

Lanham Act Protections Afforded Artistic Work (Gilliam v. American Broadcasting Co.)

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COPYRIGHT LAW

LANHAM ACT PROTECTIONS AFFORDED ARTISTIC WORK

Gilliam v. American Broadcasting Co.

Encouragement of the arts by protection of the economic incentives for artistic creation has always been the primary function of American copyright law.¹ Accordingly, the remedies available under the Copyright Act² are directed toward the prevention and redress of economic loss suffered by the copyright holder.³ Since the artist's "moral right"⁴ to claim authorship of his work and to prevent altera-

¹ The Constitution authorizes Congress to establish copyrights "[t]o promote the Progress of Science and useful Arts . . ." U.S. CONST. art. I, § 8. In the Copyright Act, 17 U.S.C. §§ 1-216 (1970 & Supp. V 1975), Congress sought to accomplish this purpose by giving a "bonus" to authors and inventors by allowing them to control the sale and use of their works. See H.R. REP. NO. 2222, 60th Cong., 2d Sess. 6-7 (1909); *Goldstein v. California*, 412 U.S. 546, 555 (1973), discussed in Comment, *Goldstein v. California: Breaking Up Federal Copyright Preemption*, 74 COLUM. L. REV. 960 (1974). It is clear, however, that this reward ultimately was intended to benefit not the author, but the public. H.R. REP. NO. 2222, 60th Cong., 2d Sess. 7 (1909).

² 17 U.S.C. §§ 1-216 (1970 & Supp. V 1975). It should be noted that in 1976 Congress extensively revised the Copyright Act, Pub. L. No. 94-553, 90 Stat. 2541 (effective Jan. 1, 1978) (codified at 17 U.S.C.A. §§ 101-810 (Supp 1976)).

³ Among the remedies available under the Copyright Act are: money damages for infringement of both common law and statutory copyright; an injunction to restrain further violations; an order requiring the articles alleged to infringe the copyright be impounded, and upon a judicial finding of infringement, be destroyed; and finally, an award of costs and attorney's fees. 17 U.S.C. §§ 101, 116 (1970 & Supp. V 1975). For an exhaustive discussion of these remedies, see 2 M. NIMMER, COPYRIGHT §§ 150-61 (1976) [hereinafter cited as NIMMER].

⁴ In Europe, an artist's personal rights are protected under the theory of moral right. This theory includes, in the broadest sense

the right to create and to publish in any form desired, the creator's right to claim the paternity of his work, the right to prevent every deformation, mutilation or other modification thereof, the right to withdraw and destroy the work, the prohibition against excessive criticism and the prohibition against all other injuries to the creator's personality.

Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors, and Creators*, 53 HARV. L. REV. 554, 556 (1940) (footnotes omitted) [hereinafter cited as Roeder]. Of these rights, the right to prevent unconsented to alterations of the work and the right to claim paternity are probably the most important. See Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1540-41 (1972). Moral rights are personal, not property rights, and may be waived but not assigned. Roeder, *supra*, at 564. These rights survive the death of the creator of the work and may be enforced by his estate or family, thus protecting his reputation for the benefit of his descendants, and, more importantly, protecting the work as part of a society's cultural heritage. *Id.* at 574-75.

The Berne Convention for the Protection of Literary and Artistic Works, an international agreement which protects the rights of paternity and integrity, has been ratified by 65 nations. Berne Convention for the Protection of Literary and Artistic Works (1971) [hereinafter

tion which may prejudice his reputation is not expressly protected by the Copyright Act, courts have utilized such diverse theories as defamation and libel,⁵ unfair competition,⁶ privacy,⁷ and contract⁸ to fashion appropriate remedies. Following this ad hoc approach, the Second Circuit, in *Gilliam v. American Broadcasting Co.*,⁹ held that an artist who claims that unauthorized editing of a television script impairs the integrity of his work may state a cause of action under the Lanham Act (the Act),¹⁰ a federal trademark statute. In so holding, the court appears to have expanded the reach of the Act to protect the artistic work itself, interpreting the statute as forbidding not only misdescription of authorship, but also the actual dissemination of the work in a substantially altered form.

The plaintiffs in *Gilliam*, a group of British writers and per-

cited as Berne Convention]. For a discussion of the Berne Convention and the moral right approach to copyright law in general, see 1 NIMMER, *supra* note 3, § 110; notes 38-43 and accompanying text *infra*.

⁵ See, e.g., *D'Altomonte v. New York Herald Co.*, 154 App. Div. 453, 139 N.Y.S. 200 (1st Dep't), *modified*, 208 N.Y. 596, 102 N.E. 1101 (1913), *discussed in* Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1548 n.55 (1972). In *D'Altomonte*, the court found that attributing to plaintiff, a respected author and lecturer, a news article not written by him, gave rise to a cause of action for libel. 208 N.Y. at 597, 102 N.E. at 1101.

⁶ See, e.g., *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass. 1939), *discussed in* Roeder, *supra* note 4, at 567-68. The *Prouty* court found that "if the defendant had appropriated, without plaintiff's consent, the plot and principal characters of [plaintiff's] novel, and that the use being made of her literary production was such as to injure the reputation of the work and of the author," relief would be available under the doctrine of unfair competition. 26 F. Supp. at 266.

