaisant, *France, in* 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE FRA-1, FRA-42 (Melville B. Nimmer & P. Geller eds., 1992); Adolf Dietz, *Germany, in* 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra*, at FRG-1, FRG-44 to FRG-45. They also take effect immediately upon the work's completion, without any requirement of fixation or registration. Lucas & Plaisant, *supra*, at FRA-11 to FRA-12; Dietz, *supra*, at FRG-16 to FRG-17. Moreover, the exploitation rights are said to be intertwined with and subordinate to the author's various personal rights in his work.

[26] 17 U.S.C. §§ 203, 304 (1988). According to the House Report accompanying the 1976 Copyright Act, the termination provision was "needed because of the unequal bargaining position of authors, resulting from the impossibility of determining a work's value until it has been exploited." H.R. REP. NO. 1476, 94th Cong., 2d Sess. 124 (1976). In addition to its restriction on inter vivos transfers, 17 U.S.C. § 203 specifies which persons are to hold the author's termination interest in the event of his death. Similarly, the Copyright Act of 1909, which provided for a two-term renewable copyright, enumerated mandatory heirs to the author's renewal interest. It was held that, under the 1909 Act, an author could prospectively assign his own renewal interest during the first copyright term, but not that of the statuory heirs. For an insightful discussion of these copyright-law restraints on authors' freedom to devise the termination and renewal interests, see Francis M. Nevins, Jr., *The Magic Kingdom of Will-Bumping: Where Estates Law and Copyright Law Collide*, 35 J. COPYRIGHT SOC'Y 77 (1988).

[27] The Supreme Court has also given credence to the idea that the right to control the first public distribution of an author's work implicates the author's "personal interest in

tinental copyright law, on the other hand, is a combination of natural rights concepts and German idealism. An examination of these contrasting theoretical underpinnings is the key to understanding the disparate treatment of alienability in the two systems.

A. *Anglo-American Liberalism and Authors' Works as Alienable Goods*

The fundamental overriding purpose of U.S. copyright law is social utility. The U.S. Supreme Court has repeatedly stated that the limited "monopoly privileges" granted to authors by the Copyright Act are designed to advance the public welfare by providing economic incentives for creative effort, while at the same time making the fruits of such effort available to as many people as possible, as cheaply as possible.[28] Authors are granted exclusive rights in order to spur the creation and dissemination of their work. Copyright is a privilege designed to serve the public interest, not an entitlement arising from the fact of creation.[29]

Lockean labor-desert theory enjoyed a prominent role in early Anglo-American doctrine, but has since provided a distinctly secondary rationale for copyright protection.[30] Recent Supreme Court

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creative control," as well as the "property interest" of "exploitation of prepublication rights." Harper & Row v. Nation Enterprises, 471 U.S. 539, 555 (1984). The common law right of authors to prevent public dissemination of their works was also enlisted in support of the state law right of privacy. Louis D. Brandeis & Samuel D. Warren, *The Right to Privacy*, 4 HARV. L. REV. 193, 198-99 (1890).

[28] *See, e.g.*, Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984); Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975).

[29] The utilitarian view of copyright has a venerable historic tradition. It finds its statutory antecedent in the first copyright statute, the English Statute of Anne of 1710. 8 Anne, c. 19 (1710). This statute is entitled "An Act for the Encouragement of Learning" and recited that it was enacted to enable learned men to write useful books. *Id.* It accorded authors and their assigns the sole right to print and reprint the authors' books for a period of fourteen years from first publication, upon compliance with registration and deposit requirements and subject to the power of various authorities to fix a fair price for copies of the book if they determined that price sought by the publisher was unreasonably high. *Id.* *See also* AUGUSTINE BIRRELL, SEVEN LECTURES ON THE LAW AND HISTORY OF COPYRIGHT IN BOOKS 21 (1899). The focus on copyright as a means to promote the general public good was incorporated in the intellectual property clause of the Constitution, which empowers Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. Similarly, the first federal copyright statute, like the Statute of Anne, was entitled "An act for the encouragement of learning" and, like subsequent federal copyright statutes until the Copyright Act of 1976, required publication and compliance with deposit and notice requirements as a condition to protection. Act of May 31, 1790, ch. XV, 1 Stat. 124.

[30] *See* William F. Fisher III, *Reconstructing the Fair Use Doctrine*, 100 HARV. L. REV. 1661, 1688-89 (1988) (noting that early American commentary on copyright law frequently invoked labor-desert theories). Moreover, several state copyright statutes enacted prior to the first federal copyright statute invoked Lockean natural rights doctrine, as well as public benefit rationale, to support the granting of exclusive rights in literary works. The preamble to the Massachusetts Act of March 17, 1783, stated, for example, that " 'the legal security of the fruits of their study and industry . . . is one of the natural rights of all men, there

opinions have reiterated that rewarding the author is a secondary consideration of copyright law and that the author has no natural right to such a reward.[31]

The labor-desert theory rests upon the idea that authors acquire a natural property right in their work by virtue of having exerted the effort to create it. At its foundation, this concept likens the author's original expression of an idea to a material object transformed by human labor. In Locke's theory, one earns the right to appropriate a material object by "mingling" it with one's physical labor and improving it to create a value-added version of the object, in essence a new object, that did not exist previously.[32] For Lockean proponents of a natural law copyright, the author's expression is an ideal object, a "product of the mind" which the author has procured the right to hold as his property by having created it with his mental labor.[33]

Eighteenth- and nineteenth-century advocates of the labor-desert theory argued that products of the mind are properly the subject of a perpetual property right that stands independently of any statutory grant or privilege.[34] Modern-day proponents of this the-

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being no property more peculiarly a man's own than that which is procured by the labor of his mind.' " Massachusetts Act of March 17, 1783, *quoted in* Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 147 R.I.D.A. 125, 145-47 (1991). Republican ideology also played a prominent role in early American copyright law. For a discussion of this influence, see *id.*

31 *See, e.g.*, Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984). *See also* Ralph S. Brown, *Eligibility for Copyright Protection: A Search for Principled Standards*, 70 MINN. L. REV. 579, 593 (1985) (citing "the deeply rooted understanding that copyright flows from acts of Congress and not from natural right").

32 *See* JOHN LOCKE, THE SECOND TREATISE OF GOVERNMENT §§ 27-28, at 17-18 (Thomas Pearson ed., 1952) (1689).

33 AYN RAND, *Patents and Copyrights*, *in* CAPITALISM: THE UNKNOWN IDEAL 126, 130 (1967). *See also* Millar v. Taylor, 98 Eng. Rep. 201, 221 (K.B. 1769) (Austin, J.). Although Lockean labor-desert theory and the utilitarian incentive theory both award productive labor, their emphasis is completely different. Under the former the laborer has a God-given natural right in the product of his labor, prior to any social order. Under the latter the producer's right is entirely a matter of social convention. It is actually more a benefit than a right, and that benefit is entirely subject to the will of the sovereign.

34 *See, e.g.*, *Millar*, 98 Eng. Rep. at 250-54 (L. Mansfield). The debate over whether authors enjoy a perpetual, common law, proprietary copyright that survives the enactment of limited statutory protection involved many of the most prominent legal and literary figures of the time. As noted by Justice M'Lean: "Perhaps no topic in England has excited more discussion, among literary and talented men, than that of the literary property of authors. So engrossing was the subject, for a long time, as to leave few neutrals, among those who were distinguished for their learning and ability." Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 654-55 (1834).

Proponents of a perpetual common law right included William Blackstone, Lord Mansfield, John Milton, and Mark Twain; opponents included Samuel Johnson and David Hume. The debate and litigation concerning this issue is discussed in: MARK ROSE, AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT 67-112 (1993), BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 12-16, 26-27 (1968), and BIRRELL, *supra* note 29, at 99-138. Mark Twain's cogent and entertaining argument in support of a perpetual property right

ory generally concede that the authors' rights must be limited in time and scope, provided that authors receive a fair return for their labors.[35] Even so, they continue to employ the property analogy in defense of the copyright system[36] and to couch the relation between authors and their work as "absolute possession" and the "exclusive right of use and disposal,"[37] classical liberal terminology for people's dominion over external things.

Significantly, both the utilitarian and natural rights models assume and require the free alienability of copyright. Under the utilitarian model, the widespread dissemination of intellectual works is as important a goal of copyright as is their creation. Since dissemination is accomplished by publishers and distributors, rather than authors, copyright is designed as much to protect the publisher's investment in bringing a work to market as it is to give the author an incentive to produce.[38] Thus, since the Statute of Anne of 1710, the English predecessor to U.S. copyright law, statutory copyright privileges have been accorded to authors' assigns as well as to authors themselves.[39]

Moreover, the utilitarian model of economic incentive to stimulate author production and publisher dissemination presupposes a private-property based milieu in which authors' and publishers'

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in literary works is presented in MARK TWAIN, *Petition Concerning Copyright*, *in* THE COMPLETE HUMOROUS SKETCHES AND TALES OF MARK TWAIN 1875 (C. Naider ed., 1961).

[35] This is much more modest than the historical claim for perpetual property right, since it introduces the question of what is a fair return. *See* Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281, 284-85 (1970). Earlier proponents of the natural rights theory of copyright maintained that an author is entitled to whatever profits his mental products produce, without limit in amount or time. *See, e.g.*, *Millar*, 98 Eng. Rep. at 231 (Yates, describing the argument of William Blackstone before the court). Advocates of a fair return contend that the securing of this entitlement is an independent and proper goal of the U.S. Copyright Act. *See* Fisher, *supra* note 30, at 1688-89 (arguing that the Supreme Court has alluded to a right of fair return that is independent of considerations of social utility); David Ladd, *The Harm of the Concept of Harm in Copyright*, 30 J. COPYRIGHT SOC'Y 421, 425-27 (1982-83) (asserting that the basis of U.S. copyright is "a felt sense of what is right and just"). *See also* Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 OHIO ST. L.J. 517, 546-47 (1990) (arguing that the limits to the scope of copyright protection can be found in a careful use of natural law principles).

[36] *See generally* Gordon, *supra* note 21.

[37] *See* Ladd, *supra* note 35, at 426 (quoting from statement of Professor Nathan Shaler presented to Congress in 1936 by then Register of Copyrights Throvald Solberg); RAND, *supra* note 33, at 130.

[38] *See* Breyer, *supra* note 35, at 292, 293-94.

[39] *See, e.g.*, 8 Anne, c. 19 (1710); 17 U.S.C. § 106 (1988) (according exclusive rights to the "owner of copyright"). Prior to the Statute of Anne, state grants of exclusive printing rights were accorded solely to publishers, not to authors. They were designed to encourage and regulate the printing trade, rather than give incentives to authors. Herman Finkelstein, *The Copyright Law—A Reappraisal*, 104 U. PA. L. REV. 1025, 1033-35 (1956). Publishers, not authors, were the prime beneficiaries of the Statute of Anne as well, since it was the practice at the time for publishers to take assignment of all rights in a work upon purchase of the manuscript. KAPLAN, *supra* note 34, at 7-9.

rewards are determined in the marketplace. This model necessarily views intellectual works as commodities. Their social utility and value to the author is measured by the amount the public will pay for them. Thus Adam Smith, although generally critical of monopoly privileges, lauded the temporary monopoly granted to authors and their assigns under the Statute of Anne as an efficient means of stimulating book production: "[I]f the book be a valuable one the demand for it in [the copyright period] will probably be a considerable addition to [the author's] fortune. But if it is of no value the advantage he can reap from it will be very small."[40] Modern proponents of Smith's functionalist, economic analysis view the creation of works of authorship much like the production of fungible consumer goods. They minimize non-economic inducements for such creation, such as prestige and the simple desire to create, and propose fine-tuning the copyright system to provide just the right amount of incentive for creative activity, without leading to under- or over-stimulation of production.[41]

For proponents of the natural rights theory of copyright, alienability follows from the analogization of copyright to the liberal prototype of property. The products of mental labor are their creator's property, just like the fruits of physical labor. And since alienability is an essential characteristic of property, products of mental labor, like corporeal property, must be fully "saleable."[42]

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[40] ADAM SMITH, LECTURES ON JURISPRUDENCE 83 (R.L. Meek, D.D. Raphael, P.G. Stein eds., Glasgow ed. 1978). Smith's intellectual descendants have not been so benign in their treatment of copyright. Encouraged in part by the Supreme Court utilitarian orientation to copyright, several commentators have questioned to what extent, if any, the exclusive privileges granted to authors and their assigns can be justified on economic grounds. *See* Fisher, *supra* note 30, at 1723-26 (calling for the replacement of copyright entitlements with liability rules and compulsory licensing systems on "economic efficiency" grounds); Stephen Breyer, *supra* note 35, at 281 (casting doubt on whether copyright is the most efficient means to encourage production of works of authorship and concluding that, at the very least, copyright protection should not be extended or strengthened); Hurt & Schuchman, *The Economic Rationale of Copyright*, 56 AM. ECON. REV. 421, 439 (1966) (arguing that "the traditional assumption that copyrights enhance the general welfare is at least subject to attack on theoretical [economic] grounds"). *But cf.* William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. OF LEGAL STUD. 325 (1989) (seeking to explain basic tenets of copyright doctrine on economic efficiency grounds). Functionalist criticism of copyright has a long history. In debates over the Literary Copyright Act of 1842, Lord Macauley attacked copyright as an undesirable monopoly that could be justified only to the extent that it achieved its objective of encouraging authors to write. *See* T. MACAULEY, SPEECHES ON COPYRIGHT (C. Gaston ed., 1914).

[41] *See, e.g.*, John Cirace, *When Does Complete Copying of Copyrighted Works for Purposes Other Than for Profit or Sale Constitute Fair Use? An Economic Analysis of the Sony Betamax and Williams & Williams Cases*, 28 ST. LOUIS U. L.J. 647, 681 (1984) (arguing that overcompensation to copyright owners "may overstimulate production of their works"); Landes & Posner, *supra* note 40, at 327-28 (stating that works will be created "only if the difference between expected revenues and the cost of making copies equals or exceeds the cost of expression").

[42] Millar v. Taylor, 98 Eng. Rep. 201, 221 (K.B. 1769) (Aston, J.).

Alienability has also traditionally been required to enable the author to "reap the pecuniary profits of his own ingenuity and labour."[43] At the time of the enactment of the Statute of Anne, like today, the principal means by which authors could earn a return from their labor was to bring their works to the market by selling or licensing the copyright to a publisher.[44] In addition, alienability was seized upon as a mechanism for limiting the duration of the author's property right. In 1834, in its seminal decision on the issue of the perpetual copyright, the United States Supreme Court accepted the Lockean argument that "a literary man is as much entitled to the product of his labour as any other member of society."[45] The Court ruled, however, that the author "realises this product by the transfer of his manuscripts, or in the sale of his works, when first published."[46] The author's natural law property right is either assigned to the transferee of the unpublished manuscript or extinguished by the work's sale to the public. The Court held, therefore, that copyright subsists in the work only to the extent provided by federal statute.[47] Finally, modern natural rights advocates rely upon copyright's free transferability to support their efforts to legitimize the copyright system by drawing parallels between copyright and tangible property.[48]

B. *The Continental Heritage: Property v. Personality*

In contrast to the utilitarian approach that dominates American copyright doctrine, Continental jurists have generally been re-

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[43] *Millar*, 98 Eng. Rep. at 252 (L. Mansfield).

[44] Throughout the eighteenth century, publishers generally purchased all rights in a work for a lump sum. Finkelstein, *supra* note 39, at 1037. Licensing and royalty arrangements were not developed until later. The sale or license of rights in works of authorship is not the sole arrangement that would provide creators with enough financial security to produce original works. Creators could be supported by private or government grants, or, as very often is the case, receive a salary from an employer who owns the copyright. *See* Breyer, *supra* note 35, at 282-83 (discussing private and government grants); Brown, *supra* note 31, at 591 n.72 (noting that in the Netherlands the government pays a salary to recognized professional artists). One could also permit unrestricted use and copying of intellectual works, but require the payment of user fees set by regulation, similar to compulsory licensing systems in effect with regard to certain types of works. *See* Fisher, *supra* note 30, at 1725-26.

[45] Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 657 (1834).

[46] *Id.*

[47] *Id.* at 661. In England, the argument for perpetual copyright was laid to rest by the House of Lords in its celebrated 1774 decision of Donaldson v. Becket, 1 Eng. Rep. 837 (1774). The court in *Donaldson* was sharply divided: seven of the eleven judges believed that the authors of a literary work and his assigns had an exclusive, perpetual right of printing and publishing the work at common law, but six judges voted that the right was preempted by the Statute of Anne. Lord Mansfield, a prominent supporter of the perpetual common law right, precluded himself from the proceedings. BIRRELL, *supra* note 29, at 124-28.

[48] *See, e.g.*, Gordon, *supra* note 21, at 1373-74.

luctant to see copyright as a sui generis, instrumentalist construct.[49] Instead, they have devoted substantial effort and imagination in the attempt to assimilate copyright within, or at least place it in relation to, the classical Roman law subdivision of rights: personality rights (rights of reputation, privacy, and other personal dignity interests), real rights (ownership, *usufruct*, easements) and personal rights (contract and tort claims).[50] In time, Continental copyright doctrine incorporated elements of all three categories, with a theoretical foundation consisting of a combination of natural rights doctrine and German idealism.

1. Continental Natural Rights Theory

The theory of natural law copyright was adopted by eighteenth century French authors as a tool for contesting the validity of royal printing privileges.[51] The theory achieved statutory recognition during the French Revolution, which swept away the royal printing privileges and replaced them with legislation based on the doctrine of intellectual property. The Revolutionary Laws of January 13-19, 1791, and July 19, 1793, codified inherent, exclusive rights of authors, dramatists, composers, and artists in their works.[52] The rights of such creators are viewed not as a statutory concession, but as a form of property that the legislature is obliged to recognize and protect.[53] The Law of July 19, 1793, explicitly conferred the

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[49] Even jurists who viewed copyright as a field apart from the classical rights generally categorized it as either a right that vests automatically upon the work's creation or a statutory privilege serving as a legitimate reward for social service, as opposed to an incentive for production. *See* Boudewijn Bouckaert, *What is Property?*, 13 HARV. J.L. & PUB. POL'Y 775, 792-93 (1990) (discussing the theories of Renouard, Roguin, and Picard); PIERRE RECHT, LE DROIT D'AUTEUR, UNE NOUVELLE FORME DE PROPRIÉTÉ (1969) (discussing the intellectual property theory of Pouliett).

[50] Bouckaert, *supra* note 49, at 793. *See also* RECHT, *supra* note 49 (discussing the competing theories of Continental jurists regarding the nature of author's rights and presenting his own conception of copyright as a new form of property).

[51] Bouckaert, *supra* note 49, at 791. For an insightful and detailed account of the use of natural law theory by publishers and authors and the debate regarding the nature of authorship in revolutionary France, see Carla Hesse, *Enlightenment Epistemology and the Laws of Authorship in Revolutionary France*, 30 REPRESENTATIONS 109 (1990). As Hesse points out, French publishers claimed, like their English counterparts, that their rights derived from a perpetual natural right, rather than from a state privilege. French playwrights claimed a natural right in the work in an effort to wrest away control from theater owners, who held the sole royal privileges in dramatic works. *Id.* at 112, 122, 125-26.

[52] *See* SAM RICKETSON, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS 1886-1986, at 5-6 (1987).

[53] In contrast to the copyright granted to authors by the Statute of Anne, the *droits d'auteur* arose automatically upon creation of a work, required no registration, deposit or other formalities, and extended for the life of the creator plus an additional five or ten years. (Even this was seen as a necessary, pragmatic compromise of the ideal of a perpetual property right.) *Id.* Limitations on the term of protection were justified by practical necessity. Lamartine, for example, distinguished the philosopher's recognition of a perpetual property right in an author's creation, akin to the natural right to the fruits of one's physi-

right to assign this property, and provided that assigns were to enjoy the same exclusive rights for the same period as the creator and his heirs.[54]

The alienability of the author's property rights was central to the natural rights component of *droits d'auteur.* Le Chapelier's report accompanying the 1793 revolutionary law referred to the author's work as " 'the most sacred and the most legitimate, the most unassailable and most personal of all of properties."[55] But this glowing pronouncement of authors' rights was tempered by other considerations. First, the Revolutionary legislators recognized the public interest in limiting the absolute character of the property right. Second, in the wake of the dissolution of royal privileges the legislators wished to provide publishers and theatrical companies with a legal basis for protecting their interests in intellectual works.[56] As in the United States, the limitation of the author's property right was justified by equating public dissemination with alienation. As Le Chapelier stated: "[W]hen an author has handed his work over to the public, [the author] has made [the public] a party to his property or, rather, he has transferred his property to it in full."[57] Publishers and theatrical companies found protection in the substitution of contract rights for royal privileges. By acquiring the author's property rights in a voluntary exchange, they obtained the legal authority to reproduce or perform the author's work and to prevent its infringement.[58]

The concept of ownership by natural right became the favored slogan of nineteenth-century Continental authors in their campaigns for legislative and international treaty recognition of economic rights in their work.[59] These efforts reached fruition in 1880 when the French Court of Cassation ruled that, except for the

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cal labor, from the legislator's obligation to eschew absolute principals in favor of practical legislation reflective of the mores and customs of the time. E. LABOULAYE, ETUDES SUR LA PROPRIETE LITTERAIRE XX (1858), *quoted in* BIRRELL, *supra* note 29, at 19.

For a discussion of republican ideology in early French copyright law, see Hesse, *supra* note 51; Ginsburg, *supra* note 30.

54 RICKETSON, *supra* note 52, at 5-6.

55 André Kerever, *The French Revolution and Authors' Rights,* 141 R.I.D.A. 9 (1989); *see also* Radojkovic, *Copyright: A General Structural Survey,* 1 COPYRIGHT 57, 60 n.22 (1965).

56 *See* Kerever, *supra* note 55, at 9.

57 *Id.* (quoting Le Chapelier's Report Accompanying the Law of 19 July 1793) (emphasis omitted).

58 *Id.* at 10.

59 The 1858 Brussels Conference on Literary and Artistic Property and the 1878 Paris Conference of the International Literary Association (headed by Victor Hugo) both enacted resolutions calling for international recognition of authors' natural property rights in their works. *See* RICKETSON, *supra* note 52, at 42, 46. For a detailed chronological account of the use of traditional property theory to characterize and promote authors' rights in nineteenth-century Europe, see RECHT, *supra* note 49, 48-60.

limitation on its duration dictated by the public interest, literary and artistic property have the same characteristics as any other form of property, and must be treated in the same fashion.[60]

By 1880, however, the property analogy begun to encounter significant opposition among Continental jurists.[61] Some argued that the rights accorded to and claimed by authors did not comport with the essential characteristics of real rights.[62] For others, the concepts of property and intellectual property had come to connote a bourgeois exclusion of the general public from its common inheritance.[63] For still others, the property analogy did not adequately express the growing emphasis on individual personality and the personal connection between authors and their creations.[64] As a result of such opposition, Continental jurists turned increasingly to German idealism as the grounding point for copyright doctrine. They based their theory on the writings of Kant and Hegel, which posit a sharp distinction between inalienable person-

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60 Judgment of Aug. 16, 1880 (Affaire Masson), Cass. civ. 3e, 1881 S. Jur. I 25, *quoted and discussed in* RECHT, *supra* note 49, at 50-51.

61 Although this marked the end of the effort to include copyright within the classical real-right construct, natural-law/property-right theory continues to influence Continental jurisprudence. The opening sentence of the French Act provides that "[t]he author of an intellectual work shall, by the mere fact of its creation, enjoy an exclusive incorporeal property right in the work, effective against all persons." FRENCH ACT, *supra* note 25, art. 1. Similarly, the German Constitutional Court has consistently held that protection of authors' rights is based on the guarantee of property afforded by the German Constitution. As a result, although the legislature has a degree of latitude in defining the scope of protection, it cannot derogate from the author's property rights in his work as recognized in the Constitution. Eugen Ulmer & Hans Hugo VanRauscher auf Weeg, *Germany (Federal Republic), in* STEPHEN M. STEWART, INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS 417 (2d ed. 1989).

