

GIVING THE DEVIL ITS DUE: ACTORS' AND PERFORMERS' RIGHT TO RECEIVE ATTRIBUTION FOR CINEMATIC ROLES*

I. INTRODUCTION

Actors'¹ and performers'² careers are to a large degree dependent on sufficient recognition of their creative contributions over a period of time. To this end, credit is a significant means of linking a carefully cultivated talent with a performer's name.³ In the seminal article on credit, Berman and Rosenthal note that "[i]t can be fairly said that in the entertainment industry the credit clauses of an agreement are often considered of greater importance than the provisions for monetary compensation."⁴ Credit confers identity on performers,⁵ which establishes a status that they can exploit in the same or other media.⁶ This has significance for performers who can emphasize their accomplishments and develop a rapport with audiences, in addition to promoting forthcoming work. Credit also has significance for insiders in the entertainment industry because it establishes a performance track record.⁷

* This Note is dedicated to David Blumenfeld.

¹ The term "actor" as used in this Note shall mean any person who appears in a cinematic role in such manner as to be visually and audibly identifiable in full. Leading or primary actors are those persons who are the film's protagonists or who have supporting roles.

² The term "performer" as used in this Note shall mean actors, as well as those persons who perform special effects or specialty rôles. Performers are not necessarily visually and audibly identifiable in full, because they may only contribute vocals or be presented in a manner calculated to create the illusion that a leading actor is actually achieving the entire role.

³ "[C]redit—also called billing—is the listing of a person's or company's name next to the function which that person or company performs with respect to an entertainment venture." 1 T. SELZ & M. SIMENSKY, *ENTERTAINMENT LAW* § 8.01 (1985) (emphasis omitted).

⁴ Berman & Rosenthal, *Screen Credit and the Law*, 9 *UCLA L. REV.* 156, 156 (1962).

⁵ 1 T. SELZ & M. SIMENSKY, *supra* note 3, §§ 9.11 to .14. Compare *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 189 Cal. Rptr. 20 (1983) with *Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 140 Cal. Rptr. 921 (1977).

⁶ 1 T. SELZ & M. SIMENSKY, *supra* note 3, §§ 9.03 to .06.

⁷ *Paramount Prods. v. Smith*, 91 F.2d 863, 867 (9th Cir.) (Wilbur, J., dissenting), *cert. denied*, 302 U.S. 749 (1937); *Poe v. Michael Todd Co.*, 151 F. Supp. 801, 803 (S.D.N.Y. 1957); see also *Tamarind Lithography Workshop v. Sanders*, 143 Cal. App. 3d 571, 576-78, 193 Cal. Rptr. 409, 412-13 (1983); *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 645, 189 Cal. Rptr. 20, 23 (1983); *Lloyd v. R.K.O. Pictures*, 136 Cal. App. 2d 638, 289 P.2d 295 (1955); cf. *Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 855-59, 140 Cal. Rptr. 921, 924-27 (1977); *Zorich v. Petroff*, 152 Cal. App. 2d 806, 809, 313 P.2d 118, 122 (1957). See generally Borchard, *Trademarks and the Arts*, 7 *ART &*

Securing market recognition through public exposure and industry awareness of talent and experience grants performers leverage with which to bargain; increased bargaining power determines rights in subsequent deals. These rights will consist of more prominent billing and greater remuneration, which will in turn generate more leverage. Thus, the successful performer may be carried by the momentum of the billing system; whereas, the performer incapable of developing his reputation is subject to a vicious circle. Lack of public acclaim or insider awareness prevents such a performer from acquiring the very leverage he needs to identify himself with his work, and prevents his attaining other employment.⁸ The bottom line is that billing is crucial to obtaining subsequent employment.

A number of guilds,⁹ well aware of this fact, explicitly provide for accreditation in their agreements.¹⁰ These provisions allow writers, directors, and producers with private employment contracts in the theater, film, and television industries to incorporate by reference credit provisions from the applicable guild agreements.¹¹ However, the guild agreement covering actors is silent as to accreditation clause specifics because this matter is individually negotiated between producers and actors.¹² An important actor's contract will require extensively detailed and intricate credit clauses,¹³ but lesser known actors may receive

THE LAW 1, 11 (1982); see also Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1546-47 (1972) [hereinafter cited as Comment, *Artistic Integrity*]. But see *Film Credits Stir Debate*, N.Y. Times, Dec. 28, 1983, at C17, col. 1.

⁸ 1 T. SELZ & M. SIMENSKY, *supra* note 3, at § 9.04. Matters concerning nature, designation, location, prominence, and arbitration of credits among the respective recipients are not within this Note's scope. See *id.* at §§ 8.01 to .05.

⁹ *Id.* at § 9.02 provides that:

[t]he Screen Actors Guild collective bargaining agreement, relating to performers in motion picture and television productions, also reflects an awareness of credit's Recognition Value. This agreement attempts to secure the Recognition Value of billing for its members by requiring credit for up to 50 performers in a theatrical motion picture, regardless of the size of their roles. When, in mid-1982, the union representing motion picture and television editors formulated the issues for upcoming collective bargaining negotiations, screen credits for members was a major demand. The union sought a credit, appearing by itself with other credits at the start of a film, for all editors of movies 60 minutes or longer in running time. In addition, the union sought separate credits for the principal sound and music editors working on films of such length.

Id. (citations omitted); cf. Berman & Rosenthal, *supra* note 4, at 157.

¹⁰ 1 T. SELZ & M. SIMENSKY, *supra* note 3, at § 9.02; Honeycutt, *Whose Film Is It Anyway?*, AM. FILM, May 1981, at 34, 34-35.

¹¹ Berman & Rosenthal, *supra* note 4, at 157.

¹² *Id.*

¹³ *Id.*

credit, at the producer's discretion.¹⁴

This Note will explain that performers' rights have not been consistently protected due to legal and historical emphases on tangible pecuniary rights, as opposed to intangible personal ones.¹⁵ This Note will also summarize the law relevant to the attribution of credit. It will demonstrate that the right to receive credit is still in its nascent doctrinal stage, due to a jurisprudence that relies heavily on freedom of contract principles.¹⁶

First, this Note will propose overt recognition of the right *to* publicity, that is, the right to receive credit. The right to publicity differs from the right *of* publicity,¹⁷ since the latter involves the right of public and commercial figures to control their

¹⁴ Chase, *No Screen Credit But Lots of Attention*, N.Y. Times, June 10, 1983, at C17, col. 2.

¹⁵ See *infra* text accompanying notes 95-134.

¹⁶ Comment, *Artistic Integrity*, *supra* note 7, at 1545-46 (discussing Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953), which is cited for the proposition that the phrase "right to publicity" was coined by this court [sic]). Courts also have mistakenly referred to "right of publicity" as "right to publicity." See, e.g., Lerman v. Flynt Distrib. Co., 745 F.2d 123, 133-34 (2d Cir. 1984), *cert. denied*, 105 S. Ct. 2114 (1985).

¹⁷ Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 677 (1981) (defining the right of publicity). Some thirty years ago in *Topps Chewing Gum*, the Court of Appeals for the Second Circuit formally recognized the right of publicity as a valid legal interest. Note, *An Assessment of the Commercial Exploitation Requirement as a Limit on the Right of Publicity*, 96 HARV. L. REV. 1703, 1704-05 (1983) [hereinafter cited as Note, *Commercial Exploitation*]. The interest protected from commercial misappropriation is the monetary value that attaches to names, images, and likenesses of public figures. See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) (a public figure's property interest in some or all facets of himself is subject to his sole decision whether or not to use them in a commercial context). Note, *Commercial Exploitation*, *supra* note 17, at 1706-07.

There are three requirements that must be met to establish a prima facie case of violation of the right of publicity: (1) that the plaintiff's name, likeness, or image has publicity value; (2) that the plaintiff has exploited his name, likeness, or image by assigning the interest or using same in commercial endeavors; and (3) that the defendant appropriated the name, likeness, or image without consent for commercial purposes. *Lerman v. Chuckleberry Publishing*, 521 F. Supp. 228, 232 (S.D.N.Y. 1981) (citations omitted), *amended and consolidated by*, 544 F. Supp. 966 (S.D.N.Y. 1982), *rev'd on other grounds sub nom.* *Lerman v. Flynt Distrib. Co.*, 745 F.2d 123 (2d Cir. 1984), *cert. denied*, 105 S. Ct. 2114 (1985).

The first requirement presupposes that the plaintiff has developed a property interest with financial value; in short, he is an established celebrity. Most unestablished performers, if not all, lack this status. The second requirement will bar virtually all unestablished performers because their commercial endeavors are unrealized.

Most importantly, the evil that the right of publicity addresses in the third requirement is that a plaintiff's name was used in a way that unjustly enriches the misappropriator. *Lerman*, 745 F.2d 123.

Unlike the right to publicity, the issue is not that the plaintiff is not denied credit. Rather, he is denied the exercise of choice as to where his name, likeness, or image will appear. However, the third requirement, misappropriation, duplicates an aspect of the common law tort of unfair competition, which prohibits unjust enrichment in commercial practices. Krigsman, *Section 43(a) of the Lanham Act as a Defender of Artists' "Moral Rights"*, 73 TRADE-MARK REP. 251, 262 (1983); see also *infra* text accompanying notes 149-238.

presentations of themselves to the public.¹⁸ Therefore, the right of publicity does not encompass those persons who are not already well established because they have no marketable personalities. In fact, the right to publicity concerns the right to establish one's personality to the point where the right of publicity will then protect the use of that personality.

Second, this Note will show that the judiciary has specifically used the law of unfair competition¹⁹ to prevent misrepresentations as to the sources of services where a performer's name has been substituted for that of another performer.²⁰ The substitution itself constituted misrepresentation and was actionable;²¹ yet it is unclear under the law of unfair competition whether "omission" has the same legal effect as substitution, since there has been no representation at all. This Note proposes to equalize the concept of omission with that of substitution. Thus, omission of a performer's name also would be actionable, since the violation of law would lie in the failure to credit the performer responsible, and would in effect treat "silence" as a failure to affirmatively disclose the source of the performed work. Any denial of credit under this analysis should be actionable, because it deprives the performer of essential economic rights.²²

Third, this Note posits that performers, as well as leading actors, who make substantial contributions, are entitled to credit.²³

II. BACKGROUND

A. *Rationale for Protection*

The United States' democratic heritage is premised on enfranchisement of a broadly based group of property owners.²⁴ As Alexis de Tocqueville observed, the United States had not so much abandoned the aristocratic model of a privileged elite, but

¹⁸ Shipley, *supra* note 17, at 673, 682.

¹⁹ See *infra* note 151.

²⁰ Smith v. Montoro, 648 F.2d 602 (9th Cir. 1981); see also text accompanying notes 186-99.

²¹ See *infra* text accompanying notes 191-95.

²² 1 J. GILSON, TRADEMARK PROTECTION AND PRACTICE 188-89 (Supp. 1985).

²³ Cf. *Make-up Union Gets \$10,000 in Damages over 'Thing' Credit*, Variety, June 30, 1982, at 4, col. 1; *Harwood, Hooper Awarded 15G Damages for 'Slight'; Confirm Spielberg Spat*, Variety, June 23, 1982, at 3, col. 3. This notion is consistent with and follows from affirmative disclosure and pecuniary interests inherent in billing. Despite the importance of accreditation, there has been little attention paid to this exact issue; see also *infra* text accompanying notes 239-50.

²⁴ See 2 A. DE TOCQUEVILLE, DEMOCRACY IN AMERICA 50-55 (H. Reeve trans., P. Bradley rev. perm. ed. 1945).

merely had debased it by spreading economic benefits over a wider spectrum of the population.²⁵ In order to obtain the promise of unlimited progress and prosperity envisioned by the settlers,²⁶ an investment oriented approach towards the future was necessary.²⁷ This strong emphasis on commercial development is reflected in the Constitution's copyright clause,²⁸ which by its terms fosters sacrifice and utility for the greater development of the public weal. Thus, the economic rights offered to authors are limited and primarily in the interest of society.

In *Zacchini v. Scripps-Howard Broadcasting Co.*,²⁹ the Supreme Court reaffirmed the economic rationale of the copyright clause's property protection:

"The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.' Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered."³⁰

Zacchini, however, involved neither copyright nor patent law, but a performer's right of publicity to control where his human cannonball act would be shown. The Court stated that the economic value of *Zacchini's* act depended upon his exclusive control of its publicity. If the defendants were allowed to televise *Zacchini's* performance, the public would have less reason to pay *Zacchini* to see the act live. Failure to protect the performer's property interest in his own performance would not promote the public's access to entertainment, the Court reasoned, since performers would be less inclined to produce work that could not be protected.³¹

Moreover, the performer's developed talent is valuable because he has invested skill, industry, and expense. Protection of these interests also prevents unjust enrichment. "No social purpose is served by having the defendant get free some aspect of the plaintiff

²⁵ *Id.* at 256-62.

²⁶ S. BERCOVITCH, *THE AMERICAN JEREMIAH* 47-49 (1978).

²⁷ Rosen, *Artists' Moral Rights: A European Evolution, An American Revolution*, 2 CARDOZO ARTS & ENT. L.J. 155, 181 (1983).

²⁸ U.S. CONST. art. I, § 8, cl. 8. Congress has the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." *Id.*; see also Rosen, *supra* note 27, at 179; Shipley, *supra* note 17, at 681; Note, *Commercial Exploitation*, *supra* note 17, at 1706-07.

²⁹ 433 U.S. 562 (1977).

³⁰ *Id.* at 576 (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

³¹ *Id.* at 575-76.

that would have market value and for which he would normally pay.' ”³² To allow others to indiscriminately use developed talents of a performer could impair the value of those attributes, diminishing public respect for the performer’s name.³³

Furthermore, the economic incentive ultimately benefits the public, since the performer is inspired to win public acclaim or gain prominence by achieving the highest levels of his art. Such expositions benefit society by providing entertainment and inspiration.³⁴

The same arguments may be applied in the context of the right to publicity, since the property interest to be protected, the performer’s name and reputation, is the same. If the performer’s work is not credited, the public may have less reason to associate subsequent roles with that performer, who could then lose increased bargaining power. Public access to entertainment would be frustrated, moreover, since the audience would be deceived by misrepresentations as to accreditation, because the service’s origination was improperly designated.³⁵

B. *A Modern Definition of Property*

The *Zacchini* Court’s espousal of intangible property rights associated with a performer’s right to control when his performance would be shown stems from a modern definition of “property.” The original definition was limited to Blackstone’s

³² *Id.* at 576 (quoting Kalven, *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)); see also Shipley, *supra* note 17, at 682 n.60 (right of publicity is analogous to a business’ goodwill in its name).

³³ *Zacchini*, 433 U.S. at 576; see generally Note, *Commercial Exploitation*, *supra* note 17, at 1706-07.