⁷ The right to privacy encompasses the right to protect oneself from being misrepresented to the public. Arguably, mutilation of a work of art may have an adverse impact not only on the work itself but also on the public's attitude toward the artist. See, e.g., *Williams v. Weisser*, 273 Cal. App. 2d 726, 78 Cal. Rptr. 542 (Dist. Ct. App. 1969) (unauthorized publication of lecture notes with plaintiff's name may jeopardize his professional standing and constitute an invasion of his privacy). The assertion of a right to privacy affords limited protection, however, since the right attaches only to those who are not public figures, and the cause of action does not survive the death of the artist. See Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1548-50 (1972). In contrast, moral rights do survive the death of the artist. See note 4 *supra*.

⁸ See, e.g., *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952) (sale of abbreviated recordings of plaintiff's music constituted breach of contract).

⁹ 538 F.2d 14 (2d Cir. 1976).

¹⁰ 15 U.S.C. §§ 1051-1127 (1970 & Supp. V 1975). Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1970) provides in pertinent part:

Any person who shall affix, apply, or use in connection with any goods or services, . . . a false designation of origin, or any false description or representation, . . . and shall cause such goods or services to enter into commerce, . . . shall be liable to a civil action by any person . . . who believes that he is or is likely to be damaged by the use of any such false description or representation.

formers doing business under the name Monty Python, had contracted with the British Broadcasting Company (BBC) to prepare the scripts for a comedy series entitled "Monty Python's Flying Circus."¹¹ The contract gave the writers a high degree of control over any changes made in the script,¹² and reserved to Monty Python all rights in their work not otherwise given to BBC. Additionally, BBC had authority under the agreement to license the broadcast of recordings "in overseas territories."¹³ In July 1975, Time-Life Films, which had acquired rights to distribute Monty Python programs in the United States, arranged for the broadcast of the programs by the American Broadcasting Company (ABC). Previously, programs in the series had been shown in this country as originally recorded without commercial interruption, both on public television and, to a limited extent, on commercial television. Monty Python and BBC apparently assumed that ABC also would broadcast the programs in their entirety.¹⁴ The first of the ABC broadcasts, however, was severely edited to allow for commercials and eliminated material ABC considered offensive or obscene by American standards.¹⁵

After a series of negotiations failed to resolve the dispute, Monty Python sought a preliminary injunction against the second ABC edited show 11 days prior to its scheduled broadcast. Although

¹¹ 538 F.2d at 17.

¹² The pertinent portion of the BBC-Monty Python agreement stated: When script alterations are necessary it is the intention of the BBC to make every effort to inform and to reach agreement with the Writer. . . . [N]ecessary alterations . . . shall be made by the Writer. . . . [T]he BBC shall not without the consent of the Writer or his agent . . . make any structural alterations as opposed to minor alterations

Id. at 17 n.2.

¹³ *Id.* at 17. Pursuant to BBC's licensing authority, Time-Life was granted the rights to distribute Monty Python programs in the United States. *Id.* at 17-18. The agreement between BBC and Time-Life authorized Time-Life "to edit the programs only 'for the insertion of commercials, applicable censorship or governmental . . . rules and regulations, and National Association of Broadcasters and time segment requirements.'" *Id.* at 18. Although the court's opinion does not indicate the substance of the ABC agreement with Time-Life, presumably ABC was also permitted to edit for commercial or censorship reasons. In comparing the BBC-Monty Python contract with these later agreements, the court noted that BBC had granted to Time-Life a power to make unilateral changes, a right which it did not possess. *Id.* at 21.

¹⁴ *Id.* at 18. ABC had once before tried to acquire broadcast rights to Monty Python programs, but the group rejected the proposed format, which would have included only excerpts of various shows. *Id.* ABC's later contract with Time-Life provided that ABC would broadcast two 90-minute specials each containing three 30-minute Monty Python programs. The group's representative, seemingly aware that the scheduling allowed no time for commercials, sought reassurances from BBC as to ABC's plans. BBC replied, "we can only reassure you that ABC have [*sic*] decided to run the programmes "back to back," and that there is a firm undertaking not to segment them." *Id.*

¹⁵ *Id.* at 18.

the district court found that the plaintiffs' work had been impaired and that the injury was irreparable,¹⁶ Judge Lasker declined to issue a preliminary injunction. The court believed that the factors favoring issuance of a temporary injunction were outweighed by the probable harm to ABC were the program to be enjoined on such short notice. In denying the injunction, Judge Lasker was also influenced by the existence of a serious question as to the ownership of the copyright in the recorded programs.¹⁷

On appeal, Judge Lumbard, speaking for the court in an opinion filed several months after broadcast of the program originally sought to be enjoined, agreed that the equities favored the plaintiff, and directed the issuance of a preliminary injunction against any further broadcasts.¹⁸ Examining the likelihood of damage to Monty

¹⁶ *Id.* After viewing the programs, District Judge Lasker concluded that plaintiffs' work had been impaired since, in addition to the substantial amount of cutting, the editing had "caused the film or program . . . to lose its iconoclastic verve." *Id.* The district court's decision was delivered in an unreported, oral opinion.

¹⁷ *Id.* at 18-19. The district court, in denying the preliminary injunction, also observed that the plaintiffs had exhibited "a somewhat disturbing casualness" in not seeking an injunction until 11 days before the scheduled broadcast. *Id.* at 18, 25. Interpreting this remark as implying that the plaintiffs were guilty of laches, the Second Circuit found that circumstances justified Monty Python's delay in seeking relief. *Id.* at 25. In particular, the court noted that Monty Python was not aware of the editing until late November, when the group viewed a tape of the first program. Negotiations between the parties in early December further delayed the bringing of suit. Consequently, the court found that there was no undue delay. Moreover, the Second Circuit indicated that ABC had not demonstrated prejudice arising from any delay in the group's actions. *Id.* For a copyright infringement case in which a two-month delay in seeking relief, while defendant incurred substantial promotional expenses, was a factor considered by the court to justify denying plaintiffs' application for an injunction, see *Jaeger v. American Int'l Pictures, Inc.*, 330 F. Supp. 274, 281 (S.D.N.Y. 1971).

