



A HOLLOW VICTORY FOR THE COMMON LAW?  
TRIPS AND THE MORAL RIGHTS EXCLUSION

BY MONICA KILIAN

ABSTRACT

With the adoption of moral rights legislation in the United Kingdom and the United States, it appeared that moral rights were on the way to becoming acceptable in Anglo-American jurisdictions. However, the adoption of the TRIPs Agreement expressly excluded the moral rights provision of the Berne Convention. TRIPs signals that all is not well with the integration of moral rights into common law societies. This Article discusses the issues that hamper the acceptance of moral rights. This Article concludes that by bringing economic and moral rights into the same arena and softening the dichotomy of economic versus personal rights, the harmonization of international copyright law will be advanced.

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EXCLUSION

MONICA KILIAN\*

I. INTRODUCTION

By 1995, when the Agreement on Trade Related Aspects of Intellectual Property Rights<sup>1</sup> (TRIPs) came into effect, moral rights legislation was part of at least two economically important common law countries: the United Kingdom<sup>2</sup> (U.K.) and the United States.<sup>3</sup> With the adoption of moral rights legislation in these two countries, it appeared that moral rights, long seen as a peculiarity of European copyright law, were on the way to becoming acceptable in Anglo-American jurisdictions.<sup>4</sup> With two important common law jurisdictions integrating moral rights into their national copyright laws, harmonization of international copyright laws appeared to be well underway. But then something unexpected happened: while the TRIPs Agreement obliged World Trade Organization (WTO) members to adhere to the substantive provisions of the Berne Convention for the Protection of Literary and Artistic Works of 1886 (“Berne”),<sup>5</sup> it expressly excluded Article 6bis, the moral rights provision.<sup>6</sup>

The exclusion of Article 6bis seems surprising, because both the U.S. and the U.K. are signatories to Berne and both have moral rights provisions as part of their national laws.<sup>7</sup> Therefore, one would expect that moral rights would be protected under TRIPs, a much more persuasive instrument than Berne due to its WTO dispute settlement provisions.<sup>8</sup> Clearly, TRIPs signals that all is not well with the integration of moral rights into common law, especially when it is clear that the final

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\* B.A., M.A., Ph.D., Master of Commercial Law Candidate 2003, University of Melbourne. She is Joint Managing Director of Lynx Engineering Consultants Pty Ltd in Australia.

<sup>1</sup> The TRIPs Agreement is Annex 1C of the *Marrakesh Agreement Establishing the World Trade Organization*, signed in Marrakesh, Morocco on 15 April 1994.

<sup>2</sup> Copyrights, Design and Patents Act 1988, c.48 (Eng.). The moral rights provisions came into effect in 1988. *Id.*

<sup>3</sup> Copyright Act of 1976, Pub. L. No. 94-553 (codified at 17 U.S.C. §§ 101-810 (1994)). The Visual Artists Rights Act of 1990 (VARA), which incorporates moral rights for visual artists, came into effect in 1991 and is found in various provisions of the U.S. Copyright Act. *See* 17 U.S.C. § 106(a) (1991).

<sup>4</sup> Interestingly enough, although moral rights are considered a long-standing French tradition, the term “moral rights” first appeared in a legislative journal only in 1872, while the term itself was not incorporated into French law until 1992. *See* Calvin D. Peeler, *From the Providence of Kings to Copyrighted Things (and French Moral Rights)*, 9 IND. INT’L & COMP. L. REV. 423, 426 (1999). However, the individual moral rights were declared by French courts in the 19<sup>th</sup> century: divulgation in 1828, paternity in 1836, and integrity in 1845. *Id.* at 447-449.

<sup>5</sup> Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971, Paris Act, art. 2 (codified in scattered sections of 17 U.S.C.).

<sup>6</sup> *Agreement Establishing the World Trade Organization*, Annex 1C, Article 9 (1994), available at [http://www.wto.org/english/docs\\_e/legal\\_e/final\\_e.htm](http://www.wto.org/english/docs_e/legal_e/final_e.htm) (last visited Mar. 13, 2003).

<sup>7</sup> *See supra* notes 2-3.

<sup>8</sup> *Agreement Establishing the World Trade Organization*, Annex 1C, Part V (1994), available at [http://www.wto.org/english/docs\\_e/legal\\_e/final\\_e.htm](http://www.wto.org/english/docs_e/legal_e/final_e.htm) (last visited Mar. 6, 2003).

version of TRIPs was drafted in accordance with the U.S. proposal, rather than that of the European Community (E.C.), which contemplated the inclusion of moral rights.<sup>9</sup> Indeed, we need not dig very deep to see how little moral rights legislation in the U.S. and the U.K. resembles that of the French model, generally considered the blueprint of moral rights.<sup>10</sup> The continued squabble over moral rights between common law and civil law countries is a stumbling block for harmonization of international copyright laws.

This paper discusses some of the issues that hamper the acceptance of moral rights in common law jurisdictions and explains how these jurisdictions have traditionally handled moral rights issues. An examination of moral rights provisions in the copyright laws of the U.S. and the U.K. will then show that these rights fall well below the standard set by Berne, which is not particularly onerous. Another strand of the discussion argues that the watered-down versions of moral rights enacted in the U.K. and the U.S. compromise the economic well-being of creators<sup>11</sup> and other interested parties, despite the fact that moral rights are generally considered to be non-economic.<sup>12</sup> However, there are significant economic benefits attached to moral rights, which affect not only creators but also copyright owners and owners of physical works of art. Integrity rights, in particular, have commercial value for third parties.<sup>13</sup> For example, collectors of a certain artist's work may be financially disadvantaged if this artist's work is mistreated in a way that cheapens his reputation (and thereby devalues their investment in his work), while the artist can suffer commercially in that he may receive less lucrative remuneration for future works.<sup>14</sup> By excluding moral rights, TRIPs thereby diminishes the overall economic benefits that can be derived from a work.