³⁴ *Zacchini*, 433 U.S. at 577.

³⁵ *Paramount Prods. v. Smith*, 91 F.2d 863, 867-68 (9th Cir. 1937) (Wilbur, J., dissenting) (subsequent history omitted):

[T]o give screen credit to a person not reasonably entitled thereto would be a fraud upon the public, while, on the other hand, to deny the author his contract rights if the play produced is based upon his story would be a violation of the contract.

In view of these conflicting considerations it is clear that in construing the terms of the contract for screen credit some attention must be given to the question as to whether or not the giving of such credit to a play which has been substantially changed would in effect be a falsehood tending to deceive the public.

... [T]he question is, has the story been so far departed from in the play that it cannot reasonably be said to be based upon the plaintiff’s story, having due regard to the rights of the plaintiff to credit for his achievement in producing the story, and the right of the public not to be deceived by reason of credit falsely given to an author.

Id.; cf. *Vargas v. Esquire, Inc.*, 164 F.2d 522, 526 (7th Cir. 1947); see generally J. WHICHER, *THE CREATIVE ARTS AND THE JUDICIAL PROCESS: FOUR VARIATIONS ON A LEGAL THEME*, 10-14 (1965).

conception of property, the absolute dominion over tangible things.³⁶ This emphasis on actual and exclusive ownership of physically present chattels was “dephysicalized”³⁷ by a later generation of legal scholars.³⁸ In addition to consisting of rights over tangible things in accord with the traditional view, property could consist of any valuable right or interest.³⁹ However, if property were to include all legal relations, there would have to be some determination of the degree of protection for each interest. Moreover, the concept of ownership would be threatened by an ever-increasing subdivision of interests in property. While any valuable interest could be property, value does not in itself necessarily confer property status that a court will recognize. Consequently, courts have ascertained interests to be property subject to “public policy.”⁴⁰

Using public policy to define property substitutes a subjective political definition of property for a legal one based on objective, demonstrable principles. “Property” under such circumstances is not a fixed set of rights; each situation is comprised of a variety of competing interests that have to be weighed against each other.⁴¹

Modern courts have recognized that various intangible forms of property are entitled to protection,⁴² which is not inconsistent with the economic philosophy underlying the copyright clause, and in fact, complements that rationale.⁴³ Although the Copyright Act⁴⁴ grants authors a qualified monopoly with respect

³⁶ Vandeveldt, *The New Property of the Nineteenth Century: The Development of the Modern Concept of Property*, 29 BUFFALO L. REV. 325, 357 (1980).

³⁷ “Our concept of property has shifted; incorporeal rights have become property. And finally, ‘property’ has ceased to describe any *res*, or object of sense at all, and has become merely a bundle of legal relations—rights, powers, privileges, immunities.” The complete acceptance of [this] conception of property . . . was signaled by the promulgation of the American Law Institute’s *Restatement of Property* in 1936. The word “property” is not included among the terms defined by the *Restatement*. Instead, the *Restatement* defines the four constituent elements of property: rights, privileges, powers, and immunities, with their correlatives: duties, no rights, liabilities, and disabilities.

Id. at 361-62 (footnotes omitted) (quoting Comment, *Taxation of Seats on the Stock Exchange*, 31 YALE L.J. 429, 429 (1922)).

³⁸ *Id.* at 360-61.

³⁹ *Id.* at 358, 366.

⁴⁰ *Id.* at 362-63.

⁴¹ *Id.* at 366.

⁴² See *Zacchini v. Scripps-Howard Broadcasting Co.*, 422 U.S. 563 (1977); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978); *Grant v. Esquire, Inc.*, 367 F. Supp. 876 (S.D.N.Y. 1973).

⁴³ See *supra* text accompanying note 30.

⁴⁴ 17 U.S.C. §§ 101-810 (1982, Supp. I 1983, & Supp. II 1984).

to form of expression,⁴⁵ the public's access to the author's particular expression of ideas is in no way frustrated if the work's origin is correctly labelled. There is no principled argument why an author's name should not be on his works, even when those works may be copied without his permission.⁴⁶ The author has fulfilled his bargain with the law. He has surrendered his ideas and ultimately his mode of expression to the public domain. Why should he forfeit economic benefits derived from reputation? Why should the public be misled as to the creative force responsible for the work?⁴⁷

The answers lie in the continuing vitality of the "physicalist" conception of property, since many courts have required authors to reserve their right of attribution.⁴⁸ Apparently, the transfer of intellectual property is perceived in terms of fixed, absolute dominion over a *res*, as opposed to a legal relation with the author.

⁴⁵ Copyright protection is not absolute and is subject to policy considerations, *e.g.*, the facilitation and dissemination of new ideas. *See supra* text accompanying note 29. Accordingly, there are limitations on exclusive rights guaranteed under the Copyright Act. 17 U.S.C. §§ 107-118. There are limitations on the duration of copyright. 17 U.S.C. §§ 302-305. There are also formal requirements that must be followed as prerequisites to infringement suits. 17 U.S.C. §§ 401-412.

⁴⁶ The work for hire doctrine allows the employer of a work made for hire to retain the copyright, unless the parties agree otherwise in writing. 17 U.S.C. § 201(b). This arrangement vests all exclusive rights under the Copyright Act in the holder of the copyright. 17 U.S.C. § 106. However, it is clearly established that § 106 of the Copyright Act does not confer accreditation rights. *Locke v. Times Mirror Magazine, Inc.*, No. 82 Civ. 4274, slip op. (S.D.N.Y. Jan. 25, 1985) (available June 29, 1985, on LEXIS, Genfed library, Dist file); *Wolfe v. United Artists Music Co.*, No. 80-6957, slip op. at 8-10 (S.D.N.Y. July 21, 1983) (available June 29, 1985, on LEXIS, Genfed library, Dist file), *aff'd mem.*, 742 F.2d 1439 (2d Cir. 1983); *Wolfe v. United Artists Corp.*, 583 F. Supp. 52, 55-56 (E.D. Pa. 1983); *see also* *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 155 (1975); *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390, 393, *reh'g denied*, 393 U.S. 902 (1968); *T.B. Harms Co. v. Eliscu*, 339 F.2d 823, 828 (2d Cir. 1964), *cert. denied*, 381 U.S. 915 (1965); *Stepdesign, Inc. v. Research Media, Inc.*, 442 F. Supp. 32, 33 (S.D.N.Y. 1977). Thus, to the extent that the Copyright Act is silent as to matter of contractual negotiation between authors and employers, the parties could agree to credit the author even though the copyright is in the employer's name. *See infra* note 72; *cf. Wolfe v. United Artists Corp.*, 583 F. Supp. 52, 56 (E.D. Pa. 1983) (Copyright Act does not provide for accreditation within enumerated protected rights).

⁴⁷ *Berman & Rosenthal, supra* note 4, at 159-60 (suggesting that "the type of publication or production as well as the nature of the artist's contribution is relevant"); *cf. Ghostwriters Leave the Closet for the Dust Jacket*, N.Y. Times, Feb. 26, 1985, at C17, col. 1 (known ghostwriters tend to receive credit) [hereinafter cited as *Ghostwriters*]; *see generally* Note, *An Artist's Personal Rights in His Creative Works: Beyond the Human Cannonball and the Flying Circus*, 9 PAC. L.J. 855, 863-67 (1978) [hereinafter cited as Note, *Artist's Personal Rights*].

⁴⁸ *See* *Vargas v. Esquire, Inc.*, 164 F.2d 522, 525-26 (7th Cir. 1947); *Poe v. Michael Todd Co.*, 151 F. Supp. 801, 802-03 (S.D.N.Y. 1957); *Edison v. Viva Int'l, Ltd.*, 70 A.D.2d 379, 384, 421 N.Y.S.2d 203, 206 (1st Dept. 1979); *De Bekker v. Frederick A. Stokes Co.*, 168 A.D. 452, 454-55, 153 N.Y.S. 1066, 1067-68 (2d Dept. 1915), *modified per curiam*, 172 A.D. 960, 157 N.Y.S. 576 (2d Dept.), *aff'd*, 219 N.Y. 573 (1916); *Chester v. Avon Book Div., Hearst Publications, Inc.*, 76 Misc. 2d 1048, 1051, 352 N.Y.S.2d 552, 555 (Sup. Ct. 1973); *Clemens v. Press Pub. Co.*, 67 Misc. 183, 183-84, 122 N.Y.S. 206, 207 (Sup. Ct. 1910); *Royle v. Dillingham*, 53 Misc. 383, 104 N.Y.S. 783 (Sup. Ct. 1907).

The legacy of the copyright clause has established a presumption that where an author has transferred his copyright interest, accreditation rights are thereby waived, unless otherwise reserved.⁴⁹ The burden has always remained with the performer,⁵⁰ and some guild agreements⁵¹ provide contractual measures for accreditation where public policy has not done so.⁵²

Accordingly, the question of attribution has been primarily addressed in terms of contract law, and as noted, many cases hold that such a right must be expressly reserved or the *res* transfer will extinguish it.⁵³ Furthermore, courts have limited their analyses to an express contractual framework, regardless of what the parties really intended to transfer.⁵⁴ There is safety to this approach; the principle of *stare decisis* is not disturbed by aberrant holdings, which result in courts rewriting the parties' contracts based on case-to-case equities. Likewise, there is no need under this approach to examine the subjective intent of the parties, since the burden is on the performer to reserve accreditation rights expressly in the agreement. Courts may also be unwilling to usurp the legislature's function by creating rights of action or drastically shifting burdens of proof, without sufficient statutory authority to warrant such unprecedented measures, especially in an area of law that has remained undeveloped for so long. Yet, this approach ignores the twentieth century's development of a communications media which has complicated the legal relations of those who use and benefit from such systems.⁵⁵

In those cases involving actors,⁵⁶ there is no *res* to transfer, unless metaphysical assertions can be made regarding the embodiment of creative energy on film. Once again, public policy

⁴⁹ See, e.g., *Wolfe v. United Artists Corp.*, 583 F. Supp. 52, 56 (E.D. Pa. 1983).

⁵⁰ See, e.g., *Vargas v. Esquire, Inc.*, 164 F.2d 522, 526 (7th Cir. 1947); *Edison v. Viva Int'l, Ltd.*, 70 A.D.2d 379, 384, 421 N.Y.S.2d 203, 206 (1st Dept. 1979).

⁵¹ See Note, *Artist's Personal Rights*, *supra* note 47, at 867; see also Berman & Rosenthal, *supra* note 4, at 157 n.3.

⁵² See Appleson, *Attorney Groups Aid Artists in Their Brushes with the Legal System*, 67 A.B.A.J. 1251 (1981) (discussing pro bono attempts to aid artists in protecting their works of art).

⁵³ See, e.g., *Edison v. Viva Int'l, Ltd.*, 70 A.D.2d 379, 384, 421 N.Y.S.2d 203, 206 (1st Dept. 1979); *Chesler v. Avon Book Div., Hearst Publications, Inc.*, 76 Misc. 2d 1048, 1051-52, 352 N.Y.S.2d 552, 555-56 (Sup. Ct. 1973).

⁵⁴ *Poe v. Michael Todd Co.*, 151 F. Supp. 801, 802 (S.D.N.Y. 1957); *Preminger v. Columbia Pictures Corp.*, 18 N.Y.2d 659, 219 N.E.2d 431, 273 N.Y.S.2d 80, *aff'g* 25 A.D.2d 830, 269 N.Y.S.2d 913 (1st Dept.), *aff'g* 49 Misc. 2d 363, 367, 267 N.Y.S.2d 594, 599 (Sup. Ct. 1966). *But cf.* *Meta-Film Assocs. v. MCA, Inc.*, 586 F. Supp. 1346 (C.D. Cal. 1984) discussed more fully at text accompanying notes 205-17.

⁵⁵ See, e.g., *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481, 488 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956).

⁵⁶ *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981); *Lloyd v. R.K.O. Pictures*, 136 Cal. App. 2d 638, 289 P.2d 295 (1955); see also text accompanying notes 186-99.

definitions of property have not included accreditation rights due to the contractual relationship between actor and producer.⁵⁷ The "physicalist" concept that the transfer of services is absolute, save what the actor expressly reserves, naturally created a bias towards contract law.

The relatively recent recognition of valuable intangible property interests as a matter of law⁵⁸ is unlikely to shift public policy in favor of crediting performers in the absence of affirmative contractual measures.⁵⁹ While contracts are necessary to regulate the prominence and order of credits among a variety of creative talents in any given production,⁶⁰ it is one matter to regulate billing and quite another to deny it. Despite the prevalence of contractual measures, there are signs that the judiciary's increasing awareness of the importance of the performer's relation to his work and audience will eventually reshape the existing law.⁶¹

As existing law⁶² struggles to develop into one cohesive doctrine, the categories of causes of action tend to overlap and blur, producing gaps, compromises, and redundancies. The rapid expansion of various related remedies may also breed similar inconsistencies.⁶³ Ultimately these will be resolved on general principles of public policy.⁶⁴

⁵⁷ *Cf.* *Nelson v. RCA*, 148 F. Supp. 1, 3 (S.D. Fla. 1957) (master and servant relationship in the absence of contrary agreement dictated rights between parties); *see generally* Note, *Artist's Personal Rights*, *supra* note 47, at 864 (discussing *Nelson*).

⁵⁸ *See, e.g.*, *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575-77 (1977); *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981); *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481, 488-90 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956); *Meta-Film Assocs. v. MCA, Inc.*, 586 F. Supp. 1346, 1363 (C.D. Cal. 1984); *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 189 Cal. Rptr. 20 (1983); *Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 140 Cal. Rptr. 921 (1977).

⁵⁹ *See Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976); *see also* Goldberg, *Commentary: The Illusion of "Moral Right" in American Law*, 43 BROOKLYN L. REV. 1043, 1057 (1977) (discussing *Gilliam*); *see generally* Comment, *The Monty Python Litigation—Of Moral Right and the Lanham Act*, 125 U. PA. L. REV. 611, 629 (1977) [hereinafter cited as Comment, *Monty Python Litigation*].

⁶⁰ I T. SELZ & M. SIMENSKY, *supra* note 3, *passim*.

⁶¹ *Smith v. Montoro*, 648 F.2d 602, 607-08 (9th Cir. 1981); *Meta-Film Assocs. v. MCA, Inc.*, 586 F. Supp. 1346, 1361-64 (C.D. Cal. 1984); *Follett v. New American Library, Inc.*, 497 F. Supp. 304 (S.D.N.Y. 1980); *see also* note 64 and text accompanying notes 170-74.

⁶² *See infra* text accompanying notes 65-238.

⁶³ E. LEVI, AN INTRODUCTION TO LEGAL REASONING 7-8 (1949).