The district court in *Gilliam* also denied relief because it was unclear whether BBC and Time-Life were indispensable parties. 538 F.2d at 18, 25. The Second Circuit rejected the contention that BBC had to be joined because it owned the copyright in the recorded program, stating that all the owners of a copyright need not be joined as parties. *Id.* at 25-26; *accord*, *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 268 (2d Cir. 1944); *Jaeger v. American Int'l Pictures, Inc.*, 330 F. Supp. 274 (S.D.N.Y. 1971); *Famous Music Corp. v. Maholias*, 53 F.R.D. 364 (E.D. Wis. 1971). Rather, equitable considerations should determine in all instances whether a party is indispensable. 538 F.2d at 26. For rules governing joinder of parties in copyright cases, see R. NORDHAUS, PATENT, TRADEMARK AND COPYRIGHT INFRINGEMENT §§ 96-99 (1971). In *Gilliam*, the Second Circuit concluded that neither BBC nor Time-Life were indispensable since complete relief could be rendered between the parties before the court. Further, the danger of inconsistent verdicts against ABC could be avoided through the use of impleader. Finally, neither BBC nor Time-Life had claimed an interest in the litigation. 538 F.2d at 25-26.

¹⁸ 538 F.2d at 26. *Hamilton Watch Co. v. Benrus Watch Co.*, 206 F.2d 738 (2d Cir. 1953), outlines the standards to be followed by a court in considering an application for a preliminary injunction. The plaintiff must show some chance of success on the merits—"it will ordinarily be enough that the plaintiff has raised questions going to the merits so serious, substantial, difficult and doubtful, as to make them a fair ground for litigation and thus for

Python if an injunction were denied, the Second Circuit held that the district court's finding of irreparable harm was not clearly erroneous. Since Monty Python's work was not widely known in this country, the nationwide broadcast of a program which "misrepresented the quality of [their] work"¹⁹ would clearly cause irreparable damage to the group's professional reputation.²⁰ The court then declared that the injunction would not impose sufficient hardship on ABC to justify its denial. Noting that the ABC show had not been scheduled for rebroadcast, the court found that at the time of the appeal the possibility of a significant financial loss or adverse effect on ABC's relations with its affiliates was minimal.²¹ Finally, the court determined that there was a substantial likeli-

more deliberate investigation." *Id.* at 740 (footnote omitted). Next, "[t]he judge must consider whether irreparable harm is likely to result to [the] plaintiff if . . . the injunction is denied . . ." *Id.* at 743. Finally, the injury to the plaintiff must be balanced against "the harm to [the] defendant likely to result if the relief is granted." *Id.* For applications of these standards, see *Jaeger v. American Int'l Pictures, Inc.*, 330 F. Supp. 274 (S.D.N.Y. 1971); *Consumers Union of United States, Inc. v. Theodore Hamm Brewing Co.*, 314 F. Supp. 697 (D. Conn. 1970).

¹⁹ 538 F.2d at 19.

²⁰ *Id.* The damage to the group's professional reputation was deemed irreparable since money damages could not adequately compensate the plaintiffs for the loss of a large audience. This audience loss, in turn, might seriously undermine the group's future plans for distributing new shows in this country. Typical examples of irreparable harm involve producers of well-known products claiming damage to their reputation in the market. For instance, in *Estee Lauder, Inc. v. Watsky*, 323 F. Supp. 1064 (S.D.N.Y. 1970), an injunction was granted against cosmetic retailers who had sold imitations of Estee Lauder products. Interestingly, the source of the counterfeit packages had not been pinpointed, and the judge agreed with the retailer's claim that it was all but impossible to distinguish counterfeit from the genuine product. *Id.* at 1066. Nevertheless, the court concluded:

[T]he counterfeits are so nearly identical to the true that the public will without question be led to believe that the spurious item is the real.

Lauder's name and reputation as a manufacturer of quality cosmetics . . . is altogether at stake as long as the spurious packages and products circulate in the market.

Id. at 1067.

Similarly, in *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972), a preliminary injunction was granted against the manufacturer and distributor of a poster which, in the well-known script letters of the Coca-Cola trademark, read "Enjoy Cocaine." Unlike the *Estee Lauder* case, the difference between the products was apparent. The court ruled, however, that the trademark was so uniquely identified with Coca-Cola products, and the probability of confusion as to origin so high, as to make out the requisite showing of irreparable harm. *Id.* at 1189-90.

²¹ Monty Python had sought the preliminary injunction only 11 days before the broadcast scheduled for December 26. The difficulty inherent in a last minute change of programming plus the loss ABC would have suffered after having spent substantial amounts for advertising convinced the district court to deny the injunction. On appeal, the Second Circuit found that after the December 26th broadcast the possibility of injury to ABC was speculative. 538 F.2d at 19.

hood that Monty Python would succeed on the merits on both the copyright infringement and Lanham Act claims.²² Discussing the alleged copyright infringement, the court noted that the editing had been both substantial,²³ involving twenty-seven percent of the original show, and in contravention of Monty Python's contractual rights.²⁴ Focusing on the question of ownership of the copyright in the recorded program, the Second Circuit agreed with the plaintiffs that the issue need not be resolved since the program was merely a derivative work²⁵ based on the group's script, the copyright of which was undisputed.²⁶ The court reasoned that one who utilizes a deriva-

²² *Id.* at 19.