An equally important consequence of the rift between common law and civil law with respect to moral rights is its negative impact on the harmonization of copyright laws, which affects all creators wishing to assert their rights on an international level. The paper concludes that in the interest of advancing the harmonization of international copyright law, it may be necessary to re-think the conceptual framework of moral rights by bringing economic and moral rights into the same arena of discussion and softening the dichotomy of economic versus personal rights.

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<sup>9</sup> Alexander A. Caviedes, *International Copyright Law: Should The European Union Dictate Its Development?*, 16 B. U. INT'L. L. J. 165, 200 (1998).

<sup>10</sup> See *infra* note 18 and accompanying text.

<sup>11</sup> The word "creator" is used to signify the person whose work is eligible for copyright protection, whether he be an author, artist, or anyone else producing work eligible for copyright protection. The words "author," "artist" and "creator" are used interchangeably unless context demands otherwise.

<sup>12</sup> Peeler, *supra* note 4, at n.12.

<sup>13</sup> Henry Hansmann & Marina Santilli, *Authors' and Artists' Moral Rights: A Comparative Legal and Economic Analysis*, 26 J. LEGAL STUD. 95 (1997) (discussing the pecuniary interests created by moral rights for the artist and third parties).

<sup>14</sup> *Id.*

## II. WHY MORAL RIGHTS CLASH WITH COMMON LAW COPYRIGHT

*A. The artistic work: An extension of the author's personality, or a commodity?*

Moral rights are central to the (European) civil law understanding of modern intellectual property rights, but are essentially a foreign concept in the common law. Moral rights are generally defined as personal rights, that is, they attach to the creator's person and exist independently of any economic rights.<sup>15</sup> The author or artist, it is said, pours his mind and soul into his work, which becomes expression of his personality and as such is "subjected to the ravages of public use."<sup>16</sup> It is this indissoluble personal connection of the creator with his work that sets the stage for moral rights. French law is generally thought to give the most leeway to moral rights; indeed, France has been dubbed the "mother country" of moral rights.<sup>17</sup> For this reason, we will refer to French law as the blueprint for moral rights.<sup>18</sup>

From the common law point of view, on the other hand, copyright is principally an economic right attached to the object, as is made clear by the introductory section of the U.K. Copyright, Designs and Patents Act: "[c]opyright is a property right."<sup>19</sup> Once an author relinquishes his work (by making it available to the public), it becomes a tradable commodity. Apart from the right to benefit commercially from his creation, the author's link with the work is severed once he has made it available to the public. The work becomes an autonomous commodity at the mercy of market forces, contractual agreements, and statutory protection. The object of copyright law, as laid out in common law countries (prior to moral rights legislation), is the work itself, and the notion that the author could, or even ought to, retain a legally enforceable personal link to the work is considered to be inconsistent with the idea of the work as tradable and alienable property.

In contrast to the wide-spread view that moral rights are incompatible with the common law position on property rights, Henry Hansmann and Marina Santilli advance the proposition that moral rights are a species of property rights as understood by the common law and are therefore not as alien to common law

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<sup>15</sup> Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 544, 557 (1940).

<sup>16</sup> *Id.* at 557.

<sup>17</sup> Adolf Dietz, *The Moral Right of the Author: Moral Rights and the Civil Law Countries*, 19 COLUM. VLA J.L. & ARTS 199, 201 (1993).

<sup>18</sup> It is noteworthy, however, that the first French copyright law of 1793 closely followed the economic / public good purpose of copyright that was the purpose of the Statute of Anne in 1710 and of the first American copyright Act of 1790. Indeed, the Marquis de Condercet, who was instrumental in formulating early French copyright law, apparently preferred a "governmental policy which provided an economic means to maximize the social utility of the creative process." Peeler, *supra* note 4, at 431. Peeler further relates that due to a changing social and philosophical environment that shifted the balance towards the rights of the individual, moral rights appeared in French courts long before they were incorporated into French law. *Id.* at 431-432. Therefore we can conclude that common law and civil law notions of copyright emerge from a similar understanding of its purpose, which is to promote the social good and encourage the creation of new work while ensuring that authors benefit economically from their work.

<sup>19</sup> Copyrights, Design and Patents Act 1988, c.48, s.1 (Eng.).

principles as they may appear.<sup>20</sup> Hansmann and Santilli find a connection between moral rights and property rights in the doctrine of servitude, which creates a divided property right.<sup>21</sup> This usually occurs when a real estate property is sold, and the seller is affected by the purchaser's use of it (for example, if the seller retains a portion of real estate that can only be accessed through the property he has just sold). As a result, even though the title in the property has passed to another, the purchaser must respect the easement, which effectively creates an interest for someone who is not the legal owner of the property. In an analogous way, Hansmann and Santilli contend, an artist who sells his physical work continues to be affected by subsequent uses of this work.<sup>22</sup> Therefore, copyright laws that include moral rights can be seen to establish an exception to the prohibition of establishing a servitude on properties that are not real estate.<sup>23</sup> Thus, they argue, the very fact that moral rights adhere to the author via the physical work seems to indicate that a divided property right is contemplated, which belies the accepted common law position that all property rights are vested in the owner. Although their thesis is rather elegant, it has not been widely used to argue that moral rights can indeed fit into a common law framework of property rights.

Another way in which common law gives a property interest to a party that does not own the property is through a trust. Furthermore, the common law concept of a "chose in action" incorporates the idea of an intangible property right, whereby possession of the actual property is not at issue.<sup>24</sup> Clearly, then, granting rights to a property owned by another (which is one way of looking at an artist's continuing moral rights in his work of art) is not entirely incompatible with the common law, even though it goes against the grain of private property principles.