62 The limited duration and incorporeal subject matter of copyright were seen as the principle obstacles to its classification as property. *See* French government comment on the Law of 14 July 1866, *quoted in* RECHT, *supra* note 49, at 55-56 (explaining deletion of reference to property in title of authors' rights law by limited duration of authors' rights); E. POUILLET, TRAITE THEORIQUE ET PRATIQUE DE LA PROPRIETE LITTERAIRE ET ARTISTIQUE 28 (3d ed. 1908) (1879), *quoted in* RECHT, *supra* note 49, at 62-63 (maintaining that copyright is a separate form of property, different from traditional Roman concept because its subject matter is intangible). In 1887, the Court of Cassation reversed its position on the classification of copyright as property, and held that "authors' rights confer only a temporary exclusive privilege of commercial exploitation." Judgment of July 27, 1887 (Arrêt Ricordi), Cass. req., 1888 D.P. I 5, note Sarraute, *quoted and discussed in* RECHT, *supra* note 49, at 68 (translation is this author's).

The description of authors' rights as property continued in German courts through the early twentieth century and was codified in the German copyright laws of 1901 and 1907. RECHT, *supra* note 49, at 75.

63 RECHT, *supra* note 49, at 54-55. Proudhon, for example, rejected the notion of property in intellectual works on the grounds that ideas belong to the community and cannot be appropriated by the author. Thus, while the author may be entitled to a reward, he cannot be considered the owner of his mental products. Radojkovic, *supra* note 55, at 58-59.

64 *See* RECHT, *supra* note 49, at 56-57 (discussing the personalist theories of Bertauld and Morillot).

ality and alienable property.[65]

2. Copyright Doctrine in the Writings of Kant and Hegel

Kant characterized authors' rights as personality rather than property.[66] According to Kant, an author's words are a continuing expression of his inner self. They are an action, an exertion of the author's will, rather than an external thing.[67] An author's right in his work is thus fundamentally a personal right.[68] It is "not a right in an object, . . . but an innate right inherent in his own person."[69]

In essence, the author's personal right is the right to communicate one's thought, which Kant depicted as an aspect of autonomy and freedom, the "one sole original, inborn Right belonging to every man in virtue of his Humanity."[70] A literary work is a speech or discourse addressed to the public in a particular form.[71] It is a narration of the author's thought. The author alone may determine whether and how his words are to be disseminated. Any person who illicitly publishes and distributes a literary work infringes upon the author's freedom because he is speaking in the author's name without the author's consent.[72] The infringer is, in effect, forcing the author to speak against his will, in a forum and through a vehicle that is not of the author's choosing.[73]

The author's right of communication also implicates his contractual autonomy. Part and parcel of an individual's innate freedom is the right to not be be bound by others, except by choice.[74] A person may limit his active free will with respect to a given action or thing only by the autonomous exercise of his will in coming to

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65 For an insightful analysis of the subject/object dichotomy in the work of Kant and Hegel, see Radin, *supra* note 1, at 1891-94.

66 For Kant, the only propertizable external objects of the will were external corporeal things, another's free will in performance of a particular act, and certain status relationships. IMMANUEL KANT, THE PHILOSOPHY OF LAW 64 (W. Hastie trans., photo reprint 1887) (1974). For an illuminating discussion of the development of early copyright theory in Germany during Kant's time, see MARTHA WOODMANSEE, THE AUTHOR, ART, AND THE MARKET: REREADING THE HISTORY OF AESTHETICS 35-55 (1994).

67 Kant differentiated between literary works, which he categorized as action ("opera"), or an exercise of the author's powers, and works of art, which he depicted as corporeal objects ("opus") that are beyond the ambit of copyright protection. *See infra* note 84.

68 IMMANUEL KANT, *Von der Unrechtm assigket des Buchernachdruckes, in* IMMANUEL KANTS WERKE 213, 221 (E. Cassirer ed., 1913) (1785).

69 "[I]st aber kein Recht in der Sache, . . . sondera ein angebornes Recht in seiner eignen Person." *Id.* at 221 n.1 (quote translated by author and Joël Dorkam).

70 KANT, *supra* note 66, at 56.

71 *Id.* at 129-31; KANT, *supra* note 68, at 221.

72 KANT, *supra* note 68, at 213-14; KANT, *supra* note 66, at 129-30.

73 *See* KANT, *supra* note 68, at 221 n.1 (an author may not be compelled to speak against his will).

74 KANT, *supra* note 66, at 56.

an agreement with another.[75]

The author's decision to create his work and have it published requires such an autonomous exercise of free will. Kant viewed the publication of a literary work as a tripartite transaction between the author, the publisher, and the public. The author creates the work and decides to communicate it to the public; the publisher disseminates the work on behalf of the author; and the public has certain rights to receive the work.[76] It is the author who must determine whether to conduct the transaction, and through which publisher his work is to be communicated. Viewed in this manner, the illicit publisher infringes upon the author's contractual autonomy, as well as upon his right of communication. By disseminating the author's work without the author's consent, the illicit publisher conducts a transaction as if on behalf of the author, but against the author's wishes.[77]

In Kant's view, however, the author does not have unlimited contractual freedom. While the author may grant to others the right to *use* his work, he may not transfer title in the work or assign his rights with respect to it.[78] Therefore, the publisher may disseminate a literary work only as the author's agent, in the author's name, and on the author's behalf.[79] The publisher's rights in the work derive solely from his agency commission, and not from any proprietary interest. In fact, the publisher's rights, even in an original manuscript that he has purported to have purchased from the author, do not extend beyond his use of the manuscript to further the transaction between the author and the public.[80]

The inalienability of the author's rights in his work follows from Kant's categorization of a literary work as part of the author's

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75 KANT, *supra* note 68, at 219.

76 *Id.* at 213-16. Although the publication of a literary work is not a typical commercial transaction, it is founded upon contractual and quasi-contractual rights and duties. Thus, for example, an author may not grant publication rights to more than one publisher, since this would render superfluous the work of the first publisher. *Id.* at 215-16. At the same time, the publisher has certain obligations towards the public to disseminate the author's work. If the author dies without heirs prior to publication, the public may require that the publisher disseminate copies of the work in an adequate number and of an acceptable quality, or that he transfer the manuscript to another publisher who is able to do so. KANT, *supra* note 66, at 131.

77 KANT, *supra* note 68, at 215 n.1.

78 KANT, *supra* note 66, at 130.

79 *See id.* at 130-31; KANT, *supra* note 68, at 215-16. According to one commentator, Kant's desire to find a legal basis for protecting publishers was no less than his concern for authors. *See* 1 STIG STRÖMHOLM, LE DROIT MORAL DE L'AUTEUR 184 (1967). However, Kant believed that publisher's rights are, in essence, derived from those of the author, and do not amount to an independent proprietary interest. *See* KANT, *supra* note 66, at 124-25.

80 KANT, *supra* note 68, at 219-20.

person, as opposed to an external thing.[81] As a result of its identification with personality, a literary work is a component of the inalienable subject. It is not an object that may be acquired and exchanged by exercise of human will. Kant emphasized this distinction by contrasting books with money. For Kant, money expresses the transferability of external objects in its purest and most developed form. Money is "the greatest and most useable of all the Means of human intercommunication through Things, in the way of Purchase and Sale in commerce."[82] It "is a thing which can only be made use of, by being alienated or exchanged."[83] A book, on the other hand, is more than merely an external thing that can be bought and sold. It is the author's communication to the public, and thus is imbued with the personality of the author. It is the "means of carrying on the interchange of Thought," as opposed to commerce.[84]

In contrast to Kant, Hegel regarded intellectual works as external things, rather than extensions of personality. Although Hegel viewed mental ability as an inalienable part of the self, he maintained that the formulation of expression in an external medium could transform products of the mind into alienable property.[85] Mental products are externalized when they are expressed in a form that may be produced by other people.[86] For Hegel, both artistic and literary works met this criterion for propertization. A work of art is the portrayal of thought in an external medium that can be copied by another.[87] A literary work is an expression of thought in a series of separable abstract symbols that can be mechanically reproduced.[88] As in modern copyright law, the author does not necessarily alienate his right to reproduce his work

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81 *Id.* at 220-21.

82 KANT, *supra* note 66, at 124.

83 *Id.* at 125.

84 *Id.* Curiously, Kant also differentiated between books and works of art, the latter of which he classified solely as objects. Immanuel Kant, *Was ist ein Buch?*, *in* DIE METAPHYSIK DIE SITTEN 405 (W. Weischedel ed., 1977), *quoted in translation in* Palmer, *Are Patents and Copyrights Morally Justified? The Philosophy of Property Rights and Ideal Objects*, 13 HARV. J.L. & PUB. POL'Y 817, 840 (1990).

85 GEORGE W. F. HEGEL, HEGEL'S PHILOSOPHY OF RIGHT §§ 43, 68 (T. Knot trans., 1952).

86 *Id.* § 68.

87 *Id.*

88 *Id.* Hegel also addressed the traditional idea-expression dichotomy in copyright doctrine, whereby the author's form of expression is protected, but the underlying idea is not. Hegel posited that ideas are not susceptible to protection because "the purpose of a product of mind is that people other than its author should understand it and make it the possession of their ideas . . . ." This, in turn, entitles the readers to express in their own way what they have learned, thereby converting their expression into a thing which they can alienate and regard as their own property. *Id.* at 55.

when he sells his manuscript or painting to another.[89] But since the right to reproduce is a part of the work's "external use," the author is free to part with the right "as a thing of value, or to attach no value to it all and surrender it together with the single exemplar of his work."[90]

3. The German Idealist Legacy

The writings of Kant and Hegel, as interpreted and applied by later theorists, have profoundly influenced the development of Continental copyright law. The Kantian conception of author's rights has found expression in the monist school of copyright theory, the most prominent proponents of which have been Otto von Gierke and Philipp Allfeld.[91] Monists hold that it is an author's fundamentally personal right[92] to determine when, in what form, and to what object his creative product is to be communicated to the public.[93] Intellectual works are part of the internal, personal sphere. Accordingly, an author's rights are rights of personality, rather than of property. They are akin to the dominion which one has over a part of oneself.[94]

Monists recognize that authors have an interest in economic exploitation of their works as well as a personal interest in the nature of their communication to the public. But monists see the economic interests as subsumed within the personal. Authors' rights may have patrimonial consequences or attributes, but there is no clear line of demarcation between these attributes and the fundamental core of personal interest prerogatives.[95] According to the monistic concept, the author's economic exploitation rights and personal rights are interrelated and mutually beneficial.[96] For example, the author's right to object to modifications of the work

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89 *Id.* § 69.

90 *Id. But see* Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 348-50 (1988). Hughes claims that Hegel posited that the complete alienation of an author's rights is an impermissible surrender of the self. Hughes's claim, however, is based upon a misreading of Hegel's explicit and much more limited statement that an author who transfers a copy of his work has simply "not necessarily alienated" the right to reproduce the work and "may reserve" that right to himself.

91 *See* STRÖMHOLM, *supra* note 79, at 329-31; FRANCIS J. KASE, COPYRIGHT THOUGHT IN CONTINENTAL EUROPE: ITS DEVELOPMENT, LEGAL THEORIES AND PHILOSOPHY 10-11, 16, 30-31 (1967). Gierke set forth his personalist theory of copyright in his two-volume work, DEUTSCHES PRIVATRECHT (1895). Allfeld expounded his views in KOMMENTAR ZU DEN GESETZEN (1902).

92 "Personal right" is referred to here in the sense of related to the self, and not to the classical Roman law meaning of the term.

93 *See* STRÖMHOLM, *supra* note 79, at 330; Radojkovic, *supra* note 55, at 61.

94 STRÖMHOLM, *supra* note 79, at 329.

95 *Id.* at 331.

96 *See* ADOLF DIETZ, COPYRIGHT LAW IN THE EUROPEAN COMMUNITY 67 (1978).

supports his personal interest in maintaining the integrity of his work, as well as his financial interest in preventing the work from being impaired by distortions.[97] At the same time, the successful commercial exploitation of the work serves the author's personal interests by disseminating his ideas and enhancing his reputation.[98]

The monists believe that authors' rights are unitary, personal, and inalienable.[99] Authors may grant licenses for the use and exploitation of their works, but they may not waive their rights or assign them to another.[100] Since the focus of the rights is the personality of the author and not his work, title to the rights must always remain with the author.

The monist theory of authors' rights was adopted by the German Act dealing with Copyright and Related Rights of September 9, 1965.[101] Under the German Act, copyright is a unitary right that protects the author with respect to his intellectual and personal relations to his work, as well as with respect to the exploitation of his work.[102] The German Act allows authors to grant licenses to use their works, but does not permit transfer of ownership, except by testamentary disposition.[103] The inalienability of copyright ownership is much more than a theoretical construct. Although an author may grant a global license of all exploitation rights in a work, upon termination of the license for any reason, all rights revert to the author.[104] Moreover, as discussed below, even during the term of the license, the author retains statutory rights that significantly restrict the licensee's right and ability to exploit the work.

In opposition to the Kantian-based monist theory of author's rights, Hegel's adherents developed a dualist theory, which assumes that the author's personal and economic interests are each protected by a legally and conceptually distinct set of rights.[105] Although the author has an indissoluble personal interest in the

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97 *Id.*

98 *Id.*

99 STRÖMHOLM, *supra* note 79, at 331.

100 In examining the German Copyright Law of 1901, Allfeld concluded that the global alienation permitted by the law referred to alienation of use (der Ausübung nach) and not of title (der Substanz nach). *Id.*

101 *See* GERMAN ACT, *supra* note 22. The German Act has been amended in 1969, 1970, 1972, 1973, 1974 and 1985.

102 *See* GERMAN ACT, *supra* note 22, art. 11.

103 *Id.* arts. 29, 31. *See also* Dietz, *supra* note 25, at FRG-56.

104 Dietz, *supra* note 25, at FRG-48.

105 The author's personal interests are protected by the moral or personal rights of paternity, integrity, disclosure, and retraction. The author's pecuniary interests are protected by the rights to exploit the work commercially through reproduction or direct communication to the public.

way his work is presented to the world, he also enjoys the independent right to exploit his work commercially. The proponents of the dualist approach, the most prominent of which has been Josef Kohler,[106] follow Hegel's position that intellectual works are externalized products, which are separate and apart from the author's inner self.[107] Kohler posited that the author's pecuniary rights are essentially rights of property in "an incorporeal intangible legal commodity which stands outside man's personality."[108] But parallel to this classical "real right" are the author's personal prerogatives to have his work attributed to him and to determine when and in what form the work is to be presented to the public.[109] These prerogatives are anchored in the author's general rights of personality, which survive the market exploitation of the "immaterial good" produced by the author.

> [T]he writer can not only demand that no strange work be presented as his, but that his own work not be presented in a changed form. The author can make this demand even when he has given up his copyright. This demand is not so much an exercise of dominion over my own work, as it is of dominion over my being, over my personality which thus gives me the right to demand that no one shall share in my personality and have me say things which I have not said.[110]

The French Copyright Act of 1957[111] bears the imprint of dualist theory. The dualist nature of French *droits d'auteur* is expressed in Article 2 of the French Act, which accords authors an

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106 KASE, *supra* note 91, at 12. Kohler characterized the author's personal rights as part of the general law protecting the individual's personality interests, and as such falling outside the law of intellectual property. *Id.* Other dualists see the author's economic and personal rights as parallel but distinct subdoctrines of the law regarding author's rights. *See* Strömholm, *supra* note 79, at 11-12.

107 *See supra* text accompanying notes 85-89. Kohler was influenced by Fichte and Schopenhauer as well as Hegel. KASE, *supra* note 91, at 39.

108 KASE, *supra* note 91, at 12 (quoting and translating JOSEF KOHLER, URHEBERRECHT AN SCHRIFTWERKEN UND VERLAGSRECHT 1 (1907)). Kohler held that an author has an exclusive, *sui generis* immaterial property right (*immaterial guter rechte*) in his work by virtue of his having created it, just as in primitive times the maker of a material object was automatically its owner. JOSEF KOHLER, DAS AUTORRECHT 98 (1880).

Intellectual productions may be subject to private ownership only temporarily, since "mental achievements become in time universal cultural possessions, and the formative material of human activity." JOSEF KOHLER, PHILOSOPHY OF LAW 122 (A. Albrecht trans., 1914).

109 JOSEF KOHLER, FORSCHUNGEN AUS DEM PATENTRECHT, MANNHEIM 114-16 (1888), *discussed and quoted in part in* RECHT, *supra* note 49, at 78-80. Kohler posited that the author's personal rights are "clamped together" but not "soldered to" the author's pecuniary rights. *Id.*

110 JOSEF KOHLER, URHEBERRECHT AN SCHRIFTWERKEN AND VERLAGSRECHT 15 (1907), *quoted and translated in* Damich, *supra* note 10, at 29.

111 *See* FRENCH ACT, *supra* note 25.

"exclusive incorporeal property right" in their works and enumerates two distinct subsets of that right: "attributes of an intellectual and moral nature," and attributes of "an economic nature."[112] The conceptual duality of the French *droits d'auteur* finds practical expression in the different treatment given to moral and economic rights in the French Act provisions governing alienability, transmission, and duration. The author's moral rights are "perpetual, inalienable and imprescriptible."[113] The author's exploitation rights, on the other hand, are assignable independently of the moral rights[114] and are of limited duration.[115]

The dual character of French *droits d'auteur* should not be overemphasized, however. French commentators speak of the interdependence of the moral and economic rights, and indeed, of the predominance of the former over the latter.[116] Moreover, authors' moral rights and other inalienable statutory rights impose significant restraints upon the transfer of economic rights, and provide for an indissoluble link between authors and their works. Thus, as one French commentator has concluded, although French law conceives of authors' creations as economically exploitable property, it does not permit the acquisition of full ownership in an intellectual work.[117]

III. The Moral Right And Its United States Parallels

Autonomy inalienabilities under Continental law arise principally from the idea that an author has a personal connection with his work that remains intact even if someone else has acquired the rights to exploit the work. This personal connection has been variously described as one of artistic reputation, emotional sensibility, and dominion of personality. To be certain, autonomy inalienabilities do serve to protect authors' standing in the community, subjective feelings of attachment to their work, and personal

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112 Henri Desbois, Le Droit D'Auteur en France 275 (3d ed. 1978). The language of Article 2 seems to suggest that authors hold a single right with two sets of attributes. This could coincide with the monist view, depending upon the extent to which the attributes are viewed as interdependent and interrelated. Therefore, the dualist nature of French *droits d'auteur* would seem to be founded in the divergent treatment of moral and economic rights in French doctrine, rather than in the language of Article 2.

113 French Act, *supra* note 25, art. 6, para. 2.

114 *Id.* art. 30. Ironically, although transfers of ownership are fully permitted, French law does not recognize copyright licenses as such; authors grant "authorizations" that in fact amount to licenses of certain rights. Lucas & Plaisant, *supra* note 25, at FRA-59.

115 French Act, *supra* note 25, arts. 21-23. As a general rule, the exploitation rights continue for the life of the author, plus 50 years.

116 Desbois, *supra* note 112.

117 *See* Alphonse Tournier, *Peut-on Acquërir la Propriété d'une Oeuvre de l'Esprit selon la loi Francaise du 11 Mars 1957?*, 20 R.I.D.A. 3 (1958).

integrity. But the most important function of autonomy inalienabilities is the protection and promotion of author sovereignty and control over the process of creating and communicating intellectual works. In the aggregate, the restrictions on alienability serve to enhance the author's ability to determine whether, when, in what manner, by whom, and in whose name the work will be presented to the public.[118]

The doctrine of moral right represents the most significant restriction on alienability in Continental copyright law aside from Germany's flat-out prohibition of copyright assignments. In France and Germany, the doctrine of moral right includes four components: the rights of disclosure, withdrawal, attribution, and integrity. The right of disclosure gives to the author the exclusive right to determine whether to create the work, whether the work is completed, and whether and in what manner to disclose the work to the public.[119] The right of withdrawal permits the author to terminate the dissemination or exhibition of the work to the public, even after it has been disclosed.[120] The right of attribution enables the author to require that he be identified as the author of his work, or that the work be published either pseudonymously or anonymously.[121] The right of integrity allows the author to prevent uses or modifications of his work that would prejudice his reputation or other "intellectual interests" as an artist.[122]

As we shall see in this Part and the next, moral rights are not absolute. They are subject to limitations in scope and conditions of good faith exercise that are designed to give weight to competing interests of transferees, other users, and the public. Nevertheless, moral rights constitute a significant burden on a transferee's free use and exploitation of a work. As a general rule, these rights remain with the author even upon the transfer of pecuniary

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118 Alongside the function of autonomy of expression, certain Continental copyright inalienabilities also serve to promote authors' material interests by guaranteeing authors a higher remuneration than they might otherwise obtain through unregulated negotiation. This interference with the alienability of copyright exploitation rights is part of a general move away from the traditional liberal model to contract freely. In the view of modern Continental theorists, as with many of their American counterparts, limitless freedom of contract is unwarranted where the parties have grossly unequal bargaining power. Eugen Ulmer, *Some Thoughts on the Law of Copyright Contracts*, 7 I.I.C. 202, 210-11 (1976). Continental law, when dealing with copyright contracts, uses the premise that the author is in a weaker economic and negotiating position than the transferee. It is also takes into account the special social value attached to literary and artistic works, and the need to provide economic maintenance for the creators of these works. *Id.* at 211-13.

119 *See infra* notes 129-55 and accompanying text.

120 *See infra* notes 156-64 and accompanying text.

121 *See infra* notes 165-88 and accompanying text.

122 *See infra* notes 189-226 and accompanying text.

rights.[123] Thus, a songwriter who has sold all worldwide exploitation rights in a song may still prevent the public performance of the song in a context or altered form that would damage the songwriter's reputation or vary significantly from the songwriter's artistic concept.[124] In addition, at least in theory, if the songwriter decides after a number of years that he no longer wishes to have the song communicated to the public, he may bring the dissemination of his song to an end.

United States law does not systematically recognize moral rights, although the Visual Artists Rights Act and a number of state acts accord limited moral rights protection to works of fine art. Recent years have seen an abundance of commentary concerning whether, despite the absence of explicit recognition, functional equivalents to moral rights can be found in United States federal and state law.[125] Many commentators contend that the combined legal effect of a patchwork of U.S. laws designed to protect a variety of economic, public, and personal interests results in colorable adherence to at least the moral rights requirements under Article 6*bis* of the Berne Convention.[126] Congress agreed with this conclusion

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123 *See infra* notes 254-305 and accompanying text. *See also* Judgment of Dec. 12, 1988 (Delorme v. Catena-France), Cour d'appel, P.I.B.D. III, No. 454, 231 (assignment of copyright "for all purposes" did not confer the right to modify the work without the author's consent).

124 In the *Maske in Blau* decision, for example, the German Federal Court of Justice enjoined a stage production licensee from producing a version of an operetta that was said to distort the intent and mood of the original work. Judgment of Apr. 29, 1970, Bundesgerichtshofes [Supreme Court], 55 Entsheidungen des Bundesgerichtshofes in Zivilsacheh [BGHZ] 1.