²³ The *Gilliam* court recognized that some editing might be permissible in order to allow for the different standards of taste of American audiences, but noted that express contractual provisions will limit such rights. *Id.* at 23. See note 29 *infra*.

²⁴ 538 F.2d at 19.

²⁵ Section 7 of the Copyright Act, 17 U.S.C. § 7 (1970), provides in part:

Compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title

Although the statute uses the words "new works," "derivative work" has been preferred as the more accurate term. 1 NIMMER, *supra* note 3, § 39, at 165-66. A derivative work has been defined as a composition that "would be considered an infringing work" if the copyright proprietor of the underlying work had not consented to the use of his copyright material. *Id.*, at 167. As the *Gilliam* court noted, the copyrighting of the derivative work does not deprive the underlying work of its copyright protection. 538 F.2d at 20, *citing* Grove Press, Inc. v. Greenleaf Publishing Co., 247 F. Supp. 518 (E.D.N.Y. 1965). Thus, the underlying work's copyright may be infringed by an unauthorized use of the derivative work. See note 27 *infra*.

²⁶ 538 F.2d at 19. Ownership of a copyright, be it common law or statutory, is one of the elements that must be established to make out a claim of infringement. 2 NIMMER, *supra* note 3, § 141. Since ABC did not challenge Monty Python's assertion of a common law copyright in the script, the *Gilliam* court did not rule on the issue. 538 F.2d at 19-20 n.3. A common law copyright, however, only protects works that have not been published. 1 NIMMER, *supra* note 3, § 11.2. Whether broadcast of the programs by ABC constituted a publication of the script with the concomitant loss of common law copyright protection was a question left to the lower court on remand. 538 F.2d at 20 n.3.

One author has described the common law copyright as follows: "Upon the creation of a song, a book, a play or a painting, to name but a few examples, the creator possesses an intangible property right, usually referred to as a common law copyright." S. ROTHENBERG, LEGAL PROTECTION OF LITERATURE, ART AND MUSIC § 1 (1960). Common law copyright includes the right to withhold one's creation from the world indefinitely, but it does not include complete ownership of the work. Such ownership implies that the owner "may use his property in a reasonable manner without fear of strangers safely making similar use of it for their own profit or to his detriment." *Id.* But reasonable use of a work covered by common law copyright results in loss of the right, since upon publication the work "falls into the public domain . . . [and is] freely available to everyone." *Id.* It is at this point that common law copyright protection ceases and the statutory scheme comes into play. Until publication, however, statutory copyright law normally has no application. See 1 NIMMER, *supra* note 3, § 93.1.

tive work runs the risk of infringing on the underlying work if his use of the program exceeds the license originally granted by the proprietor of the copyright of the underlying work.²⁷ Although this rationale is most often applied where a licensee exceeds contractual time and media restrictions,²⁸ the copyright holder's right to control his work is similarly violated when contractual provisions restricting editing are exceeded. Stating that ABC's defenses did not seem "meritorious at this stage of the litigation,"²⁹ the court concluded that there was a substantial probability that plaintiffs would succeed at trial.³⁰

Although this showing of a copyright infringement claim was sufficient in itself to support the issuance of a preliminary injunc-

²⁷ 538 F.2d at 20. The *Gilliam* court relied on *Davis v. E.I. DuPont de Nemours & Co.*, 240 F. Supp. 612 (S.D.N.Y. 1965), a case involving a dramatization of Edith Wharton's famous novel, *Ethan Frome*. The *Davis* court held that a television script, based on a screenplay which in turn was based on another play, infringed the copyright of the underlying play. *Id.* at 632; *accord*, *Wihtol v. Crow*, 309 F.2d 777 (8th Cir. 1962) (unauthorized use of 1944 version of plaintiff's song infringement of underlying 1935 copyright); *Grove Press, Inc. v. Greenleaf Publishing Co.*, 247 F. Supp. 518 (E.D.N.Y. 1965) (copying uncopyrighted translation infringes copyrighted original novel).

²⁸ *See, e.g.*, *Rice v. American Program Bureau*, 446 F.2d 685 (2d Cir. 1971) (right to license nondramatic performances of songs does not include right to license production of entire rock opera); *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150 (2d Cir.), *cert. denied*, 393 U.S. 826 (1968) (production on television not a violation of media restriction when right to copyright, adapt, and exhibit given); *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469 (2d Cir.), *cert. denied*, 342 U.S. 849 (1951) (grant of motion picture rights limited to term of book's copyright absent a right to renew).

²⁹ 538 F.2d at 21. ABC first contended that Monty Python had ratified BBC's grant of editing privileges to ABC. The court rejected this argument, remarking that Monty Python's representatives had continually sought assurances that the program would not be edited. *Id.* at 21-22.

Alternatively, ABC argued that the program was a joint work of BBC and Monty Python. *Id.* at 22. Because joint authors own a work in undivided shares and may license it without each other's permission, a finding that the program was a joint work necessarily would recognize the right of BBC to grant unlimited editing rights to ABC. *See* 1 NIMMER, *supra* note 3, §§ 67-68. Interpreting the terms of the contract as clearly reserving to Monty Python superior rights in the script, the court refused to accept this argument. 538 F.2d at 22. *Cf. Szekeley v. Eagle Lion Films, Inc.*, 242 F.2d 266 (2d Cir.), *cert. denied*, 354 U.S. 922 (1957) (contract terms negate finding of joint authorship).

