

Are Moral Rights in the United States Being "Mown" Over? *King v. Innovation Books* and the Role of the Lanham Act in Protecting the Rights of Artists

Rachel L. Wasserman

Follow this and additional works at: <https://via.library.depaul.edu/jatip>

Recommended Citation

Rachel L. Wasserman, *Are Moral Rights in the United States Being "Mown" Over? King v. Innovation Books and the Role of the Lanham Act in Protecting the Rights of Artists*, 4 DePaul J. Art, Tech. & Intell. Prop. L. 303 (1994)
Available at: <https://via.library.depaul.edu/jatip/vol4/iss2/9>

This Case Summaries is brought to you for free and open access by the College of Law at Via Sapientiae. It has been accepted for inclusion in DePaul Journal of Art, Technology & Intellectual Property Law by an authorized editor of Via Sapientiae. For more information, please contact wsulliv6@depaul.edu, c.mcclure@depaul.edu.

CASE NOTE

ARE MORAL RIGHTS IN THE UNITED STATES BEING "MOWN" OVER? *KING V. INNOVATION BOOKS* AND THE ROLE OF THE LANHAM ACT IN PROTECTING THE RIGHTS OF ARTISTS

INTRODUCTION

Countries other than the United States have long recognized moral rights as rights that are personal to authors and separate from the proprietary aspects of copyright law. Unlike traditional copyright law which protects the economic interest of the copyright owner,¹ moral rights are designed to protect a non-transferable, noneconomic interest in the creativity of the work itself, as an expression of the creator's personality.² Moral rights are vested in the creator, regardless of who owns the copyright,³ existing independently from copyright ownership and attaching solely to the original creation of the artist.⁴

Many countries throughout the world protect the personal rights of creators by recognizing the moral rights of artists. Such rights have a long tradition of protection in European jurisprudence,⁵ originating in the French doctrine of "droit moral" over a century ago.⁶ However, the status of moral rights for artists in the United States is quite different. Although the United States has recently joined the international community in recognizing the moral rights of artists, and has given lip service to the protection of such rights, the reality is that moral rights in the United States stand on uncertain ground. With the exception of certain limited forms of visual art works there is no single federal statute that governs

1. "The primary objective of our copyright law is to ensure the copyright owner's receipt of all financial rewards to which he is entitled, under the 1976 (Copyright) Act, by virtue of ownership." Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 Vand. L. Rev. 1, 2 (1985).

2. Comment, Amy L. Landers, *The Current State of Moral Rights Protection for Visual Artists in the United States*, 15 Hastings Comm/Ent L.J. 165 (1992).

3. Deborah Ross, *The United States Joins the Berne Convention: New Obligations for Author's Moral Rights*, 69 N.C.L.Rev. 363, 367 (1990).

4. Landers, *supra* note 2 at 168.

5. See John H. Merryman, *The Refrigerator of Bernard Buffet*, 27 Hastings L.J. 1023, 1025 (1976).

6. Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 Harv. L.Rev. 554, 555-56 (1940).

the moral rights of creators.⁷ As a result, an artist attempting to assert such rights is forced to resort to a hodge-podge of copyright, trademark, defamation, libel and contract theories. As Professor Martin Roeder noted in his seminal article on the status of moral rights in the United States, “the application of so many different doctrines to a subject matter which is intrinsically homogeneous produces confusion; choice of theory becomes dependent on a fortuitous combination of factors, rather than on the basic needs of the problem.”⁸

The present note examines a recent Second Circuit decision, *King v. Innovation Books*,⁹ that considered the use of a motion picture credit which stated that the motion picture was “based upon” an author’s short story. The author objected to the use of his name in conjunction with the film and claimed a violation of federal trademark law, one of the ways in which artists in the United States seek to assert their moral rights. After a discussion of the facts and holding of the King case, this note will analyze (1) the historical development of moral rights in the United States; (2) the use of the Lanham Act, which governs federal trademark law, as a vehicle to protect such rights; (3) the standard the King court applied; and (4) the impact of two recent Second Circuit district court decisions made in the wake of the King case.