### *B. Freedom Of Contract And Public Good*

Due to the fact that moral rights attach to the author through his work, it is not surprising that the rights are considered inalienable and even, in some jurisdictions (such as France and Denmark), perpetual.<sup>25</sup> Contract is powerless to strip the author of his moral rights; the most he can do is agree to waive them. However, in French law at least, he cannot be held to his waiver, which of course begs the question why a

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<sup>20</sup> See Hansmann & Santilli, *supra* note 13, at 112.

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> *Id.*

<sup>24</sup> "Chose in action" is defined as "[a]n intangibly personal property right recognized [sic] and protected by the law . . . which confers no present possession of a tangible object . . ." BUTTERWORTHS AUSTRALIAN LEGAL DICTIONARY (Peter E. Nygh et al. eds., 1997), *available at* <http://www.butterworths.com.au> (subscription required). Although this right applies chiefly to financial obligations, the point is that the concept of a property right, which one does not physically possess, is a recognized legal principle.

<sup>25</sup> Although it can be argued that if moral rights pertain only to the person of the author, they ought to cease upon the author's death. However, they are in reality as much a personal right as a (albeit limited) property right, given that an author's moral rights are passed on to his legal heirs. Furthermore, as Roberta Rosenthal Kwall points out, an author's reputation is just as easily tarnished after death when he is not around to defend himself. Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 15 (1985).

waiver is necessary in the first place. The author's ability to change his mind is unlikely to be tolerated by countries whose legal traditions are steeped in the classical theory of contract law, where breach of contract is tantamount to treason.<sup>26</sup> It is not surprising, then, that common law jurisdictions are suspicious of moral rights that cannot be contractually dispensed. Thus, the notion of freedom of contract is compromised by the notion of the inalienability of moral rights, which cannot be contracted out.

Another area of concern for the common law is the fact that copyright protection is given, not to reward the author for his work, but to make it worth his while to create more works. At the same time, copyright protection encourages others to learn from his works and create new works of their own. Indeed, the earliest copyright law, the Statute of Anne, was enacted for the "encouragement of learned men to compose and write useful books."<sup>27</sup> Similarly, the purpose of U.S. intellectual property protection is to "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."<sup>28</sup> This view has been echoed by courts<sup>29</sup> as well as by legal commentators.<sup>30</sup> The doctrine of fair use, which English courts recognized a century before moral rights made their appearance in civil law,<sup>31</sup> reflects the "public good" purpose of copyright (which is one reason why some commentators find the fair use exception of VARA incompatible with moral rights).<sup>32</sup>

Freedom of contract, private property rights, and public good are some of the most important principles with which moral rights appear to conflict. Given the centrality of these principles in the common law tradition, it is no small achievement that common law countries not only consented by virtue of becoming signatories to abide by Article 6bis of the Berne Convention, but even went so far as to implement moral rights legislation in their domestic law.<sup>33</sup> However, despite the late appearance of moral rights in common law legislation, moral rights type issues have been litigated in common law courts prior to the enactment of moral rights legislation by using existing common law principles as well as statutory law.

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<sup>26</sup> During the heyday of classical contract theory, the contract itself was seen to be the only thing governing the legal relations between the parties, and contractual agreements had to be performed, regardless of their fairness: "[A] man is obliged, in conscience, to perform a contract which he has entered into, although it be a hard one." Morton J. Horwitz, *The Historical Foundations of Modern Contract Law*, 87 HARV. L. REV. 917, 918 (1974) (quoting J. Powell, *Essay Upon the Law of Contracts and Agreements*, at 229 (1790)).

<sup>27</sup> 8 Anne, c. 19 (1710).

<sup>28</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>29</sup> "Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the arts." 20th Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975).

<sup>30</sup> An interesting, if somewhat extreme, example is the argument put forward by Carl H. Settlemeyer III, who believes that moral rights must also encompass a "negative divulgation interest" whereby the artist may not withhold his art from the public. Carl H. Settlemeyer, *Between Thought and Possession: Artists' "Moral Rights" and Public Access to Creative Works*, 81 GEO. L. J. 2291 (1993).

<sup>31</sup> See Dane S. Ciolino, *Rethinking the Compatibility of Moral Rights and Fair Use*, 54 WASH & LEE L. REV. 33, 48 (1997).

<sup>32</sup> *Id.* at 51.

<sup>33</sup> Commentators are divided as to whether the U.S. incorporated VARA to appease domestic pressure groups or to adhere to Berne. See Ciolino, *supra* note 31 at 45-46 and accompanying notes.

### III. "TRADITIONAL" COMMON LAW WAYS OF DEALING WITH MORAL RIGHTS-TYPE ISSUES

The basic moral rights are the rights of attribution, integrity, and divulgation, and some countries provide for a fourth right to withdrawal.<sup>34</sup> The copyright laws of common law countries generally contain an analogous right to the right of disclosure in the form of the right of first publication or making available to the public. However, absent moral rights legislation, there are no analogous provisions for attribution and integrity rights. Given that false attribution and affecting a work's integrity could cause considerable harm to the author and/or the copyright owner, it is not surprising that remedies for such actions can be found in common law (although not necessarily in copyright law). Courts have used, among other things, trade practices and unfair competition laws, privacy laws, and contract law to decide on moral rights type issues. Moreover, common law claims such as defamation<sup>35</sup> and even invasion of privacy<sup>36</sup> have been used successfully to prohibit the publication of works whose integrity had been damaged. In the U.S., perhaps the most useful statutory law for integrity issues is § 43(a) of the Lanham Act,<sup>37</sup> which provides protection for unfair competition with respect to false designation of origin.<sup>38</sup> One drawback of the Lanham Act is that it applies to actions in commerce only, thus limiting its application to moral rights claims.

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<sup>34</sup> See Kwall, *supra* note 25, at Appendix (providing a brief rundown of the kinds of moral rights protection in selected countries). The data is taken from WIPO Copyright Law Survey, 1981. *Id.*

<sup>35</sup> Archbold v. Sweet, 174 Eng. Rep. 55 (N.P. 1832). In this case, the publisher made significant (and incorrect) changes and amendments to a work previously published and then published this new edition without the author's permission. *Id.* The court found that these alterations harmed the author's reputation. *Id.*

<sup>36</sup> Zim v. West Publ'n Co., 573 F.2d. 1318, 1326 (5th Cir. 1978) (applying the invasion of privacy analysis as it pertained to Zim's right to control the use of his name for commercial purposes).