Finally, the court turned to ABC's claim that Monty Python had impliedly consented to the editing. It is generally agreed that the parties to a licensing agreement are deemed aware of and incorporate into their agreement prevailing industry practices, such as cutting and editing for television. *See Autry v. Republic Prods., Inc.*, 213 F.2d 667, 669-70 (9th Cir.), *cert. denied*, 348 U.S. 858 (1954). Courts, however, have always recognized the right to contract otherwise. *See, e.g.*, *Preminger v. Columbia Pictures Corp.*, 49 Misc. 2d 363, 267 N.Y.S.2d 594 (Sup. Ct. N.Y. County), *aff'd mem.*, 25 App. Div. 2d 830, 269 N.Y.S.2d 913 (1st Dep't), *aff'd mem.*, 18 N.Y.2d 659, 219 N.E.2d 431, 273 N.Y.S.2d 80 (1966). The *Gilliam* court declared that both the restrictive terms of the Monty Python agreement and the group's continual objections to any editing militated against a finding of implied consent.

³⁰ 538 F.2d at 21.

tion, the court then discussed the plaintiffs' claim that ABC had violated section 43(a) of the Lanham Act³¹ by identifying plaintiffs as authors of what was in fact a "mere caricature" of their work.³² Acknowledging that this cause of action for mutilation is derived from the moral right theory which is not embodied in the Copyright Act, Judge Lumbard nevertheless reasoned that artists, due to their financial dependence on the public, must be afforded protection against mutilation of their works if the economic protection of the Copyright Act is to be meaningful.³³ To achieve this end, the court found a probable violation of the Lanham Act's prohibition against misrepresentations damaging to one's business or personal reputation. Moreover, the Second Circuit declared that plaintiffs, upon establishing an actionable mutilation, may be entitled to a permanent injunction, and not merely a legend disassociating themselves from the program.³⁴

The *Gilliam* court's recognition that mutilation of a work may result in a misrepresentation violative of the Lanham Act is novel.³⁵ More importantly, the suggestion that a permanent injunction might issue to prevent all further use of the work constitutes an expansive interpretation of the remedies available under the Act.³⁶

³¹ 15 U.S.C. § 1125(a) (1970), quoted in note 10 *supra*.

³² 538 F.2d at 25.

³³ *Id.* at 24.

³⁴ *Id.* at 25 n.13.

³⁵ Traditionally, the Lanham Act has governed only trademarks. A trademark is a word or symbol adopted by a merchant to point out the origin or ownership of a product and to enable the public to distinguish the products of one merchant or manufacturer from those of another. See A. SEIDEL, S. DUBROFF, & E. GONDA, 1 TRADEMARK LAW AND PRACTICE §§ 1.01-.11 (1963). Typically, cases under the Act have concerned two similar products with similar names, the existence of which creates the possibility that consumers will think both originated from the same source. See, e.g., *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Chandris America Lines, Inc.*, 321 F. Supp. 707 (S.D.N.Y. 1971) ("The Greatest Show on Earth" describing circus and "The Greatest Show on Earth Isn't" describing cruise); *Sterling Prods. Co. v. Crest Mfg. Co.*, 314 F. Supp. 204 (E.D. Mich. 1970) "Litter Basket" and "Litter Bin"). Mislabeling of products is another source of much litigation under the Act. See, e.g., *Paddington Corp. v. Major Brands, Inc.*, 359 F. Supp. 1244 (W.D. Okla. 1973). Unauthorized use of another's trademark in an attempt to capitalize on the original producer's reputation or goodwill is also a clear violation of the Act. See, e.g., *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972); *Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288 (S.D.N.Y. 1972); cf. *Estee Lauder, Inc. v. Watsky*, 323 F. Supp. 1064 (S.D.N.Y. 1970) (sale by drugstores of products indistinguishable from plaintiff's cosmetics).

³⁶ A more limited form of injunctive relief, preventing further use of the trademark or description, is routinely granted. See, e.g., *HMH Publishing Co. v. Turner*, 222 F. Supp. 145 (N.D. Ga. 1963), *aff'd*, 380 F.2d 224 (5th Cir.), *cert. denied*, 389 U.S. 1006 (1967). In the typical Lanham Act case, however, the defendant may continue to distribute his product as long as the description or trademark it bears is not deceptive. See, e.g., *Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288 (S.D.N.Y. 1972). The *Gilliam* court's declaration that an

By interpreting the Act in so liberal a manner, the *Gilliam* court evidenced an increased sensitivity to an artist's right to prevent mutilation or distortion of his work,³⁷ a right long recognized under the European moral right theory.

Unlike American copyright law, the doctrine of moral right is directed not towards protecting the artist's economic interests,³⁸ but towards guaranteeing, among other things, the integrity of the work and the artist's right to be known as its creator.³⁹ The Berne Convention for the Protection of Literary and Artistic Works,⁴⁰ an international copyright agreement incorporating these rights, provides in part:

Independently of the author's economic rights, . . . the author shall have the right to claim authorship of the work and to object

injunction against dissemination of the entire work may be the only way to adequately protect Monty Python's reputation indicates an expansion of the injunctive remedies available under the Act. See text accompanying notes 52-59 *infra*.

³⁷ The court underscored the problems confronting an artist whose creation has been substantially altered and then publicly displayed. As the Second Circuit noted: "To deform his work is to present him to the public as the creator of a work not his own, and thus makes him subject to criticism for work he has not done." 538 F.2d at 24, quoting Roeder, *supra* note 4, at 569.