KING V. INNOVATION BOOKS

Horror writer Stephen King wrote a ten page short story in 1970 entitled “The Lawnmower Man” The short story was published in 1975 and, in 1978, King assigned the motion picture and television rights for the story to Great Fantastic Picture Corporation, which later assigned the rights to Allied Vision, Ltd., a movie production company. Allied then prepared to produce a motion picture based on the short story, and, by February 1991, began to advertise the movie in trade magazines with the possessory credit, “Stephen King’s *The Lawnmower Man*” and as “based upon” a short story by King. In June 1991, Allied licensed New Line Cinema Corporation to distribute the movie in North America.

¹⁰ King learned of the movie in October 1991 and made several attempts to gain information about the film and to obtain a rough cut of the movie and its credits from both Allied and New Line. King also informed both Allied and New Line that he did not want the possessory credit.¹¹

After finally viewing the film, King filed suit against Innovation Books, Allied Vision, Ltd. and New Line Cinema seeking damages and a preliminary injunction prohibiting any use of King’s name on or in conjunction with the motion picture, “The Lawnmower Man.” King claimed the use of his name in a

7. The United State became a signatory to the Berne Convention for the Protection of Literary and Artistic Works (Berne) in 1988. But, in response to Berne, the only subsequent change in United States law was the passing of the Visual Artists Rights Act of 1990, which provides protection for certain forms of visual art works. 17 U.S.C. §§ 101, 106A (1990).

8. See Roeder, *supra* note 6 at 575.

9. 976 F.2d 824 (2d Cir. 1992).

10. King, 976 F.2d at, 826-27.

11. *Id.* at 827.

possessory credit and a "based upon" credit violated section 43(a) of the Lanham Act.¹² The Second Circuit Court of Appeals affirmed an earlier district court decision prohibiting the use of the possessory credit, but reversed the district court's order to the extent that it prohibited the use of the "based upon" credit. The court of appeals held that the district court placed too much weight on the proportion of the motion picture attributable to the short story written by King, instead of focusing on the proportion of the short story quantitatively and qualitatively appearing in the film.¹³ Since most of the elements of the short story appeared in the film, the court concluded that the "based upon" credit was not false, misleading or likely to confuse, as required by section 43(a) of the Lanham Act.¹⁴

Although neither the court nor the parties involved in this dispute explicitly raised the issue of moral rights, fundamentally King was trying to protect his work by asserting his moral rights of attribution and integrity, even after he had assigned those rights associated with the copyright to the defendants. King was upset about the distortion of his work and was concerned that his name would be associated with a film which has little to do with his creation.

RECOGNITION OF MORAL RIGHTS IN THE UNITED STATES

Although the United States has only recently given formal recognition to the protection of moral rights, there is a strong tradition of moral rights protection in other parts of the world.¹⁵ The doctrine of moral rights recognizes that a work of art embodies elements of an artist's personality.¹⁶ Moral rights are inalienable by their very nature, since they constitute an element of the creator's personality rather than a property right.¹⁷ "When an artist creates . . . he does more than bring into the world a unique object having only exploitative possibilities; he projects into the world part of his personality and subjects it to the ravages of

12. *Id.* at 828.

13. *Id.* at 829-31.

14. Section 43(a) of the Lanham Act provides in full: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which (1) is likely to cause confusion, or to cause mistake, or deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (2) in commercial advertising or promotion misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities shall be liable in a civil action by any person who believed that he or she is or is likely to be damaged by such act." 15 U.S.C. § 1125(a) (1988).

15. The Berne Convention for the Protection of Literary and Artistic Works was held initially in 1886. Approximately 79 nations joined Berne between 1886 and 1989, when the United States finally joined. Doriane Lamblet, *Internationalizing the Copyright Code: an Analysis of Legislative Proposals Seeking Adherence to the Berne Convention*, 76 *Geo.L.J.* 467, 472 (1987). The members of the Berne Union include developing countries, communist countries, and free market nations. S. Rep. No. 352 100th Cong., 2nd Sess. 2.