<sup>37</sup> 15 U.S.C. § 1125(a) (1994). The relevant provisions for the purpose of this paper are in Section 1125 (false designations of origin, false descriptions, and dilution forbidden):

(a) Civil action.

(1) 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 –

(A) is likely to cause confusion, or to cause mistake, or to 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

(B) 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 believes that he or she is or is likely to be damaged by such act.

*Id.*

<sup>38</sup> See Diana Elzey Pinover, *The Rights of Authors, Artists and Performers Under Section 43(a) of the Lanham Act*, 83 TMR 38 (1993) (providing an overview of the Lanham Act in relation to attribution and integrity, as well as case law).



Conceived as trademark protection legislation and thus removed from copyright concerns, the Lanham Act has nevertheless been applied successfully to find infringements of moral rights where integrity and attribution were at issue and where the court could apply the “false designation of origin” criteria.<sup>39</sup> Although infrequently used for moral rights purposes,<sup>40</sup> the Lanham Act has won courts’ approval as a cause of action: “an allegation that a defendant has presented to the public a ‘garbled,’ . . . distorted version of the plaintiff’s work seeks to redress the very rights sought to be protected by the Lanham Act . . . and should be recognized as stating a cause of action under that statute.”<sup>41</sup> The Lanham Act has been used in a variety of cases, perhaps most notably in *Gilliam v. American Broadcasting Companies, Inc.*<sup>42</sup>

*Gilliam* is widely regarded as the landmark case where the court gave full attention to moral rights and expressed its approval of the artist’s rights of attribution and integrity. The court’s sympathy for moral rights can be gleaned from the following passage:

. . . the economic incentive for artistic and intellectual creation that serves as the foundation for American copyright law . . . cannot be reconciled with the inability of artists to obtain relief for mutilation or misrepresentation of their work to the public on which the artists are financially dependent. Thus courts have long granted relief for misrepresentation of an artist’s work by relying on theories outside the statutory law of copyright, such as contract law, *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952) (substantial cutting of original work constitutes misrepresentation), or the tort of unfair competition, *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265 (Mass. 1939) . . . Although such decisions are clothed in terms of proprietary right in one’s creation, they also properly vindicate the author’s personal right to prevent the presentation of his work to the public in a distorted form.<sup>43</sup>

The decision is notable in that it found for the artist even though there was no privity of contract between the two parties to the action.<sup>44</sup> However, *Gilliam* did not herald the arrival of moral rights for authors in the U.S.<sup>45</sup> As Ilhyung Lee comments,

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<sup>39</sup> *Id.* (containing an extensive list of the criteria).

<sup>40</sup> Marina Santilli, *United States’ Moral Rights Developments in European Perspective*, 1 MARQ. INTELL. PROP. L. REV. 89, 91-92 (1997) (quoting a U.S. court’s acknowledgment that using trademark law for works of art is a rarity). Santilli argues that in the U.S. protection of reputational interests has traditionally resided in state common law rather than in U.S. federal statutory law. *Id.* at 92.

<sup>41</sup> *Gilliam v. Am. Broad. Co., Inc.*, 538 F.2d 14 (1976) (applying the Lanham Act § 43(a) to resolve a copyright infringement suit).

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at \*26.

<sup>44</sup> *Id.* at \*17. The contract was, in fact, between the BBC and the ABC, whereas the artist’s contract was with BBC only. *Id.*

<sup>45</sup> Pinover, *supra* note 38, at 49. As Pinover points out, it is worth noting that despite the court’s rhetoric about moral rights, the decision was made on economic grounds: “Although the court speaks of harm to Monty Python’s reputation, it uses the commercial terms of lost profits and success. The artistic work is a product and one has a duty not to falsely represent its origin.” *Id.*

“the traditional rule under U.S. law is that the author does not retain moral rights in her work unless specifically provided for in the contract. Textual silence of the matter of moral rights favored the party opposing the author.”<sup>46</sup> In the U.S., therefore, apart from the limited number of cases governed by VARA, the author of a work eligible for copyright protection still needs to rely on existing legislation and common law principles.

As the above examples indicate, moral rights issues do receive attention in common law courts, even in the absence of specific legislation. However, just because some courts have found for the aggrieved artist (and where it can be safely assumed that a civil law court would do the same), we cannot infer that, because common and statutory law can be used to decide moral rights issues, specific legislation is superfluous to give effect to moral rights.<sup>47</sup> While the common law tradition does provide avenues for causes of action, these are inadequate substitutes for moral rights legislation. When compared with French law, “although personal rights results have been obtained in some situations and personality rights have been recognized [in U.S. law], the instances of extension of such rights hardly provide a sure basis for substantial protection of the interests concerned.”<sup>48</sup> Indeed, moral rights are not easily substituted with common law legal principles, mainly because the latter are unconcerned with an author’s personal rights and in many cases are unsuitable to bring a cause of action successfully. For example, as Roberta Rosenthal Kwall relates, “[g]iven that all of the substitute theories are supported by a theoretical basis different from that of the moral right doctrine, a successful claim may require elements of proof which are not directly applicable to a moral rights claim.”<sup>49</sup> In fact, the different results obtained by French and U.S. courts on the same issues only illustrate the chasm that exists between these two different legal systems.<sup>50</sup>

Apart from the few examples where courts have found for the artists in moral rights type claims, for the most part an aggrieved artist had to rely on contract law. Since the introduction of moral rights legislation into the copyright legislation of common law countries, how has this reliance on contract law changed? A brief review of the legislation in the U.S. and the U.K. will show significant holes when it comes to moral rights.