³⁸ One commentator, criticizing the limitations of the American approach, noted: When an artist creates, be he an author, a painter, a sculptor, an architect or a musician, he does more than bring into the world a unique object having exploitive possibilities; he projects into the world part of his personality and subjects it to the ravages of public use. There are possibilities of injury to the creator other than merely economic ones; these the copyright statute does not protect. Nor is the interest of society in the integrity of its cultural heritage protected by the copyright statute.

Roeder, *supra* note 4, at 557 (footnote omitted).

³⁹ In the words of a recent commentator:

By virtue of the paternity right, an author may rightfully insist on being publicly known as creator of his published work; as a corollary, he may also prevent the use of another person's name as the author of his work. In addition he may prohibit the use of his name on a work which is not his own, or on a work of his own which has been distorted, altered, or otherwise changed without his consent.

The right to the integrity of the work permits the author to prohibit or to maintain control over any alterations, additions, deletions or changes in content, style, format, etc. of his work.

Comment, *Copyright: Moral Right-A Proposal*, 43 *FORDHAM L. REV.* 793, 799 (1975) (footnotes omitted). See generally Roeder, *supra* note 4, at 561-73. The individual rights encompassed by the moral right theory in its most expansive form are outlined in note 4 *supra*.

⁴⁰ The Berne Convention protects the unpublished works of citizens of foreign nations as well as all works first published in a member nation. Established to replace the numerous treaties then in existence, the Convention has simplified and standardized copyright laws in member countries, which, in signing, declared themselves to be "animated by the desire to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works . . ." Berne Convention, *supra* note 4, Preamble.

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.⁴¹

These so-called moral rights are personal, not property rights,⁴² and provide a basis for relief regardless of economic damage or possession of a copyright. American courts have long refused to adopt the moral right theory in its entirety as part of our law,⁴³ preferring to

⁴¹ *Id.* art. 6(1) (*bis*).

⁴² NIMMER, *supra* note 3, § 110.1. *See generally* note 4 *supra*.

⁴³ *See, e.g.,* Vargas v. Esquire, Inc., 164 F.2d 522 (7th Cir. 1947) (denial of injunction to prevent publication of sketches without artist's name); Geisel v. Poynter Prods., Inc., 295 F. Supp. 331 (S.D.N.Y. 1968) (owner of cartoons may manufacture dolls of cartoon characters without artist's consent); Crimi v. Rutgers Presbyterian Church, 194 Misc. 570, 89 N.Y.S.2d 813 (Sup. Ct. N.Y. County 1949) (denial of artist's right to damages for destruction of his work). In Shostakovich v. Twentieth Century-Fox Film Corp., 196 Misc. 67, 80 N.Y.S.2d 575 (Sup. Ct. N.Y. County 1948), *aff'd mem.*, 275 App. Div. 692, 87 N.Y.S.2d 430 (1st Dep't 1949), plaintiffs, internationally known Soviet composers, sought to enjoin the distribution of an anti-Soviet film entitled "The Iron Curtain," which used plaintiffs' works as background music. 196 Misc. at 68, 80 N.Y.S.2d at 576-77. Although the court indicated that the moral right theory might have some application in the United States, it denied relief since there had been no distortion of the composition and the composers' works did not enjoy copyright protection. *Id.* at 70-71, 80 N.Y.S.2d at 578-79. Absent a copyright, it is settled in the United States that published works are in the public domain and may be copied by anyone. *See generally* Axelbank v. Rony, 277 F.2d 314 (9th Cir. 1960); McGraw-Hill, Inc. v. Worth Publishers, Inc., 335 F. Supp. 415 (S.D.N.Y. 1971). Interestingly, when the same dispute was subsequently litigated in France, the French court found definite moral damage and ordered the film seized. Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1544-45 (1972).

Many commentators have speculated as to the reasons underlying American adherence to the economic rather than the moral right approach to artistic protection. Clearly, the fact that American copyright statutes were, to a large extent, derived from the preexisting, economically oriented English scheme partially explains the current status of American law. *See* Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1542 (1972). *See generally* Comment, *Copyright: Moral Right-A Proposal*, 43 FORDHAM L. REV. 793, 803-08 (1975). The United Kingdom, however, has modified its position and is currently a member of the Berne Union. A. KENT & H. LANCOUR, COPYRIGHT: CURRENT VIEWPOINTS ON HISTORY, LAWS, LEGISLATION 9, app. 1 (1972). It has been suggested that the true reason is that the American preoccupation with exploitation of the country's vast natural wealth has drawn attention away from the protection of the arts and has resulted in underdevelopment of American legal doctrine in this area. Roeder, *supra* note 4, at 557. In contrast, one court has ascribed the American judiciary's reluctance to adopt the European view to the connotations of the term "moral right" and the breadth of the concept:

- (a) "Moral right" seems to indicate to some persons something . . . meta-legal.
- (b) The "moral right" doctrine, as applied in some countries, includes very extensive rights which courts in some American jurisdictions are not yet prepared to acknowledge; as a result, the phrase "moral right" seems to have frightened some of those courts to such an extent that they have unduly narrowed artists' rights.
- (c) Finally, it is not always an unmitigated boon to devise and employ such a common name.

Granz v. Harris, 198 F.2d 585, 590 (2d Cir. 1952) (footnotes omitted).

protect, under the guise of various other legal doctrines⁴⁴ only a few of the rights encompassed by the European theory. Following this approach, the *Gilliam* court brought the right to prevent deformation within the ambit of the Lanham Act,⁴⁵ thus finding it unnecessary to utilize the moral right theory.