125 *See, e.g.*, Amarnick, *supra* note 10; Damich, *supra* note 10; Kwall, *supra* note 10; Russell J. DaSilva, *Droit Moral and the Amoral Copyright: A Comparison of Artists' Rights in France and the United States*, 28 BULL. COPYRIGHT SOC'Y 1 (1980); Comment, *An Author's Artistic Reputation Under the Copyright Act of 1976*, 92 HARV. L. REV. 1490 (1979) [hereinafter *Reputation Comment*]; Susan L. Solomon, Comment, *Monty Python and the Lanham Act: In Search of the Moral Right*, 30 RUTGERS L. REV. 452 (1977); Comment, *Moral Rights for Artists Under the Lanham Act: Gilliam v. American Broad-casting Co.*, 18 WM. & MARY L. REV. 595 (1977); Joseph B. Valentine, Comment, *Copyright: Moral Right—A Proposal*, 43 FORDHAM L. REV. 793 (1975); Dominique Giocanti, *Moral Rights: Authors' Protection and Business Need*, 10 J. INT'L L. & ECON. 627 (1975); Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539 (1972); James M. Treece, *American Law Analogues of the Authors' "Moral Right"*, 16 AM. J. COMP. L. 487 (1968); Comment, *The Moral Rights of the Author: A Comparative Study*, 71 DICK. L. REV. 93 (1966); William Strauss, *The Moral Right of the Author*, 4 AM. J. COMP. L. 506 (1955); Arthur L. Stevenson, Jr., *Moral Right and the Common Law: A Proposal*, 6 COPYRIGHT L. SYMP. (ASCAP) 89 (1953); Arthur S. Katz, *The Doctrine of Moral Right and American Copyright Law—A Proposal*, 24 S. CAL. L. REV. 375 (1951).

126 The relevant portions of Article 6*bis* read as follows:

> (1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.
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in enacting the Berne Convention Implementation Act. The Act adopted the view that no expansion of U.S. law was necessary to meet the United States' obligations under Article 6*bis*.[127] But the Berne Convention's moral right requirements are considerably weaker than the provisions in effect in France, Germany, and other civil law countries.[128] As we shall see, the United States moral right analogues fall short of the more stringent French and German provisions, in terms of both their raw legal result and overall social effect. As such, Continental moral rights represent a considerably greater restriction on copyright alienability than do the U.S. analogues.

A. *The Right of Disclosure*

The right of disclosure is codified in both the French and German Acts.[129] Each provides that authors shall have the exclusive right to determine whether and how their work is disseminated.[130] The German Act goes beyond the French in one respect. In addition to the right to control the dissemination of the work itself, the German Act also gives the author the exclusive right to issue the first public summmary or description of a new and as yet unpublished work.[131] In other respects, however, the French provision appears to afford authors a greater measure of control than the German. As we will see, French doctrine and commentary strongly

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(3) The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.

Berne Convention, *supra* note 11, art. 6*bis*.

127 Berne Implementation Act provides that "[t]he obligations of the United States under the Berne Convention may be performed only pursuant to appropriate domestic law," and that "[t]he amendments made by this Act, together with the law as it exists on the date of the enactment of this Act, satisfy the obligations of the United States in adhering to the Berne Convention and no further rights or interests shall be recognized or created for that purpose." Pub. L. No. 100-568, § 2(2), (3), 102 Stat. 2853 (1988). The Act further provides that "[t]he provisions of the Berne Convention, the adherence of the United States thereto, and satisfaction of United States obligations thereunder, do not expand or reduce any right of an author of a work" with respect to the paternity or integrity right. *Id.* § 3(b).

128 The Berne Convention's moral right requirements are weaker in a number of ways. First, the Convention covers only the rights of attribution and integrity, and not the rights of disclosure and withdrawal. Second, the Berne integrity right arguably protects only against distortions that would damage an author's honor or reputaiton, and not against uses that simply would contradict the author's artistic concept. Third, the Convention arguably permits the waiver and transfer of the attribution and integrity rights independently from the author's pecuniary rights, whereas under French and German law the moral right is said to be inalienable.

129 FRENCH ACT, *supra* note 25, art. 19; GERMAN ACT, *supra* note 22, art. 12. The French right is generally translated as the right of divulgation, and the German right, the right of dissemination. "Right of disclosure" is used in this Article.

130 FRENCH ACT, *supra* note 25, art. 19; GERMAN ACT, *supra* note 22, art. 12.

131 GERMAN ACT, *supra* note 22, art. 12(2).

suggest that the author's moral right of disclosure may override his contractual commitments to produce or allow public dissemination of his work. German doctrine is less clear on this point. Some commentators argue that the German disclosure right is essentially coterminous with the pecuniary right of publication; once an author has authorized publication, he is contractually bound to release his work.[132] Other German commentators insist that the disclosure right stands, in some fashion, independently from the publication right.[133] The analysis in this section will be drawn largely from French sources, with an understanding that its applicability to German law is somewhat speculative. In addition, the analysis will not extend to the disclosure right of authors of audiovisual works, since both the French and German Acts contain special provisions that sharply limit the right in the area of film production.[134]

The right of disclosure is founded upon two basic premises. First, an author's work cannot be said to exist as an independent thing that stands outside the author unless and until the author determines that it has been completed.[135] Until that time, the unfinished work is "as though it were retained in its creator's brain . . . a conversation between the author and himself."[136] As a result,

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[132] Dietz, *supra* note 25, at FRG-84 to FRG-85. Recently, however, Dr. Dietz has noted that the disclosure right extends beyond the scope of the publication right in two respects. First, the disclosure right gives employed and commissioned authors the right to determine when their work is complete and ready to be handed over. Second, according to rules of private international law applicable to the German Act, foreign authors are automatically accorded the disclosure right (together with the attribution and integrity rights), but are accorded the publication right and other economic exploitation rights only when required by Germany's treaty obligations. Adolf Dietz, Legal Principles of Moral Rights in Civil Law Countries 7-8, Presented to the Association Litteraire et Artistique Internationale, Antwerp Congress on the Moral Right of the Author (Sept. 19-24, 1993).

[133] *See* Eric Marcus, *The Moral Right of the Artist in Germany*, 25 COPYRIGHT L. SYMP. (ASCAP) 93, 99 (1975) (noting that most German scholars do accept the moral right of disclosure as an independent right).

[134] The French provisions were added to the French Act by the controversial Law on Authors' Rights and on the Rights of Performers, Producers of Phonograms and Videograms and Audiovisual Communication Enterprises, July 3, 1985, No. 85-660, 1985 J.O. 1, *translated in* UNESCO, 2 COPYRIGHT LAWS AND TREATIES OF THE WORLD (1987) (hereinafter 1985 Amendments). Article 15 of the French Act now provides that if an author refuses or is unable to complete his contribution to an audiovisual work, he may not oppose the use of the part of his contribution already in existence for the purpose of completing the work. Article 19 of the French Act now provides that an author's disclosure right is subject to Article 63-1, which provides that the rights of authors of an audiovisual work, except for authors of its musical score, are deemed to have assigned to the producer their exploitation rights in the work, unless their contract stipulates otherwise. Article 89 of the German Act provides that authors of audiovisual works are deemed, in case of doubt, to have granted to the producer the exclusive right to exploit the work in every known manner.

[135] *See* Raymond Sarraute, *Current Theory on the Moral Right of Authors and Artists Under French Law*, 16 AM. J. COMP. L. 465, 467 (1968).

[136] *Id.* at 471.

a commissioned author's contractual obligation to transfer a work or the rights to exploit the work cannot take effect until the author determines that the work is complete and conforms to his original conception.[137] Thus, an author's good-faith inability to complete a work does not constitute a breach of a commission contract; the author's lack of inspiration is a normal risk contemplated by the parties.[138]

Second, even when a work has been completed, only the author may decide when and how the work will be publicly disclosed. At least under French law, the author enjoys this prerogative even when the work and all rights to exploit it are owned by a transferee.[139] As a result, an artist may prevent a transferee from reproducing and publicly exhibiting even a completed work that is in the transferee's possession. Likewise, an author may prohibit publication of a completed manuscript, even though he has assigned publication rights and delivered the manuscript to his publisher.[140]

The sole, although by no means insubstantial, caveat to the exercise of the right of disclosure, at least after the work has been completed, is the requirement that the author compensate the transferee for damages resulting from the author's breach of contract.[141] This requirement has led some commentators to suggest

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137 This principle is well illustrated by the renowned case, Judgment of March 19, 1947 (L'Affaire Roualt), Cour d'appel, 1949 D.P. II 20 (Fr.), in which the painter, Roualt, agreed to transfer all of his work to Vollard, an art dealer. Vollard kept over 800 of Roualt's unfinished paintings locked in his gallery, where Roualt would come to apply finishing touches. Upon Vollard's death, his heirs claimed ownership of the paintings. Roualt maintained that the paintings were unfinished and therefore only he could decide when to effect their final delivery. The Paris Court of Appeal ruled in Roualt's favor:

> Whereas, one who negotiates with an artist for an uncompleted work which the author retains in his possession, reserving the right to finish it, contracts for future goods whose ownership can be only transferred by delivery without reservation after completion, and is not like the buyer who purchases an artistic production in any state which the painter intends definitively to part with even though it is in the form of a sketch; Therefore, until final delivery the painter remains master of his work, and may perfect it, modify it, or even leave it unfinished if he loses all hope of making it worthy of himself; This inalienable right, an attribute of the artist's moral right, persists notwithstanding any agreement to the contrary; and the breach of any such agreement exposes the author who changes his mind only to damages.

Discussed and quoted in English translation in Sarraute, *supra* note 135, at 469-70.

138 Sarraute, *supra* note 135, at 468; DESBOIS, *supra* note 112, at 476. In its ruling in the Roualt case, the Paris Court of Appeal suggested that an artist may be required to pay damages even if the artist's failure to deliver results from lack of inspiration. In that case, however, the court required only that the artist refund the advances he had received. Judgment of Mar. 19, 1947, 1949 D.P. II, at 20.

139 Damich, *supra* note 10, at 36; DaSilva, *supra* note 125, at 20.

140 Lucas & Plaisant, *supra* note 25, at FRA-95.

141 *See, e.g.*, Judgment of May 14, 1900 (Whistler v. Eden), Cass. civ., 1900 D.P. I 500 (Fr.) (holding that the artist, Whistler, was not required to deliver a completed portrait that had been commissioned by Eden, but that he had to compensate Eden for his breach of the commission contract). *But see* DESBOIS, *supra* note 112, at 476 (suggesting that in contrast

that the right of disclosure is merely a glorified version of the contract law proscription, found in common and civil law, against the imposition of specific performance in a personal service contract.[142] At first glance, this argument appears to have some merit. According to black-letter contract law, any person—not just an author—whose services have been retained may substitute money damages for promised performance.[143] Like the right of disclosure, this entitlement is inalienable, and any agreement purporting to forfeit it is invalid as a matter of law.[144]

The theoretical justification for the inalienable entitlement to substitute money damages for promised performance differs from that for the right of disclosure. The rule against compulsory performance of a personal service contract is based upon the two-fold rationale of administrative convenience and concern for personality interests. First, compulsory performance would require, in many instances, an inordinate amount of judicial supervision over an extended period of time. Courts would be called upon to undertake the difficult and time-consuming task of gauging whether the defendant is properly performing the services to the best of his ability.[145] Second, the specific performance of a contract requiring the promisor's ongoing personal cooperation with the other party

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to the right of withdrawal, which the author may exercise only by compensating the transferee, the right of dissemination gives the author the absolute discretion to decide whether to publish the work, exercisable without an obligation to compensate the transferee). On the other hand, a court might order an author to deliver a completed work in accordance with a commission contract where the author seeks to exercise his right of disclosure in bad faith by attempting to obtain a higher price for the work from another party. Giocanti, *supra* note 125, at 634.

The French Act also makes an exception to the right of divulgation for cinematographic works, which combine the creative efforts of several persons. Article 15 provides that an author who refuses or is unable to complete his contribution to such a work may not oppose the use of the part of his contribution already in existence for the purpose of completing the work. FRENCH ACT, *supra* note 25, art. 15.

142 *See, e.g.*, STRÖMHOLM, *supra* note 79, at 23. Article 1142 of the French Civil Code limits the remedy for any contractual breach to an award of damages. André Françon & Jane Ginsburg, *Authors' Rights In France: The Moral Right of the Creator of a Commissioned Work to Compel the Commissioning Party to Complete the Work*, 9 COLUM.-VLA J.L. & ARTS 381 (1985).

143 SAMUEL WILLISTON, A TREATISE ON THE LAW OF CONTRACTS § 1423 (3d ed. 1972); RESTATEMENT (SECOND) OF THE LAW OF CONTRACTS § 367(1) (1981).

144 WILLISTON, *supra* note 143; RESTATEMENT (SECOND) OF THE LAW OF CONTRACTS, *supra* note 143.

145 WILLISTON, *supra* note 143; RESTATEMENT (SECOND) OF THE LAW OF CONTRACTS, *supra* note 143. *See also* Society of Survivors v. Huttenbach, 535 N.Y.S.2d 670, 675 (Sup. Ct. 1988) (society of Holocaust survivors and author not required to work together to complete and publish manuscript on the grounds that a court is unable to mandate cooperation between relevant parties).

Specific performance of plaintiff has an adequate legal remedy. WILLISTON, *supra* note 143, § 1423, at 786.

may threaten his autonomy, integrity, and self-respect.[146] A promisor who is compelled to perform may have to act in dissonance with newly-found but deeply-held convictions, desires, or goals. The inalienable entitlement of substituting money damages for performance enables the promisor to meet contractual obligations in a way that may be less intrusive upon his liberty and less denigrating to his person.[147]

The right of disclosure also touches upon personality interests, but these pertain specifically to the author's act of creation and subsequent continuing relationship with the thing created. Under French doctrine, and possibly under German law as well, a commissioned author enjoys a considerably greater measure of autonomy in deciding whether to comply with the contractual duty to create than does the promisor in a personal service contract in deciding whether to perform. By exercising the right of disclosure, the author who lacks the inspiration to create is apparently excused from the commission contract altogether. In contrast, a promisor who has agreed to provide other types of personal services must fulfill his obligations, if not by specific performance, then by payment of damages.

Recognizing the author's personal interest in controlling the dissemination of a work also yields a different result than protecting the autonomy and integrity of the promisor in a personal services contract. Under moral rights doctrine, even an author who has completed his work may avoid its delivery and public disclosure by compensating the transferee. But general contract doctrine would not entitle the author to substitute damages for performance. Having already performed the personal service of completing the work, the author would suffer no protectible injury to his autonomy and integrity by being compelled to deliver the product.[148] For this reason, when an author breaches his agreement to assign a copyright and deliver the manuscript in which the copyrighted work is embodied, U.S. courts may compel him to do so.[149]

In addition to the contract law doctrine of specific performance, some commentators point to the U.S. Copyright Act's first

146 *See* Anthony T. Kronman, *Paternalism and the Law of Contracts*, 92 YALE L.J. 763, 781-85 (1983).

147 *Id.*

148 Contracts for the sale of unique goods, such as a completed painting, are specifically enforceable since only a transfer of property, and not ongoing personal service under the direction of another, is required. *Id.* at 785.

149 *See* Hughes Tool Co. v. Fawcett Publications, Inc., 315 A.2d 577 (Del. 1974) (holding that the manuscript may be recovered at law by a claim for replevin or detinue, and the copyright assignment may be compelled at equity by mandatory injunction).

publication and public display rights as equivalents to the moral right of divulgation.[150] Section 106 of the U.S. Copyright Act accords copyright owners the exclusive right to distribute copies of a work to the public and to display the work publicly.[151] A U.S. author who holds the exclusive rights of publication and display may rely upon them to determine whether, and under what conditions, his work is disseminated. Like his Continental counterpart, he may require that his work be withheld from circulation even if he has transferred possession and title of a manuscript, canvas, or other physical object embodying the work.[152]

Although the U.S. Act's first publication right is essentially a pecuniary right, the Supreme Court has recognized that it also implicates the author's "personal interest in creative control."[153] Nevertheless, in contrast to the Continental moral right of disclosure, the first publication right is fully alienable by the author and any subsequent owner.[154] In fact, where the author created the work during the course of employment or transferred the first publica-

150 *See, e.g.*, PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE 643-44 (1989). Prior to the 1976 Copyright Law revision, the right of authors to control first publication was grounded in common law copyright and the right to privacy. *See, e.g.*, Peay v. Curtis Publishing Co., 78 F. Supp. 305 (D.D.C. 1948) (unauthorized publication of plaintiff's photograph in a magazine constituted invasion of privacy). Accordingly, pre-revision commentators looked to these rights as the right of disclosure equivalent. *See, e.g.*, Treece, *supra* note 125, at 488-90; William Strauss, *The Moral Right of the Author, in* 2 STUDIES ON COPYRIGHT 113, 136 (1963). The common law copyright and privacy right equivalents of the right of disclosure were preempted by the 1976 U.S. Copyright Act, and thus would no longer provide an independent basis for relief. *See* GOLDSTEIN, *supra*, at 646.

151 17 U.S.C. § 106 (1988).

152 Section 202 of the U.S. Copyright Act provides that the transfer of ownership of a material object such as a painting or manuscript does not in itself convey any rights in the copyrighted work embodied in the object. 17 U.S.C. § 202 (1988). On the other hand, the author could not rely on the Copyright Act to prevent any subsequent transfer of the painting or manuscript that amounts to publication. Under the Act, the transfer of ownership in a copy of a work brings into play the first sale doctrine exception to the right of first publication. 17 U.S.C. § 109(a) (1988). Section 109(a) provides that the transferee "is entitled, without the authority of the copyright owner, to sell 'or otherwise dispose . . . of that copy.' " *Id.* Since the term "[copy] includes the material object . . . in which the work is first fixed," 17 U.S.C. § 101 (1988), § 109(a) would require the author to rely upon the applicable state law right of privacy to prevent the exploitation of her previously unpublished work. The question of whether the sale of the original copy would constitute a waiver of the right of privacy would depend upon the particular factual circumstances surrounding the sale.

153 Harper & Row v. Nation Enterprises, 471 U.S. 539, 555 (1984).

154 17 U.S.C. § 201(d) (1988). This section provides that any of the exclusive rights comprised in a copyright may be transferred in whole or in part. The transfer of ownership in a copy of a work also effects a partial waiver of the first publication right under the first sale doctrine. *See supra* note 152; *see also* Society of Survivors v. Huttenbach, 535 N.Y.S.2d 670, 675 (Sup. Ct. 1988) (holding that publisher which had taken assignment of copyright could prevent author from publishing the work elsewhere, but also holding on the facts before it that publisher's publication of the work in the author's name without the author's consent would violate provisions of their contract, and would constitute passing off).

tion right prior to the work's creation, the author may not even be the right's first owner.[155] In that event, the right holder may freely disseminate the work, unhindered by any residual right of the author to prevent it.

B. *The Right of Withdrawal*

According to Continental doctrine, a work remains a continuing communication of the author's thought and expression after it is disseminated to the public. As a result, an author's autonomy interest in determining the conditions of this communication to the public extends beyond the initial divulgation and publication of the work. Moral rights doctrine protects this ongoing autonomy interest by according authors the right to withdraw a work from publication or to make modifications after the work is disseminated.

These rights are codified in Article 32 of the French Act.[156] Article 32 provides that even if the exploitation rights in a published work have been transferred and the work has been published, the author is entitled to withdraw or modify the work as long as he indemnifies the transferee in advance of the exercise of the right. The withdrawal right was long thought to be exercisable at the author's absolute discretion. The Court of Cassation has recently held, however, that an author may not exercise the right if his sole motivation for doing so is pecuniary.[157]

The corresponding provision in the German Act is somewhat more limited. In addition to indemnification, it requires, as a condition for the right's exercise, that the work no longer corresponds to the author's convictions and that the author's changed attitude is such that continued exploitation of the work cannot be expected of him.[158] Thus, in contrast to the French Act, which accords authors an absolute right, as long as his motive is not pecuniary, the German Act provides for court review of whether the author's changed attitude is such that continued exploitation of the work cannot be required. The German Act also contains no mention of the right of modification, although some commentators contend

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155 In fact, under the Copyright Act, the "author" of a work-for-hire is the employer, and not the person who actually created the work. 17 U.S.C. § 201(b) (1988). The transfer of authors' interests in future works is discussed *infra* text accompanying notes 385-408.

156 Pursuant to the 1985 amendments to the French Act, the withdrawal right does not apply to computer software.

157 Judgment of May 14, 1991 (Chiavarino v. Ste SPC), Cass. civ., 151 R.I.D.A. 272 (1992).

158 GERMAN ACT, *supra* note 22, art. 42(1).

that this right is included in the right of withdrawal,[159] and the German Publishing Act of 1901 gives the author the waivable right to make changes in new editions "so far as they do not prejudice the lawful interests of the publisher."[160]

The right of withdrawal under both French and German laws is less expansive than might appear at first glance. In addition to the requirement of advance indemnification, both Acts give the transferee a right of first refusal on any subsequent publication of the work.[161] As a result of these restrictions, the right of withdrawal is infrequently exercised and has been the subject of few reported

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159 As Strömholm points out, there is a fundamental flaw in this view that the right of withdrawal necessarily includes the right to alter the work. Unlike the right to terminate dissemination, the right of modification enables the author to compel performance of a publication contract with respect to a work that may be radically modified by the author. STRÖMHOLM, *supra* note 79, at 26. Other commentators maintain that the publisher cannot be forced to accept changes that would substantially alter the character of the work. *See, e.g.*, Aurelian Ionasco, *Le Droit de Repentir de l'Auteur*, 83 R.I.D.A. 33, 52 (1975); Giocanti, *supra* note 125, at 639; GÉRARD GAVIN, LE DROIT MORAL DE L'AUTEUR DANS LA JURISPRUDENCE ET LA LEGISLATION FRANCAISES 72 (1960).

160 An Act Concerning the Law of Publication 1901, art. 12, 1901 Reichsgesetzblatt [RGBl.] 217 (translated in UNESCO, 2 COPYRIGHT LAWS AND TREATIES OF THE WORLD (1987) [hereinafter German Publishing Act].

161 The French Act provides that the author must offer his exploitation rights to the transferee under the original conditions. FRENCH ACT, *supra* note 25, art. 32. The German Act permits the author to offer the licensee modified terms so long as they are reasonable. GERMAN ACT, *supra* note 22, art. 42(4). The rights of withdrawal and modification are also said to be inapplicable to the plastic arts. *See, e.g.*, DaSilva, *supra* note 125, at 25; Sarraute, *supra* note 135, at 477. Commentators reason that an artist who has transferred ownership of a painting or sculpture has no right to repossess his work. This view stems in part from a 1961 Paris Court of Appeals decision, which held that the painter, Vlaminck, who claimed that a painting sent to him for authentication was a forgery, had no right to erase his signature from the painting: "If the painter was correct in his estimate, he still had no right to alter another person's property. If, on the contrary, the painting was not a forgery, Vlaminck's moral right did not permit him to exercise a right of withdrawal after having sold the canvas." Judgment of Apr. 19, 1961, Cour d'appel Paris, 1961 Gazette du Palais [G.P.] 2.218 (Fr.).

The Paris court, and the commentators who have followed this reasoning, have missed the distinction between ownership rights in an article and copyright exploitation rights in a work embodied in the article. While the artist could not exercise the right of withdrawal in opposition to the transferees' ownership rights in the painting, he could preclude the transferee from publicly exhibiting and reproducing the painting. An author who cannot retrieve title to the original manuscript once it has been assigned may prevent his publisher from continued publication of the book.

The distinction between ownership rights and copyright was the basis for a recent decision of the German Federal Supreme Court on facts similar to the *Vlaminck* case. In the case the owner of two paintings signed with the name of deceased artist Emil Nolde sent the paintings to a foundation established by Nolde's widow and asked the foundation to certify their authenticity. The foundation claimed that the paintings were forgeries and refused to return them to their owner. The Court held that the foundation would have to return the paintings and refused to order that the paintings be marked to indicate that they were forgeries. However, in order to protect Nolde's paternity right not to be identified as author of a work that he did not create, the Court ordered that Nolde's name be removed from the painting. Judgment of June 8, 1989, Bundesgerichtshof, BGHZ 135, *reported in* 6 EUR. INTELL. PROP. REV. D-111 (1990).

decisions.[162] Nonetheless, the possibility that an author may exercise the right has been held to constitute a business risk that must be taken into account in any dealings between the author's transferee and other parties.[163] As such, the right represents a potentially significant restriction on alienability that has no parallel in U.S. law.[164]

C. *The Right of Attribution*

The right of attribution protects the author's interest in determining the authorship designation for his work. The right is said to be "based on the understanding that the 'natural link'"[165] between the author and his "intellectual child" is sacrosanct.[166] The attribution right consists of three subrights.[167] First, an author has the right to be identified as the author of his work, or to publish anonymously or pseudonymously.[168] Second, the author is entitled to prevent his work from being attributed to another.[169] Third, the author may prevent his name from appearing on works which he did not in fact create.[170]

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162 Dietz, *supra* note 25, at FRG-55; DaSilva, *supra* note 125, at 24-25; Sarraute, *supra* note 135, at 477. In addition, Article 90 of the German Act provides that the withdrawal right does not apply to various exploitaiton rights involving cinematographic works. GERMAN ACT, *supra* note 22, art. 90.