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<sup>46</sup> Ilhyung Lee, *Toward an American Moral Rights in Copyright*, 58 WASH. & LEE L. REV., 795, 813 (2001).

<sup>47</sup> See Michael B. Gunlicks, *A Balance of Interests: The Concordance of Copyright Law and Moral Rights in the Worldwide Economy*, 11 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 601 (2001) (arguing that moral rights are well catered to in common law countries, even absent specific moral rights legislation).

<sup>48</sup> Edward J. Damich, *The Right of Personality: A Common-Law Basis for the Protection of the Moral Rights of Authors*, 23 GA. L. REV. 1, 35 (1988).

<sup>49</sup> Kwall, *supra* note 25, at 23.

<sup>50</sup> Compare *Shostakovich v. Twentieth Century-Fox Film Corp.*, 196 Misc. 67, 80 N.Y.S.2d 575 (1948), *aff'd in 275 A.D. 692*, 87 N.Y.S.2d 430 (1940), with *Soc. Le Chant du Monde v. Soc. Fox Europe* [1953] *Recueil Dalloz* [D. Jur.] 16 (turning on the same facts, but decided differently in France and in the U.S.; the U.S. court refused to grant relief, whereas the French court found for the composer).

## IV. MORAL RIGHTS LEGISLATION IN THE U.S. AND THE U.K.

*A. United States*

The U.S. can boast bona fide moral rights provisions in its copyright legislation since 1990,<sup>51</sup> when the Visual Artists Rights Act (VARA) was incorporated into U.S. Copyright Law.<sup>52</sup> However, this legislation falls well short of the requirements of Berne: first, because it is restricted to the visual arts (whereas Berne applies to literary and artistic works),<sup>53</sup> and, second, because there are even further restrictions within its limited field of application.

U.S. Copyright Law concerns the “rights of certain authors to attribution and integrity.”<sup>54</sup> The moral rights here are the right of attribution (both positive and negative attribution rights), and the right to integrity. VARA goes a step further than French law in one respect: it gives the artist the right to prevent a “work of stature” from being destroyed.<sup>55</sup> However, this apparent exception is not as generous as it seems, as only authors of works of “stature” enjoy this right. Essentially, this provision can be interpreted as a matter of cultural heritage preservation, as it is unlikely that works by new or relatively unknown artists would be considered works of stature. Discrimination between works on account of aesthetic merit or “stature” is not envisaged in the Berne Convention. Here, then, is another instance where U.S. moral rights law does not comply with the spirit of Berne. Moreover, as Santilli remarks, the prohibition to destroy works of stature can be interpreted to be “consistent with the American copyright tradition more work-centered than author-centered.”<sup>56</sup> Thus, it is doubtful whether VARA is meant to comply with the obligations imposed by Berne.

Indeed, it is worth noting that most commentators agree that VARA was not enacted for the purpose of complying with Berne. This point may seem insignificant, but it gains importance in light of later developments in international copyright protection under TRIPs. Although it initially appears that VARA represents a step forward in international harmonization, in practice its provisions may well be irrelevant in international copyright disputes whenever action is brought under the (moral rights-free) TRIPs Agreement. The VARA provisions, then, are not so much an attempt of the U.S. to contribute to the harmonization of international copyright

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<sup>51</sup> See Peeler, *supra* note 4. VARA is not the first national moral rights law in the U.S. *Id.* In 1988, the National Film Preservation Act was enacted, which essentially protected the color integrity of films, recognizing that colorizing a film affected the reputation of the film maker (the film maker was given this right, not the copyright owner). The National Film Preservation Act of 1996, Pub. L. No. 104-285. This Act has been periodically repealed and replaced by a new one. The Act, however, is not part of the U.S. Copyright Act. Peeler, *supra* note 4.

<sup>52</sup> 17 U.S.C. §§ 106(A), 107 (1991) (stating the most relevant provisions regarding moral rights).

<sup>53</sup> Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971, Paris Act, art. 2 (codified at scattered sections of 17 U.S.C.).

<sup>54</sup> 17 U.S.C. § 106(A) (1991).

<sup>55</sup> See Art. L. 121-5 of the French Copyright Code (stating that in French law, the prohibition to destroy a work applies only to the master copy of an audiovisual work).

<sup>56</sup> Santilli, *supra* note 40, at 100.

law as an effort to appease the domestic artistic lobby, as VARA undoubtedly raises the stature of visual artists at home.<sup>57</sup>

Like moral rights legislation in other countries, the U.S. laws provide that moral rights cannot be transferred, but may be waived. Indeed, given the idea that inalienability is fundamental to moral rights, it would be inconsistent to provide otherwise. Moral rights in VARA are limited by fair use provisions, which are among the pillars of common law copyright. Perhaps the most contentious provision regarding fair use is the concluding phrase of section 107 which states, “[t]he fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.” Essentially, this denies the artist the right of divulgation that French law gives him. Therefore, the moral right of divulgation cannot be implied in American law because the fair use doctrine limits this right. The fair use exception, which essentially deprives an author of his moral rights, has predictably provoked heated debate.<sup>58</sup>

Perhaps the U.S.’ lapse regarding moral rights can be explained by the fact that as the world’s most important economy, it can afford, in some instances, to flout international compliance. The U.K., however, is in a different position. A common law country, it is also part of the E.C., and as such has, arguably, a more pressing duty to contribute to the harmonization of international copyright law, especially European copyright law. The moral rights provisions of the U.K.’s Copyright, Design and Patents Act<sup>59</sup> refer to a greater variety of works of intellectual creation than U.S. laws and at first glance appear to give reasonable protection. But do the U.K. rights adhere to the spirit of the Berne Convention, and are they compatible with moral rights of other E.C. countries? An examination of U.K. moral rights provisions shows that these questions cannot be answered affirmatively.