⁶⁴ Ignorance is the best of law reformers. People are glad to discuss a question on general principles, when they have forgotten the special knowledge necessary for technical reasoning. But the present willingness to generalize is founded on more than merely negative grounds. The philosophical habit of the day, the frequency of legislation, and the ease with which the law may be changed to meet the opinions and wishes of the public, all make it natural and unavoidable that judges as well as others should

III. THEORIES OF PROTECTION

A. *Droit Moral*

Regardless of an artist's pecuniary rights in his work, seventy-six countries recognize a variety of personal rights collectively known as *droit moral*.⁶⁵ *Droit moral* attaches to the artist⁶⁶ instead of to his work, so that the artist's reputation is protected as personality embodied in that work.⁶⁷ Paternity is one of the more important rights. It includes the right to claim authorship, the right to be known as the creator of one's work, the right to preclude others from receiving credit for one's work, and the right to prevent others from falsely attributing work to an artist who did not create it.⁶⁸

1. *Droit Moral* as a Federal Right

Droit moral has been described as a "bundle of rights,"⁶⁹ some of which are recognized in the United States.⁷⁰ Yet, the doctrine is unlikely to be completely accepted due to fundamental differences relating to the societal status of artists and art in this country and their status in those countries with extended cultural development.⁷¹ While Congress has introduced several

openly discuss the legislative principles upon which their decisions must always rest in the end, and should base their judgments upon broad considerations of policy to which the traditions of the bench would hardly have tolerated a reference fifty years ago.

O. HOLMES, JR., *THE COMMON LAW* 64 (M. Howe ed. 1963).

⁶⁵ 4 M. NIMMER, *NIMMER ON COPYRIGHT*, app. 22 (1985) (listing ratifications as of Jan. 1, 1985); see Rosen, *supra* note 27, at 170-79 for a discussion of *droit moral*; see also Comment, *Monty Python Litigation*, *supra* note 59, at 615-16.

⁶⁶ See, e.g., Merryman, *The Refrigerator of Bernard Buffet*, 27 HASTINGS L.J. 1023, 1025 & n.5 (1976).

⁶⁷ Note, *Authors' and Artists' Rights in the United States: A Legal Fiction*, 10 HOFSTRA L. REV. 557, 559 (1982) [hereinafter cited as Note, *Legal Fiction*]. *Droit moral* is codified in the Berne Copyright Convention of 1971:

Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the *right to claim authorship* of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

Convention for the Protection of Literary and Artistic Works, art. 6bis, para. 1 (Paris Text, July 24, 1971), reprinted in 4 M. NIMMER, *supra* note 65, at app. 27-5 to -6 (emphasis added).

⁶⁸ Note, *Legal Fiction*, *supra* note 67, at 560 n.23 (paternity and integrity rights are linked together); see also Berman & Rosenthal, *supra* note 4, at 158 & n.8.

⁶⁹ Granz v. Harris, 198 F.2d 585, 590 (2d Cir. 1952) (Frank, J., concurring) (citations omitted).

⁷⁰ See *infra* text accompanying notes 78-194.

⁷¹ Rosen, *supra* note 27, at 177-79; cf. Gantz, *Protecting Artists' Moral Rights: A Critique of the California Art Preservation Act as a Model for Statutory Reform*, 49 GEO. WASH. L. REV. 873, 876-77 & nn.19-20 & 22 (1981); see also *supra* text accompanying notes 24-64.

proposals to amend the Copyright Act⁷² to provide for moral rights, the bills have died in committee.⁷³

Moreover, if the United States were to adopt *droit moral* legislatively, there is still a question of the level of protection to be afforded to artists. Most countries that recognize artists' rights provide for varying degrees of protection, rather than following the French variant of the doctrine that prohibits waiver of the paternity right.⁷⁴ Allowance of contractual waiver of paternity rights would greatly diminish *droit moral's* efficacy, unless the more restrictive French model were imported.⁷⁵ Congressional reluctance to consider *droit moral* may not be premised only on the difficulty of deciding which version is better suited to our legal environment. If *droit moral* concepts are imported wholesale without regard for the notions of utility and sacrifice embedded in the Constitution,⁷⁶ it is feared that the civil law precepts will provide a windfall to artists.⁷⁷

2. *Droit Moral* and State Legislatures

Four states have enacted moral rights legislation,⁷⁸ and others have considered similar statutory protection.⁷⁹ For the purposes of this Note, it is necessary to consider only the California and New York statutes, since these jurisdictions are the artistic capitals of this country.⁸⁰

The California Art Preservation Act⁸¹ was the first statutory recognition of moral rights in the United States, and presumably

⁷² The proposed language is as follows:

Independently of the author's copyright in a pictorial, graphic, or sculptural work, the author or the author's legal representative shall have the right, during the life of the author and fifty years after the author's death, to claim authorship of such work and to object to any distortion, mutilation, or other alteration thereof, and to enforce any other limitation recorded in the Copyright Office that would prevent prejudice to the author's honor or reputation.

H.R. 1521, 98th Cong., 1st Sess. (1983); H.R. 2908, 97th Cong., 1st Sess. (1981); H.R. 288, 96th Cong., 1st Sess. (1979); H.R. 8261, 95th Cong., 1st Sess. (1977).

⁷³ Gantz, *supra* note 71, at 876-77 n.20.

⁷⁴ J. WHICHER, *supra* note 35, at 12-13; cf. Damich, *The New York Artists' Authorship Rights Act: A Comparative Critique*, 84 COLUM. L. REV. 1733, 1734-37, 1744-45 (1984).

⁷⁵ J. WHICHER, *supra* note 35, at 12, 18.

⁷⁶ See Goldberg, *supra* note 59, at 1057.

⁷⁷ See J. WHICHER, *supra* note 35, at 20-23.

⁷⁸ CAL. CIV. CODE § 987 (West Supp. 1985); ME. REV. STAT. ANN. tit. 27, § 303 (Supp. 1985); MASS. GEN. LAWS ANN. ch. 231, § 85S (West Supp. 1985); N.Y. ARTS AND CULTURAL AFFAIRS LAW §§ 14.01, 14.03 (McKinney Supp. 1986).

⁷⁹ Gantz, *supra* note 71, at 876 n.19.

⁸⁰ *Miller v. Universal Pictures Co.*, 10 N.Y.2d 972, 973, 224 N.Y.S.2d 662, 663 (1961) (Burke, J., dissenting).

⁸¹ CAL. CIV. CODE § 987 [hereinafter referred to as "California Art Preservation Act"]. See Petrovich, *Artists' Statutory "Droit Moral" in California: A Critical Appraisal*, 15

it and the New York Artists' Authorship Rights Act⁸² will serve as models for future enactments. The practical application of these statutes is untested, but it is unquestionable that they are theoretically significant measures, because they recognize artists' rights in their works. These Acts, however, are discriminatory in choosing which artists deserve protection and, thereby, reflect compromises between artists' and business' interests.⁸³ The California Art Preservation Act protects only works of "fine art," defined as "an original painting, sculpture or drawing, or an original work of art in glass, of recognized quality, but . . . not [a] work prepared under contract for commercial use by its purchaser."⁸⁴ Likewise, the New York Artists' Authorship Rights Act defines a work of "fine art" within narrow guidelines, but specifically provides that a work of fine art shall not include "sequential imagery such as that in motion pictures."⁸⁵

Some commentators have objected to the narrow definition of "fine art."⁸⁶ Despite these objections, it is evident that the paternity right is not extended to filmmakers, actors, or performers under these statutes.⁸⁷

3. *Droit Moral* and the Judiciary

Some American courts have expressly rejected applying the concept of *droit moral*.⁸⁸ Other courts have recognized analogous rights under the common law,⁸⁹ or have protected artists' inter-

LOY. L.A.L. REV. 29 (1981) and Gantz, *supra* note 71, for discussions of the California Art Preservation Act.

⁸² N.Y. ARTS AND CULTURAL AFFAIRS LAW §§ 14.01, 14.03 [hereinafter referred to as "New York Artists' Authorship Rights Act"]. See Damich, *supra* note 74, for a discussion of the New York Artists' Authorship Rights Act.

⁸³ See Gantz, *supra* note 71, at 887-88.

⁸⁴ CAL. CIV. CODE § 987(b)(2).

⁸⁵ N.Y. ARTS AND CULTURAL AFFAIRS LAW § 14.03(1); see also *id.* at § 11.01(9).

⁸⁶ Gantz, *supra* note 71, at 884; Petrovich, *supra* note 81, at 44-48; cf. Damich, *supra* note 74, at 1739-41.

⁸⁷ N.Y. ARTS AND CULTURAL AFFAIRS LAW § 14.03(1); see also Gantz, *supra* note 71, at 888 n.109.

⁸⁸ Gilliam v. American Broadcasting Cos., 538 F.2d 14, 27 (2d Cir. 1976) (Gurfein, J., concurring); Vargas v. Esquire, Inc., 164 F.2d 522, 526 (7th Cir. 1947) ("[w]hat plaintiff in reality seeks is a change in the law in this country to conform to that of certain other countries. We need not stop to inquire whether such a change, if desirable, is a matter for the legislative or judicial branch of the government; in any event, we are not disposed to make any new law in this respect."); Granz v. Harris, 198 F.2d 585, 590 (2d Cir. 1952) (Frank, J., concurring); Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 339-40 n.5 (S.D.N.Y. 1968).

⁸⁹ See, e.g., Geisel, 295 F. Supp. at 339-41 & n.5; Seroff v. Simon & Schuster, Inc., 6 Misc. 2d 383, 162 N.Y.S.2d 770 (Sup. Ct. 1957), *aff'd*, 12 A.D.2d 475, 210 N.Y.S.2d 479 (1st Dept. 1960); Clemens v. Press Pub. Co., 67 Misc. 183, 184 [sic], 122 N.Y.S. 206, 207-08 (Sup. Ct. 1910) (Seabury, J., concurring).

ests under general principles of law and common sense.⁹⁰ Still other courts have preferred to avoid the civil law doctrine and have resolved the matters before them on established grounds.⁹¹ No American court has ever resolved an artist's rights issue strictly on moral rights grounds, and no case has addressed the right of attribution as a common law doctrine.⁹² Although *droit moral* has not been well received in the United States,⁹³ artists' personal interests have been indirectly protected under other theories which incorporate elements of moral right.⁹⁴ Doctrinal variety is not a solution, though, since these theoretical categories were not intended to address the problem of attribution.

B. Contract Law

In the United States, the emphasis on property rights has resulted in certain assumptions about the nature of artists' works and their bargaining power. The first assumption with respect to intellectual property was that it was the same as any other good in commerce.⁹⁵ This assumption ignored the distinction between the relationships of artists and manufacturers to their respective works and the very nature of art and goods.⁹⁶ However, to the extent that society, with very limited exceptions,⁹⁷ does not protect artists' personal rights because their "products" are equated with those of manufacturers, it would seem logical to at least accord manufacturers and artists the same degree of pecuniary protection for their respective works. Courts have attempted to do

⁹⁰ See, e.g., *Drummond v. Altemus*, 60 F. 338, 338-39 (C.C.E.D. Pa. 1894).

⁹¹ *Granz v. Harris*, 198 F.2d 585, 588 (2d Cir. 1952); *Seroff v. Simon & Schuster, Inc.*, 6 Misc. 2d 383, 389, 162 N.Y.S.2d 770, 777 (Sup. Ct. 1957), *aff'd*, 12 A.D.2d 475, 210 N.Y.S.2d 479 (1st Dept. 1960); *Shostakovich v. Twentieth Century-Fox Film Corp.*, 196 Misc. 67, 80 N.Y.S.2d 575 (Sup. Ct. 1948), *aff'd*, 275 A.D. 692, 87 N.Y.S.2d 430 (1st Dept. 1949). "In the present state of our law the very existence of the [moral] right is not clear, the relative position of the rights thereunder with reference to the rights of others is not defined nor has the nature of the proper remedy been determined." 80 N.Y.S.2d at 579.

⁹² *Follett v. New American Library, Inc.*, 497 F. Supp. 304, 308, 312 (S.D.N.Y. 1980); *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 149 (D.D.C. 1980) ("plaintiff does not cite, and this court has been unable to locate, any case recognizing a common-law action for failure to attribute or misappropriation [sic] without attribution.").

⁹³ Maslow, "Droit Moral" and Sections 43(a) and 44(i) of the Lanham Act—A Judicial Shell Game?, 48 GEO. WASH. L. REV. 377 (1980).

⁹⁴ 2 M. NIMMER, *supra* note 65, § 8.21(B), at 248 (footnote omitted) ("the time honored judicial practice of distilling new wine in old bottles has resulted in an increasing accretion of case law which in some degree accords the substance of moral rights either under copyright, or under other conventional and respectable labels such as unfair competition, defamation, invasion of privacy or breach of contract.").

⁹⁵ See, e.g., *Parton v. Prang*, 18 F. Cas. 1273, 1278 (C.C.D. Mass. 1872) (No. 10,784).

⁹⁶ Rosen, *supra* note 27, at 180-81; cf. A. WARHOL, *THE PHILOSOPHY OF ANDY WARHOL (FROM A TO B & BACK AGAIN)* 85-86 (1975).

⁹⁷ See *supra* text accompanying notes 65-94.

so by applying contract law to determine the rights of artists against those of their employers.⁹⁸ Because contract law assumes equal bargaining power among parties to transactions,⁹⁹ the courts have assumed that artists have equal bargaining strength with the vast commercial concerns that employ them. This assumption may hold true for established artists¹⁰⁰ or guild members,¹⁰¹ but it does not hold true for all artists, especially those with little or no established reputations.¹⁰²

Unfortunately, the assumption of equal bargaining strength between artists and employers presupposes that if artists wish to retain the right of attribution, they have the power to reserve the paternity right in the first place.

1. Express Contracts

Not surprisingly, the predominant view is that artists must expressly reserve rights to receive credit,¹⁰³ because *droit moral* is not recognized in this country¹⁰⁴ or is subsumed in contract

⁹⁸ Note, *Legal Fiction*, *supra* note 67, at 563 & n.48.

⁹⁹ J. CALAMARI & J. PERILLO, *THE LAW OF CONTRACTS*, §§ 9-37 to -40, at 317-25, § 9-44, at 336 (2d ed. 1977).

¹⁰⁰ See *supra* text accompanying note 7.

¹⁰¹ See *supra* text accompanying notes 8-9.

¹⁰² See, e.g., *J.B. Lippincott v. Lasher*, 430 F. Supp. 993, 995-96 (S.D.N.Y. 1977); see generally *Chase*, *supra* note 12, at C17.