163 *Judgment of May 8, 1980 (Theatre du Gymnase Marie Bell v. Masmondet)*, *Cass. soc.*, 107 R.I.D.A. 148 (Jan. 1981) (holding that where a playwright exercised his moral right to modify play by eliminating one of two characters that the defendant actress had been hired to play, the actress had no cause of action for terminating her employment contract with the play's producer).

164 Treece, *supra* note 125, at 500. In an applicable U.K. decision, the infant son of Charlie Chaplin had assigned away the copyright in his life story and later sought to enjoin publication. The court refused to intervene, holding that the copyright assignment constituted a present transfer of interest for value which may not be voided even by an infant author. Chaplin v. Leslie Frewin (Publishers), Ltd., 3 All E.R. 764, 772-73 (1965).

165 Dietz, *supra* note 25, at FRG-85.

166 *Id.*

167 The French and German Acts codify the attribution right in general terms, leaving the courts and commentators with the task of determining applications of the right. Article 6 of the French Act provides cryptically: "The author shall enjoy the right to respect for his name, his authorship, and his work." FRENCH ACT, *supra* note 25, art. 6. Article 13 of the German Act provides: "The author shall have the right of recognition of his authorship of the work. He can determine whether the work is to bear an author's designation and what designation is to be used." GERMAN ACT, *supra* note 22, art. 13.

168 Dietz, *supra* note 25, at FRG-85; Lucas & Plaisant, *supra* note 25, at FRA-96.

169 *See* DaSilva, *supra* note 125, at 26; Strauss, *supra* note 150, at 116.

170 DaSilva, *supra* note 125; Strauss, *supra* note 150. As several commentators have correctly noted, the right against false attribution is not properly included in the author's right of attribution, since it pertains to general reputational interests, rather than to the relationship between an author and his work. *See* Damich, *supra* note 10, at 13. I have nevertheless included the right against false attribution here, since it might serve as a supplement to the integrity right when used to prevent attribution of a distorted version of the author's work. *See* Stevens v. Nat'l Broadcasting Co., 148 U.S.P.Q. 755 (Cal. App. Dep't Super. Ct. 1966) (preliminary injunction issued to prevent the distortion of a film).

The scope of the attribution right is far-reaching. Even after contracting otherwise, an author may insist that his name (or a pseudonym) appear not only on the work itself, but also on all copies of the work and in references to the work in other material.[171] In collaborative works, such as films, each co-author is entitled to be identified as a creator of the work.[172] In collective works, such as newspapers, each author has the right to a byline for his article.[173]

According to one commentator, in comparison to Continental copyright law, U.S. law has traditionally shown "a callous disregard for the paternity rights of creative persons."[174] Except for the narrowly circumscribed attribution right under the Visual Artists Rights Act, U.S. copyright law accords authors no right to be identified with their works. An author who wishes to have his authorship recognized must generally extract from his transferee an enforceable promise to do so, although such a contractual requirement may conceivably be established by custom and usage applicable to a particular transaction.[175]

U.S. authors have successfully invoked a number of non-copyright theories to prevent both being falsely designated as authors of works that they did not create, and of having their works attributed to another. Principal among these theories have been state law defamation and privacy claims, and state and federal actions against deceptive trade practices.[176] In particular, a number of recent decisions have held that misattribution of authorship is actionable under Section 43(a) of the Lanham Act, which proscribes false designations of origin in the sale of goods and services.[177] An established author whose name has achieved significant public rec-

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171 Sarrautte, *supra* note 135; DaSilva, *supra* note 125, at 27. The extent to which the moral right of attribution may trump contractual obligations is more limited in Germany than in France. *See infra* text accompanying notes 267-72.

172 Sarraute, *supra* note 135, at 478.

173 Giocanti, *supra* note 125, at 636-37.

174 Treece, *supra* note 125, at 494.

175 *See, e.g.*, Vargas v. Esquire, Inc., 164 F.2d 522 (7th Cir. 1947) (artist who had transferred to Esquire magazine all of his rights in several of his drawings could not compel Esquire to attribute authorship to him without contractual obligation to do so); Melville B. Nimmer, *Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 STAN. L. REV. 499, 520 (1967) (citing Poe v. Michael Todd Co., 151 F. Supp. 801 (S.D.N.Y. 1957)).

176 *See Reputation Comment, supra* note 125, at 1490, 1496-99 (discussing applicability of state law prohibitions of defamation and deceptive trade practices); Jane Ginsburg & John Kernocham, *One Hundred and Two Years Later: The U.S. Joins the Berne Convention*, 141 R.I.D.A. 57, 145-49 (1989) (reviewing applications of trademark and Lanham Act, Section 43(a), to misattributions).

177 *See, e.g.*, Lamothe v. Atlantic Recording Corp., 847 F.2d 1403 (9th Cir. 1988); Smith v. Montoro, 648 F.2d 602 (9th Cir. 1981) (involving substitution of film credit for actor); Dodd v. Fort Smith Special Sch. Dist. No. 100, 666 F. Supp. 1278 (W.D. Ark. 1987).

ognition in connection with his works may also register his name as a trademark in order to prevent misattributions of his works in circumstances likely to cause consumer confusion as to their source.[178]

These non-copyright theories are more limited in scope and applicability than their Continental attribution right counterparts. As of yet, no U.S. court has recognized an author claim, under any theory, against the simple failure to attribute authorship, as opposed to misattribution.[179] And even in the area of misattribution U.S. authors face material obstacles and limitations in asserting their claims. Defamation requires showing an injury to reputation, which may be difficult to prove.[180] Moreover, even a relatively unestablished author might be deemed a "limited purpose public figure," thus requiring a showing of actual malice.[181] The right of privacy has been successfully asserted to prevent the use of a person's name on a work that he did not create,[182] but it has been of little use in other attribution right areas.[183] Deceptive trade prac-

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178 *See, e.g., In re* Wood, 217 U.S.P.Q. 1345 (TTAB 1983) (in which the Trademarks Trial and Appeal Board upheld registration for an artist's name). A personal name may be registered as a trademark only upon proof that, through usage, it has acquired "distinctiveness" and "secondary meaning." In other words, the public must have come to recognize the name as a symbol that identifies and distinguishes the goods or services of only one seller. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 13.02[1], at 13-3 to 13-5 (3d ed. 1992).

179 *Montoro*, 648 F.2d 602, and *Lamothe*, 847 F.2d 1403, are sometimes cited for the proposition that mere failure to give credit is a violation of Section 43(a) of the Lanham Act. But both cases involved misattribution, rather than simple non-attribution. In *Montoro* a film producer had removed the plaintiff's name from film credits and substituted another name. In *Lamothe* the name of one of several joint authors was deleted, which made it appear that the remaining authors were exclusively responsible for the work.

180 A defamation action would generally require a showing that the author has been exposed to contempt or public ridicule, thus injuring his professional standing. W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 117 (5th ed. 1984); Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 357 (S.D.N.Y. 1968). This could be a difficult showing even for a well-known author, and would effectively bar a defamation claim of a young author who has yet to build a professional reputation. Defamation actions also commonly require proof of special damages. *See* Harris v. Twentieth Century Fox Film Corp., 43 F. Supp. 119 (S.D.N.Y. 1942) (dismissing plaintiff's claim for libel resulting from defendant's crediting her with story research, rather than writing, for failure to plead special damages). Finally, even a plaintiff who succeeds on the merits will be unlikely to obtain injunctive relief. *See* Shostakovich v. Twentieth Century-Fox Film Corp., 80 N.Y.S.2d 575, 577-78 (Sup. Ct. 1948) (noting traditional rule, but stating that it would grant injunctive relief in a proper case).

181 *See, e.g.*, Wojnarowicz v. Am. Family Ass'n, 17 U.S.P.Q. 2d 1337, 1351 (S.D.N.Y. 1990) (artist's defamation claim denied because of failure to show that defendant who misrepresented fragments of artist's work as the complete work did so with knowledge or reckless disregard of the facts).

182 *See, e.g.*, Lord Byron v. Johnston, 35 Eng. Rep. 851 (1816) (enjoining circulation of a poem falsely attributed to Lord Byron); Eliot v. Jones, 120 N.Y.S. 989 (Sup. Ct. 1910), *aff'd mem.*, 125 N.Y.S. 1119 (1st Dep't 1910) (unauthorized use of the name of the editor of "Harvard Classics" in connection with rival publication).

183 *See, e.g.*, Ellis v. Hurst, 128 N.Y.S. 144 (Sup. Ct. 1910) (rejecting author's petition

tice statutes are designed to shield consumers from the false designation of goods and services, rather than to protect artistic reputation.[184] As a result, these statutes might not apply to misattributions of authorship that are unrelated to the marketing of a work to the public, such as in connection with the display of works of art in public places or references to a work in critical reviews or other nonpromotional materials.[185] Furthermore, none of these theories make actionable a publisher's refusal to market an author's work under the author's designated pseudonym, absent contractual agreement.[186]

Finally, the quasi-attribution rights enjoyed by U.S. authors are fully waivable. A ghostwriter who contracts to create a book under another's name forever relinquishes the right to prevent the false attribution of the work to another.[187] A screenwriter who agrees to contribute anonymously, cannot later insist on receiving authorship credit. Indeed, under the U.S. Copyright Act, when a work is created by an employee in the scope of his employment, the employer, and not the creator, is considered to be its author, unless the parties have otherwise agreed.[188] The employer has no obligation to attribute authorship to the work's "true author."

D. *Right of Integrity*

The right of integrity is generally seen as the central tenet of moral rights jurisprudence.[189] At a minimum, the right has a nega-

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under state privacy statute to enjoin publisher from republishing the author's early pseudonymous works under the author's true name), *aff'd mem.*, 130 N.Y.S. 1110 (1911).

184 For a discussion of this distinction between deceptive trade practices and moral rights, see *Reputation Comment*, *supra* note 125, at 1499-1500.

185 Section 43(a) of the Lanham Act applies only to goods or services used "in commerce." 15 U.S.C. § 1125 (1988).

186 *See, e.g., Ellis*, 128 N.Y.S. at 144.

187 In theory the attribution of a book's authorship to a ghostwriter's client rather than to the ghostwriter constitutes impermissible reverse passing off under Section 43(a) of the Lanham Act. As such a ghostwriter's agreement to allow his work to be sold under another person's name might be unenforceable as a matter of public policy in order to protect consumers. On the other hand, however, even trademark owners maybe estopped from withdrawing their consent to another's use of their mark. The threat of consumer confusion from the continued use is only one factor in determining whether consent may be terminated. MCCARTHY, *supra* note 178, § 32.33[2], at 32-133 to 32-134. Accordingly, given that ghostwriting is a well-established practice and given the absence of any express protection for authorship attribution, it is highly unlikely that a U.S. court would countenance a ghostwriter's attempt to claim attribution in the face of a contrary contractual obligation.

188 17 U.S.C. § 201(b) (1988).

189 *See* DaSilva, *supra* note 125, at 31. In France, the right to integrity is codified principally in Article 6 of the French Act, which provides that "[t]he author shall enjoy . . . respect for his name, his authorship, and his work." French Act, *supra* note 25, art. 6. Article 14 of the German Act provides that "[t]he author shall have the right to prohibit any distortion or any other mutilation of his work which would prejudice his lawful intellectual or personal interests in the work." GERMAN ACT, *supra* note 22, art. 14.

tive aspect. It entitles an author to prevent the public presentation of his work in a manner or context harmful to his reputation, or repugnant to the "feelings that he as an artist may cherish for the work he has created."[190] Some courts and commentators have also recognized an affirmative aspect of the integrity right, requiring public presentation of the author's work, and compelling its completion and preservation.[191] A purchaser of a work of art, or a publisher or producer, thus acquires the work or right to exploit a work subject to a duty to respect and possibly to promote the author's artistic conception.

The author's negative right is vividly illustrated in the oft-cited case of artist Bernard Buffet.[192] Buffet had painted designs on a refrigerator. The refrigerator's owner sought to dismantle it and sell each panel as a separate piece. Buffet claimed that the refrigerator was an indivisible artistic unit and sued to prevent its dismantling. The French Court of Cassation ruled that the owner could keep the dismantled panels at home, but that the public display or transfer of the artist's work in mutilated form would infringe the artist's personal rights in relation to the work.[193]

The negative right may also be asserted against an unfaithful presentation or an adaptation of the work that leaves the original version intact. Thus in *Bernard-Rousseau v. Galeries Lafayette*, a French department store was held to have violated painter Henri Rousseau's right of integrity by displaying reproductions of his work that differed in color and form from the original.[194] Similarly, a theater proprietor licensed to produce the operetta, Maske in Blau, was enjoined from deleting several parts of the original score and adding elements, including the theme from the American television detective series, Dragnet, which were unrelated to the original.[195] The German Federal Court of Justice found that the defendants' distortion of the work had violated the integrity right of the operetta composer and librettist.

The negative right might also apply to the performance or public display of a work in a context that is harmful to the author's reputation or contrary to his artistic conception. During the early

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190 STRÖMHOLM, *supra* note 79, at 30 (quoting Swedish Copyright Law Commission Report, 1956 SOU No. 25, at 122).

191 *See* Damich, *supra* note 10, at 20-22.

192 Judgment of May 30, 1962 (Fersing v. Buffet), Cour de cassation, 1965 G.P. 126, *discussed in* Merryman, *supra* note 10.

193 *Id.*

194 Judgment of Mar. 13, 1973, Trib. gr. inst., 1974 J.C.P., No. 48, at 224, *discussed in* Damich, *supra* note 10, at 22.

195 55 BGHZ 1 (1970).

years of the Cold War, Twentieth Century-Fox released a film, entitled "The Iron Curtain," depicting Soviet espionage in Canada. As background music, the film included selections from the uncopyrighted works of Dmitri Shostakovich and three other Soviet composers. The composers sued to prevent the use of their music in the film, which, they claimed, cast upon them "a false imputation of being disloyal to their country."[196] Although a New York court rejected their claim,[197] they were successful in France.[198]

The author's positive right to compel public presentation of his work was dramatically demonstrated in the case of *Dubuffet v. Renault.*[199] The Renault corporation had commissioned artist Jean Dubuffet to design and prepare a model for a monumental sculpture that Renault was to construct at its plant. Renault approved Dubuffet's model and began to build the sculpture. As a result of cost overruns, however, Renault decided to abandon the project in the midst of construction. Dubuffet then brought suit to force completion on the basis of the moral rights of disclosure and integrity. In a ruling that was later confirmed by the Court of Cassation, the artist successfully obtained an order compelling Renault to complete the work and, implicitly, to preserve it as well.[200]

It is worth emphasizing that under French and German law the author's ongoing personal connection with his creation is said to extend beyond the protection of his reputational interests. The author is entitled to defend the work's integrity, as he views it, without any relation to how a given modification or use of the work might affect others' judgment of him, and regardless of whether the distorted work is attributed to him.[201] Critics may be of the

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196 Shostakovich v. Twentieth Century-Fox Film Corp., 80 N.Y.S.2d 575, 578 (Sup. Ct. 1948).

197 Shostakovich v. Twentieth Century-Fox Film Corp., 87 N.Y.S. 2d 430 (1st Dep't 1949).

198 Judgment of Jan. 13, 1953 (Soc. Le. Chant de Monde v. Soc. Fox Europe et Soc. Fox Americaine Twentieth Century), 1953 G.P. 191. Recently, the High Court of Berlin ruled that the publication of an author's poem, without the author's consent, in a lampoon of the former East German political organ, *Neues Deutschland,* violated the author's integrity right because, "in the eyes of the creator, the work had been placed in a context in which it did not belong." Adolf Dietz, *Copyright Law Developments in the Federal Republic of Germany (from 1989 to the beginning of 1993),* 157 R.I.D.A. 128, 200-01 (October 1993) (summarizing Decision of 6 May 1988).

199 Judgment of Mar. 23, 1977, Trib. gr. inst., 1977 R.I.D.A. 191 obs. Desbois (Fr.), *aff'd,* Judgment of June 2, 1978, 1980 G.P. 580 note Franck, *rev'd,* Judgment of Jan. 8, 1980, Cass. civ. 1re, 1980 J.C.P. II No. 1933 note Lindon.

200 The *Dubuffet* decision was actually based on a fairly contrived reading of the sculptor's commission contract, rather than his moral rights. However, the court's interpretation of the contract and its unusual order of specific performance were heavily colored by Dubuffet's moral rights claim and lend considerable support to a positive right of integrity. *See* Françon & Ginsburg, *supra* note 142, at 391.

201 *See* STRÖMHOLM, *supra* note 79, at 31. *See also* Judgment December 12, 1988 (De-

unanimous view that a given change in a work will only enhance the author's reputation, or that the public performance or display of a work in a certain context comports entirely with the author's persona and with the nature and quality of his other works. However, if the author sees his work and artistic endeavors in a different light, he has the right, with certain qualifications designed to prevent abuse, to enjoin such change or use.[202]

In the United States an ad hoc combination of defamation, contract and unfair competition law, together with certain provisions of the Copyright Act, provide a rough parallel to the right of integrity. The truncation or distortion of a work, or the work's presentation in an unfavorable context, might be actionable as a defamatory tort if it is attributed to the author and reflects adversely on the author's reputation.[203] A court might also enjoin the modification or use of a work that is contrary to an express or implied term of a contract.[204] In one such action, Otto Preminger sought to enjoin the licensing of his film, *Anatomy of a Murder,* for television broadcasting because of edited cuts for commercials.[205] Although the court rejected Preminger's claim, it recognized that a cause of action would have been stated if Preminger's contract with his distributor had expressly prohibited such cuts or if the cuts had been so extreme that they exceeded prevailing industry practice.[206]

The alteration of a work might also be prohibited on decep-

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lorme v. Catena-France), Cours d'appel, P.I.B.D. III, No. 454, at 231, 10 EUROPEAN INT. PROP. REV. D-182 (1989) (upholding graphic designer's integrity right claim against modifications in company logo even though designer's name did not appear on logo and modifications consisted merely of changing the direction in which the logo was slanted).

202 Vexatious or abusive exercise of the author's moral rights is not permitted. *See* Lucas & Plaisant, *supra* note 25, at FRA-102. The author's objections to changes in or uses of his work must be shown to be real and substantial by some objective measure. In addition, authors who have authorized the adaptation of their work in another medium must accept changes that are necessitated by the transfer to another medium, so long as the essential spirit, character, and substance of the work is respected. For further discussion on this point see *infra* notes 295-305 and accompanying text.

203 *See, e.g.,* Edison v. Viva Int'l, Ltd., 421 N.Y.S.2d 203 (1979) (sustaining a libel action for publication of article in substantially different form and content); Granz v. Harris, 198 F.2d 585, 589 (2d Cir. 1952) (Frank, J., concurring). *But see* Shostakovich v. Twentieth Century-Fox Film Corp., 80 N.Y.S.2d 575 (Sup. Ct. 1948) (declining to enjoin alleged personal libel for distribution of author's musical compositions in a context that cast doubt on their loyalty to their country).

204 An author may clearly prohibit an assignee or licensee from making modifications to the author's work by express contractual provision.

205 Preminger v. Columbia Pictures Corp., 267 N.Y.S.2d 594 (Sup. Ct. 1966), *aff'd,* 269 N.Y.S.2d 913 (App. Div. 1966), *aff'd,* 219 N.E.2d 431 (N.Y. 1966).

Preminger concerns the claim of the film director, and not the author of the screenplay. As Nimmer has noted, however, the court's reasoning should be applicable to authors as well. NIMMER & NIMMER, *supra* note 12, § 8.21[C][1], at 8-258 n.53.

206 *Preminger,* 267 N.Y.S.2d at 603. *See also* Society of Survivors v. Huttenbach, 535 N.Y.S.2d 670, 674 (Sup. Ct. 1988) (indicating that if the contract is silent as to changes, the transferee may modify the work to the extent permitted by custom and usage in the trade).

tive trade practice theory. In *Gilliam v. American Broadcasting Co.*,[207] the Second Circuit ruled that ABC's broadcasting of unauthorized edited versions of previously televised skits of the English comedy group, Monty Python, violated Section 43(a) of the Lanham Act.[208] The court found that ABC's modifications were so substantial that in conjunction with the identification of the skits as the work of Monty Python, they created "a false impression of the product's origin."[209] The court suggested that it sought to protect the personal, as well as the proprietary, rights of authors.[210]

Despite the *Gilliam* court's reference to authors' personal interests, the Lanham Act provides significantly more limited protection for authors than do Continental moral rights. The Lanham Act's fundamental rationale is to prevent false advertising and consumer deception rather than to protect authors per se. As a result, only distortions that so change the character of a work that to attribute the work to its original authors would constitute a false designation of origin would be actionable under the Act. In *Gilliam* ABC had cut more than one quarter of the ninety-minute Monty Python program and had deleted material that was central to the group's repertoire. It is highly doubtful that a U.S. court would entertain a Section 43(a) claim against modifications, such as the colorization of a black-and-white film or the use of actresses to play male characters in a play, which leave the work essentially intact. Such modifications, however, have been enjoined by French courts as violative of the integrity right.[211] In addition, Section 43(a) proscribes only the false designation of *origin*, and not a work's multilation in and of itself. Accordingly, a mutilated film could lawfully be screened so long as it was clearly labeled as an

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207 538 F.2d 14 (2d Cir. 1976).

208 *Id.* at 25. The court also rested its holding on grounds of breach of contract and copyright infringement.

209 *Id.* at 24. *See also* Rich v. RCA Corp., 390 F. Supp. 530, 531 (S.D.N.Y. 1975) (holding that the authorized publication of a previously written work and accompanied by a recent photograph of the author may violate Section 43(a) of the Lanham Act to the extent that the photograph suggests that the work is contemporary).

210 *Gilliam*, 538 F.2d at 24.

211 In a celebrated recent case the French Court of Cassation implicity recognized that the broadcasting in France of a colorized version of John Huston's film, *Asphalt Jungle*, violated the author's right of integrity. Judgment of May 28, 1991, Cas. civ. 1re, 149 R.I.D.A. 197 (1991). For an illuminating discussion of the *Asphalt Jungle* case, see Jane Ginsburg & Pierre Sirinelli, *Auteur, Création et Adaptation en Droit International Privé et en Droit Interne Français. Réflexions à Partir de l'Affaire Huston*, 150 R.I.D.A. 2 (1991). In another case, a French court found that a production of *Waiting for Godot* in which the lead roles were played by women, in contrast to Samuel Beckett's express instructions that the roles should be played by men, violated Beckett's moral right of integrity as asserted by his heirs. Lindon v. La Compagnie Brut de Beton, Trib. gr. inst. de Paris, 3e, 155 R.I.D.A. 225 (1993).

unauthorized edit, rather than the original author's work. In contrast, the integrity right has been held to apply even in the absence of authorship attribution.[212]

The U.S. Copyright Act within the rubric of various economic right also approximates certain features of the right of integrity.[213] The most important of these is the copyright owner's exclusive right to "prepare derivative works based upon the copyrighted work."[214] A derivative work may be a "translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed or adapted."[215] The term also includes "work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship . . . ."[216] Accordingly, an author who holds the exclusive rights to make copies of, and to prepare derivative works based upon his work may prevent unauthorized distortions, truncations, modifications, and adaptions of the work. A slightly altered version of the author's work that remains "substantially similar" to the original work will be deemed to be an infringing copy.[217] A version in a different medium or that contains significant modifications, yet remains "based upon" the original work, will constitute an infringing deriva-

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212 Judgment of Dec. 12, 1988 (Delorme v. Catena-France), Cours d'appel, *P.I.B.D. III*, No. 454, at 231, 10 EUROPEAN INT. PROP. REV. D-182 (1989) (upholding graphic designer's integrity right claim against modifications in company logo even though defendant had not even known who had designed the logo).