Prior to *Gilliam*, few courts had even intimated that distortion or mutilation of an artist's work might be actionable under the Lanham Act.⁴⁶ In *Jaeger v. American International Pictures, Inc.*,⁴⁷ the director of a German film sued the American distributors, alleging that the English language version of the film was garbled and distorted. The court commented:

Whether or not there is any square counterpart in American law of the "moral right" of artists assertedly recognized on the European continent, there is enough in plaintiff's allegations to suggest that he may yet be able to prove a charge of unfair competition or otherwise tortious misbehavior in the distribution to the public of a film that bears his name but at the same time severely garbles, distorts or mutilates his work. It is at least arguable that there is a claim under the Lanham Act . . . in the charge that defendant

⁴⁴ See notes 5-8 and accompanying text *supra*.

⁴⁵ 538 F.2d at 24-25. Judge Gurfein, while not dissenting from the majority's view that a cause of action under the Lanham Act existed in favor of Monty Python, emphasized that the Act "does not deal with artistic integrity." *Id.* at 27 (Gurfein, J., concurring). He noted that "[s]o far as the Lanham Act is concerned, it is not a substitute for *droit moral* which authors in Europe enjoy." *Id.*

⁴⁶ See *Autry v. Republic Prods. Inc.*, 213 F.2d 667 (9th Cir.), *cert. denied*, 348 U.S. 858 (1954); *Jaeger v. American Int'l Pictures, Inc.*, 330 F. Supp. 274 (S.D.N.Y. 1971). In *Autry*, the court found that plaintiff's licensing agreement with defendants permitted cutting and editing for television, and thus the Lanham Act was inapplicable. 213 F.2d at 669. The court implied, however, that in other cases severe editing might give rise to such a claim:

[W]e can conceive that some such cutting and editing could result in emasculating the motion pictures so that they would no longer contain substantially the same motion and dynamic and dramatic qualities which it was the purpose of the artist's employment to produce.

Id.

Although not specifically addressing a Lanham Act claim, other courts have implied that an artist may have some protection against dissemination of a garbled version of his work. See, e.g., *Granz v. Harris*, 198 F.2d 585, 588-89 (2d Cir. 1952); *Preminger v. Columbia Pictures Corp.*, 49 Misc. 2d 363, 267 N.Y.S. 2d 594 (Sup. Ct. N.Y. County), *aff'd mem.*, 25 App. Div. 2d 830, 269 N.Y.S.2d 913 (1st Dep't), *aff'd mem.*, 18 N.Y.2d 659, 219 N.E.2d 431, 273 N.Y.S.2d 80 (1966). In *Preminger*, the plaintiff sought an injunction against the exhibition of the motion picture "Anatomy of a Murder" in edited form. The court ruled that minor cuts were permissible in the discretion of local stationmasters, but that extensive editing, such as cutting 61 minutes of film from the movie, may constitute actionable mutilation. 49 Misc. 2d at 371-72, 267 N.Y.S.2d at 603.

⁴⁷ 330 F. Supp. 274 (S.D.N.Y. 1971).

represents to the public that what the plaintiff had nothing to do with is the plaintiff's product⁴⁸

Thus, the *Jaeger* court suggested that proof of mutilation resulting in misrepresentation may give rise to a valid claim under the Act.

The Second Circuit's decision in *Gilliam*, at first glance, might be read to support the view that proof of mutilation alone is sufficient to state a claim under the Act. Viewed thusly, *Gilliam* would closely approximate a moral right approach.⁴⁹ The terms of the Act itself, however, require an element of misdescription.⁵⁰ Thus, it might be argued, as Judge Gurfein did in his concurring opinion, that a legend clearly disassociating the group from the program would suffice to prevent future violations, thereby affording plaintiffs adequate relief.⁵¹ Although this view is consistent with other decisions discussing the remedies available under the Act,⁵² it should be noted that the circumstances in the earlier decisions differ significantly from those in *Gilliam*. For example, in *Potato Chip Institute v. General Mills, Inc.*,⁵³ it was the description, not the product itself, that was in issue. General Mills manufactured an artificial snack food advertised as a potato chip. An explanatory phrase distinguishing this product from natural potato chips was held to be sufficient to avoid confusion.⁵⁴ Certainly, in a situation

⁴⁸ *Id.* at 278 (citations omitted).

⁴⁹ Under the moral rights theory, the artist, upon proof of mutilation, may obtain injunctive relief and money damages. See Roeder, *supra* note 4, at 574. If *Gilliam* is interpreted as providing similar relief solely upon proof of mutilation, the effect of the decision may be to afford the American artist rights under the Lanham Act similar to those afforded the European artist by the moral right theory.

⁵⁰ See 15 U.S.C. § 1125(a) (1970), *quoted in note 10 supra*. As the court in *Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968), observed: "'In any proceeding under the Lanham Act the gist of the proceeding is a false description or representation, . . . or a use of the mark which 'is likely to cause confusion or mistake or to deceive purchasers'" *Id.* at 565, *quoting Societe Comptoir de L'Industrie Cotonniere Etablissements Boussac v. Alexander's Dep't Stores, Inc.*, 299 F.2d 33, 36 (2d Cir. 1962) (citations omitted).

⁵¹ 538 F.2d at 26-27 (Gurfein, J., concurring). Judge Gurfein stated: "The misdescription of origin can be dealt with, as Judge Lasker did below, by devising an appropriate legend to indicate that the plaintiffs had not approved the editing of the ABC version. With such a legend, there is no conceivable violation of the Lanham Act." *Id.* at 27 (footnote omitted). In the district court, Judge Lasker had ordered that a statement disassociating Monty Python from the program because of the editing be broadcast during the special. The Second Circuit granted a stay of that order and permitted ABC to air the program with a statement that it had been edited by the network. *Id.* at 18.