¹⁰³ *Granz v. Harris*, 198 F.2d 585, 588 (2d Cir. 1952); *Vargas v. Esquire, Inc.*, 164 F.2d 522, 525 (7th Cir. 1947); *Wolfe v. United Artists Music Co.*, No. 80-6957, slip op. at 8 (S.D.N.Y. July 21, 1983) (available June 29, 1985, on LEXIS, Genfed library, Dist file), *aff'd mem.*, 742 F.2d 1439 (2d Cir. 1983); *Nelson v. RCA*, 148 F. Supp. 1, 3 (S.D. Fla. 1957); *Bupp v. Great W. Broadcasting Corp.*, 201 Cal. App. 2d 580, 20 Cal. Rptr. 106 (1962); *Lloyd v. R.K.O. Pictures*, 136 Cal. App. 2d 638, 639, 289 P.2d 295, 296 (1955); *Edison v. Viva Int'l, Ltd.*, 70 A.D.2d 379, 384, 421 N.Y.S.2d 203, 206 (1st Dept. 1979); *Chesler v. Avon Book Div., Hearst Publications, Inc.*, 76 Misc. 2d 1048, 1051-53, 352 N.Y.S.2d 552, 555-57 (Sup. Ct. 1973); *Seroff v. Simon & Schuster, Inc.*, 6 Misc. 2d 383, 387-90, 162 N.Y.S.2d 770, 775-78 (Sup. Ct. 1957) (subsequent history omitted); *Jones v. American Law Book Co.*, 125 A.D. 519, 109 N.Y.S. 706 (1st Dept. 1908); *De Bekker, v. Frederick A. Stokes Co.*, 168 A.D. 452, 454-55, 153 N.Y.S. 1066, 1067-68 (2d Dept. 1915) (subsequent history omitted); *Clemens v. Press Pub. Co.*, 67 Misc. 183, 122 N.Y.S. 206 (Sup. Ct. 1910); see *Royle v. Dillingham*, 53 Misc. 383, 384, 104 N.Y.S. 783, 784 (Sup. Ct. 1907); see also *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481, 487 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956) (discussion of contrasting views regarding appearances in motion pictures made prior to the advent of commercial television). "One view is that once a performer has contracted to appear in a film, [such film] may be used . . . for any purpose, provided that it is a fair presentation." *Id.* (citations omitted). The contrasting view is that a film may not be used for a purpose that the parties did not contemplate at the time the film was made. *Id.* (citations omitted). Although *Ettore* goes to the issue of "use" rather than accreditation, the issues are not altogether unrelated. See *infra* notes 162-67. However, even assuming that the first view is the majority's position, the "fair presentation" provision erects a barrier to indiscriminate use by subsequent users. *Fairbanks v. Winik*, 206 A.D. 449, 201 N.Y.S. 487, *appeal dismissed*, 206 A.D. 451, 201 N.Y.S. 489 (1st Dept. 1923).

¹⁰⁴ *Granz v. Harris*, 198 F.2d 585, 590-91 (2d Cir. 1952) (Frank, J., concurring); *Var-*

rights.¹⁰⁵ In effect, there is no inherent right to receive credit.

Some courts have recognized rights which are analogous to the *droit moral* paternity right,¹⁰⁶ but have nonetheless resolved these matters on contract grounds.¹⁰⁷ One court has even suggested that the parties incorporate moral right language into their agreement.¹⁰⁸ However, if artists have retained their right to accreditation, the question of failure to attribute credit may be decided as a matter of contractual misfeasance.¹⁰⁹

An artist's express waiver of the paternity right in a contract will be enforced without hesitation as a valid property transfer.¹¹⁰

2. Implied Contracts

In the absence of express agreements, some courts have found that artists have not transferred all of their rights and have required express divestiture by artists of the paternity right.¹¹¹ Other courts have flatly refused to recognize an implied contract with respect to accreditation rights.¹¹²

However, even if an artist denied credit should find himself in a court willing to accept the existence of an implied in fact

gas v. Esquire, Inc., 164 F.2d 522, 526 (7th Cir. 1947); Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 340 n.5 (S.D.N.Y. 1968).

¹⁰⁵ Edison v. Viva Int'l, Ltd., 70 A.D.2d 379, 384, 421 N.Y.S.2d 203, 206 (1st Dept. 1979); Chesler v. Avon Book Div., Hearst Publications, Inc., 76 Misc. 2d 1048, 1051, 352 N.Y.S.2d 552, 555 (Sup. Ct. 1973); Seroff v. Simon & Schuster, Inc., 6 Misc. 2d 383, 388-90, 162 N.Y.S.2d 770, 775-76 (Sup. Ct. 1957) (subsequent history omitted).

¹⁰⁶ Gilliam v. American Broadcasting Cos., 538 F.2d 14, 24 (2d Cir. 1976); Edison v. Viva Int'l, Ltd., 70 A.D.2d 379, 384, 421 N.Y.S.2d 203, 206 (1st Dept. 1979); *see also supra* note 94.

¹⁰⁷ Gilliam v. American Broadcasting Cos., 538 F.2d 14 (2d Cir. 1976); Granz v. Harris, 198 F.2d 585 (2d Cir. 1952); Mallory v. Mackaye, 86 F. 122 (C.C.S.D.N.Y. 1898), *rev'd on other grounds*, 92 F. 749 (2d Cir. 1899); Chesler v. Avon Book Div., Hearst Publications, Inc., 76 Misc. 2d 1048, 352 N.Y.S.2d 552 (Sup. Ct. 1973); Seroff v. Simon & Schuster, Inc., 6 Misc. 2d 383, 162 N.Y.S.2d 770 (Sup. Ct. 1957) (subsequent history omitted).

¹⁰⁸ Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 339 n.5 (S.D.N.Y. 1968).

¹⁰⁹ Paramount Prods. v. Smith, 91 F.2d 863 (9th Cir.), *cert. denied*, 302 U.S. 749 (1937); Lake v. Universal Pictures Co., 95 F. Supp. 768 (C.D. Cal. 1950).

¹¹⁰ Vargas v. Esquire, Inc., 164 F.2d 522 (7th Cir. 1947); Harris v. Twentieth Century Fox Film Corp., 43 F. Supp. 119, 121 (S.D.N.Y. 1942); Edison v. Viva Int'l, Ltd., 70 A.D.2d 379, 383-84, 421 N.Y.S.2d 203, 205-06 (1st Dept. 1979); Chesler v. Avon Book Div., Hearst Publications, Inc., 76 Misc. 2d 1048, 1051-52, 352 N.Y.S.2d 552, 556-57 (Sup. Ct. 1973); Jones v. American Law Book Co., 125 A.D. 519, 109 N.Y.S. 706 (1st Dept. 1908).

¹¹¹ Warner Bros. Pictures, Inc. v. Columbia Broadcasting Sys., 216 F.2d 945 (9th Cir. 1954), *cert. denied*, 348 U.S. 941 (1955); Curwood v. Affiliated Distrib., 233 F. 219 (S.D.N.Y. 1922); Packard v. Fox Film Corp., 207 A.D. 311, 202 N.Y.S. 164 (1st Dept. 1923); *cf.* Royle v. Dillingham, 53 Misc. 383, 384, 104 N.Y.S. 783, 784 (Sup. Ct. 1907). *But cf.* Bartsch v. Metro-Goldwyn-Mayer, Inc., 391 F.2d 150, 155, 157 (2d Cir.), *cert. denied*, 393 U.S. 826 (1968).

¹¹² *See, e.g.*, Bupp v. Great W. Broadcasting Corp., 201 Cal. App. 2d 580, 20 Cal. Rptr. 106 (1962).

contract, there may be interpretation problems.¹¹³ Determining the parties' intent is, at best, speculative, and no artist should ever rely on this stopgap measure if he possesses any leverage with which to bargain for credit. Courts sometimes are reluctant to fill in terms of contracts, and when they do so, they may be swayed by factors which yield results not inconsistent with current industry practices. Moreover, although contract law has protected authors from tortious attribution of work which they did not create,¹¹⁴ it has never compelled affirmative disclosure where parties have been silent as to accreditation rights.¹¹⁵ Thus it is arguable that in situations where no enforceable express contract exists, a breach of implied in fact contract theory will fall on deaf judicial ears, especially if the artist is unknown and the industry does not give credit without negotiation.¹¹⁶ Likewise, it would be futile to argue that all contracts between performers and producers contain an implied in law duty of good faith to provide a minimum level of credit.¹¹⁷ Despite the fact that all courts recognize the existence of an implied covenant of good faith and fair dealing in each contract,¹¹⁸ such recognition is primarily used as a standard to determine contractual rights and duties.¹¹⁹ Only a few courts have derived substantive rights from this implied covenant in employment contracts.¹²⁰

¹¹³ *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956); *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952); *Poe v. Michael Todd Co.*, 151 F. Supp. 801 (S.D.N.Y. 1957); *Preminger v. Columbia Pictures Corp.*, 18 N.Y.2d 659, 219 N.E.2d 431, 273 N.Y.S.2d 80 (1966); *Clemens v. Press Pub. Co.*, 67 Misc. 183, 122 N.Y.S. 206 (Sup. Ct. 1910).

¹¹⁴ *See, e.g.*, *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976); *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952); *Chesler v. Avon Book Div., Hearst Publications, Inc.*, 76 Misc. 2d 1048, 352 N.Y.S.2d 552 (Sup. Ct. 1973); *Fairbanks v. Winik*, 206 A.D. 449, 201 N.Y.S. 487 (1st Dept. 1923); *cf. Harris v. Twentieth Century Fox Film Corp.*, 43 F. Supp. 119 (S.D.N.Y. 1942); *Lillie v. Warner Bros. Pictures, Inc.*, 139 Cal. App. 724, 34 P.2d 835 (1934); *Edison v. Viva Int'l, Ltd.*, 70 A.D.2d 379, 421 N.Y.S.2d 203 (1st Dept. 1979).

¹¹⁵ *See Nelson v. RCA*, 148 F. Supp. 1, 4 (S.D. Fla. 1957); *see generally Suid v. Newsweek Magazine*, 503 F. Supp. 146, 149 (D.D.C. 1980). *But cf. Chesler v. Avon Book Div., Hearst Publications, Inc.*, 76 Misc. 2d 1048, 1051, 352 N.Y.S.2d 552, 557 (Sup. Ct. 1973).

¹¹⁶ *See Kringsman, supra note 17, at 272.* However, where the performer is known, a court may place a higher premium on the services rendered. *See, e.g., Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956). *But compare Preminger v. Columbia Pictures Corp.*, 18 N.Y.2d 659, 219 N.E.2d 431, 273 N.Y.S.2d 80 (1966) *with Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976).

¹¹⁷ J. CALAMARI & J. PERILLO, *supra note 99*, § 1-12, at 19-20; *see also Rohwer, Terminable-At-Will Employment: New Theories for Job Security*, 15 PAC. L.J. 759, 770, 779 (1984).

¹¹⁸ J. CALAMARI & J. PERILLO, *supra note 99*, § 9-40, at 326-27.

¹¹⁹ *See infra text* accompanying notes 135-48.

¹²⁰ *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 189 Cal. Rptr. 20 (1983); *Fortune v. National Cash Register Co.*, 373 Mass. 96, 364 N.E.2d 1251

3. Damages

The type of relief sought presents an additional limitation on a performer's ability to enforce a right to receive credit under contract law theory. Contract law requires that a plaintiff prove specific damages that could have been reasonably foreseen by the breaching party,¹²¹ yet the value of future performances which are lost due to failure to receive credit may be unascertainable. For those performers who have not yet been employed or whose careers are still nascent, it is difficult to accurately assess whether they will ever achieve fame and fortune. Even in the case of an established performer, it may not be equitable to award damages as a matter of contract law, because their assessment may be too speculative, although a developed reputation is clearly valuable.¹²² Therefore, there is no "correct" computation for loss of an established reputation, since that performer might not be employed again.

Further, if performers are subsequently employed, does that militate against a finding of harm?¹²³ If so, how much?¹²⁴ Does subsequent employment mitigate damages? Does a performer have an affirmative duty to seek new roles?¹²⁵ Should courts disregard subsequent employment and focus on the harm done by the breach itself?¹²⁶ Unfortunately, contract law offers no easy

(1977). *But cf.* *Murphy v. American Home Prods. Corp.*, 58 N.Y.2d 293, 448 N.E.2d 86, 461 N.Y.S.2d 232 (1983).

¹²¹ *Poe v. Michael Todd Co.*, 151 F. Supp. 801, 803 (S.D.N.Y. 1957); *Nelson v. RCA*, 148 F. Supp. 1, 4 (S.D. Fla. 1957); *Tamarind Lithography Workshop v. Sanders*, 143 Cal. App. 3d 571, 576, 193 Cal. Rptr. 409, 412 (1983); *Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 854, 140 Cal. Rptr. 921, 923 (1977); *Zorich v. Petroff*, 152 Cal. App. 2d 806, 809, 313 P.2d 118, 122 (1957); *see generally* Comment, *The Loss of Publicity as an Element of Damages for Breach of Contract to Employ an Entertainer*, 27 U. MIAMI L. REV. 465 (1973); Annot., 96 A.L.R.3d 437 (1979) (loss of publicity from breach of contract may be too speculative).

¹²² *See, e.g.*, *Paramount Prods. v. Smith*, 91 F.2d 863, 866-67 (9th Cir.), *cert. denied*, 302 U.S. 749 (1937); *Poe v. Michael Todd Co.*, 151 F. Supp. 801, 803 (S.D.N.Y. 1957). However, tort law may bypass this problem by submitting the evidence to a jury's discretion. *Sutherland v. Auch Inter-Borough Transit Co.*, 366 F. Supp. 127 (E.D. Pa. 1973); *Grayson v. Irvmar Realty Corp.*, 7 A.D.2d 436, 184 N.Y.S.2d 33 (1st Dept. 1959).

¹²³ *See, e.g.*, *Quinn v. Straus Broadcasting Group, Inc.*, 309 F. Supp. 1208 (S.D.N.Y. 1970).

¹²⁴ *Amaducci v. The Metropolitan Opera Ass'n, Inc.*, 33 A.D.2d 542, 304 N.Y.S.2d 322 (1st Dept. 1969).

¹²⁵ *See Parker v. Twentieth Century-Fox Film Corp.*, 3 Cal. 3d 176, 181-82, 474 P.2d 689, 692, 89 Cal. Rptr. 737, 740 (1970), *aff'g* 276 Cal. App. 2d 270, 81 Cal. Rptr. 221 (1969).

¹²⁶ *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 645, 189 Cal. Rptr. 20, 23 (1983) (tort damages awarded); *Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 859, 140 Cal. Rptr. 921, 927 (1977) (statutory nominal breach of contract damages awarded); *see also Make-up Union gets \$10,000 in Damages Over 'Thing' Credit*, *supra* note 23, at 4, col. 1; *Harwood*, *supra* note 23, at 3.

answers to these questions.