213 For a more detailed discussion of moral rights analogues in the U.S. Copyright Act, see Kwall, *supra* note 10.

214 17 U.S.C. § 106(2).

Another integrity right analogue is Section 115 of the Copyright Act. This section provides for a compulsory license for the making and distribution of phonorecords of a musical composition that has previously been recorded and distributed under the authority of the copyright owner. Section 115(a)(2) provides that the compulsory license includes the privilege of changing the musical arrangement of the work where necessary to conform arrangement to the style or manner of interpretation of performance, so long as no change is made in "the basic melody or fundamental character of the work." 17 U.S.C. § 115(a)(2) (1988). The House Report concerning § 115(a)(2) indicates that this qualification to the privilege of making musical arrangements was designed to prevent the original compositions from being "perverted, distorted or travestied." H.R. REP. No. 1476, 94th Cong., 2d Sess. (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5724.

Section 115(a)(2) evinces an awareness that copyright owners have an economic interest in preventing the preparation and dissemination of derivative works that distort the copyrighted work. This interest can generally be protected by imposing conditions to their grant of derivative work rights. Since this option is unavailable for copyright owners where a derivative work may be prepared without obtaining the owner's permission, as under the compulsory license provisions of § 115, Congress accorded a measure of protection for the interest under § 115(a)(2).

215 17 U.S.C. § 101.

216 *Id.*

217 *See* NIMMER & NIMMER, *supra* note 12, § 13.03, at 13-17 to 13-54.

tive work.[218] Thus, although Shostakovich could invoke U.S. copyright law to prevent the use of his work in an unfavorable context, Bernard Buffet might have successfully brought suit in the United States to enjoin the truncation of his refrigerator. In some circumstances, the public display or presentation of the original work in a new context might also constitute a transformation of the original amounting to a derivative work.[219]

The derivative right, therefore, is essentially coterminous with at least the negative aspect of the integrity right. Like their Continental counterparts, U.S. authors who hold the derivative right may prevent modifications to their work that run contrary to their artistic sensibilities, without any need to show consumer deception or harm to reputation. In fact, the derivative right may be freely exercised without the equitable, good-faith limitations that, as we shall see, have been imposed on the moral right.[220]

Under U.S. law, an author may grant to an assignee or licensee the right to make any and all changes in his work, even if such changes amount to a distortion or truncation. The author may also grant the right to present the work in any and all contexts, including those that may be contrary to the author's personal or artistic sensibilities. Both these grants can be made in gross and in advance of actual changes or presentation of the work. In the event of such a grant, the author may not thereafter complain of mutilations or repugnant uses of the work.[221] Indeed, once an au-

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218 If the distortion is so extreme that the resulting work could not even be said to be "based on" the original work, then no cause of action will lie. *See* GOLDSTEIN, *supra* note 150, at 635. For an analysis drawing the line between the reproduction right to make the same or similar versions of a work and the right to make derivative works based upon the original work, see Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC'Y 209, 217 (1982-83).

219 *See* Mirage Editions, Inc., v. Albuquerque A.R.T. Co., 856 F.2d 1341, 1343 (9th Cir. 1988) (holding that removal of art print from a book and mounting it on a ceramic tile with a border constituted a recasting or transformation of the print amounting to an infringing derivative work).

220 *See infra* notes 279-89 and accompanying text. Of course, the derivative right is subject to fair use limitations under Section 107 of the Copyright Act.

221 Conceivably, an author's authorization to market a distorted version of a work under its original title or under the author's name would be unenforceable under the Lanham Act, Section 43(a), false advertising proscriptions. *See* MCCARTHY, *supra* note 178, § 18.11, at 18-53 to 18-55 (discussing assignment of literary titles). But this would not prevent the marketing of a distorted version that was accurately labeled as such. In addition, except in a particularly egregious case of consumer deception, the author would probably be estopped from terminating his prior consent to the grantee use. *See* MCCARTHY, *supra* 178, § 32.33[2], at 32-133 to 32-134. On the other hand, in those relatively few cases in which an author has registered a trademark in his name, he may not grant to another the right to market works under his name without some mechanism for author control over their quality. In fact, to the extent that an author's goodwill is personal to him, the personal name mark and the goodwill it represents may be incapable of being validly assigned to another person. *See* MCCARTHY, *supra* note 178, § 18.10 at 18-52 to 18-53.

thor has transferred his copyright, the exclusive right to make derivative works based upon the copyrighted work lies with the copyright owner, not with the author—and the same is true in work-for-hire cases, where the employer rather than employee-creator is deemed to be the first author for purposes of U.S. copyright law.[222]

A recent case involving Turner Entertainment's colorization of the black-and-white film, *Asphalt Jungle*, vividly illustrates the extent to which copyright alienability vitiates authors' control over their work in contrast to the Continental regime.[223] The heirs of John Huston, the film's director, objected to the colorization, which constituted a derivative work subject to the copyright owner's exclusive derivative right under U.S. copyright law. But Huston's heirs were barred from bringing an action under U.S. copyright law for two reasons. First, under U.S. work-for-hire rules a film's producer, rather than artistic director, is generally deemed to be the first author and copyright owner of the film. Second, Huston's film production contract contained a standard catch-all clause in which Huston assigned to the producer all rights that he may have had in the film.[224] However, when Turner granted to the French television channel La Cinq the right to broadcast the colorized film in France, Huston's heirs brought suit in that country to prevent the broadcast on the grounds that it would violate Huston's right of integrity. The French Court of Cassation refused to apply American law governing initial copyright ownership and contractual assignment. It ruled, under French domestic law, that Huston was the film's author and that his moral right of integrity had survived the blanket assignment of rights.[225] It held that Huston's heirs were entitled to challenge the broadcast of the colorized film and strongly suggested that the broadcast would in-

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222 17 U.S.C. § 201(b). It has been suggested that to the extent authors who have relinquished the copyright retain a right, either as beneficial owners under section 501(b) of the U.S. Copyright Act, or as holders of a reversionary interest pursuant to the termination provisions, to prevent infringement or acts that might dilute the value of the copyright, such right might be used to prevent distortions. *See* Kwall, *supra* note 10, at 55. But even if such a right were recognized, it would not apply in cases of works-for-hire and could not be relied upon by authors who had granted a derivative work rights transferee unconditional authority to determine the form of the derivative work or who had otherwise waived the right to object to distortions.

223 *Judgment of May 28, 1991, Cass. civ. 1re*, 149 R.I.D.A. 197 (1991). For an illuminating discussion of the *Asphalt Jungle* case, see Ginsburg & Sirinelli, *supra* note 211.

224 Ginsburg & Sirinelli, *supra* note 211, at 4.

225 Even under French law, for film production contracts concluded after the effective date of the July 3, 1985 amendments to the French Act, the director's exploitation rights are presumptively transferred to the producer. But the director maintains certain moral rights despite the transfer.

fringe Huston's integrity right.[226]

E. *The Visual Artists Rights Act*

A review of United States analogues to moral rights would be incomplete without an examination of the Visual Artists Rights Act of 1990. The Visual Artists Rights Act represents the first, tentative step toward federal recognition of moral rights. The Act succeeds and largely preempts eleven state statutes that accord limited moral rights protection in the area of the visual arts.[227] The Act amends the U.S. Copyright Act to accord authors of certain original and limited edition works of visual art with narrowly circumscribed attribution and integrity rights. The Act's primary impetus is to bring "U.S. law into greater harmony with laws of other Berne countries,"[228] thus strengthening the United States' commitment

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226 Ginsburg & Sirinelli, *supra* note 211, at 6, 24.

227 *See, e.g.*, CAL. CIV. CODE § 987 (West 1993); CONN. GEN. STAT. § 42-116t (West 1993); LA. REV. STAT. §§ 2151-2156 (West 1993); ME. REV. STAT. ANN. tit. 27, § 303 (West 1988); MASS. GEN. LAWS ANN. ch. 231, § 855 (West Supp. 1993); N.J. STAT. ANN. § 24:24A-4 (West 1993); N.Y. ARTS & CULT. AFF. § 11-14 (Consol. 1990); R.I. GEN. LAWS § 5-62-3 (1992).

Some of these statutes, including that of California, are designed to promote the public interest in preserving cultural and artistic creations, as well as to protect the artist's personal and economic interests. These statutes typically make actionable, by the artist or, in some instances, by a public official or body, the physical defacement, mutilation, alteration or destruction of works of fine art of "recognized quality." Other statutes, notably that of New York, serve essentially to protect the artist's reputational interests. These statutes prohibit the unauthorized public display, publication, or reproduction of a work of fine art in an altered, defaced, mutilated, or modified form when the work is identified or identifiable as being that of the artist, and when such act is likely to damage the artist's reputation. All of the statutes accord creators of works of fine art with a right of attribution. Typically, the artist is entitled "at all times" to claim authorship or, for "just and valid reason," to disclaim authorship.

Under the preemption provisions of section 301 of the Copyright Act, as amended by the Visual Artists Rights Act, the rights accorded under the state statutes are largely, although not entirely, preempted by the Visual Artists Rights Act. For preemption to occur, two criteria must be met. First, the applicable state statute provision must cover works falling within the subject matter covered by the Visual Artists Rights Act. Second, the rights sought to be vindicated under the state statute must be equivalent to the legal or equitable rights granted by the Act. Visual Artists House Report, *supra* note 16, at 21. Thus, to the extent that a state statute, such as that of New York (N.Y. ARTS & CULT. AFF. LAW § 14.53), makes actionable distortions of reproductions, as opposed to originals and limited edition copies, it would not be preempted by the Visual Artists Rights Act. *Id.* The protection of audiovisual works, as in the Massachusetts statute (MASS. ANN. LAWS ch. 231, at 85S) or of works of art in glass, as in California (CAL. CIV. CODE § 987(b)(2)) would similarly escape preemption. However, even these statutes might be preempted by the Coyright Act's derivative right to the extent that the distortions they seek to prevent constitute derivative works of the distorted originals, and so long as they do not require proof of a substantive element, such as harm to reputation, that falls outside the prima facie case for copyright right infringement.

228 *See Hearings on H.R. 2690 Before the Subcommittee on Courts, Intellectual Property, and the Administration of Justice of the House Committee on the Judiciary*, 101st Cong., 1st Sess. (1989) (statement of Ralph Oman, Register of Copyrights).

to the Berne Convention.[229] The Act is designed to protect "both the reputations of certain visual artists" and the integrity of "works of visual art that make up an important part of our cultural heritage."[230] In the true utilitarian tradition of U.S. copyright law, the House Report accompanying the Act states that the Act serves the public interest in encouraging artistic creation, in consonance with the Constitutional goal of promoting "the Progress of Science and useful Arts" by granting artists rights that are analogous to those protected by Article 6*bis*.[231]

The Visual Artists Rights Act's provisions extend to original drawings, prints, sculptures, and signed photographs that have been produced solely for exhibition,[232] and copies produced in limited editions of no more than 200 consecutively numbered copies bearing the artist's signature or, in the case of sculptures, another identifying mark.[233] Audiovisual works, applied art, books, newspapers, merchandising and promotional items, works made for hire, and various other works are explicitly excluded.[234]

Authors of qualifying works of visual art enjoy attribution rights consisting of both the right to require authorship attribution for the author's work and the right to prevent the misattribution of works that the author did not create.[235] However, the Act makes no general provision for anonymous or pseudonymous dissemination or display. An author is entitled to proscribe the use of his name only if the work has been distorted, mutilated or otherwise modified in such a way as to prejudice his honor or reputation.[236]

The author's integrity right is limited to preventing "intentional" distortions, mutilations and modifications that "would be prejudicial to his or her honor or reputation."[237] The House Report indicates that the harm to honor or reputation should be based on a finding of fact in each case as to the modification's adverse impact on the artist's professional reputation "as embodied in the work."[238] With respect to works of "recognized stature," the

229 136 CONG. REC. H13313 (daily ed. Oct. 27, 1990) (statement of Rep. Robert W. Kastenmeier).

230 *Id.*

231 Visual Artists House Report, *supra* note 16, at 5.

232 17 U.S.C. § 101 (1988 & Supp. II 1990).

233 *Id.*

234 *Id.*

235 17 U.S.C. § 106A(a)(2) (Supp. II 1990).

236 *Id.*

237 17 U.S.C. § 106A(a)(3)(A) (Supp. II 1990). The Act also makes actionable by the author the intentional or grossly negligent destruction of "a work of recognized stature." 17 U.S.C. § 106A(a)(3)(B).

238 Visual Artists House Report, *supra* note 16, at 15.

Report approaches the German and French position in noting that the modification of such works will generally be sufficient to establish harm to honor or reputation.[239] But, in contrast to Continental doctrine, the Act provides for no cause of action for distorting uses of the work, including reproductions, depictions, public presentations and portrayals that do not amount to a physical modification of the original or limited edition copy.[240]

The Visual Artists Rights Act provides that attribution and integrity rights are conferred only on the author, regardless of whether the author is the copyright owner.[241] The rights may not be transferred, but may be waived if the author expressly agrees in a written instrument signed by the author.[242] As indicated in the House Report, the Act "does not permit blanket waivers."[243] A waiver is effective only as to the works and uses of such works that are specifically identified in the written instrument,[244] and only as to the specific person to whom waiver is made.[245] Except as otherwise set forth in such a written instrument, neither the transfer of ownership of a copy of a qualifying work of visual art nor of any copyright interest therein constitutes a waiver of rights under the Act.[246]

The waiver provisions reflect an interim compromise, and may be revised in the future to strengthen author protection. The House Report recognizes that the assignment or transfer of the attribution or integrity rights would be contrary to their "personal nature."[247] It also notes that "[a]rguably, the best recognition of moral rights would countenance no waivers,"[248] both because the rights are personal to authors and because authors may routinely be required to bargain them away as a result of "a relatively weak economic position."[249] The Report concludes, however, that a no-waiver position "is probably too extreme for the U.S. system"[250] and that a narrow circumscription of waivers and the circumstances surrounding them would probably be sufficient to protect authors' in-

239 *Id.* at 16.
240 17 U.S.C. § 106A(c)(2), (3) (Supp. II 1990).
241 17 U.S.C. § 106A(b) (Supp. II 1990).
242 17 U.S.C. § 106A(e)(1) (Supp. II 1990).
243 Visual Artists House Report, *supra* note 16, at 19.
244 17 U.S.C. § 106A(e)(1).
245 Visual Artists House Report, *supra* note 16, at 18-19.
246 17 U.S.C. § 106A(e)(2) (Supp. II 1990).
247 Visual Artists House Report, *supra* note 16, at 18.
248 *Id.* (testimony of Professor Jane Ginsburg).
249 *Id.*
250 *Id.*

terests.[251] Nonetheless, the Act directs the Copyright Office to undertake a five-year review of the waiver provisions.[252] The purpose of the study is to determine whether any imbalance in bargaining power routinely compels artists to waive their rights, thus resulting in the evisceration of the Act's substantive provisions.[253]

IV. Alienability Of Moral Rights

As we have seen, alienability is one of the most significant areas in which the United States moral rights analogues appear to fall short of their Continental counterparts. Some United States analogues, including the U.S. Copyright Act's first publication and derivative works rights, are fully transferable and waivable. These rights are simply a part of the bundle of economic rights that the U.S. Copyright Act accords to a copyright owner, who may or may not be the author of the copyrighted work. Other United States moral rights analogues, including the causes of action for invasion of privacy, defamation, and the statutory fine arts paternity and integrity rights, are not transferable, but are waivable. The author's advance waiver of further control over the work will thus defeat a subsequent claim for defamation or invasion of privacy based on the publication of the work or a distorted version of the work. Although an author's rights under the Visual Artists Rights Act are not subject to blanket waiver, these rights may be irrevocably relinquished with respect to uses and users that are specified in a written instrument. Finally, with some limitations, rights derived from the deceptive trade practices analogues are effectively waived by an author who has agreed to give the transferee a free hand in modifications and description of origin.[254] These rights may also be transferred together with all of the assets of the author's business.

In contrast, German and French authors' rights doctrine is said to begin with the basic premise that an author's bond with his work is inseverable, thus making moral rights nonassignable and nonwaivable.[255] As one commentator has dramatically put it: the

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[251] *Id.* The Report also concurs with Professor Ginsburg's statement that a tight regulation of waiver might more effectively protect authors' interests than would an ideologically pure no-waiver law that might be rarely observed in practice. *Id.*

[252] Pub. L. No. 101-650, § 608(a), 104 Stat. 5128 (1990).

[253] Visual Artists House Report, *supra* note 16, at 22.

[254] For a discussion of some possible limitations on author ability to effect a waiver of Lanham Act rights, see *supra* notes 187 and 221.

[255] The French Act declares explicitly that the author's "right to respect for his name, his authorship, and his work [is] perpetual, inalienable and imprescriptible." French Act, *supra* note 25, art. 6. The German Act contains no such broad declaration, although commentators and courts take the inalienability principle as their starting point. *See, e.g.*, Dietz, *supra* note 25, at FRG-91 to FRG-92.2. The German Act, however, does explicitly provide

global renunciation of such rights would be tantamount to "intellectual suicide."[256] At the same time, the extent to which the inalienability principle is actually applied has troubled Continental commentators, as well as their American colleagues. As a leading German commentator notes: "It is relatively difficult to give a clear answer to the question whether, under German copyright law, an author has the power to transfer or waive his moral rights, since the answer is both yes and no at the same time."[257]

Much of the confusion regarding the extent to which moral rights are transferable and waivable stems from a lack of precision in defining the nature and scope of moral rights, and from the use of the terms transfer and waiver. Much of what some commentators have seen as a willingness to accept waivers or transfers can be described as the delimitation of the scope of moral rights, the conditions of their exercise, and the remedies available for their infringement. This tailoring of rights often serves to accommodate the interests of holders of contractual rights in authors' works. But it does not constitute the contractual relinquishment of moral rights by the author. A more careful use of definition and terminology cannot allay the real tension between absolutist sentiment espousing an inseverable bond between an author and his work, and the claims of exploitation right transferees, who, in a market economy, are necessary to bringing creative works to the public. But, as will be seen in this Section, a more careful use of definitions and terminology can help to differentiate between the inalienable core of moral rights protection and the partly alienable periphery.

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that the right of revocation may not be waived in advance and that its exercise may not be precluded. GERMAN ACT, *supra* note 22, art. 42(2).

The Berne Convention requires that member states provide for rights of paternity and integrity that may be exercised by authors "[i]ndependently of the authors' economic rights, and even after the transfer of said rights." Berne Convention, art. 6bis. Most commentators maintain that this provision does not require the inalienability of paternity and integrity rights, but merely that said rights are not automatically transferred or waived by virtue of the transfer of the author's economic rights. *See, e.g,* Nimmer, *supra* note 175, at 523. *But see* Damich, Statement in Support of U.S. Adherence to the Berne Convention, Berne Hearings, *supra* note 12, at 553 (noting that the World Intellectual Property Organization Guide to the Berne Convention states that the provision "protects the author against himself" and concluding that the provision presumably means that an author cannot be held to agreements in which he has completely relinquished control over the integrity of his work).

256 DESBOIS, *supra* note 112, at 470. In this statement, Desbois refers to the global renunciation of moral rights, and not to their waiver in particular circumstances. Desbois's conclusion is that the term "inalienable" in article 6 of the French Act is inaccurate to the extent that it conveys the idea of an absolute or categorical prohibition on waiver.

257 Dietz, *supra* note 25, at FRG-91.

A. *Transfer*

To what extent are moral rights transferable? A complete transfer of moral rights would give the transferee the unrestricted power to dispose of such rights and to enforce them against other persons, including the author. For example, a transferee book publisher could authorize a third person to attribute authorship to himself and could, without taking the author's wishes into account, permit or prevent modifications to the book and to any derivative works based upon it; even modifications that will damage the reputation of or run contrary to the artistic conception of the author.[258]

Transfers like the one described above are not recognized in Continental law.[259] An author cannot convey to another a protectible personal interest in the author's work. Neither does a transferee of exploitation rights acquire any right that may be exercised independently of the author to enforce the author's personal interests. Thus, a book publisher that has obtained the publication rights to a novel does not, and cannot, acquire the moral right to determine when the work is to be disseminated. The author always may prevent publication or withdraw the work from circulation upon compensating the publisher for injury.[260] Similarly, a person in whose name a book is published pursuant to an agreement with a ghostwriter has no paternity right in his attributed authorship.[261] In fact, neither he nor the ghostwriter may prevent a third person from divulging the identity of the true author of the work.[262] Similarly, an exploitation rights transferee may only prevent third party modifications or uses of the work that infringe the transferee's exploitation rights.[263] Thus, the publisher of a novel who also holds

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258 A transfer of moral rights could mean either that the transferee is entitled to assert the author's autonomy and reputational interests with respect to the work or that the transferee somehow acquires his own personal interests in relation to the work.

259 Eugen Ulmer, *Case Comments on Maske in Blau*, 2 I.I.C. 209, 218 (1971).

260 *See supra* notes 118-64 and accompanying text. Dietz characterizes the granting of the right to publish an unpublished work under conditions determined by the publisher as the author's authorization of the publisher to exercise the author's moral right of disclosure on the author's behalf. Dietz, *supra* note 25, at FRG-92. It would appear—and this is certainly the case if German law follows the French on this point—that this authorization is revocable. However, in a recent case concerning the right of the director of a feature film to determine when the film is ready for release, the Berlin Chamber Court declined to rule on the extent to which the right of disclosure might be transferable. Judgment of Oct. 25, 1985, Bundesgerichtshof, BGHZ 86, *discussed in* Adolf Dietz, *Letter from the Federal Republic of Germany: The Development of Copyright Between 1984 and the Beginning of 1989*, COPYRIGHT 77 (Feb. 1990) [hereinafter Dietz, Copyright 1990]. In any event, even under German Law, an author who could show that the work no longer corresponds with his convictions could effectively terminate such assignment.

261 *See* CLAUDE COLOMBET, PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE 109 (6th ed. 1992).

262 F. FROMM & W. NORDEMANN, URHEBERRECHT 144 (5th ed. 1985).

263 In certain circumstances, the transferee may also prevent the author from modifying or using the work in a manner that would diminish the value of the exploitation rights that

the right to reproduce and produce adaptations of the novel may prevent the dissemination of a comic book version of the work only if the comic book is deemed to be either a reproduction of the novel or a type of adaptation to which the publisher holds the exclusive rights. The publisher may not prohibit dissemination of the comic book on the grounds that it is demeaning to the publisher or the author.

The single, partial caveat to the above is that, under German law, an author may authorize another to exercise and defend moral rights in the author's name; and an exploitation rights transferee acquires a similar derivate right to enforce the author's moral rights.[264] German law is uncertain whether the transferee may bring such an action in his own name or whether he must sue on behalf of the author.[265] In either event the author retains a superior and independent power of enforcement. Where the author and the transferee or authorized party disagree on whether to bring an enforcement action, the author's views prevail.[266]

B. *Waiver*

1. Disclosure and Withdrawal Rights

The rights of disclosure and withdrawal are not waivable.[267] This means that, regardless of what other rights an author has transferred or waived, theoretically, he may always prevent his work from being disseminated. In practice, however, authors will generally find it difficult to exercise these rights in the face of the exploitation right transferee's competing interests, since once the work has been completed, exercise is conditional upon compensating the transferee for damages.