### *B. United Kingdom*

The U.K. has broader moral rights provisions than the U.S. For one, moral rights pertain to authors of literary, dramatic, musical or artistic works, as well as to directors of a film.<sup>60</sup> However, there are two major concerns with U.K. moral rights provisions: the formality requirement under section 78, and the myriad limitations and exceptions to moral rights.

Let us first consider the requirement for the author to formally assert his right of attribution. The right of attribution is fundamental to moral rights. Attribution

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<sup>57</sup> See e.g., Eric E. Bensen, *The Visual Artists’ Rights Act Of 1990: Why Moral Rights Cannot Be Protected Under The United States Constitution* 24 HOFSTRA L. REV. 1127 (1996) (arguing that VARA is unconstitutional, discriminatory and unnecessary); Lawrence Adam Beyer, *Intentionalism, Art, And The Suppression Of Innovation: Film Colorization And The Philosophy Of Moral Rights* 82 NW. U.L. REV. 1011 (1988) (arguing that the moral right of integrity is misguided and hinders innovation and creativity).

Although there is considerable support for VARA and moral rights in general among American scholars (notably Roberta Kwall, who has written extensively about the virtues of moral rights), not everyone is pleased with VARA.

<sup>58</sup> See, e.g., Ciolino, *supra* note 31.

<sup>59</sup> Copyright, Design and Patents Act, *supra* note 2.

<sup>60</sup> *Id.* at s.77(1).

also gives the most economic benefit to the author. After all, the name of an author or artist carries an intangible yet important economic benefit of goodwill, and therefore his ability to earn an income from his future work depends to a large degree on the recognition of his name. Thus, the moral right of attribution is vital to an author's economic prosperity and, along with the right to object to derogatory treatment, is his most important prerogative. Yet U.K. moral rights provisions are designed to put the onus of establishing attribution on the author.<sup>61</sup> Specifically,

[t]he author of a copyright literary, dramatic, musical or artistic work, and the director of a copyright film, has the right to be identified as the author or director of the work in the circumstances mentioned in this section; but the right is not infringed unless it has been asserted in accordance with section 78 (emphasis added).<sup>62</sup>

Section 78 (1) further provides:

[a] person does not infringe the right conferred by section 77 (right to be identified as author or director) by doing any of the acts mentioned in that section unless the right has been asserted in accordance with the following provisions so as to bind him in relation to that act.<sup>63</sup>

Subsections 2, 3 and 4 of section 78 prescribe how this assertion needs to be done for various works.<sup>64</sup> Furthermore, the section states: "[i]n an action for infringement of the right the court shall, in considering remedies, take into account any delay in asserting the right."<sup>65</sup> The above-mentioned sections of the Copyright, Design, Patents Act make it abundantly clear that an author needs to protect himself before the law will protect him. With respect to the notion that moral rights are inalienable personal rights, the need for an author to comply with formalities before he can claim a moral right is rather baffling.

Moreover, there are numerous exceptions to the right of attribution. Certain works are exempt, including computer programs and computer-generated work,<sup>66</sup> and works whose copyright is vested in the employer.<sup>67</sup> Authors cannot claim the right when the work in question has been used in accordance with the provisions in section 79(4), whereby one of the most notable provisions regards fair dealing.<sup>68</sup> Perhaps the most far-reaching exceptions (i.e., those with significant economic impact) are found in section 79(6), which states:

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<sup>61</sup> Most books published in the U.K. after the moral rights provisions took effect carry a statement asserting the author's moral rights. Presumably, the author has no right to attribution if he has neglected to assert this right (of course, in this case he could resort to trade practices law, defamation law, or other relevant law).

<sup>62</sup> Copyright, Design and Patents Act, *supra* note 2 at s.77.

<sup>63</sup> *Id.* at s.78(1).

<sup>64</sup> *Id.* at s.78(2)(3)(4).

<sup>65</sup> *Id.* at s.78(5).

<sup>66</sup> *Id.* at s.79(2).

<sup>67</sup> *Id.* at s.79(3).

<sup>68</sup> *Id.* at s.79(4)(a).

The right does not apply in relation to the publication in –

- (a) a newspaper, magazine or similar periodical, or
- (b) an encyclopedia, dictionary, yearbook or other collective work of reference, of a literary, dramatic, musical or artistic work made for the purposes of such publication or made available with the consent of the author for the purposes of such publication.<sup>69</sup>

In effect, the outlined exceptions affect a vast area of literary output—the public media—on which many authors depend for their income. Keeping in mind that these exceptions do not refer to mere news items, which are not copyrightable and indeed are specifically mentioned as an exception in section 79(5),<sup>70</sup> they do apply to any contribution made in these publications.<sup>71</sup> It can be argued that denying an author the right to attribution in the media is correlative with denying him the right to full economic exploitation of his work. For example, his byline would increase market recognition of his work, thereby influencing the level of remuneration he will receive for future work. In effect, authors writing for the kinds of publications outlined in section 79(6) need to make attribution a term of their contract with the publisher.

The exception to the right of attribution flows on to the right to object to derogatory treatment.<sup>72</sup> The exceptions to the right to object to derogatory treatment are outlined and they apply to the same range of publications as the exceptions to the right of attribution.<sup>73</sup> Combined, the exceptions to the right of attribution and to the right to object to derogatory treatment can severely affect not only reputation, but also earning power and the author's ability to attract new employers, commissioners, and purchasers of his work.

Section 79(4) provides that the right of attribution is not infringed when something done in relation to the work would not otherwise infringe the copyright, such as fair dealing.<sup>74</sup> This exception is similar to the U.S. law, where fair use of an artistic work is permitted.<sup>75</sup> A somewhat arresting provision is that estoppel can be applied to justify exceptions to moral rights. Section 87(4) reads that “[n]othing in this Chapter [on moral rights] shall be construed as excluding the operation of the general law of contract *or estoppel in relation to an informal waiver* or other transaction in relation to any of the rights mentioned in subsection (1) [emphasis added].”<sup>76</sup> Essentially, this gives the potential infringer a wide variety of defenses, while providing the author with a set of narrowly defined rights. It is somewhat perplexing that an author can waive his moral rights informally, but needs to assert them formally.<sup>77</sup> In fact, it is difficult to see how U.K. moral rights provisions

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<sup>69</sup> *Id.* at s.79(6).