In a system which protects performers' pecuniary rights, total loss of one's inchoate¹²⁷ or specified¹²⁸ career is required before damages will be awarded. That is, where a performer has been wrongfully blacklisted,¹²⁹ or physically incapacitated,¹³⁰ a court will readily consider damages. Where the setback to fame and fortune is temporary, policy notions tip the balance in favor of the breaching party, by limiting his obligations to specific damages. To do otherwise would overcompensate plaintiffs and impair market efficiency.¹³¹

4. Equity

Where damages cannot be calculated or a liquidated damages clause has not been used, a court may grant specific performance.¹³² Thus, a film could be withheld from release until the credits were amended to include the omitted performer's name and function.¹³³ In the event that the film had been released, advertising in trade magazines and newspapers could correct the omission until such time when the credits could be included in the films themselves.¹³⁴

5. Tortious Breach of Contract

As noted above, not all performers have equal bargaining power as against their employers.¹³⁵ An unestablished performer traditionally has less leverage in negotiating a contract because his name is not marketable. Under such circumstances producers may include waiver of billing provisions.¹³⁶ Assuming that public

¹²⁷ *Sutherland v. Auch Inter-Borough Transit Co.*, 366 F. Supp. 127 (E.D. Pa. 1973); *Grayson v. Irvmar Realty Corp.*, 7 A.D.2d 436, 184 N.Y.S.2d 33 (1st Dept. 1959).

¹²⁸ See *Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 140 Cal. Rptr. 921 (1977).

¹²⁹ *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 189 Cal. Rptr. 20 (1983) (threat of blacklisting); *Faulk v. Aware, Inc.*, 19 A.D.2d 464, 244 N.Y.S.2d 259 (1st Dept. 1963) (actual blacklisting).

¹³⁰ See, e.g., *Sutherland v. Auch Inter-Borough Transit Co.*, 366 F. Supp. 127 (E.D. Pa. 1973).

¹³¹ *Harris, Ogus, & Phillips, Contract Remedies and the Consumer Surplus*, 95 LAW Q. REV. 581 (1979).

¹³² *Farnsworth, Legal Remedies for Breach of Promise*, 70 COLUM. L. REV. 1145, 1149-60 (1970); see also *American Brands, Inc. v. Playgirl, Inc.*, 498 F.2d 947 (2d Cir. 1974) (back cover of *Playgirl* is not a unique advertising medium and contract provided for buy-back arrangement).

¹³³ See, e.g., *Tamarind Lithography Workshop v. Sanders*, 143 Cal. App. 3d 571, 577-79, 193 Cal. Rptr. 409, 413-14 (1983); see also *infra* notes 230-37 and accompanying text.

¹³⁴ *Cher v. Forum Int'l, Ltd.*, 213 U.S.P.Q. (BNA) 96, 103 (C.D. Cal.), *modified*, 692 F.2d 634 (9th Cir. 1982), *cert. denied*, 462 U.S. 1120 (1983); see also *infra* notes 223-26, 238 and accompanying text.

¹³⁵ See *supra* notes 99-102 and accompanying text.

¹³⁶ See *supra* note 14.

policy develops to the stage where fair bargaining principles are violated by these "agreements," the tort and contract fields may overlap.¹³⁷ In cases involving contracts of adhesion or other unconscionable and immoral business practices,¹³⁸ a court is more likely to treat such wrongful conduct as tortious than contractual. And when one considers that tort law protects personal as well as pecuniary interests, there are distinct advantages in pursuing tort remedies.¹³⁹

In *Smithers v. Metro-Goldwyn-Mayer Studios*,¹⁴⁰ a California appellate court recently upheld an award of damages for tortious breach of an implied covenant of good faith and fair dealing in a television actor's contract.¹⁴¹ The trial court had ruled that MGM's conduct constituted a tortious breach of contract as held in *Sawyer v. Bank of America*,¹⁴² and on appeal, MGM contended, *inter alia*, that Smithers was not entitled to proceed under a theory of a tortious breach of an implied covenant of good faith and fair dealing, and that damages, if they could be shown, were speculative. MGM argued that the doctrine's applicability was restricted to insurance contracts and contracts of adhesion, despite authority creating these substantive tort rights in all contracts.¹⁴³

¹³⁷ G. GILMORE, *THE DEATH OF CONTRACT*, 83-94 (1974).

¹³⁸ J. CALAMARI & J. PERILLO, *supra* note 99, § 9-40, at 326-27.

¹³⁹ One of the purposes of contract law is to put the plaintiff in the position he would have been in had the contract been performed; the goal of tort law is to compensate the injured party for his loss, as well as to punish and deter tortfeasors.

¹⁴⁰ 139 Cal. App. 3d 643, 189 Cal. Rptr. 20 (1983); *see generally* Rohwer, *supra* note 117, at 770, 779.

¹⁴¹ 189 Cal. Rptr. 20, 25. William Smithers (Smithers), a highly regarded actor with more than thirty years of experience, accepted Metro-Goldwyn-Mayer's (MGM) offer of lower pay in exchange for a preferred billing arrangement. Smithers' agent and MGM's casting director signed an interim agreement, which bound MGM to provide Smithers with certain rights as against other actors, pending the execution of the same terms in a long-form contract. The pilot film and subsequent productions violated this agreement by listing more actors than the specified number agreed upon ahead of Smithers on the crawl. When Smithers notified MGM that his billing was not in conformity with their contract, he discovered that the contract which had never been executed differed from the interim agreement. Apparently, an MGM attorney had changed the applicable provision to allow any number of actors to be billed more prominently than Smithers: "[g]enerally somebody who had more authority than I told me to change it." *Id.* at 22.

Smithers was then told that his role was to be written out of the series, that the billing provision had been a mistake, and that Smithers should waive the provision. Upon Smithers' refusal to ratify this unfavorable contract modification, the President of MGM Television advised Smithers' agent that he "would be hard pressed to use Mr. Smithers again on any shows that he . . . was involved with . . ." and he would induce Columbia Broadcasting System's Programming Chief to blacklist Smithers as well. *Id.* at 22-23.

¹⁴² 83 Cal. App. 3d 135, 137, 145 Cal. Rptr. 623, 625 (1978).

¹⁴³ *Cleary v. American Airlines*, 111 Cal. App. 3d 443, 168 Cal. Rptr. 722 (1980); *Tameny v. Atlantic Ritchfield Co.*, 27 Cal. 3d 167, 179 n.12, 610 P.2d 1330, 1337 n.12, 164 Cal. Rptr. 839, 846 n.12 (1980) (dicta). *But cf.* *Murphy v. American Home Prods. Corp.*, 58 N.Y.2d 293, 448 N.E.2d 86, 461 N.Y.S.2d 232 (1983).

The appellate court affirmed the trial court's decision and further found that MGM's threat was "extraneous to the contract, not only intending to bludgeon Smithers into foregoing his contractual rights but also threatening action directly affecting the practice of his art and damaging to his future earning power."¹⁴⁴ The court gave short shrift to MGM's contention that the breach of contract damages were speculative and thus incapable of ascertainment. It noted that those who willfully breach contracts bear the risk of computational uncertainty, although there was no accurate estimation of Smithers' loss of future earnings.¹⁴⁵

Under the *Smithers*' analysis, a party's conduct must be either extreme and outrageous, or fraudulent, before a court will recognize a cause of action in tort arising out of an employment relationship. However, a producer's forthright refusal to give credit or to negotiate this matter might not be tortious as a matter of law, because there may be no implied covenant of good faith and fair dealing with respect to a contractual failure to honor or discuss the paternity right. As a practical matter, "[f]or the unknown, commercially-untested artist having little or no bargaining power, insistence on contractual rights [paternity] may result in the loss of the contract and a prolonged stay in obscurity."¹⁴⁶ Those parties who lack bargaining power will most likely have to accept the credit terms that are dictated to them. Since this is a matter of the producer's discretion, courts are unlikely to find these arrangements are contracts of adhesion.¹⁴⁷ It is also questionable whether contract law allows unestablished performers to bargain on an equal footing with large corporate concerns, especially when the threat of blacklisting is available as a bargain enforcement deterrent.¹⁴⁸ The entertainment industry may retaliate against those performers who try to enforce their contractual rights even if they have sufficient lever-

¹⁴⁴ *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 645, 189 Cal. Rptr. 20, 23 (1983) (citation omitted). *But cf.* *Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 855-56, 140 Cal. Rptr. 921, 926-27 (1977).

¹⁴⁵ Because the jury had heard evidence as to the relationship between billing and subsequent negotiations for compensation, the court reasoned that the jury had a reasonable basis to determine damages. *Smithers*, 189 Cal. Rptr. at 24 (citations omitted).

¹⁴⁶ Krigsman, *supra* note 17, at 259.

¹⁴⁷ See Chase, *supra* note 12, at C17.

¹⁴⁸ *Smithers*, 189 Cal. Rptr., at 23-24; *cf.* D. McCLINTICK, *INDECENT EXPOSURE: A TRUE STORY OF HOLLYWOOD & WALL STREET* 515, 518 (1982); Berman & Rosenthal, *supra* note 4, at 169-77.

However, there is nothing to stop the guilds from policing their memberships' agreements so as to maintain standardized contract provisions. See Freedman, *Guild Suspends Authors of 'Grind' Over Contract*, N.Y. Times, Mar. 6, 1985, at C17, col. 5.

age with which to negotiate, so that the bargain mechanism between the parties in these matters is essentially flawed.

C. *Unfair Competition*

I. Section 43(a) of the Lanham Act

Section 43(a) of the Lanham Act¹⁴⁹ is a federal law which regulates certain unfair trade practices. Although section 43(a) of the Lanham Act is buried in a trademark statute, the class of plaintiffs protected by this section¹⁵⁰ includes those who have failed to register their names as trademarks.¹⁵¹ The Lanham Act's application has been limited to false or misleading representations of goods or services in interstate commerce,¹⁵² but courts have broadly construed its provisions within this framework.¹⁵³

In fact, courts have interpreted the Lanham Act as covering any deceptive statement made by the originating source as to that product or service.¹⁵⁴ Liability is not restricted to literally false statements, but is extended to those that are false by implication¹⁵⁵ or false as determined by surrounding circumstances.¹⁵⁶

¹⁴⁹ Section 43(a) of the Lanham Act provides in pertinent part that:

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

15 U.S.C. § 1125(a) (1982) [hereinafter also cited as Lanham Act].

¹⁵⁰ See, e.g., *Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir. 1981); *New West Corp. v. NYM Co. of California*, 595 F.2d 1194, 1198 (9th Cir. 1979).

However, there is some dispute as to whether a plaintiff need be in actual competition with the alleged tortfeasor. Some jurisdictions do not grant customers standing. *Colligan v. Activities Club of New York, Ltd.*, 442 F.2d 686 (2d Cir.), cert. denied, 404 U.S. 1004 (1971); *L'Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649 (3d Cir. 1954); *Florida ex rel. Broward County v. Eli Lilly & Co.*, 329 F. Supp. 364, 366-67 (S.D. Fla. 1971). One commentator has argued that an author's present publisher or distributor is his partner, not his competitor, and that the Lanham Act's protection is inapplicable. Note, *Legal Fiction*, supra note 67, at 578.

Other courts have held differently for analogous relationships. *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981), *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 151 (9th Cir.), cert. denied, 374 U.S. 830 (1963); *F.E.L. Publications, Ltd. v. National Conference of Catholic Bishops*, 466 F. Supp. 1034, 1044 (N.D. Ill. 1978); see also *infra* text accompanying note 190.

¹⁵¹ *In re Uranium Antitrust Litigation*, 473 F. Supp. 393, 407 (N.D. Ill. 1979), *rev'd on other grounds*, 617 F.2d 1248 (7th Cir. 1980).

¹⁵² *Id.*; see also *Follett v. New American Library, Inc.*, 497 F. Supp. 304 (S.D.N.Y. 1980); cf. *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976); see generally *Krigsman*, supra note 17, at 262-67.

¹⁵³ *Geisel v. Poynter Prods. Inc.*, 283 F. Supp. 261, 267 (S.D.N.Y. 1968).

¹⁵⁴ *Id.*

¹⁵⁵ *Id.*

Relief may also be granted where the deceptive statement creates a false impression, despite the lack of falsity in the representation.¹⁵⁷

The essential elements of a section 43(a) claim require a plaintiff to prove that:

- (1) the representation is false with respect to the defendant's own products or services;¹⁵⁸
- (2) the deceptive statement confuses or is likely to confuse

¹⁵⁶ *Id.*

¹⁵⁷ Although courts have applied unfair competition law to claims involving performers who have rendered services, they have done so for the most part without considering the nature of the services rendered. *See, e.g., Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir. 1981). One commentator has argued that Lanham Act protection "should extend, if at all, to the author or artist whose name has acquired public recognition." Note, *Legal Fiction*, *supra* note 67, at 578. Such a standard is premised on the fact that § 43(a) of the Lanham Act is buried in a trademark statute, although this commentator admits that § 43(a) is silent with respect to its statutory purpose. *Id.* at 577. If, as a matter of law, the performer's "mark" must have attained secondary meaning, that is, a distinctive feature as an indication of the creation's source, an unestablished performer might be barred from § 43(a)'s protection. The rationale for this result is that where the public is unaware of a particular service's origin, there can be no standard against which to measure falsity of representations. *See Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299, 303 (2d Cir. 1981), *cert. denied*, 455 U.S. 909 (1982).

Moreover, it is not altogether clear that "where the product sold by plaintiff is 'entertainment' in one form or another[,]. . . an ingredient of the product itself can amount to a trademark protectable under [§] 43(a) . . ." *DC Comics, Inc. v. Filmation Assocs.*, 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980). The *DC Comics* court held that where the "ingredients" come to symbolize the plaintiff or its product, trademark protection is warranted. These "ingredients" may include names, nicknames, physical appearances, and costumes. However, these characteristics have not, for the most part, been protected, "since it is difficult to see how such intangible qualities, having an infinite number of possible visible and audible manifestations, can achieve that fixture or consistency of representation that would seem necessary to constitute a symbol in the public mind." *Id.*; *see also Borchard, supra* note 7, at 17.

Nonetheless, the *DC Comics* court upheld a jury verdict of trademark infringement of plaintiff's cartoon characters, and the *Smith* court allowed a performer's claim. 648 F.2d 602.

Although there may be no satisfying doctrinal answer under trademark law standards, the doctrine of unfair competition is a considerably more flexible concept. *Ely-Norris Safe Co. v. Mosler Safe Co.*, 7 F.2d 603 (2d Cir. 1925), *rev'd on other grounds*, 273 U.S. 132 (1927). Judge Learned Hand, writing for the Second Circuit in *Ely-Norris*, stated "there is no part of the law which is more plastic than unfair competition, and what was not reckoned an actionable wrong 25 years ago may have become such today." 7 F.2d at 604; *see also Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (section 43(a) of the Lanham Act provides virtually identical protection as N.Y. Civil Rights Law § 51); *see generally* Note, *The Lanham Trademark Act, Section 43(a)—A Hidden National Law of Unfair Competition*, 14 WASHBURN L.J. 330 (1975) [hereinafter cited as Note, *A Hidden National Law*].