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the author has granted to the transferee. *See* STIG STRÖMHOLM, LA CONCURRENCE ENTRE L'AUTEUR D'UNE OEUVRE DE L'ESPRIT ET LE CONCESSIONAIRE D'UNE DROIT D'EXPLOITATION (1969).

264 *See* Deitz, *supra* note 25, at FRG-92; Ulmer, *supra* note 259, at 219.

265 In *Maske in Blau*, the German Federal Supreme Court explicitly declined to rule on the question of whether a transferee may sue in his own name for violation of the intellectual and personal interests of the author protected by the integrity right. The Court stated, somewhat quizzically, that the issue did not require a decision because the plaintiff transferee had withdrawn its claim for "immaterial damages" for infringement of the author's integrity right. Judgment of Apr. 29, 1970, 55 BGHZ 1. As pointed out by Professor Ulmer, however, under German Law a violation of moral rights may also give rise to injunctive relief and a claim for actual damages, and these remedies were sought by the plaintiff in *Maske in Blau*. Ulmer, *supra* note 259, at 218.

Professor Ulmer concludes that the plaintiff was merely acting with the author's authorization to defend the author's personal interests, and not suing to protect its own rights. *Id.* at 218-19. Fromm and Nordemann maintain, on the other hand, that the licensee may sue in his own name. FROMM & NORDEMANN, *supra* note 262, at 136.

266 Dietz, *supra* note 25, at FRG-92; FROMM & NORDEMANN, *supra* note 262, at 136.

267 Dietz, *supra* note 25, at FRG-55; Lucas & Plaisant, *supra* note 25, at FRA-95, FRA-102.

2. Attribution Right

It is sometimes suggested that the attribution right is waivable because it entitles an author to publish anonymously or pseudonymously rather than under his own name.[268] This position wholly misconceives the nature of the right and its exercise. The attribution right does not serve solely to allow authors to require that their works be identified as theirs; and even if it did, the failure of an author to so require in any given case does not constitute a waiver of the right but merely its non-exercise. Rather, the right gives authors control over what attribution is to be given to their works, whether it be the author's true name, another name, or no name at all.[269] Thus, if an author requires that his work be published anonymously or pseudonymously, this is an exercise of the attribution right, and not its waiver or non-exercise.

It follows that in considering whether the attribution right is waivable, the pertinent question, which has been described as "one of the most difficult in the entire realm of moral right,"[270] is whether an author may contractually bind himself to refrain from exercising his right to have the work published under his name or from publicly announcing that he is the true author of the work. French and German law diverge on this point. In France, agreements for anonymous publication or concealed collaboration are said to be unilaterally revocable by the author, who may disclose his authorship at any time.[271] In a recent case, the Paris Court of Appeals refused to recognize a ghostwriter's waiver of the attribution right, even though the contract was made in and governed by the laws of New York.[272] In Germany, an author's waiver of his

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268 Dietz, *supra* note 25, at FRG-85 to FRG-86.

269 Lucas & Plaisant, *supra* note 25, at FRA-96; Dietz, *supra* note 25, at FRG-85. The attribution right provision of the German Act provides explicitly that the author may "determine whether the work is to bear an author's designation and what designation is to be used." GERMAN ACT, *supra* note 22, art. 13. The right of anonymous and pseudonymous publication under the French Act may be deduced from the references to such publication in various provisions of the Act, including those in Article 22 dealing with the period of copyright protection for anonymous and pseudonymous works.

270 Roeder, *supra* note 25, at 564.

271 *See* COLOMBET, *supra* note 261, at 109; Gautier, *L'Oeuvre Ecrite Par Autrui*, 139 R.I.D.A. 63, 81-83; Lucas & Plaisant, *supra* note 25, at FRA-107 (adding that an author who has consented to an anonymous or pseudonymous publication may not later claim damages for infringement of his paternity right); Schmidt, *L'Application Jurisprudentielle dela Loi du 11 Mars 1957*, 84 R.I.D.A. 91, 96 (1975). Prior to the enactment of the French Act in 1957, a body of opinion in France held that an author's waiver of the paternity right was binding unless contrary to the public interest in knowing the identity of the true author in a given instance. According to Desbois, this view ignores the fact that the traditional concept of droits d'auteur is to protect the pecuniary and moral rights of individuals, rather than the interests of society as a whole. DESBOIS, *supra* note 112, at 530.

272 Judgment of Feb. 1, 1989 (Michel de Grece), Cass civ. 1 re, 142 R.I.D.A. 301, *noted in* Lucas & Plaisant, *supra* note 25, at FRA-85. *See also* Judgment of May 5, 1993 (Villiers v.

right to recognition of authorship is deemed to be binding, except in certain unidentified "special circumstances where such an author can assert a legally protectible interest in becoming known as the creator of his work."[273]

3. Integrity Right

Uncertainty regarding the waivability of the right of integrity has centered upon the effect of the author's transfer of the exploitation right to adapt the work in another medium, such as for the production of a film, play, or opera based upon a novel. Both German and French law narrow the scope of the integrity right in such instances. The German Act provides that where an author has licensed the alteration or adaptation of his work, modifications in the work and its title to which the author cannot object in good faith are permissible.[274] Similarly, French judicial doctrine requires that an author who has authorized the adaptation of a work must accede to changes in the work that are necessitated by its transfer to another medium.[275]

Some Continental and United States commentators characterize these restrictions on an author's right to object to changes in the work as an implied waiver of the author's moral right of integrity.[276] They point to the restrictions as indicative of the limited scope and, indeed, illusory character of the principle of the inalienability of moral rights.[277] But the blanket characterization of the restrictions as an alienation of moral rights misconceives both the nature of the restrictions and the import of case law concerning author objections to modifications made by adaptation right's grantees.

Soton), Cass. civ., 158 R.I.D.A. 205 (1993) (holding that a contract clause by which an author purported to abdicate joint authorship credit could not constitute a definitive renunciation of her attribution right and was unenforceable where her co-author had acted in bad faith by taking sole authorship credit for the joint work).

[273] Dietz, *supra* note 25, at FRG-92. *See also* FROMM & NORDEMANN, *supra* note 262, at 144. Of course, even in Germany the waiver of the attribution right must be explicit, and does not arise from an assignment of exploitation rights. In fact, recent German decisions support the right of employees to receive authorship credit even if the employer holds the exploitation rights pursuant to a collective bargaining agreement and even if the employee has been lawfully dismissed prior to the work's completion. Dietz, *supra* note 198, at 198 (summarizing Judgment of Aug. 29, 1988, Landesarbeitsgerichte, 1989 Archiv für Presserecht 596 (collective bargaining agreement)); Judgment of July 5, 1991, Bundesgerichtshof, 1992 G.R.U.R. (co-editor who had helped give the work its particular shape did not lose attribution right as result of lawful dismissal).

[274] GERMAN ACT, *supra* note 22, art. 39(2).

[275] DaSilva, *supra* note 125, at 35.

[276] *See, e.g.*, DaSilva, *supra* note 125, at 16; Kwall, *supra* note 10, at 13; Paul Goldstein, *Adaptation Rights and Moral Rights in the United States and the Federal Republic of Germany*, 14 I.I.C. 43, 56 (1983); GAVIN, *supra* note 159, at 84.

[277] *Supra* note 276.

The extent to which the right of integrity can be alienated warrants a further examination of the contours of the right and of what is meant by its alienation. If the integrity right meant that the author may, at any time and under any circumstances, prevent another from modifying the author's work, then any rule that deviated from that seemingly unlimited mandate by permitting even minor modifications in the face of the author's objections would amount to a recognition of author forfeiture or waiver of the integrity right. But no abstractly-stated right is absolute. As Ronald Dworkin has noted, although rights tend to be formulated in expansive terms, they are in fact subject to various constraints, provisos, and competing interests.[278] Therefore, no matter how broadly the right of integrity may be expressed, it no more entitles the author to prevent all modifications than does the "right to free speech" give one license to libel or extort, or the "right to privacy" preclude all intrusions into one's personal affairs.[279]

In fact, the integrity right under French and German law is limited by the competing entitlements and interests of exploitation right transferees, editors, other authors and owners of material objects in which the author's work has been embodied.[280] In France the integrity right is generally expressed in absolute, maximalist terms that, if taken literally, would entitle the author to prevent any modifications.[281] But French courts have limited the right's application, first, by qualifying the meaning of "modification" and, second, by applying the doctrine prohibiting the bad faith exercise of rights. Courts have qualified the meaning of "modification" by limiting relief to alterations of the work's essential character, as determined by an objective standard, and not solely by the author's

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278 Dworkin distinguishes between "abstract" and "concrete" rights. Abstract rights are statements of a "general political aim," such as the "right to free speech" or "equality," which do not indicate how that aim is to be weighed against other political claims in particular instances. Concrete rights are more precisely defined political aims that express with greater precision the weight they have against other political aims on particular occasions. RONALD DWORKIN, TAKING RIGHTS SERIOUSLY 93 (1977). By definition, however, a "right" must outweigh at least some social goals and must have a certain threshold weight against collective goals in general. *Id.* at 92.

279 For a detailed discussion of limitations to the right of privacy of public figures, see Robert Post, *The Social Foundations of Privacy: Community and Self in the Common Law Tort*, 77 CAL. L. REV. 957, 997-1008 (1989). For an analysis of the Supreme Court's seminal rulings regarding limitations to freedom of speech posed by the law of defamation and invasion of privacy see Melville B. Nimmer, *The Right to Speak from Times to Time: First Amendment Theory Applied to Libel and Misapplied to Privacy*, 56 CAL. L. REV. 935 (1968).

280 *See* DESBOIS, *supra* note 112, at 542-47; COLOMBET, *supra* note 261, at 112-15, 171-74.

281 *See, e.g.*, Lucas & Plaisant, *supra* note 25, at FRA-81. The reference to the integrity right in the French Act states cryptically that an "author shall enjoy the right to respect for . . . his work," without further delineating the meaning and scope of the right. FRENCH ACT, *supra* note 25, art. 6, para. 1.

sensibilities.[282] In one such case, Salvador Dali brought suit against a theater company, claiming that the addition of another artist's costumes and sets to those that Dali had designed for a ballet violated Dali's right of integrity.[283] Dali's claim was rejected on the grounds that the additions did not convey an inaccurate impression of the work.[284]

Under the doctrine of *abus de droit*, French courts will not countenance the author's bad faith or arbitrary exercise of the integrity right.[285] An author may not exercise the right "abusively to the detriment of third parties, nor unnecessarily impair interests he has granted to others in his works."[286] This rule enables courts to balance the interests of third parties, and to prevent manifestly vexatious claims.

The German formulation of the integrity right, as set forth in Article 14 of the German Act, suggests similar limitations to an absolutist conception of the right. Article 14 accords the author the right to prohibit "any distortion or other mutilation of his work

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282 See COLOMBET, *supra* note 261, at 113. *Cf.* DESBOIS, *supra* note 112, at 541-44 (noting that an editor may correct undisputable factual errors and mistakes in spelling, punctuation and syntax so long as they are not deliberate expressions of the author's style). At least one commentator has questioned whether judges should be involved in determining what is the essential character of a work and whether particular modifications alter that character. Sarraute, *supra* note 135, at 482.

283 Judgment of Mar. 5, 1968, Cour de cassation, 1968 D.P. I 382 (Fr.); Judgment of May 11, 1965, Cour d'appel, 1967 D.S. Jur. 555 (Fr.), *discussed in* COLOMBET, *supra* note 261, at 113.

284 *Supra* note 283. The court might have had held differently if Dali's creation had been physically altered, rather than merely supplemented. *See* DaSilva, *supra* note 125, at 34.

285 COLOMBET, *supra* note 261, at 105-06; Lucas & Plaisant, *supra* note 25, at FRA-102. *But see* Judgment of June 5, 1984 (Maddalena v. Raffin), Cass. civ., 124 R.I.D.A. 150, 151 (1985) (stating, in contrast to the Court of Cassation's own rulings and practice on other occasions, that "the exercise of his moral right by the author of an original work is discretionary in nature and, therefore, it is beyond the competence of the court to assess whether the exercise is legitimate" (author's translation)).

For a general comparison of the French doctrine of *abus de droit* with U.S. equity doctrine, see Jacques Dufaux, *Equity and French Private Law, in* EQUITY IN THE WORLD'S LEGAL SYSTEMS: A COMPARATIVE STUDY (R.A. Newman ed., 1973). It is interesting to note that the concept of the moral right initially arose from judicial application of the same equitable principles set forth in article 1382 of the French Civil Code that gave birth to the doctrine of *abus de droit*. Damich, *supra* note 10, at 29.

286 COLOMBET, *supra* note 261, at 105-06; Lucas & Plaisant, *supra* note 25, at FRA-97. The author's obligation to act in good faith towards exploitation right transferees may, in certain circumstances, also limit the author's right to exercise other exploitation rights in the work or to exploit new, but similar, works where such acts would impair the transferee's ability to exercise his exploitation right. For an in-depth discussion of this issue, see generally STRÖMHOLM, *supra* note 79.

U.S. copyright law contains an interesting parallel to the French doctrine of *abus de droit* and German law requirements that authors must exercise good faith in exercising their integrity right. Several U.S. courts have intimated or held that the copyright owner's misuse of copyright, such as its use as an anti-competitive device, constitutes a valid equitable defense to a copyright infringement action. *See, e.g.*, Lasercomb America, Inc. v. Reynolds, 911 F.2d 970 (4th Cir. 1990).

which would prejudice his lawful intellectual or personal interests in the work."[287] The terms of the statute protect the author only against modifications that a court finds to be sufficiently substantial to warrant interference with the interests of the modifying party. In order to be actionable, a modification must be of sufficient proportion to amount to a "distortion or other mutilation" of the work, and must result in an objectively provable injury to the author's reputation or other interest accorded legal protection under the circumstances.[288] As a corollary to these constraints, the German Act contains specific requirements that the author exercise his integrity right in good faith. In essence, unless modification gives the author grounds for a good faith objection, a person who has the right to use the author's work, either as a grantee of an exploitation right, or under a compulsory license or right of fair use, may make modifications in the work and its title.[289] According to the German Federal Supreme Court, the determination of whether an author's objections are in "good faith" requires a case-by-case balancing of the author's interest in controlling his intellectual product against the user's interest in using or exploiting the work, or in creating a derivative work, by taking into account the nature of the author's work and the contemplated use.[290]

In addition to otherwise limiting the application of the integrity right, French and German law recognize that authors may give binding consent to specific changes in their work.[291] Therefore,

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287 GERMAN ACT, *supra* note 22, art. 14.

288 *See* Dietz, *supra* note 25, at FRG-86.

289 Article 39(1) of the German Act provides that an exploitation rights licensee may not alter a work or its title unless the author has agreed to the alteration. Article 39(2), however, permits the licensee to make such "[m]odifications in the work and its title which the author cannot in good faith refuse . . . ." GERMAN ACT, *supra* note 22, art. 39(2). Article 62(1) provides that persons who are entitled, pursuant to Section VI of the German Act, to copy or disseminate a work without the author's consent, such as producers of works for personal use and organizers of a performance of a published work where spectators are admitted free of charge, may not alter the work or its title unless the author could not in good faith refuse to consent to such modification. Article 62(2) further provides that insofar as the purpose of the permitted use may require, the user may "make translations and such modifications to the work as amount merely to extracts or to transpositions into another key or pitch." *Id.* art. 62(2). Similarly, Article 62(3) provides that "[w]ith respect to artistic works and photographs, transpositions into a different scale and other modifications of the work shall be permissible to the extent required by the method of reproduction." *Id.* art. 62(3). Article 62(4) permits such modifications of literary works as are necessary for religious, school and instructional use, provided that the author has been given notice of the proposed modification and has not raised an objection within a month of such notice. *Id.* art. 62(4).

290 *See* Judgment of Apr. 24, 1970, 55 BGHZ 1 (holding that licensee's interpretation of a play that was designed to ridicule the work contained modifications to which the author could object in good faith and thus violated author's integrity right).

291 Article 56 of the French Act provides, for example, that a publisher may not modify the author's work "without the author's written consent," clearly indicating that modifica-

the right of integrity does not mean that all non-author modifications, or even mutilations, are prohibited. The right merely means that every modification—or at least every material modification—is subject to the author's consent.[292] An author's consent to a particular alteration of his work, however, does not necessarily constitute a waiver of his integrity right.[293] In essence, the integrity right gives the author continuing creative control over his work.[294] An author does not relinquish this control by agreeing to a particular modification in a particular context. The author would be surrendering creative control if he gave advance consent to whatever modifications the transferee wished to make. Such blanket consents are not enforceable under French or German law, precisely because they are seen as an impermissible waiver of the author's right of integrity.[295]

We have seen, therefore, that not every rule that permits non-author modifications necessitates an author waiver of the integrity right. We now return to the question of to what extent Continental

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tions when permitted may not alter the work or its title unless the author could not in good faith refuse to consent to such modification. FRENCH ACT, *supra* note 25, art. 56. Article 39(1) of the German Act similarly provides that an exploitation rights licensee may not alter the work "[i]n the absence of any contrary agreement . . . ." GERMAN ACT, *supra* note 22, art. 39(1). The German Federal Supreme Court has stated in dicta that an author's consent to specific modifications, even substantial modifications that change a work's basic characteristics, will be upheld. Judgment of Apr. 24, 1970, 55 BGHZ 1.

292 *See* Dietz, *supra* note 25, at FRG-86.

293 This proposition has been supported by leading French commentators. *See, e.g.*, DESBOIS, *supra* note 112, at 539-46; COLOMBET, *supra* note 261, at 114-15. German commentators, on the other hand, tend to view an author's consent to modifications as a partial waiver of the integrity right. *See, e.g.*, Dietz, *supra* note 25, at FRG-87; Ulmer, *supra* note 259, at 218.

294 DESBOIS, *supra* note 112, at 542.

295 *Id.* at 539-41 (maintaining as well that a blanket consent to modifications in a publishing or production contract cannot be recognized under French law because it contradicts the fundamental purpose of such a contract, which is that the publisher or producer bring the work to the public with "servile fidelity to the author"); COLOMBET, *supra* note 261, at 114. *See also* Dietz *supra* note 25, at FRG-92 (stating that under German law the core of moral rights protection remains with the author despite contractual provisions purporting to effect a transfer of the author's right to alter his work or a waiver of this right to oppose alterations).

The author's consent to a particular modification may arguably be seen as a partial waiver of his integrity right only in one narrow sense. If the author truly maintained absolute creative control, then he would be free at any time to decide that he did not want his work modified after all and to require that the transferee refrain from making the modification or even re-modify the work to return it to its original state. Neither French nor German law would appear to permit the author freely to renege on his consent to a modification in this manner. *See* COLOMBET, *supra* note 261, at 115; Dietz, Copyright 1990, *supra* note 260, at 78 (writer may not waive the right to object to modifications in advance, but neither may he retrospectively object to changes that he had previously accepted). The author could effectively prevent dissemination of the modified work by invoking his right of withdrawal or correction. In this event, however, the author would be required to compensate the transferee for damages caused by the impairment of the transferee's exploitation right.

law restrictions on author control over adaptations in another medium may connote an implied waiver of the integrity right.

The author's grant of adaptation rights could treat the question of adapter freedom to modify the work in any of four basic ways. First, the transfer contract can provide that each part of the adapted work, including each and every variation from the original work, is subject to author approval.[296] In this case, Continental law imposes the good faith proviso to require that the author not unreasonably withhold consent to proposed modifications.[297] Second, the contract could explicitly state that the transferee may make whatever changes he wishes without consulting the author, and that the author waives any right to object to them.[298] Such provisions are either construed or reformed to limit adapter freedom. Adapter modifications are permitted only as long as the original work is interpreted in good faith and without distorting the work's essential character.[299] Third, the contract can explicitly authorize all changes and modifications that do not distort the spirit and character of the original. Such provisions are generally upheld.[300] Fourth, the contract can be silent with regard to the scope of adapter freedom, merely stating that the transferee may prepare

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296 *See* Sarraute, *supra* note 135, at 482.

297 *Id. See also* Giocanti, *supra* note 125, at 642.

298 Such clauses are typical in the motion picture industry in the United States. *See, e.g.*, 2 A. LINDEY, LINDEY ON ENTERTAINMENT, PUBLISHING AND THE ARTS 806 (1990) (setting forth clause of standard contract for the grant of motion picture rights in a book that allows the grantee to make whatever modifications that "it in its sole discretion may deem advisable" and provides that the author waive his right to bring any action based on infringement of moral right or injury to professional reputation).

299 FROMM & NORDEMANN, *supra* note 262, at 259. In one early French case, a French court purported to uphold a blanket waiver clause, but nevertheless required the adapter to interpret the original work in good faith and without distorting its essential character. Judgment of July 23, 1933 (l'Affaire Bernstein), Trib. civ. seine, 1933 D.H. Jur., No. 5, at 33 (Fr.), *quoted in* DaSilva, *supra* note 125, at 35. In a more recent case, the Paris Tribunal de Grande Instance ruled that such a clause was null and void, given the inalienability of the author's integrity right and the clause's "negation of the dignity of the true author, [who was] reduced to the ridiculous status of commentator on the changes decided by the producer." Judgment of Feb. 24, 1970, Tr. gr. inst., 64 R.I.D.A. 180, 185. The court recognized that due allowance must be given to the producer's legitimate commercial and technical interests, but not to the point of recognizing a blanket waiver, designed to effect "the complete subjection of the artist" to the "discretion of a businessman," at the risk of "abasing the level of the work and degrading the taste of the audience."

An early U.S. case held that a writer's grant of motion picture rights authorizing the producer to "elaborate" on the story "however needed" did not entitle the producer to produce a film that bore no resemblance to the original work, but used its title and attributed authorship to the writer. Curwood v. Affiliated Distributors, 283 F. 219, 221 (S.D.N.Y. 1922). The court stated that the right to elaborate requires some "appropriate expression to the theme, thought, and main action of that which was originally written." *Id.* at 222. Today, U.S. motion picture producers commonly acquire the right to use the title of the original work even as the title of a motion picture that is not based on or suggested by the original work. *See* 2 LINDEY, *supra* note 298, at 803.

300 *See, e.g.*, Judgment of May 27, 1959, Trib. civ. seine, 24 R.I.D.A. 49.

a derivative work in a certain medium. In such instances, the author must accede to alterations that are dictated by the artistic, technical, and, to a more limited extent, commercial exigencies of the new medium.[301] At the same time, however, the adapter is required to transpose "with honesty, the spirit, character and substance of the work."[302] For example, in a film adaptation of a novel, the book's basic themes, plot, plan, episodes, and characters must be presented on the screen.[303]

The various standards for delineating the author's rights and transferees' obligations in these scenarios, as well as in instances in which no change of medium is contemplated, are sufficiently vague so as to elude definitive analysis. In fact, Continental commentators complain that the standards give courts overly broad discretion in considering claims involving violations of integrity rights.[304] Nevertheless, it would appear that the loss of creative control suffered by authors in transfer of medium cases is characterized more properly as a delimitation of the integrity right than a contractual waiver.[305] In the particular concrete circumstance in which an author has granted an exploitation right to another, the

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301 DaSilva, *supra* note 125, at 35; GAVIN, *supra* note 159, at 82.

302 Schmidt, *supra* note 271, at 93.

303 *Id.* at 95 (summarizing comments of Henri Desbois).

304 *Id.* at 93-95.