16. See Landers, *supra* note 2 at 166.

17. M. Nimmer and D. Nimmer, *The Law of Copyright*, § 8.21[A] (1992).

public use.”¹⁸ Moral rights protection varies from country to country, but generally, moral rights are considered to include the right of attribution, the right of integrity, the right of disclosure, and the right of withdrawal.¹⁹

With the exception of Section 106A of the Copyright Act which protects the rights of attribution and integrity for limited kinds of works of visual art,²⁰ moral rights have not received much formal recognition in the United States.

Nevertheless, it is true that the United States has joined the Berne Convention for the Protection of Literary and Artistic Works²¹ (Berne). Article 6bis of the Berne Convention protects the rights of attribution and integrity.²² But, in enacting Berne, Congress made few changes in currently existing law, concluding that current provisions already adequately safeguarded moral rights to the extent that article 6bis requires.²³ This minimalist approach to compliance was taken for reasons of political expediency, as well as because of the foreign nature of moral rights to American property and copyright law.²⁴

The Berne Convention Implementation Act (BCIA), which was the congressional enactment of the Berne Convention into federal law, expressly states that “the provisions of the Berne Convention . . . do not expand or reduce any right of an author of a work . . . to claim authorship of the work; or . . . to object to any distortion, mutilation, or other modification of . . . the work, that would prejudice the author’s honor or reputation.”²⁵ Section 43(a) of the Lanham Act was cited as one of the provisions already present in federal law that adequately safeguarded moral rights.²⁶

18. Roeder, *supra* note 6 at 557.

19. The right of attribution protects an author’s interest in being identified as a work’s creator, in not having the author’s work attributed to another, and in not having the author’s name used in connection with a work the author did not create. Paul Goldstein, 2 Copyright § 8.21[A] (1989 & Supp. 1992). The right of integrity prevents another from distorting, mutilating, or modifying a work in a way that would injure an author’s honor and reputation. *Id.* at § 15.24.2. The right of disclosure allows a creator to decide when and if to publish a work. *Id.* at § 15.23. And the right of withdrawal gives a creator the right to withdraw, modify, or disavow a work after it has been published. *Id.* at § 15.23.

20. Section 106A protects the right of the creator of a work of visual art to claim authorship of the work, to prevent the use of his or her name as the author of a work he or she did not create, to prevent the use of his or her name as author in the event of a distortion, mutilation or modification of the work, and to prevent intentional or grossly negligent destruction of a work. 17 U.S.C. § 106A (1990).

21. Berne Convention Implementation Act (BCIA), Pub. L. No. 100-568, 102 Stat. 2853 (1988).

22. “Independently of the author’s economic rights, and even after the transfer of 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 shall be prejudicial to his honor or reputation.” Berne Convention (Paris text), art. 6bis(1) (1971).

23. Congress did enact Section 106A of the Copyright Act, in part as a response to Berne. Section 106A protects the rights of attribution and integrity for works of visual arts existing in single copies or limited editions of 200 copies or fewer that are signed and consecutively numbered by the author. 17 U.S.C. §§ 101, 106A (1990).

24. *See generally*, Ross, *supra* note 3, at 367.

25. BCIA, *supra* note 21, at section 3(b).

26. H.R.Rep. no. 609, 100th Cong., 2nd Sess. 32-34 (1988).

The two moral rights that are relevant to King's Lanham Act claim are the rights of attribution and integrity. The right of attribution has been defined as "the right of the creator of a work to present himself before the public as such, to require others to so present him, and to prevent others from attributing works to him which he has not devised."²⁷ This right protects the artist through proper attribution as to authorship of his or her work. The right of integrity has been described as "the right to make any additions, suppressions and other modifications which the author may deem necessary in order to make the work conform to the state of his intellectual convictions."²⁸ This right allows the artist to modify a work and to prevent deformation of the work. Since Congress stated that these rights should be protected in the United States through currently existing federal statutes such as the Lanham Act, challenges such as King's to "based upon" credits should be given serious consideration by the United States courts.