The reading of § 43(a) which is most persuasive is "that the primary purpose of the Act was to eliminate deceitful practices in interstate commerce involving the misuse of trademarks, but along with this it sought to eliminate other forms of misrepresentation which are of the same general character even though they do not involve any use of what can technically be called a trademark." *Samson Crane Co. v. Union Nat'l Sales*, 87 F. Supp. 218, 222 (D. Mass. 1949).

¹⁵⁸ *American Brands, Inc. v. R.J. Reynolds Tobacco Co.*, 413 F. Supp. 1352, 1357 (S.D.N.Y. 1976); *see also infra* notes 193-94 and accompanying text.

- the public;¹⁵⁹
- (3) the deceptive statement is material;¹⁶⁰ and
- (4) the plaintiff has been or is likely to be harmed by such misrepresentation.¹⁶¹

The landmark decision, *Gilliam v. ABC, Inc.*,¹⁶² widened the potential scope of the Lanham Act by explicitly comparing it to the *droit moral* integrity right.¹⁶³ ABC, a remote licensee, edited twenty-seven percent of a Monty Python comedy program in contravention of a contract reserving editorial rights in the authors.¹⁶⁴ The court's decision rested primarily on the fact that the underlying script was protected by a common law copyright, so that the recorded program was a derivative work.¹⁶⁵ As such, the recorded program was entitled to copyright protection. Since the chain of licensees had only acquired limited rights subject to the original contractual provisions, ABC never held full copyright in the recorded program. Consequently, ABC's unauthorized editing constituted a breach of contract and copyright infringement.¹⁶⁶

An alternative holding rested on section 43(a) of the Lanham Act. The court emphasized that the *droit moral* concept of the artist's right of integrity, the right to have a work attributed to the artist in the form in which it was created, is inherent in the Lanham Act.¹⁶⁷

¹⁵⁹ See *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981).

¹⁶⁰ See *id.* at 608 (quoting 1 R. CALLMAN, UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES, § 18.2(b), at 625 (3d ed. 1967) ("the dispositive question" as to a party's standing to maintain an action under section 43(a) is whether the party "has a reasonable interest to be protected against false advertising."); see also *infra* notes 193-97 and accompanying text.

¹⁶¹ Note, *A Hidden National Law*, *supra* note 157, at 339.

¹⁶² 538 F.2d 14 (2d Cir. 1976).

¹⁶³ *Id.* at 24-25.

¹⁶⁴ *Id.* at 19.

¹⁶⁵ 17 U.S.C. § 106(2); COMMITTEE ON THE JUDICIARY, COPYRIGHT LAW REVISION, H.R. REP. NO. 1476, 94th Cong. 2d Sess. 62 (1976) provides in pertinent part:

Preparation of derivation works.—The exclusive right to prepare derivative works, specified separately in clause (2) of section 106, overlaps the exclusive right of reproduction to some extent. It is broader than that right, however, in the sense that reproduction requires fixation in copies or phonorecords, whereas the preparation of a derivative work, such as a ballet, pantomime, or improvised performance, may be an infringement even though nothing is ever fixed in tangible form.

To be an infringement the "derivative work" must be "based upon the copyrighted work," and the definition in section 101 refers to "a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted." Thus, to constitute a violation of section 106(2), the infringing work must incorporate a portion of the copyrighted work in some form; for example, a detailed commentary on a work or a programmatic musical composition inspired by a novel would not normally constitute infringements under this clause.

¹⁶⁶ *Gilliam*, 538 F.2d at 20.

¹⁶⁷ *Id.* at 24.

Judge Gurfein's concurrence in *Gilliam*, however, disagreed with the majority's liberal reading of the Lanham Act as an American equivalent of *droit moral*.¹⁶⁸ Subsequent Lanham Act analyses have largely followed Judge Gurfein's criticism, by retreating from the overly broad language in *Gilliam*, and hewing closer to the statutory purpose of fighting advertising misrepresentations.¹⁶⁹

A clear example of such advertising misrepresentations occurred in *Follett v. New American Library, Inc.*¹⁷⁰ Ken Follett, prior to his career as a successful suspense novelist, rewrote an English translation of a French novel. Follett originally had agreed to accept joint authorship with the three authors' combined pseudonym preceding his name. Once Follett achieved reknown, the publisher sought to play up Follett's contribution, listing his name first on the book's cover, in addition to omitting the pseudonym on the cover's spine. Follett successfully claimed that such designation misrepresented him as the principal author in violation of section 43(a) of the Lanham Act.¹⁷¹

¹⁶⁸ *Id.* at 26-27.

¹⁶⁹ See 15 U.S.C. § 1127; see also Maslow, *supra* note 93, at 387; Goldberg, *supra* note 59, at 1056.

¹⁷⁰ 497 F. Supp. 304 (S.D.N.Y. 1980).

¹⁷¹ *Id.* at 308-09, 312. In *Follett*, an author was able to persuade a court that his right to prevent a misleading credit attribution was coextensive with his rights under the Lanham Act. Accordingly, the issue that the court focused on was whether designation of Follett as the primary author of defendant's book would constitute a false representation under § 43(a) of the Lanham Act. *Id.* at 309. Although the court stated that "the concept of authorship is elusive and inexact," *id.* at 312, it nevertheless found that the public interest in not being misled and the author's "personal right" necessitated equitable relief. *Id.* at 313. In contrast, *Wolfe v. United Artists Music Co.*, No. 80-6957, slip op. (S.D.N.Y. July 21, 1983) (available June 29, 1985, on LEXIS, Genfed library, Dist file), *aff'd mem.*, 742 F.2d 1439 (2d Cir. 1983), involved a pro se action brought by a composer, Richard Wolfe. Judge Griesa, writing for the district court, held that the Copyright Act did not give rise to a cause of action for failure to give authorship credit. Since there was incomplete diversity of citizenship and federal jurisdiction was predicated on the copyright claims, the court dismissed the case without considering the pendent unfair competition claims. See also *Wolfe v. United Artists Corp.*, 583 F. Supp. 52, 55-57 (E.D. Pa. 1983). Whereas the *Follett* court stressed the author's personal interest in receiving attribution, the *Wolfe* court stated a preference for contract law: "[e]ither the agreements required the licensees to carry Wolfe's copyright and notice of authorship, or they permitted [defendants] to print the songs under their copyright notice." *Wolfe*, No. 80-6957, slip op. at 12.

Other aspects of these cases are worthy of consideration. Follett was a well known author, whose best selling novels were written after the work that he did for the defendants. If a work were to be published with his name on it as the sole or primary author, and such work was inferior to his later writing, its publication would harm his pecuniary interests as well as his personal ones. However, Wolfe was not as well known, and he would not suffer dilution from his name not being associated with his work. That is to say, in the case of a well known artist, a false statement as to the nature of his contribution more clearly jeopardizes his economic prospects. Having recognized possible pecuniary loss, it is easier for a court to make the connection with the pride of being successful to the pride that a craftsman or artist takes in his work. Another way of framing this problem is to say that there is a presumption in favor of those who are already enfranchised. It is very hard to show damages for an artist who is an unknown commod-

Although the court's opinion notably focused on protecting the author's right and the public's interest from false designations of authors' contributions to finished works,¹⁷² one commentator has noted that "[i]t seems likely, particularly in light of the Gilliam [sic] decision, that a contractual grant will not be overridden [sic] by the Lanham Act, despite the likelihood of public deception or confusion."¹⁷³ This view, however, pays undue deference to contractual measures, unlike the *Follett* court's recognition of an absolute right of accreditation equivalent to the *droit moral* paternity right. "Even if an attribution of authorship were consistent with industry practices, it would nevertheless be illegal under the Lanham Act if it misrepresented the contribution of the person designated as author."¹⁷⁴

Since performers are not required to sign waiver of billing provisions,¹⁷⁵ the only cases arising under the Lanham Act with respect to attribution rights have involved breach of contract¹⁷⁶ and have been silent as to such waiver provisions.¹⁷⁷ No case has ever tested the scope of section 43(a) of the Lanham Act against a contract denying an actor or performer the right to receive attribution. Under *Follett's* jurisdiction, though, an author has a cause of action where work is credited to him that he did not create. The rationale is simply that an author's reputation is unjustly jeopardized by a fraudulent use of his name in connection with material that he did not write, since the public is deceived as to its origin.¹⁷⁸ Another way of stating this proposition is that there are two frauds perpetrated; one on the author, the other on the public.¹⁷⁹ While protection of the public from deceptive or misleading representations has been a mat-

ity. Paradoxically, this artist will be treated as though he has no personal interest in receiving attribution. In contrast, the successful artist is granted rights to his work, because it is deemed to have value. Likewise, the successful artist is more likely to receive injunctive relief since he has a tangible economic interest at stake. The unknown or less known artist cannot easily make a showing of economic harm. See *supra* text accompanying note 8.

¹⁷² 497 F. Supp. at 313. Whereas *Gilliam's* breach of contract holding highlighted the financial harm that Monty Python would undergo due to its diminished reputation, the *Follett* decision is also premised on noncommercial rationales.

¹⁷³ Krigsman, *supra* note 17, at 269; see also Note, *Legal Fiction*, *supra* note 67, at 581 ("section 43(a) . . . offers no protection to an artistic creator against a waiver or conveyance of contract rights [which] would permit [assignment of] attribution of credit.").

¹⁷⁴ 497 F. Supp. at 311.

¹⁷⁵ Cf. *Vargas v. Esquire, Inc.*, 164 F.2d 522 (7th Cir. 1947); *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 189 Cal. Rptr. 20 (1983). But see *supra* note 14.

¹⁷⁶ *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981).

¹⁷⁷ *Follett v. New American Library, Inc.*, 497 F. Supp. 304 (S.D.N.Y. 1980).

¹⁷⁸ *Drummond v. Altemus*, 60 F. 338 (C.C.E.D. Pa. 1894); *Clemens v. Belford, Clark & Co.*, 14 F. 728 (N.D. Ill. 1883); *Ben-Oliel v. Press Pub. Co.*, 251 N.Y. 250, 167 N.E. 432 (1929).

¹⁷⁹ *Paramount Prods. v. Smith*, 91 F.2d 863, 867 (Wilbur, J., dissenting) (9th Cir.), *cert. denied*, 302 U.S. 749 (1937); see *supra* note 35.

ter of little relevance in many courts' analyses of private arrangements between artists and their employers in the past,¹⁸⁰ it has figured prominently in Lanham Act analyses.¹⁸¹ Thus, any balancing test, which weighs the respective interests of society to be adequately informed as to the nature of goods or services in interstate commerce against the pecuniary motives of a film producer, will probably favor the needs of the many over those of the few.¹⁸²

In *Perin Film Enterprises v. TWG Productions*,¹⁸³ a producer who was denied credit brought suit under section 43(a) of the Lanham Act. The plaintiff had been the executive producer of the television series, *For You . . . Black Woman*. After two years of service resulting in the production of twenty-two shows, the plaintiff was dismissed. He did not receive credit because the defendant substituted the name of the show's underwriter in the listing of credits as the "executive in charge of production."¹⁸⁴ Judge Griesa never reached the merits of the case, since the parties settled after his ruling that the plaintiff had standing under the Lanham Act.¹⁸⁵

In *Smith v. Montoro*,¹⁸⁶ the Ninth Circuit explicitly expanded on *Perin*. Paul Smith, an actor, entered into a contract with a film company, under which he was to receive star billing in the screen credits and advertising of *Convoy Buddies*. The film company also agreed to incorporate these provisions in contracts with the film's distributors, Edward Montoro and Film Venture International. However, Montoro removed Smith's name and substituted another actor's name, "Bob Spencer," in both the screen credits and advertising material.¹⁸⁷ Smith sought damages under various claims, including

¹⁸⁰ See, e.g., *Vargas v. Esquire, Inc.*, 164 F.2d 522, 526 (7th Cir. 1947); *Nelson v. RCA*, 148 F. Supp. 1, 3-4 (S.D. Fla. 1957); *Harris v. Twentieth Century Fox Film Corp.*, 43 F. Supp. 119, 121 (S.D.N.Y. 1942); *Edison v. Viva Int'l, Ltd.*, 70 A.D.2d 379, 383, 421 N.Y.S.2d 203, 205 (1st Dept. 1979); *Scroff v. Simon & Schuster, Inc.*, 6 Misc. 2d 383, 162 N.Y.S.2d 770 (Sup. Ct. 1957); cf. *Chesler v. Avon Book Div., Hearst Publications, Inc.*, 76 Misc. 2d 1048, 1051, 352 N.Y.S.2d 552, 557 (Sup. Ct. 1973).

¹⁸¹ See, e.g., *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981); *Meta-Film Assocs. v. MCA, Inc.*, 586 F. Supp. 1346, 1363 (C.D. Cal. 1984); *Follett v. New American Library, Inc.*, 497 F. Supp. 304, 313 (S.D.N.Y. 1980); cf. *CBS, Inc. v. Springboard Int'l Records*, 429 F. Supp. 563, 567-69 (S.D.N.Y. 1976); *Rich v. RCA Corp.*, 390 F. Supp. 530, 530-31 (S.D.N.Y. 1975); *CBS, Inc. v. Gusto Records, Inc.*, 403 F. Supp. 447, 448-49 (M.D. Tenn. 1974) (disclosure stickers on record albums).

¹⁸² See *Follett v. New American Library, Inc.*, 497 F. Supp. 304, 311, 313 (S.D.N.Y. 1980) (absolute accreditation right); see also *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981) (this case is not squarely on point, since the performer had not waived his rights).

¹⁸³ 400 PAT. TRADEMARK & COPYRIGHT J. (BNA) A-13 (S.D.N.Y. Sept. 13, 1978) (not otherwise reported).

¹⁸⁴ *Id.* at A-13 to -14.

¹⁸⁵ *Smith v. Montoro*, 648 F.2d 602, 607 n.7 (9th Cir. 1981).