305 *See* Geller, *Introduction*, *in* 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 25, at INT-197 (noting that judicial accommodation with competing rights avoids "the non sequitur of allowing inalienable rights to be contractually impaired"). In evaluating the waivability of the integrity right it is also instructive to review the difference between waiver, estoppel and the delimitation of an abstractly-stated right. A waiver is a voluntary and intentional relinquishment of a known right, privilege or claim. WILLISTON, *supra* note 143, § 678, at 239. But waiver is often used loosely to refer as well to estoppel in the sense of an involuntary abrogation of a right or bar from asserting a right because of something the right-holder has done or omitted to do. "Waiver is a troublesome term in the law" because of the many meanings and contexts with which it is used. *Id.* §§ 678-679, at 239-57. Estoppel has also been variously defined and applied. It generally relates to allegations of fact, but the term is also used, as in the text here, to mean the preclusion from asserting a right or taking inconsistent legal positions. For our purposes, the distinction between waiver and estoppel is important. Waiver is an expression of the intent of the affected party, whether expressly set forth or implied. *Id.* § 678, at 239-40. Estoppel is based upon public policy, fair dealing, good faith and justice. It is designed to prevent unfair injury to another. The delimitation of an abstractly-stated right is conceptually distinct from waiver and estoppel. Unlike waiver, it is derived from considerations of public policy and competing interests rather than intent. As opposed to estoppel, it requires no specific act or omission by the right holder, and need not carry with it a sense of protecting an innocent party from injustice. Nevertheless, the three concepts of waiver, estoppel and delimitation of rights often merge into one another. The intent to waive a right may be implied by words or conduct such that the right holder must, or another party may, reasonably expect that the right has been waived. The rightholder's subsequent attempt to assert the right might also be said to be estopped in order to prevent injustice to an innocent party who reasonably relied on the rightholder's words, acts or omissions. At the same time, the determination of what amounts to apparent intent to waive and what justifies reliance on the rightholder's words, acts or omissions depends to a large extent on customs of the trade, public policy and balancings of interests that define what the right holder and other par-

good faith proviso and accommodation of interests that are always at play in defining the scope of the integrity right require that the author permit the transferee to exercise the exploitation right in some reasonable fashion.[306] At the same time, like other rights that are seen as fundamental to the individual, the integrity right is accorded a certain threshold weight against competing interests. Accordingly, authors do not relinquish their right to prevent gross distortions even when they have purported to waive the integrity right. In short, the transfer of medium limitations reflect more a balancing of social goals, with the scales tipped towards the author, than a contractual impairment of the author's moral rights.

V. Additional Autonomy Inalienabilities

In complement to the doctrine of moral rights, Continental law contains a number of additional copyright alienability restrictions that serve the dual purpose of protecting authors' artistic control and promoting their material interests.[307] These include (i) the author's right to revoke a transfer if the transferee fails to meet statutory standards for exploiting the work, (ii) the requirement that copyright transfers be narrowly interpreted with respect to the rights assigned and technologies to be exploited, (iii) the prohibition against retransfer by the transferee without the author's consent, and (iv) restrictions on the transfer of future works.

A. *Assignee's Obligation to Exploit*

An unrestricted assignment of an asset or right gives the as-

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ties may reasonably expect to be the consequences of their words and deeds under the circumstances.

306 Alternatively, the author's agreement to have his work transformed to another medium might be seen as an implied consent to those specific changes that are required for the transformation. An early U.S. case came to this result on the basis of a narrow interpretation of the contract clause requiring author approval of all alterations, eliminations and additions to be made in a play in converting it to a film. Manners v. Famous Players-Lasky Corp., 262 F. 811 (S.D.N.Y. 1919). The court held that a modification that is "faithfully consistent with the plan and sequence of the play" could not be said to constitute an alteration, elimination or addition within the meaning of the clause, and thus would not require author approval. 262 F. at 812. But, the author's implied consent to such modifications would not mean that he has waived the integrity right. The author's consent to particular changes in his work does not mean that he has surrendered creative control to the grantee. The requirement that an author may not later renege on his consent, at least without compensating the grantee, serves to avoid an injustice to the grantee, who may have incurred expenses and other burdens in reliance upon the author's consent. It is thus more correctly seen as an estoppel or delimitation of right, than a contractual waiver.

307 Other continental copyright alienability restrictions are related solely to exploitation contract payment terms. These include the author's right to proportionately participate in exploitation revenues (French Act, *supra* note 25, art. 35) and to bring a claim for equitable remuneration if exploitation revenues are grossly disproportionate to the contractually agreed upon income (German Act, *supra* note 22, art. 36).

signee the same freedom as previously enjoyed by the assignor to exploit the asset or right acquired, at the moment of choice, or to refrain completely from exploiting the asset. Under Continental copyright law, however, a transferee does not acquire the author's right to determine the conditions of exploitation or to refrain from exploitation. Rather, the transferee has a statutory obligation to exploit the assigned work in order to serve the author's personal interest in communicating his work.[308] The statutory obligation to exploit lends support to the positive aspect of the integrity right, which has been held, under certain circumstances, to entitle an author to compel the transferee to complete, preserve, and publicly display or disseminate the author's work.[309]

The obligation to exploit constitutes an integral part of copyright protection under French and German law. In France, the obligation is set out in several statutory provisions. Article 31 of the French Act provides that an assignee under an exploitation contract "shall undertake in such contract to endeavour to exploit the assigned right in conformity with professional usage."[310] Article 48 provides that an assignee's right to publish a work is subject to the "condition that he shall assure the publication and dissemination of the work."[311] Article 57 provides that a publisher "shall be required to ensure the sustained exploitation of the work without any interruption and its distribution through commercial channels according to the customs of the trade."[312] Article 57 has been the subject of much case law concerning the publication of musical works. French courts have consistently permitted authors to terminate contracts with publishers who publish sheet music, but fail to proceed with the recording and distribution of the work on records or cassettes.[313]

The assignee's obligation to exploit is viewed as the purpose of the assignment. French case law and commentary emphasize that the obligation is imposed to protect the author's personal and pe-

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308 Ulmer & Von Rauscher auf Weeg, *supra* note 61, at 428. *See also supra* note 8 and accompanying text.

309 *See supra* notes 199-200 and accompanying text.

310 FRENCH ACT, *supra* note 25, art. 31.

311 *Id.*, art. 48. On its face, Article 48 is phrased merely as a definition of a "publishing contract," rather than as a substantive provision. The Article is interpreted, however, to impose an obligation to see to it that the work is published and distributed. Henri Desbois, *L'obligation de publication et de diffusion des editeurs de musique*, 58 R.I.D.A. 163, 207, 231 (1968).

312 FRENCH ACT, *supra* note 25, art. 57. Similarly, Article 63-5 provides that a producer of an audio visual work pursuant to a contract with the authors of the work "shall be required to exploit the audiovisual work in conformity with the practice of the profession." *Id.* art. 63-5.

313 Lucas & Plaisant, *supra* note 25, at FRA-76.

cuniary interests. "If the author deals with a publisher it is in order to communicate his work. A provision that would leave the [publisher] completely free not only to determine the time of publication, but also to decide whether or not it is desirable to publish the work at all, would be incompatible with the basic rationale for this relationship."[314] As a result, the author is entitled to terminate a publishing contract when the publisher breaches the obligation to publish and disseminate the work.[315]

Germany's Copyright Act does not impose an explicit obligation to exploit the licensed work, although some commentators maintain that such an obligation is nevertheless implied in all copyright contracts.[316] The German Act does, however, give the author the irrevocable right to terminate an exclusive license if the licensee fails to exercise his rights under the license, or does so inadequately, thereby causing serious injury to the author's interests.[317] The right of revocation may be exercised any time after two years from the grant or assignment of the license or the date of delivery of the work, if the delivery date is later.[318] The licensee must be given notice of the proposed revocation and an adequate period of time to exercise his rights under the license, unless such exercise is impossible or the extension would endanger the author's "primary interests."[319]

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314 DESBOIS, *supra* note 112, at 171 (author's translation). The publisher's obligation to exploit and its basis in the author's moral rights were set forth in case law even prior to the enactment of the French Law in 1957. *See* Judgment of Dec. 8, 1925, Tribunal de commerce de la seine, 1926 G.P.I., *discussed in* Desbois, *supra* note 311, at 169-73 (1968).

315 FRENCH ACT, *supra* note 25, art. 63.

316 *See* Hans-Peter Hillig, *Contractual Freedom in German Copyright Law, in* COPYRIGHT CONTRACTS 121, 129 (H. Cohen Jehoram ed., 1977).

317 GERMAN ACT, *supra* note 22, art. 41(1). The revocation right does not apply to cinematographic works, except for licenses to adapt, transform, or otherwise use a pre-existing work for the production of a cinematographic work. GERMAN ACT, *supra* note 22, art. 90. Article 14 of the German Publishing Act provides that "[t]he publisher shall multiply and distribute the work in the appropriate and customary manner." German Publishing Act, *supra* note 160, art. 14. German courts also recognize the author's right to terminate an exploitation contract without notice if the licensee has acted so as to cause the author to lose confidence in him such that continuation of the contractual relationship is impossible. *See cases discussed in* Adolf Dietz, Letter from the Federal Republic of Germany: The Development of Copyright Between 1979 and the Beginning of 1984 (Second part), *in* COPYRIGHT 457, 462-63 (Dec. 1984) [hereinafter Dietz, Copyright 1984]. *See also* Judgment of Feb. 25, 1977, Bundesgerichtshof, BGHZ 237 (Schulze, J.), *discussed in* Adolf Dietz, Letter from the Federal Republic of Germany; Report on the Development of Copyright Between 1972 and 1979 (Second Part), 16 COPYRIGHT 129, 134 (Mar. 1980) [hereinafter Dietz, Copyright 1980].

318 GERMAN ACT, *supra* note 22, art. 41(2). In the case of a contribution to a newspaper, the period is three months, instead of two years. For contributions to periodicals the period ranges from six months to one year, depending upon the frequency of publication. *Id.* The author may agree to refrain from exercising the right of revocation for non-exercise for up to five years. *Id.* art. 41(4).

319 *Id.* art. 41(3).

The German Act requires that the author compensate the person affected by the revocation, but only to the extent that "fairness" requires.[320] The German Federal Court has declared invalid a contract clause permitting the author's right of revocation to be exercised only upon the reimbursement of fees already received. The Court held that the blanket requirement of full reimbursement conflicts with the statutory "fairness" limitation since in some circumstances fairness might require only partial reimbursement.[321]

Parallel to the author's right under the German Copyright Act to terminate an inadequately exploited license, the German Publishing Act of 1901 sharply limits the publisher's right unilaterally to terminate a publishing contract. Under the Publishing Act, a publisher may revoke a publishing contract only if the author's work is not delivered within the prescribed time or fails to meet the contract's specifications.[322] Publisher concerns about an author's marketability or even trustworthiness are insufficient grounds for revocation. Recent decisions in German regional courts have highlighted this restriction. The Regional Court of Passau held that a publisher could not terminate a publishing contract simply because the author's public image had significantly deteriorated following a sex change.[323] The Higher Regional Court of Munich held that a publisher could not unilaterally revoke its contract with a biographer who had been the subject of criticism that had cast serious doubt on the author's dependability and accuracy.[324]

United States law does not impose the same type of parallel obligation on the publisher to exploit the work, and does not provide the same type of parallel right to the author to terminate the publishing contract for breach of this obligation. United States authors have no statutory or common law right to have their works communicated to the public. As a result, exploitation right transferees have no obligation to disseminate authors' works except to the extent that the transfer of rights contract so requires. But this does not mean that authors' rights are in every instance contingent upon an express contractual provision requiring transferee exploitation. In a number of cases United States courts have held transferees to an implied duty to use reasonable efforts to exploit the work, even absent such a clause.

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320 *Id.* art. 41(6).

321 Judgment of Feb. 18, 1982, Bundesgerichtshof, BGHZ 45, *discussed in* Dietz, Copyright 1984, *supra* note 317, at 458.

322 German Publishing Act, *supra* note 160, arts. 30 to 31.

323 *See* Dietz, *supra* note 198, at 234 (discussing Decision of 11 April 1991).

324 *Id.* (discussing Decision of 4 July 1991).

Book publishing has been a principal focus for judicial intervention in the United States. The typical book publishing contract requires the publisher to publish the book within twelve to eighteen months of receiving a complete and satisfactory manuscript, but leaves the publisher complete discretion as to the manner of publication, the number of copies printed, and the extent and means of promotion.[325] Nevertheless, courts have applied the covenant of fair dealing and good faith implied in every contract to impose upon the publisher a duty to exercise its discretion in good faith. A publisher must expend "reasonable efforts" to publish and promote a work.[326] In the seminal case of *Zilg v. Prentice Hall, Inc.*, the Second Circuit further defined this implied obligation. It ruled that the publisher must exert "a good faith effort to promote the book including a first printing and advertising budget adequate to give the book a reasonable chance of achieving market success in light of the subject matter and likely audience."[327]

This implied obligation to exploit appears to be considerably narrower than its Continental counterpart. As indicated above, Continental law recognizes the obligation to exploit as a corollary of the author's right to communicate the work to the public. Thus, the Continental obligation to exploit extends to all grantees and all means of exploitation (with certain limitations governing film production contracts under German law),[328] and may not be waived by contract.[329] In the United States, on the other hand, the rationale for judicial intervention is solely to protect the copyright owner's material interests, and not to enhance authors' ability to communicate their work. United States courts have recognized the grantee's implied duty to exploit only where, as in the typical book publishing contract, the author is to receive royalties measured by the

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325 Melvin Simensky, *Redefining the Rights and Obligations of Publishers and Authors*, 5 LOY. ENT. L.J. 111, 122-23 (1985). *See also* E. PEARLE & J. WILLIAMS, THE PUBLISHING LAW HANDBOOK § 2.07, at 2-22 (1992).

326 Zilg v. Prentice-Hall, Inc., 717 F.2d 671 (2d Cir. 1983), *cert. denied*, 466 U.S. 937 (1984); Contemporary Mission, Inc. v. Famous Music Corp., 557 F.2d 918, 923 (2d Cir. 1977).

327 *Zilg*, 717 F.2d at 680.

328 Article 90 of the German Act provides that the right of withdrawal by reason of non-exercise, as well as various other author rights, does not apply to exclusive licenses to reproduce, distribute, publicly present, or broadcast cinematographic works. The rights do apply to the exclusive licenses to make a cinematographic adaption of a non-cinematographic work, such as a book or play. GERMAN ACT, *supra* note 22, art. 90. The French Act, on the other hand, explicitly extends the obligation to exploit to producers of audio-visual works. FRENCH ACT, *supra* note 25, art. 63-5.

329 Under the German Act, the author's exercise of the right may be temporarily precluded by contract for up to five years, but may not otherwise be waived in advance. GERMAN ACT, *supra* note 22, art. 41(4).

grantee's exploitation of the work.[330] Moreover, the grantee's implied duty arises regardless of whether or not the grantor is the author of the work or simply its copyright proprietor.[331]

In addition, the standard for fulfilling the obligation to exploit is generally more lax under United States law than under Continental law. *Zilg* requires that the publisher expend reasonable efforts to promote a book for its first printing. Once this initial obligation is fulfilled, the publisher is entitled to use good faith business judgment to decide whether further promotion is warranted, without being second-guessed by the court.[332]

Continental law imposes a more stringent obligation upon the publisher in two ways. First, at least in France the obligation to exploit appears to require greater publisher marketing efforts than the implied duty set out by United States courts. As one commentator notes, the French revocation provisions do not merely state that the publisher must reasonably promote. They require that the publisher see to it that the work is published and distributed.[333] Second, while the implied duty of the United States publisher does not extend past the first printing,[334] Continental law imposes upon publishers a continuing obligation to exploit the work.[335] It provides for author revocation if the publisher fails to publish and distribute the work for subsequent printings.[336]

The standard United States publishing contract contains a

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330 *See* NIMMER & NIMMER, *supra* note 12, § 10.11[B], at 10-97 to 10-100. *Cf.* Moran v. London Records, Ltd., 827 F.2d 180, 183 (7th Cir. 1987) (noting that when a copyright owner assigns title in exchange for the right to receive royalties from the copyright's exploitation, a fiduciary relationship arises between the parties, entitling the assignor to sue for infringement as "beneficial owner" if the assignee fails to do so). For a typical book publishing contract royalty provision, see LINDEY, *supra* note 297, at 128-31.

331 *See* NIMMER & NIMMER, *supra* note 12, § 10.11[B], at 10-97 to 10-100 (referring to "grantor" and not "author"). Under U.S. law, the source of the publisher's duty arises from the contract implied in law that a purchaser of property whose payment is based upon the earnings of the property transferred must make the property productive. Waterson, Berlin & Snyder Co. Fain v. Irving Trust Co., 48 F.2d 704, 709 (2d Cir. 1931).

332 *Zilg*, 717 F.2d at 680.

333 Desbois, *supra* note 310, at 231.

334 *Zilg*, 717 F.2d at 680.

335 *See* Lucas & Plaisant, *supra* note 25, at FRA-63.

336 In addition to French Act provisions requiring exploitation in the customary manner, Article 63 of the Act provides for author revocation if the publisher fails to reprint a work after the prior printing has been exhausted. A printing is considered exhausted if two purchase orders requesting the work are not filled within three months. FRENCH ACT, *supra* note 25, art. 63. Similarly, Article 44 of the act provides that exclusive dramatic performance rights shall automatically terminate if the work has not been performed for two consecutive years. *Id.* art. 44. Like the French Act, the German Copyright Act's revocation for non-exercise provisions set no time limit on the grantee's exercise obligations. GERMAN ACT, *supra* note 22, art. 41. In addition, under Article 17 of the German Publishing Act, absent a contractual provision to the contrary, the author may rescind a publishing contract upon the publisher's failure to issue a new edition within a time set by the author. *Id.* art. 17.

similar clause giving the author the right to terminate if the work remains out of print for more than six months after an author demands an additional printing.[337] However, a work is not deemed *out of print as long as it is under contract or option for publication* in the United States in any edition of the work, regardless of whether the work is actually being disseminated.[338]

Finally and most importantly, the obligation to exploit the work under United States law is derived from contract law, whereas the obligation under Continental law is an inherent part of the author's copyright. Therefore, in the United States the obligation attaches only to the author's immediate grantee. A remote assignee without notice of his assignor's obligations to the author or other copyright proprietor does not assume the obligation by the mere fact of the subassignment.[339] In addition, the publisher's obligation in the United States may be contractually impaired. The implied duty of good faith is based on typical contract clauses governing publisher discretion in the area of publication and promotion. Nothing would prevent the parties from expressly agreeing that the grantee is entitled to absolute discretion to refrain from any exploitation whatsoever, and that the author may not exploit the work in interference with the grantee's exclusive rights. In fact, this one-sided arrangement is typical of grants of motion picture rights in a book.[340] As long as the author receives consideration for foregoing the exploitation of his work, the clause will prevail over any implied duty to exploit.

B. *Narrow Scope of Copyright Transfers*

Continental copyright law restricts the alienability of copyright by narrowing the scope of copyright transfers. This is accomplished in two ways. First, contractual provisions defining the scope of the transfer are strictly interpreted against the transferee.[341] Second, certain copyright transfer provisions, no matter

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337 *See* 2 LINDEY, *supra* note 298, at 136-37; PEARLE & WILLIAMS, *supra* note 325, § 2.15, at 2-44.

338 PEARLE & WILLIAMS, *supra* note 325, § 2.15, at 2-44.

339 Gay v. Robbins Music Corp., 38 N.Y.S.2d 337, 342 (N.Y. Sup. Ct. 1942), *cited in* NIMMER & NIMMER, *supra* note 12, § 10.11[B], at 10-97 n.11.

340 *See* 2 LINDEY, *supra* note 298, at 807.

341 The requirement of strict interpretation constitutes a restriction on alienability for two reasons. First, the requirement is more than simply a rule of narrow construction. It substantively reduces the scope of copyright transfers, by prohibiting the grant of rights with respect to means of exploitation that are unknown at the time of the making of the grant. Although such a grant is theoretically permitted if the author is given a participation in profits from such exploitation, it may be particularly difficult to arrive at an agreement as to profit participation given that the means of exploitation is unknown. Second, the requirement imposes a significant burden and obligation of foresight on parties that wish

how clearly and explicitly drafted, are deemed to be overbroad per se.

1. Strict Interpretation of Transfer Provisions

The requirement of strict interpretation of transfer provisions developed in case law and is now codified in both the French and German Copyright Acts.[342] The strict interpretation applies to both the exploitation right and the method or medium of exercising exploitation rights. Thus, an assignment of the right to reproduce a book will not be construed to imply the assignment of other exploitation rights, such as the right to distribute the book or recite it in public. Furthermore, the assignment of the right of public performance by wireless broadcast will not be construed to imply the assignment of the right of public performance through other media, such as cable transmission or stage dramatization.

Article 30 of the French Act provides that the transfer of either the right of performance or reproduction does not imply the transfer of the other right. The Article further provides that when a contract implies total transfer of one of these rights, the effect of the transfer is limited to the methods of exploitation explicitly set forth in the contract.[343] Article 31 requires that the transfer instrument specifically describe the transferred rights and their extent, purpose, place, and duration, thus further limiting judicial ability to give a liberal interpretation to copyright transfers.[344]

The French Act contains a number of narrow exceptions to the principle of strict interpretation. For example, under Article 45, a transfer of wireless broadcasting rights includes the transfer of the right to make simultaneous cable broadcasts to the same geographical area by the same entity that is authorized to make the wireless broadcasts.[345] In addition, Article 63(1) provides that film production contracts imply the assignment to the producer of the exclusive exploitation rights of various components of the film, un-

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to effect global transfers. *See* Duncan Kennedy, *Distributive and Paternalist Motives in Contract and Tort Law, With Special Reference to Compulsory Terms and Unequal Bargaining Power*, 41 MD. L. REV. 563, 595-97 (1982) (noting that the non-disclaimability of a contract term is a relative concept, ranging from compulsory terms to requirements of a "clear statement" of waiver). Such parties must negotiate and include in the grant a specific enumeration of the transferred rights, which (at least in France) must encompass a description of the extent, purpose, place, and duration of each transferred right.

[342] André Françon, *Contractual Freedom in French Copyright*, *in* COPYRIGHT CONTRACTS 101, 108 (Herman Cohen Jehoram ed., 1977); Dietz, *supra* note 25, at FRG-50 to FRG-50.1.

[343] FRENCH ACT, *supra* note 25, art. 30. Articles 26, 27, and 28 of the French Act list the methods of exploitation for the rights of performance and reproduction. *Id.* arts. 26-28.

[344] *Id.* art. 31.

[345] *Id.* art. 45.

less otherwise stated in the contract.[346] Aside from these exceptions, the rule of narrow construction of copyright conveyances is strictly and uniformally applied in French statute and case law.[347]

German law, similarly requires strict interpretation of copyright transfers. Article 37 of the German Copyright Act provides that, in the case of doubt, the author retains certain adaptation, recording, and broadcast rights.[348] Article 37(1), for example, provides that where an author grants an exploitation license in his work, he is deemed to have reserved the publication and exploitation rights in any adaptation of the work, unless the contract unequivocally indicates otherwise.[349] On the other hand, Article 89(1) recognizes an implied assignment to film producers similar to Article 63(1) of the French Act.[350]

2. Voidance or Reformation of Overbroad Transfers

French and German law further limit the scope of copyright transfers by prohibiting gross transfers. Article 38 of the French Act forbids the transfer of the right to exploit a work in a manner unforeseen or unforeseeable at the time of transfer, unless it is explicitly set forth in the transfer instrument and the author is given a percentage of the exploitation profits.[351] In addition, Article 31 of the French Act provides that the transfer instrument must explicitly set forth each transferred right, together with the right's extent, purpose, place, and duration.[352] The Court of Cassation has recently confirmed that assignments purporting to transfer "all rights" violate the specificity requirements of Article 31 and are without any force and effect.[353]

The German Act contains parallel provisions. Article 31(4) provides that a transfer purporting to grant rights with respect to unknown means of exploitation is void.[354] Under this provision,

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346 *Id.* art. 63(1).

347 Lucas & Plaisant, *supra* note 25, at FRA-55 (citing Judgment of Feb. 4, 1975, Cass civ. 1re, 1975 Bull. Civ. I, No. 47; Judgment of May 18, 1976, Cass civ. 1re, Bull Civ. I, No. 176.