THE LANHAM ACT, UNFAIR COMPETITION AND MORAL RIGHTS

The Lanham Act is the United States trademark statute.²⁹ The stated purposes of the Lanham Act are to protect the public from misrepresentation when purchasing a product and to protect a trademark owner from misappropriation of a product.³⁰ Section 43(a) of the Lanham Act is the federal unfair competition statute, which covers works and products that are not been registered with the Trademark Office.³¹ Section 43(a) has been applied to protect the related rights of attribution and integrity where there is a false reference to the origin of a work, or a reference which, while not literally false, is misleading or likely to confuse.³² But, because the Lanham Act's focus is on protecting economic property interests, it fits uneasily into a moral rights framework. "The concept of unfair competition, though forever expanding, loses its basic meaning when applied to the protection of personal, non-pecuniary rights."³³

Some early case law supports the use of 43(a) to safeguard moral rights in a contractual setting. In *Granz v. Harris*,³⁴ the defendant presented substantially shortened versions of a set of jazz concerts given by the plaintiff under the plaintiff's name. The Second Circuit Court of Appeals found unfair competition factors implied in the contractual relationship of the parties and protected the creator's interest in presenting his work free from alterations.³⁵ In *Autry v. Republic Productions, Inc.*,³⁶ the Ninth Circuit also looked to contract principles in

27. Roeder, *supra* note 6 at 561-62.

28. *Id.* at 565.

29. 15 U.S.C. §§ 1051-1127 (1988).

30. S.Rep. No. 1333, 79th Cong., 2d Sess. 3 (1946).

31. 15 U.S.C. § 1125(a) (1988).

32. *See King*, 976 F.2d at 828; *Gilliam v. American Broadcasting Co.*, 538 F.2d 14, 24-25 (2d Cir. 1976).

33. Roeder, *supra* note 6 at 576.

34. 198 F.2d 585 (2d Cir. 1952).

35. *Id.* at 588-89.

36. 213 F.2d 667 (9th Cir. 1954).

finding that star Gene Autry had contracted away the right to exploit his performance and therefore could not prevent the showing of edited versions of his movies on television. But the court did note that extensive editing of a film could reach to a level of “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.”³⁷

In *Preminger v. Columbia Pictures Corp.*,³⁸ the plaintiff, producer and director Otto Preminger, sought to prevent television distribution of his film *Anatomy of a Murder* under the defendant’s licensing agreements, which allowed each television station to edit the film for commercial interruptions. The court allowed the editing of the film because Preminger’s contract had granted television distribution rights without limitations on editing, but noted that Preminger would be entitled to injunctive relief if the cutting amounted to mutilation of the film, suggesting that mutilation would involve cutting the film by one-third or more.³⁹

Later cases went beyond the realm of contract law to apply unfair competition principles in protecting moral rights. In *Geisel v. Poynter Productions, Inc.*,⁴⁰ the plaintiff brought suit under section 43(a) of the Lanham Act after the defendant began marketing dolls displaying the plaintiff’s commercial name, Dr. Seuss. The court found that the defendant’s intentional misrepresentation to the public that the plaintiff created, designed, manufactured, produced, authorized, or approved the design of the dolls would cause customer confusion as to the origin of the dolls.⁴¹ Protection against such unfair competition was necessary to secure an artist’s attribution and maintain his reputation.⁴²

Gilliam v. American Broadcasting Co.,⁴³ has been recognized as the landmark case in explicitly recognizing an author’s interest in the integrity of his work through use of the Lanham Act. The plaintiffs, the Monty Python comedy group, sought an injunction against ABC to prevent the airing of the plaintiffs work after ABC had extensively edited it, cutting twenty four minutes from the original ninety minutes of Monty Python material. The editing included deletion of essential elements of story lines that ABC considered offensive, such that the meaning and continuity of many skits was interrupted.⁴⁴ The Second Circuit Court of Appeals found that ABC’s editing was so extensive that the work no longer represented the original and “constituted an actionable mutilation of Monty Python’s work.”⁴⁵ The court linked the concepts of the right of integrity and attribution by stating that “this cause of action, which seeks redress for deformation of an artist’s work finds its roots in the concept . . . of moral right,

37. *Id.* at 669.

38. 267 N.Y.S.2d 594 (NY Sup Ct 1966), *aff’d per curiam*, 269 N.Y.S.2d 913.

39. *Id.* at 602-03.

40. 283 F. Supp. 261 (S.D.N.Y. 1968).