⁵² See note 36 *supra*.

⁵³ 461 F.2d 1088 (8th Cir. 1972) (*per curiam*).

⁵⁴ *Id.* at 1089-90. The lower court had enjoined General Mills from advertising Chipos as potato chips without a prominent notation that the product was made from dried or dehydrated potatoes. "Fashioned from dried potato granules" was considered a sufficient explana-

where the plaintiffs seek mere accuracy of description, an order requiring a clear label or explanation is sufficient.⁵⁵ Similarly, in *Rich v. RCA Corp.*,⁵⁶ the defendant record company was enjoined from marketing a record consisting of songs recorded by plaintiff more than 10 years previously, in a record jacket with a current photograph of him.⁵⁷ Finding a likelihood of confusion or deception,⁵⁸ the court enjoined further sales, but implied that distribution of the record in the same jacket with a clear legend stating the date of the recording would not result in a violation of the Act.⁵⁹

It is submitted that the *Gilliam* majority's suggestion that a permanent injunction might issue is justifiable on the facts presented in view of the special problems inherent in the television medium. Noting that viewers might tune in on the broadcast at any time, the court questioned whether "a few words could erase the indelible impression that is made by a television broadcast,"⁶⁰ and concluded that a serious probability of a misrepresentation remains, even when a disclaimer is aired simultaneously with the broadcast.⁶¹ The same considerations clearly seem to apply when the violative

tion to avoid customer confusion. *Potato Chip Inst. v. General Mills, Inc.*, 333 F. Supp. 173, 181 (D. Neb. 1971), *aff'd per curiam*, 461 F.2d 1088 (8th Cir. 1972).

⁵⁵ Even where the confusion arises from the similarity of two products, an order requiring a clear label has been held to be the only relief appropriate under the Act. *See Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288, 1296 (S.D.N.Y. 1972), wherein the court, despite a finding that defendant's needlework designs were markedly similar to plaintiff's, granted an injunction which proscribed only the use by the defendant of the word "Nina" on any of its products.

⁵⁶ 390 F. Supp. 530 (S.D.N.Y. 1975).

⁵⁷ *Id.* at 531. A recent photograph of Rich appeared on the front and back covers of the album. Four of the ten songs listed were marked with an asterisk, indicating that these were "previously released selections." It was not indicated when the songs were actually recorded and the only date appearing on the jacket and the album itself was 1974. *Id.*

⁵⁸ *Id.* Actual proof that persons have been misled is not required in order to obtain injunctive relief. *See Hesmer Foods, Inc. v. Campbell Soup Co.*, 346 F.2d 356, 359 (7th Cir.), *cert. denied*, 382 U.S. 839 (1965); *Ames Publishing Co. v. Walker-Davis Publications, Inc.*, 372 F. Supp. 1, 12 (E.D. Pa. 1974); *Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288, 1295 (S.D.N.Y. 1972). Such proof, however, will undoubtedly strengthen the plaintiff's case. In *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972), for example, the court noted that the plaintiff had received complaints from numerous customers who had assumed that Coca-Cola had sponsored a poster proclaiming, "Enjoy Cocaine," in Coca-Cola script. *Id.* at 1188-89.

⁵⁹ 390 F. Supp. at 531.

⁶⁰ 538 F.2d at 25 n.13.

⁶¹ Judge Gurfein indicated that the district court should fashion an order which would adequately deal with the continuing possibility of confusion. But, aside from stating that the legend could be broadcast at various intervals and not just at the beginning of the show, he did not suggest how the confusion could be overcome. *See id.* at 27 & n.1 (Gurfein, J., concurring).

work is in the form of a radio show, or, to a lesser extent, a movie. One intriguing question left open in the wake of *Gilliam* is whether permanent injunctive relief will be extended beyond these rather ephemeral media events.⁶² Essentially, future application of permanent injunctions depends on which element of the court's rationale is emphasized. If the mutilation aspect is stressed, a permanent injunction may issue. If, on the other hand, the misrepresentation aspect is stressed, a clear notation disassociating the author from the altered work should be sufficient.

The *Gilliam* decision represents an important step towards the development of a more comprehensive body of principles by which certain artistic endeavors may be afforded complete protection. Although *Gilliam* follows in the tradition of other courts which have developed such protections in piecemeal fashion by application of various common law principles,⁶³ the decision is unique in that the Second Circuit has provided a *federal* cause of action encompassing the artist's right to prevent deformation.⁶⁴ More significant perhaps, is that the court has gone beyond the traditional American approach, and has expressly acknowledged the importance of the artist's intangible interest in the presentation of his work free from distortion or mutilation. By holding that mutilation which results in misrepresentation is actionable under the Lanham Act and may justify the grant of a permanent injunction against dissemination of the altered work, the court has recognized the needs of artists for redress against nonpecuniary injury.

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⁶² For example, it is unclear whether an author would be entitled to an injunction under the Lanham Act were his book, edited without consent, published with a clear disclaimer of authorship on the jacket. Arguably, the disclaimer, visible at all times to the reader, would adequately remedy the claimed misdescription. On the other hand, musical works, such as operas, symphonies, or stage might require the more comprehensive relief that a permanent injunction would provide. A disclaimer in the program or even an announcement before the beginning of the performance might easily fade from a viewer's mind, while the performance itself would tend to leave a lasting impression.

⁶³ See notes 5-8 *supra*.

⁶⁴ The recognition of a federal cause of action favors the purpose of the copyright clause to provide uniform national protection for science and the arts. See 1 NIMMER, *supra* note 3, § 1.1.