348 GERMAN ACT, *supra* note 22, art. 37.

349 *Id.* art. 37(1).

350 *Id.* art. 89(1). The implied assignment covers only technological applications known at the time of production. Judgment of Oct. 11, 1990, 22 I.I.C. 574 (1991) (holding that commercial distribution of a feature film on video cassette was an unknown use in 1968, and, therefore, not covered by the implied assignment to the producer).

351 FRENCH ACT, *supra* note 25, art. 38. This provision allows the transfer of exploitation rights in unforeseeable ways if the two conditions set forth in it are met. The Article has been criticized by French commentators for failing to apply the doctrine of strict interpretation in a sufficiently stringent manner. Françon, *supra* note 342, at 109; DESBOIS, *supra* note 112, at 641-43.

352 FRENCH ACT, *supra* note 25, art. 31.

353 Judgment of Oct. 9, 1991, Cass civ. 1re, 1991 J.C.P. II 429 (Fr.).

354 GERMAN ACT, *supra* note 22, art. 31(4).

the author must retain the exclusive right to new means of exploitation that are developed after the grant is made. The German Federal Supreme Court has broadly interpreted this statute to favor authors. It has held that uses that are not yet commercially viable in Germany at the time of the grant constitute "unknown means of exploitation" within the meaning of the provision, even if the technical possibilities of use were already known.[355]

Article 31(5) of the German Act codifies the doctrine of transfer for a specified purpose (*Zweckubertrangugstheorie*). The Article provides that unless a grant of rights specifically enumerates the methods of exploitation, the scope of the grant is determined by the purpose for which it was made. The doctrine places the burden on the transferee to show that the unenumerated rights in question are within the purpose of the grant.[356] As one commentator stated: "The copyright, so to speak, tends to remain with the author as much as possible."[357]

The application of the doctrine of transfer for a specified purpose is illustrated by the Anneliese Rothenberger case.[358] In the case a television film producer acquired the exclusive right to use a manuscript "for all purposes, including radio broadcastings, television, joint antenna broadcasting, wire broadcasting and film uses, as well as for possible uses in these fields not yet known or not yet discovered."[359] After producing and televising a film based upon the manuscript, the producer sought to market video cassettes of the film for home viewing. The Federal Supreme Court held that despite the broad wording of the grant the audiovisual exploitation rights for nonpublic use had not been transferred to the producer.[360] Referring to the rule of narrow interpretation codified in Article 31(5), the Supreme Court ruled that the grant must be limited to its objective, as determined by the aim and purpose of the contract. The Court found that the sole purpose of the contract was for the production of a television program and, therefore, the reproduction and distribution of the work on video cassettes was precluded. In reaching this conclusion, the court emphasized that Article 31(5) serves to protect the author from the unfavorable

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355 Judgment of Oct. 11, 1990, 22 I.I.C. 574 (1991). The Court also held that the Article 31(4) restriction is applicable even where an employee has transferred exclusive exploitation rights to his employer.

356 GERMAN ACT, *supra* note 22, art. 31(5).

357 Ulmer, *supra* note 118, at 216.

358 Judgment of Apr. 4, 1974, Bundesgerichtshof, 76 BGHZ 137.

359 Ernest Pakuscher, *Recent Trends of the German Copyright Law*, 23 BULL. COPYRIGHT SOC'Y 65, 70 (1975).

360 Dietz, Copyright 1980, *supra* note 317, at 129.

consequences of assigning several or all exploitation rights at once.[361]

3. United States Law

United States law contains no per se prohibition of global copyright transfers. It also contains no requirement that transferred rights be explicitly enumerated, and no limitation on grants with respect to unknown uses. Moreover, most American authorities eschew any notion that copyright grants are to be interpreted restrictively in order to protect the author. The traditional, majority view is simply that the scope of a copyright transfer is determined by general principles of contract interpretation.[362] In cases of ambiguity regarding the scope of a copyright transfer, United States courts adhering to this view determine the intent of the parties according to the language of the transfer instrument surrounding circumstances, and trade usage.[363] In the absence of any expression of intent, the principle that ambiguities are resolved against the drafter may work in favor of authors entering into standard publishing contracts and other contracts prepared by the transferee.[364] On the other hand, there appears to be a tendency, advocated by Nimmer, to construe copyright licenses liberally.[365] According to this approach, the license is not limited to expressly enumerated rights.[366] Rather, the licensee may pursue any use

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361 *Id.* *See also* Pakuscher, *supra* note 359, at 70. The appellate court rejected the author's claim that Article 31(4) voided any purported transfer of the Super-8 film cassette rights. The court ruled that the distribution of film in this format did not constitute a new type of use. Judgment of Sept. 21, 1972, Oberlandesgericht, 72 OLGZ 6, *discussed in* Dietz, *Letter from the Federal Republic of Germany: The Development of Case Law Under the 1965 Copyright Act*, 10 COPYRIGHT 105 (1974). Recent lower court cases applying Article 31(5) have held that a grant for "all television and film purposes" did not include the right to screen video recordings of the television broadcasts at an international air show and that a grant of the right to broadcast a work of music on the radio did not include the right to broadcast the work for advertising purposes. Dietz, *supra* note 198, at 123 (discussing Higher Regional Court of Frankfurt, Decision of Dec. 22, 1988 (video recording) and Higher Regional Court of Hamburg, Decision of Mar. 1, 1990 (radio broadcast)).

362 NIMMER & NIMMER, *supra* note 12, § 10.08, at 10-71 n.1. The single exception to this statement is the presumed limitation of scope of the transfer of rights in a contribution to a collective work, such as the grant of magazine publication rights in an article. Section 201(c) of the United States Act provides: "In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series." 17 U.S.C. § 201(c) (1988).

363 NIMMER & NIMMER, *supra* note 12, § 10.10[B], at 10-85.

364 *See id.* § 10.08, at 10-71 to 10-72, and the cases cited therein. *See also* Rey v. Lafferty, 990 F.2d 1379 (1st Cir. 1993) (narrowly construing copyright grant where license agreement was drafted by licensee and the author-licensor was not represented by counsel).

365 NIMMER & NIMMER, *supra* note 12, § 10.10 [B], at 10-86.

366 *Id.*

which may reasonably be said to fall within the medium of exploitation described in the license.[367]

The rationale for this position, as expressed by Nimmer, is that where a transfer instrument includes any ambiguous term capable of an extended meaning, "it is surely more arbitrary and unjust to put the onus on the licensee by holding that he should have obtained a further clarification of a meaning which was already present than it is to hold that the licensor should have negated a *meaning which the licensee might then or thereafter rely upon.*"[368] The burden is thus on the author to negate any possible interpretation that would expand the rights he intended to transfer, and not on the licensee to make certain that the transfer instrument explicitly includes the rights he intended to obtain.

The majority view leads to the opposite result than that reached in the Anneliese Rothenberger case. As pointed out by Nimmer, the approach of liberal construction would require that "a grant of the right to exhibit a motion picture by 'television' . . . includes any device by which the motion picture may be seen on television screens, including cable television and video cassette uses."[369] This was the result in *Platinum Record Co. v. Lucasfilm, Ltd.*,[370] which held that a grant executed in 1973 to exploit a motion picture "by any means or methods now or hereafter known" included the right to exploit by video cassettes and video discs, even though such methods of exploitation might not have been contemplated when the grant was made.[371]

In contrast to the majority view, the Ninth Circuit has recently taken the position that state law canons of contractual construction are subordinate to the federal copyright policy of protecting author rights.[372] As a result, a number of Ninth Circuit cases have enunciated the rule that copyright grants are assumed to prohibit

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367 *Id.*

368 *Id.* at 10-87 (footnote omitted). *But see Rey*, 990 F.2d at 1388 (suggesting that narrow construction may be more appropriate where licensor lacks business acumen and has no reason to know of the potential new uses).

369 NIMMER & NIMMER, *supra* note 12, § 10.10[B], at 10-87.

370 566 F. Supp. 226 (D.N.J. 1983).

371 *Id.* at 227. *See also* Bartsch v. Metro-Goldwyn-Mayer, Inc., 391 F.2d 150 (2d Cir. 1968); Landon v. Twentieth Century-Fox Film Corp., 384 F. Supp. 450 (S.D.N.Y. 1974); Rooney v. Columbia Pictures Indust., 538 F. Supp. 211, 229 (S.D.N.Y. 1982) ("Where . . . a party has acquired a contractual right which may fairly be read as extending to media developed thereafter, the other party can hardly avoid the contract's application to such media by establishing that the precise nature of the advance was not anticipated.").

372 *See* S.O.S., Inc. v. Payday, Inc., 886 F.2d 1081, 1088 (9th Cir. 1989); Cohen v. Paramount Pictures Corp., 845 F.2d 851 (9th Cir. 1988); Apple Computer, Inc. v. Microsoft Corp., 759 F. Supp. 1444, 1451 (N.D. Cal. 1991).

any use not explicitly authorized.[373] In one such case, *Cohen v. Paramount Pictures Corp.*,[374] a grant of the right to reproduce and exhibit a motion picture by "means of television" was held not to include the right to distribute videocassettes of the film. In its ruling, the court cited the fact that videocassettes had not yet been invented when the license was executed and that language in the license reserving to the author all rights not granted be construed in accordance with the purpose underlying federal copyright law.[375]

C. *No Further Transfer Without the Author's Consent*

A fundamental tenet of ownership is the right to dispose of the object of ownership at one's will.[376] Accordingly, an assignee of an object or property right is generally free to reassign it to another without having to obtain the consent of the assignor. Continental copyright law, however, generally requires that a copyright transferee obtain the author's consent before transferring all or part of a copyright to a third party.

Article 62 of the French Act provides that a publisher may not transmit the benefits of a publishing contract to a third party, other than as part of a transfer of his business, without first obtaining the author's authorization. Even the assignment of "full title" of the copyright does not accord the publisher the right to reconvey to a third party without the author's consent.[377] If the publisher does transfer his business, the author is entitled to terminate the publishing contract if that is necessary to prevent serious injury to his material interests or moral rights. Similarly, Article 44 provides that a theatrical producer holding performance rights for a work may not transfer the rights without the author's formal, written consent.[378]

Under German law, a copyright may only be transfered by way of a license to use the right, and not by assignment of the right itself.[379] It is not surprising, therefore, that the transferee must obtain the author's consent before assigning the license or granting a

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[373] *Supra* note 371. *Cf.* Amarnick, *supra* note 10 (proposing that the scope of copyright transfers should be narrowly interpreted to protect the author's interest in maintaining the work's integrity).

[374] 845 F.2d 851 (9th Cir. 1988).

[375] *Id.* at 854-55.

[376] *See* Honore, *supra* note 1, at 118-19.

[377] Judgment of June 17, 1993 (Defez v. Didier) Paris Cours d'appel, 158 R.I.D.A. 252 (1993).

[378] The French Act does not contain a provision regarding audio-visual production contracts, suggesting that exploitation rights in audio-visual works may be freely reassigned.

[379] GERMAN ACT, *supra* note 22, arts. 29, 31.

non-exclusive sublicense.[380] (However, the author may not in bad faith refuse to give such consent; and, no consent is required if the license is assigned as part of a sale of the licensee's business.)[381] As in France, the author cannot give a blanket consent to reassignment in advance.[382] The German Federal Supreme Court invalidated a clause in the standard copyright license contract of a broadcasting organization which purported to authorize the reassignment of the licensed rights without the consent of the author.[383]

United States copyright law imposes no restriction on subsequent copyright assignments, although, under general principles of law, a copyright licensee may not transfer his right to use a work without the consent of the licensor. A couple of cases have held that an owner of a copyright may rely upon a negative covenant to restrict the use of the work in the hands of a remote assignee.[384] But other cases have held that a remote assignee is not bound under a covenant restricting or forbidding transfers unless he had actual or constructive knowledge of the covenant.[385] In any event, it is unclear whether a covenant purporting to restrict further assignments without the author's consent would be enforceable.

D. *Future Works*

Publishers and other copyright grantees often seek to acquire rights in the author's subsequent works. From the grantee's perspective this represents a legitimate claim, given the grantee's efforts to build an audience for the author's prior work.[386] Continental law, however, seeks to protect the author's interest in his future production by restricting the transfer of future works. These restrictions serve to protect the author's material interests by preventing a young author's wholesale transfer of future rights at a time when he has little or no bargaining power.[387] In addition,

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380 *Id.* arts. 34, 35. Consent is not required to grant a nonexclusive sublicense when the exclusive license is granted merely to safeguard the author's interests. An example of such a situation is a grant to an authors' collection society. *Id.* art. 35(1). In addition, the author's consent is not required for the assignment of an exclusive license or the grant of a non-exclusive license of various rights to exploit a cinematographic work. *Id.* art. 90.

381 *Id.* arts. 34(1), 34(3).

382 *Id.*

383 *See* Judgment of Feb. 18, 1981, Bundesgerichtshof, 82 BGHZ 81, *discussed in* Dietz, Copyright 1984, *supra* note 312, at 458.

384 *See* Capital Records v. Mercury Records Corp., 221 F.2d 657 (2d Cir. 1955) (stated with respect to common law copyright under New York law); *In re* Waterson, Berlin & Snyder Co., 48 F.2d 704 (2d Cir. 1931).

385 *See* NIMMER & NIMMER, *supra* note 12, § 10.12, at 10-101 and the cases cited therein.

386 *See* PEARLE & WILLIAMS, *supra* note 325, at 70.

387 Lucas & Plaisant, *supra* note 25, at FRA-55; Dietz, *supra* note 25, at FRG-59 to FRG-60.

Continental commentators point out that an author's long-term obligation to produce books for a particular publisher, or a painter's commitment to produce paintings for a particular dealer, runs counter to the creator's personal interest in determining when and how his work is communicated to the public.[388] Gierke argued that the global assignment of all future works, including works of a specific type, constitutes an illegal limitation on the development of the author's personality.[389] Allfeld held that global transfers are subject to voidance under Section 138 of the German Civil Code, which provides that any agreement contrary to good morals has no obligatory force. He posited that "undue restrictions on personal liberty" resulting from such transfers could amount to an injury to good morals within the meaning of the statute.[390] Strömholm maintains that an author's obligation concerning future production restricts his "right to create," a right rooted in moral rights and other doctrine.[391]

Article 33 of the French Act provides that transfer of all rights in future works is voidable by the author.[392] The rule applies whenever there is a conveyance of the entire copyright in two or more future works.[393] Some commentators maintain that the Article is also applicable to the conveyance of less than the entire copyright in future works.[394] An author may grant a preferential right to a publisher for the publication of his future works of a clearly specified kind.[395] However, the publisher's right must be limited to five new works of the specified kind, or to the works the author may produce within a term of five years from the date of signature of the publishing contract.[396] A clause conveying a preferential right to a publisher that does not contain one of those two limitations is voidable by the author.[397]

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388 STRÖMHOLM, *supra* note 79, at 127.

389 *Id.* at 132.

390 *Id.* at 133.

391 *Id.* at 356.

392 The Article states that the "[t]otal transfer of future works is void." FRENCH ACT, *supra* note 25, art. 33. However, since only the author can invoke the statute, the total transfer is not void ab initio. Lucas & Plaisant, *supra* note 25, at FRA-55.

393 Lucas & Plaisant, *supra* note 25, at FRA-55.

394 Françon, *supra* note 342, at 106.

395 FRENCH ACT, *supra* note 25, art. 34. French courts have invalidated clauses granting a preferential right to "works of prose" on the grounds that the designation of the type of work is not sufficiently narrow and precise. André Françon, *Recent French Jurisprudence Concerning Publishers' Contracts*, *in* COPYRIGHT CONTRACTS 5, 9 (Herman Cohen Jehoram ed., 1977).

396 FRENCH ACT, *supra* note 25, art. 34.

397 Lucas & Plaisant, *supra* note 25, at FRA-57 (citing Judgment of July 8, 1972, 624 J.C.P. II, No. 17566, at 73); Françon, *supra* note 395, at 11 (citing Judgment of Jan. 31, 1970, Trib. gr. inst., 64 R.I.D.A. 176). In addition, when the publisher has successively refused two new

The German Act is somewhat less restrictive of the transfer of future works. A license of future works is permitted, but any license of unspecified future works may be terminated by either party after a period of five years from the date of the agreement.[398] Where the nature of the future works is not specified in detail, the license agreement must be in writing.[399] A transfer of future works for which the author received inadequate consideration may be voided by the author on general contract grounds.[400]

To understand their full import, the future works restrictions must be read in conjunction with the moral right of disclosure. The former voids contractual commitments for the transfer of future works that exceed the statutory limitations regarding duration and specificity. The latter gives the author a limited right to renege even upon contractual commitments that fall within the statutory limitations. Where the author fails to produce a commissioned work as a result of good faith lack of inspiration, he is simply excused from performance and absolved from liability. Where he produces but refuses to deliver the work or its copyright to the second party, he is still excused from specific performance, but must compensate the second party for injury and refrain from effecting a transfer to a third party without first offering the work to the second party. Ultimately, the author cannot be required to hand over his work to a publisher whose views, reputation, or manner of promotion he has come to find objectionable. At the same time, within the statutory restrictions designed to protect authors' personal and material interests, transferees may obtain some redress for the thwarting of legitimate contractual expectations.

The U.S. Copyright Act does not address the transfer of works that have yet to come into existence. As a result, courts in this country have looked to contract law to determine the enforceability of future works agreements. American case law in this area views such agreements as containing elements of both a sale of goods and a personal service contract. It reflects the view of copyright as property, tempered in part by a certain judicial reluctance

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works of the specified kind, the author may terminate the publisher's preferential right to that kind of work as long as he refunds any advances he received from the publisher for such works. FRENCH ACT, *supra* note 25, art. 34.

398 GERMAN ACT, *supra* note 22, art. 40. The provision would also appear to apply where a publisher is given a preferential right to acquire the license for each work. STRÖMHOLM, *supra* note 79, at 125-27.

399 GERMAN ACT, *supra* note 22, art. 40.

400 Hillig, *supra* note 316, at 129. Section 138 of the Civil Code (Bürgerliches Gesetzbuch) provides for the voiding of contractual provisions which run counter to prevailing moral standards. *Id.* *See also* STRÖMHOLM, *supra* note 79, at 133-35.

to order specific performance of personal service commitments.[401]

At common law a vendor cannot transfer by present sale a thing that he does not own, even though he expects to acquire it. But, as noted by the Second Circuit in *T.B. Harms & Francis, Day & Hunter v. Stern*,[402] if a future work of authorship has been transferred, then like a vendor's sale of a future acquisition, the equitable title to the property attaches and vests in the grantee the moment the work comes into existence.[403] As a general rule, therefore, the grantee may require by specific performance the assignment of the author's interest in the work immediately upon its completion. At the same time, however, as further noted by the court in *T.B. Harms*, an author's agreement to give, in exchange for a present consideration, an exclusive right in all works that he might produce at any time in the future in exchange might be void as contrary to public policy.[404] This possible flaw would be cured if the author's obligation were sufficiently limited in time or by category or, conceivably, if the author were paid a royalty, rather than lump sum, so as not to erode his incentive to produce.[405]

U.S. courts have issued injunctions prohibiting authors who have undertaken to provide future works for a given party over a given period of time from providing those works to another person during that period.[406] However, such injunctions have issued only where the author's services are of a unique or extraordinary quality, such as where the author is particularly talented or well-known in relevant field.[407]

Finally, an author may be able to revoke a commitment to supply future works for an unlimited period. In some states a contract that is of indefinite duration may be terminable at will by either party. The Ninth Circuit, however, has recently held that California's terminable-at-will rule as applied to copyright licenses is preempted by the Copyright Act.[408] The court ruled that, absent a material breach on the part of the licensee, an author-licensor may terminate a copyright license only in accordance with Section 203

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401 *See* NIMMER & NIMMER, *supra* note 12, § 10.03[A], at 10-36. *See also* Paige v. Banks, 80 U.S. (13 Wall.) 608 (1871) (holding that the right to publish an uncreated manuscript is a *fully assignable property right*). *But see* Associated Newspapers v. Phillips, 294 F. 845 (2d Cir. 1923) (holding that a journalist's agreement to furnish a newspaper with six articles per week is an employment contract, and not a contract for the sale of the articles).

402 229 F. 42 (2d Cir. 1915), *vacated on other grounds*, 231 F. 645 (2d Cir. 1916).

403 *Id.* at 48.

404 *Id.*

405 *Id.*

406 Associated Newspapers v. Phillips, 294 F. 845 (2d Cir. 1923).

407 *Id.* at 850; Kenner v. Simonds, 247 F. 822, 828 (S.D.N.Y. 1917).

408 Ramo v. Sipa Press, Inc., 987 F.2d 580 (9th Cir. 1993).

of the Act, which provides for author termination of a copyright grant at the close of 35 years following the grant.[409]

In sum, United States authors may be required, with certain limitations, to transfer their rights in their work or, alternatively, to refrain from realizing their rights altogether. Where these limitations are exceeded, author commitments to deliver as yet uncreated works are unenforceable.

VI. Conclusion

In contrast to the virulent personalist core of Continental autonomy inalienabilities, the United States analogues amount to a patchwork of legal doctrines designed to protect a variety of personal and economic interests, some pertaining to the author, some to whomever may be the copyright owner, and some to the public at large. It is not surprising, therefore, that Continental authors enjoy a measure of continuing control over whether, in what form, and through which agency their work is to be presented to the public that has no parallel in the United States. As opposed to their American colleagues, Continental authors may not be required to countenance, despite purported contractual obligations to the contrary, (1) the publication or continued dissemination of their work, (2) the public presentation of their work in a manner that significantly contradicts their artistic conception, regardless of its effect upon their reputation, (3) authorship attribution in a manner that does not accord with their wishes, (4) the failure of the exploitation right transferee to promote the work in accordance with statutory requirements, (5) the global transfer of all exploitation rights, (6) the exploitation right transferee's retransfer of the work, or (7) the unlimited transfer of future works, even if the author is to receive an additional payment for each work. In addition, in contrast to the majority view in the United States, the terms of Continental authors' exploitation rights grants are narrowly construed so as to maintain author control to the extent possible. To be sure, the exploitation rights of Continental authors are subject to a requirement of good faith and a certain accommodation to competing interests. However, even taking this into account the legal results from the application of United States analogues reach only a diminutive approximation of their Continental counterparts.

Moreover, the meaning of Continental autonomy inalienabilities cannot be measured solely by their legal result. The existence of a cohesive legal doctrine of author autonomy and personal con-

409 *Id.* at 585-86.

nectedness to one's original works promotes a very different conception of creative expression than does a proprietary copyright system. Legal rules help to determine the way we talk and think *about ourselves, our possessions, attributes and community.*[410] Thus, even if the United States analogues were to approximate similar legal results at this point in time, their overall social effect—and ultimate legal result—would vary substantially from that of Continental autonomy inalienabilities.

This conclusion does not necessarily mean that we should refrain from adopting autonomy inalienabilities in this country. The systematic implementation of such alienability restrictions would clearly entail a radical revision of our conception of creative expression. It would require that we view authors' works less as a market good and more as a constitutive part of personality.[411] At the same time, however, the Continental experience suggests that a significant decommodification of creative expression is possible even within the framework of a market society and need not prevent the widespread dissemination and commercial exploitation of authors' works.

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[410] *See* Cass Sunstein, *Legal Interference with Private Preferences*, 53 U. CHI. L. REV. 1129, 1146 (1986) ("It is hard to imagine a preference not shaped in part by legal arrangements.").

[411] I have argued elsewhere that such a radical revision would better serve the interests of individual self-realization and diversity of expression than the current American proprietary copyright regime. *See* Neil Netanel, *Copyright Alienability Restrictions and the Enhancement of Author Autonomy: A Normative Evaluation*, 24 RUTGERS L.J. 347 (1993).