41. *Id.* at 266.

42. *Id.* at 267.

43. 538 F.2d 14 (2d Cir. 1976).

44. *Id.* at 25.

45. *Id.* at 23.

which may generally be summarized as including the right of the artist to have his work attributed to him in the form in which he created it."⁴⁶ However, in a concurrence, Judge Gurfein disagreed with the Lanham Act holding and stated that "the Lanham Act . . . is not a substitute for *droit moral* which authors in Europe enjoy."⁴⁷ Judge Gurfein felt the use of 43(a) to protect the right of integrity was outside the scope of the Lanham Act, which should only protect consumers from misdescription of origin.⁴⁸

The evolving interpretation of section 43(a) began to give artists greater protection for proper attribution of their work and freedom from material alterations of their creative works. In *Follett v. Arbor House Publishing Co.*,⁴⁹ author Ken Follett brought suit under 43(a) to prevent attribution of authorship. Before he became a best-selling author, Follett had extensively edited and re-worked a manuscript that was published in Great Britain with the by-line "Rene Louis Maurice with Ken Follett."⁵⁰ After publishing several best-selling novels, Follett left Arbor House for another publisher. Arbor House planned to release the novel in America with the by-line: "by the author of *TRIPLE* and *EYE OF THE NEEDLE*, KEN FOLLETT with Rene Louis Maurice" and with only Follett's name appearing on the spine of the book.⁵¹ While the court found that Follett's contributions were greater than a typical editor, they did not rise to the level of authorship. Therefore, holding Follett out as the principal author was literally false. "The Lanham Act . . . is designed not only to vindicate 'the author's personal right to prevent the presentation of his work to the public in a distorted form . . . but also to protect the public and the artist from misrepresentations of the artist's contribution to a finished work."⁵²

THE KING "BASED UPON" STANDARD

In the context of the "based upon" credit, courts prior to *King* have found that the use of "based upon" may negate any false designation or description of origin.⁵³ But, these earlier cases did not deal with the situation *King* presents: namely, where the "based upon" attribution is itself the misleading representation.

The King court articulated a standard to determine the accuracy of the "based upon" credit. If a movie quantitatively and qualitatively draws from a literary

46. *Id.* at 24.

47. *Id.* at 27.

48. *Id.*

49. 497 F.Supp. 304 (S.D.N.Y. 1980).

50. *Id.* at 307.

51. *Id.* at 308.

52. *Id.* at 313 (quoting *Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14 (2nd Cir. 1976)).

53. See e.g. *Hospital for Sick Children v. Melody Fare Dinner Theater*, 516 F.Supp. 67, 73 (E.D. Va. 1980) (failure to consistently use language of attribution warranted a Lanham Act violation); *Landon v. Twentieth Century Fox*, 384 F.Supp. 450 (S.D.N.Y. 1974) (weekly serial advertised as "based upon" plaintiff's work not misleading because it changed the tone of the work).

work in a material way, the movie is “based upon” the literary work, although countervailing facts and circumstances may still show that the “based upon” standard is misleading.⁵⁴ The court suggested that such countervailing circumstances may include a showing that the author has strong feelings about the credit, and may also include evidence of confusion as to source in the industry or among the public.⁵⁵ Because the core of King’s short story appeared in the movie, the court held that the “based upon” attribution was not misleading, despite the fact that the short story elements comprised very little of the overall film.⁵⁶

This standard for measuring whether a work is “based upon” an artist’s earlier creation inadequately protects an artist’s rights of attribution and integrity. Even where the right to create a derivative work has been contracted away to another, authority to modify a work is never unlimited. “In no case should the modifications go so far as to attribute to the creator ideas which he does not believe and did not originally express; nor should the extrinsic esthetic quality of the work be subject to alteration.”⁵⁷ The standard the King court applies would allow someone to tack virtually anything around an artist’s work and still use a “based upon” credit. This violates the right of attribution by attributing to the artist ideas not his and violates the right of integrity by distorting what that artist had created.