¹⁸⁶ *Id.*

¹⁸⁷ *Id.* at 603.

breach of contract, false light publicity,¹⁸⁸ and violation of section 43(a) of the Lanham Act. He alleged that the substitution had damaged his reputation as an actor, and that he had lost specific employment opportunities. The lower court declined to construe the Lanham Act as a remedial statute and granted Montoro's motion to dismiss for failure to state a valid federal claim.¹⁸⁹ In that court's view, section 43(a) of the Lanham Act was limited in scope to merchandising practices economically equivalent to passing off one's goods or services as those of a competitor's. The plaintiff's claim was not a traditional trademark infringement action, since the gravamen of the complaint was not that Smith's name was misused, but that it was not used. Furthermore, the judge reasoned that state law provided adequate remedies in tort and contract. An alternative ground for dismissal rested on Smith's lack of standing since he was not in competition with the defendants. Accordingly, the pendent state claims were also dismissed for lack of jurisdiction.¹⁹⁰

On appeal, the Ninth Circuit observed that the law of trademarks and unfair competition do not encompass only fraudulent passing off, and emphasized that any form of competition which violates society's present concepts of fair business practice is covered within its terms.¹⁹¹ Since "express reverse passing off" involved the unauthorized removal of Smith's name from the credits and advertising and the substitution of another's name, the present case fell within these guidelines.¹⁹² The *Smith* court astutely recognized that an actor's ability to obtain work is often based on drawing power, and that proper accreditation is essential for actors to sell their services.¹⁹³ In addition to the language concerning trademark infringement and unfair competition, the court's analysis stressed, as a matter of policy, that it is wrong to misappropriate another's talents and workmanship. Such conversion occurs when the creator of the misidentified service is involuntarily deprived of the opportunity to

¹⁸⁸ *Id.*; RESTATEMENT (SECOND) OF TORTS § 652E (1977) provides that:

[o]ne who gives publicity to a matter concerning another that places the other before the public in a false light is subject to liability to the other for invasion of his privacy, if

(a) the false light in which the other was placed would be highly offensive to a reasonable person, and

(b) the actor had knowledge of or acted in reckless disregard as to the falsity of the publicized matter and the false light in which the other would be placed.

¹⁸⁹ 648 F.2d at 603.

¹⁹⁰ *Id.*

¹⁹¹ *Id.* at 604.

¹⁹² *Id.* at 606-07.

¹⁹³ *Id.* at 607. See Borchard, *Reverse Passing Off—Commercial Robbery or Permissible Competition?*, 67 TRADE-MARK REP. 1 (1977), for a discussion of reverse passing off.

derive credit and goodwill from the public's knowledge of the worthy service's true source.¹⁹⁴ The public, moreover, is also deceived as to the source of the services in question, which forms the basis of a regular infringement suit.¹⁹⁵

The court then turned to the argument that Smith lacked standing since he was not a member of a commercial class in competition with the defendant. Judge Pregerson rejected the lower court's restrictive analysis under section 43(a) of the Lanham Act. The statute on its face allows any person who believes that he is or is likely to be harmed to bring suit.¹⁹⁶ Further, the term "person" has been construed to mean, *inter alia*, "natural person,"¹⁹⁷ and modern case law has abandoned the competition requirement.¹⁹⁸

In dictum, the court noted that unfair competition also includes "implied reverse passing off," which occurs when a wrongdoer removes or obliterates the name of the good's or service's source and sells the product in an unbranded state.¹⁹⁹ This view is not uniformly accepted, and at least one authority²⁰⁰ has pondered whether section 43(a) requires affirmative disclosures where the alleged misrepresentation is based solely on omission,²⁰¹ since various jurisdictions have reached contradictory results.²⁰²

¹⁹⁴ 648 F.2d at 607.

¹⁹⁵ *Id.*

¹⁹⁶ *Id.* Further, § 43(a) of the Lanham Act covers false designations or misrepresentations with respect to any services and goods. Judge Pregerson also cited precedents where § 43(a) had been applied to motion picture misrepresentations. In such cases, performers' names, likenesses, or characteristics may be registered under the Lanham Act as service marks for entertainment services, however, registration is not a prerequisite for recovery. *Id.* at 605. The test is "'whether the party has a reasonable interest to be protected against false advertising.'" *Id.* (citations omitted); *see also supra* note 157.

¹⁹⁷ *Id.* at 607.

¹⁹⁸ *Id.* *But cf.* *Colligan v. Activities Club of New York, Ltd.*, 442 F.2d 686, 690-91 (2d Cir.), *cert. denied*, 404 U.S. 1004 (1971).

¹⁹⁹ *Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir. 1981); 1 J. GILSON, *supra* note 22, at 179-80; *see generally* Borchard, *supra* note 193, at 4-5.

²⁰⁰ 1 J. GILSON, *supra* note 22, at 179-80.

²⁰¹ *Id.*

²⁰² *F.E.L. Publications, Ltd. v. Catholic Bishop of Chicago*, 214 U.S.P.Q. (BNA) 409 (7th Cir. 1982); *Alfred Dunhill Ltd. v. Interstate Cigar Co.*, 499 F.2d 232 (2d Cir. 1974); *McNeilab, Inc. v. American Home Prods. Corp.*, 501 F. Supp. 517, *modified on other grounds*, 501 F. Supp. 540 (S.D.N.Y. 1980). "[A] failure to inform consumers of something, even something that they should know, is not *per se* a misrepresentation actionable under section 43(a) of the Lanham Act." *McNeilab*, 501 F. Supp. at 532; *see also* *Universal City Studios, Inc. v. Sony Corp. of America*, 429 F. Supp. 407 (C.D. Cal. 1977):

It is hard to see how a simple failure to disclose can be brought within [§ 43(a)] terms. No reference to omissions of material fact or obligation to disclose such as is found in other federal statutes . . . appears. The key language seems to be "false description," "false representation," and "false designation of origin." The absence of any statement is neither "false" nor a "representation." And it is difficult to see where such a disclosure requirement, if implied, would end, for no limits on the extent and nature of that disclosure can be readily deduced. Whether the cause of action created by

2. Unfair Competition and State Law

Since a federal question arises under section 43(a) of the Lanham Act, a plaintiff may allege his federal and pendent state law claims in a federal district court.²⁰³ One such state law claim, unfair competition, is premised on the same test as the Lanham Act, a showing of a likelihood of public confusion or deception and harm to the plaintiff arising from misrepresentations or unfair business practices.²⁰⁴

The only reported case arising under state unfair competition law involving failure to attribute screen credit is *Meta-Film Associates v. MCA, Inc.*²⁰⁵ In *Meta-Film*, the assignees of a script—portions of which evolved into *Animal House*—alleged that they were entitled to credit as screenwriters.²⁰⁶ The court acknowledged that historically the law of unfair competition had been concerned primarily with wrongful conduct resulting in lost business.²⁰⁷ Therefore, a traditional reading of state unfair competition law would have barred plaintiffs' cause of action, because no common law action existed for failure to attribute, or for misap-

§ 1125(a) is rooted in the limited context of "passing off" . . . or the somewhat broader realm of "false advertising [,]" . . . it cannot be said that as conceived or enacted the statute was designated to make all failures to disclose actionable.

Id. at 410 (citations omitted). *But cf.* *Kwik-Site Corp. v. Clear View Mfg. Co.*, 758 F.2d 167, 178 (6th Cir. 1985); *Frisch's Restaurants, Inc. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642, 650 (6th Cir.), *cert. denied*, 459 U.S. 916 (1982); *Meta-Film Assocs. v. MCA, Inc.*, 586 F. Supp. 1346, 1362 (C.D. Cal. 1984); *Bohsei Enters. v. Porteous Fastner Co.*, 441 F. Supp. 162 (C.D. Cal. 1977):

The law of false representation must necessarily include the omission of the material fact of origin . . . in the context in which [imported goods] are sold Concern over the materiality of such an omission particularly in the context of imported goods was expressed by Congress when it enacted 19 U.S.C. § 1304 requiring imported articles to be "marked in a conspicuous place as legibly, indelibly, and permanently as the nature of the article (or container) will permit in such manner as to indicate to an ultimate purchaser . . . the country or origin of the article." To hold that omission of such a material fact is not such a false representation as to affect the competition of the sale to the detriment of a seller who complies with the mandate of 19 U.S.C. § 1304 requires an utterly naive view of the realities of the market place. More importantly, it would promote disregard for the provisions of 19 U.S.C. § 1304.

Id. at 164. *But see In re Certain Caulking Guns*, 223 U.S.P.Q. (BNA) 388, 405-08 (U.S.I.T.C. 1984).

Remedies for § 43(a) Lanham Act violations may require affirmative disclosure. *See infra* note 238.

²⁰³ 28 U.S.C. § 1338 (1982); *see Smith v. Montoro*, 648 F.2d 602, 608 (9th Cir. 1981).

²⁰⁴ *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 655 n.1 (W.D. Wash. 1982) (states may follow federal law).

²⁰⁵ 586 F. Supp. 1346 (C.D. Cal. 1984).

²⁰⁶ *Id.* at 1361.

²⁰⁷ *Id.*

propriation without attribution.²⁰⁸ However, California's enactment of a comprehensive unfair competition statute²⁰⁹ widened the legal concept of unfair competition to "mean and include *unlawful, unfair* or fraudulent business practice"²¹⁰ Accordingly, the California Supreme Court has interpreted the legislature's "sweeping language to permit tribunals to enjoin ongoing wrongful business conduct in whatever context such activity might occur."²¹¹

Guided by *Smith v. Montoro*,²¹² the *Meta-Film* court then held that the deprivation of screen credits violated "contemporary standards of fairness."²¹³ The import of this decision is significant for several reasons: first, whereas the *Smith* court had focused on the harm arising from "substitution,"²¹⁴ the *Meta-Film* decision referred to "deprivation"²¹⁵ or omission with respect to accreditation; second, the *Meta-Film* court's express comparison of California unfair competition law with the *Smith*'s court interpretation of section 43(a) of the Lanham Act resulted in a finding that any immoral commercial practice with regard to misappropriation of an individual's "efforts" is actionable;²¹⁶ and third, an affirmative duty of disclosure, as a matter of tort, was imposed by *Meta-Film*, as opposed to an obligation not to substitute another's name.²¹⁷ The principles enunciated in *Meta-Film* are, of course, as applicable to actors or performers, as they are to screenwriters,

²⁰⁸ *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 149 (D.D.C. 1980).

²⁰⁹ CAL. BUS. & PROF. CODE §§ 17200-17208 (West Supp. 1985). Section 17200 provides in pertinent part: "unfair competition shall mean and include unlawful, unfair or fraudulent business practice and unfair, deceptive, untrue or misleading advertising and any act prohibited by Chapter 1 (commencing with section 17500) of Part 3 of Division 7 of the Business and Professions Code." Section 17203 states:

Any person performing or proposing to perform an act of unfair competition within this state may be enjoined in any court of competent jurisdiction. The court may make such orders or judgments, including the appointment of a receiver, as may be necessary to prevent the use or employment by any person of any practice which constitutes unfair competition, as defined in this chapter, or as may be necessary to restore to any person in interest any money or property, real or personal, which may have been acquired by means of such unfair competition.

Id.

²¹⁰ 586 F. Supp. at 1362 (quoting *Barquis v. Merchants Collection Assocs. of Oakland*, 7 Cal. 3d 94, 109, 496 P.2d 817, 827, 101 Cal. Rptr. 745, 755 (1972)) (emphasis in original).

²¹¹ *Id.*

²¹² 648 F.2d 602.

²¹³ 586 F. Supp. at 1362 (quoting *Smith*, 648 F.2d at 604).

²¹⁴ 648 F.2d at 606-08.

²¹⁵ 586 F. Supp. at 1362.

²¹⁶ *Id.* at 1363.

²¹⁷ *Id.*

because the property interests defeated and injuries suffered are identical when credit is denied.

3. Remedies

Neither *Perin*²¹⁸ nor *Smith*²¹⁹ reached the issue of damages under section 43(a) of the Lanham Act, since these cases only concerned the validity of the plaintiffs' claims. Remedies are not specified within the text of section 43(a) itself, and this has led some courts²²⁰ to apply the provisions of section 35 of the Lanham Act.²²¹ These provisions include: recovery of a defendant's profits; any damages sustained by a plaintiff; reasonable costs of the action in exceptional cases; and treble damages for any amount found as actual damages, if necessary in the court's discretion.²²²

In *Cher v. Forum International, Ltd.*,²²³ three defendants jointly and severally published an interview which the entertainer Cher had retracted. The court, exercising its discretion, reasonably compensated Cher for the wrongful impressions created in the public's mind, and consequently awarded a variety of damages under different theories of law for false advertising, including section 43(a) Lanham Act violations.²²⁴ Following other jurisdictions,²²⁵ the court awarded a sum equal to twenty-five percent of the defendants' wrongful initial advertising campaign costs, as a fair approximation of the damages necessary to conduct corrective advertisements. Since Cher and the defendants had established the value of the interview in prior negotiations, special damages were set at the agreed value amount to return each defendant's unjust enrichment. The court also awarded the costs of the suit and exemplary damages totaling \$350,000.²²⁶

²¹⁸ 400 PAT. TRADEMARK & COPYRIGHT J. (BNA) A-13 (S.D.N.Y. Sept. 13, 1978) (not otherwise reported).

²¹⁹ 648 F.2d 602.

²²⁰ *Rickard v. Auto Publisher, Inc.*, 735 F.2d 450, 455 (11th Cir. 1984).

²²¹ 15 U.S.C. § 1117 (1982).

²²² *Id.*

²²³ 213 U.S.P.Q. (BNA) 96 (C.D. Cal.), *modified*, 692 F.2d 634 (9th Cir. 1982), *cert. denied*, 462 U.S. 1120 (1983).

²²⁴ 213 U.S.P.Q. (BNA) at 99-100, 102. On appeal, the Ninth Circuit decided the case on grounds other than the Lanham Act without reaching any substantive interpretation of that statute. 692 F.2d at 637 n.1.

²²⁵ 213 U.S.P.Q. (BNA) at 102.

²²⁶ CAL. CIV. CODE § 3294 (West Supp. 1984) (pursuant to California law, such punitive damages may be awarded where a defendant acts with conscious disregard for another's rights, or with deceit or by means of intentional misrepresentation). *Cf. Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 140 Cal. Rptr. 921 (1977). The deciding factor may be whether the plaintiff sues in tort or in contract. *Ericson* was a breach of contract action, whereas *Cher* also involved state law claims of tortious unfair competition.

Whether the relief granted in *Cher* can be analogized to a cause of action such as that in *Smith v. Montoro* is debatable. Admittedly, there is little resemblance between an interview that all the parties agree is worth a certain amount and a multi-million dollar film for which a performer is only partly responsible. To the extent that a large portion of a film is rightfully released and that such performer has been paid for his services, it seems unjust to award all of the film's proceeds. Perhaps, the burden should shift to the defendant, pursuant to a finding of liability, to apportion his unjust enrichment, the amount of money necessary to correct the misleading impression and to compensate the performer for any actual harm suffered.²²⁷ Likewise, although the plaintiff's damages may be highly speculative,²²⁸ willful misconduct on the defendant's part may shift the equities in plaintiff's favor.²²⁹

However, in *Meta-Film* the court was only willing to grant injunctive relief to the plaintiffs, the extent of which, to be determined upon remand.²³⁰ This limitation followed a precedent from the California Supreme Court, which had sustained a dismissal of a private plaintiff's claim for damages in *Chern v. Bank of America*.²³¹ *Chern* involved sections 17500 and 17535 of the California Business and Professions Code,²³² which are similar to sections 17200 and 17203 of the unfair competition statute

²²⁷ 213 U.S.P.Q. (BNA) at 102-03.