<sup>70</sup> *Id.* at s.79(5) (stating that the right does not apply to works made for the purpose of reporting current events).

<sup>71</sup> *Id.* at s.79(6).

<sup>72</sup> *Id.* at s.80.

<sup>73</sup> *Id.* at s.81.

<sup>74</sup> *Id.* at s.79(4).

<sup>75</sup> 17 U.S.C. § 107 (1991).

<sup>76</sup> Copyright, Design and Patents Act, *supra* note 2, at s.87(4).

<sup>77</sup> Tony Martino, *R-E-S-P-E-C-T—That's What Moral Rights Mean to Me*, 142 N.L.J. No 6563, 1084 (1992). Martino makes the interesting comment that the reason why the right of attribution needs to be formally asserted stems from a deliberate misreading of the Berne Convention. *Id.*

significantly contribute to the existing rights of authors under other statutory and common law.<sup>78</sup>

#### V. U.K. AND U.S. CASE LAW

Does case law provide an indication how moral rights were applied or will be developed further in the United States and the United Kingdom? Considering that each country has had some form of moral rights legislation in place since 1988 (U.K.) or 1990 (U.S.), we would expect a slowly growing body of court decisions. However, case law on this issue is scarce. There is at least one significant case decided in the U.S. under VARA,<sup>79</sup> but it appears there are none in the U.K.<sup>80</sup>

An article co-written by a legal practitioner regarding a case study of derogatory treatment of an artistic work provides some insight as to why there is no case law on statutory moral rights in the U.K..<sup>81</sup> The authors contend that moral rights are more difficult to enforce by statutory protection than through contractual obligations.<sup>82</sup> Therefore, they suggest that moral rights should be specifically incorporated into a commissioning contract – an odd situation, where statutory protection is considered so ineffectual that they recommend it become an express term of a contract.<sup>83</sup> Surely a main purpose of statutory protection is to avoid the need to incorporate moral rights in a contract, thereby relieving the artist of having to negotiate these rights for himself, usually with a party with more bargaining power. The U.K. case study once more demonstrates the reluctance of common law countries to embrace moral rights fully and shows the apprehension with which legal practitioners view these rights. The fact that there is no U.K. case law on moral rights under the Copyright, Design and Patents Act to date speaks for itself.

Neither is VARA case law prolific. *Carter v. Helmsley-Spear*<sup>84</sup> is useful insofar as the court reached its decision by applying VARA and interpreting some of its provisions. The court found for the defendant because the plaintiff artist's work was

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Berne's wording, that an author has the right to "claim authorship," (article 6bis(1) of the Berne Convention) was apparently read to imply a right that needs to be asserted. *Id.*

<sup>78</sup> *Id.*

<sup>79</sup> *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77 (2d Cir. 1995).

<sup>80</sup> Mike Holderness, *Moral Rights and Authors' Rights: The Key to the Information Age*, 1 THE J. OF INF. L. & TECH. (1998) (reporting that as of 1998 there is no U.K. case law on moral rights), available at [http://elj.warwick.ac.uk/jilt/infosoc/98\\_1hold/contentf.htm](http://elj.warwick.ac.uk/jilt/infosoc/98_1hold/contentf.htm). To my knowledge, there has not been any since then.

<sup>81</sup> Nicola Solomon & David Mitchell, *Moral Rights – A Case Study*, 141 N.L.J. No. 6531, 1654 (1991).

<sup>82</sup> *Id.* In the case study, an artistic work commissioned for exhibition in a public place is obscured by additional fixtures that dramatically mute the impact of the work. *Id.* Solomon and Mitchell point out that it is for the judge to decide whether placing fixtures or furniture that do not damage the actual artistic work can be taken to mean derogatory treatment. *Id.* The considerable space for judicial discretion adds to the uncertainty of the legislative provisions. *Id.*

<sup>83</sup> *Id.* Even when moral rights are part of the terms of contract, enforcing these rights may still be quite difficult. *Id.* Solomon and Mitchell relate that the artist and her lawyer spent months trying to rouse public sympathy for her cause through a media campaign and by appealing to the arts community – all in an effort to put her in a "better position to negotiate her claim," which, fortunately, she had the foresight to incorporate into her commissioning contract. *Id.*

<sup>84</sup> *Carter*, 71 F.3d at 82-88.

a work for hire, which is specifically excluded under VARA.<sup>85</sup> In *Pavia v. 1120 Avenue of the Americas Associates*<sup>86</sup> the court declared that continuing to exhibit a work of art that had been altered without the artist's consent before VARA came into effect did not infringe the artist's rights under VARA. In another case brought under VARA, *Gegenhuber v. Hystopolis Productions, Inc.*,<sup>87</sup> the court found that whatever was not expressly included in VARA could not be protected by it; specifically, the plaintiff was not entitled to the right of attribution with regard to a puppet show.<sup>88</sup> Other cases decided under state moral rights laws only tangentially looked at VARA. For example, *Lubner v. Los Angeles*<sup>89</sup> was brought under the California moral rights statute<sup>90</sup> and the court merely speculated what the outcome would be had the case been tried under VARA.<sup>91</sup> Overall, federal moral rights provisions have not been tested with any degree of thoroughness in U.S. courts.