A more appropriate standard to apply in determining whether a work is truly “based upon” an artist’s earlier work is a “substantial similarity” test, either that used in copyright infringement actions or that used in contract disputes. It is beyond the scope of this note to explore fully the differences between these standards, but suffice it to say that the similarities under contract law would not have to be as pronounced as they would under a copyright infringement action.⁵⁸ However, either of these standards would afford artists much greater protection than the “quantitative and qualitative” standard the King court applies. The pre-existing work that a new work is “based upon” could not consist of such a small part of the new work that it is virtually meaningless. Indeed, one court has already applied a “substantial similarity” test in determining whether a motion picture was “based upon” an earlier literary work, although this was in a copyright infringement context, not a 43(a) context.⁵⁹ And, several commentators have advocated the use of a “substantial similarity” test in determining whether a work is “based upon” another work.⁶⁰

54. *King*, 976 F.2d at 830.

55. The court noted that King was much less bothered by the “based upon” credit compared to his feelings about the possessory credit. The court also pointed out that King had provided no evidence of public confusion as to source beyond the testimony of one expert witness. *Id.*

56. *Id.*

57. Roeder, *supra* note 6 at 571.

58. See *Fink v. Goodson-Todman Enterprises, Ltd.*, 9 Cal. App. 3d 996, 1008 (1970).

59. The court in *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, was examining whether the defendant’s movie was “based upon” the plaintiff’s book and therefore infringing on the plaintiff’s copyright. 683 F.2d 610, 623 (2nd Cir. 1982).

60. See *e.g.* Nimmer, *supra* note 17 section 8.21[E] (use of “substantial similarity” test in deter-

Application of a substantial similarity test might have provided stronger protection for King's right of integrity. Such a test would involve comparing the original text of King's story to the film version that was released. In the copyright context, substantial similarity analyses vary somewhat among the federal circuits, but they generally involve a two-prong test showing first, copying from the plaintiff's work and second, similarities between the works when compared in their entirety, as determined by the objective viewpoint of an expert observer and/or by the subjective viewpoint of an ordinary observer.⁶¹

The first prong of the test, namely copying, would obviously be met. Allied Vision and New Line Cinema had access to the short story and used its elements in the motion picture they created. There is no dispute over this. However, the second prong of the test, in which the works are compared in their entirety, is unlikely to be satisfied. As the district court in the King case noted, "the film incorporates only one scene from the story and uses it in a manner fundamentally inconsistent with the essential plot, characters and theme of the short story. The scene from the short story occupies approximately two minutes of screen time, and the rest of the film deals with material entirely unrelated to the short story."⁶² It is difficult to imagine a trier of fact comparing the short story and the film in their entirety, and reaching a conclusion that they are substantially similar. Thus, under a substantial similarity analysis, the "based upon" credit would indeed be misleading as to origin.

RECENT DEVELOPMENTS AFTER KING

Cases decided after *King* highlight the inadequacy of the Lanham Act in protecting an artist's right of integrity. In *Lish v. Harper's Magazine Foundation*,⁶³ the plaintiff, a well-known fiction writer brought suit against Harper's claiming *inter alia*, that the magazine had violated the Lanham Act by publishing a letter Lish had sent to his prospective students. Lish claimed that the magazine's attribution of authorship to him after the magazine had edited the letter extensively gave rise to a false designation of origin and thus violated the Lanham Act.⁶⁴ Harper's deleted a substantial amount (48%) of Lish's original letter, included an introduction that Lish had not written and failed to use the conventional method

mining whether a work is "based upon" another, even in disputes not concerned with copyright infringement); Kwall, *supra* note 1, at 45 ("substantial similarity" test appropriate to judge whether a derivative work is "based upon" a pre-existing work).

61. See *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990) (Plaintiff must show (1) access to copied work; and (2) substantial similarity through satisfying "extrinsic test" involving an objective analysis of expression and "intrinsic test" involving a subjective analysis of expression); *Stillman v. Leo Burnett Co.*, 720 F.Supp. 1353 (N.D.Ill. 1989) (Plaintiff must show (1) copying through access, or similarity in protectible and non-protectible elements of the works; and (2) unlawful appropriation of protectible elements); *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946) (Plaintiff must show (1) copying; and (2) unlawful appropriation through finding of similarity by ordinary observer looking at both works in their entirety)

62. *King v. Allied Vision, Ltd.*, 807 F.Supp. 300, 303 (S.D.N.Y. 1992).