²²⁸ See, e.g., *Smithers v. Metro-Goldwyn-Mayer Studios*, 139 Cal. App. 3d 643, 646, 189 Cal. Rptr. 20, 24 (1983).

²²⁹ *Id.*

²³⁰ 586 F. Supp. at 1364.

²³¹ 15 Cal. 3d 866, 544 P.2d 1310, 127 Cal. Rptr. 110 (1976).

²³² CAL. BUS. & PROF. CODE §§ 17500-17560 (West 1976). Section 17500 provides that:

It is unlawful for any person, firm, corporation or association, or any employee thereof with intent directly or indirectly to dispose of real or personal property or to perform services, professional or otherwise, or anything of any nature whatsoever or to include the public to enter into any obligation relating thereto, or to make or disseminate or cause to be made or disseminated before the public in this state, or to make or disseminate or cause to be made or disseminated from this state before the public in any state, in any newspaper or other publication, or any advertising device, or by public outcry or proclamation, or in any other manner or means whatever, any statement, concerning such real or personal property or services, professional or otherwise, or concerning any circumstance or matter of fact connected with the proposed performance or disposition thereof, which is untrue or misleading, and which is known, or which by the exercise of reasonable care should be known, to be untrue or misleading, or for any such person, firm, or corporation to so make or disseminate or cause to be made or disseminated any such statement as part of a plan or scheme with the intent not to sell such personal property or services, professional or otherwise, so advertised as the price stated therein, or as so advertised. Any violation of the provisions of this section is a misdemeanor punishable by imprisonment in the county jail

discussed above. Lower courts²³³ had applied the *Chern* analysis to section 17200, despite language permitting discretionary awards of ancillary damages in certain cases. As the *Meta-Film* court had concluded that it was not necessary to deter future violations or restore any unjust enrichment, the plaintiffs' claim was not restitutionary in nature.²³⁴

As a rule, injunctions are the end result of a balancing test which is "influenced by the relative equities between the parties and the efficacy of less extensive relief."²³⁵ A court must then determine the manner in which a plaintiff was or will be harmed, the possible alternative to abrogate that harm, and the relative inconvenience to a defendant resulting from each method of abrogation.²³⁶ Where a defendant's conduct is particularly reprehensible, a court could allow seizure of the film.²³⁷ Impounding this mislabelled film would be an extremely strong economic sanction and would most likely be a last resort if the film had already been distributed. Other remedies might include requiring corrective advertisements in the media to correct any "confusion" that may have resulted from misrepresentations.²³⁸

IV. THE EXTENT OF PROTECTION

Not every performer in a film can be given credit due to spa-

not exceeding six months, or by a fine not exceeding two thousand five hundred dollars (\$2,500), or by both.

Id. Section 17535 provides in pertinent part that:

Any person, corporation, firm, partnership, joint stock company, or any other association or organization which violates or proposes to violate this chapter may be enjoined by any court of competent jurisdiction. The court may make such orders or judgments, including the appointment of a receiver, as may be necessary to prevent the use of employment by any person, corporation, firm, partnership, joint stock company, of any other association or organization of any practices which violate this chapter, or which may be necessary to restore to any person in interest any money or property, real or personal, which may have been acquired by means of any practice in this chapter declared to be unlawful.

Id.; see also *supra* text following note 209.

²³³ See *Dunkerly v. Taylor*, 139 Cal. App. 3d 1005, 189 Cal. Rptr. 294 (1983).

²³⁴ 586 F. Supp. at 1363.

²³⁵ *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 664 (W.D. Wash. 1982).

²³⁶ *Id.* (citation omitted).

²³⁷ Compare *Bi-Rite Enters., Inc. v. Bruce Miner Co.*, 757 F.2d 440 (1st Cir. 1985) with *Universal City Studios, Inc. v. Mueller Chem. Co.*, 223 U.S.P.Q. (BNA) 798 (N.D. Ill. 1983); *National Football League Properties, Inc. v. Wichita Falls Sportswear*, 532 F. Supp. 651, 664-65 (W.D. Wash. 1982); see also *Berman & Rosenthal, supra* note 4, at 180-81.

²³⁸ *Cf. CBS, Inc., v. Cineamerica Distrib. Corp.*, No. 78-2245, slip op. at 11 (S.D.N.Y. Oct. 17, 1978) (available June 29, 1985, on LEXIS, Genfed library, Dist file); *Cher v. Forum Int'l, Ltd.*, 213 U.S.P.Q. (BNA) 96, 103 (C.D. Cal. 1982) (subsequent history omitted).

tial and economic considerations. In a film involving a cast of thousands, it would be impracticable to attempt a full listing.²³⁹ Moreover, it is most likely that the public would not really care, since "extras" are just that.²⁴⁰ The question then is which performers deserve accreditation?

Consider the example of a blockbuster horror film that grossed millions of dollars with its dramatic portrayal of demonic possession.²⁴¹ Curiously enough, the performer responsible for the demon's voice was not given billing for her vocal role. This omission was apparently not a careless oversight, as even the jewel supplier was given credit, and the director had orally promised the performer a special credit.²⁴² Ostensibly, credit was not given to enhance the popular perception that the teenager playing the possessed child was solely generating the horrendous obscenities and blasphemies. Only when the film company's shock tactics backfired, after negative publicity seemed to affect the teenager's chance to win an Oscar, did the extent of the performer's contribution leak to the press.²⁴³

The nature of the performer's presence in the film was crucially significant, in part, because her voice was but distorted beyond recognition, at the cost of great suffering and effort. In fact, the demon's voice was produced by a combination of many sounds: the wheezing was created by the performer's chronic bronchitis, the tones of which were overdubbed; the wailing was drawn from her experiences of keening at Irish wakes; the moaning came from another theatrical role; and the groaning noises were effected by self-induced strangulation with a scarf.²⁴⁴ The performer averred that blaspheming was an "agony" for her, and that in order to portray evil incarnate she had to imagine Lucifer by recalling her memory of being an alcoholic, of seeing the in-

²³⁹ *Film Credits Stir Debate*, N.Y. Times, Dec. 28, 1983, at C17, col. 1; Chase, *What's A Gaffer Anyway?*, N.Y. Times, June 3, 1984, § 2, at 1, col. 1.

²⁴⁰ Chase, *supra* note 239, at 1.

²⁴¹ M. MAYER, *THE FILM INDUSTRIES* 33-34 (1978).

²⁴² Higham, *Will the Real Devil Speak Up? Yes!*, N.Y. Times, Jan. 27, 1974, at D13, col. 5. *But cf.* Kaplan, *ABC to Pay Damages*, N.Y. Times, July 6, 1985, § 2, at 42, col. 5. A federal court jury ordered ABC to pay a freelance writer damages, where the network failed to credit the writer for an article upon which broadcasts were based:

The jury found that there had not been a breach of contract, but that the network had "fraudulently misrepresented" that the freelance writer would receive an on-the-air credit for his work [and] awarded \$150,000 in compensatory damages and \$50,000 in punitive damages.

²⁴³ Higham, *supra* note 242, at D13. *But cf.* Chase, *supra* note 14, at C17 (performer claiming to have benefitted from lack of accreditation due to heightened media interest in her role).

²⁴⁴ Higham, *supra* note 242, at D13, col. 5.

sane in state hospitals: " 'I've been through hell . . . [s]o I cried out from my remembered hell.' ”²⁴⁵

The performer also physically suffered by swallowing eighteen raw eggs with a pulpy apple to create the effect of violent expectoration. To convey the essence of the Devil's confinement, she had the crew bind her in sheets. " 'Sometimes I was so exhausted and my circulation was so sluggish that I wasn't able to drive home . . . My voice was ruined. For weeks I couldn't talk above a whisper.' ”²⁴⁶

That a performer is not fully presented in a film should not be a reason to deny credit, especially where talent and stamina result in a significant contribution. Where a performer's contribution is substantial but his presence unrecognizable, a stronger case exists for a right to receive credit. Even though not every contribution to a film may be acknowledged,²⁴⁷ a suitable test may be whether the performer's role is such that it is likely to be a major feature which draws audiences. Since the purpose of most popular films is entertainment,²⁴⁸ special effects and specialty roles play an ever-increasing part in satisfying audiences eager for new spectacles.²⁴⁹ Thus, not only leading actors are entitled to receive credit, but any performer who substantially adds to the film's marketability. This test would exclude, however, the extras in the cast of thousands.²⁵⁰

V. CONCLUSION

Perin, *Smith*, and *Meta-Film* represent developments in modern law that recognize the property rights of creative talents to have their respective labors acknowledged. Thus, the legislature's and judiciary's insistence on equitable commercial dealings has led to a reevaluation of the relationship between the per-

²⁴⁵ *Id.*

²⁴⁶ *Id.* (emphasis omitted).

²⁴⁷ Chase, *supra* note 239, at 1.

²⁴⁸ M. MAYER, *supra* note 241, at 45; Kerr, *Films Are Made in the Cutting Room*, N.Y. Times, Mar. 17, 1984, § 2, at 1, col. 4.

²⁴⁹ M. MAYER, *supra* note 241, at 38-39, 45.

²⁵⁰ Higham, *supra* note 242, at D13. A more difficult issue may be presented when the leading actor performs in conjunction with the performer. In the above example, the performer averred that the leading actress' voice was not used at all, just her lip movements. *Id.* More recently in *Flashdance*, the leading actress did not perform any of the dancing according to Marine Jahan. Chase, *supra* note 14, at C17. But accreditation may be denied to the performer where his contribution is relatively insubstantial. *Cf.* Parker, *Flashback: The Hand-In*, AM. FILM, Nov. 1985, at 58 (performer did not have lawyer to arrange for billing as Van Gogh's hands, or as artist who painted reproductions in film). *But cf.* *Ghostwriters*, *supra* note 47, at C17.

former and his employer.²⁵¹ But these equitable notions have realigned performers' rights only after such rights were capable of being expressed within a framework of acceptable and recognizable concepts.²⁵²

The justifications underlying the application of the Lanham Act and state unfair competition law in these cases are overinclusive. Ultimately it is unnecessary to focus on the public's right not to be confused by unscrupulous commercial practices, because the requirement that a potential plaintiff have an interest which is or is likely to be jeopardized subordinates the public deception question.²⁵³ This view presupposes that performers are involuntarily deprived of "advertising" without express reservations in contractual agreements.²⁵⁴ However, at the point that courts are willing to find that performers have pecuniary rights in receiving credit, their discussion of deception of the public is merely a subterfuge for protecting a valid legal property interest.

The language of unfair competition relies primarily on "substitution" as the actionable element which confuses the public. As noted above, the law is by no means settled where no representation is made at all.²⁵⁵ Thus, the emphasis on public deception, or the possibility thereof, once again, is the wrong inquiry. Inconsistencies will spring from a distinction as to whether any credit or the wrong credit was given. That is, as far as public confusion is concerned, substitutions are harmful under *Smith v. Montoro*,²⁵⁶ but omissions may not be misleading.²⁵⁷ Where no credit is given or is substituted wrongfully, the inquiry should be whether the performer was harmed, and that in both situations there is an affirmative duty of disclosure.

Further, it is submitted that *Perin*, *Smith*, and *Meta-Film* contain no principled limitation that restricts other performers from securing accreditation rights. Any performer or creative talent who makes a substantial contribution to a film will experience similar pecuniary and personal injuries as a leading actor from a

²⁵¹ See *infra* notes 183-217 and accompanying text.

²⁵² See *infra* notes 24-64 and accompanying text.

²⁵³ *Meta-Film Assocs. v. MCA, Inc.*, 586 F. Supp. 1346, 1363 (C.D. Cal. 1984) (quoting *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981)).

²⁵⁴ That is, such a right is a property interest capable of legal protection, and the public's interest in knowing the derivation of services imposes an affirmative duty of disclosure on distributors which is not subject to waiver.

²⁵⁵ I. J. GILSON, *supra* note 22, at 188-89.

²⁵⁶ 648 F.2d 602.

²⁵⁷ *But cf.* *Meta-Film Assocs. v. MCA, Inc.*, 586 F. Supp. 1346, 1363-64 (C.D. Cal. 1984).

denial of credit.²⁵⁸ In fact, a performer may have a more pressing claim, because while a primary actor is fully perceived in most films, a performer's contribution may consist of only vocals²⁵⁹ or present the performer in a disguised form.²⁶⁰

However, it is arguable that where such a performer is "masked" by the leading actor's role, a form of substitution has occurred which prevents differentiation. Under such circumstances, the performer's claim is the most pressing since he is for all intents and purposes, invisible.

This Note has demonstrated that full acceptance of the *droit moral* paternity right is unlikely given the legal and economic climate of the United States.²⁶¹ Further, it has suggested that contract law is an unsatisfactory medium of redress, due to the parties' unequal bargaining positions, as well as the inexact measure for computing damages.

However, accreditation rights are valid property interests worthy of legal protection. This Note argues for greater pecuniary protection to be given to performers by imposing a duty of affirmative disclosure with respect to accreditation rights on film producers and directors. This duty, arising under section 43(a) of the Lanham Act or state unfair competition law, should be expanded to cover all performers who contribute substantially to the finished product, and not merely the primary or leading actors.

Robert L. Gordon

²⁵⁸ The people who create sound effects to the picture are called Foley artists or Foley walkers. I, however, worked as a Foley supervisor and Foley editor. My job consisted of deciding what to record, collaborating with the Foley artists on the props, and directing the three Foley artists for twelve full days as they made the sound effects. Afterward, I edited the tracks to make them in sync with the picture
 It was . . . too much effort for MGM/UA to credit either the three Foley artists or the Foley editor on *Mrs. Soffel*. The other studios credit these positions. The MGM/UA legal department, whom I am told made a last-minute decision to drop thirty technical credits, worries that they are giving out too many credits. Maybe we are not that important, but try to imagine *Mrs. Soffel* with no horse hooves, and no footsteps, and no movement sounds for everything you see, including the fight scenes. It would be a less dramatic experience, I am sure.

Letter from Joanne D'Antonio to Jamie Wolfe, in *AM. FILM*, Apr. 1985, at 6.

²⁵⁹ See *supra* notes 242-47 and accompanying text.

²⁶⁰ See *supra* note 250.

²⁶¹ Kringsman, *supra* note 17, at 257, 265-69.