## VI. CONCLUSION

Given that it can be demonstrated that the economic right of exploitation granted by copyright is intrinsically linked with moral rights, it is surprising that some commentators, and courts, from common law countries insist on brushing off moral rights as a kind of foreign disease that would do irreparable harm to cherished common law positions on copyright. There is even the impression that moral rights in Europe are treated with a "gospel"<sup>92</sup>-like fervor and should therefore be approached with caution by the rational (read: common law) mind. Perhaps this aversion to moral rights can be traced, at least in the U.S., to egalitarian principles that are fundamental to the U.S.' self-perception.<sup>93</sup> After all, moral rights are premised on the supposition that the artist is a special type of worker, whose product falls into a different category than other products, simply because it originates in the mind. The acceptance of moral rights depends, then, on a particular view of the role of the artist and his work and thus hinges on a particular cultural paradigm: one which gives artistic and literary works an enhanced status exceeding that of other types of works produced by human endeavor. Cultures that do not share this view of the value of artistic creation, and in particular the notion of the artist's inalienable personal connection with the work, are invariably at odds with the ideal of moral

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<sup>85</sup> *Id.* at 85.

<sup>86</sup> 901 F. Supp. 620, 628 (S.D.N.Y. 1995).

<sup>87</sup> No. 92-C-1055, 1992 WL 168836, \*4 (N.D. Ill. 1992). See also Roberta Rosenthal Kwall, *How Fine Art Fares Post VARA*, 1 MARQ. INTELL. PROP. L. REV. 1, \*38 (1997).

<sup>88</sup> *Gegenhuber*, 1991 WL, 168838 at \*4.

<sup>89</sup> 53 Cal. Rptr. 2d 24 (Cal. Ct. App. 1996).

<sup>90</sup> *The California Art Preservation Act*, CAL. [PROPERTY] CODE § 987(a) (West 1982 & Supp. 1995).

<sup>91</sup> Kwall, *supra* note 25 at 15-16. Kwall discusses a range of decisions that take into account moral rights issues. *Id.* However, it is interesting to note that in most cases VARA did not apply, frequently because courts sidestepped the question whether VARA preempts state law. *Id.*

<sup>92</sup> Sheldon W. Halpern, *Of Moral Rights and Moral Righteousness*, 1 MARQ. INTELL. PROP. L. REV. 65, 68 (1997).

<sup>93</sup> *Id.* at 65. See also Eric E. Bensen, *The Visual Artists' Rights Act Of 1990: Why Moral Rights Cannot Be Protected Under The United States Constitution*, 24 HOFSTRA L. REV. 1127 (1996) (decrying that moral rights are unfair).



rights. And if cultural incompatibility regarding the status of artistic works is compounded by different legal traditions, we can see why it has been difficult for common law countries to acknowledge the worthiness of moral rights.<sup>94</sup>

Another reason why moral rights are not readily accepted in the common law countries may simply be because discussions about the merits of moral rights tend to be one-sided. With few exceptions,<sup>95</sup> current debate revolves around how the common law copyright tradition could adapt to civil law's understanding of author's rights. More specifically, the debate centers around how and why common law should implement more incisive moral rights legislation. The obligation flows in one direction only, assuming that as an offspring of "natural law," moral rights represent a facet of the "human condition" and should therefore find unquestioned universal acceptance.<sup>96</sup> Such an unidirectional flow of expectations rarely augurs well for international cooperation. Indeed, as we have seen, common law countries go out of their way to preserve as much as possible of their own legal tradition even while paying lip service to moral rights.

It is clear that moral rights are important, not only for an author's personal reputation, but also for his economic benefit and that of third parties.<sup>97</sup> It is therefore more perplexing that much legal discourse insists on a separation of moral and economic rights, as if these two rights had no points of convergence.<sup>98</sup> However, if we looked at moral rights, not only as an extension of "natural law" and thus an inherently personal right, but also as an extension to the economic rights of the author granted by copyright law, and, further, if moral rights were to pertain not only to natural persons but also to other legal entities (after all, it can be argued that companies have reputations as much as people do), then perhaps the common law / civil law dialogue on moral rights would run a smoother course. In other words, repackaging the discourse of moral rights from a strictly personal to a personal *and*

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<sup>94</sup> It is telling that the United Kingdom enacted moral rights only in 1988, even though it was one of the earliest signatories to the Berne Convention.

<sup>95</sup> Santilli offers a minority voice with her suggestion that the VARA fair use exception should not be criticized for its deficiency in granting moral rights, but, rather, could "provide a possible model to be transplanted into the Berne Convention provisions on moral rights or as part of the future regulation of moral rights within the European community." Santilli, *supra* note 40, at 95. While Santilli has in mind the difficulty European courts face in balancing the interests of the artist and of the public or other legitimate stakeholders, it is nevertheless questionable whether such a severe curtailment of moral rights (as found in the VARA fair use exception) would indeed be acceptable in those European countries with a strong moral rights tradition.

<sup>96</sup> Natural law gives rise to basic, universal human rights. According to the 1948 U.N. Universal Declaration of Human Rights, human rights also encompass an author's moral rights: "Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author." *U.N. Universal Declaration of Human Rights*, art 27(2), 1948. For a further discussion of this theme, see Thierry Joffrain, *Deriving a (Moral) Right for Creators*, 36 *TEX. INT'L. L.J.* 735 (2001).

<sup>97</sup> Santilli, *supra* note 40, at 90 (noting that the fact that third parties also derive an economic benefit from moral rights is usually overlooked when moral rights are seen merely as personal rights of the creator). She further remarks that, "greater attention to the mixed interests served by the moral rights doctrine would improve our understanding of the conflicts to which they give rise and offer specific insights for future statutory developments." *Id.*

<sup>98</sup> This dualism is demonstrated not only in legal scholarship and commentary, but also in legal texts and legislation. For example, the Berne Convention clearly separates economic and moral rights. Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971, Paris Act, art. 6bis (codified at scattered sections of 17 U.S.C.).

economic level might prove be one way of working towards harmonization of copyright laws. Unfortunately, adhering to a strict moral rights / economic rights dichotomy has only led to weaker overall rights for the author under TRIPs, the most enforceable, and hence important, intellectual property treaty to date.