63. 807 F.Supp. 1090 (S.D.N.Y. 1992).

64. *Id.* at 1106.

of ellipses to indicate where deletions had been made.⁶⁵

Lish clearly felt that Harper's actions destroyed his work, harmed his reputation and violated his right of integrity. "They took my writing, and with mischief in mind, in order to create what they imagined to be a newsworthy or titillating object, went forward and re-created another piece of writing from my writing. I regard what they did is a horrendous distortion of my intention and an awful use of myself."⁶⁶

However, the court rejected Lish's Lanham Act claim. Although recognizing that both *Gilliam* and *King* allow such a claim to succeed if the plaintiff's work is so distorted that it is misleading as to the origin of the work, the court stated that in this case, the material was not impliedly false because of the editing Harper's had done.⁶⁷ Lish presented no survey evidence tending to show consumer confusion and the court felt that the letter as edited was not unrepresentative of the original letter Lish had written. As a result, there was no false designation of origin that would confuse consumers. Additionally, although Lish felt quite strongly that the magazine had mutilated his work, the court did not even weigh this factor as a countervailing circumstance of the type the King court suggested might change the outcome.⁶⁸ The Lanham Act claim was dismissed.⁶⁹

An application of the substantial similarity test in this case might well have resulted in better protection for Lish's right of integrity, which was egregiously violated in this case. Even where an artist has authorized another party to modify a work, such modifications are not unlimited.⁷⁰ Certainly in a case like this, where a work has been used and extensively modified without authorization from the creator, who feels strongly that, "next to his family, the thing he cherished most and holds most dear are the words he writes,"⁷¹ there has been a violation of the creator's right of integrity.

Application of the substantial similarity test would involve comparing the original text of Lish's letter to the edited version which Harper's eventually published. Again, obviously the copying prong of a substantial similarity test would be met since Harper's was using the actual words Lish had written. But, when examining the unlawful appropriation prong, Lish might have been able to show that the two works viewed in their entirety were not substantially similar. According to one expert witness at the trial, Harper's editing of Lish's letter changed the letter from "a serious and sometimes moving and impressive piece of work, to something that looked ridiculous."⁷² Although the expert witnesses

65. *Id.*

66. *Id.*

67. *Lish* 807 F. Supp. at 1106-07.

68. *King*, 976 F.2d at 830. *See supra* notes 54-55.

69. *Id.* at 1107-08.

70. *See e.g.* *Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14 (2d Cir. 1976); *Autry v. Republic Productions, Inc.*, 283 F.Supp 261 (S.D.N.Y. 1968).

71. *Lish*, 807 F.Supp. at 1105.

72. *Id.* at 1107.

at the trial disagreed on the effect of the editing, if a substantial similarity test been applied, it is possible that the trier of fact would have concluded the works were dissimilar enough that the attribution of the letter to Lish's name would be misleading as to origin, even though Lish had written the words that were published. To establish a violation of the Lanham Act, it is sufficient that a representation of a product, although technically true, creates a false impression of the product's origin.⁷³ Under these circumstances, the 43(a) claim would succeed.

More recently, in *Playboy Enterprises, Inc. v. Dumas*, the widow of artist Patrick Nagel brought a Lanham Act claim against Playboy for marketing a collection of poster reproductions of artwork created by Nagel under the name "The Playboy Collection by Patrick Nagel" and for promoting them as the "Nagel Collection."⁷⁴ Nagel had created the artwork for publication in *Playboy* at an earlier date, but Dumas argued that the reproductions violated the Lanham Act because she did not authorize or approve of the selection or quality of the reproductions.⁷⁵

Again, the court rejected the Lanham Act claim because there was no proof that a false impression of the product's origin was created. The terms "by Patrick Nagel" and "from the Playboy Collection" were literally true so the name of the collection was not false on its face.⁷⁶ Additionally, there were no violations based on alterations of the works in the Nagel collection. Physical alterations were made to four of the ten works of art for the collection: on three, a woman's breast was covered; on the fourth, only the top half of the work was used.⁷⁷ Since Dumas provided no objective evidence, either through expert testimony or through public surveys, that the public would be misled as to the origin of the work due to the alterations in the posters, the Lanham Act claim was dismissed.⁷⁸

Application of a substantial similarity test would be unlikely to change the result in *Playboy*. The description of the changes made to the artwork seems to indicate that, when viewed in their entirety, the works were substantially similar. Despite the negative result for the artist in this instance, such a result is entirely compatible with the policy considerations underlying the protection of an artist's right of integrity. Nagel had created the works and assigned the rights to the works to Playboy. The right of integrity in this context does not protect an artist from minor alterations in a work, only such editing and modification that results in a misrepresentation of the work.⁷⁹ If an edited work is substantially similar to

73. See *Rich v. RCA Corp.*, 390 F.Supp. 530 (S.D.N.Y. 1975) (Recent photo of plaintiff on cover of album containing songs recorded in the distant past was a false representation that the songs were new)

74. 831 F. Supp. 295, 301 (S.D.N.Y. 1993).

75. *Id.* at 315.

76. *Id.* at 316.

77. *Id.*

78. *Id.* at 317.

79. See e.g. *Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14, 24 (2nd Cir. 1976) (Extensive unauthorized editing of television show was a misrepresentation creating a false impression of origin); *Preminger v. Columbia Pictures Corp.*, 267 N.Y.S.2d 594 (N.Y. Sup. Ct. 1966), *aff'd*

the original work created by the artist, attributing the work to the artist causes no damage to the artist's reputation. But, where a work has been mutilated to the point where it is no longer substantially similar, the artist can suffer significant harm.⁸⁰

Both *Lish* and *Playboy* demonstrate that an artist who wants to protect his or her right of integrity through the use of the Lanham Act has to be prepared to prove consumer confusion as to the origin of the work resulting from the distortion of the work. These cases suggest that the artist will have to use survey evidence or convincing expert testimony that will show such confusion in the eyes of the public, even if there is some change or distortion of the artist's original work. Even where a work has been substantially edited with significant deletions (as in *Lish*, where nearly half of the original work was deleted), without this proof of consumer confusion as to origin, an artist is unlikely to succeed in court under a Lanham Act claim.

CONCLUSION

While *King* provided some guidance in articulating a standard by which to ascertain the accuracy of a "based upon" credit, it also demonstrated that the Lanham Act is not a proper vehicle for the protection of an author's moral rights. The Lanham Act does provide some limited protection for moral rights in certain situations. But, 43(a) does not protect authors against alteration of their work absent a false or misleading attribution to that author. Because the Lanham Act, as interpreted by the King court, allows for "based upon" attribution when the film draws in material respects from a literary work, regardless of what proportion of the film involves the short story, or how many unrelated scenes are tacked around the literary work, the Act does not sufficiently protect the author's right to attribution and integrity.

The standard used in *King* may help some artists protect their rights of attribution and integrity under limited circumstances. A better approach would be to use a "substantial similarity" analysis, similar to that used in copyright infringement and contract cases. Such a standard would allow those authorized to make derivative works enough flexibility to modify and edit works. Yet it would still prevent the harm to an artist's good name and reputation caused by association of his or her name with a work that has been mutilated and distorted to a point well beyond the artist's original creation.

However, post-*King* cases clearly show that the focus of the Lanham Act is preventing consumer confusion as to the source of a work, not protecting the artist from an unwanted change or a distortion of his or her work. As a result, a claim that may be a serious violation of the right of attribution or integrity, but

per curiam 269 N.Y.S.2d 913 (N.Y.Ct.App. 1966) (editing film for commercial interruptions was not mutilation of the film).

80. See Larry E. Verbit, *Moral Rights and Section 43(a) of the Lanham Act: Oasis or Illusion?* 78 TMR 579, 599 (1988).

1994]

MORAL RIGHTS

315

that does not fit squarely within the scope of 43(a) is likely to be rejected. This makes the Lanham Act a clumsy tool for safeguarding the moral rights of artists.

Rachel L. Wasserman

-